

GUIDE TO:
INTERNATIONAL
TRADEMARK REGISTRATION

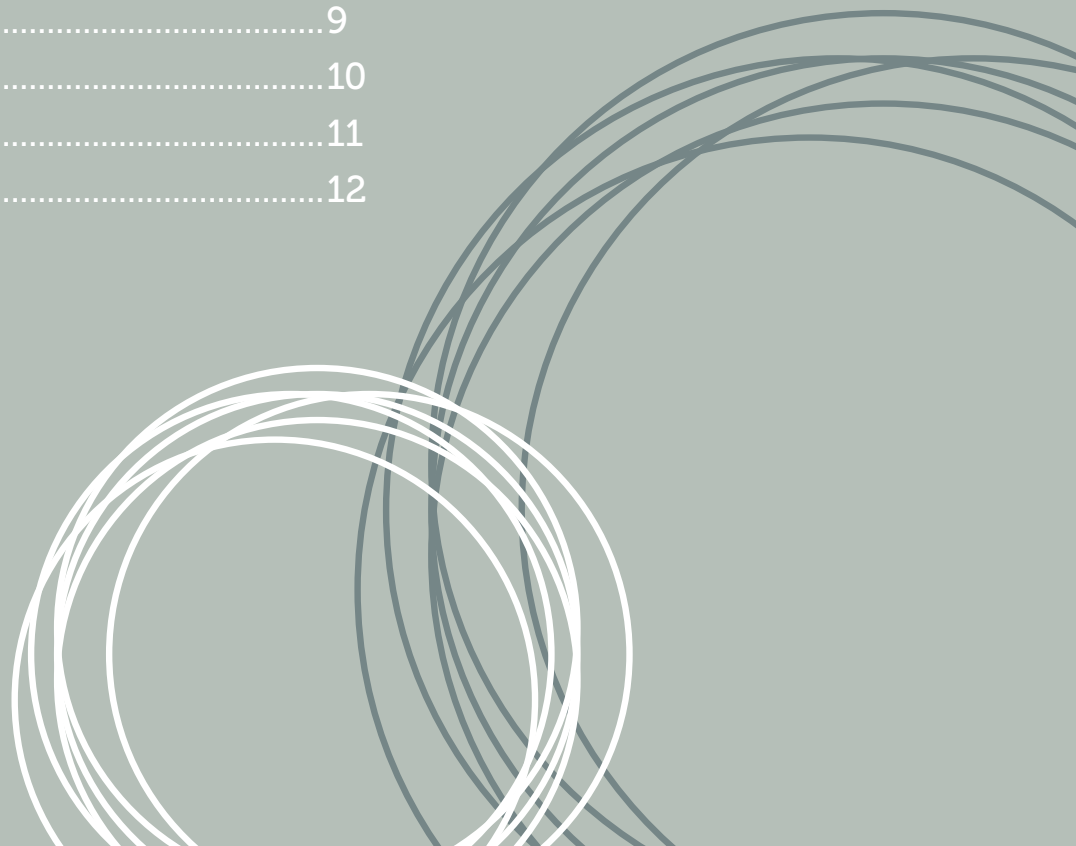


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Types of International Applications

There are two ways to secure protection of a trademark outside of Australia.

1. The filing of national applications to each country of interest. This will usually require the engagement of an appropriate agent/attorney in each particular country chosen; or
2. The filing of a single application seeking international registration through the Madrid Protocol and designating the other 'member' countries of interest. This application must be based on your national (Australian) application when filing from Australia.

The Pros & Cons

It may not always be appropriate to file under the Madrid Protocol, as it does have strict criteria to be met – including that your international application will be dependent on your Australian trademark for the first five years.

Where appropriate however, a single international application through the Madrid Protocol holds a number of benefits for trademark applicants, including:

- It is a single application, which can be filed in English when you are filing from Australia.
- Process can be much simpler, and less expensive, through the Madrid Protocol than when filing multiple applications to many different countries.

- Only one form/request needs to be filed in the future to make any changes or renew the trademark.
- One agent can represent you in the entire international application initially – with the need to appoint international agents only arising in certain circumstances.
- Additional countries can be added to your existing international registration at a later date.

One of the 'cons' however, with the filing of an international application through the Madrid Protocol, is that fees are payable up front. The vast majority of member countries will require their full fee in order to proceed. When filing national applications a number of countries will require an 'application' fee initially, and a registration fee or similar only once approved by the particular country.

The Madrid Protocol

Australia joined the Madrid Protocol in 2001 and since then it has been possible to file a single application through the treaty and simply designate the other protocol members you wish to extend your trademark registration into. Likewise, since 2001 applicants who have a national application in another protocol member country may file a single application designating Australia.

