

APPLICATION FOR INTERNATIONAL REGISTRATION OF TRADEMARK GUIDANCE FOR APPLICANTS

The Madrid Agreement Concerning the International Registration of Marks (Decree No. 65/1975 Coll. in the wording of Decree No. 78/1985 Coll.)

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Announcement of Ministry of foreign affairs No. 248/1996 Coll., on the Accession of the Czech Republic to The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks)

The application for international registration of trademark must be filed in written form in one copy with the Industrial Property Office (hereinafter “Office”), Antonina Cermaka 2a, 160 68 Prague 6 - Bubeneč. The application must be related to one trademark only.

On the basis of the demand for the international registration of trademark filed by the applicant, the Office processes the application for international registration of trademark and sends it to the International Bureau of the World Intellectual Property Organization in Geneva, which records the registered trademark in the international register and proceeds it to the registration offices of the states bounded by both the Madrid Agreement and the Protocol.

If the applicant mentions in the application for the international registration at least one state which is a party to the Madrid agreement, irrespective of the fact if that state is also a party to the Protocol relating to this agreement (section no.10 of the application form), the Office may only apply for an international registration of a trademark which is registered in trademark register of the Czech Republic. If the procedure of trademark registration in the Czech Republic is suspended or the application is refused, the filed application for international registration will be rejected as groundless.

If the applicant mentions in the application for the international registration entirely the states bound by the Protocol but not by the Madrid agreement (section no. 11 of the application form, section no. 10 shall be left blank), the Office may apply a trademark for an international registration already on the basis of the filing of the identical trademark application provided that the application has all necessary particulars prescribed by the Act No. 441/2003 Coll., on trademarks, as amended. The international registration of trademark is in that case dependent on registration of trademark in the Czech Republic. If the application is refused or if the procedure is suspended, the international registration will be cancelled and deleted from the international register.

In the international trademark application it is possible to set up a claim to the priority right of this trademark application for national registration in the Czech Republic provided that the international application will be delivered to the International Bureau within six months from the date of application filing in the Czech Republic. If the applicant is interested in keeping this right in case that the international application must lean against the registration of the same trademark in the Trademark register of the Czech Republic, it is necessary to send the application for international registration of trademark to the Office in sufficient timing advance. Considering the new established publishing of the trademark applications and the objection procedure according to the Act No. 441/2003 Coll., on trademarks, as amended, the Office will not be capable to ensure the timely execution of the international application, if it

is not filed at the same time as the national application. The Office cannot ensure a meeting of deadline as well if the national application has formal or matter-of-fact faults which restrain from its record to the trademark register of the Czech Republic.

Instructions for filling in an application for the international registration of trademark

1. An applicant
The full title, eventually first name and surname of applicant and in case of legal entity the registered address and in case of natural person the permanent address are to be filled in. Phone and fax numbers shall be stated for a need of a personal contact with applicant's representative.
2. A reference number of national application
The reference number of a file of the national application of trademark in the Czech Republic filed with the Industrial Property Office is to be filled in. If the trademark is already registered in trademark register, the number of registration is also to be filled in. Further the filing date of national application of trademark filed with the Office shall be filled in.
3. An applicant's representative
This section is to be filled in only when the applicant is represented by attorney or common representative, in accordance with the administrative instructions. The full title or first name and surname and full address of the representative are to be filled.
4. A payer of the fee to the International Bureau of the World Intellectual Property Organization
The person, who pays the fee for the international registration of trademark to the International Bureau of the World Intellectual Property Organization is to be ticked. If the payment has already been made, the number of acknowledgement concerning the payment receipt issued by the International Bureau is to be filled in.
5. The methods of payment to the International Bureau of the World Intellectual Property Organization
The selected method of payment for the international registration paid with the International Bureau of the World Intellectual Property Organization is to be ticked.
6. A text wording or a pictorial representation of the trademark
A text wording or a pictorial representation of the trademark to be registered is to be filled in and it shall be done in that style which is capable to be reproduced in minimum size 15x15mm and in maximum size 80x80mm. A text wording or a pictorial representation must be identical to the trademark presented in the application designated in section no. 2 of the application.
7. The information whether the trademark is being registered in standard characters is to be ticked. Such a trademark means only the verbal trademark without any graphic modification and represented in black and white. This information must correspondent

with the information presented in the national application designated in section no. 2 of the application.

8. A reproduction of the trademark

It is to be designated by the cross whether the trademark is being registered in the black and white or in the colour reproduction. The filled in information must correspondent with the information presented in the national application designated in section no. 2 of the application.

