

## International Mark Registration (IR)

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### Introduction

To simplify the acquisition of international mark protection, the Madrid Agreement Concerning the International Registration of Marks (MMA) has been created together with its supplementary protocol (PMMA), 98 countries being at present party to said agreement. The protocol PMMA concerns individual regulations relating to costs and deadlines relevant to the various Contracting States but also refers to regulations concerning some of the legal and formal advantages.

Meanwhile all of the Contracting States that originally signed just the MMA have now also become party to the protocol, which means that **as from 31.10.2015 the protocol (PMMA) is now binding for all of the Contracting States**, so that the procedure is now the same for all of the countries concerned.

### Advantages

By way of international registration, it is possible to attain mark protection for individually selected countries within the Contracting States by **filing a single central request**. In addition, an extension of mark protection may be attained in a manner common to all countries.

The advantages regarding costs arise from the fact that submission formalities are handled by a **single** (German) representative operating at a **single** registration office, that is to say, without intervention of a foreign attorney based in the relevant foreign country. If no objections are subsequently raised by the national offices, international mark protection may be obtained, theoretically, without entering into correspondence with a foreign attorney, thus reducing costs significantly. However, this will in fact not always be feasible and depends, in particular, on the actual mark involved and on the country or countries selected.

Another advantage is that protection may be supplemented at a later date in a simple manner by naming other countries. Although such protection does not share the same temporal relevance as the original registration, administration runs on the same lines as the original registration such that, for example, no additional renewal periods require consideration.

The attainment of protection by this method may be opportune when, following the application for a German Mark or a Community Mark, it is necessary to extend protection for the same to other countries. Two to three target countries suffice to save costs as compared with individual national applications in a foreign country, although the saving achieved can only be ascertained in consideration of the current selection of countries.

### Requirements

In all cases, the main requirement for international registration is that at least one **basic application** must exist in the so-called country of origin (Germany or the EU). This is determined by the location of the headquarters or domicile of the applicant, or, if the applicant's domicile is not in one of the Contracting States, by his or her nationality.

### Procedure

An application for international registration must be submitted to the office at which the basic mark was registered or applied for. In the case of German basic marks (or applications) this will be the **German Patent and Mark Office** (DPMA) and for Community basic marks (or applications) the **Harmonization Office** in Alicante (OHIM). Within a period of two months following submission, the respective office must forward the application to WIPO for registration. If all formal preconditions are fulfilled at this juncture, WIPO will publish the application and notify the Contracting States concerned. This registration has the same effect as if the mark referred to in the application had been granted protection by directly applying for the same in the relevant Contracting State.

Within **18 months** following registration, notice may be forthcoming from the relevant offices to the effect that the mark applied for has been rejected (provisional refusal of protection). This may be grounded on formal reasons arising from national regulations or else be due to doubts concerning the availability of protection for the mark itself (so-called absolute grounds). However, it might be due to confliction with prior legislation (relative grounds). If a provisional refusal of protection is announced, a national attorney must be called on to communicate with the relevant office for continuation of the procedure. In the event

of inability to successfully counter the grounds for denying protection, any protection having been obtained by registration is voided retroactively.

The **term of protection** lasts for 10 years from the date of registration and is subject to renewal for further 10-year periods on payment of appropriate fees to WIPO.

### **Five-year dependency on the basic mark**

It should be noted that for a period of five years following the date of registration, an international registration is dependent on the existence of the basic mark. Thus the basic mark may not be abandoned during this period and neither may it be cancelled on account of proceedings instigated during this period, as otherwise the international registration will also be automatically cancelled. If a basic mark is only partially abandoned during this period or only partially cancelled on account of proceedings instigated during this period, the international registration will be cancelled to the same partial extent.

However, it is possible to convert the international registration to a national mark in the respective countries within the scope of said cancellation. This then has the same priority as the international registration. It involves the same costs as incurred for a national application but offers protection from loss of priority in the country concerned.

### **Obligatory use**

Obligatory use is governed by the relevant national requirements as dictated by the national mark law.

### **Cost Examples**

Costs (official fees in CHF including net legal fees) for registration of one mark involving **three classes of goods and services** for **seven exemplary countries**

USA, Japan, Switzerland, China, EU, Republic of Korea, Israel: approx. 10,100 €

*Direct national applications, by way of comparison:* >approx. 17,000 €

The countries USA, Japan and the EU are reckoned as being „expensive“ countries, whilst China, for example, is practically negligible.

In the case of more than three classes, additional class fees are required. Additional costs are also involved when national proceedings require correspondence with a foreign attorney for assistance concerning denial of protection (official objections or opposition). This particularly applies to marks, the **protectability** of which is **uncertain**, and to those bearing a high **risk of opposition**, as may be the case, for example when similar older marks have been registered for the same market segment. Furthermore, marks containing **uncommon** or **unclear** terms in the **goods and services classification** may be affected.