

CLIENT INFORMATION SHEET | INTERNATIONAL TRADE MARK REGISTRATION FROM AUSTRALIA

CLIENT INFORMATION SHEET | MADRID PROTOCOL FROM AUSTRALIA v110220

Please find following our information sheet for filing an international trade mark application (Madrid protocol application) from Australia.

The information sheet is not exhaustive but covers most common items incurred during filing.

Should you require additional information or if you have any questions then please let us know.

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PURPOSE OF THIS INFORMATION SHEET

The purpose of this information sheet is to provide general information about an international trade mark application (Madrid protocol application) from the perspective of an Australian filer with little or no relevant experience with trademarks so they can be aware of at least some of the fundamentals about international trade mark registrations and associated issues and considerations.

This information sheet should not be taken as being exhaustive in any sense however may help clarify, refine or articulate a novice’s trade mark requirements in preparation of further consultation with trade mark practitioners such as our firm so that the novice can maximise the benefit from a further consultation in relation to the novice’s specific trade mark requirements or issues.

We trust you find the information sheet helpful.



CLIENT INFORMATION SHEET | INTERNATIONAL TRADE MARK REGISTRATION FROM AUSTRALIA**WHAT IS AN INTERNATIONAL TRADE MARK REGISTRATION**

An international trade mark application facilitates the obtaining of protection for trademarks in members of the international trade mark system ("the Contracting Parties") which presently stands at 98 countries, by the filing of a single trade mark application that designates which countries the application is to have effect.

The members are either individual countries or regional trade mark systems such as the European Union Trademark (previously known as a Community Trade Mark). A list of current Contracting Parties is provided in Schedule 1 herein. A list of current European Union Trademark members is provided in Schedule 2 herein.

Once an international trademark application is lodged it is checked for certain formalities then subject to compliance with the formalities requirements it is registered at the international level.

This then triggers national examination and opposition procedures in all the designated Contracting Parties where protection is required. Subject to the outcome of the national examination and opposition procedures in each designated Contracting Party national protection to the international registration in the relevant designated Contracting Party is granted.

Therefore national protection in a designated Contracting Party of an international trade mark registration only arises after the international trade mark registration successfully completes the national examination and opposition process in the relevant designated Contracting Party.

Ultimately an international trade mark registration can be equivalent to a bundle of national registrations, the subsequent management of that protection is made much easier. There is only one registration to renew, and changes such as a change in the ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step.

THE INTERNATIONAL APPLICATION | REGISTRATION | NATIONAL PROTECTION

A mark may be the subject of an international application (for Australian applicants) only if it has already been separately registered, or if its registration has been separately applied for in the Australian Trademark Office ('the basic registration or application').

That is before an international application can be filed, it must be based on a coexisting corresponding domestic Australian trademark application or registration. The Australian trademark office is the Office of origin for Australian applicants of an international application that rely on an Australian basic application.

An international application may claim priority from an eligible earlier trademark application such as a corresponding domestic Australian trademark application providing of course it is filed in good time before the convention period expires.

An international application must designate the Contracting Parties in which the mark is to be protected, however the Australian trademark office cannot be designated in an international application at any stage as it is the Office of origin for Australian applicants an international application.

The international application is subject to the payment of an official basic fee, and a variable official fee in respect of each designated Contracting Party that maybe contingent on the number of classes in the application.

The international application is filed with the Australian trademark office who when satisfied will certify the international application corresponds to the corresponding Australian basic application / registration and will forward the certified international application to the International Bureau for further processing. The International Bureau is the office that administers the international trademark registration system.

The International Bureau checks that the certified international application complies with its formality requirements and subject to that compliance issues an international registration number and filing date (which

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usually is the date the international application was filed with the Office of origin) and will notify each designated Contracting Party of the international registration and that trademark protection is sought in the relevant Contracting Party via the international registration.

However if the international application contains any irregularities (ie does not comply with the formalities requirements) the International Bureau will advise the Australian trademark office and the applicant, and if the irregularities are not remedied within 3 months the international application will be considered abandoned.

NATIONAL EXAMINATION | REFUSAL OF NATIONAL PROTECTION

The national trade mark office of a designated Contracting Party examines the international registration in exactly the same way as a national application in that Contracting Party / Country.

If grounds for objection are found during the national examination procedure, or if a national opposition is filed, the national office has the right to declare that protection cannot be granted to the mark in that Contracting Party while the objections remain or the opposition is unfavourably unresolved.

If a Contracting Party is going to refuse protection to the international registration it must do so within fixed time limits. Any national provisional refusal based on national examination grounds must be notified to the International Bureau by the national office of the Contracting Party concerned within set time limits ranging from 12 months to 18 months from the international registration date. In some cases a national provisional refusal based on a national opposition may arise after the 18 month time limit.

