Trademarks. International registration

- Flyer - Madrid System promotion [1]
- Importance of International Registration
  Exporting businesses, small and large, need a reliable, convenient and cost-effective mechanism to protect trademarks in markets of interest. The Madrid System is the one-stop solution for trademark holders to obtain and maintain protection in multiple markets. This system is a centralized filing and management procedure of applications for registration of trademarks.

  Close

- The Registration Procedure
  International trademark protection shall be ensured through:

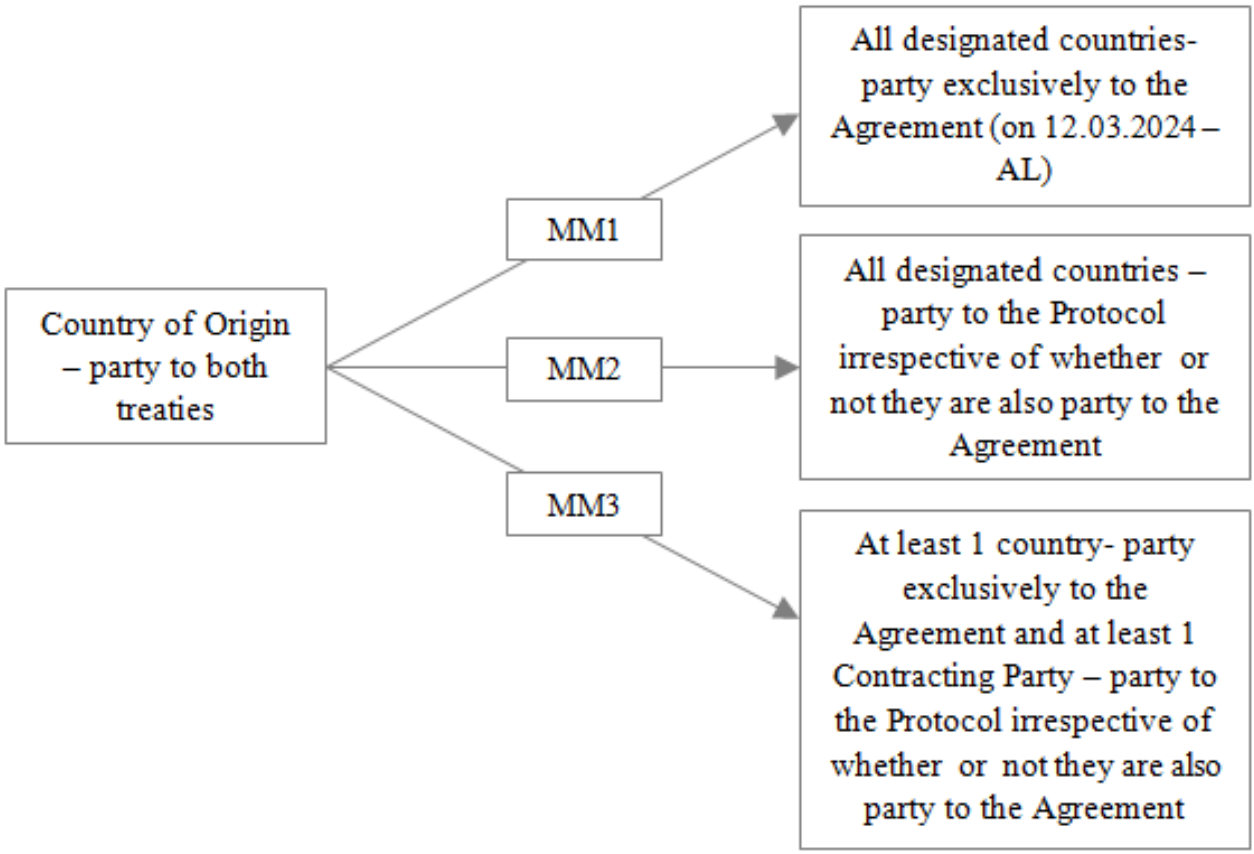
  - Filing an application to the Office of industrial property protection of the respective country.
  - Filing an application to the regional Office.
  - Filing an application for trademark registration abroad under the Madrid Agreement Concerning the International Registration of Marks, which, in our country, may be filed only through the AGEPI .
  - Madrid Agreement Concerning the International Registration of Marks of 1891
  - Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989

