



INTERNATIONAL TRADEMARK REGISTRATION

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Introduction

In the surrounded world the registration of TM is multiple jurisdictions that will be governed by 2 treaties separately that are Madrid Protocol and Madrid Agreement. This protocol is not an agreement it has its treaty to work out. Both of these together are known as the Madrid system. Under Article 9 of the Paris Convention which both are well balanced with each other to cooperate that they constitute the Madrid union which is a special union. The wider scale of businesses and corporations for them International trademark were once only necessary.

The respective trademark office is based on where a trademark is registered for the territory. Where protection is sought in which trademark are territorial and must be filed in each country. The Paris Convention for the protection of industrial property claiming priority of a trademark has been laid down. Article 15, 16, 19, and 20 provides for the legal protection of a unique trademark through the World Trade Organization's Agreement on Trade-Related Intellectual Property Rights.

No, especially in the United State trademark will not need any kind of protection for registration of a trademark in a foreign country. Any application of a qualified owner of trademark pending before the U.S. Patent Office and Trademark Office (USPTO), you need to file a single application for

registration in any of those countries in who has been joined the Madrid Protocol which is known as "International Application".

International Registration Trademark

On a county, to country basis, trademark rights are acquired. Like you only have trademark rights in the U.S., if you register your trademark in the U.S. The Madrid system where you have to get a trademark registration in a country that belongs. If the registration of a trademark in a country that is a part of the Madrid System, then WIPO in Geneva, Switzerland where you accepted that can ask your country's trademark office to submit the registration. You have to pay for all the appropriate fees after all the WIPO will examine all the information that your TM office submit to make certain complete things. 83 countries are the members as per January 2011 in the Madrid Protocol.

Acts which help International Trademark Protection

Madrid Protocol (1989), Paris Convention, TRIPS, Trademark Law Treaty (1996), some regional trademark system that is APEC (Asia-Pacific) Community Trademark (European Union) ARPIO & OAPI (Africa). Paris Convention- There is no requirement of domicile. It's national treatment. The right of priority is needed. It's a well-known mark. The weakness of the Paris convention- In this nowhere defines the meaning of Trademark; don't require any protection related to service mark.

TRIPS Agreement- Some minimum standards are set. It is also a well-known mark. It's proposed for use within three years. The renewal period is seven years.



Community Trademark European- There is one registration for all European Countries. There must be use in 1 country sufficient. It's a cost advantage.

OAPI- Its office is situated in Yaound, Cameroon. In Western Africa sixteen French-speaking countries. The registration is valid in all other countries. National law allows opposition, infringement, cancellation. Members are the Central African Republic, the niger, etc.

ARPIO- Its office is situated in Harare, Zimbabwe. A single application will be designated in countries. The application has been reviewed in twelve months by designated countries. The same national law applied opposition, infringement as well as cancelation, and so on.

Different kinds of protection strategy

Classes- There is a multi-application to file in classes. Related to goods and services can file into it. Various owners can file into relevant classes. Like for eg. The trademark must be registered in _____ classes.

Route- There are many different routes like regional, national, international, and filing strategies.

Budget- It includes Size, time, allocation as well as increase.

Average cost- the United States of America in which the filing fee is nearby 900 Dollars and the registration fee is nearby 1,500 dollars. As per Europe in which filing fees are nearby 1,700 Euros and the registration fee is nearby 2,400 Euros. For the protection of its mark, a company wishes to file in

Switzerland, France, UK, Germany, and Italy.

Enforceability- It related mark, region, timeline, and in addition to country.

Portfolio Management- It requires Protection, Maintenance, Enforcement, and in addition to online tracking and analysis.

Globally TM Registration

In developing countries around 36% of trademark registrations in the year 1996 were granted to residents. In developed countries where 80% of the trademark of a resident to tall applications is equal to many developing countries in the year 1996 like India, Brazil, Korea, China, etc. Ensuring that trademark protection is sufficient by the mid-1990s a developing had an interest.

The CTM System

In 1996 the CTM registration system through which it was created and protects almost twenty-seven states members for a trademark in the EU. Any new member on state upon accession in which it automatically extended for CTM registration and application. The entire member states of the Paris Convention are allowed to the CTM system is available to the resident, which involves every country in the world. Including the US, it is a unique filing opportunity for individuals as well as to companies of most countries. Once it is granted, it is available for ten years and it can be renewed for successive ten years period. If it is invalid due to some reason or revoked then the owner can apply/ converted it into a national application in the member state where the third person or earlier person objections or rights can't apply, while retaining the filing date in this view.

One of the members can be applied directly to OHIM or national trademark offices where



this application is made in a form that can be submitted either of them. There are only 5 languages that are applied to OHIM that are for cancellation proceedings or opposition (French, Spanish, English, Italian, or German).

