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# International Registrations under the Madrid Protocol

*Updated since USA and EC became members*

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## Introduction

The Madrid Agreement has a history of more than 100 years and the Madrid Protocol (The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks) is [an offshoot of the Madrid Agreement](#). The Protocol was adopted in Madrid on 27 June 1989 and became operational on 1 April 1996. Most of the initial signatories were European countries but since the turn of the century, many countries around the world have become members. Today, [with the possibility of more than 65 designations](#) under the Madrid Protocol, including Japan, South Korea, the USA and the European Community, it is simply impossible for trademark owners and practitioners not to at least contemplate the Madrid system as a possible route where multi-national protection of a trademark is required. Many owners are attracted by the potential savings and simpler procedure of filings under the Madrid Protocol as compared to national/regional filings. Many are also concerned whether that is really the whole story. If it were so, why do some companies make a conscious decision not to use the system even though it is available to them? Why do others use the system some but not all the time? Yet, there are some trademark owners who believe strongly in the system and use it almost inevitably for protection of their marks in Madrid Protocol member countries.

## What the Madrid System Is Meant to Be

The Madrid system is a system which enables a trademark owner to seek protection for his trademark in several countries by filing *one* application directly with his national or regional trademark office. This single application serves as a bundle of applications as if they were filed directly in each of the national or regional offices designated in the Madrid application. As the filing can be achieved without the services of a representative in each jurisdiction, the Applicant stands to have substantial [cost-savings](#) at the filing stage. Only in the case where a [refusal](#) is issued in a country will the services of a local agent be

required to respond to the refusal and secure the desired protection in that country.

The International Bureau of the World Intellectual Property Office in Geneva (“IB”) issues an “International Registration” within a few months and this is treated as a *single* registration by IB. A trademark registration granted through this process is to have the same force and effect as a national/regional registration in that jurisdiction. Any changes in the [owner's details](#) or [ownership](#) and [renewal](#) of the registration will be processed centrally by IB.

The discussion in the present article is confined to the Madrid Protocol only. The UK, Australia, Japan, South Korea, Singapore and the USA are all members only of the Madrid Protocol and not the Madrid Agreement. Different provisions apply if an Applicant is entitled to file a Madrid application under the Madrid Agreement only, or under both the Madrid Agreement and the Madrid Protocol. Whether the provisions of the Agreement or the Protocol applies will then be guided by Article 9sexies of the Protocol, known as the Safeguard Clause.

### **Members of the Madrid Protocol**

As at February 2006, an Applicant can select from a [list of more than 65 possible designations](#) in a single application filed under the Madrid Protocol (Belgium, Luxembourg and the territory of the Kingdom of the Netherlands in Europe being one possible designation under “Benelux”). They are referred to as “Contracting Parties” to the Madrid Protocol.

Presently, many Asia-Pacific countries have yet to join the Madrid Protocol. Although China, Japan and South Korea are members, you cannot use the Madrid Protocol to secure protection in Hong Kong SAR. India, the second fastest growing economy, is not a member, and neither are many Middle-Eastern countries. New Zealand is not a member but Australia is. In ASEAN, the only member country is Singapore. Vietnam being a member of the Madrid Agreement but not the Madrid Protocol.

On the other hand, the Madrid system is very well established in the European countries and since 1 October 2004, trademark owners had the choice of designating individual countries in the European community or selecting the Community as a single designation (remembering a designation of EC does not cover Switzerland or Norway). [Whether selecting the EC as a single designation will be advisable](#) in any given situation requires consideration of various factors deserving separate discussion.

### **Pre-Requisites to File an Application Under Madrid Protocol** ***Article 2 of the Madrid Protocol***

#### **1. Connecting Nexus**

The Applicant (which term will encompass each of a number of co-Applicants) must possess the necessary “Connecting Nexus” to a member of the Protocol, i.e. the Applicant must

- be a national of
- is domiciled in, or
- have “a real and effective industrial or commercial establishment in”

a Contracting Party to the Madrid Protocol.

This means that a Malaysian company may not be entitled to file a Madrid Application as Malaysia is currently not a member of the Madrid Protocol. However, if the Malaysian company has “a real and effective industrial or commercial establishment in” a member country, say Singapore, the Madrid Protocol remains a possibility.

This is a limitation of the Madrid Protocol as it currently stands. Even in the situation of a number of co-Applicants, *every* Applicant must possess the requisite “Connecting Nexus,” and this limitation persists after filing such that a Madrid application/registration can only be transferred to a new owner with the requisite “Connecting Nexus” (see [Changes in Ownership](#)). The “Connecting Nexus” requirement of the Madrid Protocol can be contrasted with that of the Patent Co-operation Treaty (“PCT”) in which only one of a number of co-Applicants requires to possess “Connecting Nexus” with a member country and it is possible to transfer a PCT application at some stage after filing to an owner from a non-member country.

