

## 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 5th March 2015):

Albania	Egypt	Lithuania	Sierra Leone
Antigua & Barbuda	Estonia	Macedonia	Singapore
Armenia	European Union	Mali*	Slovakia
Australia	Finland	Mauritania*	Slovenia
Austria	France	Monaco	South Korea
Azerbaijan	Gabon*	Mongolia	Spain
Bahrain	Georgia	Montenegro	Sudan
Belarus	Germany	Morocco	Swaziland
Benelux	Ghana	Mozambique	Sweden
Benin*	Greece	Namibia	Switzerland
Bhutan	Guinea*	Madagascar	Syria
Bosnia & Herzegovina	Guinea Bassau*	Mexico	Togo*

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

\*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.