  Both treaties refer to the International Registration of Marks and allow interested persons from the Member States to:

  - seek protection in multiple countries through a single application (currently 95 members are party to the Madrid System);;
  - use one language; pay the fees in one currency (Swiss Francs). Close

- The International Application for Trademark Registration
  According to the regulation, the international application for trademark registration may be submitted only through the competent national office in respect of trademarks (AGEPI, in the Republic of Moldova), designated as the office of the country of origin. A prerequisite is the mandatory prior registration of the trademark (according to the Agreement) or prior submission of an application for trademark registration (according to the Protocol) in the country of origin. The application for international registration shall be drafted in **French or English** and submitted in 3 copies by the trademark holder or the applicant from the Republic of Moldova. It shall not be completed on a standard form (MM1, MM2, MM3, link: http://www.wipo.int/madrid/en/forms/ [2]) drawn up by the International Bureau of WIPO.

  Selection of the form where the Office of origin is party to both treaties



For further details on the selection of the form , please access http://www.wipo.int/madrid/en/madrid_simulator [3].

The guide to completing the application form for international registration MM2may be accessed here [4]. Each application shall relate to a single trademark. Meanwhile the applicant may use in the international application several registrations (Agreement) or registrations / applications (Protocol) of the same trademark in the Republic of Moldova.

The data included in the international application shall entirely correspond to the data entered in the National Register of Applications for Trademark Registration, or where appropriate in the National Register of Trademarks.

The international application shall include:

- name and address of the applicant;;
- country of origin;
- name and address of the patent attorney, where applicable;
- representation of the trademark;
- date and number of the application (registration) in the country of origin;
- dates and numbers of previous international registrations, where applicable;
- list of goods and services according to the international classification;
- the contracting countries where the applicant wishes to seek protection for a trademark, according to the Madrid Agreement or Protocol;
- other information, where necessary;

The date of the international registration within the meaning of Article 3(4) of the Madrid Agreement, or, if applicable, within the meaning of Article 3(4) of the Protocol to that Agreement, with the Republic of Moldova as country of origin, shall be considered the date when the international application was filed with the AGEPI, provided that it is received by the International Bureau within 2 months from the respective date. Otherwise, the date of international registration shall be the date when the international application was received by the International Bureau.

The filing date of the international application with the AGEPI shall be considered the date

when the application and the proof of payment of the fees in the amount established were filed; where the two documents are not filed at the same time, then the filing date of the last document shall be considered.

The applicants may limit the lists of goods and services for one or more countries designated in the application.

Though regulating the same procedure, there are some essential differences between the Madrid Agreement Concerning the International Registration of Marks and the Protocol to that Agreement, namely:

Following the "cascade" in choosing the office of origin:

1.According to the Agreement, the office of origin is defined as the office of the country member to the Agreement where the applicant:

- has a real and effective industrial or commercial establishment in the Republic of Moldova;
- if he has no such establishment, the country of residence is the Republic of Moldova;
- in the absence of the above, the country whose national he is (citizen of the Republic of Moldova).

The applicant shall follow the so-called “cascade”, it may not choose freely the office of origin. For example, the applicant may not choose as the office of origin the office of the country member to the Agreement where it has its domicile, if it has a real and effective industrial or commercial establishment in another state member to the Agreement.

2. Unlike the strict provisions of the Agreement, in case of the designations governed by the Protocol there is no obligation to apply the so-called “cascade”. According to the Protocol, the office of origin is defined in a manner implying the possibility to choose the office of origin between the office of the country member to the Protocol where the applicant has an establishment, its domicile or whose national it is.

The terms: “national”, “domicile”, “real and effective establishment” shall conform to the legislation of every country.

- The Protocol provides the possibility of submitting an application in one of the 3 languages: French, English, Spanish (unless the national office provides otherwise), the Agreement allows the use of a single language. (**AGEPI as an office of origin shall receive, verify and transmit to the International Bureau the applications governed by the Protocol in French and English**).
- The Protocol provides the possibility of submitting an international application based on both a national registration and a national application, while, according to the Agreement in order to submit an application for international registration, the applicant shall obtain the mandatory national registration of its trademark.
- According to Article 9 of the Protocol, where the international designation is governed by the Protocol, there is the possibility of transforming the international registration into a national application, if, upon the request of the office of origin, the international registration is excluded from the International Register in respect of all or part of the goods and / or services listed in the said registration.

