

**SOUTH-EAST ASIA
IPR SME HELPDESK**

**CHINA IPR
SME HELPDESK**

**LATIN AMERICA
IPR SME HELPDESK**

How to internationally protect your trade mark through the Madrid system?



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1. The importance of trade mark protection

a) What is protectable as a trade mark?

A trade mark is a sign that is capable of distinguishing the goods or services of one undertaking from those of others.

In general, it is possible to distinguish several trade mark categories:

- **word marks** consist exclusively of words, letters, numerals and other standard typographic characters;
- **figurative marks** consist exclusively of figurative elements;
- **figurative marks containing word elements** are signs with a combination of verbal and figurative elements;
- **shape marks** consist of a three-dimensional shape;
- **shape marks containing word elements** are shape marks containing verbal elements;
- **position marks** protect the specific way in which the mark is placed on or affixed to the product;
- **pattern marks** are signs where a set of elements are regularly repeated.

Some trade mark systems grant protection to 'non-traditional' trade marks. This special category includes marks that differ from the usual concepts (i.e. words, designs, logos, letters or combination of letters), such as (i) colours, (ii) motions, (iii) sounds, (iv) scents and (v) holograms.

Although non-traditional marks exist across the world, not all countries allow them to be registered. For example, sounds are registrable as marks in Mainland China, Brunei, Indonesia, Malaysia, Singapore, Thailand, Argentina, Bolivia, Chile, Colombia, Costa Rica, the Dominican Republic, Ecuador, El Salvador, Guatemala, Mexico, Nicaragua, Panama, Paraguay, Peru, Uruguay and Venezuela. Scents are protected in Malaysia, Singapore, Argentina, Bolivia, Colombia, the Dominican Republic, Ecuador, El Salvador, Guatemala, Mexico, Nicaragua, Panama and Peru. In Argentina, Malaysia and Singapore, it is also possible to register motions as trade marks. Holograms can be registered as trade marks in Indonesia, Malaysia, Singapore and Vietnam.



The lack of widespread standards and uniform criteria for their protection and representation, the difficulty in solving conflicts between such signs, and the lack of technological tools for the correct registration of the same, make the protection of non-traditional marks particularly difficult.

b) Why should you protect your trade mark?

The registration of a trade mark endows its owner with several benefits.

First of all, trade marks are property assets that can be bought, sold and licensed. Therefore, trade mark protection enables companies to access new markets through licensing, franchising and other contractual arrangements developing overseas manufacturing, marketing and distribution. It also allows co-branding and sponsorship agreements (through which the owner can extend its business and enhance its market power) to be built.

In the light of this, it makes strategic sense for companies to significantly invest in their intellectual property (IP). Legal protection (in terms of registered trade marks) is a fundamental part of defining rights: in many countries, only a registered trade mark grants its owner the right to stop others from using identical or similar marks. In the absence of legal protection, all marketing and commercial efforts can easily be frustrated as third parties can't be prevented from using an identical and/or confusingly similar trade mark for identical and/or similar products. In other words, a registered trade mark allows its owner to protect their brand reputation and defend their IP rights (IPR) against unauthorised use.

c) How to check trade mark availability

Before filing a trade mark application, carrying out searches to check if identical or similar marks are already registered in the market of interest is highly recommended.

Such activities are essential to avoid refusals issued by the IP offices of the countries in which protection is sought. Prior availability searches are also essential to reduce the risk of conflicts with third party owners of prior rights (administrative opposition proceedings or legal actions) and to avoid the related litigation costs.

The World Intellectual Property Organization (WIPO) and national/regional IP offices make databases available to applicants wishing to check the availability of trade marks. WIPO's Global Brand Database (<https://www3.wipo.int/branddb/en/>) is an aggregate search portal; it enables applicants to search for trade marks previously registered under the Madrid system and it also includes many national trade marks. However, it does not include national trade marks filed directly with some of the contracting parties. For this reason, searching the online databases of national/regional IP offices is also recommended.

Other aggregate search portals are TMview (<https://www.tmdn.org/>) and ASEAN TMview (<http://www.asean-tmview.org>).

