

INTERNATIONAL TRADE MARK FACT SHEET

What is an International Trade Mark?

An International trade mark registration ("IR") is essentially a cluster of national rights centrally managed by the World Intellectual Property Office ("WIPO"), under the guise of a single registration.

An International Application can be filed only by a company, or an individual that is a national of, domiciled in, or has a real and effective industrial or commercial establishment in a member state (i.e. a signatory of the Madrid Agreement or the Madrid Protocol, or both). The UK, for example is a signatory of the Madrid Protocol which means that any UK Company, or individual can be the proprietor of such an IR and can designate any (and all) of the countries that are also signatories to the Madrid Protocol (83 countries in all). Below is a full list of the member states:

▪Albania ▪Antigua and Barbuda ▪Armenia ▪Australia ▪Austria ▪Azerbaijan ▪Bahrain ▪Belarus ▪Belgium
▪Bhutan ▪Bosnia and Herzegovina ▪Botswana ▪Bulgaria ▪China ▪Croatia ▪Cuba ▪Cyprus ▪Czech
Republic ▪Democratic Peoples' Republic of Korea ▪Denmark ▪Egypt ▪Estonia ▪European Union
(Community) ▪Finland ▪France ▪Georgia ▪Germany ▪Ghana ▪Greece ▪Hungary ▪Iceland ▪Iran ▪Ireland
▪Israel ▪Italy ▪Japan ▪Kazakhstan ▪Kenya ▪Kyrgyzstan ▪Latvia ▪Lesotho ▪Liberia ▪Liechtenstein
▪Lithuania ▪Luxembourg ▪Madagascar ▪Monaco ▪Mongolia ▪Montenegro ▪Morocco ▪Mozambique
▪Namibia ▪Netherlands ▪Norway ▪Oman ▪Poland ▪Portugal ▪Republic of Korea ▪Republic of Moldova
▪Romania ▪Russian Federation ▪San Marino ▪Sao n Tome and Principe ▪Serbia ▪Sierra Leone
▪Singapore ▪Slovakia ▪Slovenia ▪Spain ▪Sudan ▪Swaziland ▪Sweden ▪Switzerland ▪Syrian Arab
Republic ▪Republic of Macedonia ▪Turkey ▪Turkmenistan ▪Ukraine ▪United Kingdom ▪United States
of America ▪Uzbekistan ▪Viet Nam ▪Zambia

An International Application must be based upon a national application or registration obtained in the home country (namely the country where it is a national, domiciled, etc.). This is commonly referred to as the basic mark. A UK company or individual can utilise either a UK or a Community application or registration as its basic mark.

The resultant IR is wholly dependant upon the basic registration for the first five years of its life. If the basic mark is cancelled, withdrawn, or refused to any extent then the IR will likewise be cancelled, withdrawn or refused to the same extent.

Why Choose an International Trade Mark?

An IR is a very cost effective way of protecting your mark in a number of different countries.

An IR is treated as a single registration, regardless of the number of countries designated, and it is centrally managed.

What happens once an application has been filed to protect my Trade Mark?

The International Application must be filed through the office where the basic mark has been applied for, or is registered; this is commonly referred to as the Office of Origin.

The application is then examined on formalities only. For example, the goods and services are examined to determine whether they are correctly classified and that the terms used in the specification are acceptable, and not too vague for classification purposes.

Once any objections have been dealt with the application is registered and a Certificate of registration is issued.

Details of the IR are then sent to the Intellectual Property Offices of each designated state to be examined under the national law of that state. Each state has 12 months in which to either accept or reject the IR, (in some instances the member states have opted for a term of 18 months).

If no objection is notified to WIPO during the relevant term, then the IR is deemed to be protected in the designated state concerned.

The acceptance or rejection of the IR in one designated state will have no effect on the acceptance or rejection of the IR in another state.

If the IR meets with objection in a designated state it is normally necessary to instruct a local agent to deal with the matter, which will incur additional expense.

Once my Trade Mark is registered what then?

An IR remains in force for a period of 10 years, and is renewable for like periods subject to payment of renewal fees. It is essential to use the mark the subject of a registration in order to maintain its validity. Any continuous period of 5 years' non-use will leave the registration vulnerable to cancellation by third parties.

It is also possible at any time after filing the original application to file an application for subsequent designations. This means that you can, at any time, extend the IR to protect the mark in other member states, subject to acceptance by the new designated state(s).

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