

FILING FOR TRADEMARK PROTECTION INTERNATIONALLY

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A client recently asked a very interesting question relating to filing trademark applications internationally, namely, whether they can register all their trademarks as international trademarks **instead** of just Canadian trademarks?

The short answer is yes and no, you can register all of your marks wherever you want to **use** them, anywhere in the world. However, at its base, trademark protection is **national** or regional in nature.

There is an important principal in international law that may help to understand how the system works. Countries are sovereign and control their laws and court systems. International treaties are concluded between countries to align laws and regulation to attain common goals and facilitate international trade. The treaties are agreements between countries to adopt or change their existing laws, rules and procedures to make them more uniform. International organizations **manage** international agreements or treaties. Once a treaty is concluded, each member country makes changes to its national laws in accordance with the treaty to make the rule more uniform between the participating countries. However, each country is still sovereign and in control of its own laws, rules, procedures, courts and administrative agencies, so these are often interpretation by the courts and offices in slightly different ways.

Legal rights can only be given by recognized territorial authorities (i.e., countries, states, provinces, etc.). Therefore, to have national legal rights, trademark applications must be filed **in each country** protection is sought in.

The term “international” registration is understood to be a registration that is made in more than one territorial jurisdiction, but it does not necessarily mean in every country.

To be clear, there is no worldwide blanket or international trademark registration. However, “international” or multi-jurisdictional trademark registrations do exist. For example, a European Union trademark registration is registered at the European Intellectual Property Office (“EUIPO”) and is valid in the now 27 member countries¹.

The European Union forms an internationally recognized legal jurisdiction or territory with its own laws, regulations, and courts.

This being so, member countries also have their national trademark registry, where the mark can be registered instead of, or in addition to, the European Union’s register. For other countries such as Canada, the United States of America, Mexico, China, the registration must be placed on the national register to secure trademarks rights in such territories.

¹ As of December 31, 2020, the United Kingdom left the European Union. As a result, a European trademark registration no longer has effect in the UK. Please consult your trademark professional to learn more about the transitory provisions in place to safeguard rights.

What may also cause questions to be raised is the World Intellectual Property Organization (“**WIPO**”) international trademark database that merely lists registrations worldwide but does not grant rights in of itself.

There are other considerations that I will only briefly allude to such as international filing priorities which require that the first application filed anywhere in the world be done in the home country before filing in any other country in order to fully benefit from this right. In addition, to be able to file using the international filing system discussed below, some countries, such as Canada, require that a national (domicile) application be filed to gain access to the international system.

There are two ways to obtain trademark protection internationally, namely:

- 1) file an application to register the trademark directly in the desired country or countries with direct national applications filed at the national trademark offices (using a trademark agent located in the target countries); or
- 2) file an application using the international **central filing system** where an application is filed at a central service, and this central service dispatches it to each country where protection is desired. This is what the Madrid Protocol system does.

If you were to file an application in several countries going the national route, for example, in the United States of America, Russia, China and Italy your trademark agent would need to:

- 1) Hire a local trademark agent in each country to file the applications;
- 2) Translate the applications into the official language for each country, in this example into Russian, Chinese and Italian;
- 3) Pay the national fees in each currency at each national office; and
- 4) Be subjected to the varying delays each country has to complete the registration process.

The Madrid Protocol makes it easier to do so, but it is not a trademark registration in the pure legal sense. For example, if trademark rights are being infringed in the United States, procedures would need to be filed in US courts where the infringement is happening to be able to enforce rights. A national US registration or a national designation of the international file is also necessary to have legal standing and benefit from the national laws.

The Madrid Protocol is an international treaty relating to trademarks covering 123 countries and representing more than 80% of world trade. Canada became a member of the Protocol on June 17, 2019. WIPO, located in Geneva, Switzerland, manages this treaty. Simply put, the Madrid Protocol is an international trademark **filing system** where trademark owners can file an application with WIPO and designate as many member countries as they would like to have trademark protection in. Once filed, a file or “registration” number is provided to the trademark applicant, but because WIPO is not a country with jurisdiction or territory, there are no national or territorial rights granted per se.