TMview includes trade mark registrations and applications filed in many IP office across the world, including in Argentina, Brazil, Chile, Colombia, Costa Rica, Cuba, Mexico, Peru and Uruguay in Latin America (LA) and Brunei, Cambodia, Laos, Malaysia, the Philippines and Thailand in South-East Asia (SEA).

At the same time, ASEAN TMview is an online database of trade mark registrations and applications filed in participating SEA countries (except Myanmar).

The box opposite details the national IP office databases available online.

As the free online tools may not be complete, engaging a local agent to conduct trade mark searches is always advisable.



COUNTRY	WEBLINK
MAINLAND CHINA	https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/Guide%20to%20Trade%20Mark%20Protection%20in%20China.pdf Languages: Chinese, English
HONG KONG	https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/hong_kong_factsheet.pdf Languages: Chinese, English
MACAO	https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/macao_factsheet.pdf Languages: Chinese, English, Portuguese
TAIWAN	https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/Taiwan_online.pdf Languages: Chinese, English
SEA COUNTRIES	
BRUNEI DARUSSALAM	http://ipsearch.bruipo.gov.bn/ Languages: English, French, Bahasa Melayu
CAMBODIA	http://www.cambodiaip.gov.kh/SearchMark.aspx Languages: English, Khmer
INDONESIA	http://e-statuski.dgip.go.id/ Language: Indonesian
LAOS	Not available directly from IP office website https://www3.wipo.int/branddb/la/en/ Language: English
MALAYSIA	https://iponlineext.myipo.gov.my/SPHI/Extra/IP/TM/Qbe.aspx?sid=637026118052833457 Language: English
MYANMAR	Not available
SINGAPORE	https://www.ip2.sg/RPS/WP/CM/SearchSimple/IP.aspx?SearchCategory=TM Language: English
THAILAND	http://www.ipthailand.go.th Language: Thai
THE PHILIPPINES	https://www3.wipo.int/branddb/ph/en/ Language: English
VIETNAM	http://iplib.noip.gov.vn/ Languages: Vietnamese, English
LA COUNTRIES	
ARGENTINA	https://portaltramites.inpi.gob.ar/marcasconsultas/busqueda Language: Spanish
BOLIVIA	Trade mark search available upon application and payment https://www.senapi.gob.bo/propiedad-intelectual/propiedad-industrial/signos-distintivos Language: Spanish
BRAZIL	https://gru.inpi.gov.br/pePI/jsp/marcas/Pesquisa_num_processo.jsp Language: Portuguese
CHILE	https://ion.inapi.cl/Marca/BuscarMarca.aspx Language: Spanish
COLOMBIA	https://sipi.sic.gov.co/sipi/Extra/IP/TM/Qbe.aspx?sid=637220909813506962 Languages: English, Spanish
COSTA RICA	Search available upon registration http://www.rnpdigital.com/propiedad_industrial/index.htm Language: Spanish
CUBA	http://wiposearch.ocpi.cu/wopublish-search/public/trademarks?1&query=*.: Languages: Spanish, English, French, Arabic, Chinese
DOMINICAN REPUBLIC	https://www.onapi.gov.do/index.php/busqueda-de-signos-nombres-y-marcas Language: Spanish
ECUADOR	There is no public trade mark database, it is possible to request a search at the IP office upon payment https://www.derechosintelectuales.gob.ec/signos-distintivos/
EL SALVADOR	There is no public trade mark database, searches can be made upon payment and registration with the National Registration Centre https://www.e.cnr.gob.sv/ServiciosOL/portada/rpi.htm
GUATEMALA	There is no public trade mark database, searches can be made upon registration and payment http://rpi.gob.gt/publico/#/login
HONDURAS	Searches can be made available upon application https://digepih.webs.com/marcasformularios.htm Language: Spanish
MEXICO	https://marcanet.impi.gob.mx:8181/marcanet/ Language: Spanish
NICARAGUA	There is no public trade mark database, it is possible to request a search at the IP office upon payment https://www.mific.gob.ni/Propiedad-Intelectual/Signos-Distintivos Language: Spanish
PANAMA	http://consulta.digerpi.gob.pa/Marcas/Disponibles Language: Spanish
PARAGUAY	https://servicios.dinapi.gov.py/expediente/expediente_agente.php Language: Spanish
PERU	https://enlinea.indecopi.gob.pe/buscatumarca/#/inicio Language: Spanish
URUGUAY	https://rad.miem.gub.uy/pamp/mark/index Language: Spanish
VENEZUELA	Search available upon registration and payment http://webpi.sapi.gob.ve/index0.php Language: Spanish

