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Obtaining Trademarks Overseas – A Brief Guide for Clients



Adamson**Jones**

Obtaining trademarks in overseas countries

A summary of the issues and procedures involved in obtaining trademarks around the world

How do I obtain trade mark protection overseas?

There are three commonly-used ways of obtaining trade mark protection overseas:-

- a) file separate national trade mark applications in each country of interest;
- b) file a Community Trade Mark (CTM) application, which covers all member states of the EU; and
- c) file an international trade mark application using the Madrid Protocol.

Each of these options is discussed below.

What is a foreign national trade mark application?

A foreign national trade mark application is one that is filed directly at the national Trade Marks Registry of a foreign country in which trade mark protection is required, for example the United States, Brazil, Canada, Japan, Australia, New Zealand, etc. If you are only interested in protecting your trade mark in a limited number of countries, national trade marks may be the most cost-effective option. However, where protection is required in a larger number of foreign countries, it may be more cost-effective to use the Madrid International Registration System, which is described in detail below. We can advise you as to the best course of action once you have provided us with a list of countries in which you wish to obtain trade mark protection.

In order to file a foreign national application, we use the services of a local trade mark attorney in each country of interest. We have a large network of foreign associates, who assist us by filing and prosecuting foreign trade mark applications in their home country on behalf of our clients.

The cost of filing national trade mark applications varies between countries. However, for a typical case, the cost of filing a national trade mark application in English-speaking countries will be £800 to £1200 plus VAT, including official fees and foreign attorney charges. Where trade

mark protection is required in a foreign-language country, such as in Japan or China, the cost for a typical application will be between £1,000 to £2,000 plus VAT including translation charges.

Once the national trade mark application has been filed at the local Trade Marks Registry, it must be prosecuted through to registration, and this process may take 6 to 18 months depending on the country and any objections that may be raised. Prosecution involves dealing with search and examination reports, and other formalities before the national Trade Marks Registry until the application is either accepted, resulting in a registered trade mark, or refused. In addition, in some countries, such as the United States, it may be necessary to provide evidence to the Registry that the trade mark has been used in the country in which protection is sought, and there will be associated costs in compiling and filing such evidence. Prosecution costs can range from about £500 to £1,500 plus VAT for a typical case.

Upon acceptance by the national Registry, the trade mark will be registered for an initial period of ten years. In order to keep a registered trade mark in force, it is necessary to pay renewal fees, normally every ten years, in which case the registration can be maintained indefinitely.

When do foreign trade mark applications need to be filed?

In contrast to patent and design applications, there is no strict requirement for a trade mark to be confidential when filing a trade mark application. In fact, many national trade mark applications are filed after several years of use in that country. However, complications can occur if an application is delayed for too long, as it presents the risk that a third party may be able to register the identical or a confusingly similar trade mark application in the same country before you. This could in some cases prevent your trade mark application from being registered. For this reason, we recommend that a national trade mark application is filed before the mark is used in each country, or at least very shortly after use has begun, to minimise the risk of a conflicting application from a competitor.

Please note that by filing a foreign trade mark application within 6 months from the earliest filing date of your initial UK or Community Trade Mark application, it is possible to back-date the foreign application to this so-called priority date. This can provide some advantages, as it effectively means your national trade mark application has an earlier filing date, which could be useful if a competitor applies to register the identical or a confusingly similar trade mark application in that foreign country.

What is a Community Trade Mark?

A Community Trade Mark (CTM) is a single trade mark registration that provides protection in all of the member states of the European Union.

The cost of a CTM application is from about £1,400 plus VAT, including the official fees and our charges. This charge includes three class fees, whether or not the goods/services you wish to cover fall into three classes. Therefore, we believe that the CTM system provides excellent value for money for securing trade mark protection across the whole of the EU. Should further classes be required, then a further charge of about £200 plus VAT is payable for each additional class of goods/services. In more complicated cases, where additional professional time is required to finalise the list of goods/services, an additional charge of £50 to £200 plus VAT may also be incurred.

CTM applications are filed at the Office for Harmonisation in the Internal Market (OHIM) in Alicante, Spain. After filing, the application is examined as to whether or not it is inherently registerable. OHIM then issues a search report in respect of earlier Community Trade Marks. This search report may give us an indication as to whether or not any problems could occur later on in the CTM application process. For example, we may be able to predict the likelihood of any third parties opposing your trade mark application. The cost for briefly reviewing and reporting the search reports to you is usually £100 - £200 plus VAT.

If OHIM finds any existing marks on the CTM Register that might conflict with yours, it notifies the owners of those marks of the existence of your application, but OHIM itself does not raise any objection. The CTM system relies on CTM owners themselves to monitor whether an application for an identical or a confusingly similar mark is filed, and if so, to oppose such applications.

The CTM application is then published, and in the following three months, anyone may file a formal opposition against the application. We will advise you of the procedure for responding to an opposition against your CTM application should the need arise. However, the cost of dealing with an opposition can vary between £500 and £2000 plus VAT, or more for complicated cases. While it is difficult to predict whether or not a third party will oppose a CTM application, the various search reports that are issued by OHIM may provide an indication as to whether an opposition could be filed against your application. At the end of any formal opposition, the mark will either be maintained or rejected, either in full or in part, ie the mark may be registered in respect of the full range of goods/services originally specified, or a limited range.

