

Implementation of the Madrid Protocol in the United States

On November 2, 2003, the United States will become a party to the Madrid Protocol (“Protocol”). Trademark applicants domiciled in the United States will have the opportunity to obtain an International registration covering multiple countries through a single application. A list of the countries is attached. Once the United States Patent and Trademark Office (“USPTO”) implements the Protocol, United States applicants who own a United States registration or file a United States application can request that the USPTO file an electronic application for an International registration with the World Intellectual Property Organization (“WIPO”).

The basic costs, in addition to the filing fee for the United States application, will be the USPTO’s fee of \$100 per class for certifying an International trademark application; WIPO’s fee of 653 Swiss francs (\$440) covering up to three classes and 73 Swiss francs (\$50) for each additional class; and individual country fees of 73 Swiss francs (\$50) or the fee normally charged to apply for registration in that country.

The International Bureau of WIPO will examine the application for formalities only and forward the application to the trademark offices in the countries where the applicant is seeking protection for substantive examination. WIPO must be notified of a refusal of registration or opposition within 18 months. If, after 18 months, there has been no objection to the mark, it will be deemed registered as of the date of the International registration in all of the countries where the application has been accepted, unless the application has been opposed by a third party. Once protection is granted in one country, the International registration has a term of ten years. New countries may be added to the registration.

The Protocol offers potential advantages for United States applicants including:

- Easier expansion of trademark protection in foreign countries. It will be possible to seek protection in any or all of the 60 member states of the Protocol by filing a single application.
- An expedited examination process. As described above, objections by an Examiner or a third party opposer must be sent to WIPO within 18 months.
- Lower registration and maintenance costs. Unless an objection is raised by an Examiner or a third party, it will not be necessary to retain a foreign associate. Renewals, assignments, name changes etc. can also all be done with a single filing.

The value of these potential advantages may be reduced by initial search costs in individual countries, the need to respond to office actions and the need to defend oppositions.

Potential disadvantages include the following:

- Limited description of goods and services. The goods or services covered by an International registration cannot be broader than the national registration upon which it is based. Since the USPTO often requires a narrower specification of goods and services than other countries, a United States applicant seeking to extend protection to a Protocol country may obtain a narrower registration than it would under a national filing.
- Central attack provision. An International registration is dependent on the home registration for five years after the International registration issues. Therefore, if the home registration is cancelled within this five year period, the International registration will no longer be valid. However, it will be possible to maintain the registrations in the extension countries by notifying the local trademark offices within three months of the invalidation of the International registration and paying the additional filing fee required by each country.
- An International registration is not a unitary right. Because an International registration is a bundle of national registrations, third parties can cancel the registration in countries where the mark has not been in use within the time period required by law. This is in contrast to a Community Trademark, or CTM, registration, where use in one country is sufficient to protect the mark in all of the countries that are part of the European Union.

In summary, while the Protocol offers potential benefits, an International registration may not be the most effective way to obtain protection for trademarks and service marks in all circumstances.

Finally, wholly apart from seeking an International registration abroad, those interested in United States marks should bear in mind that applicants domiciled in any of the member states will be able to extend protection of their marks to the United States. Therefore, once the Protocol is implemented by the USPTO, a search of United States marks should be expanded to include a search of the International trademark register.

Contact Information

If you have any questions regarding the Madrid Protocol, please contact your usual legal advisor at Ropes & Gray.