

INTERNATIONAL TRADE MARK REGISTRATION

The U.S.A. signed up to the International system for registration of trade marks on November 2, 2003 and it is now possible for trade mark owners in the U.S.A. to submit international applications to the USPTO. This note provides some information on the International registration system and addresses some issues which arise particularly, but not exclusively, for U.S. applicants.

Under the International registration system, it is possible to obtain an “International registration”. This is a bit of a misnomer as the “registration” is more of a bundle of national registrations than a registration in its own right.

The International registration system is governed by two treaties: the Madrid Agreement and the Protocol Relating to the Madrid Agreement. The system is administered by the International Bureau of the World Intellectual Property Organisation (WIPO) in Geneva, Switzerland. The treaty that the U.S.A. has ratified is the Protocol. This note is, therefore, restricted to how the system works under the Protocol and not under the Agreement.

Advantages of the International Trade Mark Registration System:

- One application filed with one National Registry in one language (English or French)
- Can cover up to fifty-seven countries including all EU countries, Norway, Switzerland, Japan, China, Australia, Russia and Singapore
- Can claim priority in usual way
- Provided no objections raised, no need to appoint local agent in designated countries
- More countries can be added at any time after registration
- One renewal request filed centrally every ten years
- Change of proprietor details, including change of address, change of name, assignments etc. recorded centrally with one request
- Possible to assign in part i.e. in relation to certain countries only or in relation to certain goods or services only

Points to note:

- Filing from the U.S. will result in a narrow specification.
- Registration is dependent on home application/registration for 5 years.
- Restrictions on who can own an International registration may make subsequent transfers difficult.
- Obtaining protection with a Community trade mark in EU countries may be cheaper and is more beneficial.
- Mostly cheaper up front than filing separate national applications but may not be so in the long term

How to File

- Basic application or registration

Before filing for an International registration, the applicant must first have one or more “basic” applications or registrations. Usually, the applicant has only one basic application or registration. This basic application or registration must be in the applicant’s country - i.e. the country where the applicant is a national, is domiciled, or in which the applicant has a real and effective industrial or commercial establishment – and that country must be a signatory to the Protocol. A list of signatories to the Protocol is at the end of this note.

The International registration must be for exactly the same mark as covered by the basic application or registration and for exactly the same, or a narrower range of, goods and services. The application can cover as many countries as the applicant wants (provided the countries adhere to the Protocol). Each country is called a “designated country”. The application can claim priority in the normal way either from the basic application or registration or from an earlier mark.

- Where to file

The application is filed with the national registry where the basic application or registration was filed (the “Office of Origin”). The Office of Origin then forwards the application to the International Bureau at WIPO.

- Procedure

The International Bureau examines the application for formal requirements. Any mistakes or queries are communicated to the Office of Origin who may then communicate with the applicant if it needs clarification before responding.

When the formal requirements are satisfied, the International Bureau “registers” the mark and issues a certificate. The registration is published in “The WIPO Gazette of International Marks”. At the same time the International Bureau informs the trade mark offices in the designated countries and the Office of Origin.

The trade mark offices in the designated countries examine the registration according to national laws as if it were a nationally filed application. If accepted, protection in the designated countries will be effective from the filing date of the International registration. However, if refused, and if the refusal is not overcome, protection is not granted in that particular designated country. If the application is refused by a national trade marks office, whether in whole or in part, then that refusal will be dealt with in accordance with the law and practice of the relevant country. The applicant is given a chance to respond to the refusal but, in order to do so, must appoint a representative in that country.

The International registration may be opposed in each designated country in the same way that a national application in that particular country would be opposed. There is no centralised opposition procedure.

Subsequent Dealings

An International registration can be assigned. It can be assigned in part i.e. in relation to only certain countries or in relation to only part of the specification.

It is not necessary to include the basic application or registration in the transfer. However, particularly where the International registration is still vulnerable to central attack, it is usual for the basic application or registration to be assigned to the same holder as the International registration.

Who Can Apply for or Hold an International Registration

The applicant or proprietor must be a national or domiciled in a country party to the Protocol or have a real and effective industrial or commercial establishment in such a country. This requirement is obviously a problem for those in countries not yet a party to the Protocol as they cannot apply for International registrations. Moreover, they cannot receive assignment of International registrations. This can cause problems where a business is taken over by a foreign entity or where a group of companies wants to assign its trade mark rights to a group company in a different country. This future restriction on assignability is something that should be considered when a decision is made to use the International system for obtaining trade mark protection.

Although the basic application or registration must be in the country of the original applicant, this does not mean that a subsequent proprietor must be in the same country. The subsequent proprietor must simply fulfil the requirements above i.e., of having the relevant connection with a Protocol country.

Central Attack

- Dependency

The International application or registration is dependent on the basic application or registration for five years from the filing date of the International registration. That means that if the basic application or registration fails in any respect for any reason, then the International registration also fails. Thus, if the basic application never proceeds to registration, or is successfully attacked post registration in the five year period, the International registration will fail. If the basic application or registration fails only in part, for example a restriction is made to the specification, then the International registration will fail to a similar degree.

- Transformation

However, all is not lost if the basic application or registration fails, or is restricted. Although the International registration will also fail or be restricted, it is possible to transform the International registration into national applications in one or more of the original designated countries. The national applications will retain the original filing date (and priority date, if there is one) of the International registration. They will, however, be re-examined, attract a new filing fee, and it is very likely that an agent will need to be appointed in order to handle the national application. This increases the cost of obtaining protection significantly.

