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THE MADRID
PROTOCOL:
TRADEMARK SUPERHERO?

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THE MADRID PROTOCOL: TRADEMARK SUPERHERO?*

I Introduction

The Madrid Protocol Superhero adjusts her silver and scarlet cape bearing the stylish "MP" and lightning design, steps back, and soars out into the dazzling sunshine. With her X-ray vision, she scans the commercial universe, looking for United States trademarks requiring international protection. She also searches for the Community Trade Mark in the distance. Does it need her protection as well?

Despite her outward appearance, the Superhero is not invincible. She is untested, and may have flaws. But her superpowers, including those recently vested in her by United States legislation and regulations, are peerless. And she is surely here to stay.¹

The Superhero has been easing into her work in the United States as trademark owners begin to feel comfortable asking for her help. In the United States, as of February 20, 2004, there have been only 412 international applications filed since the USPTO began accepting applications on November 2, 2003. Why so few? After all, the system promises cost savings, ease of use and speedy registration. Under the Madrid Protocol, United States trademark owners with a mark registered in or an application pending with the United States Patent and Trademark Office ("USPTO") can file a single application in a single language using a

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¹ This is a sequel to a pamphlet distributed at the 2003 INTA 125th Annual Meeting in Amsterdam, Gilson & LaLonde, "The Madrid Protocol: A Slumbering Giant Awakens at Last." This pamphlet repeats some of the basic information about the Protocol from the earlier pamphlet but is updated in light of final USPTO regulations, early filing experience in the United States, and recent developments regarding the Community Trade Mark.

The authors thank Mary Squyres of Brinks Hofer Gilson & Lione for her constructive comments on a draft of this pamphlet. See Squyres, *Trademark Practice Throughout the World* (2002) (Chapter 14, "The Madrid System").

single currency.² Similarly, trademark owners with a mark registered in or an application pending in their home country can file an application in that country designating the United States and receive trademark protection there.

While the Protocol system is certainly underutilized, that is to be expected so soon after its arrival in the United States. For example, the dependency of an international registration on a United States application or registration has surely made U.S. mark owners hesitant to file under the Protocol unless and until they are certain their basic marks are on solid ground. It may be a while before the Protocol Superhero's red phone starts ringing off the hook, but the system still holds substantial promise for those trademark owners in the right situation.

Let's go over some of the basics of the Madrid Protocol system, and then we'll discuss upcoming developments and the pros and cons of the system.

II Review of the Basics

The Madrid System of international trademark registration is governed by the Madrid Agreement Concerning the International Registration of Marks (the "Madrid Agreement") and the Protocol Relating to the Madrid Agreement (the "Madrid Protocol").³ The Madrid Agreement and the Madrid Protocol are independent filing systems. Some countries, like France and Spain, are members of both the Agreement and the Protocol, and others, like Egypt, are only members of the Agreement, or, like the United States, are only members of the Protocol.

The advent of the Madrid Protocol in the United States does not change any substantive trademark law. The Protocol is a treaty that simply and effectively streamlines international trademark application procedures.

² Right now, however, that statement is not strictly true. The United States has temporarily suspended its requirement of electronically filing Madrid Protocol-based applications, and until the electronic filing system is in place, those who file an international application with the USPTO must pay the U.S. fees to the USPTO in dollars and also pay the international fees to the International Bureau of WIPO in Swiss Francs. See § II.e.i *infra*.

³ The Madrid Protocol is reprinted in Gilson & LaLonde, 3 *Trademark Protection and Practice* Appendix 10C.

Sixty-two countries are currently members of the Madrid Protocol,⁴ and the European Union, with its ten new members, is expected to join later this year.⁵ In addition, as of April 1, 2004, Madrid System applicants can file applications in Spanish, where the Office of Origin permits them to do so.⁶ This change should ultimately lead Latin American countries to choose to join the Madrid system.

[a] – Who Can File an International Application?

United States businesses and individuals will certainly be able to file in the United States under the Madrid Protocol. In order to apply for an international registration under the Protocol, the applicant must be a national of, be domiciled in, or have a real and effective business or commercial establishment in one of the countries or intergovernmental organizations that are members of the Protocol.⁷ The United States is now such a member.

