



ITMA

madrid
protocol

BRIEFING PAPER

THE MADRID PROTOCOL



the Madrid Protocol

Introduction

The Madrid Protocol presents a cost-effective and efficient way in which to seek the protection of a mark beyond the United Kingdom or other home territory.

An International Registration comprises a bundle of national rights, so only a single application – via WIPO, the World Intellectual Property Organization – needs to be filed in order to renew the registration or to record a transaction or change of details against it. This results in considerable cost savings and ease of administration compared to separate national registrations.

History

The Madrid Protocol (1989) was adopted at Madrid on 27 June 1989 and came into operation in the UK on 1 April 1996. In essence it represents a method of achieving protection overseas for a mark which has already been applied for or registered in the applicant's ("Holder's") home country.

Protection gained under the Madrid Protocol is known as an International Registration. Countries or territories which have ratified the Protocol are known as Contracting Parties. The UK has ratified the Protocol.

Who administers it?

The Madrid Protocol is administered by WIPO which is based in Geneva, Switzerland.

Countries covered

An International Registration obtained under the Madrid Protocol will extend to whichever member countries/territories (Contracting Parties) you choose to designate. If any new Contracting Parties join the Protocol after you have obtained your International Registration you can apply to have your protection extended to the new Contracting Party, by way of a Subsequent Designation.

For a list of member countries of the Protocol, see www.wipo.org or the ITMA website.

Who may apply

To apply for an International Registration under the Madrid Protocol the Holder (Applicant) must be based in a Contracting Party. Therefore, a company incorporated in the UK or a British citizen should be entitled to apply for an International Registration under the Protocol. In addition the Holder must possess a home application or registration for the mark. This home application or registration must be for the identical mark and must cover the goods or services which are the subject of the International Registration. An International Registration can be based on more than one home application/registration for the same mark.

Where to apply

An application for an International Registration must be filed via the Trade Mark Registry of the Holder's home Contracting Party. Thus a UK Holder would file their application through the UK Trade Marks Registry. Once the details of the International Registration have been verified by the Registry as corresponding to the home application/registration upon which it is being based, then the Registry will forward the application to WIPO.

Alternatively, a WIPO application based on a Community trade mark application or registration must be filed through OHIM.

Fees

In addition to the fees charged by your trade mark attorney, the UK Trade Marks Registry currently charges a handling fee of £20 per International Registration. This is paid directly to the UK Registry. The cost of the International Registration itself is a basic Swiss Francs 653 (Swiss Francs 903 if the mark is applied for in colour) for up to three classes. If more than 3 classes are filed for there are additional charges. There are also additional fees for each designated Contracting Party. For

current information on fees please visit www.wipo.org. OHIM charges €300 which must be paid directly to OHIM.

Which languages can be used

The official languages of the Madrid Protocol are English, French and Spanish though if applying through a UK firm, English is the required language.

What is registrable

Any mark which is the subject of a home application or registration in a Contracting Party can form the basis of an International Registration under the Madrid Protocol. However the mark will also need to be registrable in each of the designated Contracting Parties if it is to be deemed protected in each designated Contracting Party. This latter test will depend on the national trade mark laws of the designated Contracting Party in question.

Registration procedure

After the International application has been forwarded to WIPO it accords it a registration number and date. The International application is then registered by WIPO and published in the official Gazette with the Holder being sent a certificate. WIPO also communicates details of the International Registration to each of the designated Contracting Parties (i.e. to the national Trade Marks Registry of each designated Contracting Party).

The International Registration is then examined according to the national trade mark laws and practices of the designated Contracting Party. If the designated Contracting Party does not refuse the International Registration within a certain period (either 12 or 18 months) the mark is considered protected/registered in that Contracting Party.

Under the Madrid Protocol system the onus is firmly on the designated Contracting Party to refuse protection on a timely basis.

If an objection is raised against the International Registration then the Holder will have an opportunity to contest the objection, again according to the trade mark law and practice of that Contracting Party. This will involve using a local trade mark attorney. Your UK trade mark attorney will usually have a reliable contact in the country in question.

When an International Registration becomes protected in a designated Contracting Party then the extent of protection of the mark in the designated Contracting Party will be the same as if the mark had been registered nationally in that Contracting Party.

Challenging an International Registration

An International Registration can be challenged in two ways.

The first option is to oppose the International Registration in each designated Contracting Party. This will be conducted according to the national opposition procedures of each Contracting Party.

Alternatively the International Registration can be "centrally attacked". The International Registration will, during the first five years of its life, remain dependent on the home application/registration upon which it has been based. Therefore if the home application/registration is opposed/cancelled during the first five years then the International Registration will fall away.

"Central attack" must be effected against the home application/registration according to the national trade mark law and practice of the Contracting Party in question. If a mark is cancelled as the result of "central attack", then the Holder has a three month term within which potentially to "transform" the International Registration into national applications in the designated Contracting Parties, without loss of rights.

Use and Non-use

An International Registration constitutes a bundle of national rights. It is therefore necessary to make sure that the mark is not allowed to fall into non-use in each of the designated Contracting Parties. Non-use will be determined according to the national trade mark law of each designated Contracting Party.

Revocation

If an International Registration is more than five years old the only way to invalidate it is to challenge it in each designated Contracting Party, again according to the national trade mark laws of the Contracting Party.

Transfers

An International Registration can be transferred but the assignee must qualify as a Holder in its own right (see definition under 'Who may apply', above). If the assignee is not entitled to hold an International Registration then it cannot be recorded as the new Holder on the International Register.

If it is entitled, an application to record the transfer is filed at WIPO, who will in turn notify details of the recordal to each designated Contracting Party in respect of which the transfer has been effected.

It is possible for an International Registration to be partially transferred i.e. for only part of the goods or services or for some of the designated Contracting Parties.



If a transfer occurs in respect of the home application/registration within the first five years, then details of the transfer will be communicated by the home Registry direct to WIPO who will in turn notify the relevant designated Contracting Parties.

Licences

In the case of licensing, it has been possible to record a licence against an International Registration since 1 April 2002. The licence can be partial as to territorial extent and goods/services and there is no need for the licensee to qualify as a body entitled to hold/own an International Registration.

Infringement

Infringement of an International Registration is determined according to the national trade mark laws of the designated Contracting Party where the infringement is occurring.

Renewal

An International Registration under the Madrid Protocol is valid for 10 years. It is then renewable for a further 10 years, ad infinitum.





This briefing paper is intended as guidance only and no legal liability can be accepted in relation to the information given above. For further information contact a trade mark attorney or contact the Institute office at:



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