d) Brief overview of trade mark protection systems in China, SEA and LA*

COUNTRY	TIME FOR THE REGISTRATION	COSTS**	EXPIRATION DATE	MORE INFORMATION ABOUT NATIONAL SYSTEMS
MAINLAND CHINA	9 months	EUR 40 per class, for up to 10 goods/services + EUR 5 per additional item	10 years from the date of registration; the registration is indefinitely renewable for periods of 10 years	Please see the following China IPR SME Helpdesk Guide: <i>Guide to Trade Mark Protection in China</i> https://www.china-iprhelpdesk.eu/sites/all/docs/publications/EN_TM_2016.pdf
HONG KONG	6–9 months	EUR 237 per class + EUR 119 per additional class	10 years, renewable for 10 year periods indefinitely	IP Factsheet: Hong Kong https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/hong_kong_factsheet.pdf
MACAO	6–8 months	EUR 115 per class	7 years, renewable for 7 year periods indefinitely	IP Factsheet Macao https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/macao_factsheet.pdf
TAIWAN	8–12 months	Filing and registration fees: EUR 170 per class (up to 20 items) + EUR 6 per additional item	10 years, renewable for 10 year periods indefinitely	IP Factsheet Taiwan https://www.china-iprhelpdesk.eu/sites/china-hd/files/public/Taiwan_online.pdf
SEA COUNTRIES				
BRUNEI DARUSSALAM	1–2 years	EUR 135 per class Publication: EUR 113	10 years from the date of application; the registration is indefinitely renewable for periods of 10 years	Please see the following SEA IPR SME Helpdesk Guide: <i>Guide to Trade Mark protection in South-East Asia</i> https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/sea-trademarks-ea-02-20-035-en.pdf
CAMBODIA	9 months – 1 year	EUR 36 for one mark in one class Registration and publication: EUR 60 for one mark in one class.	10 years from date of application; indefinitely renewable for periods of 10 years	
INDONESIA	24–36 months	EUR 100 per class	10 years from filing date; indefinitely renewable for periods of 10 years	
LAOS	12–15 months	EUR 115 for one class + EUR 82 for each additional class	10 years from filing date; indefinitely renewable for periods of 10 years	
MALAYSIA	12–24 months	EUR 200 per class (claiming descriptions adopted from the pre-approved list). EUR 232 per class (claiming descriptions not adopted from the pre-approved list)	10 years from the date of application; indefinitely renewable for periods of 10 years	
MYANMAR	2–4 months	Registration of the Declaration of Ownership per mark per class: EUR 33 Under the <u>new system</u> , it is expected to be: EUR 160–190 for one class + EUR 6–10 for each additional class		
SINGAPORE	6–9 months	EUR 155 for each class, using the pre-approved list of goods and services. EUR 220 for each class, not using the pre-approved list of goods and services	10 years from date of application; indefinitely renewable for periods of 10 years	

