

THE MADRID PROTOCOL: WHAT TRADEMARK OWNERS AND PRACTITIONERS SHOULD KNOW

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What is the Madrid Protocol?

- The Madrid Protocol is an international treaty for trademark registration. One trademark registration may extend protection into each member country an applicant designates.
- The Madrid Protocol is part of the “Madrid System”:
 - Madrid System = Madrid Protocol + Madrid Agreement (all governed by WIPO)
 - Madrid System – 74 countries/territories (“Contracting Parties”)
 - Madrid Protocol – 61 Contracting Parties, including U.S.

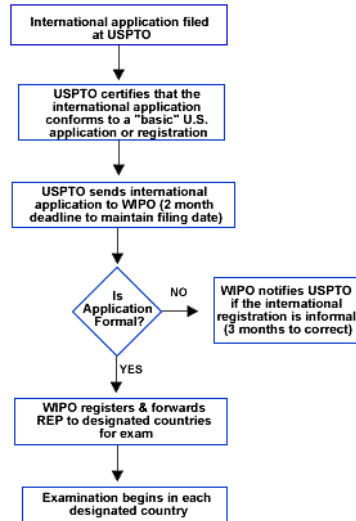
Who Can Take Advantage of the Protocol?

- A Natural Person or Legal Entity That is:
 - a national, domiciled, or has a “real and effective industrial establishment”
 - in a Protocol (not Agreement!) member country or intergovernmental organization.

Where Can A U.S. Applicant File Under the Protocol?

- In any of the sixty other territories that are members of the Madrid Protocol (“Contracting Parties”)

How Do You File a Madrid Protocol Application?



Coverage of the Protocol

- Western Europe: Austria, Benelux, Denmark, Finland, France, Germany, Greece, Iceland, Ireland, Italy, Liechtenstein, Monaco, Norway, Portugal, Spain, Switzerland, Turkey, UK
- Eastern Europe: Poland, Hungary, Bulgaria, Czech Republic, Slovak Republic, Slovenia, Russian Federation, Ukraine, Armenia, Estonia, Belarus, Georgia, Latvia, Moldova, Macedonia, Serbia & Montenegro (former Yugoslavia), Turkmenistan, Lithuania, Romania
- Africa: Kenya, Lesotho, Morocco, Mozambique, Sierra Leone, Swaziland, Zambia
- E. Asia and Pacific: Japan, China, Australia, S. Korea, Singapore, Bhutan, N. Korea, Mongolia
- Middle East: Cyprus, Iran
- Caribbean: Antigua and Barbuda, Cuba

The Nuts & Bolts: Filing International Applications Based on U.S. Rights



Initial Issues and Requirements

- New rules take effect November 2, 2003
- Must have a valid BASE application or registration on file at the USPTO
- Must file electronically (through TEAS—not WIPO!)
- International application must:
 - contain same mark as base;
 - include same or narrower goods or services than covered by base;
 - designate at least one Contracting Party;
 - pay U.S. certification fee (USPTO) and the WIPO fees for all classes and all designated C.P.s at time of filing (US fees: US \$'s payable to PTO; WIPO fees: payable to PTO in US \$s, or to WIPO in Swiss Francs).



Filing Date/Registration Date

- USPTO must certify the application within two months to give applicant a registration date that matches the date of receipt at PTO.
- Priority rules still apply: you can claim priority from the base application/registration within six months of filing date, resulting in International Reg. date with same date as base filing.



Irregularities - WIPO Notifies Applicant/PTO

- Irregularity with Goods/Services:
 - Response MUST be filed through TEAS with USPTO (USPTO will forward to WIPO)
 - USPTO will certify that amended goods/services are within scope of base rights.
 - ****PITFALL: BE CAREFUL WITH AMENDMENTS—IF YOUR AMENDED I.D. IS REJECTED, YOU WILL NOT GET ADDITIONAL RESPONSE TIME!****
- All other irregularities:
 - Can file response with USPTO (TEAS) or WIPO
 - . ****PITFALL: TO BE CONSIDERED TIMELY, RESPONSES MUST BE RECEIVED BY WIPO (NOT USPTO) BY THE DUE DATE.****
- If you are filing with USPTO, respond early and at least one month prior to response deadline.



Subsequent Designations (Adding more countries)

- Can be done through the USPTO (if I.R. is based on U.S.) or WIPO
- Irregularities with Subsequent Designation
 - Must file response directly with WIPO.
- No time limit
 - can always add more countries/territories

Recording Changes

- Must be filed directly with WIPO, with some exceptions

International Filings Based on Non-U.S. Rights

- New “Section 66(a)” filing basis (request for extension of protection (“REP”) into U.S.)
- No multiple filing bases for Section 66(a) application
- No Supplemental Register available
- Filing Date for 66(a) Applications:
 - If request for U.S. protection is made in Int’l Application: same as date of Int’l Registration
 - If request is made in a “subsequent designation”: date WIPO records the subsequent designation

Claiming Priority

- From base filing if:
 - REP or subsequent designation indicates priority claim and
 - the I.R. date or the date of recordal of the subsequent designation is within 6 months of base filing date.