## **2. Basic Application or Registration**

There must be a pending application or granted registration in a Contracting Party with which the Applicant has the necessary Connecting Nexus. This will serve as the “Basic application” or “Basic registration” of the Madrid Application. It is also possible for a Madrid application to be based on a number of basic applications/registrations, for example a Madrid application covering 3 classes could be based on 3 separate Singapore applications. We use “basic application/registration” for convenience but the singular may encompass the plural in appropriate situations.

## **3. Madrid Application Must Correspond to the Basic Application/Registration**

The Applicant can file a Madrid Application through the Office of that Contracting Party (called the “Office of Origin”) within the following parameters:

- a) the mark in the Madrid application must be the same as that in the basic application/registration,
- b) the applicant of the Madrid applicant must be the same as the proprietor of the basic application/registration, and
- c) the goods and/or services of the Madrid application must be within the scope of the basic application/registration.

As the mark in the Madrid Applicant must be the same as that in the basic application/registration, and the same for each country designated in the Madrid application, a Madrid Protocol filing may not be suitable where a mark is to be used in different languages in different countries. (Different language marks may in some countries have been filed in a single application for a “series” of marks. If this is to serve as the basic application for the Madrid application, the owner has to choose one of the marks for the Protocol filing. “Series application” is not available in the Madrid system.)

It is also possible for a group of companies with operations in various countries to organize ownership of its trademarks by different companies within the group. In view of the abovementioned requirement that the Applicant of the Madrid application must be the same proprietor as the basic application/registration, such companies will have to decide on one of them being the common owner of the mark in the various countries if it desires to use the Madrid Protocol. (Transfers to different companies, provided they each possess the requisite “Connecting Nexus,” may be arranged after filing, but this will involve additional costs.)

The requirement that the goods/services of the Madrid application must be the same or narrower than that of the basic application/registration means that the peculiarities of the Office of Origin in their examination of specifications affects all the countries designated in the Madrid application. A US company filing a Madrid application through the US Trademarks Office will have to base its Madrid application on a basic US application/registration. As the description of goods/services of the US basic will have been very specific in accordance with US law and practice, the goods/services of the Madrid application based on it will accordingly be limited. This is possibly the main obstacle to US Applicants embracing the Madrid Protocol. (It may be possible to circumvent this limitation if a US company possesses “Connecting Nexus” with [more than one member country](#)). Much broader coverage of goods/services can often be claimed by the Applicant if they filed independent national or regional applications instead, and this can have very significant impact in the context of opposition or infringement proceedings, or in enabling customs authorities to take action against importation of goods not just similar to but in fact covered by a cited trademark registration.

### **Priority and Seniority**

The Madrid Protocol has provision for priority date to be claimed. If an earlier application for the mark was filed in a member country of the Paris Convention or the World Trade Organisation within the preceding six months, the same date of filing may be claimed for the Madrid Application. There is nothing to prevent the Basic Application from serving also as the basis for the priority date claim.

In the context of a designation of the European Community, amendments have been made to the Common Regulations and Administrative Instructions of the Protocol so that an Applicant in a Madrid Application designating the European Community may also claim [seniority of earlier rights](#) established in a Member State of the European Union.

## Right of Refusal

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(forward to [Additional Charges in the event of Refusals](#))

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After formalities have been cleared, it takes the IB only a few months to issue a Certificate of International Registration. Trademark owners must not think that his mark is thereby protected in each of the designated jurisdictions. The designated countries/organization may subject the application for protection to examination under its own legislation. If a mark is found to be unregistrable under local law, or to conflict with an earlier application or registration in that country/territory, the Designated Office may issue a Notice of Refusal to the Madrid Applicant. It is also possible that third party opposition is filed against the extension of protection of the mark in a particular designated country/territory. In such event, a local agent in that country/territory shall have to be appointed to file a response to the Notice of Refusal and/or defend the opposition, within such time limits as prescribed by the local legislation.

The Madrid Protocol regulates the time limit within which a Madrid Application must be examined by each Designated Office. Under Article 5(2) of the Madrid Protocol, a Notice of Refusal must be issued to the Applicant within one year, unless the Contracting Party made a declaration that such time limit is extended to 18 months - [Annex A](#).

This means that a trademark advisor has a rather different role in managing a Madrid filing. Having arranged for a bundle of applications to be filed via a single Madrid application (without benefit of pre-filing advice from foreign agents), he has to diary the time-limit which each designated country/territory has in which to issue a Notice of Refusal, beyond which protection in that country/territory may be presumed. It is noteworthy that designated countries are not obliged to issue notices confirming protection of a mark filed under the Madrid Protocol and in practice, not all countries issue such notices. Further, Protocol members may or may not have made the Article 5(2) declaration, or may change its position subsequent to its initial joining of the Protocol. The trademark advisor has to keep himself updated by regularly checking WIPO publications.

