A guide to applying for your trade mark overseas
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Disclaimer

This application guide is designed to help you prepare and file a trade mark application under the Madrid Protocol. This guide does not cover every issue that may come up and you should not regard this guide as an authoritative statement on the relevant law and procedure. You should also note that the requirements may change from time to time and while we make every effort to ensure the information presented is accurate, you should check with IP Australia before relying on the information. Although fee amounts are listed in this guide, please check IP Australia’s website before paying your fees.
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International registration of your trade mark under the Madrid Protocol

Introduction

There are two different ways Australian trade mark owners can seek trade mark protection overseas. An application may be filed directly with each country, or a single international application can be filed through us nominating the relevant Madrid Protocol countries in which protection is required.

The Madrid Protocol is a treaty providing for the international registration of trade marks. It is administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) in Geneva. This treaty makes it easier for people to file trade mark applications in a number of countries simultaneously.

Over 90 countries have signed the Madrid Protocol, including Australia, the United Kingdom, the United States of America, the European Union, Japan and New Zealand. A full listing is available on the [WIPO website](http://www.wipo.int).

All requests for trade mark protection in Madrid Protocol member countries are examined according to the trade mark legislation and laws existing in each designated country. The Madrid Protocol also allows trade mark owners overseas to designate Australia in their international applications.

Benefits of international registration

Benefits of making an international application under the Madrid Protocol include:

- the application can be made in English
- it can be simpler and less expensive than applying directly to each country
- a single request can be made to make changes to, or to renew, international registrations
- the trade mark will have the same protection that would be extended to a national registration in that country
- other Madrid Protocol member countries can be designated for an international registration at a later date. These are called ‘subsequent designations’.
Other options for applying for trade marks overseas

The national trade mark systems of Madrid Protocol members continue to operate independently, and a trade mark owner can still apply for registration directly to overseas countries. There may be some circumstances where applying directly to a country of interest may be a better option than seeking international registration under the Madrid Protocol.

Intellectual property professionals or business advisers can assist when you are deciding which of these options to consider.

Search for similar trade marks before applying

Before applying for an international registration it’s a good idea to identify any national trade marks in Madrid Protocol countries of interest that are similar to your trade mark. By doing this, you may avoid problems that could make it difficult to register your trade mark. You would need to search the trade mark records in your countries of interest, as well as the IB records. As doing a thorough search is not a simple exercise, consider contacting an IP professional who specialises in international trade mark searching. See our website for IP professionals and other sites.

Various trade mark offices provide searchable records of existing trade mark applications and/or registrations on their websites. There are also companies which provide searching services for a fee and some are internet based.

IB records can be searched using the ROMARIN database which is available, free of charge, on the WIPO website. ROMARIN contains information about international applications that have been received by the IB from an Office of Origin, and all international registrations.

How long does an international registration last?

An international registration under the Madrid Protocol is protected for a period of ten years from the date of registration. The date of registration is usually the date the international application was received by the Office of Origin. International registrations can be renewed every ten years upon payment of the relevant fee.
Applying for an international trade mark registration

Who can apply?

An applicant, whether a person or a legal entity, must satisfy at least one of the following criteria:

- the applicant must be an Australian national
- the applicant must be domiciled in Australia
- the applicant must own a real and effective industrial or commercial establishment in Australia.

When the application for an international registration is filed by more than one applicant, each applicant must satisfy at least one of the above requirements.

The applicant must also have an application for registration of a trade mark or a registered trade mark with us.

You can file your own application for international registration or you can use the services of a registered patent or trade mark attorney or an IP professional.

Some designated countries may insist on the nomination of an address for service in their country if they issue a provisional refusal (an objection) against an international registration. The offices of designated countries will advise you of their requirements in relation to your international registration.

The basic trade mark

An application for international registration must be based on one or more Australian trade mark application or registration owned by the same applicant(s).