Duration and Renewal

The International registration must be renewed every ten years. A request for renewal is made with the International Bureau who records the renewal in the International Register and notifies the trade marks offices in the designated countries. The International Bureau also issues a renewal certificate and publishes the renewal in "The WIPO Gazette of International Marks".

Subsequent Designation

New countries can be added to an International registration after it has been obtained (where those countries are party to the Protocol). Protection in such new countries will not be backdated to the filing date of the International registration but will run from the date of the new country's designation.

Countries party to the Agreement can also be added if the proprietor's country is bound by the Agreement, as well as the Protocol.

As renewal is effected centrally, any subsequent designations will become due for renewal at the next renewal date of the International registration rather than ten years after designation.

COMPARISON WITH NATIONAL AND COMMUNITY TRADE MARK REGISTRATIONS

- National registrations

The cost of obtaining an International registration varies with the type of mark, number of classes and countries designated. The cost per country is not uniform. Initial costs are usually lower than filing in each country nationally, mainly because local representatives are not appointed. However, local representatives will need to be appointed if objections are received in a particular country. Costs will also increase if the basic application or registration fails and the registration is transformed into national applications.

- Community trade mark registrations

If a number of EU countries are to be covered, it may be cheaper to obtain a Community trade mark. A Community trade mark application in 3 classes will incur official fees of roughly US\$2,500 (including registration fees). An International application covering 3 classes and designating all pre 1st May 2004 EU member

states will incur official fees of roughly US\$3,100 (excluding the cost of the basic application/registration). Adding those countries which became EU member states on 1 May 2004 (9 out of the 10 – Malta is not a signatory to the Protocol) would cost roughly US\$ 900 more.

A Community trade mark has other benefits. For example, a Community trade mark may remain validly registered even if not used in every EU country. An International registration will need to be used in every country designated in order to remain validly registered in that country.

How can Lloyd Wise help in obtaining International Registrations?

One of the particular problems of the International registration system for U.S. applicants is the fact that the International registration can only cover goods and services included within the basic application or registration. Thus, if a U.S. filed mark is used as the basic application or registration, the International registration will be restricted to the narrow range of goods and services covered by the U.S. application or registration.

One way of avoiding this problem is to base the International registration on an application or registration filed in a different country. Of course, this will only be possible if the applicant is a national of or is domiciled in another country party to the Protocol or has a real and effective industrial or commercial establishment in such a country. If the applicant does have a choice of countries in which it can file its basic application (or has subsidiaries or related companies that could file the International application for it), then thought should be given to choosing the U.K. as the country in which to file the basic application. One of the main advantages of choosing the U.K. is that fact that the specification of the basic application or registration will be in English. This means that there is no possibility of translation errors resulting in the omission of goods or services from the basic application or registration and, therefore, from all of the designated countries.

The U.K. Trade Marks Registry is one of the more stringent registries in the world and still examines applications on both absolute and relative grounds. Although this means that an application filed within the U.K. is sometimes difficult to register, it also means it is difficult to attack, once registered. The examination of U.K. applications takes place quickly. A U.K. application usually receives its first examination within a month of filing so an initial assessment as to whether registration is likely to be granted can be given within a relatively short time. We have found this to be very attractive to clients using the International system.

If a decision is made to base an International registration on a U.K. application or registration, Lloyd Wise is ideally suited to handling the International registration. We already have extensive experience of filing International registrations and have therefore both the experience and the infrastructure to handle International registrations.

Even if the International registration is to be based on a non-U.K. application or registration, you can still appoint Lloyd Wise to handle the International application and take advantage of our expertise.

Lloyd Wise has offices in Singapore and China which also have expertise in handling International registrations. Lloyd Wise can, therefore, handle objections in the United Kingdom, Singapore and China whether or not it is handling the International registration, itself.

It is expected that it will become possible to apply for a Community trade mark registration via the International registration system in the near future. As we have extensive experience of handling Community trade mark applications, we will also be able to handle any problems, queries or oppositions in relation to a Community trade mark applied for via the International registration system.

As usual with a summary note, we have only been able to deal with matters in a general fashion. If you would like more information on International registrations, or advice on specific situations please either write to your usual Lloyd Wise contact or Kate Széll in London (e-mail ks@lloydwise.co.uk),

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INTERNATIONAL TRADE MARK REGISTRATIONS **APRIL 2004 – MADRID PROTOCOL COUNTRIES**

This table lists the countries party to the Madrid Protocol and shows roughly how much the official fee is, in Swiss Francs, to designate the country assuming application is made for a mark covering 3 classes. There will also be a basic cost for filing the application which will vary depending on the Office of Origin.

More than 3000 Swiss Francs

Japan

More than 1000 Swiss Francs

Australia
United States of America

500 to 1000 Swiss Francs

Belarus	*Ireland	Turkmenistan
China	Norway	Ukraine
*Denmark	Singapore	*United Kingdom
*Estonia	South Korea	
Georgia	Switzerland	

100 to 500 Swiss Francs

Armenia	*Finland	*Italy
*Benelux	*Greece	*Sweden
Bulgaria	Iceland	

Less than 100 Swiss Francs

Antigua & Barbuda	Kyrgyzstan	North Korea
Albania	*Latvia	*Poland
*Austria	Lesotho	*Portugal
Bhutan	Liechtenstein	Romania
Croatia	*Lithuania	Russian Federation
Cuba	Macedonia	Serbia and Montenegro
*Cyprus	Moldova	Sierra Leone
*Czech Republic	Mongolia	*Slovakia
*France	Monaco	*Slovenia
*Germany	Morocco	*Spain
*Hungary	Mozambique	Swaziland
Iran	Namibia	Turkey
Kenya		Zambia

* indicates EU Member State