

# WIPO application timeline and information sheet

## Filing of national trade mark application

An International Application can be filed at any time but must be based on an existing trade mark application or registration in the applicant's home territory (or a territory where the applicant has a real and effective commercial or industrial establishment). The home territory must be a member state of the Madrid Protocol.

## Preparation of international trade mark application

We will discuss which designations to include in the application. We will assess whether an earlier effective filing date may be claimed by claiming priority.

## INTERNATIONAL PHASE

### Filing of international trade mark application

Once the designations to be covered are confirmed, we will file the application via the relevant home trade mark registry.

### Application certified by national office

Once the home trade mark registry has certified the application, it will forward the application to WIPO.

### Examination

WIPO will review the application and will either accept it or issue an irregularity notice.

### Irregularity notice issued

WIPO may raise formalities objections against the application.

### Respond

We will draft and submit a response via the home registry.

### International Registration granted

If accepted, WIPO will issue a Certificate of Registration and the registration will be published in the International Gazette. This does not confer any protection of the mark.

If the irregularities are not overcome, the application will be refused/partially refused

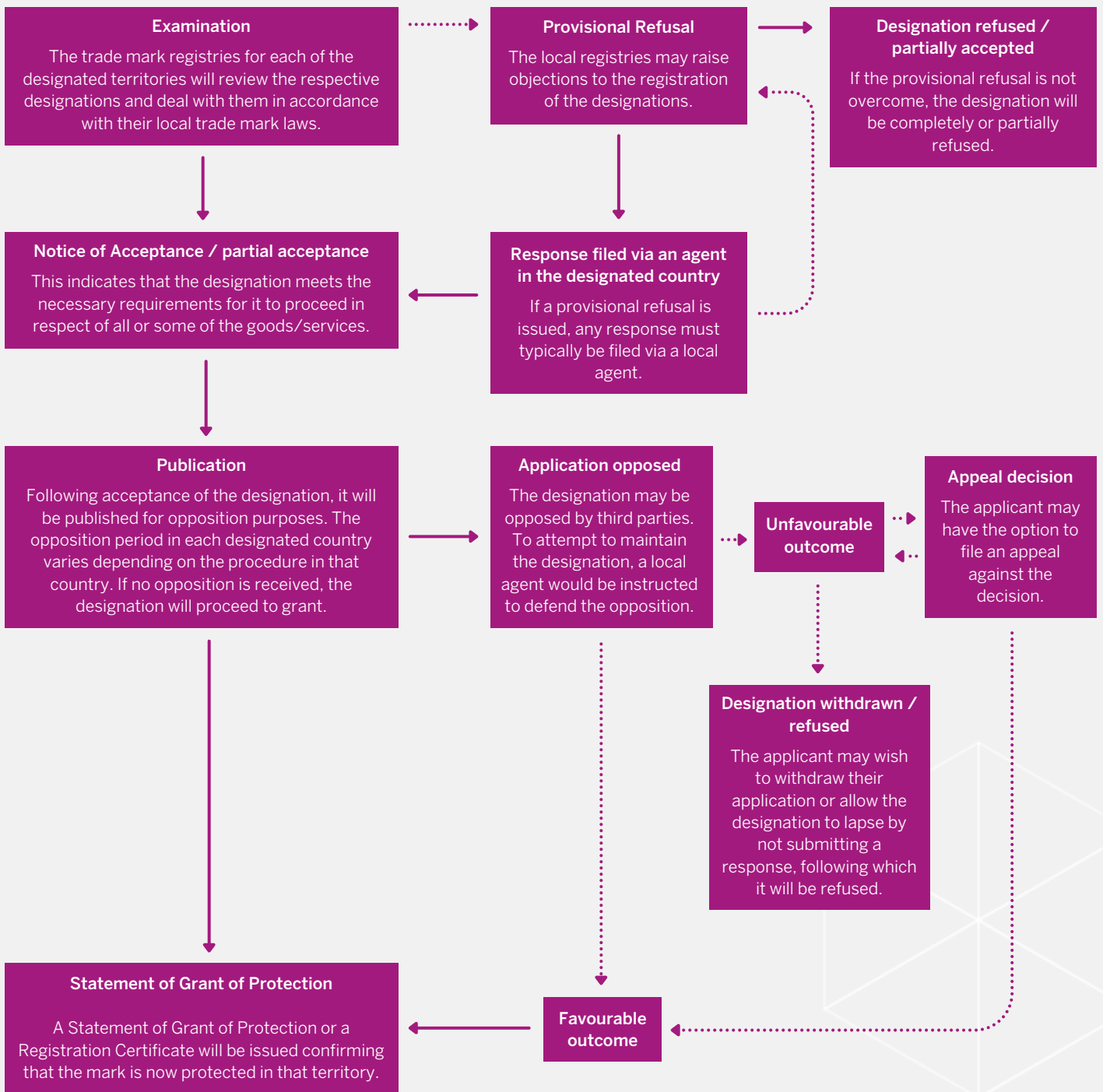
### Subsequent designations

It is possible to expand the geographical scope of protection by designating additional countries in the existing international registration. This requires the filing of a subsequent designation application and can only be done once the Certificate of Registration has been issued.

### Designated Countries

WIPO sends the application to the IP offices of the designated territories.

**NATIONAL PHASE – EQUIVALENT EXAMINATION/OPPOSITION PROCEDURES TO NATIONAL APPLICATIONS**



## Advantages

- **Simplified process:** The Madrid System allows for the filing of trade mark applications in multiple countries through a single process, streamlining the administrative process.
- **Cost effective:** Local agents would only be required, and legalised and/or notarised supporting documents would only need to be submitted, if a provisional refusal or opposition is encountered.
- **Management of the trade mark:** Any changes to the trade mark, such as updating owner details, ownership of the mark, or recording licences can be recorded centrally via WIPO.
- **Wide geographic scope:** The Madrid system covers a large number of countries that are party to the Madrid Protocol, allowing for broad international protection (depending on the number of countries designated).
- **Renewals:** Trade mark renewals can be managed centrally via WIPO, simplifying the process of maintaining your trade mark registrations, as well as reducing the cost.
- **Adding countries:** If the geographic protection of a mark is to be expanded, additional countries may be designated by filing subsequent designations.

## Disadvantages

- **Limited to Member Countries:** The Madrid system only applies to countries that are party to the Madrid Protocol, so protection is not available in all countries.
- **Dependency on base application:** The international registration relies on a 'base' application/registration for five years. If the base application/registration is refused or cancelled during this period, the international application ceases to be effective. Nevertheless, it is possible to transform designations to national applications, preserving the priority date, although this would incur further costs.
- **National laws still applicable:** While the Madrid system streamlines the administrative process, trade mark protection is still subject to each territory's national laws, regulations and procedures. Each designated territory's trade mark office conducts its own examination of the application, which can lead to inconsistent outcomes and varied protection for each designation covered. However, this would also be true of applications filed at the relevant local registries.
- **Owner's nationality or domicile:** An international application/registration may only be owned by entities which are nationals of, or domiciled in, or that have a real and effective industrial or commercial establishment in, a country or territory which is a party to the Madrid Protocol.