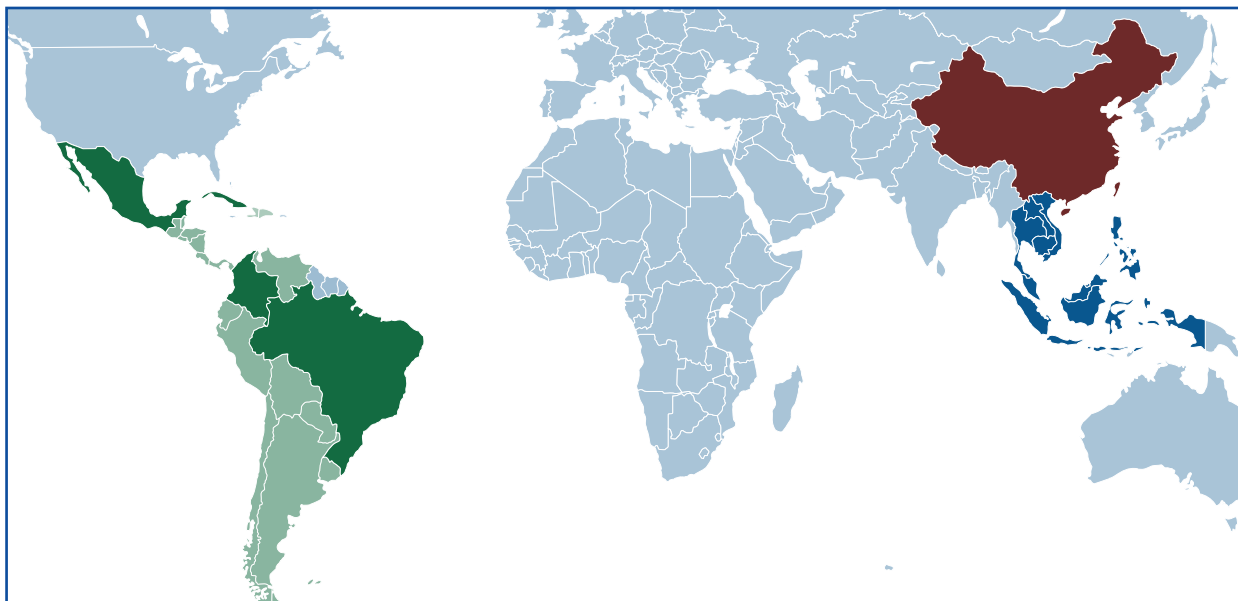
COUNTRY	TIME FOR THE REGISTRATION	COSTS**	EXPIRATION DATE	MORE INFORMATION ABOUT NATIONAL SYSTEMS
THAILAND	18–24 months	EUR 30 per item, for up to 5 items in a class; the fee for a mark with more than 5 items in a class is EUR 252 Registration fee: EUR 16 per item, for up to 5 items in a class; EUR 150 for more than 5 items in a class	10 years from date of appli- cation; indefinitely renewable for periods of 10 years	Please see the following SEA IPR SME Helpdesk Guide: <i>Guide to Trade Mark protection in South-East Asia</i> https://www.southeastasia-iprhelpdesk.eu/sites/default/files/publications/sea-trademarks-ea-02-20-035-en.pdf.pdf
THE PHILIPPINES	12–24 months	Without claim of colour and priority: Small entities: EUR 22 per class Big entities: EUR 47 per class Claim of colour additional fees: EUR 5 for small entities and EUR 10 for big entities. Fees for Allowance / Publica-tion for Opposition: Small entities, EUR 16; big entities, EUR 17 Fees for Issuance of Certifi-cate of Registration: Small entities, EUR 10; big entities, EUR 21	10 years from the date of registration; indefinitely renewable for periods of 10 years	
VIETNAM	15–18 months	Official filing fee: EUR 38 for one class for up to 6 items of goods/services; each further class in the same application is EUR 30, and each extra item of goods/services exceeding that is EUR 6 Publication fee: EUR 5 Registration fee: EUR 5	10 years from the filing date of application; indefinitely renewable for periods of 10 years.	
LA COUNTRIES				
ARGENTINA	20 months	EUR 31	10 years from the date of registration; indefinitely renewable for periods of 10 years	Please see the following LA IPR SME Helpdesk Guide: <i>Trade marks in Latin America in a Nutshell</i> https://www.latinamerica-ipr-helpdesk.eu/library/factsheet/trade-marks-latin-america-nutshell
BOLIVIA	8–10 months	EUR 130 Registration fee: EUR 66 Publication fee: EUR 33	10 years from the date of registration; indefinitely renewable for periods of 10 years	
BRAZIL	18 months	Paper applications: EUR 90 Online applications: EUR 60 or 70, depending on whether the applicant chooses to use the Nice Classification list or submits a free heading Registration fee: EUR 130	10 years from the date of grant; indefinitely renews-ble for periods of 10 years	
CHILE	4 months or 8–12 months	Application costs are calcu-lated according to the infla-tion-based Monthly Tax Unit (UTM); trade marks cost 3 UTMs, EUR 160 (as of 28 May 2020)	10 years from the date of registration; indefinitely renewable for periods of 10 years	
COLOMBIA	8–10 months	Paper applications: EUR 273 for one class + EUR 130 for each additional class Online applications: EUR 225 + EUR 112 for each addition-al class	10 years from the registra-tion; indefinitely renewable for periods of 10 years	