Replacement

- When National Registration covers:
 - same mark as extension of protection; for
 - same goods/services; and is
 - owned by identical party
- I.R. will “replace” the national registration (by operation of law)
 - Can request USPTO to note the “replacement”
 - Can maintain both the replaced registration and the I.R.
 - The I.R. gets all the rights of the replaced registration



Dependency/Central Attack

- I.R.s are dependent on the base rights for five years
- If base application or registration is refused, withdrawn, or cancelled, the I.R. and all designations will also be cancelled.



Transformation

- THE GOOD NEWS: You can transform the I.R. into National Rights.
- HOW?
 - In U.S.: Electronically file a request to transform the REP into a U.S. national application within three months of the date of cancellation.
 - Same filing date is accorded to the transformed application



Maintenance of I.R.

- Renewal: 10 year periods, must renew through WIPO (6 mo. Grace period)
- Declaration of Use (Section 71):
 - Required for REPs to U.S.
 - DATE RUNS FROM REGISTRATION OF REP, NOT I.R. DATE
 - File between:
 - fifth and sixth years; and
 - between 6 months prior to 10 year anniversary, and 10 years (with 3 month grace period).
 - THIS IS SEPARATE FROM THE RENEWAL, AND DONE THROUGH THE PTO.



Strategic Considerations

Benefits of International Registration

- Single registration covering numerous countries
- Ease of transfer, renewal, changes
- No need to hire local counsel unless refusal
- Potential cost savings

How Much Will It Cost?

- Example
 - U.S. application: \$335 plus attorney fees \$485
 - Basic I.R. fee: 653 CHF (\$495)
 - Complementary fees: 73 CHF (\$55) per country that does not charge individual
 - Supplementary fees: Range from 100-600 CHF per country
 - USPTO WIPO transmission fees: Expected to be about \$500
 - Assuming 24 countries, approximately \$24,000 if file individually; approx. \$5000 using I.R.
 - More for color, multi-class

Disadvantages

- Unforgiving rules
- Central attack/dependency on base application/registration
- For U.S. applicants, narrower protection
- Higher search costs
- Limitations on transfer (only to companies entitle to hold registrations under the Protocol)
- Cannot amend mark

Checklist of Things to Think About Before Filing Under Madrid

- Countries of interest
- The Mark:
 - Strength?
 - Likely to encounter objection?
 - Likely to change (e.g., design)?
- Status of basic application/registration
- Status of use
 - CTM: Use in one country is use in all of EU, not so for I.R.!
- Likelihood of transfer of ownership, and to whom?
- Country of origin:
 - If I.R. seems the best, think about using another country as base rights (e.g., Sweden for Volvo, UK for Land Rover)

More New Rules

On November 2, numerous new rules go into effect that apply to ALL new trademark filings.

Signing

- No longer a requirement to maintain signed and dated copies of electronic transmissions



Drawings

- Standard character (f/k/a “typed” drawing)
 - applicant should submit a statement that “the mark is in standard characters and no claim is made to any particular size, font style, or color”.
 - PTO will treat drawings in all caps as standard.
- Special form
 - design marks, or those that claim color, font style, or size. Color marks must now be filed in color.



Partial Refusals

- Failure to respond results in abandonment only for the goods/services refused



Petitions To Revive

- File either:
 - within two months of receipt of Notice of Abandonment; or
 - if no Notice of Abandonment received, within two months of actual knowledge of abandonment, provided that applicant has diligently checked status of application every 6 months (old rule: 1 year)



Dividing Registrations Now Available



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Extensions of Time to Oppose

- Against section 1 or 44 application: can file paper or electronically
- Against section 66 application: MUST file electronically
- No extensions available beyond 180 days past publication:
 - First request: either 30 days, or 90 days if good cause shown
 - Second: if 1st was 30 days, can request 60 days for good cause shown
 - Final: after 90 days, one additional 60 day on consent or showing extraordinary circumstances.
 - NO FURTHER EOTs UNDER ANY CIRCUMSTANCES.



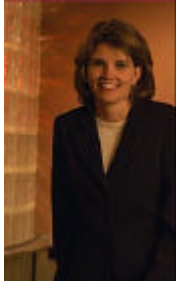
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Notices of Opposition/Petitions for Cancellation

- Again, must file electronically when challenging Section 66 app/reg
- Electronically-filed oppositions/cancellations: Will be refused if fee is insufficient to cover ALL challengers and ALL classes challenged
- Paper-filed oppositions: Will be refused if fee is insufficient to cover at least ONE challenger and at least ONE class challenged; if fee covers less than all challengers/classes challenged, rules dictate what the opposition/cancellation will cover
- Amendments:
 - Against Sec. 1 or 44 applications: may not be amended to add to the goods/services being opposed after the expiration of the opposition deadline
 - Against Sec. 66 applications: may not be amended to add to the goods or services, to add a new ground, or to claim a new registration after filing.

Three Pointers

- Plead broadly and completely!
- File all oppositions electronically!
- Use protective orders—everything is public record!



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