At the end of the three month opposition period, the mark will proceed to registration, provided that no oppositions have been filed, or after any opposition has been overcome. OHIM then issues a registration certificate. At this stage, you may now use the registered trade mark symbol ®. The CTM is registered for an initial period of ten years, and provided that renewal fees are paid to OHIM every ten years, the trade mark will remain registered indefinitely.

However, if a CTM is not used at all in any of the member states of the EU for a period of five years, it may be invalidated by a competitor, and removed from the register. Therefore, it is important for you to use your trade mark after registration in at least one EU member state, which does not necessarily have to be the United Kingdom.

Does a CTM have any disadvantages?

A Community Trade Mark is “unitary” in nature. This means that if another trade mark owner has an earlier national trade mark (eg a French or Latvian or Portuguese national trade mark etc), then they may be able to successfully attack your CTM in its entirety. For example, the trade mark owner could oppose or invalidate your CTM, affecting your trade mark protection across all of the EU member states.

However, in such circumstances, it may be possible to convert your CTM application into individual national trade mark applications in each country in which no earlier national prior right exists, and in which trade mark protection is required.

What is a Madrid International Trade Mark?

The United Kingdom and OHIM are two of over 60 members of the Madrid Protocol, which is an international registration system by which applicants from any member can obtain international trade mark protection in any other country which is also a member of the Protocol.

The Madrid system provides a very cost-effective way of obtaining trade mark protection with a single registration in numerous foreign countries, provided that they are members of the Protocol. We can provide you with an up-to-date list of the members of the Protocol upon request.

In order to use the Madrid system, it is necessary to have either a registered UK or European trade mark, or at least a UK or European trade mark application, for the mark that is to be covered by the Madrid registration. The cost for filing an application under the Madrid Protocol depends on whether the base application/registration was filed at the UK Intellectual Property

Office (UKIPO) or OHIM, the particular countries in which protection is sought, the number of classes in which the goods/services are covered, and whether or not the trade mark is in colour, or black and white. We can provide you with an accurate quote for your Madrid trade mark application once you have provided us with a list of countries in which you wish to protect your mark.

The Madrid application is filed at the UKIPO which initially verifies the application before forwarding it to the World Intellectual Property Organisation (WIPO) in Geneva, where it is examined in detail. WIPO then sends the application to the national Trade Marks Registry of each designated country where it will be examined in accordance with the corresponding national law. Each national Registry will then inform WIPO as to whether or not the Madrid application has been accepted or rejected.

If a national Registry does not refuse the Madrid application within about 12-18 months, then the mark is considered to be registered in that designated country. Under the Madrid Protocol system, the onus is on each national Registry to refuse protection on a timely basis. If an objection is raised, then the applicant is given the opportunity to argue in favour of the application.

An international Madrid Registration lasts for an initial period of ten years, but may be renewed every ten years upon payment of a single international renewal fee, the amount of which is determined by which countries are designated and the number of classes of goods/services.

Can a Madrid Registration be challenged?

Yes. It is possible to attack a Madrid registration in each designated country in accordance with national law.

In addition, the Madrid registration can be attacked centrally. During the first five years of its life, the Madrid registration is linked to the home UK or CTM trade mark application/registration. Accordingly, if the UK or CTM application/registration is successfully opposed or invalidated in some way during the first five years, then the international Madrid registration will be revoked. However, if this occurs, there are provisions to enable the international registration to be transformed into a series of national applications in each designated country, without any loss in trade mark rights.

Do I have to use the trade mark?

Yes. Because the Madrid registration essentially consists of a bundle of national trade mark registrations, it is necessary to use the mark in every single designated country. Non-use, normally for a period of five years or more, in any designated country, may result in the registration becoming invalid in that country and open to attack.

What are trade mark watches?

We recommend that trade mark owners police their trade mark rights in every country in which they have a registered trade mark. For this reason, we provide regular trade mark watching services for clients who wish to keep themselves informed of any attempt by a competitor to register a trade mark that may be either identical or confusingly similar to their own trade mark. If such a conflicting application were to be successfully registered, it could diminish your trade marks rights, and seriously affect your business.

In cases where a potentially conflicting trade mark application has been filed, the watch enables the trade mark owner to contact the applicant of the conflicting mark in order to come to some agreement, for example, by requesting the later application to be withdrawn or restricted. Trade mark owners also have the option of filing a formal opposition against subsequently filed trade marks, if they believe that there is a likelihood of confusion by the customer. We can help you by filing trade mark oppositions against competing marks on the register.

The cost of maintaining a basic watch of the Community Trade Marks Register for one year for a single mark covering up to three classes is from about £200 plus VAT per year. The cost of maintaining a worldwide watch will be from about £250 plus VAT per year. The watch results will be forwarded to you without comment, and additional charges would arise only if you request advice regarding enforcement or oppositions.

In addition to watches that we can perform on your behalf, we recommend that you closely monitor your competitors' products yourself to see if they use any trade marks that are identical or confusingly similar to your mark in each country in which you are active. It is possible to enforce your trade mark rights against such infringing activities.

How can AdamsonJones help?

We would be happy to discuss with you the best way to protect your trade marks overseas.
Please feel free to contact us to arrange a meeting.

NB: We have endeavoured to ensure that the information in this note is accurate and up-to-date.
However, this note is for general guidance only, and is not a substitute for professional advice.



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