If a national provisional refusal arises a copy is sent to the holder / owner of the international registration usually in the form a national examination report or notice of opposition as applicable. The notice of the national provisional refusal will set out applicable time limits in which the applicant has to overcome the adverse examination report or to defend the opposition as applicable.

Any national procedure subsequent to a national refusal, such as review, appeal or response to an examination report or an opposition, is carried out directly between the holder and the national Office concerned, without any involvement on the part of the International Bureau.

However, once all the national procedures before that national Office have been completed / exhausted, the national Office must send to the International Bureau a final statement. Depending upon the outcome of the case, such statement will confirm either that protection for the mark has been totally refused (Confirmation of Total Provisional Refusal), or that protection has been partially or totally granted to the mark, as the case may be (Statement of Grant of Protection Following a Provisional Refusal). This statement is recorded in the International Register, and a copy is transmitted to the holder of the international registration.

Where, before the expiry of the refusal period, all the procedures before a national Office have been completed and the Office has found no grounds to refuse protection, the Office shall, as soon as possible, (and before the expiry of the refusal period), send to the International Bureau a statement to the effect that protection is granted to the mark (Statement of Grant of Protection where no Notification of Provisional Refusal has been Communicated). Such statement is recorded in the International Register and published in the Gazette and a copy is transmitted to the holder of the international registration.

EFFECTS OF INTERNATIONAL REGISTRATION

From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed direct with the Office of that Contracting Party. If no provisional refusal is notified to the International Bureau within the relevant time limit, or if any such refusal is subsequently withdrawn, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

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An international registration is therefore equivalent to a bundle of national registrations. Although it is a single registration, protection may be refused by some of the designated Contracting Parties, or the protection may be limited or renounced with respect to only some of the designated Contracting Parties. Likewise an international registration may be transferred to a new owner with respect to only some of the designated Contracting Parties. An international registration may also be invalidated (for example, for non-use) with respect to one or more of the designated Contracting Parties. Moreover, any action for infringement of an international registration must be brought separately in each of the Contracting Parties concerned.

This is in contrast to a unitary regional right such as the European Union trade mark, which cannot be refused, limited or transferred with effect for only a part of the territory covered by the right, and which may be enforced by a single legal action covering infringement occurring anywhere in that territory.

DEPENDENCE ON THE BASIC MARK

For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Office of origin.

If, and to the extent that, the basic registration ceases to have effect, whether through cancellation following a decision of the Office of origin or a court, through voluntary cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected.

Similarly, where the international registration was based on an application in the Office of origin, it will be cancelled if, and to the extent that, that application is refused or withdrawn within the five-year period, or if, and to the extent that, the registration resulting from that application ceases to have effect within that period.

If, within three months of such cancellation, the holder files an application for registration with the Office of a designated Contracting Party, that application will be treated as if it had been filed on the date of the international registration or (as the case may be) the subsequent designation of the Contracting Party concerned.

After the expiry of the period of five years from the international registration date the international registration becomes independent of the basic registration or basic application.

SUBSEQUENT DESIGNATION

The effects of an international registration can be extended to a Contracting Party not covered by the international application by filing a subsequent designation. Thus, the holder of an international registration can expand the geographical scope of the protection of the mark in line with the applicable business needs, including the extension of the trademark protection to a Contracting Party which was not a member of the Madrid System at the time of the international application.

Moreover, where protection has initially been refused, it is possible to later make a subsequent designation if the grounds for refusal no longer apply.

CHANGES IN THE INTERNATIONAL REGISTER

A change in the name or address of the holder may be recorded in the International Register on request.

Likewise a change in the ownership of an international registration may be recorded, in respect of all or some of the goods and services and all or some of the designated Contracting Parties. A change in the ownership may be recorded in the International Register only if the transferee is a person who fulfils the conditions (of establishment, domicile or nationality) to be the holder of an international registration

Information concerning such changes is notified by the International Bureau to the designated Contracting Parties.

CLIENT INFORMATION SHEET | INTERNATIONAL TRADE MARK REGISTRATION FROM AUSTRALIA**DURATION OF REGISTRATION | RENEWAL**

An international registration is effective for 10 years. It may be renewed for further periods of 10 years on payment of the prescribed fees.

The international registration may be renewed in respect of all the designated Contracting Parties or in respect of only some of them.

It may not however be renewed in respect of only some of the goods and services recorded in the International Register; if therefore the holder wishes, at the time of renewal, to remove some of the goods and services from the international registration, he must separately request cancellation in respect of those goods and services.

ADVANTAGES OF THE MADRID SYSTEM

International registration has several advantages for the owner of the mark.

After registering the mark, or filing an application for registration, with the Office of origin, the applicant has only to file one application, in one language, and pay one fee instead of filing separately in the Trademark Offices of the various Contracting Parties in different languages and paying a separate fee in each Office.

