

Trademarks

OCTOBER 2003

The “New” International Trademark Registration - Simplifying International Trademark Protection for U.S. Trademark Owners

Beginning November 2, 2003, trademark owners in the United States will be able to file for and obtain a single international registration for each trademark that can cover up to 58 other countries through a centralized system, instead of having to file a separate trademark application and to maintain a separate registration in each foreign country. These international registrations will be able to claim a filing date based on U.S. applications filed up to six months earlier, or as early as May 2, 2003. Therefore, it is timely to consider whether an international registration would be the best protection for your trademark.

The current process for registering marks in foreign countries is cumbersome and expensive. Presently, a U.S. trademark owner must hire separate trademark counsel in each country, file a separate trademark application in each country, and deal with translations, certified copies of documents, and other specific requirements of each country. The new international application promises to simplify the process and often will reduce the cost of registering marks around the world, because only one application needs to be prepared and filed, one set of fees needs to be paid, and often no foreign trademark counsel will be necessary.

International registrations have been available since 1892 to citizens of many other countries under a

treaty called the Madrid Agreement. The United States has now joined a 1989 treaty called the Madrid Protocol that modified the Madrid Agreement, and on November 2, 2002, President Bush signed into law the Madrid Protocol Implementation Act, which adopted the international registration system for the U.S.

The international registration system may not be the complete answer to all of a trademark owner's international needs, but it certainly will be a valuable tool that should be considered as an option in this regard. In this Trademark Update, we (1) discuss some of the potential benefits of using the international registration system; (2) explain the expected international application procedure; and (3) identify some of the expected costs associated with the international registration system.

A. BENEFITS OF THE INTERNATIONAL APPLICATION

1. Simpler and Cheaper Single Application

Under the Madrid Protocol, the owner of a U.S. trademark application or registration will be able to file one international application in one language and can choose to have that application “extended” geographically to up to 58 foreign countries. The international application eliminates the need to

MADRID PROTOCOL MEMBER COUNTRIES*

Albania	Greece	Republic of Korea
Antigua and Barbuda	Hungary	Republic of Moldova
Armenia	Iceland	Romania
Australia	Ireland	Russian Federation
Austria	Italy	Serbia and Montenegro
Belarus	Japan	Sierra Leone
Belgium	Kenya	Singapore
Bhutan	Latvia	Slovakia
Bulgaria	Lesotho	Slovenia
China	Liechtenstein	Spain
Cuba	Lithuania	Swaziland
Czech Republic	Luxembourg	Sweden
Democratic People's Republic of Korea	Monaco	Switzerland
Denmark	Mongolia	The former Yugoslav Republic of Macedonia
Estonia	Morocco	Turkey
Finland	Mozambique	Turkmenistan
France	Netherlands	Ukraine
Georgia	Norway	United Kingdom
Germany	Poland	Viet Nam
	Portugal	

* As of 10/08/03. In November 2003, Cyprus and the United States will be added to this list. Iran will be added in December 2003. Unofficial reports indicate that the European Union may join the Madrid Protocol in the near future. Source: World Intellectual Property Organization website, www.wipo.int/madrid/en.

prepare and file multiple applications and to hire trademark lawyers in each separate country to file applications. Because there is only one application, only one set of official and attorney's fees will be required to file in multiple countries.

2. *Simpler and Cheaper Single Registration Maintenance*

If the international application is successful, it will result in one international registration with one registration number and one renewal date covering every country to which the application was successfully extended. The registration can later be extended to provide protection in any of the countries not previously chosen. Modifications to the international registration such as amendments, changes of address, assignments, or renewals can be filed in a central location, and the necessity for multiple amendments is avoided.

3. *Faster Access to National Protection*

A request to extend either an international application or an international registration to a particular country must be examined and acted upon by that country within eighteen months or it automatically receives protection as if it were registered in that country on the date the extension was requested. This is a much shorter time frame than many countries provide for foreign applications filed directly with their national office.

4. *Earlier and Easier Filing Date and Priority*

The filing date of an international registration, which is important for determining priority between conflicting users of a mark, is the date on which the international application is filed with the U.S. PTO, as long as the application is received by the central Madrid Protocol office within two months of filing

and meets the requirements set out for an international registration. The Madrid Protocol also allows the applicant to claim a priority filing date for its international application based on a U.S. application filed within the previous six months.

