



International Trademark Protection

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A Practice Note discussing strategies for protecting trademarks internationally. This Note focuses on the framework for international trademark protection, including key multinational trademark registration filing systems. It also addresses international trademark enforcement and international treaties affecting trademarks.

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Globalization has significantly affected trademark portfolio practice in recent years. US companies now sell their products or services throughout much of the world. One negative aspect of this shift to a global marketplace is that counterfeiting has increased, as intellectual property (IP) protection has lagged behind many countries' growing manufacturing capabilities. Trademark owners must therefore now secure registration in many more countries to ensure their brands are adequately protected in all countries in which they exploit or are likely to exploit their marks.

This Note examines strategies for protecting a trademark internationally as a company expands its operations, including:

- Evaluating a company's existing trademark portfolio (see *Evaluating a Trademark Portfolio*).
- Expanding a trademark portfolio (see *Expanding a Trademark Portfolio*).
- Trademark filing strategies (see *Trademark Filing Strategies*).
- Trademark enforcement (see *International Trademark Enforcement*).

Trademark protection around the world largely remains a patchwork system of national laws and trademark registries. However, recent developments harmonizing trademark practice and setting up multinational filing systems have reduced certain costs and procedural obstacles to the international protection of trademarks. This Note discusses several of the key regional filing systems, including:

- The Madrid Protocol administered by the World Intellectual Property Organization (WIPO), including its recent expansion to include the US in 2003 and the EU in 2004 (see *The Madrid Protocol System*).
- The European Community Trade Mark (CTM) system introduced in 1996 (see *The CTM System*).
- Examples of other regional filing options in Africa and the Benelux countries (Belgium, the Netherlands and Luxembourg) (see *Examples of Other Regional Filing Options*).

For information on trademark protection in the US, see *Practice Note, Acquiring Trademark Rights and Registrations* (<http://us.practicallaw.com/2-505-1700>).

EVALUATING A TRADEMARK PORTFOLIO

Conducting regular trademark audits is integral to evaluating whether a portfolio of trademark registrations meets a brand owner's needs. A company should first identify the key trademarks in its portfolio that require protection. A trademark portfolio can typically be broken down into four tiers, from most to least important:

- **First tier.** Usually includes house marks, which are marks used across the company's full range of products and services.
- **Second tier.** Includes important individual product or service names that are used in all or most of the company's key markets.
- **Third tier.** Consists of:
 - sub-brands;
 - regional brands; and
 - marks used on a limited range of goods or services.
- **Fourth tier.** Consists of:
 - slogans;
 - marks used for a limited duration; and
 - non-traditional marks such as product configurations and color marks.

After identifying the trademarks that require protection, a company should identify the jurisdictions in which protection is important. These countries typically fall into three categories. These three categories are:

- Present and near-term projected marketplaces for a company's products and service offerings.
- Countries where branded products are manufactured.
- Counterfeiting hotspots.

Companies should then consider which marks must be protected in which territories and review their trademark portfolio to identify:

- Holes in coverage to be patched by new filings for trademark registration.
- Filings that may no longer be necessary and can be allowed to lapse.

When conducting a trademark portfolio audit, companies must consider that trademark registrations in most countries become vulnerable to challenge if not used within a grace period of, typically, three to five years after registration. Companies should note those registrations that have passed this grace period and confirm that the marks are being used in the relevant region. If not, it may need to file new applications to ensure valid protection if the company desires to maintain protection.

EXPANDING A TRADEMARK PORTFOLIO

A trademark owner may decide to expand its trademark portfolio by adding one or more new trademarks or using existing trademarks for new products or services. For example, a product launch, line extension or an update to a company's branding may motivate a trademark owner to seek new trademarks. Similar issues arise when a company expands into a new commercial marketplace and must determine whether to obtain additional registrations for its existing marks in that jurisdiction.

Even when selecting and clearing a new trademark solely for use in the US, it may be advisable to undertake a simultaneous clearance process in relevant foreign jurisdictions to avoid future complications.

In each case, a company must carefully consider and understand the scope of protection available and the particular legal requirements in each jurisdiction. This includes making sure that the proposed trademark meets local requirements (see *Identifying Suitable Trademarks*) and that no third parties have prior rights to the trademark in that jurisdiction (see *Identifying Available Trademarks*). For these purposes, one must coordinate with local counsel familiar with the laws of the jurisdiction.

