

Protecting your trade mark overseas



The Madrid Protocol is a trade mark registration system that enables trade mark owners to file an international trade mark application in their own country and, in the same application, designate the overseas countries where trade mark protection is required. Registration in every country is not automatic, but the Madrid system simplifies the overall registration process and can reduce costs.

Here is our guide to protecting your trade marks overseas.

Background

If you have a strong export focus, then you will be familiar with protecting trade marks around the world.

Traditionally, you would file separate trade mark applications in each country to obtain the level of trade mark protection you needed.

You can still file separate trade mark applications in each country to obtain the level of trade mark protection you need, but the Madrid system provides an alternative registration regime that can reduce your registration costs.

Deciding whether to use the Madrid system

This will depend on your particular circumstances, including the particular countries of interest.

We will work with you to review the options and recommend the best option for you.

How to save costs using the Madrid system

Cost savings depend on whether the countries of interest to you are also members of the Madrid system.

Currently 91 countries are members of the Madrid Protocol, including Australia, China, USA, Japan, South Korea, Singapore, and members of the European Union (including the United Kingdom).

We will work with you to ensure that Madrid system is the best option for the countries where you need protection.

What you need before you can file an international application

An application for an international trade mark must be based on a home application or registration and mirror that home application or registration.

Before filing for an international trade mark, we will review your home applications and registrations to make sure that they are an adequate basis for international protection.

How to file and register an international application

The international trade mark application is filed at your local trade marks office.

After a formality review, the application is submitted by the local trade marks office to the International Bureau (IB) of the World Intellectual Property Office (WIPO).

The IB will carry out its own formality review. Once any formalities are dealt with, the international application is registered, and is forwarded to each of the national trade mark offices designated in the international application.

Each national trade mark office examines the international application based on their national trade mark laws, and can refuse to extend protection to their country in whole or in part. At this point, we may need to appoint local representatives to help you advance your local trade mark registration.

We can help you anticipate the likelihood of receiving such refusals.

Adding countries after you file an international application

More member countries can be added at any time by paying the appropriate fees. In fact, as new countries sign up to the Madrid system, an application can be made to extend an existing international registration to those countries.

As there is a basic application fee to file a new international application, and each time to add a new group of countries, the more countries that are designated at once, the cheaper an international registration becomes in relative terms.

How to renew and update the international registration and designations

Renewals and any changes affecting an international registration can be carried out centrally by filing a single request as the IB. The IB will notify the designated trade mark offices of these changes on your behalf.

Things to be aware of

If for any reason the home application or registration is removed, cancelled, or restricted in any way during the first 5 years of the international registration, then your international registration will be directly impacted.

If your international registration is removed, cancelled, or restricted in any way, then you can file national applications claiming the original Protocol filing date. Filing national applications will however incur an extra cost.