

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 25th December 2018):

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

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

*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.