

Protecting trade marks in Australia via the Madrid Protocol.

Australia is a party to the Madrid Protocol and can be designated in an application for an International Registration (IR) upon filing or in a subsequent request for extension to additional countries.

Procedure in Australia

An International Registration designating Australia (IRDA) is usually examined by the Australian Trade Marks Office (ATMO) within about 6 months from notification of the IRDA from WIPO.

An IRDA is examined for registrability on both absolute and relative grounds, ie a prior registration or pending application for a conflicting trade mark in Australia can be cited against an IRDA.

An adverse report constitutes a provisional refusal for the purposes of the Madrid Protocol. The provisional refusal may be contested, but the ATMO will not consider any response unless the holder of the IRDA has appointed an address for service in Australia.

Under the Protocol the ATMO must, within 18 months from being notified by WIPO of the IRDA, either accept the IRDA or issue a provisional or final refusal.

Deferment of the period for acceptance is possible for various reasons, including awaiting the fate of a pending prior conflicting Australian application (or IRDA), or awaiting the result of a non-use removal action against a cited mark

If no objections are raised, the ATMO will send an acceptance notice to WIPO. The notice will then be forwarded by WIPO to the address for service recorded in the Madrid application. There have, however, been occasions when the acceptance notice has been sent directly to the applicant, rather than to the address for service in the Madrid application.

Address for Service

An address for service in Australia is required for an IRDA if:

1. an objection is raised by the Australian Trade Marks Office during examination;
2. a third party opposes the IRDA after acceptance; or
3. a non-use removal action is filed against a protected International Trade Mark in Australia.

What we require to become the Address for Service for an IRDA

If a notice of provisional refusal is received from WIPO, please send us a copy of the Madrid application and a copy of the notice of refusal. We can then become the address for service in Australia and advise on the grounds for refusal.

If notification of an opposition to an IRDA is received after acceptance, we can obtain details of the accepted IRDA from the ATMO and we only require a copy of the notice of opposition.

Rights conferred by a Protected International Registration in Australia

The rights given to a protected International Registration are the same as those given to an Australian national trade mark registration.

These rights include a defence to a third party infringement action from the owner of a prior registered trade mark in Australia.

Removal for Non-Use

An action for removal of an International Registration protected in Australia cannot be taken until five years has elapsed from the filing date of the Madrid application.

If a protected international trade mark is not used in Australia for a continuous period of three years, it becomes vulnerable to removal on the ground of non-use.

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