Where a Notice of Refusal is issued, the Designated Office is free to impose a deadline as it deems fit for the filing of an Official Response or Appeal against the refusal. Different countries have in place rather different ideas as to what an appropriate term for response/appeal should be. Some countries give 3 to 4 months but some as short as a few weeks with no possibility of extension. As long as the trademark advisor has not taken steps to involve a local agent, no other party may be aware of the relevant deadline and/or how best to address the refusal. If you are dealing with a term as short as a couple of weeks, it can be extremely challenging for the trademark advisor to identify and brief a local agent for the first time, receive advice on what avenues may be available to address the refusal, seek the owner's instructions, and secure execution of whatever prescribed documents for the response/appeal to be filed (for China, a Power of Attorney executed by the Applicant must be filed with the Appeal). Time difference between countries add to the difficulties. Trademark practitioners need

to set up a good system to receive and address such Notices of Refusal and waste no time in noting the deadlines imposed by the relevant Office.

## **Costs**

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The potential for cost-savings is undoubtedly the main motivation for trademark owners to consider using the Madrid Protocol. The various cost items of a Madrid Application will include:

### **1. Costs of the Basic Application/Registration**

As this is no different from the cost of an ordinary national or regional filing, it need only be mentioned here. If the Madrid route were not chosen, it is likely an application would still have been filed in this jurisdiction.

### **2. Administrative Fee of the Office of Origin**

Having established that a trademark owner has the requisite [Connecting Nexus](#) to file a Madrid Application and selected the [Basic Application/Registration](#) on which the Madrid Application will be based, the trademark owner (or his representative) proceeds to file the Madrid Application through that Office of Origin. To process the Madrid Application, the Office of Origin charges an Administrative Fee, the quantum of which varies from office to office.

### **3. Basic Fee Payable to IB**

A Basic Fee is payable to IB for each Madrid Application filed, irrespective of the number of countries/territories designated. This currently stands at CHF653 for a black and white mark and CHF903 for a colour mark covering one to three classes under the International Classification of Goods and Services (8<sup>th</sup> edition) [\[except for International Applications originating from Least Developed Countries\]](#). Where the goods/services fall into more than three classes, a supplementary fee of CHF73 is payable per additional class beyond three (but if individual fees are payable for all the selected designations, no supplementary fees need be paid).

### **4. Complementary Fees or Individual Fees**

For each country/territory designated, a complementary fee or an individual fee will be payable. The quantum of complementary fee payable stands at CHF73, but where a particular Contracting Party has made a declaration under Article 8(7)(a) of the Madrid Protocol that it wishes to receive an individual fee instead, the appropriate individual fees as notified by the office of that country/territory will be payable instead - [Annex B](#)). As the fees payable may be reduced or increased from time to time, it is advisable to check “*Information Notices*,” “*Fees*” and/or use the “*Fee Calculator*” provided by WIPO at <http://www.wipo.int/madrid/en/fees/> to update the information. In practice, it is not always easy for an owner or trademark advisor to calculate complementary/individual fees payable for the countries/territories of interest as

these do change rather frequently. One has to be particularly careful to take note that the fees may be changed with effect from a certain date such that what one anticipated the fee to be when discussions commenced may be quite different from what it turns out to be when the Madrid application is in fact lodged.

Further, individual fees for some countries are structured such that one fee is payable for the first three classes with additional fees payable per class beyond three, whereas for some other countries, individual fees are payable on per class basis. In the case of the former, the owner should be invited to consider if they wish to cover more goods/services since it is possible to achieve this without incurring additional expenses if they do not fall beyond 3 classes (provided the Basic application/registration cover these goods/services).

## **5. Professional Charges for Madrid Filing**

It is not necessary to appoint an agent to file and manage a Madrid application but it is often a good idea to do so. It is worth mentioning that the professional charges of such an agent is likely to be higher than if the agent were appointed to file merely a national/regional application in the country where the agent practices, but lower than the sum total in charges of foreign agents if national/regional applications had been filed in each country/territory of interest.

## **6. Additional Charges in the event of Refusals**

As mentioned earlier, Contracting Parties may issue [Notices of Refusal](#) on account of its own examination or on account of existing third party rights in that country/territory. In such event, a local representative will have to be appointed to file response to the refusal. Depending on the complexity of the basis for refusal, deadline for filing of response and possibility and costs of amendment or appeal, the cost in event of refusal can be high. Trademark owners are often tempted to exhaust the allocated budget at the filing stage. They should instead, be warned to be prepared for additional expenses in some countries. If a trademark owner prefers that likely problems with the mark or specification be anticipated at the time of filing and all substantial expenses be incurred at such time when a specific budget for protection is allocated, it may be preferable to file national/regional applications with pre-filing advice from trusted local agents.