Identifying Suitable Trademarks

From both a legal and marketing perspective, a strong trademark is generally distinctive (that is, it identifies the source of a product without immediately describing the products or services associated with it). Descriptive trademarks, while sometimes initially attractive because they tend to communicate information about the product or service to the consumer, are often costly and difficult, if not impossible, to register and enforce.

In addition, for trademarks used and registered outside the US, local requirements and legal limitations must also be considered. For example, in certain countries, single letters cannot be registered.

A trademark owner should also determine whether the proposed trademark has any meaning or connotation in local languages and dialects. While sometimes costly, local counsel can advise on this issue and help trademark owners avoid embarrassing situations arising from unintended meanings or connotations. Local counsel can also advise whether it is necessary or advisable to register any foreign translations or transliterations of word marks.

Identifying Available Trademarks

A company must also assess a proposed trademark's availability for adoption, use and registration in each country of interest. Generally, an available trademark can be distinguished from all existing third-party trademark rights, including both:

- Registered trademarks.
- Unregistered trademarks in countries that recognize common law trademark rights based on use of a mark. Countries that recognize some form of common law trademark rights include the US, the United Kingdom (UK), Australia, Canada and India.

Assessing the availability of a trademark may involve searching and analyzing trademark use and registration data from a variety of sources, including:

- National trademark registries.
- Business name records.
- Websites.
- Domain name records.
- Commercial usage.

The internet offers a wide range of easily accessible tools for assessing the availability of a proposed new trademark. For preliminary searching, informal searches with search engines such as Google or Bing may reveal potentially problematic prior uses of the proposed new trademark or a similar trademark. For more formal searching, trademark owners may turn to:

- Subscription databases, such as TrademarkScan or Saegis, whose website maintains a list of the countries and organizations in its database.
- Online records of national trademark offices (for a sample of these sites, see *Box, National Trademark Offices*).
- Consolidated international screening searches offered by commercial search vendors that include:
 - Country Identical Screening Search (KISS), which searches for identical marks in any jurisdiction;
 - Regional Identical Screening Search (RISS), which searches for identical marks in certain geographic regions or a "custom" region; and
 - Worldwide Identical Screening Search (WISS), which searches for identical marks in more than 200 available jurisdictions and trademark offices.

For commercially significant trademarks, such as new brands or spin-off brands, a trademark owner may decide to obtain in-depth availability opinions from local counsel in relevant foreign countries.

TRADEMARK FILING STRATEGIES

Once a trademark has been selected and cleared for adoption, use and registration, a trademark owner must decide where to file for registered protection and promptly file the trademark applications.



File Quickly

A trademark owner must file as soon as possible after clearing the mark because in most jurisdictions priority of trademark rights is determined by the filing date, regardless of use in that country or elsewhere. Even in the US, where priority is determined by use, rather than filing, it still is advisable to file as soon as practical, as the filing date sets a nationwide constructive use date.

In countries that are parties to the Paris Convention for the Protection of Industrial Property (Paris Convention), trademark owners can file applications up to six months after the first filing in a Paris Convention jurisdiction for the same mark and for the same goods and services, and still claim the first filing date as the effective filing date. As priority in most countries is based on the filing date, an applicant can secure a filing date by applying to register its mark in one principal country and then determining the other countries of most importance in which to seek protection.

Where to File

Determining which countries to focus on for filing protection requires an understanding of the suitability and availability of the marks in each relevant jurisdiction (see *Expanding a Trademark Portfolio*).

Because obtaining the desired scope of protection may require a multiple-country filing program, using available consolidated filing mechanisms can provide significant cost savings and simplify implementing an international trademark strategy (see *Multinational Filing Systems*).

INTERNATIONAL TRADEMARK ENFORCEMENT

Consistency is vital to any global IP enforcement strategy. A company can implement a consistent approach by:

- Defining a circle of protection around its trademarks.
- Developing a clear set of criteria for deciding what matters fall:
 - within the circle and therefore should be challenged; and
 - outside the circle and should not be challenged or should be challenged with a less aggressive posture.

The stronger the trademark (that is, the more distinctive and well-known) and the greater the resources the company is willing to commit to the trademark, the wider the circle can be. The circle generally should be smaller for a marginally distinctive trademark which the company does not want to spend a significant amount of time or money enforcing.

In conducting a global business, a company may encounter a significant amount of potentially infringing activity (including counterfeiting) and objectionable trademark filings by third parties. Deciding when to take action is a key function of a company's in-house or outside trademark counsel. The more clearly defined the criteria is for deciding when to take action, the better trademark counsel can meet the company's needs. A

clear strategy can also help a company avoid taking inconsistent positions in different cases, for example, arguing that two marks are confusingly similar only to find that these arguments are used against the company in a different case involving an analogous mark that has priority over the client's mark.

