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Wiggin & Dana

From the Intellectual Property Practice Group at Wiggin & Dana

Trademark Law Alert

The Madrid Protocol

On November 2, 2002, President Bush signed the implementing legislation for the United States to join an international trademark treaty known as the Madrid Protocol (the "Protocol"). On August 2, 2003, the United States deposited the necessary Instrument of Accession to the Protocol with the World Intellectual Property Office ("WIPO"), allowing membership of the United States to take effect on November 2, 2003, the target date set by the United States when President Bush signed the implementing legislation. The Protocol will provide U.S. trademark owners with the ability to seek registration in Madrid Protocol countries, using what has been called a "one-stop" filing mechanism.

An Overview

The Madrid Protocol system, administered by WIPO, offers the owner of a mark in the United States the ability to obtain registration (called an "International Registration") for its mark(s) in a vast number of countries by using a centralized filing system. A single application is filed with the United States Patent and Trademark Office, designating those Member Countries in which the applicant wishes to seek registration. Currently there are 58 countries (also referred to as "member states") that are party to the Protocol.

In addition to providing U.S. owners with the ability to seek international registration for their marks, U.S. adherence to the Protocol will allow applicants from foreign countries to seek U.S. registration in the same manner. Under procedural rules, the national Trademark Offices of designated countries must examine and act upon applications within 18 months. Failure to issue a provisional refusal to register a mark within the 18-month time frame will result in automatic registration of the mark.

Advantages of the Madrid Protocol

The Protocol facilitates filing in Member Countries, through use of a single application in one Trademark Office, with one set of documents, in a single language, with payment of a single filing fee (that is payable in U.S. currency), and results in a single registration, with one registration number that has one renewal date. Because the filing system is "centralized" through one Trademark Office, thereby eliminating the need to retain lawyers in all foreign countries where registration is desired, it is expected that this centralized filing will greatly reduce the costs of obtaining worldwide trademark protection for U.S. registrants, businesses and individuals alike. With the exception of the European Union (Community), where it is now possible to obtain a single registration covering all 15 member states of the European Union (note: the European Union is in the process of being enlarged, and the European Union is ultimately expected to become a contracting party to the Protocol), and certain African countries, it is not currently possible to obtain registration in numerous foreign countries without filing separate applications in each of those countries. In addition to reductions in filing fees, maintenance fees and lawyer/agents' fees, changes of address, assignments and similar changes (*e.g.*, name changes) will need to be filed only in one office, and will require payment of only a single filing fee, thereby reducing the fees and processing costs associated therewith. Also, under the Protocol, the owner of an International Registration may subsequently extend an existing International Registration to additional Member Countries, including countries that may later join the Protocol.

Mechanics of Filing - The Basics

Designation of Countries

When an International Application is filed in the applicant's home country "Office of Origin" (in the United States, the United States Patent and Trademark Office), the applicant designates those Member Countries for which coverage is sought. Registration will be effective (in absence of a refusal to register in a given country) only in the countries designated in the International Registration. As such, the filing of an application for International Registration does not automatically extend to all Member Countries. As noted above, however, the owner of an International Registration may thereafter seek extension of

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its International Registration to additional Member Countries.

International Convention Priority

If an International Application is filed within six-months of a corresponding filing in an applicant's country of origin, it is possible to claim the filing date priority of the "home country" application. In other words, if the International Application is filed within six-month's from the filing date of the home country application, claiming the filing date priority of the home country application, the International Application will be deemed to have been filed as of the filing date of the home country application.

