

International Protection of Trade Marks

Trade marks may be protected in countries other than Australia either by filing separate National applications in each country of interest, by filing an application for a European Community Trade Mark (“CTM”) or by filing an International application to register a trade mark designating one or more members of the Madrid Protocol countries (“International Application”). Griffith Hack is able to assist clients in protecting their trade marks in any country.

Madrid Protocol

An International Application may be filed to register a trade mark designating one or more of the Madrid Protocol countries set out below.

Key Benefits:

- A single International Application can designate multiple countries, thereby avoiding overseas agents’ costs for filing the application.
- Payment can be made in a single currency.
- The grant of protection in designated countries provides the same rights that are granted to the owners of National trade mark registrations.
- The duration of an International Registration is 10 years from the date of filing the International Application. Protection can be maintained indefinitely subject to payment of renewal fees every 10 years. Renewal of the International Registration will have the effect of maintaining protection in each designated country.

- Assignments and changes of names or addresses may be recorded in relation to a single International Registration.
- Additional countries can be added later.

The trade mark contained in the International Application must be the subject of an Australian trade mark registration (“Basic Registration”) or an Australian trade mark application (“Basic Application”).

The goods or services covered by the International Application may be more restricted but may not be broader or contain different goods or services than those covered by the Basic Application or Basic Registration.

The International Application, once filed, will be treated as a National application in each country and will be examined separately by each designated country’s Trade Marks Office. Objections may be therefore raised in one or more designated countries on the grounds of prior trade marks or that the mark is not capable of distinguishing the owner’s goods/services from those of other traders. An International Application in a designated country can also be opposed. At that point, it will be necessary to nominate a local agent, to respond to any official objections or if an opposition is lodged.

Disadvantages:

An International Registration will be dependent on the continuing validity of the Australian Basic Registration or Application for a period of 5 years. In the event that during the first 5 years of the term of the International Registration, the Basic Application does not proceed to registration or is limited, or the Basic Registration is cancelled or limited, the International Registration will fail and/or be limited to the same degree.

Member Countries:

The following countries are members of the Madrid Protocol for the International registration of trade marks.

Albania	Denmark
Antigua & Barbuda	Egypt
Armenia	Estonia
Australia	European Union
Austria	Finland
Azerbaijan	France
Bahrain	Georgia
Belarus	Germany
Belgium	Ghana
Bhutan	Greece
Bosnia & Herzegovina	Hungary
Botswana	Iceland
Bulgaria	Iran, Islamic Republic of
China	Ireland
Croatia	Italy
Cuba	Japan
Cyprus	Kenya
Czech Republic	

Korea, The democratic People's republic of (North Korea)	Poland
Korea, The republic of (South Korea)	Portugal
Kyrgyzstan	Romania
Latvia	Russian Federation
Lesotho	San Marino
Liberia	Sao Tome and Principe
Liechtenstein	Serbia
Lithuania	Sierra Leone
Luxembourg	Singapore
Macedonia, The former Yugoslav Republic of	Slovakia
Madagascar	Slovenia
Malta*	Spain
Moldova, Republic of	Sudan
Monaco	Swaziland
Mongolia	Sweden
Montenegro	Switzerland
Morocco	Syria Arab Republic
Mozambique	Turkey
Namibia	Turkmenistan
Netherlands	Ukraine
Norway	United Kingdom
Oman	United States of America
*(via European Union only)	Uzbekistan
	Vietnam
	Zambia

79 member countries
(as at 16 February 2010)

European Community Trade Marks

Registration of a European Community trade mark has the same effect as a National trade mark registration in each member country.

The duration of a European Community Trade Mark is 10 years from the date of filing the application in the European Community Trade Mark Office. Protection can be maintained indefinitely subject to payment of renewal fees every 10 years.

Key Benefits:

Infringement: A Community Trade Mark registration is enforceable throughout the European Union. A decision on infringement by a Court in one country is enforceable in all other countries of the Union. Therefore, a single infringement action can be filed.

Use: The use of a Community Trade Mark in a single European Union country within five years of the date of registration is sufficient to avoid revocation due to non-use. This eliminates the need to market products in all countries where registration has been obtained.

Renewal: A single renewal of the Community Trade Mark is required, rather than multiple renewals in the member countries.

Licensing: A European Community Trade Mark can be licensed in respect of some, or all, of the European Union countries.

Disadvantages:

Opposition: It is possible to oppose a Community Trade Mark application on the basis of a prior conflicting registration or other enforceable right in any European Union country. A significant proportion of applications may therefore be opposed, and may involve multiple oppositions.

Assignment: A European Community Trade Mark can only be assigned with effect for all countries of the European Union.

Subsequent Conflicting Applications by Other Parties: Owners of Community Trade Mark registrations and applications will be notified of later conflicting CTM applications, but owners of National (i.e. non-Community) registrations and applications will not be informed of later conflicting CTM applications. We recommend that owners of Community Trade Marks and National trade marks maintain a trade mark watching service.

Member Countries:

The following countries are protected by a European Community Trade Mark

Austria	Latvia
Belgium	Lithuania
Bulgaria	Luxembourg
Cyprus	Malta
Czech Republic	Netherlands
Denmark	Poland
Estonia	Portugal
Finland	Romania
France	Slovakia
Germany	Slovenia
Greece	Spain
Hungary	Sweden
Ireland	United Kingdom
Italy	

We recommend that, prior to filing any trade mark application, we conduct pre-filing searches to determine the availability of a trade mark for use and registration in each country and to provide advice on registrability.

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