



Challenges of filing international trademarks

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The Madrid System is a common tool to register trademarks internationally. However, the advantages and disadvantages should be carefully considered before initiating the filing process as the international trademarks may not be a suitable option for everyone.

The Madrid System for international trademarks is a suitable option to file trademarks in multiple countries. As of today, it includes over 130 countries all over the world with the newest member being Mauritius. While many countries are present, some nations are still missing, for example many countries in Latin America and most of Middle East with an exception being United Arab Emirates who joined the Madrid System almost two years ago.

One of the advantages of filing an international trademark before World Intellectual Property Organization (WIPO) is using a simplified filing process as several countries can be protected through a single application. Also, it is more cost-effective than filing separate national trademarks for each country of interest. Costs are not only reduced at filing stage but also when renewing the trademark or for other administrative tasks such as changes of address of the holder since these requests can be managed through a single process for all designated countries. The trademark application can be handled in one of the official

languages (English, French or Spanish) which therefore reduces translation costs. Another benefit of the Madrid System is its flexibility which allows additional countries to be added to the international trademark at a later stage via subsequent designations.

While international trademarks offer several advantages they also come with a fair share of challenges.

It is important to bear in mind that several requirements must be met before initiating the filing process of an international trademark.

Firstly, the holder needs to be a national of – or have a domicile or an effective industrial or commercial establishment – in one of the member countries of the Madrid Protocol. This requirement is especially important in the event of a future assignment of the trademark as assignments are only possible if the assignee also meets the requirement of having nationality, domicile, or an

establishment in one of the Contracting Parties of the Madrid System.

Filing an international trademark means using a simplified filing process since several countries can be protected through a single application.

Secondly, a basic trademark application or registration is required, which also needs to be filed in one of the member states. The international trademark depends on the home application during the first five years and can therefore be subject to a central attack which means that in case the home application is cancelled or rejected the international trademark would face the same consequence. That said, it is possible to convert each designation into a national trademark, but this is a costly procedure resulting in national trademarks in each country.

In an attempt of decreasing the risk of the home application not maturing into registration, it may be advisable to wait until after the examination stage has ended or even after the opposition period has lapsed. However, this adds to the registration process being rather slow. WIPO can take around 2-3 months to register a trademark in case of a straightforward proceeding and afterwards each designation may still be examined individually in each country. The examination period can be up to 12 or 18 months, depending on whether the country of the basic registration is part of Madrid Protocol or Madrid Agreement.

While international trademarks offer several advantages they also come with a fair share of challenges.

While international trademarks have many benefits, it is important to bear in mind the requirements to determine the appropriate filing strategy before initiating the filing process.