

From: Carl Oppedahl [mailto:carl@oppedahl.com]
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To: inta
Subject: (INTA list) Ninety-five percent of REPs to the US get refused

From the Madrid Protocol list server:

Here are some current statistics regarding Madrid Protocol Requests for Extension of Protection to the United States.

About 19740 REPs to the US have been made to the International Bureau, of which 15454 have been registered by the International Bureau. The IB transmits these REPs electronically to the USPTO, and right now 14799 of them have US serial numbers.

It takes about six and a half months for a REP to the US that has a US serial number to get examined. For example right now the USPTO is examining REPs that received US serial numbers in about March of 2005.

By far the majority of REPs to the US (about ninety-five percent) receive international refusals. Of the 14799 REPs to the US that have received US serial numbers, about 12413 have been examined, and 11776 have received an international refusal.

What are the causes of refusal? A review of several hundred refusals identifies the following.

In well over half of all international refusals emanating from the USPTO, at least one ground for refusal is the Madrid applicant having failed to state, in section 2 of Form MM2, the "legal nature of the legal entity:" of the applicant or the country "under the law of which the legal entity is organized:" Although these two fields are merely listed on the MM2 form as "may be required", for a REP to the US, these fields are very much required.

In well over three-quarters of international refusals emanating from the USPTO, a chief ground for refusal is indefiniteness in the identification of goods/services. The applications that avoided such refusals appear in nearly all cases to have identifications selected directly from the USPTO's Trademark Acceptable Identification of Goods & Services Manual.

Of the 12413 REPs that have been examined, 4208 have been published for opposition, and 1353 have been registered.