B. HOW THE MADRID PROTOCOL WORKS

To utilize the Madrid Protocol in the U.S., the applicant must be a national of, be domiciled in, or have a real and effective industrial or commercial establishment in the U.S. The applicant must own a U.S. trademark registration or application, which is called the “basic” application or registration. The application process is as follows:

1. Filing the Application

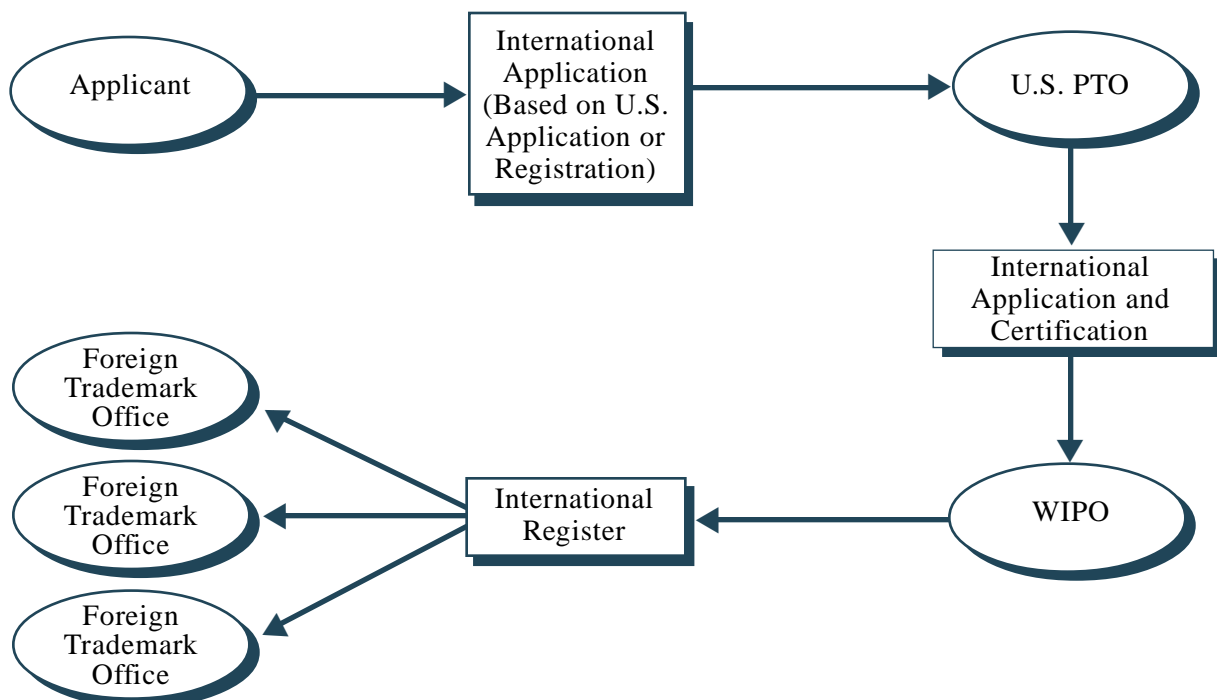
The applicant must file the international application with the U.S. PTO as a separate application from the basic U.S. application or registration and must identify the basic U.S. application or registration on which the international application is based. The

mark in the international application must be identical to the mark in the basic application or registration, and the list of goods and services must be identical to or narrower than those in the basic application or registration. The applicant must designate at least one foreign country to which it seeks to extend protection and must pay the appropriate filing fees (see below).

2. Processing by the U.S. PTO

After receiving the international application, the U.S. PTO will then forward the application to the International Bureau of the World Intellectual Property Organization (“WIPO”) in Geneva, Switzerland, along with a certification of the date that the international application was filed in the U.S. PTO and a certification that the international application is the same as the U.S. application or registration on which it is based. If the international application is received by WIPO within two months, the date that the international application is properly

International Application Procedure



filed in the U.S. PTO will be the filing date of the international registration. If not, then the filing date is the date that WIPO receives it.¹

The applicant can claim priority based on the basic U.S. application if the international application is filed within six months of the basic U.S. application, in which case the filing date of the international registration is the filing date of the basic U.S. application. For example, if the international application is filed November 2, 2003, and the U.S. PTO sends it to WIPO before January 2, 2004, then November 2, 2003 is the filing date. If the applicant had filed its basic application on May 2, 2003 and claimed priority on that basic application, then May 2, 2003 is the filing date of the international application.

3. Examination of the Application by WIPO

Once WIPO receives the international application, it follows a two-step examination process. First, it evaluates whether the application meets the international application filing requirements. If the application doesn't conform to the requirements, WIPO will contact either the trademark owner or the U.S. PTO. If the requirements are met, WIPO places the mark on the register and publishes it in the *WIPO Gazette of International Marks*. Second, WIPO forwards the registration information to the foreign countries that the applicant has designated. The trademark owner is not limited to its initial selection of countries, but can also request to extend the geographical reach of its international registration to additional member countries at a later date.

4. Examination by the National Offices

Each designated foreign country then proceeds to examine the application on the basis of its own national law and must respond to the applicant within 18 months. At this point the national office may request additional information or responses to

office actions. Responding to the foreign national trademark office, when necessary, is the only portion of the application process that will likely require the applicant to obtain foreign trademark counsel.