COUNTRY	TIME FOR THE REGISTRATION	COSTS**	EXPIRATION DATE	MORE INFORMATION ABOUT NATIONAL SYSTEMS
COSTA RICA	5–6 months	Application: EUR 46 per class Publication: EUR 90–130	10 years as from the registration; indefinitely renewable for periods of 10 years	<p>Please see the following LA IPR SME Helpdesk Guide: <i>Trade marks in Latin America in a Nutshell</i></p> <p>https://www.latinamerica-ipr-helpdesk.eu/library/factsheet/trade-marks-latin-america-nutshell</p>
CUBA	18 months	EUR 275 for 3 classes + EUR 92 for each additional class Registration fee: EUR 82 for any class	10 years from the date of application; indefinitely renewable for periods of 10 years	
DOMINICAN REPUBLIC	3 months	Application: EUR 93 + EUR 70 for each additional class Publication: EUR 40 for one class + EUR 20 for each additional class	10 years from the grant registration; indefinitely renewable for periods of 10 years	
ECUADOR	4–6 months	EUR 191 (Three-dimensional marks: EUR 922)	10 years from registration; indefinitely renewable for periods of 10 years	
EL SALVADOR	7–9 months	Application: EUR 92 per mark per class. Publication: EUR 70 (minimum charge)	10 years from the registration; indefinitely renewable for periods of 10 years	
GUATEMALA	2–3 months	EUR 37	10 years from the date of registration; indefinitely renewable for periods of 10 years	
HONDURAS	8–12 months	Application: EUR 1.90 Registration: EUR 26 Publication: EUR 163	10 years from the date of registration; indefinitely renewable for periods of 10 years	
MEXICO	8–10 months	EUR 120	10 years from filing date; indefinitely renewable for periods of 10 years	
NICARAGUA	6–8 months.	EUR 136 for a word or design trade mark (per class) + EUR 46 for each additional class	10 years from the date of registration; indefinitely renewable for periods of 10 years	
PANAMA	3–6 months	EUR 110 (including registration and publication fees)	10 years from date of application; indefinitely renewable for periods of 10 years	
PARAGUAY	8–10 months	EUR 25	10 years from the date of registration; indefinitely renewable for periods of 10 years	
PERU	5–6 months	EUR 156 per class	10 years from the date of registration; indefinitely renewable for periods of 10 years	
URUGUAY	18–24 months	Word mark: EUR 100 + EUR 61 for each additional class Combined/design mark: EUR 140 + EUR 80 for each additional class	10 years from the date of registration; indefinitely renewable for periods of 10 years	
VENEZUELA	8–12 months	EUR 70	15 years from the date of registration; indefinitely renewable for periods of 15 years	

* This table refers to trade mark applications filed directly through national IP offices.

** The costs provided are related to the local registration fees and do not apply to Madrid system applications, but they are presented as a comparison. Such costs include the official fees in a smoothly proceeding case, they exclude the legal fees incurred when the appointment of a trade mark attorney is required. More costs can be incurred, for example, for translations, stamps and attorney fees.

2. How to manage your trade mark portfolio through the Madrid system



a) What is the Madrid system?

The 'Madrid system for the international registration of trade marks' is a cost-effective solution for registering trade marks worldwide. It is governed by two treaties:

- the Madrid Agreement Concerning the International Registration of Marks — concluded in 1891 and revised in Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979;
- the Protocol Relating to the Madrid Agreement, concluded in 1989, which aims at making the Madrid system more flexible and compatible with the domestic legislation of certain countries or intergovernmental organisations that have not been able to enter the Agreement¹.

The contracting parties to the Madrid Agreement and Protocol constitute the **Madrid Union**, i.e. a Special Union under the Paris Convention for the Protection of Industrial Property².

Any country which is party to the Paris Convention may become party to the Madrid Agreement or Protocol by depositing an instrument of accession.