It is of course possible for the trademark owner to decide not to file a response in the event that a refusal is issued by a particular designated country but the fees already incurred will generally not be refunded. Japan however adopted an interesting scheme for payment of individual fees such that a smaller portion is paid initially and a larger portion is paid only when the Japan Patent Office confirms that the mark qualifies for protection in Japan. Apart from Cuba which also adopted a similar scheme of two-part payment of individual fees in November 2003, no other country has adopted such a scheme. When the European Community joined the Protocol, it introduced another scheme whereby designation fee is to be paid in full on filing but, in the event that a total or partial refusal is issued, a portion of the fees will be reimbursed by the Office for the Harmonization in the Internal Market (OHIM).

## **Dependency and Central Attack**

### ***Articles 6 and 9quinquies of the Madrid Protocol***

The convenience and costs-savings offered by the Madrid Protocol comes with a major risk – for the first five years from the date of an international registration, anything that affects the basic application/registration will also affect all the designations of the international registration. If the basic application is refused in total, the international registration will be ineffective in total. If the basic application/registration is limited in scope, such limitation will also affect the scope of protection in each designated jurisdiction. If the basic application/registration is successfully opposed or cancelled, rights in the designated countries will also fail (known as “Central Attack”).

In one sense, this may be cost-effective in that a third party may, instead of opposing or attacking registration of a mark in a multiple number of countries, only commence proceedings against the basic application/registration during the dependency period. The trademark owner, too, need not incur the cost of defending his applications/registrations in various countries but invest the costs in defending his basic application/registration in his home country, with which he is probably more familiar. In another sense however, the dependency on the outcome and subsistence of the basic application/registration makes the multi-national trademark portfolio of the owner much more vulnerable. It is for this reason that some trademark owners have not used the Madrid Protocol at all, or have not used it for important marks, or for protection in important markets.

In the face of a total collapse or partial limitation in rights due to limitation, rejection, opposition, lapse, revocation, cancellation or invalidation of the basic application/registration, the trademark owner may request for “transformation” of the international registration into national applications/registrations in some or all of the designated countries/territories. Such transformed applications/registrations shall be treated as if they were filed on the filing date of the international registration but may be subject to reexamination by the respective Trade Marks Office depending on how far examination of the international registration had progressed before the date of transformation and/or implementing legislation in the designated country/territory with regards to transformation. Official transformation fees will be payable, and a foreign agent will likely have to be appointed to represent the owner in each country/territory where transformation is requested. The expected convenience and cost-savings of using the Madrid system may be lessened or lost in such event.

After the expiry of the first five years, the international registration will become independent of the basic application/registration, provided there is no pending decision regarding a rejection or a request for cancellation etc of the application/registration where the action commenced before the expiry of the five-year period.

## **Subsequent Designation**

### ***Article 3ter of the Madrid Protocol***

It is possible for a trademark owner to initiate a Madrid Application designating only some of the countries/territories that are members of the Madrid Protocol, and subsequently designate others when he decides that protection of the mark should be extended to other territories, perhaps due to initial budget constraints or due to subsequent market expansion. Alternatively, as more countries become members of the Protocol, a trademark owner can request for extension of protection to some or all of the new member countries. A request for "Subsequent Designation" may be filed through the Office of Origin or directly with the IB (unless the Office of Origin has prescribed otherwise). It will be effective in the territories subsequently designated from the date of such subsequent designation but will otherwise have the same validity as the international registration it is attached to. The subsequent designations will be subject to examination in the newly designated countries/territories with the possibility of [Notices of Refusals](#) being issued as described earlier.

The fee payable to IB for a Request for Subsequent Designation is lower than the Basic Fee payable for a new Madrid Application (CHF300 instead of CHF653), but the complementary or individual fees for each designated jurisdiction will be the same whether it was designated initially or subsequently. As the extension of protection to the additional countries/territories will expire with the international registration it is attached to, the owner is in effect paying the same complementary/individual fees for shorter term of protection.

## **Post-Registration Matters**

### **1. Renewal**

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Another perceived "convenience" of an international registration is that it has one effective registration date, is valid for ten years therefrom and is renewed as a single registration. The trademark owner files a single renewal with IB before expiry (or within 6-months grace following expiry) which renewal is effective for all the designations. A Basic Fee of CHF653 (plus supplementary fee of CHF73 if more than three classes are covered) is payable, as well as complementary and individual fees. The individual fees payable for renewal is often the same in quantum as compared to the fees for designating this jurisdiction in a Madrid Application, but it can sometimes be lower (e.g. Australia and Singapore) and sometimes, rather substantially higher (e.g. Benelux, PRC and Japan).