Each Contracting Party, or member of the Protocol, can interpret these requirements as it sees fit, but one provision of the Lanham Act may give some clues as to how the USPTO would handle the definitions. Section 44(c) of the Lanham Act defines an applicant's country of origin as "the country in which he has a bona fide and effective industrial or commercial establishment."⁸ The USPTO's *Trademark Manual of Examining Procedure* ("TMEP") declares that an assertion by an applicant or its attorney that the applicant has such an establishment suffices and does not have to be independently verified. If, however, evidence in the record contradicts the applicant's assertion, "the examining attorney has the discretion to require the applicant to set forth the specific circumstances that establish that the applicant maintains a bona fide and effective industrial or commercial establishment in the country. Relevant factors

⁴ See Appendix A *infra* for a complete listing of countries party to the Protocol, the Agreement, or both.

⁵ See III *infra*.

⁶ See www.wipo.org/pressroom/en/releases/2003/p358.htm (WIPO press release).

⁷ Article 2(1) of the Madrid Protocol; 15 U.S.C. § 1141a(b).

⁸ 15 U.S.C. § 1126(c).

include the presence of production facilities, business offices and personnel.”⁹

[b] – What are the Requirements for Filing in the United States?

Trademark Rule 7.11 sets forth the minimum requirements for a date of receipt of an international application in the USPTO.¹⁰ The international application must include the filing date and serial number of the basic application or the registration date and registration number of the basic registration. It must also include the applicant’s name and address and the name of the applicant must be identical to that of the applicant or registrant for the basic application or registration.

Practice Tip: Because the name of the applicant in the international application must be *identical* to that of the applicant or registrant in the basic application or registration, a mark owner should file its request to record a change in ownership of a U.S. basic application or registration well before it files its international application. Recently, the USPTO issued reel and frame recording data the morning of the business day following such an electronic filing. A mark owner should file assignments electronically with the USPTO at <http://etas.uspto.gov> because the USPTO records such assignments much more quickly than assignments filed by mail. If a mark owner has filed a request to record a change of ownership, it should check the USPTO’s Trademark Applications and Registrations Retrieval (TARR) database at <http://tarr.uspto.gov> to see whether the information has in fact been updated before submitting its international application.

In addition, when electronic filing is possible, the USPTO will use more electronic forms pre-populated with information from their trademark database. Trademark owners should verify the accuracy of the information in the Trademark Electronic Search System (TESS) for a mark well before filing an international application based on that application or registration.

⁹ TMEP § 1002.04. The Manual also notes that the existence of an applicant’s wholly-owned subsidiary in a country does not alone establish an industrial or commercial establishment. *In re Aktiebolaget Electrolux*, 182 U.S.P.Q. 255 (TTAB 1974). See also *Ex parte Blum*, 138 U.S.P.Q. 136 (Comm’r Pats. 1963).

¹⁰ 37 C.F.R. § 7.11. 37 C.F.R. Part 7 is reprinted as Appendix B *infra*.

An international application must also include a reproduction of the mark that is the same as the mark in the basic application or registration and that meets the requirements of 37 C.F.R. § 2.52. If the mark owner claimed color as a feature of the mark in the basic application or registration, the international application must also contain a statement that color is claimed as a feature of the mark. The international application must contain a list of goods or services that is identical to or narrower than the goods or services listed in the basic application or registration.

And an international application must designate one or more countries (or intergovernmental organizations, when the EU joins) in which the applicant seeks protection. These designations are known as requests for extension of protection. International registration owners *may not* designate countries that are not members of either the Agreement or the Protocol, such as Canada or Mexico.

[c] – Bases for International Application

In order to obtain protection under the Madrid Protocol, an individual or business domiciled in a member country must own either a trademark application or registration. This application or registration is the basis for the international application; therefore, it is called the basic application or the basic registration.

A trademark owner must make an international application for exactly the same mark and have a list of goods and services that is the same or narrower as in the basic application or registration. The basic registration may be one on the Supplemental Register and the basic application may be one for the Supplemental Register.

[d] – Priority

The Madrid Protocol enables trademark owners to take advantage of the Paris Convention priority they have in their national filings. The international application may thus contain a Paris Convention priority claim if it is based on the first-filed application and priority is claimed within six months of the original filing date. In order for the priority claim to survive, the USPTO must transmit the international application to WIPO either (1) within two months of the date it receives the international

application or (2) within the six month priority period. A priority claim will usually be based on the underlying United States basic application.

An applicant may claim a right of priority if its international application contains a claim of priority and the filing date of the application that forms the basis for the priority claim was not more than six months before the date of the international registration.

