

INTERNATIONAL TRADEMARK

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Duration

Registration of an international trademark covers 10 years from filing date of the application, and can be renewed for an unlimited number of times for 10-year periods.

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International Conventions

The Paris Convention.

The Madrid Agreement (1891) concerning international registration of trademarks was revised in Brussels (1900), Washington (1911), The Hague (1925), London (1934), Nice (1957), Stockholm (1967), and amended in 1979.

Under Article 3bis of the Nice or Stockholm Act, all countries signatory to the Madrid Agreement declared that they were not protected by international registration unless requested by the owner of the trademark.

A Protocol (1989) to the Madrid Agreement concerning international registration of trademarks.

The Madrid Union comprises the countries signatory to the Madrid Agreement and of the contracting countries to the Madrid Protocol.

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Area covered

The international trademark is valid in all countries signatory to the Madrid Agreement and/or Agreement. An updated list of the countries comprised in the Madrid Union, which, as from October 1 2004, also includes countries of the European Union (EU), can be consulted in the download area of our web site.

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What is an international trademark?

Unlike the Community trademark, the international trademark is not supranational in the sense of conforming to rules the same for all countries signatory to the Convention, but only offers a centralized procedure for filing an application to register a trademark in a plurality of designated countries which, apart from one or more that for some reason refuse it, gives rise a number of independent national trademarks according to the countries specified in the application to register.

It follows that the national trademark accepted in the single countries signatory to the Convention, can qualify as an international trademark.

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Procedures

Filing an application for an international trademark must be preceded by one to register it in the country of origin or by an application for registration in the European Union.

Starting from the date on which the application was filed in the country of origin, a period of six months begins during which the right to priority can be affirmed in order to establish the novelty of the trademark in each country. As from October 1, 2004 it is also possible to claim priority for an application to register a trademark in the EU.

The different possibilities are therefore as follows:

- Filing the application for an international trademark with the Italian Patent and Trademark Office (UIBM) if the application for domestic registration was filed there for the trademark now to be made international. UIBM then forwards the application to the Geneva office of the World Intellectual Property Office (WIPO).
- Filing the application to register an international trademark with the Office for Harmonization in the Internal Market (OHIM) at Alicante, Spain if the application was made there for a Community trademark now to become international. OHIM forwards the application to the Geneva office of the World Intellectual Property Office (WIPO).
- Filing the application to register an international trademark directly with the Geneva office of the WIPO, stating priority acquired in the country of origin, or that of the Community trademark.

The application to register (in French or English) must include indication of one or more classes of products or services to which the trademark will apply, making reference to the international classification of products and services listed in the Nice Agreement of June 15, 1957, and subsequent alterations.



The International Office at Geneva forwards the application to register the trademark in the individual designated countries; these have 12 or 18 months time, from the date of communication, to reject the application to register if the legal basis is lacking to make the trademark valid in that country; otherwise the application will be registered.

A single country can refuse registration of an international trademark if the authorities of that country do not recognise its validity.

Opposition, within a previously established term, can be made to national registration by anyone who has a legal right to do so.

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Aspects of protection

Judicial protection is the form established by the legislation in force in each single country.

The countries signatory to the Paris Union Convention that have not signed the Agreement on the 'International Trademark', can in any case make individual national filings maintaining the priority clause.

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