The national trade mark(s) is referred to as the 'basic trade mark(s)'. The international application must be for a trade mark identical to the basic trade mark and include some or all of the goods and/or services covered by that basic trade mark. There may be more than one basic trade mark where the goods and/or services claimed in the international application are spread over several Australian trade mark applications and/or registrations.
Dependence on basic trade mark

The basic trade mark must be carefully maintained because the international registration is dependent on it for five years from the date the international application is filed. IP Australia must report changes to the scope of the basic trade mark to the IB because this will have the same effect on the international registration.

For example, if the basic trade mark lapses, is cancelled or removed, or the goods and/or services are amended within five years of the international application being filed, the IB will cancel the international registration to the same extent in all designated countries.

This also applies if the basic trade mark is restricted or ceases as a result of an action that commenced within the five year period.

Priority

If you have previously filed the same trade mark in another country, the Paris Convention allows you to claim an earlier priority date on your international application providing it is filed within six months of the date on which the trade mark was first filed. This may be your national application.

If you have not yet filed your (basic) Australian application, you should consider doing so and then file your international application.

If you wait to receive an examination report on your national application before filing your international application, you will have an indication of the likelihood of registration of your basic Australian trade mark.

Series of trade marks cannot be filed

It is NOT possible to file an international application for a series of trade marks, even where the basic trade mark covers a series of marks. The international applicant is advised to select one trade mark in the series as the trade mark on their international application.

Special trade marks can be filed

- Three-dimensional (shape)
- Colour
- Sound

International applications for three-dimensional or shape trade marks, colour trade marks and sound trade marks must include the same written description as the basic trade mark.

- Certification, Collective and Guarantee trade marks

It is possible to file an international application for a collective, certification or guarantee trade mark. You should be aware that in some countries collective and certification trade marks are not the same as collective or certification trade marks under Australian trade mark legislation. Some countries will require documentation such as rules, and will advise holders of their requirements. Australia does not have ‘guarantee trade marks’.
Filing your international application

International applications which are based on Australian trade mark applications or registrations must be filed through IP Australia.

An international application based on Australian trade mark applications or registrations cannot be filed directly with the IB.

The application form (MM2) can be downloaded from the WIPO website.

We accept completed international applications by the following channels:

- online: through our eServices channel
- by post: download the MM2 form from WIPO’s website or request a paper form by phoning us on 1300 651 010; then post your application to:

  The Registrar of Trade Marks  
  IP Australia,  
  PO Box 200,  
  Woden ACT 2606  
  Australia

To send your fees by post, by cheque, money-order or credit card (Visa or MasterCard only), use the ‘Payment Form for Credit Cards, Cheques and Money Orders’. This form is available from our website. Post the completed form to the address above, along with your money-order or cheque, made payable to IP Australia.

Requesting changes to an international registration

It is not possible to request changes to an International Application until the International Application has been recorded on the International Register and given an International Registration number. You may then apply in writing directly to the IB, or through us to record:

- an amendment to the holder’s name or address
- a restriction to the goods and/or services
- a change in ownership of the international registration
- subsequent designations.

If a change is needed in respect of details of an international application please contact us. This change may not be able to be requested until after an International Registration number has been allocated.

Subsequent Designations:

It is possible to add countries to an international registration at any time. This may be desirable when your markets expand or when other countries join the Madrid Protocol. Requests for subsequent designations may be made through us or direct to the IB. A separate form and fees are needed for these requests. Please read the Subsequent Designations information on our website.

Renewal

Under the Madrid Protocol, renewal of international registrations is due ten years from the registration date as recorded by the IB. The IB notifies the holder or their representative six months before the expiry date. Payment of renewal fees may be made up to six months after the expiry date, however penalty fees apply.
Fees and payment options

How much does it cost?

A handling fee of $100 Australian dollars (AUD$100) applies to each international application filed through us. The handling fee is to cover costs involved in checking, certifying and transmitting the international application to the IB. The handling fee must be paid at the time of filing an international application.

