

## INTERNATIONAL TRADEMARK REGISTRATIONS

Since June 17, 2019, Canadian businesses have been able to file trademark applications in other countries through the Madrid System for the international registration of marks.

This system permits Canadian businesses to file a single trademark application through the Canadian Intellectual Property Office (CIPO) to register the mark in multiple countries. Foreign businesses will similarly be able to extend their trademark rights into Canada by filing a single trademark application through the intellectual property office in their country.

The entire system is centrally administered by the World Intellectual Property Office (WIPO).

### What is an International Trademark Registration?

An “international trademark registration” is recorded on the “international register” maintained by WIPO. Unfortunately, these titles are somewhat misleading. Recording an “international trademark registration” on the international register does not automatically grant the registrant exclusive worldwide rights in the mark.

The “international register” may be better described as an international database of trademarks registered in multiple jurisdictions. The system for recording trademarks on the international register is governed by an international treaty known as the Madrid Protocol.

Each trademark on the international register is referred to as an “international trademark registration”, but it is in fact a collection of protocol applications/registrations for the same mark in multiple countries.

### Components of International Trademark Registration

Each international trademark registration has multiple components:

- First, the applicant must have a pending “basic application” or an existing “basic registration” in their home country. The goods and services identified in the basic application/registration must be assigned to one or more classes according to the Nice Classification System prior to filing the international trademark application.
- Second, the application for an international trademark registration must designate each foreign jurisdiction where they want a corresponding application for the same mark to be filed. These are known as “protocol applications” and, if they mature to registration, they become known as “protocol registrations”. Thus, an international trademark registration will contain multiple protocol applications/registrations.
- Third, each protocol application must identify the goods and services to be associated with the trademark in the designated jurisdiction and assign those goods and services to one or more

classes according to the Nice Classification System. The identification of goods and services associated with the trademark may not be the same in all designated jurisdictions, but cannot be broader than those included in the basic application.

### **International Application Not Subject to Substantive Examination**

After filing, the international application will only be examined to ensure that it satisfies formal requirements such as the identification of a corresponding basic application and payment of the required fees. If there are no objections to these formalities, the international application will mature to an “international registration”. Once accepted by WIPO, the registration date for an international registration will be its effective filing date with WIPO. If the international application is filed within 6 months after filing the basic application, it may claim priority from the filing date for the basic registration but this does not affect its registration date.

### **Protocol Applications Subject to Substantive Examination**

After filing, each protocol application is subject to substantive examination by the trademark office in each designated jurisdiction based on domestic law and each designated jurisdiction is entitled to demand amendments and/or refuse registration for the applied-for-mark. Thus, a protocol trademark application may be accepted in some designated jurisdictions and refused in others where the applied-for-mark is considered generic or a third party has prior rights in a confusingly similar trademark.

### **What is the Nice Classification System?**

The Nice Classification System is a standardized classification system defined by another international treaty known as the Nice Agreement. It organizes goods and services for the purpose of filing trademark applications into 34 classes of goods and 11 classes of services.

Generally speaking, goods are classified according to their purpose or function, and by the material from which the good is made. Distinction is also drawn between finished products and raw materials or partially processed goods. Services are grouped broadly. Applicants may find that their product lines and services span multiple classes. Consider a jewelry store. The retail sale of jewelry is a service within class 35. Jewelry appraisal is a financial service in class 36. Jewelry repair is a service in class 37 while the casting or manufacture of jewelry for others is a service in class 40. As goods, articles of jewelry fall under class 14 as goods made of precious metals.

The Nice Classification System is a formality for the administration of the trademark registers and has no substantive impact on the scope of the trademark registration in law. This means that when evaluating two similar trademarks for confusion, the fact that the goods and services associated with each mark are assigned to a different class is not significant. For example, the registration of confusingly similar marks associated with the retail sale of jewelry (class 35) and jewelry repair (class 37) is still likely to be prohibited despite the services being assigned to a different class since those services are sold in the same lines of trade. As a result, there is no appeal from any disagreement with

WIPO respecting the classification of goods and services.

### **How Much does it Cost to File an International Application?**

If there is no existing registration in Canada, the applicant will first have to incur the cost to file an application to register the mark in Canada which can serve as a “basic application” for the international trademark application. If there is an existing registration in Canada but the goods and services have not been assigned to one or more class in accordance with the Nice Classification, the applicant will first have to incur the cost to file an application in Canada to so classify the goods and services. The “basic application” must include ALL the goods and services that may appear in any of the protocol applications filed in designated jurisdictions.

