

U.S. SIGNS INTERNATIONAL TRADEMARK TREATY - THE MADRID PROTOCOL

On Saturday, November 2, 2002, President Bush signed into law the Department of Justice Authorization Conference Report, which included implementation legislation for the Madrid Protocol. Upon implementation, U.S. applicants will be able to file a single application in the U.S. that can, for a fee, be expanded under the Protocol to include applications in any additional member country.

A. Benefits

1. Protocol applicants pay a single fee based upon the countries to be covered by the registration;
2. Protocol filings are made in a single application; in a single language and in a single trademark office.
3. Filings under the Protocol can be accomplished by a single trademark counsel without independent trademark counsel in each country, however it is necessary to hire local counsel for trademark searches and for responses to trademark examiners;
4. Protocol registrations have a single registration number and a single renewal date;
5. If a Protocol mark is assigned or if the trademark owner changes its name or address, a single record change is sufficient, regardless of the number of countries where the mark is protected; and
6. U.S. companies that previously relied on overseas subsidiaries to hold international registrations can unify trademark ownership with the U.S. parent company for a single owner without forfeiting the international registration;

B. Drawbacks

1. Each country still independently examines Protocol applications under the same standards applied to its national applications;
2. The United States Patent and Trademark Office currently requires more detailed, and often more narrow identifications of goods and services than many Protocol member states – because Protocol filings are dependant on the home country mark that provides the basis for the application, individual national applications may provide broader overall protection for U.S. trademark owners;
3. By filing Protocol applications, applicants may lose the input of informed local counsel at all stages of the process, which may make it more difficult to address potential problems before investing in filing and prosecution costs;
4. If the home application for a Protocol filing is amended or refused, that action applies to each expansion application;

5. International registrations cannot be amended after registration – applications in industries where minor alterations are often made to existing registrations may prefer to file individual national registration in countries where post-registration amendments are allowed; and

6. International registrations can only be assigned to new owners that reside in a member country (which excludes countries such as Canada and much of Latin America , which are currently not members of the Protocol).

The United States Patent and Trademark Office is to promulgate a system of rules for administering Protocol applications. It is estimated that the Protocol will not be available in the U.S. until late 2003. If you desire to read the entire bill see H.R. 2215 (Subtitle D – Madrid Protocol Implementation and Title XII The Madrid Protocol) at <http://thomas.loc.gov>.