

## Intellectual Property & Technology

### Applying for Trade Mark Protection in Multiple Jurisdictions (Part I): The Madrid System

#### Background

The trade mark registration system in Hong Kong and most other jurisdictions only confers territorial protection. For instance, a Hong Kong-registered trade mark (other than a well-known trade mark) will not be afforded protection in Taiwan to the same extent as trade marks registered there. In order to have its trade mark rights comprehensively protected, it is most often recommended for a trade mark owner to apply for registration in every jurisdiction where its business interests lie or could potentially lie. International registration through the Madrid System is a means designed to facilitate such multi-jurisdictional trade mark registration.

#### The Madrid System

Under the Madrid System, a qualified trade mark applicant may file an international application through the trade mark office where the applicant has filed a domestic trade mark application<sup>1</sup> or obtained a domestic trade mark registration (the “**Office of Origin**”). In the international application, the applicant is required to designate the jurisdictions in which registration is applied for. If any of those jurisdictions accepts the international application, the applied-for trade mark will be registered and protected likewise as a domestic trade mark registration in such jurisdiction(s).

#### Procedural Steps

##### Application to the Office of Origin and its certification

To qualify for the Madrid System, an applicant must file its international application to the Office of Origin on the prescribed form and specify the jurisdictions to which the protection is sought therein. The Office of Origin will proceed to certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of certification, in the domestic application or registration. The Office of Origin will then send

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<sup>1</sup> This only applies to international applications designating contracting parties to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (the “**Madrid Protocol**”), or contracting parties to both the Madrid Agreement Concerning the International Registration of Marks (“**Madrid Agreement**”) and the Madrid Protocol.

the international application to the International Bureau (the “**IB**”) of the World Intellectual Property Organisation (the “**WIPO**”) for its formalities check.

#### Formalities check by the IB

The IB will check that the international application complies with the requirements of the Madrid Agreement and/or the Madrid Protocol and any other applicable provisions. If the IB finds irregularities in the international application, both the applicant and the Office of Origin will be informed and given 3 months to remedy.

#### Registration, publication and notification

If the IB is satisfied that all the filing requirements are met, the IB will register the mark in the international register, notify the international registration to the trade mark office of the designated jurisdictions, and publish the international registration in the WIPO Gazette of International Marks.

#### Substantive examination by the designated jurisdictions

The IB will notify the trade mark offices of the designated jurisdictions of the extension of the international application to them. The offices will handle the substantive examination in accordance with the respective local laws and procedures. The offices have the right to refuse protection as if the mark had been filed directly with the offices concerned.

#### Notification of refusal or grant of protection

Each designated jurisdiction should notify the IB of its refusal, if any, within 12 months from the date on which the trade mark offices concerned were notified of the designation. If no refusal is notified to the IB within the prescribed time limit or the refusal notified has been withdrawn subsequently, the mark is protected in the designated jurisdictions as if it had been registered by the trade mark office of those jurisdictions.

### **Comparison with Filing Individual Domestic Trade Mark Applications**

The advantage under the Madrid System is apparent: an applicant may apply for registration in one or more jurisdictions by filing a single application (in a single language) with the Office of Origin and paying one set of fees. If a trade mark owner has business interests in a large number of jurisdictions, filing a single international application may save costs whether at the application phase or at subsequent renewals or recordation of changes, and may facilitate management of its trade mark portfolio. An application can also be subsequently made to extend the international registration to other jurisdictions which were not initially designated.

Nevertheless, a major weakness of the Madrid System is what has become known as the “central attack”. Any refusal, withdrawal or cancellation of the domestic application or registration at the Office of Origin within 5 years of the registration date of the international registration will lead to the refusal, withdrawal or cancellation of the international registration

in the same manner. Although the refusal, withdrawal or cancellation of the international registration can be remedied by transforming the international registration into domestic applications in each designated jurisdictions, this could incur much more time and costs than filing individual domestic applications at the outset.

Another weakness lies in the availability of the Office of Origin. An international application must be made in a jurisdiction where the applicant has a real and effective industrial or commercial establishment in, or is domiciled, or is a national. While most advanced economies (including China) are contracting parties to the Madrid Agreement and/or the Madrid Protocol, **Hong Kong is not**. A Hong Kong-based entity would be required to employ a Chinese or foreign affiliated company to apply for domestic and international registration and subsequently record an assignment of the trade mark registered under the Madrid System back to the Hong Kong-based entity. This could incur obstacles and further costs and therefore may render the Madrid System not desirable for those entities.

Although the Intellectual Property Department of Hong Kong conducted a consultation (which ended in February 2015) on the proposed application of the Madrid Protocol to Hong Kong, the views received were mixed. It is therefore unknown whether and when Hong Kong will become a contracting party to the Madrid Protocol.

## Concluding Remarks

Whether an international application under the Madrid System could save costs and be more efficient than individual domestic trade mark applications depends on several factors. With the risk of “central attack” in mind, it is prudent to consult local trade mark agents about the risk of refusal, revocation or withdrawal of the domestic application or registration before the Office of Origin, before considering applying for international registration under the Madrid System.

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**Important:** The law and procedure on this subject are very specialised and complicated. This article is just a very general outline for reference and cannot be relied upon as legal advice in any individual case. If any advice or assistance is needed, please contact our solicitors.

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