It involves cost-saving and easier the registration process. Quickly assess the availability of a trademark in Europe.

An internationally effective trademark there is no such things- Access to a large number of regions while the Madrid system requires conducive in which you can enjoy every protection there is no proper structure that can require a genuine international trademark.

Through WIPO no one doesn't apply- A party to a Madrid Agreement only if that person is applying from a country, it must be submitted through a national office and be based on a finalized registration. The handwritten application will not be accepted while a person can be applied for that application to be submitted.

International Application

Through PRV a people can file for Trademark for international registration. A person needs a Swedish trademark with PRV to do it. The person filed International registrations which are part of the Madrid protocol. The person applied for an international registration through which they are having a Swedish trademark registration or an application. After applying the form of an application and send it to the PRV (MM2 form). Afterward, examine the application for the formal need to be done. If there is any missing or incorrect in the application then it sends for office action. It will send it for the correction and it will not come back on a

prescribed time then it must be canceled. If it is correct then it will forward to the authority WIPO of the intellectual property rights.

If it is agreed to accept the registration will apply to the Swedish base for 5 years. If there is any alteration or canceled in the Swedish base in 5 years then it will also be altered or canceled in the international registration.

International application PRV charges a fee for the examination. It involves one class goods or services the basic fee is 2700 SEK. For the additional class, the fee is 1000 SEK. Origin office: Sweden, Class number: it involves application; determine the countries where the people want to designate determine the guarantee and certification mark, collective or color mark.

Registration Process

IP Office (office of origin) through national or regional- if anyone wants to register he/she has to apply for that the person has to be registered already or applied an application in the IP Office of home. The basic mark is known through its registration or an application. It will be certified and send it to the office of WIPO to get registered through sending it to the international application wound up by the same office.

A formal examination is done by WIPO- For international application, a formal examination is only conducted by WIPO. In the International register, it will be recorded and then afterward published in the WIPO Gazette of International mark. Wherever that person wants to publish in all of the territories which notify the IP Offices to protect the mark after sent an application for a certificate into international registration through WIPO.



Substantive examination through IP offices of national or regional- An application time limit within (twelve to eighteen months) the IP offices of that territory where a person can protect his/her mark as prescribed by their legislation. In the international register, WIPO will record that decision. Its mark is valid for ten years. It can be renewed after the end of each ten years of the period time.

Why people register TM internationally- From other businesses a TM is owned to differentiate between people's goods and services. As we all known business has its symbol to get register in the market for their safety purpose. It may associate with a brand. Anyone can protect his/her brand by getting it registered. Till that country, a TM registration has been limited only to that country apply. For that protection of trademark, the person has to register into other countries also independently. It can only be possible to get registered into a different country by agreeing with their rules and regulations as well as the country's law. An application may be made independently to each country if that person wants to register his/her business worldwide.

International TM registration Benefits

Over eighty percent of international trade will be a part of the global market by applying or registering its trademark in the Madrid system. It can be easily available to the customer of global if its business runs globally through the internet. A brand can be smoothly arranged by a centralized system by applying his/her brand internationally by the way of the Madrid System and it can easily take place into new areas of the market as worldwide. Protected in multiple countries by a single application filed in 1 language and pay as per prescribed rules of it and get

applied as a trademark. It is convenient also through changes and renewal. Internationally the way of protection must be cost-effective as well as convenient. To save time applies only a single application. Within eighteen to twenty months a TM can be registered if there is no objection raised. From the date of registration, it can be valid for up to ten years. There will be easily affordable to get any kind of changes and renewal is required anytime. By submitting a simple application to WIPO where people get done from renewal. For ten years it can be renewed several times there is no limit prescribed. Against infringing parties or anyone interfering with it, people can take any action to stop it by the way of legal help. Many multiple modes can be used for an International TM such as Licensing Agreement, sales contract, etc.

Rule - There are some regions where rules are strict and didn't apply where else registration period of renewal 10 years. The renewal period will be done after the five years of registration in the country of the US. While EUIPO requires a unitary system that provides the protected rights upon registration and renewal in all member states but at the same time, it can't be provided for the Madrid system.

International trademark registration

Date of the international registration- International application was got by the Indian TM Registry when international registration will bear that on it.

International registration effects- Protection in each of the designated contracting parties from the date of international registration got, as people mark has been filed directly in the DCP. It may be refused by the DCP for the mark. It will allow for appeal or review which



lay on prescribed law and practice concerned by the DCP. It will be valid for ten years if DCP has not refused that application and after ten years it can be a renewal for ten years further.

To the new territories of the country where extending the protection of the mark reaches. The extension has its effect only to some of the members of the Madrid system after if the holder of an international registration wants to. It may be transmitted to WIPO by mail, by electronic means as well and the subsequent designation must be presented in an official form. There is a basic fee payable according to a subsequent designation (300 CHF). For individual fees, it has been fixed by DCP and a complementary fee is (100 CHF).

