

THE INTERNATIONAL TRADE MARK SYSTEM

The international system allows us to file one application covering several countries.

The Application is filed at the World Intellectual Property Office (“WIPO”) and all administration is then handled centrally at this office (such as changes of name, assignments, renewals etc).

Not all countries subscribe to the international system and so it is not always an option for overseas applications. However, most of the main markets do, and we can advise when developing your filing strategy which of the countries of interest are covered.

As we can file one central application and remove the initial requirement of local attorney involvement in each territory, this is often the most cost-effective route for obtaining international protection in a number of countries. It can also be faster, as the WIPO impose time limits on local offices for examining applications.

However, when filing via this system, you should be aware of the following limitations:

1. You must have a ‘base’ application in order to file an international application;
2. This ‘base’ will form the basis of the entire international application, meaning that the list of goods/services must mirror, or be wholly included within the list within the base, and all other details (such as owner name, address) must be the same. This can sometimes limit your ability to tailor a specification to address local practice rules/issues and can therefore lead to time later on addressing those issues;
3. The international application is reliant upon the base for the first 5 years of its life. This means that if anything happens to the base, it will have a knock-on effect on the international. So, if the list of goods is restricted in the base, the international will also be restricted and if the base is removed from the Register, the international will also fall down and be vulnerable to removal. If you wish to keep the international protection at that stage, you then pay fees to convert the central application into national filings in each country. For this reason, having a stable base application/registration is important.
4. In some countries, you will not receive a certificate from the local office if you file via the international system; these must be actively requested and paid for.

National filings

The alternative to filing via the international system is filing direct at each local office, generally with the assistance of a local attorney in each country. This often means you can tailor a specification to comply with local practice to try and avoid issues during the examination process. It also means will receive a local certificate. In China, local filing can be particularly helpful so it may be discussing this with your Attorney before deciding how to file there.

In terms of timing, depending on the country, national filings can be faster or slower than using the international system; some local offices react much more quickly when you file locally but some still take months (sometimes years) to process an application, in which case this route will be slower.

From a cost perspective, this route is almost always more expensive due to the local attorney involvement. It will also mean higher renewal costs in the future and a greater admin burden when it comes to recording changes in ownership and the like. However, it can save money during the prosecution stage as you can pre-empt possible issues.

Equally, some countries only allow single class applications, meaning you cannot file multiple classes in an individual application and will therefore need to file an application for each class, again often increasing costs.