Conducting regular IP audits is also a key part of a global enforcement strategy. This ensures that a company has the tools it needs to enforce its rights in its countries of interest (see *Evaluating a Trademark Portfolio*). Generally, trademark registration costs are much lower than the cost of enforcing an unregistered mark in a country against an infringer. Most costly of all is being shut out of a potential market because another party has registered the company's mark first in that jurisdiction.

International Trademark Monitoring

Effective global IP enforcement requires vigilant monitoring of:

- Trademark registers.
- Marketplaces.
- Domain name registries.

Commercial vendors can monitor third-party activity in each area for objectionable trademark use. Trademark watching services can notify the trademark owner of any third-party applications similar to a specified mark. As counterfeiting of well-known trademarks can be rampant in certain jurisdictions, these services may generate a significant number of notices, which must be timely and regularly reviewed to meet any deadlines for enforcement activity and prevent prejudice to the trademark owner's legal position resulting from undue delay.

Pursuing Enforcement

Deciding which third-party activities to proceed against can involve a difficult line-drawing process. To develop an effective trademark enforcement strategy, a company should:

- Outline clear criteria in advance for the types of activities that it will challenge. A company can then efficiently review internal and third-party reports of potential infringement and counterfeiting activity and promptly take effective action when appropriate.
- Coordinate with company employees and local business contacts in key overseas jurisdictions. These individuals can be a valuable source of information concerning counterfeit materials and potentially infringing activities. Consequently, it is always a good idea for companies to maintain open lines of communication with their contacts on the ground and educate them to:
 - look for infringing activity;
 - report this activity as soon as possible; and
 - keep detailed records and evidence, including any evidence of actual confusion that may arise.

Working with Customs

Another component of an effective global enforcement strategy is working with customs offices in key jurisdictions to assist them in identifying and seizing infringing articles. Many jurisdictions, including the US and the EU, have customs recordal procedures for registered trademarks that companies can use to identify infringing products before these products enter the marketplace. Once a registration is recorded, the customs office will monitor imports for possible infringement of the mark.

In many countries, it may be possible to cooperate with customs officers and conduct in-person training sessions to:

- Educate them about the company's key trademarks.
- Help them distinguish between genuine and infringing articles.
- Increase their effectiveness and interest in assisting the company police its brands at the borders.

MULTINATIONAL FILING SYSTEMS

In the past, most international trademark protection relied on a patchwork of different countries' trademark laws, creating inconsistency and confusion. However, recent developments have made it easier for companies to manage their international trademark portfolios by providing streamlined channels of registration and promoting uniform standards for protection. Companies must now consider the option of using one or more multinational systems depending on the jurisdictions in which protection is desired. These multinational systems include:

- The Madrid Protocol system (see *The Madrid Protocol System*).
- The CTM system (see *The CTM System*).
- The African Intellectual Property Organization, the African Regional Intellectual Property Organization and regional filing arrangements in the Benelux countries (see *Examples of Other Regional Filing Options*).

In addition to these multinational filings systems, several other treaties affect international trademark practice (see *Box, Major International Treaties Affecting Trademarks*).

The Madrid Protocol System

The participation of the US, the EU and several additional commercially significant countries in the Madrid Protocol system is one of the most important recent development affecting international trademark filing strategy. The Madrid Protocol is a treaty creating a multinational trademark filing and registration system. It offers applicants the opportunity to obtain trademark protection in more than one country using one application based on a trademark registration or application in their country of residency (their "home" country).

The Madrid Protocol operates in parallel with another international trademark treaty known as the Madrid Agreement (together known as the Madrid System). However, the US, UK and many other commercially significant countries have not joined the Madrid Agreement.

As of September 2012, 87 countries are party to the Madrid Protocol, including:

- The US and the EU.
- Most non-EU European countries.
- China, Japan, South Korea, Singapore and Australia.
- Most of the Commonwealth of Independent States' countries.
- Various Middle Eastern and African countries.

Notably absent from the Madrid Protocol are various Western Hemisphere countries, including Canada and almost all Latin American countries. WIPO (whose website has a dedicated trademark-related portal) maintains a *list* of parties to the Madrid Protocol.

