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THE MADRID
PROTOCOL:
A SLUMBERING GIANT
AWAKENS AT LAST

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The Madrid Protocol:
A Slumbering Giant
Awakens At Last

by

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Table of Contents

I	Introduction	1
	[a] – When Can Trademark Owners Take Advantage of United States Implementation?	3
	[b] – Why the Delay for United States Implementation?	4
	[i] – State Department Objections	4
	[ii] – The HAVANA CLUB Imbroglio	5
	[iii] – “Anonymous Republican Hold”	5
II	The Madrid System	6
	[a] – The Madrid Agreement	7
	[b] – The Madrid Protocol	7
	[c] – Differences Between the Agreement and the Protocol	8
III	Madrid Protocol Basics	11
	[a] – Who May File an International Application?	11
	[b] – Filing the International Application: Basic Applications and Basic Registrations	11
	[c] – International Registration	14
	[d] – Priority	15
	[e] – Designations	16
	[f] – Examination by the Office of a Designated Contracting Party	17
	[g] – Dependence on Basic Application or Basic Registration and “Central Attack”	20
	[h] – What Happens to an Existing National Registration?	23
	[i] – Fees	23
	[j] – Searching	24
	[k] – Post-Registration	25
	[i] – Renewal	25
	[ii] – Subsequent Designations	26
	[iii] – Assignment	27
	[iv] – Limitation, Renunciation or Cancellation	27
	[v] – Amendment	28
	[vi] – Licenses	28
	[vii] – Change of Name or Address of Holder or Its Representative	29
IV	Advantages and Disadvantages	29
V	Conclusion	32
	Appendix A – Provisions to Implement in the United States the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks	33
	Appendix B – Official Form for Application for International Registration Governed Exclusively by the Madrid Protocol	47

THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST*

I Introduction

Yes, the Giant has finally stirred, stretched and put his enormous feet on the stone floor, beginning, slowly but determinedly, to wake up and move. No trumpets blaring, no town crier shouting, no villagers running in fear. The sounds of the day are muted. But there is a definite excitement in the air. The moment everyone has been waiting for is almost here, though the wait has been so long some take him not for the Madrid Protocol but for a huge, sleepy Rip van Winkle.¹

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks – known more simply as the Madrid Protocol – is soon to be implemented in the United States.² Without a doubt, this will be an event of stunning proportions in the trademark world. Why?

When the United States becomes a Contracting Party, U.S. trademark owners with a mark registered in or an application pending with the United States Patent and Trademark Office (“USPTO”) will be able to file not only a single application but one in a single language using a single currency. They can thereby obtain a single international registration with one renewal date. By doing so, U.S. mark owners will apply for protection

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¹ Because the USPTO had not issued its proposed rules and regulations as of this writing, the authors will explain the background and the general operation of the Protocol. Specific, detailed practice tips will have to wait until later.

² The full text of the implementing legislation in the United States, *not yet in force*, appears as Appendix A to this pamphlet. For more on the effective date of the legislation, see I.a *infra*. The Madrid Protocol itself is reprinted in Gilson & LaLonde, 3 *Trademark Protection and Practice* Appendix 10C. For further reference, see also WIPO’s “Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol” at www.wipo.int/madrid/en/index.html; “INTA Issue Brief – The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice,” 92 T.M.R. 1430 (2002); Squyres, *Trademark Practice Throughout the World* (2002) (Chapter 14, “The Madrid System”). The authors are grateful to Mary Squyres for her thoughtful comments.

in all countries they designate that are signatories to the Madrid Protocol,³ subject to objection by a country within approximately eighteen months of application on the basis of examination or opposition.⁴ Similarly, certain owners of foreign trademarks can easily apply for a United States trademark registration and obtain the same protection here as would a domestic applicant. With the Protocol, simplicity abounds.

There will be unprecedented, some might say gigantic, opportunities for trademark owners that have chafed under the cost and complexity of filing separately for national trademark registrations in the vast majority of countries around the world. Indeed, the budget-minded business should find it possible to expand trademark coverage to over 50 countries – if its mark is eligible for registration there – with the somewhat greater cost of a single application, rather than being limited to fewer countries for the same cost. Much of the savings will come with renewals, assignments and making changes in contact information.

The United States will finally become a member of the Protocol when the legislation takes effect. The system has gained international acceptance. During 2001, 3,134 international registrations were filed under the Madrid Protocol.⁵ By the end of 2001, 381,684 international registrations were in force under the Madrid system.⁶

The Madrid Protocol implementing legislation makes no substantive change to United States trademark law and grants no new substantive rights to trademark owners. Instead, in the prolix words of the Senate Report on the legislation, it “establishes the structural and procedural mechanisms to accommodate the filing, acceptance, and examination of international applications in the U.S. Patent and Trademark Office, and the registration, maintenance, and cancellation of marks based on such applications.”⁷ Each national trademark office will independently examine filings under the Protocol using the same standards it applies to

³ A list of countries that are currently signatories to the Protocol appears at N.17 *infra*.

⁴ See III.f *infra* for more on the time limitation for refusal.

⁵ See www.wipo.int/madrid/en/index.html for WIPO’s Statistical Supplement for 2001. In that year, there were also 7,817 registrations filed under the Madrid Agreement alone and 13,034 registrations resulting from international applications governed by both the Agreement and the Protocol.

⁶ *Id.*

⁷ S. Rep. 106-249 at 5 (2000).

3 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

applications filed directly with that office. Thus, applicants must still consider the viability of obtaining trademark protection in each country in which they seek protection.

On October 17, 2002, the U.S. Senate passed an advice and consent resolution approving the United States joining the Madrid Union under the provisions of the Protocol.⁸ Then on November 2, 2002, President Bush signed into law the Department of Justice Authorization Conference Report, which contained the implementing legislation for the Madrid Protocol.⁹ The USPTO is therefore hard at work developing a system for administering Madrid Protocol applications and is expected to publish proposed regulations by March 31, 2003. As this monograph goes to print, we do not have the details of USPTO implementation, rules and forms (all will be electronic).

[a] – When Can Trademark Owners Take Advantage of United States Implementation?

The effective date of the Madrid Protocol Implementation Act is uncertain. According to the statute, it will be the *later* of (1) the date on which the Madrid Protocol enters into force with respect to the United States (*i.e.*, three months after deposit with WIPO of the instrument of accession)¹⁰ or (2) one year after the Madrid Protocol Implementation Act was enacted (*i.e.*, when the President signed the legislation into law), which was November 2, 2002.¹¹ Even though the statutory language is clear, the actual effective date of the legislation is not. As of February 2003, the United States State Department still had not deposited the instrument of accession with WIPO. The USPTO has said that it plans to have its Madrid Protocol procedures in place by November 2, 2003, and if the U.S. State Department deposits the instrument on August 2, 2003, then November 2, 2003 will in fact be the first day for Madrid Protocol applications. However, if the State Department does not deposit the

⁸ 148 Cong. Rec. S10640 (Oct. 17, 2002).

⁹ The Madrid Protocol Implementation Act was part of a large appropriations bill (21st Century Department of Justice Appropriations Authorization Act, H.R. 2215) embodied in House Report 107-685.

¹⁰ See Article 14 of the Madrid Protocol.

¹¹ Pub. L. No. 107-273, Div. C, Tit. III, Subtit. D, § 13403.

document until September 1, 2003, for example, then the Madrid Protocol will take effect in the United States on December 1, 2003.

[b] – Why the Delay for United States Implementation?

Enactment of the Madrid Protocol Implementation Act and ratification of the treaty have been a long time coming in the United States. The delay, many thought, has been maddening, caused by a combustible mixture of international diplomacy and good old-fashioned American politics.

The Protocol came into existence in 1989 and began operation in 1996. The Madrid Protocol Implementation Act was first introduced in the United States Congress in 1993. Legislators strongly supported the bill and the Clinton Administration even forwarded the treaty to the Senate for ratification. Any delay was unrelated to substantive concerns over whether to become a member of the Protocol. So why did it take so long for the United States to join?

[i] – State Department Objections

In 1994, the United States State Department objected to a provision in the Protocol allowing an intergovernmental organization to join the treaty if at least one of its member states is a party to the Paris Convention and thus also eligible to join the treaty.¹² The State Department interpreted this provision to mean that intergovernmental members such as the European Union would, upon joining, be able to vote in the governing body for the Madrid system, while its member nations would each also be able to vote. If the individual member nations each had a vote *and* the EU had a vote, the State Department argued, there would be unacceptable double votes for the same constituency. The State Department thus objected, concerned about the precedent this interpretation might set in future international agreements. Finally, in February 2000, the Council of the European Union and the Representatives of the Governments of the Member States approved a Statement of Intent affirming that the European Union and its Member States will first try to reach a common position with other participants, but if that is not possible, then they agreed that the number of votes they cast will not exceed the number of Member States. At that point,

¹² Article 14(1) of the Madrid Protocol.

the administration sent the ratification recommendation to the Senate. However, even after the diplomatic obstacle was surmounted, the Protocol was blocked from Senate consideration by a contentious trademark dispute and political maneuvering.

[ii] – The HAVANA CLUB Imbrolio

Passage of the implementing legislation and Senate ratification of the Protocol were hindered by a private dispute over the mark HAVANA CLUB. Bacardi, a rum distiller, alleged that it acquired the mark from the mark's original owner, and Pernod Ricard, a French company that had formed a joint venture with the Cuban government, claimed that the Cuban government had given it worldwide rights to use the same mark.

Section 211 of the United States Department of Commerce Appropriations Act of 1999 provides that no United States court shall recognize or enforce any treaty rights of a designated national for a trademark that is the same or substantially similar to a trademark used in connection with a confiscated business unless the original owner has given consent.¹³ The statute protects owners of trademarks confiscated by Fidel Castro's government after its takeover of Cuba. Thus, the law barred Pernod Ricard from enforcing its mark in the United States.

What does this have to do with international trademark registrations under the Madrid Protocol? Well, the draft advice and consent resolution of the Senate Foreign Relations Committee contained language relating to the HAVANA CLUB dispute when a Senator proposed an amendment that would have allowed the United States to block the registration of trademarks deemed to violate United States law, as under Section 211. Pernod Ricard campaigned against the inclusion of the language and the vote was put off again.

