

Implementing The Madrid Protocol at the USPTO

The fun began on November 2, 2003

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GIPLA --11/04

Non-Madrid Practice Tips

- File assignments electronically or by fax
 - <http://etas.uspto.gov>.
 - New mailing address –
 - **Commissioner for Trademarks**
P.O. Box 1451
Alexandria, VA 22313-1451

What is the Madrid Protocol?

- An intellectual property treaty which the US joined on November 2, 2003
- The Protocol was adopted in 1989 and began operating as an international filing system in 1996
- The Protocol currently has 66 member countries—called Contracting Parties

Why is Madrid good for U.S Trademark Owners?

- The Madrid Protocol permits a trademark owner to:
- Potentially file a single application, in English, at the USPTO website, pay in US dollars, and seek registration in any or all of the Contracting Parties to the Protocol.
- There is no need to file individual applications in each of those 65 countries

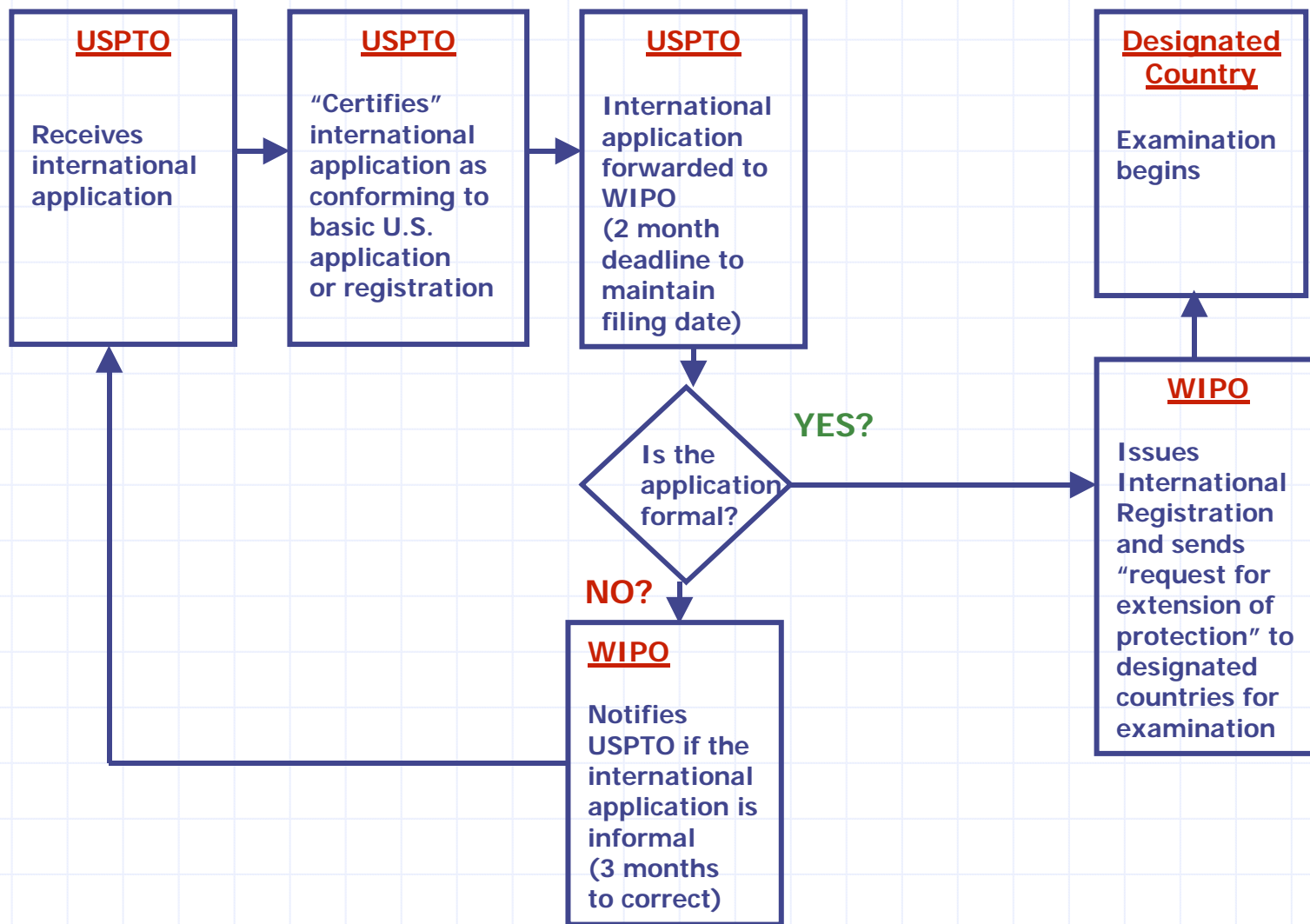
More of the Benefits of Madrid

- After rights are granted in any of those Contracting Parties
 - Assignments for any or all of the rights in any or all of the contracting parties can be effected by filing a single document with WIPO
 - Renewal of all rights can be effected by the payment of a single fee at WIPO