However, it should be noted that maintenance of protection can involve more than renewal alone. For instance, a US registration must still be maintained by filing Declarations of Use before the 6<sup>th</sup> and 10<sup>th</sup> anniversaries (sections 8 and 15 of the Lanham Act). If protection was secured in the US without the assistance of a US trademark agent, there will be no US agent watching out for these deadlines for them.

## **2. Changes in Proprietor's Name or Address**

(back to [What the Madrid System Is Meant to Be](#))

Any changes in the name or address of the trademark owner need only be notified to the IB which will in turn notify the office of each jurisdiction covered by an international registration. The owner does not have to arrange for such changes to be recorded individually by each Designated Office. The official fee payable to IB to update such changes is currently only CHF150 per change.

## **3. Changes in Ownership**

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International registrations are assignable in whole or in part (by way of different owners for different countries, or by division of goods/services) but there are restrictions on the transferee. The new owner must be incorporated in, a citizen of, be domiciled in, or have "a real and effective industrial or commercial establishment in" (i.e. possess the requisite "Connecting Nexus") a Contracting Party at the time of the application to record the change in ownership. Otherwise, the IB will not record the change in ownership.

This limitation on the transferability of international registrations potentially has significant impact of the value of a trademark and can create innumerable complications in structuring transfers in the future. It is therefore important that trademark owners appreciate this.

It is also possible for the international registration to be assigned apart from the basic application/registration. However, this will probably be a very dangerous proposition during the five-year dependency period as the assignor will continue to be able to make decisions (including abandonment of the basic application/registration), which may jeopardize the international registration.

## **Conclusion**

It is hoped that the preceding discussion helps to bring to mind main features of the Madrid Protocol that one will wish to consider when assessing whether the Madrid system will be suitable for a particular trademark portfolio. We bear in mind that the system itself evolves in time and any description of it must be constantly updated. For example, before the USA became a member, or when protection in European countries could only be by way of individual country designations rather than designation of the European Community, the Madrid Protocol may have been considered unsuitable. Such a view should now be re-evaluated. More countries may join, fees may be increased or reduced, actual practice and experience in each country may change, even the Common Regulations and Administrative Instructions may be amended. Whatever conclusion one draws, it should be re-assessed in time to come.

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## **Brief Summary of the Differences between the Madrid Agreement and the Madrid Protocol**

(back to [Introduction](#))

The Madrid Agreement Concerning the International Registration of Marks (“the Agreement”) is the first of two treaties that make up what we refer to as the “Madrid System”. It was signed in 1891 with the intention to develop a system that enables international protection of trademarks in its member countries. The system is administered by the World Intellectual Property Organisation (WIPO).

In the 1980s, WIPO undertook the task of developing modifications to entice non-member countries to join the Madrid system. The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“the Protocol”) was adopted on 27 June 1989 and became operational on 1 April 1996. The Protocol introduced important changes that addressed the perceived defects in the Agreement. A summary of the differences between the Madrid Agreement and the Madrid Protocol follows:

### Madrid Agreement

#### 1. *Basic Registration*

The International registration must be based on a trademark registration in the Country of Origin. This was an obstacle for trademark owners where the examination and/or opposition process of their home country was lengthy.

#### 2. *Official Language*

French was the only official language.

#### 3. *Complementary Fees*

The fee payable for each designated country was fixed and this was often considered insufficient to cover the designated office’s costs for examination and other proceedings.

### Madrid Protocol

#### *Basic Application or Registration*

The Protocol allowed the international registration to be based on a trademark registration or pending application in the Country of Origin.

#### *Official Language*

English, along with French, became official languages of the Protocol, subject to what may be prescribed by the Office of Origin.

*[Spanish was added as an official language with effect from 1 April 2004.]*

#### *Complementary or Individual Fees*

The Protocol provides for a contracting party to make a declaration that it wants to receive an individual fee instead of a share in the revenue produced by the supplementary and complementary fees. Many contracting parties have since made the declarations

and do, from time to time, revise the amounts it wishes to receive.

4. *Period for Issue of Refusal*

Each designated office had 12 months in which to complete its examination and to notify the International Bureau of any refusal, objection or opposition against protection of the mark in that country.

*Extended Period for Issue of Refusal*

The Protocol allows a contracting party to make a declaration to extend the 12-month examination period to 18 months. It also provides for declaration to be made that a designated office may issue notification of refusal based on an opposition after the 18-month time limit.

5. *Dependency*

The International registration depends on the basic registration during the first five years of the international registration. If the basic registration is cancelled or in any way limited in effect during this period, the international registration will likewise be affected (known as "Central Attack").

*Dependency and Transformation*

The risk of central attack is mitigated by the introduction of the possibility of "transformation" - in the face of total collapse or partial limitation in rights due to cancellation or limitation of the basic application or registration, the trademark owner may, within three months of the cancellation or limitation, request transformation of the international registration into national applications or registrations in some or all of the designated countries. The filing date of the international registration will be maintained.