[iii] – “Anonymous Republican Hold”

After negotiations resolved the HAVANA CLUB dispute, and despite support for the implementing legislation, an “anonymous Republican hold”

¹³ The Department of Commerce Appropriations Act was included in the Omnibus Consolidated and Emergency Supplemental Appropriations Act of 1999, Pub. L. No. 105-277, 112 Stat. 2681, which became law in the United States on October 21, 1998.

resulting from a clash over federal judicial nominations held up passage of the Madrid Protocol Implementation Act for several months.¹⁴ When that situation was resolved, the passage of the Act and the Senate's advice and consent for ratification of the treaty came soon after. And with them came an audible sigh of relief from the embattled trademark community.

II The Madrid System

Those taking advantage of the considerable Madrid Protocol benefits must understand that there are actually two treaties that govern the "Madrid system" of international registration of trademarks: (A) the Madrid Agreement Concerning the International Registration of Marks and (B) the Protocol Relating to the Madrid Agreement. Together, they form the Madrid system of international registration and are administered by the International Bureau of the World Intellectual Property Organization ("WIPO"), in Geneva, Switzerland. States that are party to either the Agreement or the Protocol or both are known as "Contracting Parties."

Another international agreement, the Paris Convention for the Protection of Industrial Property, also plays an important role in the harmonization of trademark protection and the Madrid system.¹⁵ The Paris Convention, to which the United States is a party, gives persons in Contracting States the same rights as nationals in other Contracting States and provides for a six-month right of priority for trademarks. This six-month priority means that those who file applications in a Contracting State to the Convention may rely on that filing date as their priority date when they file in other Contracting States, provided that they file in the other States within six months after the original application was filed. Lawyers filing trademark applications in the USPTO often inform their clients of the deadline to give them the opportunity to apply to register the mark in other Paris Convention countries, preserving the filing date priority in those countries.

¹⁴ 148 Cong. Rec. S5583 (June 14, 2002) (statement of Sen. Leahy); 148 Cong. Rec. S9586 (Sept. 30, 2002) (statement of Sen. Leahy); 148 Cong. Rec. S9689 (Oct. 1, 2002) (statement of Sen. Leahy).

¹⁵ For the text of the Paris Convention, see Gilson & LaLonde, 3 *Trademark Protection and Practice* Appendix 10A.

7 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

Any state that is a party to the Paris Convention may become a party to the Agreement or the Protocol or both. An intergovernmental organization (such as the European Union, which is not yet a party) may become a party to the Protocol where at least one of its member states is a party to the Paris Convention and where it has a regional office that registers marks in the organization's territory.

[a] – The Madrid Agreement

The Madrid Agreement spans three different centuries. It was adopted in 1891 and, as of January 28, 2003, 52 States, including China, the Russian Federation and most of Europe, are contracting parties. The Agreement provides for the international registration of marks. The owner of a “home country” trademark registration – not merely an application – in a member state may file with its home trademark office an international application designating other member states in which extension of protection is desired. The application is forwarded to the International Bureau of WIPO for issuance of an international registration, which has a term of 20 years.

[b] – The Madrid Protocol

By contrast, the Madrid Protocol is a relative newcomer. Adopted at a diplomatic conference in 1989, it is a separate treaty that co-exists with the Madrid Agreement. It began operation on April 1, 1996, and is, as is the Madrid Agreement, an international trademark filing system among Contracting Parties that results in the issuance of international registrations. The United States is to become a Contracting Party of the Protocol upon the effective date of the Madrid Protocol Implementation Act.¹⁶ As of January 28, 2003, 57 countries are signatories to the Madrid Protocol (not yet including the United States).¹⁷ The European Union is not yet a Contracting Party, but is expected to join the Protocol.

¹⁶ See I.a *supra* for more on the effective date of the Madrid Protocol Implementation Act in the United States.

¹⁷ The countries and the dates on which they became party to the Madrid Protocol are: Antigua and Barbuda (March 17, 2000); Armenia (October 19, 2000); Australia (July 11, 2001); Austria (April 13, 1999); Belarus (January 18, 2002); Belgium (April 1, 1998); Bhutan (August 4, 2000); Bulgaria (October 2, 2001); China (December 1, 1995); Cuba

[c] – Differences Between the Agreement and the Protocol

The United States is not a member of the Madrid Agreement. A number of concerns, detailed below, precluded United States participation in the Madrid Agreement, and were addressed in the Protocol.

- The Madrid Agreement requires that an international application be based on a home country *registration*.¹⁸ This restriction was felt to disadvantage U.S. trademark owners because it takes longer to obtain a registration in the United States than in most other countries. Under the Protocol, the applicant may base its application for international registration on an *application* filed with the home country’s trademark office *or a registration* granted by that office.¹⁹ This change will also allow those who apply under the Protocol to take advantage of the six-month priority period of the Paris Convention.²⁰

(December 26, 1995); Czech Republic (September 25, 1996); Democratic People's Republic of Korea (October 3, 1996); Denmark (February 13, 1996); Estonia (November 18, 1998); Finland (April 1, 1996); France (November 7, 1997); Georgia (August 20, 1998); Germany (March 20, 1996); Greece (August 10, 2000); Hungary (October 3, 1997); Iceland (April 15, 1997); Ireland (October 19, 2001); Italy (April 17, 2000); Japan (March 14, 2000); Kenya (June 26, 1998); Latvia (January 5, 2000); Lesotho (February 12, 1999); Liechtenstein (March 17, 1998); Lithuania (November 15, 1997); Luxembourg (April 1, 1998); the former Yugoslav Republic of Macedonia (August 30, 2002); Monaco (September 27, 1996); Mongolia (June 16, 2001); Morocco (October 8, 1999); Mozambique (October 7, 1998); the Netherlands (April 1, 1998); Norway (March 29, 1996); Poland (March 4, 1997); Portugal (March 20, 1997); Republic of Korea (April 10, 2003); Republic of Moldova (December 1, 1997); Romania (July 28, 1998); Russian Federation (June 10, 1997); Sierra Leone (December 28, 1999); Singapore (October 31, 2000); Slovakia (September 13, 1997); Slovenia (March 12, 1998); Spain (December 1, 1995); Swaziland (December 14, 1998); Sweden (December 1, 1995); Switzerland (May 1, 1997); Turkey (January 1, 1999); Turkmenistan (September 28, 1999); Ukraine (December 29, 2000); United Kingdom (December 1, 1995); Yugoslavia (February 17, 1998); Zambia (November 15, 2001).

For the most current list of adhering countries, visit the WIPO website at www.wipo.int/treaties/documents/english/g-mdrd-m.doc.

¹⁸ Article 3(1) of the Madrid Agreement.

¹⁹ Article 2(1) of the Madrid Protocol.

²⁰ See Section 67 of the Madrid Protocol Implementation Act, reprinted in Appendix A to this monograph (hereinafter “MPIA Section”) (providing that the holder of an international registration with a request to extend protection to the United States may claim Paris Convention priority if the date of international registration or the date of the

9 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

- Critics believed that the 12-month period in the Agreement within which a designated country could refuse an extension of protection²¹ was inadequate given the relatively extensive and lengthy examination process followed in the United States. Under the Protocol, however, each Contracting Party may elect a period of 18 months (instead of 12 months, as in the Agreement) to grant or refuse protection to the mark or notify the holder of the possibility of refusal.²² The United States has in fact elected to follow the 18-month period.²³
- Under the Madrid Agreement, “central attack” may occur during the first five years of an international registration as follows: Where the basic application or basic registration has its scope of protection limited or eliminated during that time, under the Agreement, the international extension registrations were similarly limited or eliminated and there was no recourse for the owner of the international registration.²⁴ The Madrid Agreement’s “central attack” provisions were considered unfair by U.S. trademark owners because many of the grounds available to reject, oppose or move to cancel a U.S. registration are not recognized in other countries. Under the Protocol, however, when an international registration is canceled during its first five years due to failure of the basic application or basic registration, the international registration may be transformed into national applications in each of the Contracting Parties in which the international registration had effect, maintaining the priority date of the international registration.²⁵ That procedure takes some of the sting out of “central attack.”
- Under the Agreement, the working language is French and all applications filed under the Agreement must be in French.²⁶ Under the Protocol, however, the Office of Origin may require applications made

request for protection is not later than six months after the date of the first regular national filing or a subsequent application).

²¹ Article 5(2) of the Madrid Agreement.

²² See Article 5(2) of the Madrid Protocol.

²³ MPIA Section 68(c)(4). See III.f *infra* for more on the time limits for refusal.

²⁴ Article 6(3) of the Madrid Agreement.

²⁵ See Article 9*quinquies* of the Madrid Protocol.

²⁶ Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement (hereinafter “Common Regulations”), Rule 6(1)(a).

under the Protocol to be filed in English or in French, or it may permit the applicant to choose one of the two.²⁷

- Under the Agreement, an applicant has less choice over the trademark office in which it must file: It may only file in a country party to the Agreement in which it has “a real and effective industrial or commercial establishment.” Only if it has no such establishment may it file in the Office in the country of its domicile if that country is party to the Agreement or, if it has no domicile in such a country, then it may file in a country party to the Agreement where it is a national.²⁸ However, under the Protocol, the applicant may choose its Office of Origin based on establishment, domicile *or* origin.²⁹
- A registration under the Agreement lasts for 20 years before it must be renewed,³⁰ while under the Protocol a registration lasts for 10 years before it must be renewed.³¹ The shorter time period should eliminate deadwood on the International Register.
- Under the Agreement, the applicant pays a fixed fee for each designated Contracting Party.³² Under the Protocol, however, there may be either a fixed fee or the Contracting Party may set up its own “individual” fee system in which the national Office may charge the same fee for any extension of an international registration in its territory that it would have charged for a national ten-year registration.³³ This change means that designations under the Protocol will likely be more expensive than those under the Agreement, though still less than obtaining registration from individual countries, especially if the user does not incur local agent’s charges.

²⁷ Common Regulations, Rule 6(1)(b).

²⁸ Article 1(3) of the Madrid Agreement.