Moreover, the holder does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive decision to register the mark; if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned.

In some cases, the holder does not even have to wait the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since a holder may before the expiry of the time limit, receive a statement of grant of protection from the Office of that Contracting Party.

A further important advantage is that changes subsequent to registration, such as a change in the name or address of the holder, or a change (total or partial) in the ownership or a limitation of the list of goods and services may be recorded with effect for several designated Contracting Parties through a single simple procedural step and the payment of a single fee. Besides, there is only one expiry date and only one registration to renew.

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SCHEDULE 1 – MADRID PROTOCOL COUNTRIES AS OF OCTOBER 2018

- | | | |
|--|---|--|
| 1. Afghanistan | 37. Ghana | 75. Republic of Korea |
| 2. African Intellectual Property Organisation (OAPI) | 38. Greece | 76. Republic of Moldova |
| 3. Albania | 39. Hungary | 77. Romania |
| 4. Algeria | 40. Iceland | 78. Russian Federation |
| 5. Antigua and Barbuda | 41. India | 79. Rwanda |
| 6. Armenia | 42. Indonesia | 80. Samoa |
| 7. Australia | 43. Iran (Islamic Republic of) | 81. San Marino |
| 8. Austria | 44. Ireland | 82. Sao Tome and Principe |
| 9. Azerbaijan | 45. Israel | 83. Serbia |
| 10. Bahrain | 46. Italy | 84. Sierra Leone |
| 11. Belarus | 47. Japan | 85. Singapore |
| 12. Benelux * (Belgium
Luxemburg Netherlands –
Europe Terr.) | 48. Kazakhstan | 86. Slovakia |
| 13. Bhutan | 49. Kenya | 87. Slovenia |
| 14. Bosnia and Herzegovina | 50. Kyrgyzstan | 88. Spain |
| 15. Botswana | 51. Lao People's Democratic
Republic | 89. Sudan |
| 16. Brazil | 52. Latvia | 90. Swaziland |
| 17. Brunei Darussalam | 53. Lesotho | 91. Sweden |
| 18. Bulgaria | 54. Liberia | 92. Switzerland |
| 19. Cambodia | 55. Liechtenstein | 93. Syrian Arab Republic |
| 20. Canada | 56. Lithuania | 94. Tajikistan |
| 21. China | 57. Luxembourg | 95. Thailand |
| 22. Colombia | 58. Madagascar | 96. The former Republic of
Yugoslav Macedonia |
| 23. Croatia | 59. Malawi | 97. Tunisia |
| 24. Cuba | 60. Malaysia | 98. Turkey |
| 25. Cyprus | 61. Mexico | 99. Turkmenistan |
| 26. Czech Republic | 62. Monaco | 100. Ukraine |
| 27. Democratic People's
Republic of Korea | 63. Mongolia | 101. United Kingdom |
| 28. Denmark | 64. Montenegro | 102. United States of America |
| 29. Egypt | 65. Morocco | 103. Uzbekistan |
| 30. Estonia | 66. Mozambique | 104. Viet Nam |
| 31. European Community (i.e.
CTM) *** | 67. Namibia | 105. Zambia |
| 32. Finland | 68. Netherlands | 106. Zimbabwe |
| 33. France | 69. New Zealand | |
| 34. Gambia | 70. Norway | (total of 106 states) |
| 35. Georgia | 71. Oman | CURRENT LIST OF COUNTRIES |
| 36. Germany | 72. Phillipines | |
| | 73. Poland | |
| | 74. Portugal | |

NOTES:

* Belgium, Luxembourg and the territory of the Kingdom of the Netherlands in Europe have a unified legislation on trademarks and a common Office for the registration of trademarks under that legislation

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(Benelux Office). Under the Madrid System, protection shall be requested as if they were one country (Benelux). Their designation shall be subject to payment of a single complementary or individual fee.

SCHEDULE 2 – EUROPEAN UNION MEMBER COUNTRIES AS OF FEB 2020

- | | | |
|-------------------|-----------------|---------------------------|
| 1. Austria | 12. Greece | 23. Romania |
| 2. Belgium | 13. Hungary | 24. Slovakia |
| 3. Bulgaria | 14. Ireland | 25. Slovenia |
| 4. Croatia | 15. Italy | 26. Spain |
| 5. Cyprus | 16. Latvia | 27. Sweden |
| 6. Czech Republic | 17. Lithuania | |
| 7. Denmark | 18. Luxembourg | (total of 27 states) |
| 8. Estonia | 19. Malta | |
| 9. Finland | 20. Netherlands | CURRENT LIST EU COUNTRIES |
| 10. France | 21. Poland | |
| 11. Germany | 22. Portugal | |