International Applications

Outgoing applications from national applicants to the International Bureau of WIPO

Process: U.S. Applicant Seeking Protection through the Protocol



How does the Protocol Operate?

For the US Trademark Owner

The U.S. trademark owner seeking international registration must have a “basic application” or “basic registration” in the USPTO.

A basic application or registration means a regularly filed U.S. application or a valid U.S. registration.

More on How it Operates (2)

The US trademark owner seeks an international application

- The trademark owner uses its basic application/registration to form the basis for an international registration by filing an international application with the USPTO.
- The international application must have the same mark, the same owner, and the same or less goods or service as exist in the basic application(s) or registration(s).

What the USPTO Must Do with the International Application

- The job of the USPTO is to certify to the International Bureau of WIPO that the international application:
 - Has goods or services that are within the scope of the goods or services in the basic application or registration
 - That the mark is the same
 - That the owner is the same
 - In short, that the international application reflects the data in the basic application or registration

Additional Elements in the International Application

- International Applicant must be “entitled to file its international application with the USPTO
 - Must be citizen of, domiciled in-, or have a real and effective industrial or commercial establishment in the US

What Happens After the MPU Certifies?

- If the international application conforms to the basic application or registration
 - THEN
- The USPTO Madrid Processing Unit certifies that fact and forwards the international application to the International Bureau of WIPO
- The international application NEVER becomes part of the examination process at the USPTO

The Electronic International Application

- US applicants can now use the USPTO web site (TEAS forms) to file an international application
- The rules concerning international application are in Part 7 of the CFR (37 CFR Part 7)
- Information on filing paper application can be found at the web site. www.uspto.gov “Tips for Paper Filers”

E-Filing the International App

- File at www.uspto.gov
- Pay fees using credit card, deposit account, electronic funds transfer or e-check
- Pre-populate application directly from the USPTO database
- **practice tip**—look at what's in the database carefully—especially who owns the basic application or registration

Paper Filing the International Application

- See: Federal Register notices of October 24 and November 7, 2003.