²⁹ Article 2(1) of the Madrid Protocol.

³⁰ Articles 6(1), 7(1) of the Madrid Agreement.

³¹ Articles 6(1), 7(1) of the Madrid Protocol.

³² Article 8(2)(c) of the Madrid Agreement.

³³ Article 8(7) of the Madrid Protocol.

III Madrid Protocol Basics

[a] – Who May File an International Application?

Businesses and individuals in the United States will qualify under the Madrid Protocol. A natural person or legal entity that (1) is domiciled in a country or territory of an intergovernmental organization that is party to the Madrid Protocol, (2) is a national of a country that is party to the Protocol or of a member state of an intergovernmental organization that is a party, or (3) has a “real and effective industrial or commercial establishment” in a country or territory of an intergovernmental organization that is party to the Protocol may file an application for an international registration.³⁴ Other people or legal entities may not file applications with the USPTO under the Madrid system.

Definitions of “national,” “domiciliary,” and “real and effective industrial or commercial establishment” are for each Contracting Party to interpret. The United States legislation does not define these terms. However, the phrase “real and effective industrial or commercial establishment” is taken from Article 3 of the Paris Convention, and excludes bogus business establishments but also includes establishments that may not be the company’s principal place of business.³⁵ Businesses may have such establishments in several different countries that are Contracting Parties, and the applicant may therefore choose any of the Offices of those countries to be the Office of Origin.

[b] – Filing the International Application: Basic Applications and Basic Registrations

Under the Protocol, an international registration must be based on a national application (the “basic application”) or registration (the “basic registration”) in the trademark office of a Contracting Party to the Protocol. In order to apply for an international registration, the applicant must file a form at the national trademark office where the basic application was filed or the basic registration was granted.³⁶ The office where trademark

³⁴ Article 2(1) of the Madrid Protocol; MPIA Section 61(b).

³⁵ WIPO Guide B.02.06, N. 2 *supra*.

³⁶ An official WIPO form for Application for International Registration Governed Exclusively by the Madrid Protocol is attached as Appendix B to this monograph.

applications are filed in a Contracting Party is called the “Office of Origin.”

If a U.S.-based company applies to register a mark with the USPTO, which is the Office of Origin for the United States, that application constitutes a “basic application” under the Madrid Protocol and under United States legislation.³⁷ The company, as the owner of that basic application, may also then file an “international application” for international registration under the Madrid Protocol. It does so by submitting to the USPTO a written application and fees as required by the PTO’s upcoming regulations. The USPTO will require that applications be filed in English. Note that the USPTO will require that international applications be filed *electronically*.

Of extreme importance to trademark owners is what might be called a retroactive effect of the Protocol. A U.S. company that owns a trademark registration granted by the USPTO owns a “basic registration” under the Protocol and the United States legislation.³⁸ Thus, the company can review its entire registered trademark portfolio and select Madrid Protocol application candidates, no matter how many years ago the registrations issued. The requirements should be easy to meet. In order to file an international application, the company must be a “qualified owner” of a basic application or basic registration under the United States legislation, which means that the owner must be a national of the United States, be

³⁷ A basic application is an application for trademark registration that has been filed with an “Office of a Contracting Party.” Article 2(1) of the Madrid Protocol; MPIA Section 60(1). A Contracting Party is any country or “inter-governmental organization” that is a party to the Madrid Protocol, MPIA Section 60(3), and the Office of a Contracting Party is the office or governmental entity of a Contracting Party that is responsible for registering trademarks (in the United States, it is the Patent and Trademark Office) or “the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau” of the World Intellectual Property Organization. MPIA Section 60(15). For example, the Office for Harmonization in the Internal Markets is the common office for the European Union and when the EU becomes a party to the Protocol, the OHIM will be its Office of Origin.

³⁸ MPIA Section 60(2); Article 2(1) of the Madrid Protocol. It is unclear whether a registration on the Supplemental Register will qualify to be a basic registration or if the U.S.-based international applicant must have a registration on the Principal Register.

domiciled in the United States, or “have a real and effective industrial or commercial establishment in the United States.”³⁹

After the international application is filed, the Office of Origin is tasked with certifying that the mark in the international application is identical to the mark in the basic application or registration, that the applicant is the same as the owner of the basic application or registration, and that the goods and services listed in the international application are the same as or are included in the goods and services listed in the basic application or registration. It also verifies the date on which it received the request for the international registration. Then the Office of Origin will forward the international application to the International Bureau of WIPO.⁴⁰ In the United States, when a qualified trademark owner files an outbound application for international registration with the USPTO and pays the requisite fees, the USPTO will examine that application and certify that the information in the international application corresponds to that in the basic application or basic registration at that time. After the PTO examines and certifies an international application, the PTO transmits it to the International Bureau of WIPO and is required to do so within two months.⁴¹

Foreign applicants may apply for United States protection of marks already in use here in an inbound application. But foreign applicants that attach a declaration of *bona fide intention to use* a mark in commerce along with their international applications or registrations may also receive an extension of protection in the United States.⁴² The request for extension of protection must be verified by the applicant for the international registration or its holder.⁴³ The filing date of the request for extension of protection in that case establishes nationwide priority of the mark just as the filing of an intent-to-use application would if made directly with the USPTO. The foreign applicant will have the same rights as given in Section 7(c) of the Lanham Act, which gives the filing date of the intent-to-use application as the priority date, contingent on the registration of the

³⁹ MPIA Section 61(b). See III.a *supra*.

⁴⁰ MPIA Section 62(b).

⁴¹ Article 3(4) of the Madrid Protocol.

⁴² MPIA Sections 60(5) and 66(a).

⁴³ MPIA Section 66(a).

mark on the U.S. Principal Register.⁴⁴ For the Madrid Protocol applicant, the priority date will be the earliest of the following: (1) the date of international registration if the request for extension of protection in the United States was filed along with the original international application; (2) the date of recordal on the International Register of the request for extension of protection, if the request for extension of protection was made after the international registration date (*i.e.*, was made as a subsequent designation); or (3) the date of priority claimed pursuant to Article 4 of the Paris Convention.⁴⁵

Note that the international application can only relate to goods and services covered by the basic application or registration. It is also possible to base an international application on several applications and/or registrations that together cover the goods and services to which the international application relates. The basic applications and/or registrations must all be in the name of the same person filing the international application and must have been made with the same Office. The applicant need not include any disclaimers from its basic application or basic registration in its international application.⁴⁶

[c] – International Registration

After receiving the international application, the International Bureau determines whether the filing requirements are met and whether the listed goods and services are properly classified. If so, the mark is recorded in WIPO's International Register as the subject of an international registration and published in the WIPO Gazette of International Marks. The mark will be scanned from the international application form and reproduced exactly in the WIPO Gazette.⁴⁷ If the mark is in color, it will be reproduced in black and white in its main entry in the Gazette and will be published in color in a separate section at the end of the Gazette.⁴⁸ WIPO also notifies the Offices of the designated Contracting Parties of the international registration, informs the Office of Origin and sends a certificate to the holder.

⁴⁴ 15 U.S.C. § 1057(c).

⁴⁵ MPIA Section 66(b). See II *supra* for more on Paris Convention priority.

⁴⁶ Common Regulations, Rule 9(4)(b)(v).

⁴⁷ Common Regulations, Rule 32(1)(b).

⁴⁸ Common Regulations, Rule 32(1)(c).

15 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

Those who wish to oppose a mark would *not* do so at this time but must instead wait for the appropriate time to do so in the Office of a designated Contracting Party (*e.g.*, publication in the USPTO's Official Gazette). WIPO does *not* determine substantively whether the mark qualifies for protection or whether an identical or similar mark has already been registered. Those questions are left for the Offices of the designated countries.

The phrase "international registration" is a misnomer in that it is not a registration in the same sense as a trademark registration with the USPTO. Instead, the holder of an international registration gains *the right to apply for registration in Contracting Parties*. This right survives even if a designated Contracting Party refuses registration. If the holder of the international registration designates, for example, China, Japan and Korea, and China and Japan grant an extension of protection but Korea does not, the international registration continues in force.

[d] – Priority

An international registration will bear the date on which the international application was filed with the Office of Origin, provided that the application reaches WIPO within two months from that date and the application is in order. If not, the priority date will be the date WIPO receives all of the elements required for the application.⁴⁹ Essential elements include the identity or contact information of the applicant, designated Contracting Parties, a reproduction of the mark, and an indication of goods or services for which registration is sought.⁵⁰ It is the duty of the Office of Origin to remedy any deficiencies. Where the deficiency is corrected within two months from the date the international application was filed, the date of the international registration will be the same as the date of filing. If the deficiencies are not corrected within three months of notification to the Office, WIPO will consider the application abandoned.⁵¹

An applicant may claim priority for an earlier filing under Article 4 of the Paris Convention if the applicant applies for an international

⁴⁹ Article 3(4) of the Madrid Protocol.

⁵⁰ Common Regulations, Rule 15(1).

⁵¹ Common Regulations, Rule 11(4).

registration or makes a subsequent designation within six months of filing its basic application.⁵² Where the holder of an international registration makes a request for extension of protection in the United States, it may claim a priority date based on the Paris Convention's six-month priority rule if (1) its request for extension of protection explicitly makes such a claim and (2) the date of its international registration or the date of recordal of the request for extension of protection in the United States is not later than six months after the earlier filing.⁵³

That earlier filing – the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property) – will usually be the basic application or the application that resulted in the basic registration. It may also be, however, another application made in a country that is party to the Paris Convention or an application “which, under a bilateral or unilateral treaty concluded between countries of the Paris Union, is equivalent to a regular national filing.”⁵⁴ The WIPO Guide to the International Registration of Marks Under the Madrid Agreement and the Madrid Protocol states that this results from Article 4A(2) of the Paris Convention, and notes that the International Bureau records claims to priority from applications for Community Trademarks filed with the Office for Harmonization in the Internal Market (OHIM) under Paris Convention priority.⁵⁵

[e] – Designations

The applicant may only designate a Contracting Party where its own Office of Origin is party to the same treaty as that Contracting Party.⁵⁶ For example, when the United States becomes a party to the Madrid Protocol, applicants whose Office of Origin is the USPTO may not designate Albania, Croatia or Viet Nam because those countries are party to the

⁵² An applicant may not claim a priority date that is more than six months earlier than the date of the international registration. Common Regulations, Rule 14(2)(i).