Madrid Protocol Registration and Application Procedures

The Madrid Protocol is only open to trademark applicants who are one of the following:

- Nationals of a country that is a member of the Protocol.
- Domiciled in a member country.
- Have a real and effective industrial or commercial establishment in a member country.

To use the Madrid Protocol system, a company must file a trademark application or own a trademark registration in its home country. An applicant that is a member of the EU may file on the basis of a CTM registration or application as its home registration or application (see *The CTM System*). An application for an international registration (IR) is then filed with the home country's trademark office, which certifies the application and sends it to the International Bureau of WIPO. The application must:

- Be filed in one of WIPO's official languages (English, French and Spanish).
- Specify the home application or registration and the countries covered (designated countries). The applicant may specify the EU as one of the designated jurisdictions, which has the same effect as filing a CTM application.
- Include a payment in Swiss francs of all fees, including those for the designated countries.

WIPO reviews the application for irregularities, such as the incorrect classification of goods and services. If the application has been correctly filed, it is registered on the International Register and published in the *WIPO Gazette*. As long as the home country's trademark office transmits the application to WIPO within two months, the filing date of the IR is when the application was filed in the home country. WIPO then transmits the application to the trademark offices in each designated country. IRs can be extended to additional member countries at any time after registration.

The trademark office of each designated country examines the IR according to its own trademark laws and requirements as if it were an individual national application filed through standard channels. Each office has 12 or, at the designated country's option, 18 months to provisionally refuse registration. The time can be extended further for refusals stemming from third-party opposition proceedings. The extent of the searches and examinations carried out by the designated country's trademark office (or in the case of Community Trademarks, the Office for Harmonization in the Internal Market (OHIM)) varies according to local procedure, but will typically cover:

- The trademark office's own examination of the inherent registrability of the mark.
- An evaluation of existing third-party rights for potential conflicts.

The designated countries trademark offices notify WIPO of any provisional refusal, which WIPO then relays to the applicant and the home country's trademark office. The applicant must appoint local counsel in the relevant country or territory to respond to the refusal, including any refusal based on a third-party opposition, under local law.

Grant of an International Registration

If an IR issues, it is valid for an initial ten-year period and renewable for successive ten-year periods. All renewals, changes of ownership and other matters affecting the registration are dealt with centrally at the WIPO.

An IR is equivalent to a national registration in each of the respective jurisdictions to which it extends. For example, infringement claims must be pursued through separate actions in each jurisdiction, and no method exists for obtaining relief in one territory for all Protocol countries in which infringement occurs. Similarly, a trademark owner can assign or license its trademark rights in some or all of its designated countries. However, assignments of the IR can only be made to parties who qualify for IR ownership under the Madrid Protocol.

Advantages of the Madrid Protocol System

The key advantage the Madrid Protocol system is that it may provide significant cost savings over filing individual applications directly with each country's national trademark registry. For example, under the Madrid Protocol, an IR covering more than 80 countries costs well under \$20,000 for up to three classes of goods and services, while comparable individual national filings could cost more than \$100,000. In addition, the procedural aspects of filing and maintaining an IR are greatly simplified over multiple national applications because there is essentially only:

- One application to file.
- One registration that issues.
- One renewal to docket and coordinate at the end of a single unified registration term.

The Madrid Protocol also does not have any translation, power of attorney or document legalization requirements, which result in further time and cost savings for an applicant.

Using the Madrid Protocol also typically results in reduced local counsel costs because a local agent need only be designated if a national trademark office refuses the application.

Disadvantages of the Madrid Protocol System

An applicant's IR remains dependent on the owner's underlying home country application or registration for a period of five years (dependency period). This has several important consequences, particularly for US trademark owners:

- **Narrow range of covered goods and services.** An applicant's Madrid Protocol filing cannot cover a broader range of goods and services than the underlying home country application or registration. Because the US has strict and narrow goods and services specification requirements, IRs based on US applications or registrations generally cover a much narrower range of goods and services than comparable individual national filings in other countries would cover.
- **Invalidity of or restrictions on home country registration apply to the IRs.** During the five-year dependency period, if the underlying home country application or registration becomes invalid for any reason, or if the goods and services are restricted, the same invalidation or restriction applies to the IR. While the applicant can then re-apply directly for national protection in the designated Madrid Protocol countries without the loss of the filing date of the IR, this will involve considerable additional cost. The Madrid Protocol may not be the best way to secure international protection for the mark if there is any concern that the home country application will not register, either because of failure to use the trademark as required within the allowance term or because of prior marks that could cause a risk of objection in examination or in a third-party opposition. If any of these problems occur, it could significantly affect the company's international trademark portfolio and not just the underlying rights.
- **Use required in every Madrid Protocol country.** A trademark covered by an IR registration must be used in each designated country to insure against cancellation and other invalidation actions based on non-use being brought against it. Therefore, trademark owners must carefully evaluate this filing technique before deciding to use it.

