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The Madrid Protocol: Frequently Asked Questions by U.S. Trademark Owners Seeking International Rights

- What is the Madrid Protocol?
- Which countries are members of the Madrid Protocol?
- When did the Madrid Protocol become effective in the United States?
- Who can submit an international application through the USPTO?
- What are the requirements for submitting an international application through the USPTO?
- Can a U.S. trademark owner file an international application directly at the International Bureau?
- What is the cost for filing an international application through the USPTO?
- How can a U.S. trademark owner file an international application with the USPTO?
- What other electronic Madrid Protocol forms are available?
- What happens after the international application has been submitted to the USPTO?
- Will the International Bureau automatically register the mark in an international application once it has been certified by the USPTO?
- What is a Notice of Irregularity with respect to an International Application and how do I respond to it?
- What is the date of the international registration?
- Can an international applicant claim a priority filing date based on a U.S. basic application?
- What happens after the International Bureau registers the mark in the international application?
- After the mark in an international application registers, can the holder of the international registration request an extension of protection in additional countries?
- Can a subsequent designation be submitted through the USPTO for forwarding to the International Bureau?
- What is the duration of an international registration?
- If the U.S. application or registration that forms the basis of the international registration is abandoned, cancelled or expires, will the international registration be cancelled?
- Where can I get more information about the Madrid Protocol?

What is the Madrid Protocol?

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) is an international treaty that allows a trademark owner to seek registration in any of the countries that have joined the Madrid Protocol by filing a single application, called an "international application." The International Bureau of the World Intellectual Property Organization, in Geneva, Switzerland administers the international registration system.

The resulting "international registration" serves as a means for seeking protection in member countries, each of which apply their own rules and laws to determine whether or not the mark may be protected in their jurisdiction. Neither the Madrid Protocol nor the Madrid Agreement provide for registration of an "internationally effective" trademark.

Which countries are members of the Madrid Protocol?

As of November 2007, 74 countries have joined the Madrid Protocol. These countries are called "Contracting Parties." A current list of the Contracting Parties is available online at the World Intellectual Property Organization (WIPO) website: <http://www.wipo.int/madrid/en/members>.

When did the Madrid Protocol become effective in the United States?

The Madrid Protocol went into effect in the United States on November 2, 2003. As of that date, U.S. trademark owners became able to submit an international application to the USPTO to forward to the International Bureau in Geneva, Switzerland. Similarly, as of that date, foreign trademark owners could seek extension of protection of an international registration of a mark to the United States.

The Trademark Act has been amended by federal legislation to add provisions for implementing the Madrid Protocol in the United States. This amending legislation is called the Madrid Protocol Implementation Act (MPIA). The USPTO has also added new rules to the Trademark Rules of Practice for documents relating to the Madrid Protocol. The MPIA and the new rules are posted on the USPTO website at: www.uspto.gov.

Who can submit an international application through the USPTO?

Any trademark owner with an application filed in or a registration issued by the USPTO and who is a national of, has a domicile in, or has a real and effective industrial or commercial establishment in the United States can submit an international application through the USPTO.

What are the requirements for submitting an international application through the USPTO?

To file an international application through the USPTO, an applicant must have a U.S. application, called a "basic application" or a U.S. registration, called a "basic registration." The mark and the owner of the international application must be the same as the mark and the owner of the basic application or registration. The international

application may be based on more than one USPTO application or registration provided the mark and the owner are the same for each basic application and/or registration. The international application must 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. The international applicant must pay the U.S. certification fee(s) at the time of submission and identify at least one Contracting Party in which an extension of protection (that is, registration in a Contracting Party) is sought.

A list of the minimum requirements for obtaining a date of receipt of an international application in the USPTO is set forth in 37 C.F.R. §7.11(a). See notice of final rules published in the Federal Register, 68 FR 55748 (Sept. 26, 2003), and posted on the USPTO web site at: <http://www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf>. The requirements for a complete international application are set forth in Article 3 of the Protocol and Rule 9 of the Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement (Common Regulations). The Common Regulations are currently available on the WIPO website at <http://www.wipo.int/madrid/en/>.