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## **Where are Trademark Owner has “Connecting Nexus” in more than one Member Country**

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Where the trademark owner is a national or is domiciled in one Contracting Party but also has “a real and effective industrial or commercial establishment” in another Contracting Party, he may decide that an application/registration in the latter serves better as the basic application/registration for his Madrid application. For example, a Japanese company with a manufacturing plant in Singapore may arrange for a national application to be filed in Singapore followed by a Madrid application to be filed through the Singapore Trade Marks Office. This could be because of lower agency costs and/or administrative costs here, or because the Singapore office is responsible for protection of the trademarks in say South Asia, Europe and the USA. Alternatively, a US company with an establishment in the UK may wish to file a Madrid application through the UK Trade Mark Office on the basis of a UK application/registration as it covers a wider range of goods/services than its US counterpart.

Selecting a certain Country of Origin does not necessarily mean that the Protocol Application must be filed in the name of a trademark owner’s “establishment” in the other country. If the “establishment” in that country is not the same legal entity as the trademark owner, but say a fully owned subsidiary, it may still be possible that the Madrid Application is filed in the name of the parent company (national or domiciled in one Protocol member country), citing the entitlement to file in the second member country by virtue of its “establishment” in the second country. Whether the “establishment” constitutes “a real and effective industrial or commercial establishment” in the second country is a matter of national law in the second country.

Where more than one country is available, which of them will serve as the preferred Country of Origin of a Madrid Application will require more intimate knowledge of the laws and practice of the countries. For present purposes, I seek only to highlight some points to ponder:

- 1) whether the “establishment” in the other country constitutes “a real and effective industrial or commercial establishment” in that country,
- 2) relative costs of representation and administration of the Madrid application in the other country,
- 3) scope of protection granted or likely to be accorded by the basic application/registration as this will affect the scope of protection in all the countries designated,
- 4) vulnerability of the basic application/registration to attack by third parties as this will also affect the Madrid registration issued based on it.

## Would Selecting the European Community as a Single Designation be Advisable?

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The current Member States of the European Community (“EC”) are:

Austria, Belgium, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Poland, Portugal, Slovakia, Slovenia, Spain, Sweden, the Netherlands and the United Kingdom

Designating “EC” in an international registration is meant to be like filing a Community Trade Mark “CTM” application with the Office for Harmonization in the Internal Market (“OHIM”) and will, unless protection is refused, issue as a CTM registration, enforceable in all Member States of the European Community. The “Individual Fee” payable for designation of “EC” is currently CHF2229 for the first 3 classes and CHF461 per additional class beyond three (fees were reduced as from 8 February 2006). Should protection be refused by OHIM, there is provision for partial refund of the fees equivalent to the registration fee that would have been payable for a CTM application filed directly with OHIM at that time.

If a trademark owner does not require protection of his mark throughout the European Union, but only in some of the countries, he has the option of designating such individual countries in an international registration. The fees payable will depend on the particular countries selected. For purposes of comparison, the table below summarizes the fees payable for one mark in 3 classes (the fee for a “EC” designation covers up to 3 classes):

Austria, Cyprus, the Czech Republic, France, Germany, Hungary, Latvia, Lithuania, Poland, Portugal, Slovakia, Slovenia, Spain	CHF	73 per country*
Benelux (i.e. Belgium, Luxembourg, Netherlands)	CHF	245*
Denmark	CHF	487*
Estonia	CHF	350
Finland	CHF	236*
Greece	CHF	277
Ireland	CHF	584
Italy	CHF	237
Sweden	CHF	485
United Kingdom	CHF	600

\* - same fee payable for fewer than 3 classes

*Malta is not a member of the Madrid Protocol*

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As far as fees are concerned, it is possible that designating certain individual countries separately (say France, Germany, Italy, Spain and the United Kingdom) will be less costly than designating EC as a whole. However, fees will not be the only factor to be considered.

The following seeks to briefly identify some *other* factors to consider in deciding whether to designate individual European countries, or to select the European Community as a single designation under the Madrid Protocol:

**Designating Individual European Countries:**

**Single Designation of EC:**

- |  |   |
|--|---|
| X Examination in each country possibly on absolute and/or relative grounds   | √ Examination by one office (OHIM), on absolute grounds only                            |
| X Local agents' services in each state that issues a refusal which may lead cost to escalate                           | √ Single local agent can address refusal issued by OHIM                                 |
| √ Opposition less likely, or can select countries where conflict unlikely  | X Opposition more likely as monopoly throughout EU is being claimed                     |
| X Opposition process in individual country, multiple representatives   | √ Single opposition procedure, single representative before OHIM                        |
| √/X Negotiations for settlement in each country (unless consolidated by parties)                                       | √ Parties may be more keen to achieve Pan-European settlement                           |
| X Enforcement action in each country   | √ Enforceable throughout EU   |
| X Protection in additional EU Member States must be by subsequent designations or filing new international application | √ Protection may be extended to additional EU Member States by virtue of EU Enlargement |

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## **Seniority of Earlier Rights in a Member State of the European Union**

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Under the Community Trade Mark system, the proprietor of a trade mark who already owns a national registration in a member state of the European Union may, when applying for registration of the same mark with the Office for Harmonization in the Internal Market (“OHIM”) for goods/services covered by the earlier national registration, claim the seniority arising from that earlier national registration. When the European Community acceded to the Madrid Protocol, the Common Regulations of the Protocol were also amended to allow for seniority claim when the European Community is designated in an international registration.