Please note if the international application is filed via eServices customers will pay the international application and IP Australia handling fees, in Swiss francs (CHF), in a single transaction directly to WIPO.

In addition to the handling fee the international application fees consist of:

- **Basic fee**
  653 Swiss francs (CHF) or 903 CHF where there is any colour in the representation of the trade mark
  and

- **Complementary fee(s)**
  100 CHF for each designated country, unless the country requires an individual fee
  and

- **Supplementary fee**
  100 CHF for each extra class over 3 classes.

If all designated countries require individual fees, the supplementary fee does not apply.

and/or

- **Individual fee(s)**
  Currently a large number of countries have individual fees. A country's individual fee can be no higher than the equivalent national filing and registration fees. The list of individual fees is available on the WIPO website.

If the international application is filed via eServices the full fees must be paid to the IB in CHF.

If the international application is filed via the mail the full fees can be paid to either to the IB in CHF or to us in AUD.

If paying directly to the IB, the fee calculation tool on the WIPO website should be used to calculate the amount due in Swiss francs (CHF). Information on the payments methods available through the IB can be found on WIPO's website by searching 'how to pay'.

If making full payment to us, use our *fee calculator*. This calculator enables the applicant to work out how much an international application will cost in both AUD and CHF currencies.
How to pay fees to us

File your completed application with the correct fees:

Using eServices

By VISA or MasterCard when you submit your application through eServices.

For paper applications

By cheque, money-order or credit card (Visa or MasterCard only) using the ‘Payment Form for Credit Cards, Cheques and Money Orders’ available from our website. Post the completed form, along with your money-order or cheque, made payable to us, to:

IP Australia
PO Box 200
Woden ACT 2606 Australia

We will also accept payment (AUD) for other IB fees including renewal fees, subsequent designations, changes to the name and address of a holder, and the transfer of ownership.

Be vigilant – check all letters and invoices

Information, including contact details, about trade mark applications and registrations is available online, including via the internet. Some people may use this information to send letters and invoices to you requesting payment for IP services that you have not requested. They may send you an invoice, or offer to provide a service, such as:

- registering your trade mark
- publishing your trade mark in an international register
- providing you with trade mark monitoring services.

See our website for a current list of companies that send these unofficial invoices, and for examples of the invoices they send. The WIPO website also contains a warning about these companies.

Before paying a fee for any IP-related service, we recommend that you carefully consider what, if any, value the service will provide.

WARNING

Do not pay unnecessary fees!

These companies are not associated with us, WIPO or its International Bureau. The services offered by these companies do not provide official trade mark registration or trade mark rights in Australia or overseas.
What happens after an international application is filed?

First steps - our role as office of origin

We check the international application and the fees payable. When we can certify that the international application meets requirements, the application and the applicable fees are forwarded to the IB.

It is very important that any issues raised by us during the certifying process are responded to quickly by the applicant.

The filing date of the international registration is the date of receipt of the international application by us, providing the international application and our certification are received by the IB within two months of that date. However, if we cannot certify and forward the international application to the IB within two months from the date we receive the international application, the original filing date will be lost and the filing date will be the date the application is received by the IB.

We will also monitor the basic trade mark for at least five years from the date the international application is filed and must notify the IB if it ceases to exist or there is a restriction in its scope.

Next steps - International Bureau’s role

The IB checks that the international application meets their requirements such as classification, formalities and fees. The international applicant and IP Australia will be notified if the IB has any problems with the international application. Contact us immediately if you receive an irregularity notice from the IB about your international application.

When any problems have been overcome the trade mark is recorded in the International Register. The IB sends the applicant a Certificate of Registration and notifies all designated countries. The Certificate of Registration does not mean that the trade mark is protected in any of the designated countries, it must first be examined in each of the designated countries. Details of the international registration are published in the WIPO Gazette of International Marks, on the WIPO website.

