

How to register and protect a trademark internationally?

The Madrid System provides a solution **for registering and protecting trademarks internationally** throughout the world.

This system is the most suitable option for those who want to protect their trademark in different territories being members of said Madrid System.

However, if you just wish to obtain protection for your trademark in one or two territories, and do not plan to extend protection to other territories in the future, then national or regional routes may be more appropriate.

Governed by the World Intellectual Property Organization (WIPO), this system allows to apply for protection of a trademark in up to 131 member countries, **by filing a single application, thus simplifying the process compared to the alternative of national registrations on a country-by-country basis.**

The streamlined and centralized management of this system allows trademarks to be **protected and maintained conveniently and cost-effectively.**

In addition, **the geographical scope of protection can be extended at any time by means of a subsequent designation.**

In order to register a trademark internationally through this system, a number of steps must be considered.

Europe | U.S.A | Argentina | Brazil | Mexico

The 'basic mark' as a preliminary step to international trademark registration

Before applying for a trademark registration at a global level, it is very important to complete a prior step at a national level: **a basic trademark must be registered or have been filed for at the corresponding National Trademark Office of a Member State of the Madrid System** (known as the '**Office of origin**').

In case of residence in the Spanish territory, this first national application may be filed before the **SPTO or EUIPO**. It is also necessary that this prior basic trademark **is granted and remains in force for at least five years** from the date of application for the international trademark. During said time period, the international trademark will be linked to the basic trademark.

If the basic mark ceases to have effect, either partially or totally, for any reason (for example, if it is refused, withdrawn, cancelled or not renewed) within that five-year period, the international registration will cease to be protected to the same extent.

International trademark application at the Office of origin

Once the previous step (registering or applying for registration of the basic mark) has been completed, the next step is **applying for the international trademark at the Office of origin of a member country of the System** (in this regard, it should be noted that international applications filed by applicants directly before WIPO will not be taken into account and will be returned without being examined).

Before filing an international application, **it is important to search for existing marks in those territories to be designated**. These searches will help to detect earlier marks that may be similar or identical to the mark, subject of the international application. To this end, it is advisable to have an agent or a **trade mark attorney** carrying out a complete analysis of the registrability of the mark, in order to avoid possible future conflicts.

The prosecution of this international registration application may be carried out simultaneously to the national application prosecution made as a prior step, being possible to have the national trademark application filed and straight away the international registration application, that may only cover the goods and services included in the basic trademark.

Europe | U.S.A | Argentina | Brazil | Mexico

Disclaimer: Please note that the present communication is of a general nature. It is not intended as legal advice and does not create an attorney-client relationship. No warranty of any kind is given with respect to the subject matter included herein or the completeness or accuracy of this note and no responsibility is assumed for any actions (or lack thereof) taken as a result of relying on or in any way using information contained in this note. In no event shall we be liable for any damages resulting from reliance on or use of this information. Any analysis regarding or related to the developments indicated above needs to be applied to a case in particular and consulted or verified with local counsel in each jurisdiction.

Examination period for the international trademark application

Once the international application has been filed with the Office of origin, **the examination period begins**. During said period the application will be examined so as to ensure that the mark complies with all applicable requirements. In addition, **the Office of origin will examine whether the details corresponding to the international mark match with those of the basic mark**.

At this point, **it is advisable to seek advice on the examination practices of the different Offices corresponding to the territories concerned** to see whether any steps may be taken to avoid possible future provisional refusals.



If deficiencies are found in the application for the international registration, the Office of origin will invite the applicant to remedy said deficiencies within 10 working days. In case irregularities are not remedied within that period, the application will be rejected.



The Office of origin shall send the application for the international registration to WIPO once all deficiencies have been rectified within the therefore granted time limit. WIPO will then implement a **new examination of the involved requirements and formalities**.

Submission of the international application to WIPO and examination

Once WIPO receives the international application, examination thereon will start, in order to ensure that the application complies with the **relevant formal requirements**, such as:

- Capacity of the applicant;
- Sufficient contact details;
- Designation of at least one member of the Madrid System;
- Quality of the images;
- Payment of fees;
- Classification;
- Indication of goods and services;
- Declarations of the Offices of Origin;
- Declarations of intent to use.

Europe | U.S.A | Argentina | Brazil | Mexico

Disclaimer: Please note that the present communication is of a general nature. It is not intended as legal advice and does not create an attorney-client relationship. No warranty of any kind is given with respect to the subject matter included herein or the completeness or accuracy of this note and no responsibility is assumed for any actions (or lack thereof) taken as a result of relying on or in any way using information contained in this note. In no event shall we be liable for any damages resulting from reliance on or use of this information. Any analysis regarding or related to the developments indicated above needs to be applied to a case in particular and consulted or verified with local counsel in each jurisdiction.



In case WIPO finds deficiencies, the interested party will be notified by means of a '**notice of irregularity**', informing that, in case said items are not remedied, the application will be considered abandoned.



To the contrary, in case WIPO verifies that the application is correct, then:

- The application is recorded at the International Register;
- The Office of origin is informed;
- The application is notified to the Offices of the designated countries or Organizations, which will proceed to grant or refuse protection of the designation by applying their national law;
- A certificate of international registration is issued and forwarded to the holder;
- The mark is published in the WIPO Gazette.

In relation to the third point, Offices have a **period of 12 or 18 months** (from the date of notification) **to determine whether the mark is eligible for protection in their territory**. If the Office does not issue any provisional refusal in the territory concerned within the applicable time limit, the mark is automatically protected in that territory.

Once the prosecution of the international registration is concluded, the protection of the mark in each concerned country **will be the same as if the mark would have been filed directly in those countries**. In this regard, it is important to bear in mind that, even if the application is made internationally, **the granting prosecution thereof in each territory is carried out in accordance with the applicable national law**.

How long does the international registration of a trademark last?

A trademark is granted for **ten years** from the date of application, **although it can be renewed indefinitely for successive ten-year periods**.

Furthermore, it is important to remember that, once five years have elapsed from the date of the international registration, said international registration becomes independent from the basic mark.

How to register an international trademark step by step (summary)

1. The applicant needs to have a national trademark application or registration in a member country of the Madrid System (basic mark);
2. The second step is to file the international application before the Office of origin;
3. The Office of origin will examine and analyze formalities and whether the application complies with the applicable requirements;
4. If no deficiencies are found, the Office of origin transfers the application to WIPO;
5. WIPO carries out a further examination of the formalities of the application;
6. If no defects are found, the international application is forwarded to the national Offices, designated in the application;
7. Each national Office shall grant or refuse protection of the international registration of the mark within its territory on the basis of its own national legislation;
8. Once the international trademark is registered, it has the same effects as a national trademark in the designated countries.

International trademark registration: need advice?

At **UNGRIA** we have a team of [trademark attorneys](#) who can advise you and accompany you in the registration, prosecution and protection of your trademark at an international level as well as its surveillance and renewal.

Please contact us for more information.

[CONTACT US](#)

Europe | U.S.A | Argentina | Brazil | Mexico

Disclaimer: Please note that the present communication is of a general nature. It is not intended as legal advice and does not create an attorney-client relationship. No warranty of any kind is given with respect to the subject matter included herein or the completeness or accuracy of this note and no responsibility is assumed for any actions (or lack thereof) taken as a result of relying on or in any way using information contained in this note. In no event shall we be liable for any damages resulting from reliance on or use of this information. Any analysis regarding or related to the developments indicated above needs to be applied to a case in particular and consulted or verified with local counsel in each jurisdiction.