A seniority claim is to be effected by filing official form (MM17) directly with OHIM, with documentary proof, identifying the following:

1. each member state in or for which the earlier mark is registered,
2. the date from which the relevant registration is effective,
3. the number of the relevant registration, and
4. the goods and/or services for which the earlier mark is registered.

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## **Basic Fees Payable for International Applications Originating from Least Developed Countries**

(back to [Basic Fee Payable to IB](#))

A basic fee is payable to the International Bureau for each international registration, irrespective of which or the number of the countries designated. This currently amounts to 653 Swiss francs for a black and white mark and 903 for a colour mark.

By virtue of an amendment to the Schedule of Fees annexed to the Common Regulations under the Madrid Protocol, for international applications filed by applicants whose Country of Origin is a Least Developed Country (“LDC”) in accordance with the list established by the United Nations, the basic fee is reduced to 10% of the above-mentioned amounts (rounded to the nearest full figure). As such, for applicants having a real and effective industrial or commercial establishment, or a domicile, in a LDC, or being a national of an LDC, and who utilize the trademark office of such LDC as the office of origin when filing the international application, the basic fee currently payable is 65 Swiss francs for a black and white mark and 90 Swiss francs for a colour mark.

Presently, the list of LDCs comprises 50 States of which seven are party to the Madrid system (i.e. the Madrid Agreement and/or Protocol). Bhutan, Lesotho, Mozambique, Sierra Leone and Zambia are party to the Madrid Protocol.

The list of LDCs is maintained by the United Nations and can be consulted at [www.un.org](http://www.un.org).

**A Contracting Party May Make Declaration for Notice of Refusal to be Issued within 18 Months.**

(back to [Right of Refusal](#))

MEMBER	REFUSAL WITHIN 12 MONTHS	REFUSAL WITHIN 18 MONTHS*
Albania	v	
Antigua and Barbuda	v	
Armenia		v
Australia		v *
Austria	v	
Bahrain	v	
Belarus		v
Benelux (i.e. Belgium, Luxembourg and the Netherlands)	v	
Bhutan	v	
Bulgaria		v
China		v *
Croatia	v	
Cuba	v	
Cyprus		v *
Czech Republic	v	
Democratic People's Republic of Korea	v	
Denmark		v *
Estonia		v *
European Community		v
Finland		v *
France	v	
Georgia		v
Germany	v	
Greece		v *
Hungary	v	
Iceland		v
Iran (Islamic Republic of)		v *
Ireland		v *
Italy		v *
Japan		v
Kenya		v *

Kyrgyzstan	v	
Latvia	v	
Lesotho	v	
Liechtenstein	v	
Lithuania		v *
Monaco	v	
Mongolia	v	
Morocco	v	
Mozambique	v	
Namibia	v	
Netherlands Antilles	v	
Norway		v *
Poland		v
Portugal	v	
Republic of Korea		v *
Republic of Macedonia	v	
Republic of Moldova	v	
Romania	v	
Russian Federation	v	
Serbia and Montenegro	v	
Sierra Leone	v	
Singapore		v *
Slovakia		v
Slovenia	v	
Spain	v	
Swaziland	v	
Sweden		v *
Switzerland		v
Syrian Arab Republic	v	
Turkey		v
Turkmenistan		v
Ukraine		v *
United Kingdom		v *
United States of America		v*
Zambia	v	

\* It is possible that the Designated Office issues a notification of refusal of protection based on an opposition after the expiry of the 18-month time limit (pre-conditions apply).

Note: This information is collated from publications of WIPO and checked as at February 2006. This has been prepared for convenience only, without guarantee as to exhaustiveness or accuracy.

