

Securing Protection Overseas

Trade Marks

Registering your trade mark in the UK affords no rights or protection overseas; it is necessary to register your trade mark in an overseas country in order to obtain effective protection there. In some countries, registration is the only way of protecting it; claiming that you were the first to use your trade mark in the country or that you have used it there for many years will afford you no effective rights at all.

Routes to Protection

There are various ways of protecting your trade mark around the world -

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National registration

Protection may be achieved by obtaining registration at a national Trade Marks Office.

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The International Registration System

Applying for trade mark protection individually at a series of national Trade Mark Offices is expensive. However, a system exists to enable registration in several countries more cheaply yet whose scope of protection is exactly the same as if individual trade mark applications had been filed at national Trade Mark Offices. This is commonly known as the "Madrid" System.

To take advantage of "Madrid", the trade mark owner must first have a "home country" trade mark application or registration in place. He may then choose the overseas countries into which the "home country" application/ registration is to be extended.

Up to 80 countries in addition to the UK may be designated in an International Registration.

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The Community Trade Mark ("CTM")

The EU consists of 27 Member States. Registration may be obtained simultaneously in all 27 by means of one CTM application at a significantly lower cost than the "national" filing route.

Patents

Patents are national rights, so if you want patent protection in a country, you have to obtain a patent for that country. In most countries, valid patents are only granted if the invention covered by the patent has not been made available to the public anywhere in the world before the patent was applied for. For this reason, it is possible in most countries to claim the priority of an earlier patent application covering the same invention (e.g. claim the priority of a UK patent application on filing PCT, European and US patent applications) as long as the patent application claiming priority is filed at the appropriate Patent Office within 12 months of the first patent application.

Routes to Protection

There are various ways of protecting your patent around the world -

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National patent applications

In most countries, patents may be applied for at national Patent Offices.

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International patent applications (PCT applications)

Applying for patent protection individually at many national Patent Offices is expensive, especially since translations are often required. The Patent Cooperation Treaty (PCT) enables a single international patent application to be filed which has the effect of patent applications in over 130 countries. A PCT application may be filed in English, at a local Patent Office. A PCT application does not result in granted patents directly but it simplifies the procedure and, since a PCT application is pending for up to 30 months from the priority date, it keeps options open. After the 30 month period, it is necessary to enter the national phase in the countries where patent protection is needed. At that stage, the national patent procedure begins.

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European patent applications

The European Patent Convention is an agreement between all Members States of the European Union and a number of other important countries (e.g. Norway, Switzerland, Iceland and Turkey). A European patent application is filed at, examined in and (if found allowable) granted by the European Patent Office (EPO). At this stage, it is necessary in most countries to complete some formalities in order to bring the patent into force. Overall, the cost of obtaining a European patent in three or more European countries is usually lower than the cost of the national route.

This fact sheet should not be treated as a legal opinion.

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