⁵³ MPIA Section 67.

⁵⁴ WIPO Guide at B.II.13, N. 2 *supra*; Article 4(2) of the Madrid Protocol.

⁵⁵ WIPO Guide at B.II.13, N. 2 *supra*.

⁵⁶ Common Regulations, Rule 9(4)(a)(xv).

Madrid Agreement only.⁵⁷ (Of course, Madrid System applicants may never designate countries that are neither party to the Protocol nor the Agreement and thus not part of the Madrid system.)

An applicant for an international registration may not designate the Contracting Party of the Office of Origin for the basic application or basic registration. In other words, a United States applicant may not include the United States as one of its designated Contracting Parties.⁵⁸ Thus, the United States applicant must keep track of its USPTO renewal date as well as its international registration renewal date.

[f] – Examination by the Office of a Designated Contracting Party

It is important to note that filing an international application by no means guarantees protection in each designated country, just as filing any trademark application does not guarantee registration. The Office of Origin of each designated country examines the application as if it were an application for registration filed directly with that Office. The USPTO, for example, will examine a request for extension of protection to the United States “as an application for registration on the Principal Register” and if the applicant appears to be entitled to protection, it will publish the mark in its Official Gazette.⁵⁹ The mark will be protected in the designated countries just as if it had been the subject of applications filed directly with those countries.

An Office of Origin may issue a statement of grant of protection if it decides to extend protection to the mark, though under the Protocol the Office need not issue a definitive statement granting registration, even if it chooses to permit it. Nevertheless, by statute, the United States “shall issue” notice of a certificate of extension of protection where protection has not been refused.⁶⁰ Where it does issue such a certificate, the extension of protection will have the same effect as a registration on the

⁵⁷ As of February 2003, countries that are party to the Agreement and not the Protocol are: Albania, Algeria, Azerbaijan, Bosnia and Herzegovina, Croatia, Egypt, Kazakhstan, Liberia, San Marino, Sudan, Tajikistan, Uzbekistan and Viet Nam. For a current list of countries party to the Agreement and/or the Protocol, see www.wipo.int/treaties/documents/english/pdf/g-mdrd-m.pdf.

⁵⁸ MPIA Section 65(b).

⁵⁹ MPIA Section 68(a)(1).

⁶⁰ MPIA Section 69(a).

United States Principal Register and the holder of the international registration will have the same rights and remedies as the owner of a registration on the Principal Register.⁶¹

In the alternative, the Office may refuse protection to that mark in that country on any of the grounds on which an application filed directly with that Office might be refused.⁶² In 2001, for all Offices of Origin, there were 45,754 total or partial refusals.⁶³ The Office must notify WIPO of its refusal or the potential for its refusal, if any, within a certain time after the national office was notified of the designation. At the end of that time limit, the holder of an international registration will know whether its mark is protected in a Contracting Party or whether the Contracting Party might refuse protection. The usual time limit under the Protocol is one year, but Contracting Parties may instead declare that their time limit is 18 months.

The Office need not make a final decision on the application within the 18-month time period. If it wants to retain the option to refuse the application after 18 months, it must send a *provisional refusal during that period* listing all possible grounds for refusal of that mark. The notification of provisional refusal must also give the holder of the international registration a reasonable time limit for filing a request for review or appeal to the provisional refusal or a response to the opposition. An Office may send more than one notification of refusal with additional grounds for refusal as long as all such notifications are sent within the applicable time limit. An Office may not base a final decision on refusal on a ground that was not mentioned in a notification of refusal sent during the time limit.

An Office of a Contracting Party that has opted for the 18-month time limit may also still choose to refuse protection after that period as long as it does two things before the 18 months are over: (1) informed the International Bureau that oppositions might be filed with respect to the international registration after the end of the 18-month period *and* (2) sent a notification of refusal, based on an opposition, no more than seven months after the beginning of the opposition period. If the time for filing

⁶¹ MPIA Section 69(b).

⁶² Article 5(2)(a) of the Madrid Protocol. See MPIA Section 68(a)(4) (“Extension of protection shall be refused to any mark not registrable on the Principal Register.”).

⁶³ WIPO Statistical Supplement for 2001, N. 5 *supra*.

19 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

oppositions is shorter than seven months, the Office must make a notification of refusal within one month after the end of the opposition period.⁶⁴

In the United States, publication of the international mark in the PTO's Official Gazette gives notice to third parties who may oppose the extension of protection, just as does publication of a mark that is the subject of a regular application with the PTO. A request for extension of protection to the United States will be subject to opposition at that point as would an ordinary U.S.-based trademark application.⁶⁵

If the mark is not registrable on the Principal Register in the U.S., it will not receive an extension of protection.⁶⁶ Either a refusal or notification of the possibility of refusal must be issued within 18 months after the USPTO is told of the designation, and if neither is issued, the USPTO will lose the right to refuse protection of the mark.⁶⁷ The USPTO may send to the International Bureau *no later* than 18 months after the request for extension of protection any of the following: (1) a notification of refusal based on an examination of the request for extension of protection; (2) a notification of refusal based on a filed opposition to the request; or (3) a notification of the possibility that an opposition to the request may be filed after the 18-month period.⁶⁸ If the USPTO sends a notification that an opposition could be filed after the 18-month period, it shall also send the International Bureau any notification of refusal based on the opposition within *seven months* after the opposition period begins or within *one month* after the end of the opposition period, whichever is earlier.⁶⁹

Note that a holder of an international registration may still not know if it has an extension of protection in the United States for several months *after* the 18-month period has expired. The opposition period begins upon publication of the mark in the USPTO's Official Gazette, but there is no

⁶⁴ Article 5(2)(c) of the Madrid Protocol.

⁶⁵ MPIA Section 68(a)(2).

⁶⁶ MPIA Section 68(a)(3).

⁶⁷ MPIA Section 68(c)(4).

⁶⁸ MPIA Section 68(c)(1). Under the Protocol, a notification of provisional refusal may be an *ex officio* provisional refusal based on grounds found by the Office, a provisional refusal based on an opposition, or both. Common Regulations, Rule 17(1).

⁶⁹ MPIA Section 68(c)(2).

requirement for when publication must take place. Thus, even though the U.S. must notify a holder of refusal either within seven months after the start of the opposition period or one month after the end of the opposition period, the opposition period itself could start, say, a year after the end of the 18-month refusal period. Thus, in that example, the holder would have to wait for a final refusal, if any, for the 18-month notification period plus a year (or possibly longer) plus 7 months after the start of the opposition period.

If a designated country has issued a refusal, the applicant may contest that refusal as if it had filed an application directly with that Office, and with the same rights and remedies.⁷⁰ If the refusal relates to only some of the goods and services listed in the international application, and the refusal is not contested, the mark will be registered for the remaining goods and services with no action on the applicant's part.

All proceedings after a refusal are between the holder of the international registration and the national Office of Origin. Upon receiving a provisional refusal from a designated Contracting Party, the holder of the international registration should hire a local representative familiar with the relevant law, practice and language. After the proceedings are over, the Office must notify the International Bureau whether it has confirmed or withdrawn its provisional refusal, which result will be recorded in the International Register and published in the Gazette.

[g] – Dependence on Basic Application or Basic Registration and “Central Attack”

For the first five years of its existence, the international registration depends completely on the status of the basic application or basic registration with the Office of Origin. If during that time the basic application is refused or withdrawn or the basic registration or the registration resulting from the basic application is canceled or has lapsed, the holder of the international registration may no longer invoke the protection of that registration.⁷¹ The defeat of an international registration

⁷⁰ Article 5(3) of the Madrid Protocol.

⁷¹ By statute, the USPTO must notify the International Bureau whenever a basic application or basic registration that is the basis for an international registration has been “restricted, abandoned, or canceled, or has expired, with respect to some or all of the

as to all designated Contracting Parties through invalidation of its basic application or registration is known as “central attack” (though such invalidation need not be the result of a third party “attack,” a Madrid Protocol misnomer). It applies no matter why the basic registration or application ceases to have effect, whether it is through cancellation by an Office of Origin or a court, or through voluntary withdrawal or non-renewal.

Similarly, if the basic registration is canceled after the five years as a result of an action that began *during* the five-year period, the international registration will likewise be canceled.⁷² If, for instance, an opposition is filed against the basic registration within the five-year period that results in rejection of the application *after* the five-year period, the international registration will be canceled upon rejection of the application. In addition, if an appeal of a refusal of the basic application taken before the five-year period is over results in a final rejection *after* the five-year period, then the international registration will be canceled. And where a request for withdrawal of the basic application or cancellation of the basic registration made before the five-year period is over results in cancellation or withdrawal *after* the five-year period, cancellation will result. Where the refusal or withdrawal of the basic application or the cancellation of the basic registration is for only some goods or services, the cancellation of the international registration will be only as to those goods or services. After the five-year period, the international registration continues independent of the basic application or registration if there was no adverse action taken during the five-year period that could still result in cancellation.

goods and services listed in the international registration” within five years after the date of the international registration. MPIA Section 63(1). In addition, if the International Bureau notifies the USPTO of the cancellation of an international registration with respect to some or all of the goods and services listed, the Director of the USPTO must cancel any extension of protection in the United States with respect to those goods and services. MPIA Section 70(a).

⁷² The USPTO must notify the International Bureau whenever a basic application or basic registration that is the basis for an international registration has been “restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration” over five years after the date of the international registration “if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.” MPIA Section 63(2).