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**SUMMARY TABLE OF COMPLEMENTARY FEES (CF) OR INDIVIDUAL FEES (IF) PAYABLE WHEN FILING A MADRID PROTOCOL APPLICATION**

*(all fees quoted in Swiss Francs)*

(back to [Introduction](#))

(back to [Members of the Madrid Protocol](#) )

(back [Complementary Fees or Individual Fees](#))

	Country/IGO:	CF (73):	IF:
1.	Albania (CF)		
2.	Antigua and Barbuda (CF)		
3.	Armenia (IF: 221 (1 class) + 22 per additional class)		
4.	Australia (IF: 436 per class)		
5.	Austria (CF)		
6.	Bahrain (CF)		
7.	Belarus (IF: 600 (3 classes) + 50 per additional class)		
8.	Benelux i.e. Belgium, Luxembourg and the Netherlands <sup>1</sup> (IF: 245 (3 classes) + 25 per additional class)		
9.	Bhutan (CF)		
10.	Bulgaria (IF: 251 (1 class) + 15 per additional class)		
11.	China (IF: 310 (1 class) + 155 per additional class)		
12.	Croatia (CF)		
13.	Cuba (IF: 283 (3 classes) + 113 per additional class) <sup>2</sup>		
14.	Cyprus (CF)		
15.	Czech Republic (CF)		
16.	Democratic People's Republic of Korea (CF)		
17.	Denmark (IF: 487 (3 classes) + 124 per additional class)		
18.	Estonia (IF: 214 (1 class) + 68 per additional class)		
19.	European Community (IF: 2229 (3 classes)+ 461 per additional class)		
20.	Finland (IF: 236 (3 classes) + 88 per additional class)		
21.	France (CF)		
22.	Georgia (IF: 281 (1 class) + 105 per additional class)		
23.	Germany (CF)		
24.	Greece (IF: 185 (1 class) + 46 per additional class)		
25.	Hungary (CF)		
26.	Iceland (IF: 271 (1 class) + 54 per additional class)		

<sup>1</sup> Protection may not be requested separately for Belgium, Luxembourg or the Netherlands, but only for all three countries as a whole (Benelux), subject to payment of one designation fee. This will cover the Kingdom of Netherlands but not the Netherlands Antilles.

<sup>2</sup> The fees are payable in 2 parts i.e. the first part (283 for the first 3 classes and 113 for each additional class) is paid upon designation and a second part of 158 (irrespective of number of classes) is payable only if the Office of Cuba is satisfied that the mark qualifies for protection.

27.	Iran (CF)		
28.	Ireland (IF: 372 (1 class) + 106 per additional class)		
29.	Italy (IF: 141 (1 class) + 48 per additional class)		
30.	Japan (IF: 226 (1 class) + 171 per additional class) <sup>3</sup>		
31.	Kenya (CF)		
32.	Kyrgyzstan (IF: 340 (1 class) + 160 per additional class)		
33.	Latvia (CF)		
34.	Lesotho (CF)		
35.	Liechtenstein (CF)		
36.	Lithuania (CF)		
37.	Monaco (CF)		
38.	Mongolia (CF)		
39.	Morocco (CF)		
40.	Mozambique (CF)		
41.	Namibia (CF)		
42.	Netherlands Antilles (IF: 283 (3 classes) + 29 per additional class)		
43.	Norway (IF: 430 (3 classes) + 121 per additional class)		
44.	Poland (CF)		
45.	Portugal (CF)		
46.	Republic of Korea (IF : 297 per class)		
47.	Republic Of Macedonia (CF)		
48.	Republic Of Moldova (IF: 339 (1 class) + 28 per additional class)		
49.	Romania (CF)		
50.	Russian Federation (CF)		
51.	Serbia and Montenegro (CF)		
52.	Sierra Leone (CF)		
53.	Singapore (IF: 200 per class)		
54.	Slovakia (CF)		
55.	Slovenia (CF)		
56.	Spain (CF)		
57.	Swaziland (CF)		
58.	Sweden (IF: 243 (1 class) + 121 per additional class)		
59.	Switzerland (IF: 600 (2 classes) + 50 per additional class)		
60.	Syrian Arab Republic (CF)		
61.	Turkey (IF: 491 (1 class) + 96 per additional class)		
62.	Turkmenistan (IF: 236 (1 class) + 118 per additional class)		
63.	Ukraine (IF:590 (3 classes) + 118 per additional class)		
64.	United Kingdom <sup>4</sup> (IF: 386 (1 class) + 107 per additional class)		

<sup>3</sup> The fees are payable in 2 parts i.e. the first part (226 for the first class and 171 for each additional class) is paid upon designation of Japan, and the second part of 754 per class is payable only if JPO is satisfied that the mark qualifies for protection and only for the accepted class(es).

<sup>4</sup> An international mark protected in the UK renders protection in some other places automatically (e.g. Jersey), or by way of re-registration.(e.g. Cayman Islands).

65.	United States of America (IF: 367 per class)		
66.	Zambia (CF)		
Total complementary fees payable:		(A)	
Total individual fees payable:			(B)
Total fees payable for all the countries designated i.e. (A) + (B) :			

Note:

*This information is collated from publications of WIPO and checked as at February 2006. This has been prepared for convenience only, without guarantee as to exhaustiveness or accuracy. The information should be double-checked and updated constantly.*