The relative advantages and disadvantages of the Madrid Protocol system compared to filing individual national applications are summarized in the *Box, Madrid Protocol: Advantages and Disadvantages*.

For information regarding other treaties that affect international trademark practice, see *Box, Major International Treaties Affecting Trademarks*.

The CTM System

The CTM registration system, which was created in 1996, protects trademarks in all 27 member states of the EU. CTM registrations and applications are automatically extended to any new member states upon accession. Unlike the Madrid Protocol system, which extends protection to designated countries in a hub-and-spoke type mechanism, the CTM application serves as a single, unified filing covering all EU member states. Companies cannot limit the protection of a CTM registration to certain EU member states.

The CTM system is available to residents in all member states of the Paris Convention, which includes almost every country in the world. Because of this, the CTM system is a unique filing opportunity for companies and individual citizens of most countries, including the US.

The CTM System is governed by the Community Trade Mark Regulation (consolidated Regulation 207/2009/EC) and administered through the OHIM in Alicante, Spain.

Once granted, a CTM registration takes effect throughout the EU for an initial period of ten years and can be renewed for successive ten-year periods.

A trademark owner can lose rights in a CTM in a manner similar to a national registration, through:

- **Expiration.** The owner may fail to renew the registration after the original registration period or any renewal period.
- **Surrender.** The owner can cancel the registration voluntarily at any time, either wholly or partially (that is, for only some of the goods or services for which the mark is registered).
- **Declaration of invalidity.** A registration can be declared invalid in its entirety or partially.
- **Revocation.** A registration can be revoked wholly or partially (for example, owing to non-use of the mark).

If a CTM is revoked or declared invalid (or otherwise ceases to have effect, whether as an application or a registration), the owner may be able to convert the CTM into separate national applications in member states where third-party objection or earlier third-party rights do not apply, while retaining the filing date of the CTM. In this case, the owner will likely incur considerable extra cost, but the conversion may be worth pursuing in priority territories, especially if it solves the problem of intervening third-party rights in those countries.

CTM Submission and Examination

A CTM application is made on an official form that can be submitted either to one of the member states' national trademark offices or directly to OHIM. The application can also be filed electronically. It can be filed in any one of the 23 official languages of the EU, but the applicant must also specify a second language that is one of the five official languages of OHIM (English, French, German, Italian or Spanish) to be used for opposition and cancellation proceedings.

OHIM examines an application and may refuse it on substantive grounds or for non-compliance with formalities. OHIM does not apply substantive grounds for refusal as strictly as many national offices. However, descriptiveness of the applied for mark in any of the official languages of the EU is an obstacle to registration.

All applications undergo a search against CTM applications and registrations to determine the extent and nature of any prior conflicting rights. An applicant can also request searches for prior conflicting marks in the national trademarks registrations of certain member states (for a listing of the available member states, see *Advantages of CTM System*). The offices making these searches prepare the reports within two months, setting out details of existing conflicting trademarks. OHIM then sends these reports to the applicant with the CTM search report.

The prior rights search is conducted after OHIM's substantive examination, and OHIM is not permitted to object to an application on the basis of any prior rights that are identified. However, OHIM does notify the owner of any identified conflicting CTM (but not national) rights of the new CTM application on publication. This gives the owner the opportunity to consider whether to file an opposition against the new application.

Oppositions to CTM Applications

OHIM can only refuse registration due to the existence of an earlier conflicting CTM or national trademark if the owner of the earlier prior relevant CTM or national right opposes the application within three months of its publication and the opposition is successful. Unless there is a successful opposition, OHIM will register the CTM (whether or not any conflicting trademarks are cited in the search reports), and it will be published in the *CTM Bulletin*.

A company that owns identical trademark registrations at the national level in one or more EU member states may consolidate those national registrations and record them as part of a CTM registration. In doing so, the owner not only preserves the original national filing dates in the CTM record (known as seniority), but also saves money on renewal fees, as there will only be one fee to pay instead of a fee for each national registration. However, a CTM holder can only take advantage of the seniority claims if it allows its national registrations to lapse and there are several reasons that a rights holder may elect to maintain its national registrations. For example, a national registration should be retained if it is the subject of ongoing infringement or opposition claims or is covered by contractual obligations, such as a license.