Further information about the IB’s role can also be found on the WIPO website.
The role of designated countries

The international registration is examined according to the trade marks legislation and laws existing in each designated country. It is important to note that if the international registration is refused in one country, it does not necessarily mean it will be refused in all designated countries. It is possible for an international registration to attract no objections in some countries but have a notification of refusal issued by others.

A notification of refusal is sent by the designated country to the IB who forwards a copy to the trade mark holder. Refusals must be made within a set time limit - in either 12 or 18 months. In some cases, but only after the holder has been made aware of the possibility, opposition can be lodged after the expiry of these time limits. Countries notifying a refusal are required to provide the IB and the holder with detailed reasons and supporting documentation.

Most countries allow for a review of, or appeal against, a refusal. A full or partial provisional refusal based on examination is similar to a first adverse report in Australia. It will include any ways in which the problems may be able to be overcome.

If no refusal is issued, or it is overcome, the international registration will be protected in the designated country. Protection will be effective from the date recorded on the international registration. In most cases this will be the date on which we received the application for the international registration. Protection in a designated country will give the holder the same rights as if the trade mark had been registered in that country.
A guide to applying for your trade mark overseas

Flowchart of an international application

Note: We are the Office of Origin for Australians seeking protection overseas by filing international applications.

Australia will be a Designated Country for overseas trade mark owners seeking protection in Australia under the Madrid Protocol.

Office of Origin

- National application filed - an international application may be based on this application or on the resulting registration
- International application is filed with us
- We check international application against basic trade mark
- We certify international application and send it to the IB
- If the Australian basic trade mark is restricted within five years of international registration date, we must notify the IB. The IB cancels the international registration to the same extent and notifies designated countries. Holder has three months to file a transformation application in the designated countries and keep the priority date of the international registration.

International Bureau (IB)

- IB checks international application for fees, formalities and classification
- IB registers international application and publishes international registration in its Gazette
- IB sends certificate to holder
- The IB:
  - handles changes to the international registration
  - renews international registrations
  - communicates with the holder, Office of Origin and designated countries

Designated Country

- Examines the international registration in accordance with its national legislation
- Notifies IB of problems (refusal) IB sends the notice to the holder
- Once any problems are overcome, the designated country may advertise the international registration for opposition
- If opposition is filed designated country must notify the IB
- When everything is in order, designated country gives effect to the international registration as if it were a trade mark registered as a result of a national application
Contact us

Our staff will help you and answer your questions, however we cannot assist you on legal matters or provide business advice. You may wish to consult a trade mark attorney, an IP professional, a solicitor experienced in trade mark matters, or your business adviser. See our website for information about how to contact an IP professional.

We subscribe to the Telephone Interpreter Service. If you need help communicating in English, you can phone the interpreter service on 131 450 for the cost of a local call from anywhere in Australia.

All written correspondence regarding trade marks should be directed to:

Post
The Registrar of Trade Marks
IP Australia
PO Box 200,
Woden ACT 2606
Australia

Phone
1300 651 010 (within Australia);
+61 2 6283 2999 (International callers only)

Website
www.ipaustralia.gov.au - for comprehensive information relating to intellectual property, to access IP Australia’s eServices, and to download publications and other documents

Communicating electronically with us

The date you provide information to us can be critical to the certainty of your IP rights.

We have implemented a set of Electronic Business Rules that mean that when you communicate with us electronically (e.g. online), using our preferred method, the date and time of that communication will be Australian Eastern Standard/Daylight Saving Time.

Our preferred means of communication is through eServices - you can register and log in on our website.

We provide these rules to outline the submission requirements for your IP, including:

- identifying the appropriate file formats to submit your service request
- providing a list of electronic payment options.
Privacy of personal information

We are committed to handling personal information in accordance with our obligations under the Privacy Act 1988. Our Privacy Policy explains how we handle personal information, and is available on our website.