All hope is not lost, however, if one's international registration is canceled during the first five years. The Madrid Protocol provides that the holder of an international registration that is canceled through a "central attack" may apply for registration of the same mark with all Offices of designated Contracting Parties where the international registration had effect and whose designation is governed by the Protocol, as long as such application is made *within three months after the international registration is canceled*.⁷³ The national applications that result from this procedure, known as "transformation," are given the date of the original international registration. Other than the extraordinary priority, these applications become ordinary national applications that must be filed with the Office of the Contracting Party directly. Note that transformation is not available where the holder has itself opted to cancel the registration.⁷⁴

For example, the holder of an international registration that is canceled by the International Bureau under Article 6(4) of the Protocol may file an application with the USPTO under either Section 1 or Section 44 of the Lanham Act to register the same mark for any of the canceled goods and services that were covered by an extension of protection in the United States based on that international registration.⁷⁵ Again, the application receives the priority date of the international registration or the request for extension of protection in the United States or Paris Convention priority, but *only* if the application is filed with the USPTO no more than three months after the international registration was canceled and *only* if the application meets all of the requirements of Sections 1 or 44.⁷⁶

WIPO notes that cancellation of an international registration due to the invalidation of the basic application or registration is relatively rare; only 190 such cancellations occurred in 2001 and many of those were only partial, applying to just some of the goods or services covered by the international registration.⁷⁷

The five-year potential cancellation period operates much like a typical statute of limitations. Potential opposers or cancellation petitioners have

⁷³ Article 9*quinquies* of the Madrid Protocol.

⁷⁴ WIPO Guide B.82.02, N. 2 *supra*.

⁷⁵ MPIA Section 70(c).

⁷⁶ MPIA Section 70(c).

⁷⁷ WIPO Guide B.77.07, N. 2 *supra*.

this limited period to assert and prosecute their claims, and if they do not they are barred. Coincidentally, there is a clear parallel under the Lanham Act with the five year “limitation” period of Section 14.⁷⁸ Under this provision, once a federal registration issues, after five years it is no longer vulnerable to a cancellation petition on grounds of prior use and likelihood of confusion. However, a registration is subject to cancellation “at any time” based on narrowly-drawn statutory grounds, such as the registered mark becoming a generic term or becoming abandoned, or where there is fraud in the procurement of the registration.⁷⁹

[h] – What Happens to an Existing National Registration?

Can an applicant designate a country in which it already has a registration for that mark for those goods and services? Yes. An international registration under the Madrid system replaces a national registration in a designated Contracting Party for the same mark and the same goods and services recorded by the same person.⁸⁰ This replacement may be advantageous because renewals under the international registration will be more convenient than renewing separate registrations. Such replacement would take place automatically, without review by the Office of Origin of the designated Contracting Party.

[i] – Fees

There is a “basic” fee of 653 Swiss francs (approximately \$470 U.S., as of February 2003) for filing the international application, or 903 Swiss francs (approximately \$655 U.S.) where the mark is in color. There is also a fee per designated country and per class for any class over three. Under the Protocol, Contracting Parties may choose to either follow the standard fee structure of the Madrid Agreement and set a fixed fee or set up their own “individual” fee system in which the national Office may charge the same fee for any extension of an international registration in its territory that it would have charged for a national ten-year registration. The standard fee structure includes a designation fee of 73 Swiss francs (approximately \$53 U.S.), called a “complementary” fee. A so-called

⁷⁸ 15 U.S.C. § 1064(1).

⁷⁹ 15 U.S.C. § 1064(3); see Gilson & LaLonde, 1 *Trademark Protection and Practice* § 4.03[1] for more on this provision.

⁸⁰ Article 4*bis*(1) of the Madrid Protocol.

“supplementary” fee of 73 Swiss francs for each class of goods and services over and above the third class is assessed, except where all of the designated countries collect an individual fee. In addition, the Office of Origin may charge a filing fee.⁸¹

The United States has chosen to levy an “individual” fee which will be the same amount as the current application or renewal fee charged by the USPTO to a domestic applicant or registrant.⁸² The USPTO is working on proposed implementing regulations, including its filing fees under the Madrid Protocol. It cannot charge more for Madrid applications than for applications filed directly with the USPTO.

Applicants or those holding an international registration may pay fees directly to the International Bureau or through the Office of Origin or the Office of the Contracting Party. For fees paid directly to the International Bureau, trademark owners may open an account with the Bureau and pay fees by debit to that account, or they may make a payment to the Bureau’s bank account or pay by banker’s check. WIPO suggests that an applicant, a holder of an international registration or a representative “having frequent dealings with the International Bureau . . . will find it useful to maintain a current account with the International Bureau.”⁸³

Fees for *renewal* include the basic fee, individual fees for each designated Contracting Party for which such a fee is owed, complementary fees for each designated Contracting Party for which no individual fee is owed, and a supplementary fee for each class of goods or services over three except where all of the designated Contracting Parties have an individual fee owed, in which case no supplementary fees are owed.⁸⁴

[j] – Searching

The applicant for an international registration should, at the very least, search WIPO’s international database. WIPO maintains the Madrid Express database online, which includes all international registrations

⁸¹ WIPO has a helpful fee calculator at www.wipo.int/madrid/feecalculator/FirstStep.

⁸² Senate Ratification of Madrid Protocol, 148 Cong. Rec. S10640 (Oct. 17, 2002) (Sec. 3(4) of Resolution of Ratification).

⁸³ WIPO Guide A.08.05, N. 2 *supra*.

⁸⁴ WIPO Guide B.73.01, N. 2 *supra*; Common Regulations, Rule 30(1).

under the Madrid system that are currently in force as well as those that expired within the past six months.⁸⁵

[k] – Post-Registration

[i] – Renewal

An international registration under the Madrid Protocol lasts for ten years and may be renewed every ten years by paying the required fee to WIPO.⁸⁶ The holder of the international registration may choose to renew the registration for less than all of the designated Contracting Parties.⁸⁷ It may renew the international registration up to six months after the date it expires, on payment of a surcharge of half of the basic fee owed if after the expiration date.⁸⁸ The International Bureau is supposed to send the holder of an international registration a reminder of the date the registration will expire, six months before that date.

If the holder does not renew its international registration, it lapses as of the date the previous period of registration expires. The International Bureau then notifies the Offices of the designated Contracting Parties and publishes a notification in the Gazette.

Where the holder of an international registration has succeeded in obtaining a certificate of extension of protection in the United States, at the time for renewal it must file an affidavit with the USPTO describing the goods or services listed in the extension of protection as to which the mark is in use in commerce, attaching a specimen or facsimile of the current use, or explaining that any nonuse is due to special circumstances.⁸⁹ To avoid cancellation, the affidavit and specimen plus any fee must be filed (1) within one year from the end of the six-year period after the date the USPTO issued the certificate of extension of protection and (2) within six months from the end of the ten-year period after issuance of the certificate

⁸⁵ See www.wipo.int/madrid/en/madrid_express.htm.

⁸⁶ Articles 6(1), 7(1) of the Madrid Protocol. The International Bureau's unofficial form for renewal is at www.wipo.int/madrid/en/forms/pdf/mm11.pdf (form MM11). See III.i *supra* for more on renewal fees.

⁸⁷ Common Regulations, Rule 30(2)(a).

⁸⁸ Article 7(4) of the Madrid Protocol.

⁸⁹ MPIA Section 71(b).

or within three months after the end of that ten-year period with the payment of a surcharge.⁹⁰ In addition, the affidavit and fee must be filed before the close of every subsequent ten-year period.

[ii] – Subsequent Designations

The holder of an international registration may at any time file a designation to extend protection of its mark to an additional Contracting Party not named in its original international application, known as a “subsequent designation.”⁹¹ It may do so not only if it did not designate that Contracting Party in its original international application, but also if a Contracting Party refused protection of the mark and the holder believes the grounds for refusal are no longer valid. In addition, the holder may designate a Contracting Party that became a party to the Madrid system after the holder filed its original international application. A subsequent designation may be made either for all or for only part of the goods and services in the international registration, and there may be several subsequent designations for one Contracting Party with different goods and services referenced in each.⁹² The International Bureau will publish the subsequent designation in the Gazette. In 2001, there were 6,432 subsequent designations under the Madrid System.⁹³

Protection under the subsequent designation is up for renewal on the same date as the international registration regardless of when the later designations were recorded.⁹⁴ For example, if the holder of an international registration makes a subsequent designation nine years after the original international registration, it must be renewed one year later, along with the original international registration. Refusal of protection for a subsequent designation follows the same procedures as for refusal of the original international registration.⁹⁵ The holder of an international registration based on a U.S. application or registration may make a

⁹⁰ MPIA Section 71(a).

⁹¹ For the form to make a subsequent designation, see www.wipo.int/madrid/en/forms/pdf/mm4.pdf (form MM4).

⁹² WIPO Guide B.38.03, N. 2 *supra*.

⁹³ WIPO Statistical Supplement for 2001, N. 5 *supra*.

⁹⁴ Common Regulations, Rule 31(2).

⁹⁵ Common Regulations, Rule 24(8).

subsequent designation by filing a request of extension of protection either with the International Bureau of WIPO or with the USPTO.⁹⁶

[iii] – Assignment

One significant limitation on an international registration is that the holder of that registration can only assign it to a national or domiciliary of a Contracting Party or a country that is a member of an intergovernmental organization that is a Contracting Party, or to a person with “a bona fide and effective industrial or commercial establishment” in such a country.⁹⁷ In other words, the assignee must be one who would be entitled to file an international application on its own at the time of assignment. The holder of an international registration may choose to assign some or all of its goods or services and may assign as to one or all of its designated Contracting Parties.⁹⁸ The assignment of marks that are the subject of an international registration is accomplished through the filing of documents with WIPO.

Where the international application is invalidated by a “central attack,” any resulting national applications may be transferred to any party, even where that party would not qualify to hold an international registration under the Madrid System.⁹⁹ In the United States, the owner of a registration with the USPTO may assign that registration freely, even if it serves as a basic registration.

[iv] – Limitation, Renunciation or Cancellation

The holder of an international registration may (1) limit its list of goods and services as to some or all designated Contracting Parties,¹⁰⁰ (2) renounce protection as to some, but not all, of the designated Contracting Parties as to all of its listed goods and services,¹⁰¹ or (3) cancel its

⁹⁶ MPIA Section 64.

⁹⁷ Article 9 of the Madrid Protocol; MPIA Section 72.

⁹⁸ WIPO Guide B.59.02, N. 2 *supra*.

⁹⁹ WIPO Guide B.77.05, N. 2 *supra*.