Advantages of the CTM System

Key advantages of the CTM system include the significant cost savings and administrative ease of the simplified registration process. Instead of filing 27 individual national applications, an applicant files a single CTM application to obtain unified rights covering all EU member states. Use of the trademark in any single member country protects the entire registration from cancellation or invalidation based on non-use of the trademark. This means that use in one country in the EU extends and maintains protection throughout the EU. However, this rule is not set out expressly in the CTM Regulations and there have been efforts in the European Commission to change the rule so that use would be required in a substantial portion of the EU to sustain a CTM that is subject to use requirements.

From an administrative perspective, the benefits of a single registration include:

- One procedural language.
- One administrative center (OHIM).
- One file to be managed.

The CTM registration process is also relatively quick, with applications typically maturing to registration within nine months of filing, barring any extraordinary circumstances or third-party oppositions.

From an enforcement perspective, in contrast to the Madrid Protocol system, a CTM gives the owner the right to object to infringement throughout the EU. The owner may also be entitled to apply for EU-wide relief, such as an injunction, for all infringing acts in the EU, instead of having to pursue several actions in different member states. Under the CTM regulations, several courts may have jurisdiction and a party may, in many cases, choose to bring infringement or invalidity proceedings in respect of CTMs in the jurisdiction the party considers most favorable in terms of law, procedure or costs. Parties who are not domiciled in, or that do not have permanent establishments in, an EU member state must bring proceedings in the Spanish CTM and Community Design Courts in Alicante, Spain.

Filing a CTM application can also be a good way to quickly assess the availability of a proposed trademark in Europe. On filing an application, the CTM Office gives applicants the opportunity to order copies of national trademark search reports for an additional fee. Ordering and reviewing comprehensive searches in EU member states before filing for a CTM can be extremely expensive. It therefore is often more cost efficient to first file the CTM application and then request copies of national search reports.

National search reports are available for the following EU member states:

- Austria.
- Czech Republic.

- Denmark.
- Finland.
- Greece.
- Hungary.
- Lithuania.
- Poland.
- Romania.
- Slovakia.
- Spain.

A drawback is that these reports often provide only basic information about cited third-party marks and may therefore provide minimal help in identifying serious conflicts. Nevertheless, they can provide a decent point of reference for evaluating existing third-party marks in EU member states. This is particularly true when an initial preliminary screening search of the CTM database or EU member countries, or both, does not disclose any serious obstacles to adoption of a mark in the EU.

Disadvantages of the CTM System

The unitary nature of the CTM registration system has certain disadvantages for trademark applicants:

- **Overcoming oppositions in a single member state.** An objection based on a single national trademark registration can delay the entire CTM registration process. In this situation, the applicant can convert its CTM application into multiple national applications instead of allowing the entire CTM to lapse. However, the costs involved with this conversion would eliminate any cost savings gained by filing the CTM in the first place.
- **Difficulty in identifying potential third-party conflicts** Considering how many countries are covered by the CTM and the limitations of national search reports, it can be difficult to assess whether a CTM application will elicit any third-party objections. OHIM will not refuse to register a mark on the grounds that it is confusingly similar to another mark. It can only refuse registration due to the existence of an earlier mark if the owner of a prior relevant CTM or national registration in an EU member state successfully opposes the application within three months of its publication. Therefore, the prior applicants or registrants must themselves object to later-filed applications. Theoretically, search reports permit CTM applicants to identify marks that may pose problems for their applications, providing an opportunity for applicants to address issues preemptively by withdrawing their applications or attempting to negotiate consents or coexistence agreements with prior mark owners. Normally, however, applicants must simply wait and see whether their applications receive any third-party objections.
- **Limitations on assignment.** While the owner of a CTM registration may choose to license the right to use a CTM in some, but not all, member states, a CTM registration can only be assigned in its entirety.

Another shortcoming of the CTM system is that a trademark owner may want protection in European countries that do not belong to the EU, such as Norway or Switzerland. In that case, the trademark owner must supplement its CTM filing by also filing individual national applications directly in the non-EU countries of interest.

The relative advantages and disadvantages of the CTM system compared to filing individual national applications are summarized in the *Box, CTM: Advantages and Disadvantages*.

Examples of Other Regional Filing Options

In addition to the Madrid Protocol and CTM systems, trademark owners may also take advantage of other regional filing arrangements. These include regional filing arrangements:

- In Africa (see *Africa*).
- In Benelux (see *The Benelux*).

