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International Protection of Trademarks under the Madrid Protocol

Generally, a "trademark" is a distinct word, phrase, symbol, device or combination thereof, affixed to goods or services, that serve to identify the source, or manufacturer, of the good or service. Trademarks function to: 1) further business profits by allowing businesses to market their goods/services on the goodwill of their mark; and 2) allow consumers to make informed decisions about the quality of goods/services they are purchasing.

In the United States, there are federal trademark laws to protect marks used in association with goods and services in interstate commerce from infringement. Under the Madrid Protocol, businesses may also be able to protect their trademarks on an international level.

The Madrid System

International protection of trademarks was first made possible under an international convention, entitled the Madrid Agreement, in 1891. However, due to some shortcomings of the Agreement (including fees and time limits), the Madrid Protocol was created in 1989. Some countries prescribe to only one convention, some to both, with the remainder having ratified neither.

The United States ratified the Madrid Protocol in 2003, making it possible for U.S. companies to seek international protection of their trademark in any country which is also a member to the Madrid Protocol. Similarly, member countries may seek protection of their trademarks within the U.S. There are over 60 members to the Madrid Protocol.

Administration of the Madrid System

Under the two Madrid conventions, the Madrid "System" functions to offer international protection of trademarks from infringement. The Madrid System is administered by the International Bureau of World Property Intellectual Organization (WIPO), located in Geneva, Switzerland. The International Bureau maintains the "International Register" of trademarks.

Benefits of Trademark Registration under the Madrid System

One of the main benefits of registration under the Madrid System is that it essentially offers "one stop shopping" for international trademark protection. In other words, the Madrid System allows a trademark owner to file just one application (in their home trademark office or Office of origin), in one language (either English or French) and pay just one fee rather than undergoing multiple filings in separate countries where protection is sought. Once certified locally, the Office of origin will forward the international application to the WIPO.

Ten-year (mandatory) renewals are also effective with just one filing and one fee. Also, any change in trademark ownership is effective in just one filing. However, an assignment of a trademark to a third party who is located in a non-member country (such as to a Canadian company) will not be recognized (e.g., valid) under the Madrid System.

Basic Eligibility to File an International Application in the USPTO

In the U.S., trademark owners seeking international protection must file their "international application" with the U.S. Patent & Trademark Office (USPTO). In order for the USPTO to certify and thus forward the international application to WIPO, the trademark owner must meet certain preliminary requirements. In general, to file an international application through the USPTO the applicant must:

1. Already have a "basic" U.S. application or registration;
2. Be the owner of the mark on both the basic and international applications;
3. Include a list of goods and services that is identical to or narrower than the list of goods or services in the basic application or registration;
4. Pay the U.S. certification fees; and
5. Identify at least one Contracting Party (where international protection sought).

Although applicants may choose their "home country" (i.e., country of registration), the choice must be based on a real and effective industrial or commercial establishment.

International Registration of Trademarks

Once received by WIPO, an application for registration of a trademark must still meet filing requirements set forth in the Madrid System. If the requirements are met and fees paid, the International Bureau will register the mark on the International Register, notify the mark owner and notify each Contracting Party designated in the application. Contracting Parties have 18 months within which to refuse to grant an extension of trademark protection to the applicant.

If the requirements under the Madrid System are not met, the International Bureau will send the applicant and their home country trademark office a notice explaining the problem with the application. These notices are called "irregularity notices or letters." If the irregularities are corrected within the time prescribed, the International Bureau will register the mark.

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