9. A list of colours in French (eventually in English)

This section is to be filled in only when the colour trademark is being registered. The names of colours used for pictorial representation of the trademark and indicated in the application are to be translated into French. If at least one state is mentioned in section no. 11 of the application (state which is bound by the Protocol but not by the Madrid agreement), the names of colours may be in French or in English. If the application includes only the states mentioned in section no. 10 (states bound to the Madrid agreement), the names of colours must be **entirely** in French.

This section must be also filled when the trademark contains writings in some other characters other than the Latin. The transliteration must follow the phonetics of French, respectively English language.

10. The states bound to the Madrid agreement for which the protection is required

The states bound to the Madrid agreement for which the protection is required are to be named in the application irrespective of the fact whether they are bound also to the Protocol.

11. The states bound to the Protocol for which is required the protection

The states bound to the Protocol but not to the Madrid Agreement for which is required the protection are to be named in the application.

The application may include only the states mentioned in sections no. 10 or in no. 11 or in both of them.

12. The list of names of the goods and services in French is to be provided. This list must not extend the list of names of the goods and services provided in national application designated in section no. 2. The goods and services are sorted in ascending order according to the classes of the international classification (classes 1-45). Each group of the goods or services must be preceded by number of the class to which the goods or services belong. The goods and services included in the list must correspondent with the international classification which is available in the Office. If the list consists of more than ten items, it is necessary to propose it on the separate sheets in two copies.

If at least one state which is bounded to the Protocol but not to the Madrid Agreement is mentioned in section no. 11 of the application, the list of the goods and services may be written in French or English. If the application mentions only the states in section no. 10 (bounded to the Madrid Agreement), the application must be written **entirely** in French.

13. The annexes

The annexes attached to the application are to be ticked.

14. A signature

The application shall be signed by the applicant or his representative. If the application is filed by the legal entity, it shall be endorsed with the company's stamp.

The application must be attached with the following documents:

1. If the black and white trademark is applied for - 5 black-white reproductions of the trademark sized minimum 15 mm and maximum 80 mm.
If the colour trademark is applied for - 5 coloured reproductions of the trademark sized minimum 15 mm and maximum 80 mm.
2. Power of attorney or the representative mentioned in section no. 3 of the application if the applicant is being represented. In case of general power it is possible to fill in the number of the power granted by the Office.

Administrative fee

The application for the international registration of trademark is liable to the administrative fee CZK 2500. It can be paid by postal order, by money transfer from the applicant's account to the account of the Industrial Property Office (Czech National Bank, account no. 3711-21526-001/0710, constant symbol 1148) or by cash at the cash desk in the Office. Variable symbol for all payments is number 3 and number of file of the application for international registration of trademark.

Fees concerning the international registration of trademark paid to the International Bureau of the World Intellectual Property Organization

The fee for the international registration of trademark whose amount is prescribed by the tariff of fees under the Madrid Agreement and the Protocol is to be paid in advance directly to the International Bureau of the World Intellectual Property Organization.

Fees may be paid to the International Bureau:

- a. by transfer to the bank account of the International Bureau (Organisation Mondiale de la Propriété Intellectuelle, address: 34 chemin des Colombettes, CH-1211, Geneve 20, Suisse; account no. CH35 0425 1048 7080 8100 0, bank code CRESCHZZ12A, Crédit Suisse, Geneve)
- b. by a banker's cheque
- c. by payment into the Swiss postal cheque account of the International Bureau (account no. 12-5000-8, Geneva)
- d. by payment in cash at the International Bureau
- e. if the applicant or his representative have opened a current account with the International Bureau, the payment may be made by transfer from that account

Information needed for making a payment of the fee:

1. the purpose of fee written in French or English (enregistrement de la marque, trademark registration)
2. the text wording and the number of trademark registration in the Czech Republic and name of the applicant
3. the name and the address of payer to which the Office will send the payment receipt acknowledgement

The name of the trademark owner and number and date of the international registration are needed for making a payment of the fee concerning the other operations made by the International Bureau with already registered international trademark (requests for renewal of international registration after ten years, transposition of international trademark to another owner, recording of other changes concerning the international trademark). The name of the payer and his full address are also needed as in the case of registration fee payment.

The payment is considered as already paid on the date when the International Bureau receives the required amount of money or if the money is available at the account opened with the International Bureau the payment is considered as already paid on the date when the Bureau receives an order for withdrawal of money from that account.

The international registration of trademark is dependent on the registration of the trademark in the Czech Republic within five-year time period from the date of the international registration. If the trademark in the Czech Republic is cancelled within that time period, its international registration is cancelled as well.