

How to Apply for an International Trade Mark



Applying for an International Trade Mark

**Guidance for people
applying from the UK**

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International trade marks

If you own a trade mark in the UK you can protect it abroad by applying for an international trade mark under a procedure called the Madrid system. This is a multi-national system based on two international treaties - the Madrid Agreement and the Madrid Protocol - and run by the World Intellectual Property Organization (WIPO) which is based in Geneva, Switzerland.

Which countries are covered by the Madrid system?

Because the UK is a member of only the Madrid Protocol (and not the Madrid Agreement), you can protect your mark only in countries which are also members of the Protocol. You can get a list of the countries that are members of the Protocol from the WIPO website at www.wipo.int/madrid and clicking on the 'countries' link, or you can call us (the UK Intellectual Property Office) on 08459 500 505.

Why not apply straight to the countries?

By using the Madrid system you can apply to a number of countries by making just one application, in English, and paying just one fee. So this system is cheaper and easier to use than applying separately to each country.

Who can apply for an international trade mark?

The owner of a trade mark (application or registration) in one of the member countries of the Madrid Protocol, who is also one of the following:

- a national of a member country of the Protocol;
- a resident of a member country of the Protocol; or
- a person or organisation with business premises (legally, 'a real and effective industrial or commercial establishment') in one of the member countries of the Protocol.

This is called the 'Entitlement to file' on the application form (Box 3). If you have any questions about your right to apply for an international trade mark, please call us or WIPO.

How do I apply?

You should fill in a WIPO application form called an MM2(E).

How to fill in the application form

You must type your answers. WIPO will not accept handwritten applications.

Box 1

Enter 'United Kingdom'.

Box 2

Your name and address details must be exactly the same as those of your UK trade mark, because this is one of the items of information which we must certify.

Box 3

If the address which you have given in Box 2(b) is not a UK address, and you are not a British National, you will need to give your business address in the UK at (b)(ii) in this box. You must give an established address - we will not accept a Post Office box number.

Box 4

If you have appointed anyone to represent you (for example, a trade mark attorney), give their details here.

Box 5

You must base your international application on a UK trade mark application or on a registered UK trade mark. You may base your international application on more than one UK mark if, for example, you hold registrations for the same mark in a number of different classes. You must list all marks which your international application is based on. You may need to use the continuation sheet at the end of the application form for this.

Box 6

If you are claiming International Convention priority from an earlier mark, give the details of that mark here.

Box 7

The representation of the mark which you provide must fit inside box (a). WIPO will use this representation when they publish your mark, so please make sure that it is as clear as possible.

The representation of the mark must be exactly the same as your UK mark and must be in colour if that is how it appears on the register. If you claimed colour as an element of your basic UK mark, then you must claim colour in your international application. You will also have to pay the extra application fee for coloured marks (see ‘What does it cost to apply for an international trade mark?’ below).

You cannot apply for international protection for a series of marks. So, if your UK mark is a series, you must choose one of the marks in the series on which to base your international application.

Box 8

See note about Box 7 above. If you claimed colour as an element of your UK mark, you must make the same claim in your international application.

Box 9

You must include any indications which are part of your UK mark.

Box 10

The list of goods and services must be no wider than that of your UK mark.

Box 11

You can designate as many countries as you like. After WIPO have registered your mark you can designate extra countries by using form MM4 (Application to make a subsequent designation).

Box 12

You must sign and date the form.

Box 13

We will complete this box - see ‘Where should I send my application?’

If you have any questions about filling in the application form, please call us or WIPO.

You can take or send your application to us at one of the following addresses.

[Where should I send my application?](#)

UK Intellectual
Property Office
Concept House
Cardiff Road
Newport
NP10 8QQ

UK Intellectual
Property Office
Harmsworth House
13-15 Bouverie Street
London
EC4Y 8DP

Mark your envelope 'For the attention of the Madrid Application Unit'.

Or you can fax it to 01633 817777. If you fax your application to us, **you must also send the original copy to us by post, as WIPO require an original copy of the mark.**

You should send **only**:

- your application form;
- a handling fee sheet (Form FS4, which you can print from our website at www.ipo.gov.uk); and
- the handling fee of £40, but you do not have to pay this if you are sending a subsequent designation on form MM4.

You can pay the £40 handling fee:

- by cheque made payable to 'UK Intellectual Property Office';
- straight from your office deposit account; or
- by bank transfer straight to our account at Barclays Bank (sort code 20-18-15, account number 80531766).
- by most major credit and debit cards.