There are set criteria in place to determine whether you are eligible to file through this system, which should be carefully considered before investing the time and funds in using the system:

Who is entitled to file?

When filing from Australia and through the Australian trademarks office (known as the Office of Origin) the applicant must:

- Be an Australian national;
- Be domiciled in Australia;
- Have a real and effective industrial or commercial establishment in Australia.

NB: If the applicant's address is not in Australia they will be asked to provide the address details of their establishment in Australia

The Basic Application

When Australia's government office is acting as the Office of Origin, the international application must be based on an Australian trademark or trademarks, in the same person/s name/s.

It is very important to note that the International application and registration is dependent on this basic application for the first five years. Any cancellation or restriction that the basic Australian trademark may experience will affect the International Registration to the same degree. It is therefore strongly encouraged that Applicants conduct proper research and have appropriate searches conducted before filing via the Madrid Protocol. Where possible, it is encouraged that applicants wait until they are sure that their Australian trademark is 'safe' and at no risk of lapsing before investing in an international application through this system.

Trademark to be the same as the Basic Application

Essentially the International application will mirror the details of your basic Australian trademark application – the owner must be the same; the trademark must be identical and the goods/services must be the same or narrower in scope. It is therefore important to ensure your basic Australian application covers all goods/services required. It will not be possible to expand the goods/services in the international application from those of your Australian application.

Should you file a logo in colour or black & white?

Generally speaking, when you file a logo in Australia (comprising of images and wording) no restriction to colour will be set, unless you specifically request it or nominate particular colours as features of your trademark. Essentially, this means you are flexible to change colours in the future.

However, not all countries operate in the same way. Some countries, the USA for example, will request that you provide a colour claim for filing a colour representation of your trademark. As the international application requires your trademark to be identical to the basic application, consideration should be given prior to filing in Australia as to whether a colour or black and white representation of your trademark should be given.

In the event you file a colour version in Australia and later determine an international application is required but you do not wish to restrict the colours of your logo, we will first need to amend the copy on the Australian records to enable the filing of a black and white version in the international application.

Note regarding fees:

Please also note that the official fee for filing of a logo, under the Madrid Protocol that is in colour incurs a higher official fee than filing in black and white.



Countries Available

Following is a list of countries available for designation, when filing from Australia, through the Madrid Protocol:

Please note that new countries are constantly becoming members of the Madrid Protocol and accordingly the following list is current at the time of publication.

- Afghanistan
- African Intellectual Property Organization (OAPI)
- Albania
- Antigua and Barbuda
- Armenia
- Austria
- Azerbaijan
- Bahrain
- Belarus
- Benelux
- Bhutan
- Brazil
- Brunei Darrusalam
- Bonaire, Sint Eustatius and Saba
- Bosnia and Herzegovina
- Botswana
- Bulgaria
- Cambodia
- Canada
- China
- Columbia
- Croatia
- Cuba
- Curaçao
- Cyprus
- Czech Republic
- Denmark
- Egypt
- Estonia
- Eswatini
- European Union
- Finland
- France
- Georgia
- Germany
- Ghana
- Greece
- Hungary
- Iceland
- India
- Indonesia
- Iran (Islamic Republic of)
- Ireland
- Israel
- Italy
- Japan
- Kazakhstan
- Kenya
- Korea (Democratic People's Republic of)
- Korea (Republic of)
- Kyrgyzstan
- Latvia
- Lesotho
- Liberia
- Liechtenstein
- Lithuania
- The Republic of North Macedonia
- Madagascar
- Malawi
- Malaysia
- Mexico
- Moldova (Republic of)
- Monaco
- Mongolia
- Montenegro
- Morocco
- Mozambique
- Namibia
- New Zealand
- Norway
- Oman (Sultanate of)
- Philippines
- Poland
- Portugal
- Romania
- Russian Federation
- Rwanda
- Samoa
- San Marino
- Sao Tome and Principe
- Serbia
- Sierra Leone
- Siint Martin
- Singapore
- Slovakia
- Slovenia
- Spain
- Sudan
- Sweden
- Switzerland
- Syrian Arab Republic
- Tajikistan
- Thailand
- Tunisia
- Turkey
- Turkmenistan
- UAE
- Ukraine
- United Kingdom
- United States of America
- Uzbekistan
- Viet Nam
- Zambia
- Zimbabwe