Can a U.S. trademark owner file an international application directly at the International Bureau?

No. The international application must be filed through the USPTO. The USPTO must certify (review and confirm) that certain information in an international application based on a U.S. basic application or registration is the same as the information contained in the basic application or registration. The USPTO then forwards the international application to the International Bureau.

What is the cost for filing an international application through the USPTO?

An international applicant must pay fees to the USPTO and to the International Bureau. The USPTO charges a fee for certifying international applications and transmitting them to the International Bureau, called a "certification fee." The certification fee is \$100.00, per class, if the international application is based on a single U.S. application or registration. The certification fee is \$150.00, per class, if the international application is based on more than one U.S. application or registration.

The International Bureau requires payment of fees based on whether the reproduction of the mark is in black and white and/or in color, the particular Contracting Parties designated in the international application and the number of classes of goods and services indicated in the international application. The schedule of fees, individual fees and International Bureau Fee Calculator are posted on the WIPO web site at: <http://www.wipo.int/madrid/en/>. The international application fees must be paid directly to the International Bureau in Swiss francs.

How can a U.S. trademark owner file an international application with the USPTO?

An international application may be filed electronically using the Trademark Electronic Application System (TEAS) for International Applications. Electronic forms are accessible at <http://teasi.uspto.gov/>. An international application may also be filed on

paper using the official form issued by the International Bureau of the World Intellectual Property Organization available online at <http://www.wipo.int/madrid/en>. For further information, please see the "Tips for Paper Filers" at http://www.uspto.gov/web/trademarks/madrid/madrid_tipspaperfilers.htm.

What other electronic Madrid Protocol forms are available?

Currently, the USPTO offers three forms: 1.) Application for International Registration, 2.) Subsequent Designation of an International Registration, to extend protection of goods/services to additional countries or extend protection of additional goods/services to previously designated countries, and 3.) Response to a Notice of Irregularity. A fourth form for the Transformation of a cancelled International Registration into a National Application is under development.

What happens after the international application has been submitted to the USPTO?

If the international application meets the requirements of 37 C.F.R. §7.11(a), then the USPTO will certify that certain information in the international application is the same as the information in the U.S. basic application or registration and forward the international application to the International Bureau.

If the international application does not meet the requirements of 37 C.F.R. §7.11(a), then the USPTO will not certify the international application. The USPTO will notify the international applicant of the reasons why the international application cannot be certified. The certification fee is not refundable. The international applicant may promptly resubmit a corrected international application based on the same U.S. application or registration. The certification fees must be included with the new submission.

Will the International Bureau automatically register the mark in an international application once it has been certified by the USPTO?

No. Certification by the USPTO is only to ensure that the international application is properly based on a U.S. application or registration and to validate the date of receipt of the international application by the USPTO. The International Bureau must still review the international application to determine whether it meets the Madrid Protocol filing requirements. If the requirements are met and the fees paid, the International Bureau will then register the mark, publish it in the WIPO Gazette of International Marks (WIPO Gazette), send a certificate to the international applicant, now called "holder of the international registration", and notify the Offices of the Contracting Parties designated in the international application. The WIPO Gazette may be purchased from the WIPO Electronic Bookshop on the WIPO web site at: <http://www.wipo.int/ebookshop?lang=eng>.

What is a Notice of Irregularity with respect to an International Application?

If the Madrid Protocol filing requirements have not been met, the International Bureau will send a notice to both the USPTO and the international applicant that explains the problems with the application. These notices are referred to as "Notices of Irregularity."

Responses to irregularity notices must be received by the International Bureau within the time period indicated in the irregularity notice.

