

# International trade marks under the Madrid Protocol

The Madrid Protocol is a treaty providing for the international registration of trade marks that is controlled by the International Bureau (IB) of the World Intellectual Property Organization (WIPO).

## How can a trade mark be registered in an overseas market?

Australian trade mark owners may choose between two different routes for registering trade marks overseas. The first is to file directly as a national application in each desired country or region (eg a European Community Trade Mark Application (CTM)). The second is to file an international application under the Madrid Protocol treaty designating at least one member country.

## What types of trade marks may be registered as an International Registration (IR)?

Normal word, graphics, and combinations may be registered. It is also possible to register shape, sound and colour, but not scent, as trade marks.

## Which Countries are members of the Madrid Protocol?

There are currently 80 countries that are members of the Madrid Protocol including Austria, Australia, Belgium, China (PRC), Czech Republic, Denmark, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Japan, North and South Korea, Luxembourg, Netherlands, Norway, Poland, Portugal, Romania, Russia, Singapore, Slovakia, Spain, Sweden, Switzerland, Turkey, the United Kingdom and the United States of America. Other countries including New Zealand are considering joining and it is expected that over time the list of member countries will increase. Link [here](#) for a list of member countries.

## Who can apply for an International Registration (IR)?

Any person or legal entity (eg corporation) that is an Australian national, is domiciled in Australia, or has a real and effective industrial or commercial establishment in Australia. The applicant must have an Australian home trade mark application or registration on which the IR application is based called the "basic application" or "basic registration".

## How is an IR application filed?

Watermark can prepare and file the IR application on your behalf with IP Australia acting as a receiving office. The IR application may claim convention priority if applicable. The IR application must be for exactly the same trade mark as the basic application or registration and for goods and/or services in one or more classes no wider than the basic application or registration. IP Australia check IR applications received by them and pass them on to the IB for further processing.

## What official examination can be expected?

The International Bureau (IB) check IR applications to ensure that they meet formal requirements and they are then registered and placed on the International Register of Trade Marks. For the trade mark to be actually protected in a designated country, each designated country must review the IR relative to their own national laws and if necessary issue a refusal to protect under these laws. Designated countries are required to review the IR within either twelve or eighteen months from the international filing date depending on the country and if a refusal notice to protect is issued, applicants have the same rights to respond as they would have had if the IR had been a national application in that country.

Possible opposition to registration in each designated country is also conducted under the laws of the individual countries and needs to be commenced within the aforementioned twelve to eighteen month periods but can be processed and finalised after these dates.

## What occurs if a refusal to protect is maintained?

Protection of trade mark rights in any country where a refusal notification is issued and not rescinded or where an opposition proceeding succeeds, means that the IR trade mark rights

continued overleaf

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will not extend to that country. This, however, has no effect on any other designated country.

### Can the goods / services covered differ between designated countries?

It is possible for this to occur, however, in any case, the goods / services cannot extend beyond those covered by the Australian basic application or registration.

### How much will an IR cost?

The cost of an IR will depend on both the number and the particular countries designated and the number of classes of goods or services covered. It should be borne in mind that the IR application fees effectively cover both filing and registration. In the majority of cases, filing an IR application designating at least two countries will be cost effective relative to separate national applications in the respective countries. In some cases, designating only one country with an IR application, will be cost effective relative to a national application in that country having regard to the cost savings of not having to pay acceptance / registration charges.

In every case, ask your Watermark professional to provide a cost estimate for the respective routes including both expected filing and acceptance / registration costs.

### Can an IR owner add further countries?

It is possible to do this at any time by preparing and filing a separate IR application designating a further country or countries. It will normally be less expensive to add a country to an existing IR than it would be to file a separate national application in that country.

### How long does an IR last?

The renewal term for an IR is ten years from its international filing date and thereafter for similar ten year periods.

Renewal fee payments are made centrally via IP Australia and the IB, and while costs will vary depending on the number of designated countries, the costs will be significantly less than renewing the same number of individual national registrations. It is also possible to renew the IR in only some of the designated countries.

### How are changes of name and transfer of title handled?

Like renewals, such matters are handled centrally via IP Australia and the IB. Again, it would be expected that the costs of recording such matters will be significantly less than attending to them on

individual national registrations. The owner of the IR does not need to remain the same as the basic application or registration.

### What are the advantages and disadvantages of an IR?

There is a limited number of countries that are party to the Madrid Protocol treaty where Australian trade mark owners might wish to protect trade marks. The list is growing and likely to continue to increase.

An IR or an application for an IR within five years from its international application date will suffer the same fate as any changes made to the basic application or registration on which it is based. Thus any restrictions to the goods or services covered by the basic application or registration will also occur in the IR or IR application. In the worst case scenario, if the basic application is refused or if the basic registration is cancelled, then the IR application or IR will similarly be cancelled. Beyond this initial five year period, changes to the basic registration have no effect on the IR.

If a basic application or registration is restricted or cancelled within the first five years, it is possible to convert the IR or IR application within a limited period into individual national applications, however, increased costs should be expected in such circumstances.

Some increased costs may be experienced in the case of a designated country issuing a refusal notice as in such cases, if it is intended to dispute the refusal, it would be necessary to appoint a local agent to act and to pay their charges for doing so.

It is possible to add countries cost effectively in the future whether or not those countries were party to the Madrid Protocol treaty when the initial IR was obtained.

If the IR proprietor owns an existing national registration of the same scope, they can combine it with the IR if they wish.

Renewal and other post registration recordal procedures are simplified and attended to centrally providing significant cost savings.

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