¹⁰⁰ For the form for recording a limitation of the list of goods and services, see www.wipo.int/madrid/en/forms/pdf/mm6.pdf (form MM6).

¹⁰¹ For the form for recording a renunciation of protection, see www.wipo.int/madrid/en/forms/pdf/mm7.pdf (form MM7).

international registration as to all of the designated Contracting Parties for some or all of its listed goods and services.¹⁰² Goods and services that are the subject of limitations or renunciations may be recovered by a subsequent designation upon payment of the required fees. After cancellation of an international registration, however, the registration is removed from the International Register and the former holder of the registration may not make a subsequent designation to revive it.

[v] – Amendment

A mark that is recorded in the International Register *may not be amended* at any time. Even if the mark sought to be used differs just slightly from that in the international registration and even if the mark was amended in the basic application or basic registration, the holder of the international registration will likely have to file a new international application for a new mark.

A holder also may not extend the list of goods or services on its international registration. If it wishes to extend protection beyond those goods or services, it must file a new international application as to those additional goods or services.

[vi] – Licenses

Licenses of international marks may be recorded in the International Register. Thus, the holder of an international registration need not record a license in the Office of each Contracting Party where one has been granted. The holder may file its request to record the license with the International Bureau, with the Office of its own Contracting Party, or with the Office of a Contracting Party where the license is granted.¹⁰³

¹⁰² For the form to request the cancellation of an international registration, see www.wipo.int/madrid/en/forms/pdf/mm8.pdf (form MM8).

¹⁰³ For the official form for recording a license, see www.wipo.int/madrid/en/forms/pdf/mm13.pdf (form MM13).

[vii] – Change of Name or Address of Holder or Its Representative

The holder may change its name or address or the name or address of its representative on its international registration using an official form from the International Bureau. It may file this form either with the Bureau or with its Office of Origin.¹⁰⁴

IV Advantages and Disadvantages

In general, the advent of the Madrid Protocol in the United States is a positive development for U.S.-based trademark owners. It is an easier, cheaper and more efficient way to obtain trademark registrations in other countries than having to file multiple separate national applications. Members of the United States Congress touted the Protocol as helping small businesses in the U.S., in particular, allowing them to remain competitive in the international marketplace without having to spend time and money filing separate trademark registrations around the globe.¹⁰⁵

Filing under the Madrid Protocol has several advantages. After filing an application in or obtaining a registration from an Office of Origin, the mark owner need only file a single application in one language and pay fees in one currency to one office. Similarly, the registration may be renewed every ten years in a single transaction. Because applicants can file one application in a single language, translation expenses and other costs for preparing an application are reduced. Applicants pay a single fee based on the number of countries they seek to cover by the registration, lower than the fees to file separate applications. They have one registration number with one renewal date and can change their address or

¹⁰⁴ For the form to change the holder's name or address, see www.wipo.int/madrid/en/forms/pdf/mm9.pdf (form MM9), and for the form to change the representative's name or address, see www.wipo.int/madrid/en/forms/pdf/mm10.pdf (form MM10).

¹⁰⁵ *E.g.*, 147 Cong. Rec. H892 (March 14, 2001) (statement of Rep. Coble) (Becoming a member of the Madrid system "is especially important to our small businesses which may only be able to afford worldwide protection for their marks through a low-cost international registration system."); 147 Cong. Rec. H892 (March 14, 2001) (Statement of Rep. Berman) (U.S. membership in the Protocol "is especially critical to small businesses that may otherwise lack the resources to acquire worldwide protection for their trademark.").

representative or record an assignment with one form rather than filing in each national trademark office. The need for local agents in each country is also reduced, saving on legal fees, though applicants may consider having local foreign counsel conduct searches for the marks and, if the Office of Origin of a designated Contracting Party issues a notification of refusal, the applicant at that point will need to hire local foreign counsel to pursue registration in that country. The holder of an international registration does not need to wait indefinitely to find out if its mark will be registered in the Contracting Parties it designated, but knows that if there is no refusal or notification of refusal within the applicable time limit, the mark is protected.

Trademark owners outside the United States who are eligible to file under the Madrid system will also benefit because they can extend protection to the United States through their existing international registrations. Finally, the international registration system is already in place and has been working for several years.

Despite the major advantages of convenience and reduced cost and having solved many of the problems with the Madrid Agreement, there are potential drawbacks of filing under the Madrid Protocol. The Protocol procedures may make it too easy to apply for trademark protection in other countries without knowing local standards or searching local marks. Thus, applicants may lose the benefit of input from informed local counsel early on in the process, making it more difficult to address potential problems later.

Another concern for those using an application or registration in the United States as the basis for a Madrid Protocol registration is the dependency on U.S. registration. Because the USPTO requires a narrow description of goods or services, the scope of coverage for the international registration will also be limited where the international registration is based on a U.S. application or registration. Filing applications directly in other countries could thus result in broader protection than filing based on a U.S. application or registration.

Similarly, some critics warn that the Protocol may flood the USPTO with foreign applications, allowing foreign applicants to make broad claims of coverage where United States companies are limited to the goods and services actually used. However, while foreign applicants may be able

31 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

to make broad *claims*, the USPTO examiners should screen those claims and winnow down the goods and services to those actually in use in the United States. As an additional check, the required affidavit of use under Section 71 should narrow the goods and services to those actually in use.¹⁰⁶ However, the USPTO examiners face a substantial burden in processing the new inbound applications.

In addition, a large volume of inbound applications would require trademark practitioners' close scrutiny of publication of the marks in the USPTO's Official Gazette. Trademark maintenance may become more costly under the Protocol if mark owners must file a greater number of oppositions. Nevertheless, vigilant trademark owners will be able to oppose based on any grounds currently available to them to attack applications filed directly with the USPTO.¹⁰⁷

International registrations may not be amended after registration, so applicants aware that they may later want to make minor changes to their registrations would be better off filing individual national registrations in countries allowing post-registration amendments.

Holders of international registrations can only assign those registrations to a national or domiciliary of a Contracting Party or a country that is a member of an intergovernmental organization that is a Contracting Party or to a person with "a bona fide and effective industrial or commercial establishment" in such a country. This restriction currently excludes, for example, Canada and most of the Latin American countries, none of which is a member of the Protocol.

¹⁰⁶ MPIA Section 71.

¹⁰⁷ For a discussion of those grounds, see Gilson & LaLonde, 3 *Trademark Protection and Practice* § 9.03[2].

V Conclusion

The Madrid Protocol will bring a new era of international trademark protection opportunities for American businesses, as well as for foreign businesses designating the United States for coverage. Business globalization will be spurred through multinational trademark use and protection, and the USPTO will learn whether predictions of the volume of inbound Protocol applications domestically and internationally have been accurate or not. The Madrid Protocol Giant will be around for many, many years to come, awake and, one hopes, gentle.

APPENDIX A

*PROVISIONS TO IMPLEMENT IN THE UNITED STATES THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS***

To be added after 15 U.S.C. § 1129

DEFINITIONS

Section 60. In this title:

- (1) Basic application. — The term ‘basic application’ means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.
- (2) Basic registration. — The term ‘basic registration’ means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.
- (3) Contracting party. — The term ‘Contracting Party’ means any country or inter-governmental organization that is a party to the Madrid Protocol.
- (4) Date of recordal. — The term ‘date of recordal’ means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.
- (5) Declaration of bona fide intention to use the mark in commerce. — The term ‘declaration of bona fide intention to use the mark in commerce’ means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of

** These sections are not yet in force in the United States. For a discussion of their effective date, see I.a *supra*.

protection of a mark to the United States and that contains a statement that —

- (A) the applicant or holder has a bona fide intention to use the mark in commerce;
 - (B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and
 - (C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.
- (6) Extension of protection. — The term ‘extension of protection’ means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.
- (7) Holder of an international registration. — A ‘holder’ of an international registration is the natural or juristic person in whose name the international registration is recorded on the International Register.
- (8) International application. — The term ‘international application’ means an application for international registration that is filed under the Madrid Protocol.
- (9) International bureau. — The term ‘International Bureau’ means the International Bureau of the World Intellectual Property Organization.
- (10) International register. — The term ‘International Register’ means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

35 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

- (11) International registration. — The term ‘international registration’ means the registration of a mark granted under the Madrid Protocol.
- (12) International registration date. — The term ‘international registration date’ means the date assigned to the international registration by the International Bureau.
- (13) Madrid protocol. — The term ‘Madrid Protocol’ means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.
- (14) Notification of refusal. — The term ‘notification of refusal’ means the notice sent by the United States Patent and Trademark Office to the International Bureau declaring that an extension of protection cannot be granted.
- (15) Office of a contracting party. — The term ‘Office of a Contracting Party’ means —
 - (A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks; or
 - (B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.
- (16) Office of origin. — The term ‘office of origin’ means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.
- (17) Opposition period. — The term ‘opposition period’ means the time allowed for filing an opposition in the United States Patent and Trademark Office, including any extension of time granted under section 13.

INTERNATIONAL APPLICATIONS BASED ON UNITED STATES APPLICATIONS OR REGISTRATIONS

Section 61.

- (a) In General. — The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.
- (b) Qualified Owners. — A qualified owner, under subsection (a), shall —
- (1) be a national of the United States;
 - (2) be domiciled in the United States; or
 - (3) have a real and effective industrial or commercial establishment in the United States.

CERTIFICATION OF THE INTERNATIONAL APPLICATION

Section 62.

- (a) Certification Procedure. — Upon the filing of an application for international registration and payment of the prescribed fees, the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification.
- (b) Transmittal. — Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.

**RESTRICTION, ABANDONMENT, CANCELLATION, OR
EXPIRATION OF A BASIC APPLICATION OR
BASIC REGISTRATION**

Section 63.

With respect to an international application transmitted to the International Bureau under section 62, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration —

- (1) within 5 years after the international registration date; or
- (2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.

**REQUEST FOR EXTENSION OF PROTECTION SUBSEQUENT
TO INTERNATIONAL REGISTRATION**

Section 64.

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request —

- (1) directly with the International Bureau; or
- (2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Director.

**EXTENSION OF PROTECTION OF AN INTERNATIONAL
REGISTRATION TO THE UNITED STATES UNDER
THE MADRID PROTOCOL**

Section 65.