Certification and Date of Receipt Requirements

Once filed, the U.S. Patent and Trademark Office will "certify" that the mark, the owner and the goods and/or services in the International Application are the same as those listed in the basic registration or application. The U.S. Patent and Trademark Office will then forward the International application to WIPO. To receive a "Date of Receipt" (a filing date) from WIPO, the International Application must contain the following elements:

- Must be filed through the U.S. Patent and Trademark Office's electronic "TEAS" system, if the application is being filed by a U.S. applicant
- Basic application and its filing date or registration number and registration date
- Name and address of the international applicant (identical to basic application)
- Drawing of the mark
- Color claim (if appropriate)
- Description of the mark (if appropriate)
- Type of mark (*e.g.*, sound, three-dimensional, etc., if appropriate)
- List of Designated Countries
- Certification fee (if filed through U.S. Patent and Trademark Office) and WIPO International Application fees for all classes and designated countries
- Correspondence e-mail address

After these filing requirements are met, each country designated by the applicant will conduct its own examination. As mentioned, any provisional refusal must be made within eighteen months.

Refusals to Register

If registration is refused in a country designated in the International Application, the applicant would respond directly to the refusing country's trademark office, not to either the U.S. Patent and Trademark Office or WIPO. At this point, the applicant would need to engage counsel in the refusing country (if no refusal is issued, there is no need to engage foreign counsel). If a refusal in any designated country cannot be overcome, or if the applicant decides not to respond to the refusal, the International Registration will still issue, however, the coverage will not be extended to the country(ies) in which registration was refused.

Central Attack

For the first five years of registration, an International Registration is dependant on the continued validity of the underlying Basic Registration or Application. If the corresponding Basic Registration or Application is invalidated for any reason during the initial five-year period of International Registration, the International Registration is likewise invalidated. In this situation, however, the International Registration can be converted into separate national filings in the designated countries, retaining the filing date (including priority filing date) of the Basic Registration or Application, provided a "Request for Transformation" is filed within three months of the invalidation of the underlying International Registration, and upon payment of the national filing fee in each country.

Costs

The filing fee for an application for International Registration is currently 653 Swiss Francs if color is not claimed as a feature of the mark, and 903 Swiss Francs if the mark is in color (thus the fees range approximately between U.S. $450.00 and $700.00). There is also a

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"Supplementary fee" of 73 Swiss Francs (approximately U.S. $50.00) for each class of goods and/or services designated above the three International Classes covered by the basic fee, as well as a "Complementary fee" of 73 Swiss Francs for the designation of each designated Member State. It should be noted that countries may also add their own designation fees, as well as "supplementary fees" for each class of goods and/or services.

In addition to the WIPO fees, for an application filed by a U.S. applicant, at the time of filing, the applicant must also pay the "Certification Fee" (certification is discussed above under "Certification and Date of Receipt Requirements") of U.S. $100, per International Class, for an application based on a single Basic Registration or Application or U.S. $150, per International Class, for an application based on multiple Basic Registrations or Applications.

Duration and Effect of Registration

International Registrations are effective for a ten-year period and renewable for similar periods, upon the filing of a single Renewal Application accompanied by the appropriate renewal fee. An International Registration enjoys the same rights and enforceability as a registration that results from a "direct" national filing.

Conclusion

While not appropriate in every situation, the Madrid Protocol can provide an effective vehicle for obtaining and maintaining registration for marks in a number of foreign countries in a more streamlined, cost effective manner. Recognition of both the benefits and the limitations of the Madrid Protocol are, however, imperative to implementation of a sound strategy for developing and maintaining a trademark portfolio.

This Alert is provided for informational purposes only and does not constitute legal advice or by itself create an attorney-client relationship.

Principal Contacts:

James H. Bicks
Tel: 203-363-7622
jbicks@wiggin.com

Francis J. Duffin
Tel: 203-498-4347
fduffin@wiggin.com

Michael K. Kinney
Tel: 203-498-4411
mkinney@wiggin.com

Marry R. Norris
Tel: 203-498-4377
mnorris@wiggin.com

William A. Perrone
Tel: 203.363.7604
wperrone@wiggin.com

William J. Speranza
Tel: 203-363-7637
wsperanza@wiggin.com

Francisco A. Villegas
Tel: 203-363-7662
fvillegas@wiggin.com

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www.wiggin.com