[e] – Outbound Applications: International Applications Originating from the United States

International applications originating in the United States are known in the U.S. as *outbound* applications because they request protection for the trademark in other countries. The applicant must submit the international application through the national trademark office of the Protocol member state where the basic application or registration is located. If an applicant is basing its international application on an application or registration with the USPTO, it must file its international application with the USPTO.

[i] – Fees

[A] – Filing an International Application

Until at least November 4, 2004, when filing an international application with the USPTO, one must pay two types of fees: (1) international application fees *to be paid directly to WIPO* and (2) certification fees *to be paid directly to the USPTO*.

[1] – WIPO International Application Fees

The international application fee is 653 Swiss Francs (\$530 US as of this writing) where the mark is not in color and 903 Swiss Francs (\$730) where it is in color. There is also a fee per member state that is added to the basic fee and payable to WIPO, and a supplementary fee of 73 Swiss Francs (\$60) per every class over three.

The Trademark Rules of Practice provide that Madrid Protocol applicants must pay their international application fees through TEAS at

the time they submit their application.¹¹ However, the USPTO has suspended that rule, providing instead that until at least November 4, 2004, those filing Madrid applications must pay their international fees *directly to WIPO, either before or after* they submit the international application to the USPTO.¹² The applicant must pay these fees in Swiss Francs, through either a debit account with WIPO, direct payment into WIPO's bank account in Switzerland, a banker's check in Swiss currency, or cash at WIPO.¹³

[2] – United States Certification Fees

An applicant must pay the U.S. certification fee of \$100 per class if the international application is based on one basic U.S. application or registration and \$150 per class if based on more than one basic U.S. application or registration. An example of how to calculate certification fees: An international application is based on a single U.S. application in classes 1, 2, 3, 4 and 5. The applicant has designated Iceland and requested an extension of protection in three classes: 1, 2, and 3. It has also designated Sweden and requested an extension of protection in two classes: 1 and 4. It has therefore requested an extension of protection in four classes: 1, 2, 3 and 4. So the total certification fee would be 4 x \$100, or \$400.

[B] – Fees for Responding to Irregularity Notices

There are no U.S. fees for processing a response to an irregularity notice. Fees for responding to any irregularity notices regarding an international application must go directly to WIPO; applicants cannot pay those fees to the USPTO.

¹¹ 37 C.F.R. § 7.11(a)(9) (“The certification fee required by § 7.6, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (see § 7.7)).”

¹² See “Modification to Temporary Postponement of Electronic Filing and Payment Rules for Certain Madrid Protocol-Related Rules,” 68 Fed. Reg. 74,479 (2003).

¹³ For more on payment directly to the International Bureau of WIPO, see www.uspto.gov/web/trademarks/madrid/madrid_tipspaperfilers.htm.

[C] – Fees for Subsequent Designations

As with international applications, until the USPTO accepts electronic applications, those who submit fees for subsequent designations must pay (1) international application fees *directly to WIPO* and (2) transmittal fees *directly to the USPTO*. The U.S. collects a \$100 transmittal fee per class for subsequent designations.¹⁴

[D] – How to Pay Fees to WIPO’s International Bureau

First, determine the amount of the fee. At the WIPO website, there is a fee schedule, a listing of individual fees by country where the country has opted to charge such fees, and a very useful fee calculator.¹⁵

[ii] – Paper Filing

Until at least November 4, 2004, Madrid Protocol applicants must submit international applications, subsequent designations and responses to irregularity notices to the USPTO *on paper*.¹⁶ Due to technical difficulties, the USPTO has postponed the advent of electronic filing for Madrid-based documents. All Madrid submissions should be mailed to: Commissioner for Trademarks, P.O. Box 16471, Arlington, VA 22215-1471, Attn: MPU. (“MPU” designates the USPTO’s Madrid Processing Unit.)

Those filing an international application must use the official form, Form MM2, at the WIPO web site. One can print out a PDF version¹⁷ or use an editable PDF form that one can fill out on the web site and print out.¹⁸ There is also an official paper form for subsequent designations, MM4.¹⁹ While responses to notices of irregularity must also be filed on paper for the time being, there is no official form for doing so. Applicants

¹⁴ 37 C.F.R. § 7.6.

¹⁵ See www.wipo.int/madrid/en/fees/index.htm.

¹⁶ See “Modification to Temporary Postponement of Electronic Filing and Payment Rules for Certain Madrid Protocol-Related Rules,” 68 Fed. Reg. 74,479 (2003).

¹⁷ See www.wipo.int/madrid/en/forms/pdf/mm2.pdf. Form MM2 is reprinted in Appendix C *infra*.

