

International Registration (IR) of Marks

As of April 2010

Introduction

To simplify the acquisition of international trademark protection as compared with direct foreign applications, two international agreements have been created, to which 84 countries are parties (i.e. those countries have signed at least one of the agreements):

- The Madrid Agreement Concerning the International Registration of Marks (**MA**) and
- The Madrid Protocol (**MP**)

Many agreement states have signed both agreements; some, such as the USA, have signed only the MP. Which agreement (MA, MP) is applicable to the respective registration process depends on the participating country and cannot be arbitrarily selected. Any influence is thus only possible by selecting specific countries.

The Advantage of International Registration

By way of a **uniform submission process**, international registration allows one to obtain protection in any agreement states of one's choice. Even the payment of extension fees is handled uniformly, thus simplifying formalities to a certain degree. The process is available when, after applying for a German mark or a Community mark, protection is to be extended to other countries.

Even with only two or three target countries, cost saving can be seen in comparison with direct national foreign applications, this always being determined by the particular country selected.

The advantage lies in the fact that submission formalities are handled by **one** (German) representative at **one** registration office – that is, without the need to hire foreign attorneys in the respective countries. If no objections are made and no adverse actions taken at the national offices at a later point, international trademark protection can be obtained, theoretically, without the interaction of any foreign attorneys, which can significantly reduce costs. However, this will not always be possible and is particularly dependent on the mark involved and its goods and services classification.

Requirements

The basic requirement is at least one **basis application** in the home country (Germany or the EU). The **MA** process additionally requires that this mark be already registered, that is, at the time of international registration there must exist a basis **mark** (Mark of Origin). This can lead to problems when the priority of an initial application is called upon to obtain priority for the international registration. This must occur within six months from the date of the initial application (priority deadline).

The Process

The application for international registration must be submitted to the authority where the basis mark was registered or the application submitted. In the case of German basis marks (or applications) this will be the **German Patent and Mark Office** (DPMA) and for Community basis marks (or applications) the **Harmonization Office** in Alicante (OHIM). Within two months after submission, the office must forward the application to WIPO for registration. WIPO publishes the application and notifies the affected agreement states. By registering the mark referred to in the application, the mark obtains protection for the affected states as if the application were submitted there directly.

Within 12 (MA) or 18 (MP) additional months from registration there is a waiting period in which it is determined whether the national authorities in question will provide notice of objections to the application (denial of protection). This may affect the availability of protection for the mark itself and/or the goods and services classification (the so-called absolute grounds). However, it may also involve a conflict with prior legislation (relative grounds). If there is a denial of protection, a communicating domestic attorney must be engaged as a representative to carry forth the process there

with respect to the pertinent national authority. In the event that the grounds for denying protection cannot be successfully overcome, any protection obtained by registering is retroactively voided.

The **term of protection** is 10 years from registration and can be renewed in further 10 year periods on payment of a fee to WIPO.

The Differences and Common Features of the Two Processes at a Glance

| Criteria | MA | MP |
|--|--|---|
| Costs | Uniform national lump-sum fees | Individual, sometimes high national fees |
| Requirements | Registered basis mark | Registered basis mark or basis mark application |
| Languages <i>New rule as of 1.9.2008</i> | French, Spanish or English, <i>unless the national authority in question limits the acceptable language to one or two of these.</i> | |
| Deadline for Processing at the National Authorities | 12 Months | 18 Months |
| Usage Rights | According to national law in each of the countries in question | |
| Dependence on the Basis Mark (application) i.e. loss of the IR mark if the basis mark fails | 5 Years | |
| Convertibility of the IR mark to national marks <i>upon loss of the basis mark within the 5 year dependency period</i> | no | yes |

Cost Examples

Costs (Authority fees including attorney costs) for registering one mark involving **three goods and services classifications** for **five** sample countries implementing

| | |
|---|-----------------|
| lump-sum fees under the MA (Austria, Spain, France, Czech Republic, Italy) | approx. 2,400 € |
| individual fees under the MP (USA, Japan, Switzerland, China, EU) | approx. 5,500 € |

direct national applications, by comparison >approx.10,000 €

The two examples cover the lower (MA) and upper (MP) limit, i.e. for five applications under the MP, the five most expensive countries were selected. This includes, however, only the minimum costs incurred upon **submitting the application**. **Further costs** will be incurred with respect to more than three classes and, particularly, in national procedures where there has been a denial of protection (official objections or opposition) requiring the assistance of a foreign communicating attorney. This particularly affects marks whose **protectability is uncertain**, as well as those that have a **high risk of being opposed**, e.g. when similar, older marks are registered for the same market segment. But also marks containing uncommon or unclear terms in the goods and services classification may be affected.