

Navigating international trademark registrations and symbol usage

By **Nathaly J. Vermette**

Law360 Canada (May 8, 2024, 12:55 PM EDT) -- As companies extend their reach globally, safeguarding intellectual property assumes heightened importance. The World Intellectual Property Organization (WIPO) provides a streamlined avenue for trademark registrations through the Madrid Protocol (an international agreement), commonly recognized as the “international trademark registration system.”

Yet, misconceptions persist surrounding trademark symbol usage and the ramifications of international registrations. Among trademark holders securing international registrations, a recurring question surfaces: Should the ® symbol adorn their logo?

The concise answer is no. The ® symbol should not be applied until securing national registrations. Furthermore, it should only be used in countries where the trademark holds a national registration. Premature use of the ® symbol, particularly in jurisdictions like the United States, can precipitate legal entanglements, including accusations of false declarations and unfair competition. Instead, the TM symbol suffices to denote a trademark.



Nathaly J. Vermette

Comprehending international registrations

Distinguishing an international trademark registration under the Madrid Protocol from a national registration is essential. WIPO’s system simplifies proceedings by enabling a single and centralized



application to be used in multiple countries. Nevertheless, it's imperative to discern that this international registration doesn't confer identical rights as national registrations.

The process

Originating from a national application in a member country, a WIPO application is assigned an international registration number post-validation and then disseminated by WIPO to countries designated by the trademark applicant. Each nation then assesses the application according to its national laws. Solely upon acceptance and registration by these nations does the applicant secure trademark rights in each jurisdiction.

Dispelling confusion

Certain countries maintain the same international registration number while others allocate additional application and registration numbers. It's crucial to acknowledge that international registration merely attests to compliance with WIPO's standards and expedites the application process but doesn't bestow legal entitlements.

The significance of national registrations

While international registration is pivotal for global trademark protection, it doesn't supplant national registrations. National registrations (attained either through a WIPO application or directly from the national trademark office) are indispensable for enforcing trademark rights in particular jurisdictions.

Conclusion

Grasping the intricacies of international trademark registrations and appropriate symbol usage is imperative for enterprises traversing borders. While the Madrid Protocol offers convenience, proceeding cautiously and ensuring adherence to national regulations is paramount. For further information or assistance with trademark filings, consulting legal professionals specializing in intellectual property law is advisable.

Nathaly J. Vermette is a distinguished business lawyer and trademark agent based in Montreal. She specializes in business law and her practice primarily focuses on intellectual property law. Additionally, she drafts and implements commercial agreements, such as licensing, technology transfer, services and distribution agreements. Vermette teaches intellectual property and contract management at McGill University's School of Continuing Studies.

The opinions expressed are those of the author(s) and do not necessarily reflect the views of the author's firm, its clients, Law360 Canada, LexisNexis Canada or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.

Interested in writing for us? To learn more about how you can add your voice to Law360 Canada, contact Analysis Editor Peter Carter at peter.carter@lexisnexis.ca or call 647-776-6740.