Customer service charter

We are committed to providing our customers with excellent customer service and high quality products and services. Our commitments are outlined in our Customer Service Charter, available on our website. We review our charter regularly and measure our compliance each quarter.
## Glossary of terms

<table>
<thead>
<tr>
<th>Term</th>
<th>Definition</th>
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<tbody>
<tr>
<td>Basic Trade Mark</td>
<td>The national application or registration on which the international application or registration is based.</td>
</tr>
<tr>
<td>Contracting Party</td>
<td>Any country, State or inter-governmental organisation which is a member of the Madrid Protocol.</td>
</tr>
<tr>
<td>Designated Countries</td>
<td>Those countries you nominate on the international application form as countries in which you are seeking international trade mark protection.</td>
</tr>
<tr>
<td>Holder</td>
<td>The owner of an international registration.</td>
</tr>
<tr>
<td>International Application</td>
<td>Your international trade mark application before the IB has issued a Certificate of Registration.</td>
</tr>
<tr>
<td>International Register</td>
<td>The IB’s database that contains all international registrations, including details of each designated country.</td>
</tr>
<tr>
<td>International Registration</td>
<td>Your international application after the IB has issued the Certificate of Registration and notified the designated countries.</td>
</tr>
<tr>
<td>Office of Origin</td>
<td>The Trade Marks Office of the country through which the international application is filed. For Australian applicants this is IP Australia.</td>
</tr>
<tr>
<td>Protected International Trade Mark</td>
<td>An international trade mark registration to which protection has been given in Australia.</td>
</tr>
<tr>
<td>RO</td>
<td>Receiving Office - the national office where the international application is filed then checked and processed.</td>
</tr>
<tr>
<td>ROMARIN database</td>
<td>The ROMARIN database is available on WIPO’s website. Use it to search for international applications and international registrations for trade marks.</td>
</tr>
<tr>
<td>Subsequent Designation</td>
<td>Any country that is added to your international registration after the international application is forwarded to the IB.</td>
</tr>
</tbody>
</table>
Appendix: Instructions for filling in the international application form

To ensure that you are using the most up-to-date Application for International Registration forms, please download the current forms from the WIPO website.

If your application is not received by the IB within two months of filing with us, the original date of filing cannot be granted. This may occur where your international application is not completed correctly or the handling fee has not been paid.

Please be very careful when completing the international application form. Once filed the goods and/or services cannot be extended. No changes at all can be made to the trade mark.

Contracting party whose office is the Office of Origin

This is the Protocol country through which the trade mark holder is applying - in this case, Australia.

Applicant

As well as the name, address, address for correspondence, and telephone/fax numbers, the applicant is also required to state either English, Spanish or French as the preferred language for correspondence coming from the IB. All correspondence between the applicant and us however must be in English. Also, all correspondence between us and the IB will be in English.

Entitlement to file

Each applicant is required to state their connection with Australia. That is, each applicant must be either an Australian national, be domiciled in Australia, or have a real and effective industrial or commercial establishment in Australia. If the applicant is domiciled in Australia or has real and effective industrial or commercial establishment in Australia, that address must also be provided.

Representative

This is an optional section to be completed only if the applicant has a representative who will communicate with the IB on their behalf. If the representative has previously been allocated an identification code by WIPO, that code should be given in the space provided; otherwise, that space should be left blank.

Basic application or basic registration

An international application must be based on a trade mark (or trade marks) applied for or registered with us. The owner of the trade mark must be the same as, the mark identical to, and the goods and/or services the same or less than the national trade mark. The number and filing date of the basic trade mark(s) must be included. If you have only recently filed your Australian application and do not yet know the number allocated to it by us, the basic trade mark and date of filing must be described in the covering letter so that we can complete this section.
Priority claimed
The applicant may claim a filing date earlier than the actual filing date of the international application if their first filing of the trade mark in a country party to the Paris Convention occurred within six months prior to filing the international application. A convention claim can be based on the basic Australian trade mark where this international application is filed within six months of filing the Australian application.