In this case, the person who was the holder of an international registration may file an application for registration of the same trademark with the AGEPI, provided that the international registration in the Republic of Moldova is effective under the Protocol, which is being treated as if it has been filed on the date of international registration or of the territorial extension for the Republic of Moldova, enjoying the same priority as the international registration, subject to the following conditions:

- the application shall be filed within 3 months from the date the international registration was excluded from the register;
- the goods and services listed in the application shall be effectively covered by the list

of goods and services contained in the international registration concerning the Republic of Moldova;
- the application referred shall meet all the requirements of national legislation, including the requirements relating to fees.
- an application for the renunciation or revocation of an international registration governed by the Protocol may be directly filed with the International Bureau. Close

- Specific Aspects of the International Procedure
  - *Selection of language of correspondence*
    In case of an international application, the applicant may indicate (by ticking the corresponding box) whether he wishes to receive notifications from the International Bureau in English, French or Spanish. There is no necessity to tick the corresponding box where the applicant wishes to receive the correspondence in the same language the application was filled in. It should be noted that selection of the language refers only to the correspondence of the International Bureau.

  - *Indication of the basic registration (of the application)*
    The basic registration carried out by the country of origin shall be indicated by specifying the number and date of registration. The date to be indicated shall be the date which, according to the national legislation, is deemed to be the registration date, which is not necessarily the date on which the trademark was recorded in the Register. For example, if, according to the national laws, the trademark is deemed registered on the filing date, then such date shall be indicated as the registration date.

    Where an application for international registration is based on a national registration, the filing number of the application from which the national registration resulted shall not be indicated in order to avoid confusion.

  - *Disclamation*
    Where the applicant wishes to declare that it will not claim the exclusive right on certain verbal elements within the mark, he shall tick the corresponding box indicating the respective elements. The purpose of this declaration is to avoid refusals in certain designated countries. Where the disclamation was indicated, such declaration shall relate to all the designated countries.

    For the disclamation of exclusive rights it shall not be necessary for the respective elements to be disclaimed at national level, and it shall not be necessary to make such an indication either in the application for international registration or where certain elements have been disclaimed at national level.

  - *Premature filing of the application for international registration*
    The Madrid Agreement provides for the possibility of submitting an international application solely on the basis of a national registration, therefore, when filing an international application while there is only the basic application at the national level, and among the designated countries there are countries party exclusively to the Agreement, the national office shall deem the application as premature.

Where the international application relates to both the countries party to the Protocol and the countries party exclusively to the Agreement, the applicant shall be warned that the application will not be deemed premature provided that the designations under the Madrid Agreement are excluded from the application.

The International Bureau of WIPO has developed a series of online tools to facilitate communication with users of the Madrid System : international trademark holders or their representatives. Thus, there have been launched and promoted several tools useful to manage an international registration, such as:

  - MGS (Madrid Goods & Services Manager) - useful for the holder / patent attorney

when filing an application for trademark registration to compile the list of goods and / or services. It is highly promoted by the International Bureau (IB), national offices, including the AGEPI that has placed on its website this tool (http://www.agepi.gov.md/ [5]).

- MRS (Madrid Real-time Status) – allows real-time tracking of the status of any document under development at IB with reference to your trademark. By accessing MRS it is possible to receive a list of all documents relating to a specific international trademark recorded or in the process of being recorded in the International Trademark Registry. This allows you to see what is happening to your request at point in time.
- MPM (Madrid Portfolio Manager) – PM (Madrid Portfolio Manager) of IB with reference to your trademark. By accessing MPM it is possible to receive a list of all documents relating to a specific international trademark recorded or in the process of being recorded in the International Trademark Registry.
- MEA (Madrid Electronic Alert) – EA (Madrid Electronic Alert) of IB with reference to your trademark. By accessing MEA it is possible to receive a list of all documents relating to a specific international trademark recorded or in the process of being recorded in the International Trademark Registry or communicated electronically to the interested person.

Other services that may be requested from the International Bureau of WIPO may be found directly on the WIPO website (http://www.wipo.int/madrid/fr/ [6]).

Close

Source URL: https://www.agepi.md/en/trademarks/international