A list of members of the Madrid Union (122 countries as of April 2020) is available at https://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

The system is administered by the International Bureau of the WIPO and allows trade mark owners to protect their marks in several countries by filing one application and obtaining an international registration that takes effect in each of the designated contracting parties. The Madrid system also allows Subsequent Designations to be made, and new territories to be added to an international registration that has already been granted. The system cannot be used to protect a trade mark in countries/regions that are not the members of the Madrid Union.

b) How does the Madrid system work?



¹ https://www.wipo.int/treaties/en/registration/madrid/summary_madrid_marks.html

² https://www.wipo.int/edocs/lexdocs/treaties/en/madrid-gp/trt_madrid_gp_001en.pdf

The process can be divided into the following main steps:

1. Application filing through a national or regional IP office (Office of Origin)

The applicant needs to have already registered the mark, or have filed an application, with the IP Office of Origin. This registered mark or application is known as the 'basic mark'. The international application must be submitted through the IP Office of Origin, which will certify it, and forward it to the WIPO.

The applicant should classify the list of goods and services in accordance with the International Classification of Goods and Services established by the Nice Agreement (1957) and according to the classification of the basic mark. However, the applicant should bear in mind the sub-classification of goods and services applicable in the countries in which protection is sought.

2. Formal examination of the international application by the WIPO

Once the international application has been submitted, the WIPO conducts a formal examination to verify that it complies with the requirements of the Madrid Agreement and Protocol, and their common regulations.

In the absence of formal irregularities, the WIPO registers the mark in the International Register and publishes the international registration in the WIPO Gazette of International Marks. Then the WIPO sends the applicant a certificate of the international registration and notifies the IP offices of the designated contracting parties.

3. Substantive examination by the IP office of the designated contracting party and final decision

The IP offices of the designated contracting parties proceed with the substantial examination of the international registration according to the applicable national legislation and issue a decision within the applicable time limit (12 or 18 months from the date of notification by the WIPO).

The designated IP office can provisionally refuse, totally or partially, the protection of the mark due to nonconformity with national laws or on account of existing prior rights of third parties. A refusal must indicate the grounds on which it is based, and does not affect the protection granted by the other contracting parties. The statement of refusal is communicated to the applicant by the WIPO.

The applicant can reply to the provisional refusal and this procedure is completely carried out by the competent IP office of the contracting party concerned. If the applicant overcomes the grounds of refusal, the IP office concerned issues a statement granting the registration; otherwise, it definitively refuses the protection of the mark in the country concerned. The International Bureau are informed about the final decision, which is published, and the applicant is notified.

If there is no refusal within the applicable time limit, the protection of the trade mark in each designated contracting party is granted and the international trade

mark has the same protection as a national trade mark in each country.

It is important to bear in mind that, for a period of five years from the date of the registration, an international registration remains dependent on the basic mark. Consequently, if within the five-year period the basic mark is revoked due to a decision of the Office of Origin or a court decision, or due to a voluntary cancellation or non-renewal, the international registration is no longer protected.

The system grants 10 years' protection from the filing date with the WIPO; this is indefinitely renewable directly through the WIPO with the payment of the required fees.

The costs of an international application can be easily estimated through the WIPO Madrid Fee Calculator (<https://www.wipo.int/madrid/feescalculator/>).

In general, the filing of an international application is subject to the payment of: i) a basic fee; ii) a 'complementary fee' or 'individual fee' for each designated contracting party; iii) a supplementary fee for additional classes of goods and services (where required).

Some contracting parties require the payment of a 'second part fee' after the registration of the trade mark in the country (such as Brazil and Cuba).

All the payments must be made in Swiss francs and it is possible to pay using the Current Account at the WIPO, or by credit card, bank transfer or postal transfer.

c) Advantages of the Madrid system

The main advantage of the Madrid system is the centralised filing: it allows a single application to be filed with WIPO in one language (English, French or Spanish) through the payment of one set of fees (in Swiss francs), rather than filing different applications in each country where protection is sought, in compliance with the respective national procedural rules.

The system is also cost-effective: the trade mark owner can avoid all the translation- and exchange-related expenses occasioned by compliance with the different national and regional procedures that are conducted in various languages and require fees to be paid in different currencies. In addition, the single procedure ensures one deadline for all the designated countries.