There is a standard fee of 653 Swiss Francs for each international trademark application containing up to three classes of goods and services and for which there is no colour claim. The payment of an additional 100 Swiss Francs is required for each additional class of goods and services beyond the initial three classes. If colour is claimed as a feature of the applied-for-mark, the payment of an additional 250 Swiss Francs is required. At present, the Swiss Franc is approximately equal to the value of the US dollar.

In addition to the foregoing, most countries will require payment of an individual filing fee which varies from country to country, sometimes depending again on the number of classes involved and whether colour is claimed as a feature of the applied-for-mark. Obviously, the filing costs increase with the number of designated countries and, at

present, more than 100 countries may be designated. To reduce costs, the international application and/or the protocol applications for some designated jurisdictions may not include all the classes of goods and/or services identified in the basic application if the goods and/or services assigned to that class are not offered by the business outside Canada or in the designated jurisdictions.

To get an estimate of the anticipated costs, WIPO provides a convenient calculator on its web site at

<https://www.wipo.int/madrid/en/fees/calculator.jsp>.

### **Why File International Trademark Applications?**

Blaze IP files trademark applications on behalf of its Canadian clients in other jurisdictions by retaining a local trademark agent to file the application on its behalf. This traditional means of filing foreign trademark applications can be expensive and wasteful, especially for routine trademark applications that attract no substantive objections from the foreign trademark office and require no knowledge of local laws and procedures.

The centralized system provided by the Madrid Protocol makes it possible for a Canadian trademark firm like BLAZE IP to file trademark applications in multiple foreign jurisdictions through CIPO in English or French. Although a few jurisdictions still require the appointment of a local attorney or “domestic representative” after filing (including the US), protocol applications which encounter no substantive objections may mature to registration in designated jurisdictions without incurring the cost to retain any local trademark agents. Generally,

local agents will only be required if a protocol application in a designated jurisdiction attracts substantive objections or a third party opposes the application.

In addition, assignments, renewals and changes of address may be recorded simultaneously through WIPO for the international registration and all protocol applications. Again, this can avoid the cost of retaining agents in multiple foreign jurisdictions to record such routine changes.

Finally, designated jurisdictions are required to comply with certain time limits for processing protocol applications. In the absence of an opposition or substantive objections, a protocol application should mature to registration within 18 -24 months after filing. This can be beneficial in some countries where the examination and approval of trademark applications can be notoriously slow.

### **When do International Trademark Registrations Expire?**

International trademark registrations must be renewed every 10 years. The deadline for renewal of an international trademark registration and ALL its related protocol applications is calculated from the registration date for the international registration.

Each protocol application must be renewed at the same time as the international trademark registration even if they have not yet matured to registration or matured to registration in the designated jurisdiction at a later date. As a result, the initial term for each protocol registration may be less than 10 years in the designated jurisdiction.

The international trademark registration may be renewed for some or all of the designated jurisdictions. The protocol registrations for each designated jurisdiction can also be renewed for some or all of the identified goods and services.

### **What are the Risks of using the International Trademark Register?**

The primary disadvantage of the Madrid System is that for five years after its registration date, the international trademark registration is dependent on the basic registration. Any changes to the basic registration during the five-year dependency period, such as the removal of some goods and services, will flow through the international registration and each protocol registration will be automatically amended to match the basic registration.

Thus, a successful central attack on the validity of the basic registration, either in whole or in part, within those first five years may result in the simultaneous amendment or expungement of the corresponding international trademark registration recorded by WIPO and ALL of the protocol registrations in each designated jurisdiction. After the five-year dependency period expires, the scope and validity of the international registration and the protocol registrations become independent of the basic registration.

It may therefore be unwise to file foreign applications through the Madrid System where there is reason to believe the validity of the basic application/registration may be contested.

If the basic registration has been registered in Canada for more than five years, it is generally immune from expungement unless: (i) it is no longer being used for the identified goods and services in Canada; or (ii) it has become a generic term to describe the identified goods and services in Canada.

### Where to Get More Information?

The Madrid System represents an exciting opportunity for Canadian businesses to protect their trademarks at the international level. However, it is a complex system and we recommend that the assistance of knowledgeable IP counsel be sought to ensure that the efficiencies are realized and the substantial filing fees are not squandered.

You can get more information about the Madrid System by visiting the web sites for:

#### **Canadian Intellectual Property Office**

<http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr02322.html>

#### **World Intellectual Property Office**

[www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/)

Or by contacting:

#### **BLAZE IP**

McMaster Innovation Park  
175 Longwood Road South, Suite 102  
Hamilton, Ontario L8P 0A1

T: 905-572-9300

[www.blaze-ip.ca](http://www.blaze-ip.ca)