



Madrid Protocol: What Is It and How Does It Work?

The Madrid Protocol is a system for obtaining international trademark registrations. Under the Protocol, owners of a trademark registration or pending application in their home country may use that home registration or application as a basis to request registration of the mark in one or more of 60 countries who are members of the Madrid Protocol.

Is it really international?

"International" is not entirely accurate. While an International Registration can cover more than one country, there are currently only 61 Contracting Parties to the Protocol. The United States joined the Protocol on November 2, 2003. Most of the current members of the Madrid Protocol are in Europe, Asia and Africa. The current Contracting Parties to the Protocol are listed below:

Albania	Finland	Liechtenstein	Sierra Leone
Antigua and Barbuda	France (includes all overseas departments and territories)	Lithuania	Singapore
Armenia	Georgia	Luxembourg	Slovakia
Australia	Germany	Monaco	Slovenia
Austria	Greece	Mongolia	Spain
Belarus	Hungary	Morocco	Swaziland
Belgium	Iceland	Mozambique	Sweden
Bhutan	Ireland	Netherlands Antilles	Switzerland
Bulgaria	Italy	Netherlands	The former Yugoslav Republic of Macedonia
China (does <u>not</u> include Hong Kong or Macau)	Japan	Norway	Turkey
Cuba	Kenya	Poland	Turkmenistan
Cyprus (on Nov. 4, 2003)	Korea (South)	Portugal	Ukraine
Czech Republic	Korea (North)	Republic of Moldova	United Kingdom
Denmark	Latvia	Romania	United States
Estonia	Lesotho	Russian Federation	Zambia
		Serbia and Montenegro	

What are the basic formal requirements and process?

There are four basic requirements for using the Madrid Protocol:

- The mark in the International Application must be identical to the mark in the home application or registration;
- The goods and/or services in the International Application must be the same as the goods and/or services in the home application or registration;
- The named owner of the International Application must be the same named owner of the home application or registration; and
- The appropriate filing fee must be paid. The fee is based on how many classes of goods and services are included in the application, and how many and which countries are designated.

What are the advantages of an International Registration?

- File one application in one location and have one renewal date; centralized recordation of assignments, name changes, and address changes; (WIPO);
- Pay one fee in one currency (Swiss Francs);
- File in one language (English, French or Spanish);
- No foreign associate is needed unless an Office Action or other refusal to register is issued by the trademark office in the Contracting Party;
- Trademark owners can claim the benefit of priority under the Paris Convention to the home application if the International Registration is filed within six months of the filing date of the home application;
- Replacement: trademark owners with pre-existing national trademark registrations in Madrid Protocol Contracting Parties can Request an Extension of Protection in those Contracting Parties to "replace" the national registration, and still retain all of the filing dates and prosecution history with regard to the prior national registration. The advantage is the cost and time savings associated with renewals and recordation of ownership information. The only exception is that a home registration (upon which the International Registration is based) can never be replaced with an International Registration. It must be maintained separately; and
- Subsequent Designations: owners of an International Registration can make subsequent designations to other or new Contracting Parties to the Protocol. The subsequent designation is an easy filing process utilizing all of the information already existing in the International Registration. It must still undergo the process of a Request of Extension of Protection in the newly designated Contracting Party. A granted subsequent Extension of Protection does not have the benefit of the first filing date of the International Registration, but it does have the same renewal date and advantage with regard to recording assignments and other ownership changes.

Are there any limitations of an International Registration?

- The drawing of the mark can never be amended. If a design mark is registered and the look of the mark is updated over time, the mark of the registration cannot be amended. A new home application will have to be filed in order to file a new International Application to protect the updated version of the mark.
- The goods and/or services of the International Registration can never be broader than the goods and/or services of the home registration. If the goods and services of the home application are amended or partially deleted during the first five years of the pendency of the International Registration, the goods and services of the International Registration will also have to be narrowed or partially deleted accordingly.
- The United States requires that U.S. trademark registrations identify their goods and services with specificity. However, there are a number of countries across the globe that allow trademark registrations with much broader identifications of goods and services. Some even allow the goods and services to recite a standardized class heading for a particular class of goods. If a U.S. applicant Requests an Extension of Protection through the Madrid Protocol into one of those countries, the Extension of Protection will be limited to those goods and services specified in the U.S. registration. On the other hand, if the same applicant filed a national trademark application in that country, it could have a registration with a much broader identification of goods and services.
- An International Registration can be assigned in whole or in part, but only to a person or entity that is domiciled in or has a real and effective industrial or commercial establishment in a country designated in the International Registration. The International Registration cannot be assigned to any entity that is not entitled to participate in the Protocol.
- All deadlines are firm and extensions of time are not permitted.
- Filing an International Application may not be less expensive than filing directly in the same national countries. However, if a trademark owner anticipates that it will continue to use and desire to protect a particular trademark in some of the Contracting Parties to the Protocol for more than 10 years, there can be noticeable cost savings when the International Registration is due for renewal, or is assigned, or the owner has a name change or address change that must be recorded.

Why is an International Registration called a "Bundle of Rights"?

The International Registration does not extend any rights in and of itself. The rights are extended by the countries designated in the International Registration.

After the International Registration is granted it is examined by the individual trademark offices in the Designated Countries. The trademark offices in each Designated Country can require that the goods and/or services specified in the International Registration be further defined, limited, or partially deleted in their specific jurisdiction in order to grant the Extension of Protection.

If the Designated Country's trademark office refuses registration, the owner must then engage local counsel in that country to respond to the Office Action. If no Office Action is issued, local counsel is not necessary.

Ultimately, if the protection is granted, the International Registration has the same rights and effect as a national trademark registration from the designated jurisdiction, and maintains the same registration number and renewal date as the International Registration.

What does it mean that the International Registration is dependent upon the home registration for five years?

The fate of the International Registration is dependent upon the registration on which the International Registration is based, the "home" registration. If the home application is refused registration or the home registration is cancelled during the first five years of the pendency of the International Registration, the International Registration will become abandoned. This is referred to as a "central attack." There are provisions to "transform" the International Registration to national registrations in the Designated Countries if, and only if, the International Registration is defeated by a central attack. Transformation requires the hiring of local counsel, meeting all of the individual filing requirements in the individual countries, paying all of the individual country fees, and undergoing examination as a national trademark application in each country. If an International Registration is not abandoned due to a central attack, it becomes independent of the home registration after the International Registration has existed for five years.

Will You Be Affected by the Madrid Protocol Even If You Do Not File Foreign Trademark Applications?

U.S. trademark owners will be affected by U.S. accession to the Madrid Protocol even if they do not file for foreign protection through the Madrid Protocol. When the U.S. accedes to the Protocol, International applicants will be able to designate the U.S. in their International Application.

As a result, when investigating the availability of a proposed mark for use and registration in the U.S., we will also need to search International Registrations and Applications that designate the U.S. We have confirmed with our preferred search providers that they will include International Applications and Registrations in their full search reports at no additional cost. However, with more records to review, search costs are likely to increase slightly.

The Madrid Protocol may offer certain benefits to U.S. trademark owners interested in protecting their trademarks abroad. However, the Protocol is not a one-stop shopping forum or appropriate for every mark or every trademark owner.

We, at Sterne Kessler, are prepared to assist you in making the strategic decisions about how best to protect your marks abroad. The decision whether to utilize the Madrid Protocol must be made on a mark-by-mark basis and take into account your overall business plans for each mark. If you have any questions regarding the Madrid Protocol, please contact us at (202) 371-2600.