

# THE MADRID PROTOCOL – HOW BRAND OWNERS CAN PROTECT THEIR TRADEMARKS INTERNATIONALLY

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## Introduction

In today's interconnected world, many businesses span multiple jurisdictions. Trademark protection, however, is generally territorial. That is to say, it only applies in countries where registration is obtained. This can make it inconvenient for brand owners to protect their trademarks if they plan to do business in multiple jurisdictions because it would require the brand owner to make a separate application in each jurisdiction. The Madrid Protocol was designed to make this process simpler and cheaper.

## Overview of the Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the "**Madrid Protocol**") is an international treaty that allows a trademark owner to seek registration in any of the participating states ("**Contracting Parties**") by filing a single application, called an international application. The international registration system is administered by the International Bureau ("**IB**") of the World Intellectual Property Organization ("**WIPO**") in Geneva, Switzerland.

The resulting "international registration" serves as a means for seeking protection in member countries. It should, however, be noted that each member country can apply its own rules and laws to determine whether the mark will enjoy protection in their jurisdiction.

After making a basic application in the designated office of the Contracting Party of the basic mark, an applicant can make an international application. They can then select other Contracting Parties in which they would like to seek protection for their mark. If at a later date, the applicant seeks to expand the geographical scope of their international registration, they may designate additional Contracting Parties in a subsequent designation. A subsequent designation may also be used to extend protection to goods or services that were not originally extended to the previously designated Contracting Parties.

An international registration may be maintained in force indefinitely by the payment of the prescribed fees every 10 years. However, in some jurisdictions, there is a requirement for genuine use of the trademark by the proprietor within a certain period after registration, after which the trademark will be liable to be cancelled. Where this period is less than 5 years (for instance in the Philippines, where the period is 3 years), the mark may be vulnerable between the period following the expiry of the genuine use window and the 5-year mark due to the so-called "central attack" vulnerability (discussed in greater detail below).

## Filing a Madrid Protocol application via IPOS

To begin with, applicants must have an existing trademark application or registration in Singapore. They

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must also have a connecting nexus to Singapore, either by virtue of their Singapore citizenship, them being domiciled in Singapore, or them having a real and effective industrial or commercial establishment in Singapore. The scope of the international application must be the same as, or narrower than, the list of goods or services in the basic application or registration. The mark applied for must be identical to the mark in the basic application or registration and under the same proprietor.

Once the basic application is made at the Intellectual Property Office of Singapore (“**IPOS**”), IPOS will forward the application to the IB of WIPO. The intellectual property offices of the designated Contracting Parties (which the applicant has specified he wants to seek international protection in) will then have between 12-18 months, depending on the jurisdiction, to give notice of rejection. If no notice of rejection is received by WIPO in the applicable time period, the application is considered protected in the designated country.

## **Advantages of going via the Madrid Protocol**

The Madrid Protocol is convenient. The application need only be made once at an appropriate office of origin (see the section below), in one language, and gives trademark protection in multiple territories. It allows successful applicants to manage their brand portfolio through a centralised system. There is only one registration to renew, and changes such as a change in ownership or address of the holder can be recorded in the International Register through a single, simple procedural step. Expansion into new markets is also much less complicated, as additional countries can be added to the international registration by way of subsequent designation.

The Madrid Protocol also has a global reach. There are more than 100 participating states in the Madrid Protocol, including, at the time of writing, the United States, China, Japan, Australia, most of Europe and most of ASEAN (Brunei, Cambodia, Indonesia, Laos, Philippines, Singapore, Thailand and Vietnam), representing 80% of world trade. From the date of the international registration (or, in the case of a Contracting Party designated subsequently, from the date of that designation), the protection of the mark in each of the designated Contracting Parties is the same as if the mark had been the subject of an application for registration filed directly with the Office of that Contracting Party.

As a result of the above, the Madrid Protocol is a cost-effective means of protecting one’s brand worldwide, as only one application in one language is needed. This eliminates the need to engage representatives in multiple jurisdictions, pay multiple application fees and engage translation services in multiple languages to enjoy protection in multiple countries.

## **Disadvantages of going via the Madrid Protocol**

The major drawback of going via the Madrid Protocol is the so-called “central attack” vulnerability. Article 6 of the Madrid Protocol provides that an international registration will become independent from the basic mark after 5 years from the date of international registration. Put another way, for a period of 5 years from

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the date of the international registration, the protection resulting from the international registration remains dependent on the basic mark.

Therefore, if the basic mark ceases to have effect, either partially or entirely, during the initial 5-year period, or later on as a result of proceedings initiated during the said period, the protection of the international registration will be cancelled and all designations will cease to have effect to the same extent as the basic mark.

This may happen, for example, if the basic mark lapses (due to a failure to renew), is refused or withdrawn, is registered for a narrower range of goods/services or if it is the subject of a final decision of rejection, revocation, cancellation or invalidation. If within the 5-year window, the basic mark's specification is narrowed in its original jurisdiction, the narrower specification will be applied to the international application.

This provision allows for "central attack," the possibility of a third party initiating an action against the basic application or registration that, if successful, results in the cessation of the entire international registration.

In such an event, IPOS will notify IB WIPO of the ceasing of the effect of the basic mark. To mitigate the harshness of this, the Protocol allows for the international registration to be transformed into a national application. Singapore has adopted this approach. This means, for example, if an international registration originating in Australia was invalidated there, the applicant can, if he applies within three months of the cancellation of the international registration, apply to IPOS to have the mark registered as a national application in Singapore. The international registration filing date will be treated as the filing date, that is, the international registration filing date is not "lost". If, however, IPOS was the originating office, and the mark was cancelled at the request of IPOS, the mark holder may choose to apply for transformation in the other Contracting Parties where he previously had an international registration. Do note that the transformation requirements in other Contracting Parties may differ.

## Conclusion

As the Internet makes doing business across borders ever simpler, brands and business owners will see an increasing need to protect their intellectual property in multiple jurisdictions via trademark.

Notwithstanding the presence of some inherent vulnerabilities as above mentioned, the Madrid Protocol provides a convenient, cost-effective means of achieving this objective.

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