- (a) In General. — Subject to the provisions of section 68, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.
- (b) If the United States Is Office of Origin. — Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.

**EFFECT OF FILING A REQUEST FOR EXTENSION OF
PROTECTION OF AN INTERNATIONAL REGISTRATION
TO THE UNITED STATES**

Section 66.

- (a) Requirement for Request for Extension of Protection. — A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant for, or holder of, the international registration.
- (b) Effect of Proper Filing. — Unless extension of protection is refused under section 68, the proper filing of the request for extension of protection under subsection (a) shall constitute constructive use of the

39 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

mark, conferring the same rights as those specified in section 7(c), as of the earliest of the following:

- (1) The international registration date, if the request for extension of protection was filed in the international application.
- (2) The date of recordal of the request for extension of protection, if the request for extension of protection was made after the international registration date.
- (3) The date of priority claimed pursuant to section 67.

**RIGHT OF PRIORITY FOR REQUEST FOR EXTENSION OF
PROTECTION TO THE UNITED STATES**

Section 67.

The holder of an international registration with a request for an extension of protection to the United States shall be entitled to claim a date of priority based on a right of priority within the meaning of Article 4 of the Paris Convention for the Protection of Industrial Property if —

- (1) the request for extension of protection contains a claim of priority; and
- (2) the date of international registration or the date of the recordal of the request for extension of protection to the United States is not later than 6 months after the date of the first regular national filing (within the meaning of Article 4(A)(3) of the Paris Convention for the Protection of Industrial Property) or a subsequent application (within the meaning of Article 4(C)(4) of the Paris Convention for the Protection of Industrial Property).

**EXAMINATION OF AND OPPOSITION TO REQUEST FOR
EXTENSION OF PROTECTION; NOTIFICATION OF REFUSAL**

Section 68.

- (a) Examination and Opposition. —
- (1) A request for extension of protection described in section 66(a) shall be examined as an application for registration on the Principal Register under this Act, and if on such examination it appears that the applicant is entitled to extension of protection under this title, the Director shall cause the mark to be published in the Official Gazette of the United States Patent and Trademark Office.
 - (2) Subject to the provisions of subsection (c), a request for extension of protection under this title shall be subject to opposition under section 13.
 - (3) Extension of protection shall not be refused on the ground that the mark has not been used in commerce.
 - (4) Extension of protection shall be refused to any mark not registrable on the Principal Register.
- (b) Notification of Refusal. — If, a request for extension of protection is refused under subsection (a), the Director shall declare in a notification of refusal (as provided in subsection (c)) that the extension of protection cannot be granted, together with a statement of all grounds on which the refusal was based.
- (c) Notice to International Bureau. —
- (1) Within 18 months after the date on which the International Bureau transmits to the Patent and Trademark Office a notification of a request for extension of protection, the Director shall transmit to the International Bureau any of the following that applies to such request:

41 THE MADRID PROTOCOL: A SLUMBERING GIANT AWAKENS AT LAST

- (A) A notification of refusal based on an examination of the request for extension of protection.
 - (B) A notification of refusal based on the filing of an opposition to the request.
 - (C) A notification of the possibility that an opposition to the request may be filed after the end of that 18-month period.
- (2) If the Director has sent a notification of the possibility of opposition under paragraph (1)(C), the Director shall, if applicable, transmit to the International Bureau a notification of refusal on the basis of the opposition, together with a statement of all the grounds for the opposition, within 7 months after the beginning of the opposition period or within 1 month after the end of the opposition period, whichever is earlier.
- (3) If a notification of refusal of a request for extension of protection is transmitted under paragraph (1) or (2), no grounds for refusal of such request other than those set forth in such notification may be transmitted to the International Bureau by the Director after the expiration of the time periods set forth in paragraph (1) or (2), as the case may be.
- (4) If a notification specified in paragraph (1) or (2) is not sent to the International Bureau within the time period set forth in such paragraph, with respect to a request for extension of protection, the request for extension of protection shall not be refused and the Director shall issue a certificate of extension of protection pursuant to the request.
- (d) Designation of Agent for Service of Process. — In responding to a notification of refusal with respect to a mark, the holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation filed. If the person

designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

EFFECT OF EXTENSION OF PROTECTION

Section 69.

- (a) Issuance of Extension of Protection. — Unless a request for extension of protection is refused under section 68, the Director shall issue a certificate of extension of protection pursuant to the request and shall cause notice of such certificate of extension of protection to be published in the Official Gazette of the United States Patent and Trademark Office.
- (b) Effect of Extension of Protection. — From the date on which a certificate of extension of protection is issued under subsection (a) —
 - (1) such extension of protection shall have the same effect and validity as a registration on the Principal Register; and
 - (2) the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register.

**DEPENDENCE OF EXTENSION OF PROTECTION TO
THE UNITED STATES ON THE UNDERLYING
INTERNATIONAL REGISTRATION**

Section 70.

- (a) Effect of Cancellation of International Registration. — If the International Bureau notifies the United States Patent and Trademark Office of the cancellation of an international registration with respect to some or all of the goods and services listed in the international registration, the Director shall cancel any extension of protection to the United States with respect to such goods and services as of the date on which the international registration was canceled.

- (b) Effect of Failure To Renew International Registration. — If the International Bureau does not renew an international registration, the corresponding extension of protection to the United States shall cease to be valid as of the date of the expiration of the international registration.

- (c) Transformation of an Extension of Protection Into a United States Application. — The holder of an international registration canceled in whole or in part by the International Bureau at the request of the office of origin, under article 6(4) of the Madrid Protocol, may file an application, under section 1 or 44 of this Act, for the registration of the same mark for any of the goods and services to which the cancellation applies that were covered by an extension of protection to the United States based on that international registration. Such an application shall be treated as if it had been filed on the international registration date or the date of recordal of the request for extension of protection with the International Bureau, whichever date applies, and, if the extension of protection enjoyed priority under section 67 of this title, shall enjoy the same priority. Such an application shall be entitled to the benefits conferred by this subsection only if the application is filed not later than 3 months after the date on which the international registration was canceled, in whole or in part, and only if the application complies with all the requirements of this Act which apply to any application filed pursuant to section 1 or 44.

AFFIDAVITS AND FEES**Section 71.**

- (a) Required Affidavits and Fees. — An extension of protection for which a certificate of extension of protection has been issued under section 69 shall remain in force for the term of the international registration upon which it is based, except that the extension of protection of any mark shall be canceled by the Director —
- (1) at the end of the 6-year period beginning on the date on which the certificate of extension of protection was issued by the Director, unless within the 1-year period preceding the expiration of that 6-year period the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with a fee prescribed by the Director; and
 - (2) at the end of the 10-year period beginning on the date on which the certificate of extension of protection was issued by the Director, and at the end of each 10-year period thereafter, unless —
 - (A) within the 6-month period preceding the expiration of such 10-year period the holder of the international registration files in the United States Patent and Trademark Office an affidavit under subsection (b) together with a fee prescribed by the Director; or
 - (B) within 3 months after the expiration of such 10-year period, the holder of the international registration files in the Patent and Trademark Office an affidavit under subsection (b) together with the fee described in subparagraph (A) and the surcharge prescribed by the Director.
- (b) Contents of Affidavit. — The affidavit referred to in subsection (a) shall set forth those goods or services recited in the extension of protection on or in connection with which the mark is in use in commerce and the holder of the international registration shall attach

to the affidavit a specimen or facsimile showing the current use of the mark in commerce, or shall set forth that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of extension of protection.

- (c) Notification. — The Director shall notify the holder of the international registration who files 1 of the affidavits of the Director's acceptance or refusal thereof and, in case of a refusal, the reasons therefor.
- (d) Service of Notice or Process. — The holder of the international registration of the mark may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person residing in the United States on whom notices or process in proceedings affecting the mark may be served. Such notices or process may be served upon the person so designated by leaving with that person, or mailing to that person, a copy thereof at the address specified in the last designation so filed. If the person designated cannot be found at the address given in the last designation, or if the holder does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person residing in the United States for service of notices or process in proceedings affecting the mark, the notice or process may be served on the Director.

ASSIGNMENT OF AN EXTENSION OF PROTECTION

Section 72.

An extension of protection may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in, or has a bona fide and effective industrial or commercial establishment either in a country that is a Contracting Party or in a country that is a member of an intergovernmental organization that is a Contracting Party.

INCONTESTABILITY

Section 73.

The period of continuous use prescribed under section 15 for a mark covered by an extension of protection issued under this title may begin no earlier than the date on which the Director issues the certificate of the extension of protection under section 69, except as provided in section 74.

RIGHTS OF EXTENSION OF PROTECTION

Section 74.

When a United States registration and a subsequently issued certificate of extension of protection to the United States are owned by the same person, identify the same mark, and list the same goods or services, the extension of protection shall have the same rights that accrued to the registration prior to issuance of the certificate of extension of protection.

APPENDIX B

Official Form for Application for International Registration Governed
Exclusively
by the Madrid Protocol

MM2(E)

APPLICATION FOR INTERNATIONAL REGISTRATION
GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

For use by the applicant: this international application contains, in addition to the application form, the following number of sheets:	For use by the applicant/Office of origin Applicant's reference: Office's reference:	For use by the International Bureau: Total additional sheets received:
--	--	---

1 CONTRACTING PARTY WHOSE OFFICE IS THE OFFICE OF ORIGIN:

2 APPLICANT Identification code
(where supplied by WIPO):

(a) Name:

(b) Address:

(c) Address for correspondence:

(d) Telephone: Fax:
E-mail address:

(e) Preferred language for correspondence: English French

(f) Other indications (as may be required by certain designated Contracting Parties)

(i) if the applicant is a natural person, nationality of applicant:

(ii) if the applicant is a legal entity:

- legal nature of the legal entity:
- State and, where applicable, territorial unit within that State, under the law of which the legal entity is organized:

3 ENTITLEMENT TO FILE

(a) Indicate in the appropriate box(es):

- (i) where the Contracting Party mentioned in item 1 is a State, that the applicant is a national of that State; or
- (ii) where the Contracting Party mentioned in item 1 is an organization, the name of the State of which the applicant is a national; or
- (iii) whether the applicant is domiciled in the territory of the Contracting Party mentioned in item 1; or
- (iv) whether the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party mentioned in item 1.

