



Q239 – The basic mark requirement under the Madrid System

Introduction to Working Questions 2014

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Responsible Reporters:

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Background

- An international registration (IR) is generally an efficient way to obtain trademark protection in many countries
- How does it work?
 - First basic registration in country of origin of trademark owner (the basic mark requirement)
 - Then other countries can be designated as part of an IR
- In the first five years, an IR can be nullified by nullifying the basic registration (central attack)₈

Relevance

- Some favour the abolishment of the basic mark requirements, arguing:
 - Party is blocked from access to Madrid System if it does not obtain mark in country of origin, even if mark would be readily accepted elsewhere
 - Central attack too far-reaching
 - Simplification/cost benefits

Relevance (ctd)

- Others are against abolishment basic mark requirement, because:
 - Balanced, well working system, not to be abolished lightly in favour of uncertain alternative (both in terms of efficiency and costs)
 - Central attack is an efficient tool
 - Questionable whether changes are feasible (see also failure Trademark Registration Treaty)

Issue

- To be considered: impact transliterations / transcriptions (relevant if mark is to cover countries with different writing systems, such as Latin/Chinese/Japanese)
 - In particular cost and genuine use issues (e.g. Chinese trademark owner may be required to register a basic registration in Latin words in China, while he only wishes to use the mark elsewhere)

Questions to explore

- Do the national groups support a change of the basic mark requirement?
- What form should any changes take?
 - E.g. shortening of central attack period from five to three years, no requirement that basic registration in country of origin TM owner
- What are the pros and cons of such changes?