What the Madrid Protocol does, is makes it easier to file applications in many countries at the same time by using the original national application. But to do so, there must first exist a country-of-origin application to file at WIPO.

Once a Canadian application is filed and an application number is issued, access can then be had to the WIPO electronic system. Countries are then chosen or designate where protection is sought.

You may have deduced some of the practical advantages to using the international system. As a base, the international application is filed using the same information contained in the existing country of origin application. So, there is but one form to complete, and in one language. At this initial filing stage, there is no need to use a foreign agent, nor to translate the original application into the official languages of the target countries. Furthermore, all the different national fees are calculated and paid directly to WIPO in one currency (Swiss Francs). The international system then reviews the central application to ensure that it conforms to the internationally agreed criteria, and once confirmed, distributes the filing information and the funds to the designated countries.

Each country then examines the application according to its national laws to ensure that they are respected. If objections are raised by the national offices (i.e. some elements do not respect the country's laws) or a refusal due to national legal reasons (i.e. a mark is already registered in that country and would cause confusion with the proposed mark) the national trademark office sends a notice to WIPO, who then transmits the notice to the original filing agent or owner requesting a response. In other words, **WIPO is a filing central**.

For many countries, using the Protocol works well as their laws are quite similar to each other. However, for some countries this may be more complicated because the national rules are not completely aligned and may be more or less demanding with varying results. For example, Canada has some of the most demanding rules in the world regarding the specificity of the description of goods and services related to the mark. Furthermore, the requirement that a mark must be inherently distinctive to be allowed registration may prevent mark registered in one country to be accepted in Canada. When foreign trademark owners file an application in Canada using the international system, there often are objections from the Canadian Intellectual Property Office because the Canadian rules have not been respected in the original application as such rules are not known nor do they apply in the original filing country. Conversely, when a Canadian application is sent by WIPO to the designated countries, very often there are objections because the rules of the other countries do not align with the Canadian rules under which the base application was filed. Local legal counsel must then be engaged to properly respond and address the issues raised in the objection letters. This often ends up costing more and delaying the application process.

Therefore, when clients want to file trademark applications in other countries where the legal requirements are known to be different, I recommend and use a local agent to file a national application directly, and do not use the Madrid Protocol. The costs end up being about the same, and the process is faster as we usually can avoid unnecessary objections or refusals with the local agent's knowledge and expertise on the national law. You may save money initially by filing an application using the Madrid system, but you end up having to pay later when there is a need to hire a local agent to make the necessary national modifications in each country.

For other countries where the rules are more flexible and they allow broader descriptions of goods and services, it is often advantageous to use the Protocol.

As you can ascertain, there are strategic considerations. For example:

- 1) Knowledge of, or access to information about the different national legal requirements is essential in order to decide whether or not to use the Madrid Protocol system;
- 2) the Protocol provides that each country must address registration process within 12 to 18 months. There are no guarantees or limits for direct national applications;
- 3) If, for some reason, the country or origin application has a problem with the registration process (is refused, is opposed and procedures continue for several months or years, or the resulting registration is attacked or cancelled within the first few years (this is referred to as a "central trademark attack")) all of the international applications based upon this home application would fall like dominos. There is however a limited time to convert the international designations into individual national applications with the necessary conversion costs this would imply in order to maintain and continue protecting your rights; and
- 4) Some countries allow for very broad descriptions of goods and services, whereas Canada is VERY strict requiring a high level of specificity. If an international application is filed based on a Canadian application, the protection could be much more limited (specific) than if an application were file directly in Europe using the broader description affording much wider protection.

There are many issues to take into consideration when discussing and planning strategy and a budget to file for trademark protection. In some cases, it may be a great idea to use the international system, in other cases, not so much. Each case is different, so it is therefore important to discuss strategy with an experienced and knowledgeable trademark agent before deciding.

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