

Overseas Trade Mark Protection

International trade has grown substantially in size and importance, not least due to the explosion of e-commerce and budget airline fares. Trade marks have become even more valuable assets for expanding companies seeking recognition and reputation in overseas markets. Consequently, the protection of trade marks overseas through registration is strongly recommended to any United Kingdom individual or company planning to trade in its goods or services abroad.

UK traders seeking overseas trade mark protection can file separate applications in each desired country. This can be expensive. However, two international systems – the Community Trade Mark and the International Registration system ('Madrid Protocol') – are available, and these often provide UK traders with much more cost-effective ways of obtaining multi-country protection.

The Community Trade Mark

A Community Trade Mark (CTM) registration is obtained from OHIM (the Office for Harmonisation in the Internal Market, based in Alicante, Spain) and is a unitary right which covers all member states of the European Union. A CTM application can be filed either at OHIM or via a national trade mark office, and it can include as many classes of goods/services as desired. Multiple application fees, translation costs and overseas attorney fees are avoided since it is a single application centrally examined by a body having English as one of its working languages.

Once filed, the CTM application is examined by OHIM to ensure that it satisfies certain official requirements, including whether the mark is sufficiently distinctive (original) for registration. OHIM then carries out a search for conflicting earlier CTMs, the results of which are sent to the Applicant. The owners of any CTMs identified in the search are also notified of the publication of the later application. OHIM does not have the power to refuse CTM applications because of the existence of an earlier identical or similar mark, unless the owner of any such mark successfully opposes the later application.

After the application is published, owners of earlier marks have three months in which to file an opposition if they consider the mark in question to be confusingly similar to their own. If no opposition is filed, or an opposition is successfully overcome, the CTM will proceed to registration, so providing the owner with trade mark protection throughout the EU for a period of ten years, renewable indefinitely for further ten year periods.

The Madrid Protocol

UK traders looking to register their trade marks on a wider scale than that offered by the CTM route (or outside the EU) can do so through the Madrid Protocol. This is an agreement, to which the UK is a signatory, which allows any individual or company based in one member country to obtain trade mark protection in any or all of the other member countries via an 'International Registration'. There are currently at least 90 countries signed up to the Madrid Protocol, including most European countries, the EU itself, the US, China, Japan, South Korea, India and Australia.



At any time after a UK or CTM application has been filed, the applicant may apply to the World Intellectual Property Organisation (WIPO) in Geneva for an International Registration of that same mark in relation to the same (or narrower) goods or services. The UK or CTM application/registration becomes the 'basic' application/registration for the purposes of the International Registration. The International application may designate as many of the Madrid Protocol member countries as required, and additional countries may also be designated at any time after filing. Once the application has been allocated a registration number, WIPO sends copies of the application to the trade mark registries of all the designated countries. Each country then carries out its own examination of the mark in accordance with its national trade mark laws.

If one country refuses to grant protection, it does not adversely affect the outcome of the application in other countries. The International Registration remains effective in the countries that accept it, so long as the 'basic' UK/CTM application/registration for the mark remains in force for a concurrent minimum period of 5 years.

Since the system is administered by one central body (WIPO), the Madrid Protocol provides a very cost-effective, efficient way to obtain trade mark protection in a range of countries.

Other options

Overseas trade mark protection for UK traders planning to expand into one or two countries only, or into countries that have not yet signed up to the Madrid Protocol, can be obtained via individual national applications. Trade mark laws, examination procedures and registration costs vary from country to country; we would be happy to advise you further in relation to any specific countries of interest.

Further advice

The Trade Mark Group at Dehns has wide experience of obtaining overseas trade mark protection, and has built up strong commercial relations with trade mark attorneys in all parts of the world. If you would like any further advice regarding the protection of your trade marks overseas, please contact us using the details below.

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