Africa

In Africa, applicants can file for consolidated trademark protection through the:

- **African Intellectual Property Organization (OAPI).** Like the CTM system, *OAPI* is a unified framework. It covers the following 16 Francophone African countries:
 - Benin;
 - Burkina Faso;
 - Cameroon;
 - Central African Republic;
 - Chad;
 - Congo;
 - Equatorial Guinea;
 - Gabon;
 - Guinea;
 - Guinea-Bissau;
 - Ivory Coast;
 - Mali;
 - Mauritania;
 - Niger;
 - Senegal; and
 - Togo.

Registrations cover all countries that are member states, and use in one country constitutes use for all countries. Notably, it is impossible to obtain national registrations or renewal in any of the OAPI member states individually. Trademark protection lasts ten years from the date of application and is renewable for further periods of ten years.

- **African Regional Intellectual Property Organization (ARIPO).**

Under *ARIPO*, protection is extended as a collection of national rights (like the Madrid Protocol). It covers the following eighteen mostly English-speaking African countries:

- Botswana;
- The Gambia;
- Ghana;
- Kenya;
- Lesotho;
- Liberia;
- Malawi;
- Mozambique;
- Namibia;
- Rwanda;
- Sierra Leone
- Somalia;
- Sudan;
- Swaziland;
- Uganda;
- United Republic of Tanzania;
- Zambia; and
- Zimbabwe.

Unlike OAPI, ARIPO it is not well recognized or well administered. Because certain ARIPO member countries have not yet passed implementing legislation, the ARIPO system may be an inviable option for trademark protection, and national trademark applications still offer the soundest mechanism for protection in ARIPO member countries. Unlike OAPI, separate national registrations may be obtained in each country that is a party to ARIPO.

The Benelux

Another example of a regional filing arrangement is the joint trademark application protection available in the Benelux countries. *The Benelux Office for Intellectual Property* (BOIP) is the official body for trademark registration in the Benelux. The registration process typically takes four months. Registration covers all three Benelux countries and is valid and renewable on a ten-year basis.

National Trademark Offices

Many trademark offices have websites through which trademark records can be searched. The following is a sampling of some of those sites:

- **Australia.** Australian Government: *IP Australia*.
- **Canada.** Canadian Intellectual Property Office: *Canadian Trade-marks Database*.
- **European Community.** The Trademarks and Designs Registration Office of the EU, Searching the Community Trade Mark Database: *CTM-ONLINE*.
- **Hong Kong.** Intellectual Property Department, Government of Hong Kong: *IPD Online Search System*.
- **International Register.** World Intellectual Property Organization IP Services: *ROMARIN (International Trademark Information Database)*.
- **New Zealand.** Intellectual Property Office of New Zealand: *IPONZ*.
- **Singapore.** Intellectual Property Office of Singapore: *eTrademarks Search*.
- **United Kingdom.** UK Intellectual Property Office: *Online Trade Mark Services*.

Madrid Protocol: Advantages and Disadvantages

ADVANTAGES	DISADVANTAGES
Administration. One application, one registration and one renewal.	Scope of Registration. The trademark applied for must be identical to the trademark in the home country application or registration, and the specifications of the goods or services cannot be broader than that in the home country application or registration.
Cost. Consolidated filing offers potentially significant cost savings over individual national applications	Objections. Objections will be in the local language and may require use of local agents, increasing costs.
Geographical Scope. Potential protection in over 80 jurisdictions.	Use. The trademark should be used in each designated country to protect the trademark from non-use challenges in the respective countries.
	Dependence. Registration is dependent on the home application or registration for the first five years, so that if that right is attacked, international protection could be lost. Conversion to national rights is available, but at significant additional costs.

CTM: Advantages and Disadvantages

ADVANTAGES	DISADVANTAGES
Administration. One application, one registration and one renewal, and one set of fees at each stage..	Oppositions. Oppositions are more likely and, if the trademark is refused on the basis of an earlier right in a member state, it will be refused for the whole of the EU. Conversion to national rights is available, but at significant additional costs.
Cost. Consolidated filing offers potentially significant cost savings over individual national applications.	Assignment. Can only be assigned for the whole of the EU.
Geographical Scope. All 27 member states of the EU.	
Convenience. Consolidation of registrations; can claim seniority from earlier national registration.	
Use. Use in only part of the EU should be sufficient to resist a revocation action.	
Infringement. Choice of forum and opportunity to obtain EU-wide relief.	