The international registrations where the people request the recording to alter the holder's name and address (without changing the ownership). There are no fees payable if any people want to change the email id, phone number, or address for correspondence from the record. For this representative can use from the MM10.

The dependency period is for five years; in India, the international registration will remain dependent upon the basic mark. For the goods or services, the international registration will be canceled accordingly as a whole or apart. The international registration will become independent for a person's basic mark after the completion of the dependency period and it ceases to have any effect then it can't be canceled as longer.

It can be effortless for a person to track and manage the IR through WIPO action of various online tools and services, besides, to keep eye on competitors.

International Registration Effects

The registration got registered by the office of that contracting party when there is no refusal is issued or refusal informed by the contracting party is withdrawn. It is valid for ten years. With the prescribed fees it can be renewed for a further ten years. Regarding all goods or services where they are limited protection provided but with some of the designated contracting parties.

Trademark protection in the country European Union

Specific requirement- At the IP India website a people can file an international application online. In the form of MM4 has been designated presented in WIPO, once people have obtained an International Registration by way of either through-line or by mail. Professional representation before the EUIPO – appoint a representative for filing a seniority claim directly to it. Examine all the grounds of absolute for refusing similarly as directed to EUTM applications.

For TM Registration in an EU country then how much long time it would take- It takes four to five months for the EU TM registration whether it has been gone through the procedure of fast track or not. This procedure applies where it has already been received by the EUIPO which the goods or services from a database of terms. If the payment is completely paid then only the examiner will examine the application. If anyone opposed during the registration process when the time of registration also dependent.

The process of registration

The first stage is applied to apply then it comes to application examination within two



to six weeks afterward the application got published then opposition against the application would become up within three months after that trademark is registered if there would be no opposition were raised. That trademark will be registered for 10 years and after the end of 10 years, it can be renewed afterward.

Cost of International TM Registration

It differs from place to place the International TM Registration Cost. It can be claimed through the Madrid protocol in other countries due to the priority of application in India. The type of search, how the people go through the registration will differ for applying International TM Registration cost. The people have to register his TM in those other countries where they want to sell and market internationally according to his plan and all. It is a very major key principle before considering registration that people need to understand the regulations of the trademark in each of the countries.

We all know trademark registration as well as prosecution both, is territorial so, the registration cost will differ from one country to that other country. I explain to you with the help of example Fees in UAE vary from the fee in Omar. The brand owners feel the higher cost of his business in comparison to their local business because they are involved in multiple governances due to much they face most certainly that thing with just one product.

For Trademark filing and registration in all those OHIM, ARIPO, and OAPI member countries where only these agencies like OHIM, ARIPO, and OAPI in which they accept single application also as well as single fees for doing it registered. It can be

maintained upon a timely registration renewal in addition to payment for renewal fees for every ten years.

Madrid System

The mark is protected through the application which nominates one or more than one contracting party. It may be only used by a legal entity or natural person. Art 4 of the Paris Convention which provides to enjoy the right of priority of Madrid registration. The following language such as English, Spanish, or French in these languages where an applicant can apply (single) by paying prescribed a single set of fees.

Conclusion

Madrid system may not be the Indian trademark owners are not going to the usage for the management for their trademark portfolio. International Registration TM has some special provisions integrated by the new chapter through Trademark Amendment Bill which was introduced in 2007 under the Madrid Protocol. In the Lok Sabha, this bill was introduced.

References:-

<https://www.stopfakes.gov/article?id=Does-a-U-S-Trademark-Registration-Protect-a-Trademark-in-a-Foreign-Country>
<https://www.wellsiplaw.com/what-is-an-international-registration-for-a-trademark/>
<https://www.slideshare.net/Brainleague/trademarks-presentation-on-international-trademark-protection-and-management>
<https://slideplayer.com/slide/4097982/>
<https://www.kilpatricktownsend.com/~medi a/Files/articles/2013/International%20Trade%20mark%20Protection%2095056643%203.ashx>



<https://patentbusinesslawyer.com/international-trademark-filing-in-india-the-madrid-protocol-trademark-registration-in-india/>
https://www.wipo.int/madrid/en/how_madrid_works.html
<https://www.legalraasta.com/international-trademark-registration/>
http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_93_1_THE_MADRID_PROTOCOL.pdf
<https://iproackers.com/kb-article/how-long-does-it-take-to-register-a-trademark-in-eu/>
<http://www.patentsntrademarks.com/international-trademark-registration/international-trademark-registration-cost/>
<https://www.prv.se/en/trademarks/applying-for-a-trademark/international-protection/international-application/>
<https://www.altacit.com/publication/madrid-system-and-indian-trade-mark-owners/>