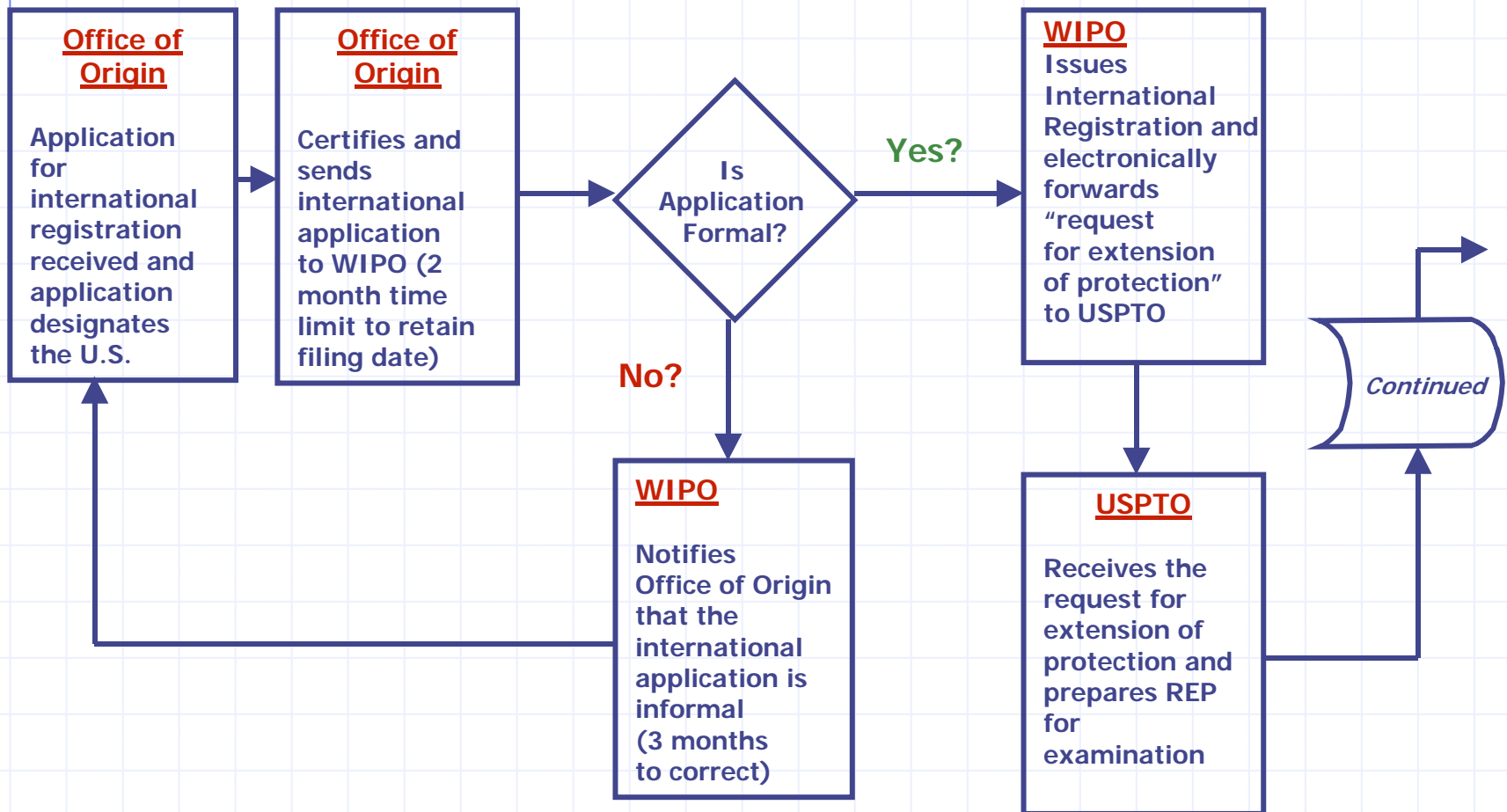
File using the MM2 form (available at the WIPO web site). This form can be filled out on line and then printed and mailed.