The mark
A representation of the trade mark is to be attached to the space provided at box (a). The representation must be identical to the trade mark that is the subject of the basic application or registration.

If the representation on the basic trade mark is in black and white, the representation in box (a) must be black and white. If the representation on the basic trade mark is in colour, the reproduction in box (a) must also be in colour. If the representation on the basic trade mark is in black and white but claims colour as a distinctive feature of the mark (see point 8 below), a reproduction of the mark in colour must also be provided in box (b). The trade mark can be typed, printed, pasted or reproduced on the form.

The representation will be scanned for reproduction in WIPO’s Official Gazette therefore it must be sufficiently clear for this purpose.

The representations must fit in the square area provided on the form and must be no larger than 8cm x 8cm.

If the trade mark is a word mark (that is a word/s rendered in common type script with no embellishments or device elements) box (c) may be ticked. This declaration does not legally bind either the IP Office or courts of a designated country which may have different criteria as to what constitutes standard characters.

Colour(s) claimed
This section is to be completed when the applicant claims colour as a distinctive feature of the mark in both the basic trade mark and the international application (see above).

Miscellaneous indications
Transliterations of the mark is compulsory where the mark consists of or contains characters other than Latin characters, or numerals other than Arabic or Roman numerals. The IB does not require the applicant to provide a translation for trade marks consisting of or containing words in languages other than English. Some member countries however may require a translation before protection can be granted. This section is also for the indication of trade marks which are three-dimensional, sound marks, or collective, certification or guarantee marks. There are no ‘guarantee marks’ in Australia. In some countries a certification trade mark is referred to as a guarantee trade mark, or as a collective trade mark.

Any endorsements included in the basic trade mark which describe the mark itself must be recorded on the international application form. Endorsements concerning the use of the trade mark are not to be included.

Goods and services for which international registration is sought
The goods and/or services claimed must be the same as or less than those claimed in the basic trade mark(s). The exact wording need not be used however the claim may be equivalent to but not broader than the basic trade mark. The applicant must list the goods and/or services grouped in the appropriate class determined by the International Classification of Goods and Services. Each group must be preceded by the class number and where more than one class exists, listed in numerical order.

If the goods and/or services claimed are exactly the same as the basic trade mark the following wording may be used. For example:

<table>
<thead>
<tr>
<th>Class</th>
<th>Goods and Services</th>
</tr>
</thead>
<tbody>
<tr>
<td>16</td>
<td>Exactly as stated in basic application or registration</td>
</tr>
</tbody>
</table>
Designated contracting parties

The applicant is to tick the boxes corresponding to the countries which the international registration is to cover. The space under ‘Others’ is for the designation of countries which have acceded to the Madrid Protocol after the form was printed.

If the European Union (EM) is designated, the applicant must indicate a second language in which third parties may lodge opposition and cancellation proceedings before the Office of the European Community (OHIM). The applicant must choose between French, German, Italian or Spanish, and indicate their choice by ticking the appropriate box. In addition, if the applicant already has an identical mark for the same goods and/or services registered in a member state of the EM they may be able to claim seniority of that earlier mark. Such a claim means that in the event that the earlier mark is allowed to lapse or is surrendered, the applicant will continue to have the same rights as they would have had if the earlier mark had continued to be registered. A claim to seniority must be made on the IB’s official form MM17 and attached to the application form.

If the US is designated the applicant must also complete official form MM18 - the Declaration of Intention to Use the Mark. Both forms MM17 and MM18 can be found on the WIPO website.

Signature by the applicant or his/her representative (optional)

We do not require the application form to be signed.

The Certification and signature of the international application by the Office of Origin will be completed by us.

We must certify that the information contained in the international application form accords with the details of the basic trade mark.