

HOW TO REGISTER AN INTERNATIONAL TRADE MARK

What rights does an International trade mark registration give you?

An International trade mark registration can cover some or all member states of the Madrid Protocol*. An International trade mark registration is renewable every ten years.

An International trade mark registration has to be based on a 'home' trade mark application or registration in a member state or territory of the Madrid Protocol.

An International trade mark registration gives you the exclusive right to use the trade mark in the member states covered by the International Registration. A trade mark registration can stop another trader using a mark which is either identical or similar to the registered trade mark in relation to goods or services which are identical or similar to the registered goods and services. In certain circumstances, a trade mark registration can stop the use of an identical or similar mark on wholly dissimilar goods.

An International Registration will be cancelled if the 'home' registration is cancelled in the five years following the date of grant of the International Registration. This is termed a 'central attack'.

Advantages of International registration system:

- Costs tend to be lower than corresponding national applications;
- One trade mark registration covers multiple countries;
- International registrations can be extended to cover new countries.

Disadvantages of International registration system:

- Registration is dependent on 'home' application of registration for five years.

Member states of the Madrid Protocol (effective 2th January 2018):

Albania	Egypt	Macedonia	South Korea
Algeria	Equatorial Guinea*	Mali*	Spain
Antigua & Barbuda	Estonia	Mauritania*	Sudan
Armenia	European Union	Monaco	Swaziland
Australia	Finland	Mongolia	Sweden
Austria	France	Montenegro	Switzerland
Azerbaijan	Gabon*	Morocco	Syria
Bahrain	Gambia	Mozambique	Thailand
Belarus	Georgia	Namibia	Togo*
Benelux	Germany	Madagascar	Tunisia
Benin*	Ghana	Mexico	Turkey
Bhutan	Greece	Moldova	Turkmenistan
Bosnia & Herzegovina	Guinea*	New Zealand	Ukraine

Botswana	Guinea Bassau*	Niger*	United Kingdom
Bulgaria	Hungary	North Korea	United States of America
Burkina Faso*	Iceland	Norway	Uzbekistan
Brunei Darussalam	India	Oman	Vietnam
Cambodia	Indonesia	Philippines	Zambia
Cameroon*	Iran	Poland	Zimbabwe
Central African Rep.*	Ireland	Portugal	
Chad*	Israel	Romania	
China	Italy	Russian Federation	
Columbia	Japan	Rwanda	
Comoros*	Kenya	San Marino	
The Republic of Congo*	Kazakhstan	São Tomé & Príncipe	
Cote d'Ivoire*	Kyrgyzstan	Senegal*	
Croatia	Latvia	Serbia	
Cuba	Lesotho	Sierra Leone	
Cyprus	Liberia	Singapore	
Czech Republic	Liechtenstein	Slovakia	
Denmark	Lithuania	Slovenia	

*Members of The Organisation Africaine de la Propriété Intellectuelle (OAPI)

What information do we require to file an International trade mark application?

- Full name and address of applicant;
- Country and state, if appropriate, of incorporation of the applicant;
- Details of the trade mark to be registered;
- If the trade mark consists of a logo, a good representation of the logo, preferably by e-mail in jpeg format;
- Details of the goods and services to be sold under the trade mark;
- Details of any foreign trade mark application on which priority is to be claimed (if appropriate).

How long does it take to register an International trade mark?

- An International trade mark application is usually 'registered' around three months after filing, following a formalities examination by the World Intellectual Property Office (WIPO).
- However, the Intellectual Property Offices of each country covered by the registration have up to 18 months to raise objections to the registration.
- If no objections are raised, the registration is confirmed, but if objections are raised then we will deal with these objections through the Intellectual Property Offices concerned.