

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:

Albania	European Union	Lithuania	Sierra Leone
Antigua & Barbuda	Finland	Macedonia	Singapore
Armenia	France	Madagascar	Slovakia
Australia	Georgia	Moldova	Slovenia
Austria	Germany	Monaco	South Korea

Belgrave Hall, Belgrave St,
Leeds, LS2 8DD, UK

Tel: +44 (0) 113 233 0100
Fax: +44 (0) 113 233 0101
Email: marketing@hgf.com

HGF also have offices in Aberdeen, Liverpool, London, Manchester, Sheffield, York and Glasgow
Harrison Goddard Foote is regulated by the Intellectual Property Regulation Board
© Harrison Goddard Foote 2011

Azerbaijan	Ghana	Mongolia	Spain
Bahrain	Greece	Montenegro	Sudan
Belarus	Hungary	Morocco	Sweden
Benelux	Iceland	Mozambique	Switzerland
Bhutan	Iran	Namibia	Syria
Bosnia & Herzegovina	Ireland	North Korea	Turkey
Botswana	Israel	Norway	Turkmenistan
Bulgaria	Italy	Oman	Ukraine
China	Japan	Poland	United Kingdom
Croatia	Kenya	Portugal	United States of America
Cuba	Kazakhstan	Romania	Uzbekistan
Cyprus	Kyrgyzstan	Russian Federation	Vietnam
Czech Republic	Latvia	San Marino	Zambia
Denmark	Lesotho	São Tomé & Príncipe	
Egypt	Liberia	Serbia	
Estonia	Liechtenstein	Swaziland	

**correct as of February 2011*

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.