Priority Periods

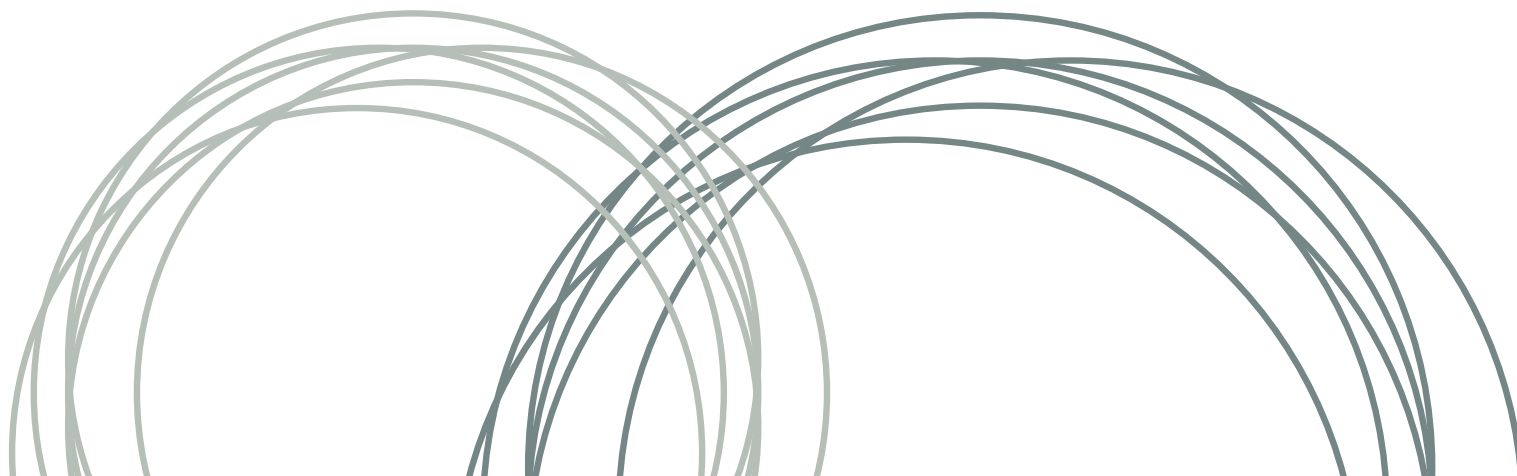
Australia is also member to the Paris Convention. This means that if you have already filed an application for the same trademark in a country member to this convention, such as Australia, it allows you to claim an earlier date of priority. This period allows strictly that for a period of 6-months following your earliest filing for a particular trademark that you may claim priority.

Therefore, if your earliest filing is in Australia, you may wait and file your international application any where up to 6 months from the Australian filing date without any jeopardy to your rights. This will allow the various countries you designate to view your application as though filed on the same date as the basic Australian trademark even if physically it is filed several months later. This therefore provides priority for your trademark over other trademarks that have been filed with a later priority date than you during those six months.

Please Note:

This is a strict 6-month time frame and cannot be extended. Any instruction to file an international application inclusive of such a priority claim should be received by our office around 4 weeks before the period expires to ensure ample time to prepare and submit your application and ensure it is receipted by the government office.

The above is not to suggest that you cannot file an international application more than 6-months after an Australian application is filed. In such instances, it simply means you will not be able to claim priority based on the Australian trademark, and, your international application will be examined as at the date it is presented and filed and no earlier.



Fees

If you wish to file national applications (i.e. a separate application to each country of interest), please contact our office for a quote. These applications include the need to appoint agents or representatives in those countries and estimates will need to be obtained.

The total cost through the Madrid Protocol will vary depending on several main factors:

- Which countries you wish to designate;
- How many classes of goods/services you wish to include;
- In the case of “logo” marks, whether it is colour or black and white.
- If you wish to register a trademark through the Madrid Protocol please contact our office for a quote and if possible include your Australian trademark number, and the countries of interest.

Fee Structure through the Madrid Protocol

When filing through Australia and based on an Australian application several official fees are factored in to come to a total cost, including:

- a) A basic filing fee;
- b) A handling fee;
- c) Fee per countries (varies)

The Country Fees

A number of available countries are paid what is known as a “complimentary” fee, which is a set fee up to three classes.

Those not covered by the above fee type are paid an ‘individual’ fee. In these cases the individual fee is not set across the board and will vary from country to country. Some that charge an individual fee will cover up to three classes for the one fee; others will charge the same fee per class and others will charge one fee for the first class, and a lower fee for each additional class.

International Trademark Application Process

Following is a flow chart of a typical international application through the Madrid Protocol when filing from Australia and based on an Australian trademark application.

Step 1

1. File International Application through Australian office after national application filed.

1.

2. If no issues found, the Australian office will then certify the application and transmit the details to the International Bureau.

2.

3. Australian office will check the international application against basic application and ensure details comply.

3.

4. International Bureau will check formalities and descriptions of goods/ services and issue notice if formalities not met.

4.

5. Once formalities are met, the International Bureau will register your international application and publish accordingly.