5. Maintaining an International Registration

The international registration lasts for ten (10) years and can be renewed for additional ten-year periods by making one filing in the U.S. PTO. However, for the first five (5) years the international registration remains dependent on the continuing validity and scope of the basic U.S. application or registration. During this five-year period, any cancellation or limitation of the basic U.S. application or registration will also apply to all rights obtained in other member countries under the international registration. However, even under these circumstances, the owner can maintain its foreign rights. The Madrid Protocol provides trademark owners with the option to convert rights under an international registration into corresponding national rights by instituting national filings within three months of the cancellation or limitation to the original U.S. application or registration. These new national filings receive the same priority date as the previous international registration for that country.

Any future enforcement of the mark in a particular country using the international registration must be done in that country under the substantive and procedural laws of that country.

C. INTERNATIONAL APPLICATION FEES

Each of the administering bodies and government agencies may charge separate fees related to processing the international application. Although these fees can become significant, the overall cost will likely be less than filing individual applications in each separate country. These fees include the following:

¹ Because the U.S. PTO must forward the international application to WIPO within two months, the U.S. PTO will require that any international application filed in the U.S. PTO be filed electronically.

- The U.S. PTO will charge \$100 per international class per application for certifying an international application to WIPO.
- WIPO charges three fees for a basic application: (1) an application fee of approximately \$458, (2) a supplementary fee of approximately \$52 for each international class over three, and (3) a complementary fee of approximately \$52 for each country designated.
- Approximately 22 individual countries set their own complementary fee instead of WIPO's complementary fee – for instance, among the higher fees are: the United Kingdom at approximately \$271, Australia at approximately \$279, and China at approximately \$242.

- The U.S. PTO, WIPO, and the individual countries all charge additional fees for more complex applications.

These fees are all set in Swiss francs and therefore are subject to changes in exchange rates. However, all of these fees can be paid to the U.S. PTO in U.S. currency at one time upon filing the international application.

FRANKLIN B. MOLIN

fmolin@kl.com
412.355.6251

KIMBERLY L. NASH

knasb@kl.com
412.355.8245

If you would like to discuss any of these issues in greater detail, please contact any one of the following K&L Trademark & Copyright Group lawyers:

Boston	Arthur Z. Bookstein	617.261.3153	abookstein@kl.com
Dallas	Robert Everett Wolin	214.939.4909	rwolin@kl.com
Harrisburg	Carleton O. Strouss	717.231.4503	cstrouss@kl.com
Los Angeles	Paul W. Sweeney, Jr.	310.552.5055	psweeney@kl.com
Miami	Daniel A. Casey	305.539.3324	dcasey@kl.com
Newark	Anthony P. La Rocco	973.848.4014	alarocco@kl.com
New York	Anthony H. Handal	212.536.4870	ahandal@kl.com
Pittsburgh	Franklin B. Molin	412.355.6251	fmolin@kl.com
San Francisco	Deborah Bailey-Wells	415.249.1065	dbaileywells@kl.com
Washington	Stephen C. Glazier	202.778.9045	sglazier@kl.com



Kirkpatrick & Lockhart LLP
Challenge us.®

www.kl.com

BOSTON ■ DALLAS ■ HARRISBURG ■ LOS ANGELES ■ MIAMI ■ NEWARK ■ NEW YORK ■ PITTSBURGH ■ SAN FRANCISCO ■ WASHINGTON

This publication/newsletter is for informational purposes and does not contain or convey legal advice. The information herein should not be used or relied upon in regard to any particular facts or circumstances without first consulting a lawyer.

© 2003 KIRKPATRICK & LOCKHART LLP. ALL RIGHTS RESERVED.

75 State Street
Boston, Massachusetts 02109
617.261.3100 PHONE
617.261.3175 FAX

2828 North Harwood Street
Suite 1800
Dallas, Texas 75201
214.939.4900 PHONE
214.939.4949 FAX

Payne Shoemaker Building
240 North Third Street
Harrisburg, Pennsylvania 17101
717.231.4500 PHONE
717.231.4501 FAX

10100 Santa Monica Boulevard
Seventh Floor
Los Angeles, California 90067
310.552.5000 PHONE
310.552.5001 FAX

Miami Center - 20th Floor
201 South Biscayne Boulevard
Miami, Florida 33131
305.539.3300 PHONE
305.358.7095 FAX

The Legal Center
One Riverfront Plaza, Seventh Floor
Newark, New Jersey 07102
973.848.4000 PHONE
973.848.4001 FAX

599 Lexington Avenue
New York, New York 10022
212.536.3900 PHONE
212.536.3901 FAX

Henry W. Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222
412.355.6500 PHONE
412.355.6501 FAX

Four Embarcadero Center, 10th Floor
San Francisco, California 94111
415.249.1000 PHONE
415.249.1001 FAX

1800 Massachusetts Avenue, N.W.
Second Floor
Washington, DC 20036
202.778.9000 PHONE
202.778.9100 FAX

www.kl.com



Kirkpatrick & Lockhart LLP

Challenge us.®