

International Protection fo Trademarks in Connection with Brand Expansion

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Local entrepreneurs are more and more often taking actions aimed at protecting their trademarks abroad.

The presence of products bearing local trademarks in foreign markets is becoming more and more common. The shaping of an international nature and increased recognition of trademarks usually starts from the development of a distribution network through obtaining new sales markets and concluding commercial contracts with foreign entities. While planning activity in other territories, it is advisable to ensure trademark protection in the selected jurisdictions. Trademark protection is based on the rule of territoriality. A global brand usually emerges when their trademarks are protected in a majority of countries worldwide. An applicant has three types of applications available:

- domestic (before local trademark office),
- international (through the Madrid system) or
- regional (i.e., covering the entire European Union).

When planning the brand development strategy, the status of the protection for trademarks must be verified and the territories, which should be protected, must be selected. In the absence of any protection, the most important distinctive marks of

the entrepreneur (e.g. company name or logo) differentiating it from its competitors, with whom the entrepreneur is associated by consumers, should be verified. One should also check registers and databases of trademarks in order to ensure whether an identical or similar trademark is not subject to registration by another entity operating in the market.

A majority of entrepreneurs first register their trademarks in the local IP office, which is a proper solution, as this trademark application can be a basis for further applications for other countries through the Madrid Protocol or Madrid Agreement. The main purpose of the international system of trademark registration is to facilitate the registration procedure in the member states of the Madrid Union (currently 116 states). As a result of one registration or one base trademark application, the applicant obtains a possibility to apply for protection in the country of origin and in all selected member states, provided the system guarantees an identical scope of protection granted as to the one granted upon direct registration of the trademark in the selected country.

The Madrid system is managed by the International Office of the World Intellectual Property Organization (WIPO) with its registered office in Geneva. The Madrid system is based on the following international agreements (i) Madrid Agreement Concerning the International Registration of Marks of April 14, 1891, and (ii) Protocol to the Madrid Agreement adopted on 27 June 1989.

The rules for international registration are as follows. After obtaining registration or filing a trademark application in the IP office of the country of origin, an application for registration is filed with the International Office of WIPO through a local IP office of the country of origin. A condition for applying for international registration of a trademark under the Madrid agreement is obtaining of the registration in the country of origin and, under the Madrid Protocol, it is the mere filing of a trademark application or obtaining of its registration in the country of origin.

Filing of an international trademark application must contain, among other things, a representation of the trademark, which must be identical to the trademark specified in the main registration or the main trademark application, as well as a list of goods and services to be covered with protection. The International Office of WIPO collects fees for international applications, the amount depends on whether the trademark is black and white or coloured, and how many countries and classes of goods the trademark application refers to. Upon selection of a few territories, these fees are relatively lower than the filing of independent domestic trademark applications, which is a non-disputable advantage of international applications.

Entrepreneurs acting only in the European Union can benefit from protection on the basis of filing a European Union trademark application made directly in the European Union Intellectual Property Office (EUIPO, formerly OHIM, with its registered office in Alicante, Spain). In accordance with the rule of territoriality, a European Union trademark is valid in all European Union member states, irrespectively of the exclusive rights granted on the basis of national trademark protection systems. Such trademark can be subsequently a basis for filing an international trademark application covering other member countries of the Madrid Union.

Possession of an extensive trademark portfolio is positively perceived by foreign

business partners. They are informed in this way that the entrepreneur is concerned about the protection of intellectual property rights, that it also respects the same in relation to the rights held by other entities operating in the market, and that it puts effort into increasing the value of its own assets. Submission of trademark applications on the territories on which industrial or commercial activity is conducted also prevents unfair competition of entities which want to steal the rights to the brand and benefit from its earlier reputation.

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