Once the international registration has been granted, additional advantages arise from the Madrid system: it is possible to record a change of name or address through one application, which can be extended to all the designated countries; a single renewal date and application will be effective in all the designated countries.

There are also advantages for national IP offices: they do not need to carry out a formal examination, take care of the goods and services' classification or publish the mark.



d) Disadvantages of the Madrid system

An international registration can only include the classes of goods and services claimed in the basic mark. In some places, such as Mainland China and Thailand, there is a sub-classification system in effect and international registration applications are often provisionally refused due to nonconformity with the list of goods and services. This aspect can make the registration process longer than usual.

The Madrid system can be a good choice if the identification of goods and services for which protection is sought is brief and uncomplicated, as it is unlikely to encounter any issues when it's extended into other jurisdictions. However, when the identification of goods and services is more detailed and complicated, the Madrid system may not be the best option. If there are issues at a designated office, registration through the Madrid system can become costly and complicated. For example, when a national IP office provisionally refuses an application or requests clarifications, the applicant needs to appoint a local trade mark agent/attorney to handle the case. This often results in additional costs and requires a local

agent/attorney to reply to the office within the time limit (in some cases this is very short).

When opting for an international registration, the applicant should be aware of local issues (such as administrative problems in Indonesia and inconsistency in Thailand) that could affect the protection of the mark.

For all these reasons, it is important to carefully develop an international filing strategy and discuss it in advance with legal counsel in the EU and the relevant foreign counsels to achieve the best global trade mark portfolio strategy.

Another disadvantage is that it may take a long time for the owner to gain an overview of the status of the international registration as the relevant IP offices have from 12 to 18 months to issue a decision.

A final consideration: if, within five years of the international registration, the basic mark is amended or revoked in the country of origin due to prior third-party rights, or following a declaration of invalidity, or an office action, the international registration will also be amended or cancelled.

3. SME case studies

Case study 1:

International application in more than 40 countries based on an EU trade mark application

Background

A European company filed an European trade mark (EUTM) application in five classes, claiming many products and services and, at the same time, filed an international application with the WIPO designating more than 40 countries (including Mainland China, Cuba, Singapore, the Philippines, Mexico and Vietnam).

A prior availability search was carried out that outlined potentially conflicting marks but the company decided to go ahead with the filing of the EUTM and the international application.

The EUTM application was opposed by a third party. At the same time, the international application was examined by national IP offices and received many refusals due to the classification and description of goods and services not conforming with national practices or due to the existence of prior third-party rights.

Action taken

During the opposition proceedings before the European Union Intellectual Property Office (EUIPO) relating to the basic EUTM, the parties settled on a coexistence agreement and the initial EUTM classification was limited accordingly.

In the meantime, regarding the international registration, the applicant replied to the provisional refusals issued by the national IP offices (including Mainland China, the Philippines and Cuba) and overcame them by limiting the list of goods and services. Subsequently, the IP offices concerned issued statements indicating the specific goods and services for which protection of the mark was granted in their territory. With the relevant amendments to the list of goods and services, the international registration was granted in each of the designated contracting parties.

Outcome

The basic EU application was subject to a partial ceasing of effect because it was restricted and this affected the international registration (because of the five-year period of dependence).

Consequently, the cancellation of some of the goods and services of the basic mark also affected the international registration. Some of the cancelled goods and services made up the substance of the refusals issued by the national IP offices.

Therefore, the protection of the mark is now different in almost every country due to the amendments to the list of goods and services. The company could have avoided the costs incurred by the national refusals by awaiting the registration of the basic mark before filing the international application.

Lessons learnt

- Considering the outcome of the preliminary searches in order to avoid oppositions and office actions is advisable.
- Take care of the first filing, it is important to be sure that the basic mark will not change for at least five years from the international registration date.
- Wait for the registration of the basic mark before filing an international trade mark application.
- When the identification of goods and services is detailed and/or complicated, the Madrid system may not be the best option (in the light of the specific requirements and practices of some IP offices).

Case study 2:**A success story from a company that used the Madrid system****Background**

Since 1988, an Italian food company has used the Madrid system to register its marks almost everywhere in the world (including Mainland China, Cuba, Laos, Cambodia, and Vietnam). During these years, the company has implemented the protection of its trade marks by filing several Subsequent Designations with contracting parties that have joined the Madrid system.

