

TRADE MARKS

International Trade Mark Protection

Trade mark registration grants the owner exclusive rights to use the trade mark throughout all states and territories of Australia; however, an Australian trade mark registration only secures your rights within Australia. If you wish to sell your product or services in other countries,

There are two ways an IP owner may file an application to protect their trade mark overseas:

1. A single international application via the Madrid Protocol
2. National applications filed directly into each country of interest



The Madrid Protocol

Australia is party to an international treaty called the Madrid Protocol. There are nearly 100 countries that are currently signatory to the Madrid Protocol. A full list of these countries is available on www.wipo.int.

Filing international trade marks utilising the Madrid system, allows for the filing of trade mark applications in a number of countries in one application. Our firm files the application directly, and it is only necessary to engage foreign Associates if an objection is raised in a particular country. In that case, we need to engage a foreign firm to enter as your representative in that country and prosecute the application on your behalf.

It is also possible to make subsequent designations under the Madrid Protocol, if you wish to add countries to the international registration at a later date.

This method of filing means that over the life of the application our firm will charge for the filing of the application and all steps taken in prosecuting the application to acceptance and registration in each country, whilst our Associates only charge if they are required to answer an objection.

First to file vs. first to use

Different countries have different rules when it comes to recognition of trade mark rights. A first to file trade mark system grants rights to the person who first filed a trade mark application, even if another party can show prior use of the trade mark. Some countries which follow a 'first to file' system include China, Italy, Austria, Portugal and Sweden. Australia does not follow the first to file rule. Even if you have not yet registered a trade mark, you might have some common law claim over it if you can show your business has been using it in the past.

Brand owners who export goods to, or manufacture goods in, any 'first to file' countries should file their trade mark application as early as possible to minimise the risk of another party obtaining the rights for that trade mark.

FIND OUT MORE

We recommend that you speak with one of our Attorneys regarding your IP protection needs. There is no obligation and no fee for an initial meeting. We will advise the required steps and costs involved. Please contact us for more information.

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