- Pay USPTO fees to USPTO at time of filing
- Pay WIPO fees to WIPO

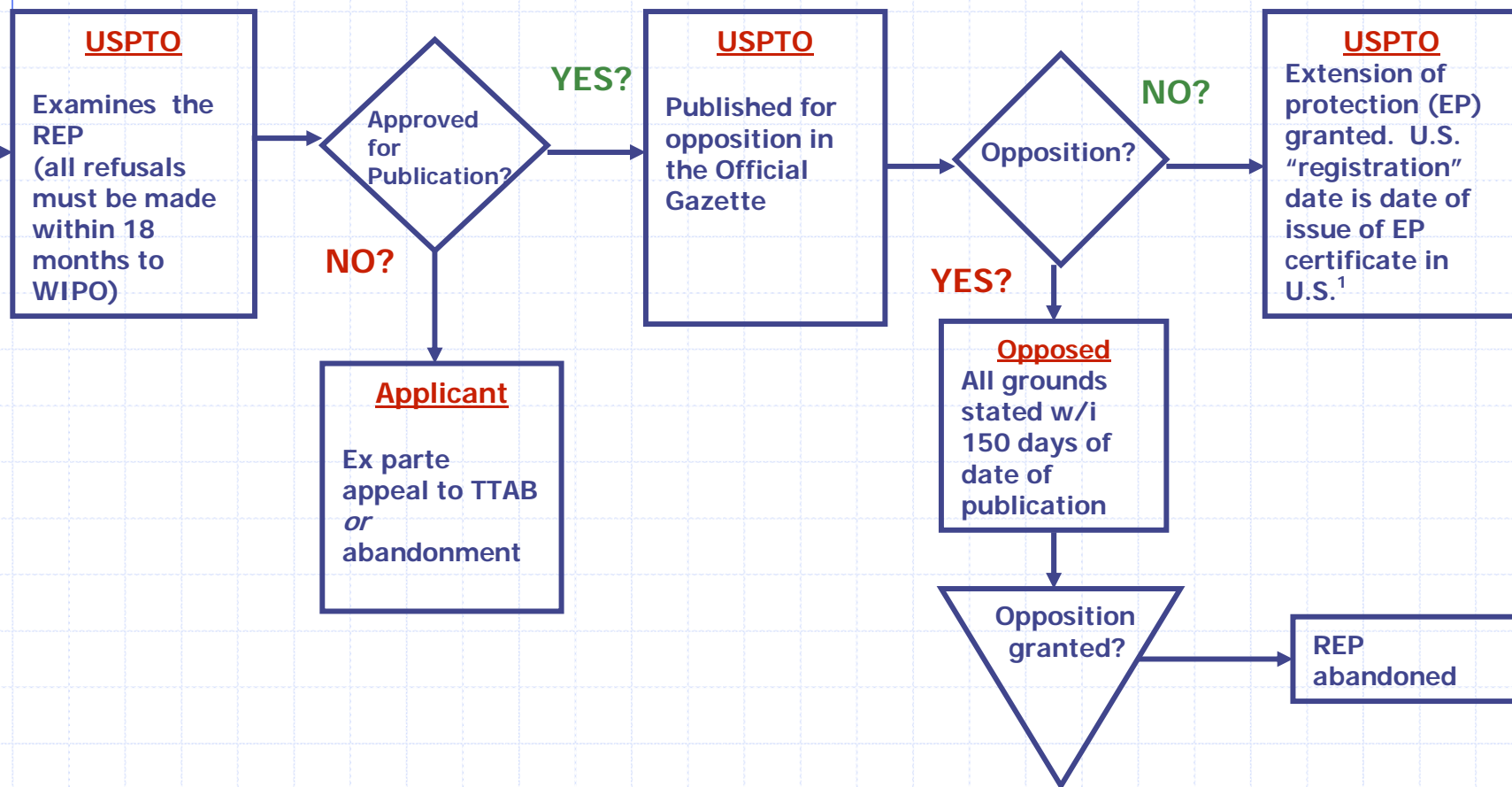
Requests for Extension of Protection

Incoming from the International
Bureau of WIPO

Process: Foreign Applicant Seeking Protection through the Protocol in the U.S.



Process: Foreign Applicant Seeking Protection through the Protocol in the U.S.



1. Protocol registration date is either: (a) date of international registration, or, (b) date of extension request.

Speculating on Madrid filings

- Before the U.S. joined Madrid, many commentators feared the “flood” of Madrid filings would inundate the U.S. Office.
- The U.S. looked at the filing records in recent Madrid members such as Japan and Australia and concluded that no “flood would come.

Predicting workflow

- The U.S. experience, as well as the Australian, U.K. and Japanese experience with Madrid filings is that:
- The percentage of foreign filings remains relatively constant. The basis for filing changes from Paris Convention to Madrid.

Foreign filing information

- The percentage of foreign applications filed into the U.S. has remained fairly constant—6 to 9%
- After the U.S. began accepting Madrid filings, the percentage of Paris convention based applications dropped—but were replaced by Madrid filings.
- Overall in the past year foreign filings (as a percentage of total filings) has remained relatively constant at about 8 to 9%

Current U.S. information on Madrid filings (11/01/04)

- Requests for extension received 5422
- International applications 1764
- International applications certified 1457
- International applications rejected 293
- Irregularity notices 537
- Subsequent designations 35

U.S. filing information

- In FY04, total application classes filed were 298,489
- Madrid extensions of protection (about 4900 filed in FY04) are only a small percentage of filings.

A few extension requests are
received
months after receipt at WIPO

SN 79003907 is the U.S. backlog champion,
e-delivered to the USPTO on 8/12/04 with
a filing date of 11/15/03, a difference of
271 days (essentially 9 months old when it
arrived).

Request for Extension of Protection

- The data (i.e. mark, goods etc.) in the international registration forms the basis for the REP.
- That data in the REP is sent to the USPTO and is treated just like a regularly filed US application.

What's different?

- **Classification**—accepted as is—**IDs** must conform to US practice
- The REP cannot be assigned at the USPTO
- The REP is renewed at WIPO when the international registration is renewed

Other Differences

- The REP can be “transformed” into a regularly filed national application if its basic application/registration is restricted, abandoned, cancelled or expired in the first 5 years of the international registration’s life.
- The REP can “replace” an earlier registration – if the mark, goods and owner are the same

Summary

- The Madrid Protocol is an International Trademark Filing Treaty
- The USPTO began accepting international applications and requests for extension of protection on 11-02-03
- Trademark owners who use the treaty must have a “basic application” or “basic registration” in their home country

Summary -- Continued

- The USPTO has a limited role in the Madrid system
 - Certifying the scope of international applications
 - Examining requests for extension of protection to the United States
 - REPS must be examined just like regularly filed US applications

Additional Information

- www.uspto.gov
- www.wipo.int
- **QUESTIONS?**