

Foreign Trademark Filing: What You Need to Know in a Nutshell

This is what I hear from many clients: “the trademark you filed for us will protect us in foreign countries too, right?” Wrong! As with patents, trademark registrations only cover the country in which they are filed. So your US trademark application will only bestow trademark rights in the United States and not beyond. Therefore, in order to protect your trademarked word or design in Japan, or Germany, or whatever country you’re concerned about, you will need to file a trademark application in each of those countries. This can get costly very quickly. But wait, there is a solution...

Madrid Protocol Application

As of 2003, the United States has been a member of the Madrid Protocol. This is an international treaty that streamlined the foreign filing process by allowing an applicant to file one application designating as many foreign member countries as they wish. Prior to the Madrid Protocol, you had to hire local counsel in each and every country and file each application separately. Now this filing can be done by a US attorney without the hassle of hiring local counsel in each country. There are currently over sixty countries that are members of the Madrid Protocol. What a life-saver! Indeed, but there are a few requirements in order to qualify as discussed below.

Requirements to File a Madrid Protocol Application

In order to file a Madrid Protocol application, you must:

- 1) Have either a pending US application, or an issued US registration with the United States Patent and Trademark Office (“USPTO”); and
- 2) The trademark owner must either be a citizen of the United States; be domiciled in the US; or have a “real and effective industrial or commercial establishment in the United States.”

Madrid Protocol Fees

There is a certification fee charged by the USPTO for filing the Madrid Protocol application. The certification fee price will vary depending upon the number of classes of goods and services you have in your application. The more goods and services you have, the higher the certification fee will be.

The second fee is the international registration fee which is charged by the International Bureau of the World Intellectual Property Organization (“WIPO”). This fee varies depending upon the countries designated in the application.

Madrid Protocol Process

Assuming you already have a pending US application or a US registration, your attorney will file the Madrid Protocol application with the USPTO located in the Virginia. The USPTO will eventually transmit a certified application to the International Bureau (“IB”) which is the branch of WIPO that administers the Madrid Protocol. The IB will determine if all the requirements of the application are met. If so, the IB will publish the mark in the WIPO Gazette of International Marks and send a certificate to the owner. If there is a problem with the application, the IB will issue a notice referred to as an “irregularity notice.” This notice can be responded to and often overcome.

Once the IB approves the application, it will notify each and every country you designated, referred to as “contracting parties,” in your Madrid Protocol application. Each contracting party will then examine the application in the same manner as it would a national application made under its laws. If it approves the application, it will then issue a registration in that country.

Final Note

Your original US application is extremely important as the Madrid Protocol application depends upon the US application. If the US application is abandoned or cancelled during the first five years, the mark pending with IB will be cancelled as well.

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