

brief guide to madrid protocol

There are currently in excess of eighty countries who have signed up to the Madrid Protocol. These include major trading nations such as the USA and China as well as the European Union and the 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.

The main benefit of the Madrid Protocol is that, for a single fee, a registration covering, potentially, all the countries signed up to it can be secured. This results in considerable cost savings and ease of administration for renewals, assignments or other changes compared with national registrations.

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 Country by way of a Subsequent Designation.

To apply for a registration under the Madrid Protocol the Applicant must be based in one of the Contracting Countries.

In addition, the Applicant must possess a home application or registration for the identical mark which must cover the goods or services which are the subject of the International Registration.

For a UK applicant the application is filed via the UK Intellectual Property Office or, if based on a Community Registration, through OHIM, who will confirm the validity of the application and forward it to WIPO.

WIPO examine the application and, if satisfied, forward it to the National Registries concerned who have up to 18 months to accept or reject the application.

WIPO will issue a registration certificate shortly after publication of the application in the official journal. However, the mark is only validly registered once the 18 month objection period has passed.

If there are objections raised in any particular country they need to be resolved directly with the relevant national registry

Once registered, subject to national requirements with regard to use in individual countries, the mark is registered for a period of 10 years with further 10 year periods subject to renewal.

It is important to note that the home registration upon which the international application is based must be maintained during the first five years that the international registration is in force, as any changes during that period will also apply to the international registration. If the home registration should be lost during that period it is possible to convert the international registration into a series of national registrations maintaining the original filing date.

It is possible to assign an international registration but only to an assignee who also qualifies to hold such a registration. The assignment may be for some or all of the goods or services covered and for any or all the countries designated.

For advice regarding the suitability of this type of application for your requirements please contact a Nucleus IP attorney.

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