

**PROTECTING
YOUR TRADEMARK
ABROAD:**
**TWENTY
QUESTIONS
ABOUT
THE MADRID
PROTOCOL**



WORLD
INTELLECTUAL
PROPERTY
ORGANIZATION

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WORLD
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**COUNTRIES PARTY
TO THE MADRID
PROTOCOL**

as at July 19, 2001

Antigua and Barbuda	Liechtenstein
Armenia	Lithuania
Australia	Luxembourg*
Austria	Monaco
Belgium*	Mongolia
Bhutan	Morocco
Bulgaria	Mozambique
China	Netherlands*
Cuba	Norway
Czech Republic	Poland
Democratic People's Republic of Korea	Portugal
Denmark	Republic of Moldova
Estonia	Romania
Finland	Russian Federation
France	Sierra Leone
Georgia	Singapore
Germany	Slovakia
Greece	Slovenia
Hungary	Spain
Iceland	Swaziland
Ireland	Sweden
Italy	Switzerland
Japan	Turkey
Kenya	Turkmenistan
Latvia	Ukraine
Lesotho	United Kingdom
	Yugoslavia

* 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 a single designation fee.

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INTRODUCTION

Protecting Your Trademark Abroad: Twenty Questions About The Madrid Protocol

The Madrid Protocol, along with another international treaty called the Madrid Agreement, governs the so-called Madrid system for the international registration of trademarks. The system is administered by the International Bureau of the World Intellectual Property Organization (WIPO), which maintains the International Register of marks.

Although the basic principles of the Agreement and the Protocol are the same, they differ in a number of respects, such as the fees and the time limits within which the Office of a designated country can issue a refusal of protection of the mark. The rules governing communications with the International Bureau also vary. This pamphlet deals only with the Protocol.

A country may become a party to either the Protocol or the Agreement or both. Furthermore, an intergovernmental organization that has a regional Office for the purposes of registering marks with effect in the territory of the organization (such as the European Community) may accede to the Protocol (but not to the Agreement). To date however, no such intergovernmental organization has acceded to the Protocol; this pamphlet therefore simply refers to “countries”.

1.

DO YOU WANT
TO PROTECT
YOUR TRADEMARK
IN SEVERAL
COUNTRIES?

You would like to have your trademark protected in several countries, but you realize that filing a separate application in each country is complicated and expensive. You may then want to file an application for international registration under the Madrid Protocol.

2.

WHAT IS
THE MADRID
PROTOCOL?

It is a treaty that provides for the international registration of trademarks (including service marks). By filing a single application (called “international application”) in one language, you obtain a single registration (called “international registration”) which secures protection for your mark in several countries.

3.

WHO IS
ENTITLED TO FILE
AN INTERNATIONAL
APPLICATION?

An international application under the Madrid Protocol may be filed by any person who has a real and effective industrial or commercial establishment or a domicile in, or who is a national of, one of the countries party to the Protocol.

4.

IS THERE ANY
PRECONDITION
TO FILING AN
INTERNATIONAL
APPLICATION?

Before a mark can be the subject of an international application, it must already have been registered, or registration must have been applied for, for the same goods or services with the trademark registration office of a country in respect of which one of the requirements mentioned in point 3 is fulfilled. This office is referred to as the Office of origin.

5.

IS THERE A LINK BETWEEN THE INTERNATIONAL REGISTRATION AND THE APPLICATION OR REGISTRATION WITH THE OFFICE OF ORIGIN?

For the first five years, the international registration is dependent on the application or registration with the Office of origin (the “basic application” or “basic registration”); see point 17, below. After the end of the five-year period, the international registration becomes independent of the basic application or basic registration.

6.

WHERE CAN PROTECTION BE OBTAINED?

Protection of the mark can be obtained in any country (other than that of the Office of origin) which is also a party to the Madrid Protocol (the list of countries party to the Protocol is given on the insert to this brochure). The countries where protection is sought must be listed in the international application. Further countries may be designated subsequently (see point 19, below).

7.

CAN PRIORITY OF AN EARLIER APPLICATION BE CLAIMED?

Yes, priority of a first national or regional application can be claimed in an international application within six months of the filing of that first application.

8.

IN WHAT LANGUAGE IS AN INTERNATIONAL APPLICATION TO BE FILED?

An international application may be filed in either English or French. (The Office of origin may however restrict the applicant’s choice to only one of these languages.)

9.

WHERE SHOULD
AN INTERNATIONAL
APPLICATION
BE FILED?

An international application must be filed with the Office of origin. The Office certifies that the mark in the international application is the same as in the basic application or registration, that the applicant is the same person as the owner of the basic application or registration and that the goods and services listed in the international application are covered by those listed in the basic application or registration. The Office of origin then forwards the international application to the International Bureau of WIPO.

10.

WHAT IS THE COST
OF OBTAINING
AN INTERNATIONAL
REGISTRATION?

The following fees are payable for the filing of an international application:

- a **basic fee** of 653 Swiss francs (or 903 Swiss francs where the mark is in color);
- either a **standard designation fee** of 73 Swiss francs or an **individual designation** fee whose amount is fixed by the country concerned (but may not be higher than the amount that would be payable for registering the mark directly with the office of the country concerned) for each designated country;
- a **supplementary fee** of 73 Swiss francs for each class of goods and services beyond the third (however, no supplementary fee is payable where all the countries designated are ones in respect of which an individual fee is payable).