Major International Treaties Affecting Trademarks

In addition to the Madrid Protocol (see *The Madrid Protocol System*), several other treaties have a significant effect on international trademark practice.

PARIS CONVENTION

The Paris Convention, the oldest international IP treaty, set up the principle of national treatment (that a member country's own persons and the foreign nationals of all other member countries must enjoy a similar level of IP (including trademark) protection). The Paris Convention specifies that trademark protection in member countries must cover well-known marks, trade names and service marks, but does not require registration of service marks.

The Paris Convention also set up Convention priority rights (see *Trademark Filing Strategies: Filing Quickly*).

AGREEMENT ON TRADE-RELATED ASPECTS OF INTELLECTUAL PROPERTY RIGHTS (TRIPS)

Like the Paris Convention, TRIPS prohibits discrimination between a member country's own nationals and nationals of other member countries (national treatment). However, it also includes a most-favored nation provision, specifying that any rights that a signatory country extends to nationals of one member country must be extended to nationals of all other member countries.

Article 2 of TRIPS incorporates the substantive provisions of the Paris Convention so that they are binding on TRIPS signatories that have not ratified the Paris Convention. In addition, TRIPS extends trademark protection beyond the Paris Convention by:

- Requiring the registration, and not just protection, of service marks.
- Extending the protection for well-known trademarks to cover well-known service marks.
- Requiring an expanded scope of protection for well-known trademarks and service marks in relation to marks used on dissimilar goods and services.

TRADEMARK LAW TREATY (TLT)

The TLT harmonizes standards for trademark registration and renewal, setting out the maximum formal administrative requirements that the national trademark offices of member countries can impose.

The TLT addresses three phases of the trademark application and registration process:

- **Applications for registration.** It defines the elements that can be required as the basis for receiving a trademark application.



Each member country must allow applicants to file a single application covering goods and services in multiple classes of the Nice Classification. The national registries of contracting parties can require the following application information:

- a request for registration, the name and address and other information concerning the applicant and its representative;
 - information concerning the mark, including one or more representations of the mark;
 - the goods and services for which registration is sought classified under the Nice Classification; and
 - a declaration of intention to use the mark (if the member country permits applications based on an intent to use the mark in the future, such as US intent-to-use trademark applications) or a declaration of actual use of the mark and corresponding evidence of Trademark Law Treaty use, or both.
- **Registration and renewal.** It harmonizes the duration of the initial registration period and each renewal period at ten years each, and sets out the conditions that a member country can require for renewal.
 - **Changes after registration.** It simplifies the procedures for recording name and ownership changes for trademark applications and registrations. In each case, a single request is sufficient even when the change relates to more than one trademark application or registration, if the requested change relates to all specified registrations or applications.

The TLT also prohibits requirements for the attestation, notarization, authentication, legalization or certification of any signature, unless a registration is being surrendered. A member country must accept an application request made on a form that corresponds to the TLT model, subject to the use of a language accepted by the office, and cannot require further formalities. The TLT further provides that a power of attorney submitted to a national office may relate to one or more applications or registrations owned by the same applicant.

Like TRIPS, the TLT requires member countries to register service marks as they would trademarks. However, the TLT does not require member countries to register collective marks or certification marks (known as guarantee marks in certain jurisdictions).

For more information, search for the following resources on our website.

Topics

- Trademarks/Trade Marks
(<http://us.practicallaw.com/topic2-103-2080>)

Practice Note: Overview

- Brand Protection Toolkit
(<http://us.practicallaw.com/4-509-1314>)

Practice Notes

- Protecting Against Counterfeit Trademarks and Gray Market Goods
(<http://us.practicallaw.com/2-503-4782>)
- Trademark Searching and Clearance
(<http://us.practicallaw.com/4-507-2834>)

Standard Document

- Trademark Search and Registration Questionnaire
(<http://us.practicallaw.com/0-508-1487>)

Checklists

- Creating an Effective Trademark Anti-counterfeiting Program Checklist
(<http://us.practicallaw.com/0-503-4783>)
- Registering a Trademark Checklist
(<http://us.practicallaw.com/6-502-8835>)
- Trademark Searching and Clearance Information Checklist
(<http://us.practicallaw.com/9-508-1831>)

Article

- IP in business transactions: Country Q&A tool
(<http://us.practicallaw.com/7-501-7488>)

For the links to the documents referenced in this note, please visit our online version at <http://us.practicallaw.com/9-505-6643>

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