(b) Where the address of the applicant, given in item 2(b), is not in the territory of the Contracting Party mentioned in item 1, indicate in the space provided below:

- (i) if the box in paragraph (a)(iii) of the present item has been checked, the domicile of the applicant in the territory of that Contracting Party, or,
- (ii) if the box in paragraph (a)(iv) of the present item has been checked, the address of the applicant's industrial or commercial establishment in the territory of that Contracting Party.

.....
.....

MM2(E) – VIII.02

4 REPRESENTATIVE (if any) Identification code
(where supplied by WIPO):

Name:

Address:

Telephone: Fax: E-mail address:

5 BASIC APPLICATION OR BASIC REGISTRATION

Basic application number: Basic application date: (dd/mm/yyyy)

Basic registration number: Basic registration date: (dd/mm/yyyy)

6 PRIORITY CLAIMED

The applicant claims the priority of the earlier filing mentioned below.

Office of earlier filing:

Number of earlier filing (if available):

Date of earlier filing: (dd/mm/yyyy)

If the earlier filing does not relate to all the goods and services listed in item 10 of this form, indicate in the space provided below the goods and services to which it does relate.

.....

.....

7 THE MARK

(a) Place the reproduction of the mark, as it appears in the basic application or basic registration, in the square below.

(b) Where the reproduction in item (a) is in black and white and color is claimed in item 8 of this form, place a color reproduction of the mark in the square below.

(c) The applicant declares that he wishes the mark to be considered as a mark in standard characters.

Where the Office of origin has addressed this form by telefacsimile, the present space must be completed before addressing the original of this page to the International Bureau.

Number of basic application or registration or Office reference as shown on the first page of this form:

.....

Signature by the Office of origin:

8

COLOR(S) CLAIMED

- (a) The applicant claims color as a distinctive feature of the mark.
Color or combination of colors claimed:
- (b) Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties):
.....
- (c) The mark consists of a color or a combination of colors as such.

9

MISCELLANEOUS INDICATIONS

- (a) Transliteration of the mark (where applicable):
- (b) Translation of the mark (as may be required by certain designated Contracting Parties)
 - (i) into English:
 - (ii) into French:
- (c) If the words contained in the mark have no meaning (and therefore cannot be translated), check the box.
- (d) Where applicable, check the relevant box or boxes below:
 Three-dimensional mark Sound mark Collective mark, certification mark, or guarantee mark
- (e) Description of the mark (where a description is contained in the basic application or the basic registration):
.....
- (f) Verbal elements of the mark:
.....
- (g) The applicant declares that he wishes to disclaim protection for the following element(s) of the mark:
.....

MM2(E) – VIII.02

11 DESIGNATED CONTRACTING PARTIES
 Check the corresponding boxes to designate Contracting Parties

<input type="checkbox"/> AG Antigua and Barbuda	<input type="checkbox"/> GE Georgia	<input type="checkbox"/> MN Mongolia
<input type="checkbox"/> AM Armenia	<input type="checkbox"/> GR Greece	<input type="checkbox"/> MZ Mozambique
<input type="checkbox"/> AT Austria	<input type="checkbox"/> HU Hungary	<input type="checkbox"/> NO Norway
<input type="checkbox"/> AU Australia	<input type="checkbox"/> IE Ireland*	<input type="checkbox"/> PL Poland
<input type="checkbox"/> BG Bulgaria	<input type="checkbox"/> IS Iceland	<input type="checkbox"/> PT Portugal
<input type="checkbox"/> BT Bhutan	<input type="checkbox"/> IT Italy	<input type="checkbox"/> RO Romania
<input type="checkbox"/> BX Benelux	<input type="checkbox"/> JP Japan	<input type="checkbox"/> RU Russian Federation
<input type="checkbox"/> BY Belarus	<input type="checkbox"/> KE Kenya	<input type="checkbox"/> SE Sweden
<input type="checkbox"/> CH Switzerland	<input type="checkbox"/> KP Democratic People's Republic of Korea	<input type="checkbox"/> SG Singapore*
<input type="checkbox"/> CN China	<input type="checkbox"/> LI Liechtenstein	<input type="checkbox"/> SI Slovenia
<input type="checkbox"/> CU Cuba	<input type="checkbox"/> LS Lesotho	<input type="checkbox"/> SK Slovakia
<input type="checkbox"/> CZ Czech Republic	<input type="checkbox"/> LT Lithuania	<input type="checkbox"/> SL Sierra Leone
<input type="checkbox"/> DE Germany	<input type="checkbox"/> LV Latvia	<input type="checkbox"/> SZ Swaziland
<input type="checkbox"/> DK Denmark	<input type="checkbox"/> MA Morocco	<input type="checkbox"/> TM Turkmenistan
<input type="checkbox"/> EE Estonia	<input type="checkbox"/> MC Monaco	<input type="checkbox"/> TR Turkey
<input type="checkbox"/> ES Spain	<input type="checkbox"/> MD Republic of Moldova	<input type="checkbox"/> UA Ukraine
<input type="checkbox"/> FI Finland	<input type="checkbox"/> MK The former Yugoslav Rep. of Macedonia	<input type="checkbox"/> YU Yugoslavia
<input type="checkbox"/> FR France		<input type="checkbox"/> ZM Zambia
<input type="checkbox"/> GB United Kingdom*		

Others: _____

* By designating Ireland, Singapore or the United Kingdom, the applicant declares that he has the intention that the mark will be used by him or with his consent in that country in connection with the goods and services identified in this application.

12 SIGNATURE BY THE APPLICANT OR HIS REPRESENTATIVE
 (If required or allowed by the Office of origin)
 _____ (dd/mm/yyyy)

13 CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

(a) Certification

The Office of origin certifies

(i) that the request to present this application was received on _____ (dd/mm/yyyy).

(ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be, that any indication given in item 8(c), 9(d) or 9(e) appears also in the basic application or the basic registration, as the case may be, that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be, that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 without having being claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Office's signature: _____

Date of signature: _____ (dd/mm/yyyy)

FEE CALCULATION SHEET

(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT

The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).

Holder of the account: Account number:

Identity of the party giving the instructions:

(b) AMOUNT OF FEES; METHOD OF PAYMENT

Basic fee (653 Swiss francs if the reproduction of the mark is in black and white only; 903 Swiss francs if there is a reproduction in color)

Complementary and supplementary fees:

Number of designations for which complementary fee is applicable	x	Complementary fee	=	Total amount of the complementary fees	=>
.....		73 Swiss francs	

Number of classes of goods and services beyond three	x	Supplementary fee	=	Total amount of the supplementary fees	=>
.....		73 Swiss francs	

Individual fees (Swiss francs):

Designated Contracting Parties	Individual fee	Designated Contracting Parties	Individual fee
.....
.....
.....
.....
.....

Total individual fee =>

Grand total

Identity of the party effecting the payment:

Debit from a current account with WIPO	<input type="checkbox"/>	Holder of the account	Account number
Payment received and acknowledged by WIPO	<input type="checkbox"/>	WIPO receipt number
Payment made by banker's check (attached)	<input type="checkbox"/>	Check identification	dd/mm/yyyy
Payment made by banker's check (sent separately)	<input type="checkbox"/>	Check identification	dd/mm/yyyy
Payment made to WIPO bank account Crédit Suisse, CH-1211 Geneva 70 Swift: CRESCH ZZ12A, N° CH35 0425 1048 7080 8100 0	<input type="checkbox"/>	Payment identification	dd/mm/yyyy
Payment made to WIPO Postal check account N° 12-5000-8, Geneva	<input type="checkbox"/>	Payment identification	dd/mm/yyyy

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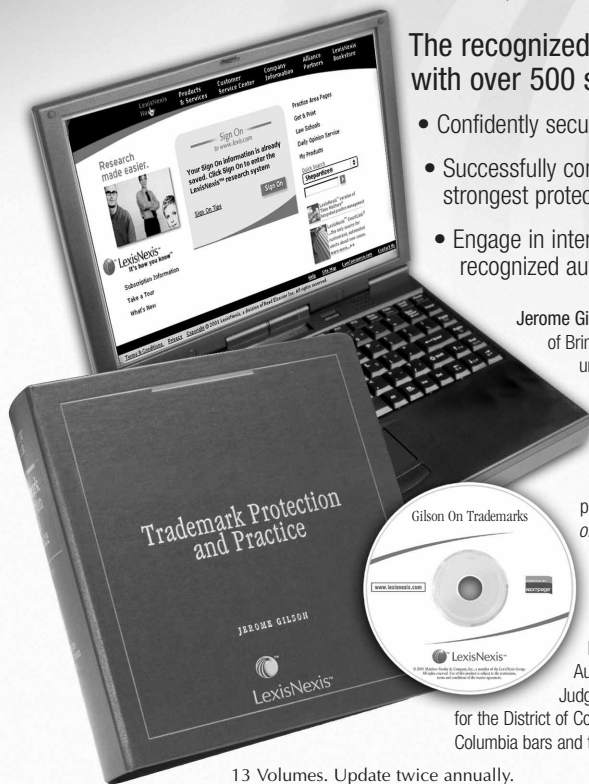
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Jerome Gilson is a partner with the Chicago intellectual property law firm of Brinks Hofer Gilson & Lione. He has specialized in trademark and unfair competition law for more than 40 years and is admitted to practice before the United States Supreme Court and seven United States Courts of Appeal. In 1998 he was voted Number One Trademark Practitioner Worldwide by his peers, as reported in *Euromoney's Managing Intellectual Property*, and in 2000 he was selected by his peers to be included in the 2000-2002 edition of *Best Lawyers of America*. In 2001 he was presented with the International Trademark Association's President's Award for dedicated and distinguished service.

Anne Gilson LaLonde graduated from the University of Michigan Law School, practiced for two years at Sidley & Austin in Washington, D.C., and completed a clerkship for Chief Judge Norma Holloway Johnson of the United States District Court for the District of Columbia. She is a member of the Illinois and District of Columbia bars and the bar of the United States Supreme Court.

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