11.

HOW ARE
THE FEES
TO BE PAID?

In addition, the Office of origin may charge a handling fee for forwarding the international application to the International Bureau.

The fees shown in bold characters in point 10 are to be paid in Swiss francs. They are to be paid direct to the International Bureau although, in some cases, the Office of origin may be prepared to collect and forward them.

12.

WHAT IS
THE ROLE OF THE
INTERNATIONAL
BUREAU AT
THIS STAGE?

The International Bureau checks that all the filing requirements are met and that the goods and services are correctly classified. If so, the mark is recorded in the International Register. The International Bureau then notifies the international registration to the Offices of the designated countries.

The International Bureau does not examine whether the mark as such qualifies for protection, or whether an identical or similar mark has already been registered; that is a matter for the Offices of the designated countries.

13.

WHAT IS
THE EFFECTIVE DATE OF
AN INTERNATIONAL
REGISTRATION?

An international registration bears the date on which the international application was filed with the Office of origin, provided that it reaches the International Bureau within two months and that no essential elements (such as a reproduction of the mark, or the list of goods and services) are missing.

14.

WHAT ARE
THE EFFECTS OF
AN INTERNATIONAL
REGISTRATION?

From the date of the international registration, the protection of the mark in each of the designated countries is the same as if the mark had been the subject of an application filed direct with the Office of that country. If no refusal (see point 15, below) is notified within the prescribed time limit, the protection of the mark in each designated country is the same as if the mark had been registered by the Office of that country.

15.

CAN PROTECTION
FOR A MARK
BE REFUSED
IN A DESIGNATED
COUNTRY?

The Office of a designated country has the right to refuse protection of a mark in the territory of that country. Refusal may be made on any of the grounds on which an application for registration filed direct with that Office might be refused. Refusal is notified to the International Bureau and recorded in the International Register.

In principle, any refusal must be issued no later than 12 months from the date on which the Office concerned was notified of the designation. However, where a country has made a declaration to that effect, the time limit is extended to 18 months. Such a country may also declare that a refusal based on an opposition may be issued after the expiry of the 18-month time limit, provided however that the Office concerned has, within the 18-month period, notified the International Bureau of this possibility.

At the end of the applicable time limit therefore, the holder of an international registration is in a position to know whether his mark has been accepted for protection in each of the designated countries, or whether protection has been refused in one country or whether there is still a possibility of refusal on the basis of an opposition in a particular country.

16.

WHAT ACTION NEEDS TO BE TAKEN IN THE EVENT OF A REFUSAL?

The holder has the same right to contest the refusal with the Office that issued it as if the mark had been deposited direct with that Office. Where the refusal relates to only some of the goods and services listed in the international registration, and the refusal is not contested, the mark stands protected for the remaining goods or services, without any action being needed on the part of the holder.

17.

WHAT ARE
THE CONSEQUENCES
OF DEPENDENCE
ON THE BASIC
APPLICATION
OR BASIC
REGISTRATION?

If, during the first five years following the date of the international registration, the basic application is refused or withdrawn, or the basic registration is canceled, the international registration must also be canceled. This is also the case if the basic registration is refused after the end of this five-year period as a result of an action begun within that period. If the refusal or withdrawal of the basic application or cancellation of the basic registration is for only some of the goods or services, the cancellation of the international registration will likewise be partial.

This effect is sometimes referred to as “central attack”. It can be mitigated by transforming the international registration into a series of national applications in the designated countries, while retaining the date of the original international registration. In 2000, nearly 23,000 international registrations were effected; during the same period, only 140 international registrations were canceled (in whole or in part) as a result of central attack.

18.

WHAT IS
THE DURATION OF AN
INTERNATIONAL
REGISTRATION?

An international registration lasts for ten years. It may be renewed for further periods of ten years, simply by paying the requisite fees to the International Bureau.

19.

CAN AN INTERNATIONAL REGISTRATION BE EXTENDED TO COUNTRIES OTHER THAN THOSE DESIGNATED IN THE INTERNATIONAL APPLICATION?

Additional countries can be designated at any time, provided they are party to the Protocol at the time of the designation. Such subsequent designations are useful where new countries accede to the Protocol or simply where the holder's interest in a country develops after the international registration has been made.

20.

CAN CHANGES AFFECTING AN INTERNATIONAL REGISTRATION BE RECORDED?

The following changes affecting an international registration can be recorded in the International Register:

- a change of name or address of the holder;
- a change in ownership of the registration (which may be total or may be for only some of the designated countries or only some of the goods or services);
- a limitation of the list of goods and services;
- a renunciation of the protection in respect of one or more of the designated countries;
- cancellation of the international registration.

All that is necessary is the filing of a simple form with the International Bureau and the payment of a fee. The change is effective for all the designated countries concerned.

**ADVANTAGES
OF THE MADRID
PROTOCOL**

Simplicity, economy and flexibility

- at the application stage:
 - a single application
 - in one language
 - filed with the trademark office of the home country
 - to obtain protection in several countries.

- at the post-registration stage:
 - guarantee on the period within which potential grounds of refusal to protect a mark can be raised by the Offices of the designated countries
 - possibility of designating other countries after registration
 - easy handling of operations:
 - a single request to record changes (transfers, changes of name or address, etc.) which may affect the registration as a whole or in part;
 - a single request for renewal.

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