Certain irregularities require remedy by the USPTO as the office of origin. In such cases, the applicant must respond to the irregularity and submit the response to the USPTO. The response will be reviewed, and if acceptable, forwarded to the International Bureau. The USPTO provides an electronic form for submission of the response available at <http://teasi.uspto.gov/>.

Receipt by the USPTO will NOT satisfy the time requirement. Please ensure responses are submitted with adequate time for review and forwarding to the International Bureau. The USPTO suggests responses should be submitted one month before the deadline imposed by the International Bureau. If the irregularities are corrected within the prescribed time, the International Bureau will register the mark. Please note that deadlines relating to fee deficiencies may have different time allowances than other irregularities.

What is the date of the international registration?

The date of the international registration is the date of receipt of the international application in the USPTO provided that the International Bureau receives the international application within 2 months of the date of receipt in the USPTO. If the International Bureau does not receive the international application within 2 months of the date of receipt in the USPTO, the date of the international registration will be the date of receipt by the International Bureau.

Can an international applicant claim a priority filing date based on a U.S. basic application?

Yes. A claim of priority in an international application may be based on a U.S. application in accordance with Article 4 of the Paris Convention even if the filing date of the basic application precedes the implementation date of the Madrid Protocol in the United States. The international application must both (1) assert a claim of priority and (2) be filed in the USPTO within six months after the filing date of the basic application that forms the basis of the priority claim.

What happens after the International Bureau registers the mark in the international application?

Once the International Bureau registers the mark, the International Bureau will notify each Contracting Party designated in the international registration of the request for an extension of protection to that country. Each designated Contracting Party will then examine the request for an extension of protection the same as it would a national application under its laws. If the application meets the requirements for registration of that country, then the Contracting Party will grant protection of the mark in its country. There are strict time limits for refusing to grant an extension of protection (a maximum of 18 months). If a Contracting Party does not notify the International Bureau of any refusal of an extension of protection within the time limits set forth in Article 5(2) of the

Madrid Protocol, the holder of the international registration is automatically granted protection of its mark in that country.

After the mark in an international application registers, can the holder of the international registration request an extension of protection in additional countries?

Yes. The holder of an international registration may designate additional Contracting Parties in a subsequent designation. A subsequent designation is a request by the holder of an international registration for an extension of protection of its international registration to additional Contracting Parties. A subsequent designation may also be used to extend protection to goods or services that were not originally extended to the previously designated Contracting Parties. For example, if a trademark owners sought international registration of five classes of goods and services, but limited the initial designation to only one class of goods to the identified Contracting Parties, the holder of the international registration can later designate any or all of the goods/services covered by the international registration to both those countries previously identified or to new countries designated in the subsequent designation.

Can a subsequent designation be submitted through the USPTO for forwarding to the International Bureau?

Yes. If the holder of an international registration is a national of, has a domicile in, or has a real and effective business or commercial establishment in the United States and the international registration is based on a U.S. application or registration, then the subsequent designation may be submitted to the USPTO using either the electronic form provided or on paper. A USPTO transmittal fee is required in either case. The holder also has the option of filing a subsequent designation directly with the International Bureau.

What is the duration of an international registration?

An international registration lasts for ten years from the date of registration and may be renewed for additional 10-year periods by paying a renewal fee to the International Bureau.

If the U.S. Application or registration that forms the basis of the international registration is abandoned, cancelled or expires, will the international registration be cancelled?

Possibly yes. For the first 5 years, the international registration is completely dependent on the U.S. basic application or registration. This means that, during the first 5 years of the life of the international registration, if the U.S. basic application or registration is refused, withdrawn, cancelled or restricted, in whole or in part, then the International Bureau will cancel the international registration. A refusal or cancellation of a basic application or registration after the end of the 5-year period will also result in the cancellation of the international registration, if the action that caused the refusal or cancellation began within that 5-year period. However, after the 5-year period has ended, the international registration becomes independent of the basic application or registration.