5.

6. The International Bureau will then send you a registration certificate- and advise the trademark application details to each chosen country.

6.

7. Each chosen country then examines your trademark details and application in accordance with their own national laws.

7.

8. Each country will then notify the International Bureau of any problems found that need to be addressed.

8.

9. If no issues are found, or they are overcome your trademark may be advertised for the purposes of third party oppositions.

9.

10. If no opposition is filed – your mark may then receive protection.

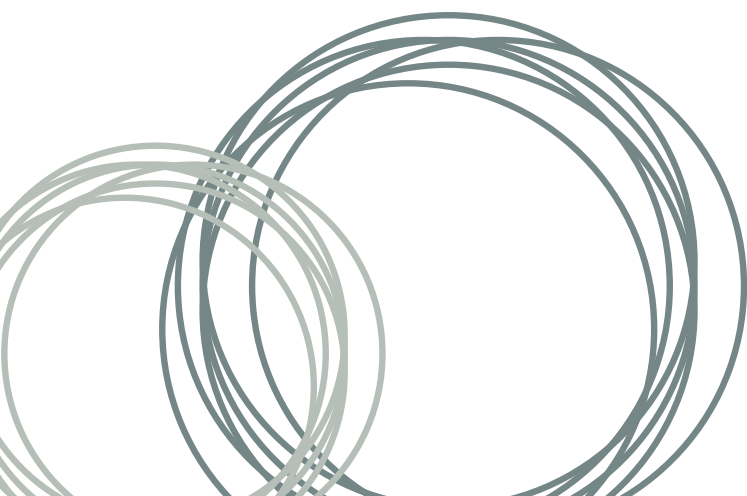
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Warning

The Australian Office and International Bureau are aware of companies sending unsolicited invoices and notifications to trademark holders. These communications will often look quite official and be requesting payment of monies to them for 'entry' of your trademark to their publications.

Please be aware that such companies and requests are not related to any official trademark office, in Australia or elsewhere and you are not required to pay them. All official communication will come from the relevant government office (usually directly from the Australian office, or the International Bureau) – or – where you have appointed an agent to act on your behalf, from their office. Following is a list of some of the known companies to be issuing these unsolicited invoices and notices:

- Globus Edition SL, Palma de Mallorca, Spain
- Company for Economic Publications Ltd, Vienna, Austria
- IT & TAG, Switzerland
- Company for Publications and Information Anstalt, Liechtenstein
- INFOCOM, Schaan, Switzerland
- International Bureau for Federated Trademark & Patent Register
- Gaia Alamanach LTD
- Commercial Centre for Industry and Trade, Switzerland
- European Institute for Economy and Commerce EIEC, Belgium
- Institute of Commerce, Trade and Commerce, Switzerland
- TM Collection, Hungary
- ZDR-Daten register GmbH, Germany
- Register of International Patents and Trademarks (RIPT)
- Edition The Marks KFT



Important Notes

Registration Period

Registration under the Madrid Protocol (and most countries if applied for individually) lasts for 10 years and renewal requirements will need to be met each 10 years to continue the protection of your trademark. If you employ our office in the initial process, we will remind you of your trademark renewal/s as they come due.

Provisional Refusals

If an international office issues a refusal during its examination of your trademark application it may become necessary to appoint an agent in the specific country to address the issues. In such instances, further fees may apply. Our office will always notify you of these charges and seek additional instruction before they apply.

Searching

You might wish to consider having professional searches conducted before filing an application outside of Australia. These searches can identify whether there are similar trademarks already registered in your countries of interest that would likely prevent your trademark from being approved. These searches should be conducted of each country's database, as well as the international database concerning other trademarks filed through the Madrid Agreement or Madrid Protocol.

Amendments to your Application

Certain changes can be made to your International Application (under the Madrid Protocol) with a single request – such as changes to the applicant's name, address or representative's details. A restriction to your goods/services may also be requested (however, note that your description of goods/services cannot be expanded). Fees may apply for certain requests on your International application or registration.

If you have filed individual applications to various countries, again changes may be made. In these cases separate requests and notifications concerning the changes would be required, and fees may apply.



More Information

As this guide demonstrates, there are a lot of aspects to trademarks, trademark law and trademark registration. If you have questions not answered in this guide – please contact our office:

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ADDITIONAL INFORMATION AVAILABLE:

- Trademark forms (Australia)
- Guide to Australian trademark registration
- Designs
- Copyright
- Licensing & royalties
- Other types of intellectual property

Disclaimer:

Please note that this publication is provided for information purposes only and is not intended to be legal advice, nor should it be substituted for such advice. Areas of law are complex, and professional advice should be sought prior to the commencement of any action related to trademarks.

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