

Protecting your trade marks overseas

Updated July 2020

FB Rice provides a central point of contact for protection of your trade marks throughout the world. We bring the same expertise to protection of trade marks wherever needed.

It is possible to file applications overseas using a number of systems and we will work with you to develop the most appropriate global filing strategy depending on your business plans and budget. The official fees and overseas associates charges (where applicable) vary from country to country and depend on the registration regime used.

1. International Registration under the Madrid Protocol system

This is an “international registration” allowing you to file a single application designating the countries or territories of interest. The whole of the European Union (EU) can be designated as a single region. The costs vary depending on the countries/territories designated. There are over 100 countries in the Madrid Protocol system – see the list of the Madrid Protocol Members on our [Resources page](#).

To file an international application you must have either an Australian or New Zealand trade mark application or registration. The international filing undergoes preliminary examination for formalities at the central office, the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, and then undergoes examination in each of the designated countries according to each country’s national law.

If the application encounters official objection in any country it is necessary to appoint a local attorney in that country and additional costs will be incurred for prosecution of the application. Examination typically occurs within 6-12 months, and registration is likely to occur within about 12-18 months, assuming there are no serious official objections are raised.

The benefits of filing using the Madrid Protocol system are:

- it is generally a less expensive option compared to filing national applications in each of the countries/territories of interest;
- additional countries (that are members of the Madrid Protocol) can be added at a later time if your markets expand;
- renewals and administrative matters such as records of change of name or address, and changes of ownership, are simpler and more cost effective; and
- with the exception of a small number of countries, there are no registration fees payable once the application has been accepted and advertised.

2. National applications

This is where an application is filed directly in the country of interest. The costs vary from country to country. For those countries that are not members of the Madrid Protocol or are not part of the EU, such as South Africa, and some Asian and South American countries, national registration is the only option currently available.

We work with a network of trusted associates across the globe who assist in obtaining trade mark protection and streamlining national processes.

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3. ASEAN (Association of South East Asian Nations)

South East Asia is a complex region with varied trade mark laws and processes. We have a wealth of knowledge and experience assisting businesses to protect their trade marks throughout the region, including in Indonesia, Malaysia, The Philippines, Singapore, Thailand and Vietnam.

We work closely with our network of local associates on the ground in each country and help to streamline the complex processes and formalities to secure best possible registration outcomes.

For businesses planning to enter the Asian and ASEAN markets, the most effective strategy is to file key trade marks very early. For further information on trade mark protection in this region, please see our ASEAN information sheet on our [Resources page](#).

4. European Union (EU) Trade Mark

The EU regime is a single application covering all 28 member states of the EU, and any countries which are subsequently added to the EU. The EU member states are currently: Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom*.

Switzerland, Norway, Iceland, Bosnia-Herzegovina, Serbia, and Albania, as well as a number of other countries, are not current EU members.

Registration of an EU trade mark has the same effect as a national registration in each member state. This is a valuable mechanism and cost-effective regime for European trade mark protection. The EU can be designated as a single region application, or via the Madrid Protocol regime.

Brexit and EU trade marks

The United Kingdom (UK) left the EU on 31 January 2020. However, the status of EU trade mark registrations will remain unchanged until the end of the "Transition Period" which is expected to be 31 December 2020.

Holders of EU trade marks, registered before the end of the Transition Period, will automatically be granted an equivalent UK registration having the same filing and priority dates as the original EU registration. However, holders of EU trade mark applications, which are still pending at the end of the Transition Period, will be given a period of nine months to file a corresponding UK application for the same trade mark bearing the same filing and priority dates as the original EU application.

As the end of the Transition Period is nearing, we recommend trade mark applicants wishing to protect their marks in both the UK and EU file separate applications in both jurisdictions.

Further information on Brexit and trade marks can be found [here](#).

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5. The Pacific Island

Our trade mark attorneys act directly before the Australian, New Zealand and Papua New Guinea Trade Marks Offices and have strong relationships with local Trade Mark Offices and attorneys in a number of Pacific Island nations to assist with securing trade mark protection in the region. This includes in Fiji, Tonga, Vanuatu, Kiribati, Solomon Islands, Tuvalu and Samoa.

Trade mark registration processes are diverse throughout the Pacific Island region. Some countries operate Trade Mark Registers, others allow re-registration of marks registered in other jurisdictions, while some smaller countries have no formal trade mark registration process. For these smaller Island nations with no formal system, we recommend the placement of "Cautionary Notices" in local newspapers once a year.

Further information on the trade mark systems in Pacific Island nations can be found in the *Trade Mark protection in the Pacific Region* document on our [Resources page](#).

Your FB Rice trade mark advisors are available to assist. As trade mark specialists, we understand that each business needs an individual overseas filing program to meet its aims for export and trade mark protection. We are able to help you devise a global searching and filing strategy. For further information please contact the trade marks team at FB Rice at TradeMarks@fbrice.com.au.