

Filing International Trade Marks via the Madrid Protocol - What you need to know

Since 10 December 2012, New Zealand individuals and businesses have had the ability to use a New Zealand trade mark application or registration as their base for a 'Madrid Application', whereby multiple countries can be designated at the click of a button.

This can be compared with filing separate national applications into individual countries for the same trade mark, where the assistance of local agents must be engaged.

At present, 116 countries are party to the Madrid protocol, and are available for designation in a Madrid Application. The Application is filed through the Intellectual Property Office of New Zealand (IPONZ), who sends the designations to the World Intellectual Property Organisation (WIPO) in Switzerland. WIPO then forwards the designations on to the applicable national trade mark Offices for examination.

Over the course of the past few years, we have dealt with many Madrid Applications on behalf of our New Zealand clients, as well as dealing with incoming requests from overseas agents who require assistance with New Zealand designations filed elsewhere.

In light of this, we have compiled together a list of advantages and disadvantages that clients should consider when contemplating filing a trade mark in multiple countries.

Advantages

- The process for filing a Madrid Application is simple – there is one application filed in the English language, and in most cases, only one filing fee is required.
- When selecting multiple designations, the cost can be significantly lower than filing separate applications via the national route.
- If an application is straightforward and no oppositions are raised, the assistance of a local agent is not required, thereby reducing the cost.
- Administration of the Madrid Application (and the base application) is cheaper than dealing with separate national applications and registrations on an individual basis. This is because renewals, recording changes of name of owner, and assignments of the subject trade mark are carried out centrally by making a single request to WIPO.
- National trade mark Offices must accept or reject an application within 12-18 months from filing, which for certain countries, speeds up the examination process in comparison to examination via the national route.

Disadvantages

- Not every country in the world is a member. There are 116 countries parties to the Madrid Protocol, so sometimes applications must be filed via the national route instead. Notably, Canada and Hong Kong are not party to the Madrid Protocol.
- The Madrid Application relies on the longevity of the base application or registration. If the base application or registration is attacked and cancelled within 5 years of the Madrid Application filing date, the applicable designations will be cancelled or limited accordingly.

While it may be possible to convert the designations to separate national applications or registrations, this can be costly. To lessen the risk of such an attack, we do not recommend filing a Madrid Application until we are certain the base application will reach acceptance and pass the opposition period, in order for it to proceed to registration. As with any trade mark registration, a base registration can be revoked on the basis of non-use after a certain period of time.

- Because the administration of a Madrid Application is carried out centrally, it is ‘all or nothing’ so to speak. For example, if only one designation is to be assigned, it must first be converted to national format.
- A Madrid Application cannot be assigned to someone that is not a national of, or who does not have a commercial establishment or is domiciled in, a country that is party to the Madrid Protocol.
- We note the increase in overseas companies using the Madrid Protocol to designate New Zealand, whereas previously they may have not been likely to do so. It has been commented that the Madrid Protocol provides an incentive to those wanting to broaden their protection in Australasia as formerly, many trade mark owners would only file into Australia. It is therefore vital that New Zealanders ensure their trade marks are adequately protected, given that the potential for conflict has increased.

Concluding Comments

Experience dictates the advantages of the Madrid Protocol outweighs the disadvantages, which can be contained. Filing a Madrid Application can be particularly beneficial when multiple designations are required.

Because the Madrid filing fees are subject to fluctuations in the Swiss Franc, please contact us to obtain a tailored quote if you are interested in protecting your trade marks overseas.

Please contact us via our website at www.ellisterry.com or email Emily Ellis at emily.ellis@ellisterry.com if you have any further questions regarding the Madrid Protocol.