Action taken

Filing activities are as relevant as market surveillance, and allow the company to have a registered trade mark to enforce if it detects illicit or unauthorised uses of its IP. When a potential infringement is detected, the company — through its IPR counsel — may react appropriately.

Outcome

The ownership of several international registrations, effective almost worldwide, allows the company to promptly react to illicit behaviour using a cost-effective IP strategy. Thanks to the marks protected through the Madrid system in Mainland China, for example, it was possible to stop several infringements and to oppose the registration of confusingly similar marks in this country.

Lessons learnt

- The ownership of an international registration allows companies to fight illicit behaviour and possible infringements as well as to maintain their competitive position on the market, even in those markets that are culturally and geographically distant and apparently unsafe.

**4. Take away messages**

- Start protecting your mark before entering the market: carry out preliminary searches at a worldwide level or at least in the territories of interest.
- Prepare a strategy to develop your IPR protection: identify the countries in which protection is desired, its purpose and costs. It is not necessary to file each mark in all countries at the same time: the Madrid system allows Subsequent Designations connected to an international registration that has already been granted to be made. The only way to develop a cost-effective plan is to base it on both the current and prospective business operations to be made in the foreign territories.
- Small and medium-sized enterprises (SMEs) should first discuss their international filing strategy with competent IP attorneys to decide whether to use the Madrid system filing route or the national filing route. In complex cases, IP attorneys can help to draft the application in a way that eventually results in the desired scope of protection in all designated offices.
- Take care of your first filing, even the national one: a cancellation of a basic mark within the first five years of international registration will lead to the cancellation of all the foreign applications and registrations under the Madrid system; it is important to be sure that the basic mark will not change for at least five years, especially if the country of origin requires continued use.
- Consider the use of the same mark (and goods and services description) globally: evaluate the need to use variants of the mark and/or local language versions of it on a country-by-country basis.
- Activate, through your IP attorney, a worldwide surveillance system and monitor IP gazettes and legal actions.
- Protect the transliteration or the translation into each South-East Asian language of your mark.



5. Glossary of terms

- **Intellectual Property (IP):** the manifestation of creative or inventive activity, such as trade names, designs, artistic or literary works, inventions, images or symbols.
- **Intellectual Property Rights (IPR):** rights connected to the above-mentioned creative content, including trade marks, patents, industrial designs, geographical indications, trade secrets and copyright.
- **Trade mark:** a sign that is capable of distinguishing the goods or services of one undertaking from those of others.
- **World Intellectual Property Organization (WIPO):** a self-funding agency of the United Nations that manages several IP services at an international level and works to develop effective international IP systems (<https://www.wipo.int/about-wipo/en/>).
- **Madrid Protocol / Madrid system:** The Madrid Protocol is a centralised system for registering and managing trade marks worldwide. This Protocol has been ratified by many countries around the world, including the EU, the USA and China. It allows trade mark owners to register in different countries through one application instead of making individual applications.

6. Related links and additional information

- Visit the SEA IPR SME Helpdesk website for further relevant information, such as how to deal with business partners in SEA, <http://www.southeastasia-iprhelpdesk.eu>
- Visit the China IPR SME Helpdesk, at <https://www.china-iprhelpdesk.eu/>
- Visit the LA IP SME Helpdesk website, at <https://www.latinamerica-ipr-helpdesk.eu/>
- Visit the Helpdesk blog <http://www.yourIPinsider.eu> for related articles on IP in SEA and China, or <https://yourlatamflagship.com/> for related articles on IP in LA.
- ASEAN TMview, <http://www.asean-tmview.org/tmview/welcome>
- TMview, <https://www.tmdn.org/>
- WIPO Global Brand Database, <https://www3.wipo.int/branddb/en/>
- WIPO, <http://www.wipo.int>
- Nice Classification, www.wipo.int/classifications/nice/en
- ASEAN TMclass, <http://euipo.europa.eu/ec2/>
- Madrid Protocol, <http://www.wipo.int/madrid/en/guide/>



Free IP advice for European SMEs

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