We will certify that your international application is for the same mark as the UK mark on which it is based, and that the international list of goods and services is no wider than the national list and any colour limitation is included where appropriate. We will also confirm the date on which we received your application. WIPO will use this date as the filing date of your international application provided we are able to certify and forward the form to them within two months of filing.

What is the filing date of my application?

The filing date is the date when we received your application, which should include all of the following:

- Your name and address.
- The name and address of your representative (if any).
- A representation of your mark, including a claim to colour or other features of the mark, where these are claimed (that is, three-dimensional, sound, and so on)
- A list of the goods or services you want your mark to be registered for.
- A list of the countries where you want your mark to be protected.

- A Fee Calculation Sheet showing the amount of the fees and how you are paying.
- Form MM18 if you are designating the United States.
- Form MM17 if you are claiming Seniority if you are designating the European Community

What happens if I do not include all of the above with my application?

WIPO will ask you to send the missing documents or information within three months.

We will ask you to supply the missing information, which you must do in time to allow us to certify and forward your application to WIPO within two months of your filing. If you do not do this your application date will be amended to the date it reaches WIPO.

What does it cost to apply for an international trade mark?

This depends on your mark and the number of countries you wish to cover with your application, but is the total of:

- 1 a **basic fee** of 653 Swiss francs (or 903 Swiss francs if your mark is in colour), **and**
- 2 either a **standard designation fee** of 73 Swiss francs, or an individual designation fee for each designated country - the amount is fixed by the country concerned, and
- 3 a **supplementary fee** of 73 Swiss francs for each class of goods and services after the third.

It is not easy to calculate a total fee because each country's designation fees vary considerably. There is a list of fees and a fee calculator on the WIPO website at www.wipo.int/madrid . If you need any help with fees, please call us (see under Contact points on page 11).

How do I pay?

You must pay all these fees in Swiss francs (CHF) to WIPO in Geneva.

You can pay WIPO:

- by cheque;
- straight from a WIPO current account;
- by bank transfer to WIPO's account number (IBAN) CH35 0425 1048 7080 8100 0 at Cr dit Suisse, CH-1211 Geneva 70, Swift: CRESCH ZZ12A; or
- by payment or transfer to WIPO's Swiss postal cheque account number 12-5000-8, Geneva.

You can get information about opening an account with WIPO by contacting them (see Contact points on the next page). If you have a UK office deposit account you can tell us to take the correct amount in Swiss francs from your account.

Do I have to pay when I apply?

No, but if you do not pay the fees to WIPO within **three months** of them asking for payment, they will treat your application as if you had never made it.

What happens when WIPO register my mark?

When WIPO register your mark, it does not mean that it is protected in all the countries or regions that you have designated. WIPO will tell those countries, and it will be up to each of them to examine your mark under their own trade mark laws.

They must tell WIPO of any problems within set time limits, and WIPO will send you a copy of their letter. You must then reply direct to that country about their objections, and you may have to meet other requirements of their particular trade mark laws, for example, by giving an appropriate contact address for them to write to you.

You should also note that our, or WIPO's, acceptance of certain words in your list of goods and services does not guarantee that all countries will accept them.

If a country does not object to your application within the set time limits, your mark will be protected in that country.

Contact points

World Intellectual Property Organization (WIPO)

34, chemin des Colombettes
PO Box 18
CH-1211 GENEVA 20
Switzerland

Website: www.wipo.int
Phone: +41 22 338 91 11
Fax: +41 22 740 14 29
E-mail: intreg.mail@wipo.int

Correspondence about international trade marks (letters to examiners, and so on)

Fax: +41 22 740 1429

UK Intellectual Property Office

International Fees and Applications Section
Cardiff Road
Newport
South Wales
NP10 8QQ

Website: www.ipo.gov.uk

Central enquiries (for general information, information booklets, and so on)

Phone: 08459 500 505
Fax: 01633 813600
E-mail: enquiries@ipo.gov.uk

Information about international trade marks,

Phone: 01633 814117 or 814842
Fax: 01633 817777

Concept House,
Cardiff Road,
Newport,
NP10 8QQ

Tel: 08459 500 505
Minicom: 08459 222 250
Fax: 01633 817777

www.ipo.gov.uk
www.intellectual-property.gov.uk

For copies in alternative formats,
please contact our Central Enquiry Unit

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