¹⁸ See www.wipo.int/madrid/en/forms/editable/ed_mm2.pdf.

¹⁹ For the PDF version, see www.wipo.int/madrid/en/forms/pdf/mm4.pdf and for the editable PDF version, see www.wipo.int/madrid/en/forms/editable/ed_mm4.pdf.

submitting such responses should include the USPTO control number that was assigned to the international application when it was certified and a copy of the International Bureau's irregularity notice.

The USPTO suggests that applicants include a self-addressed, stamped postcard when filing an international application on paper. After receipt of the application, the USPTO will return the postcard, bearing a control number.

The Trademark Trial and Appeal Board *is* accepting electronically-filed oppositions to Section 66(a) applications – those requesting an extension of protection in the U.S. under the Madrid Protocol. In fact, such oppositions *must* be filed electronically using the Electronic System for Trademark Trials and Appeals (ESTTA), as must requests for extensions of time to oppose.²⁰ (Notices of opposition and extensions of time regarding Section 1 or Section 44 applications may be filed electronically or on paper.) The TTAB strongly urges those who have not used the system previously to “plan ahead, and . . . submit your notice of opposition prior to the deadline in case you encounter problems.”²¹ The TTAB cannot extend the time to oppose beyond that in the Trademark Rules of Practice.

[iii] – USPTO Certification

Upon receipt of a Madrid-based application, the USPTO must certify that the trademark and the applicant in the international application are the same as those in the basic application or registration. It must also certify that the goods or services listed in the international application are covered by those listed in the basic application or registration.²² If the PTO certifies an application, it then sends the application to WIPO. In order for the applicant to maintain its filing date as the date it submitted its application to the USPTO, the USPTO must send the application to WIPO within two months of receipt. In these early months of the Protocol in the United

²⁰ 37 C.F.R. § 2.101(b)(2).

²¹ See <http://estta.uspto.gov/>.

²² See USPTO Examination Guide 2-03, “Guide to Implementation of Madrid Protocol in the United States,” § II.C, at www.uspto.gov/web/trademarks/madrid/madridguide.htm, for a full list of what the USPTO needs to certify. This Examination Guide is reprinted in its entirety in Gilson & Gilson LaLonde, *Trademark Protection and Practice*, Appendix 9.

States, certification has typically taken only one or two days. If the international application is sent to WIPO after that two-month period, the date of the international registration will be the date of its receipt at WIPO.

If the USPTO certifies an international application and forwards it to WIPO, the USPTO's MPU will mail the applicant a confirmation of certification. If, however, the USPTO does *not* certify the application, the MPU will send a letter to the applicant explaining why it was not certified.

[iv] – “Registration” of the Mark at WIPO

After WIPO receives an international application from the USPTO, WIPO confirms that certain filing requirements have been met (*e.g.*, payment of the fees). If the application is in order, WIPO “registers” the trademark and publishes it in the *WIPO Gazette of International Marks*.

Why is “registration” in quotation marks in the above heading? Because an international registration is not a trademark registration as we know it. International registration is essentially a filing receipt, meaning that the trademark owner has applied to register its mark in the countries it has designated. Once WIPO has registered the international registration, the mark owner will have the same rights as if it had filed an application directly in each designated country.

[v] – Irregularities

After the mark is sent to WIPO, it may yet fail WIPO's determination of whether it has met the formalities. If the irregularity involves classification or identification of goods or services, the response to the irregularity should be filed with the USPTO at least one month before the end of the response time in the WIPO notice.²³ When the TEAS electronic filing system is ready, an international applicant must respond to an identification or classification irregularity using a special TEAS form. Currently, there is no official form for responding to an irregularity notice. If the applicant proposes revised goods in its response to the irregularity, the USPTO will certify that the scope of the revised goods is the same or

²³ 37 C.F.R. § 7.14(e).

narrower than that in the basic application or registration. All other responses must be made directly to WIPO.²⁴

[vi] – Examination by Office of a Designated Contracting Party

When WIPO “registers” the mark, it sends the relevant information in the international application to the national offices of the countries designated by the mark owner in its international application. The national offices must treat a request for extension of protection as a properly-filed national application. Each country’s trademark office, then, examines the application under its own national trademark law. The national trademark offices must act on the application within either 12 or 18 months, depending upon the time frame chosen by the country when it became a member of the Protocol, possibly longer if there is an opposition to the application in that country.

If the national office does not act during the 12- or 18-month period, the trademark owner will gain all of the benefits of a national registration in that country. Note, however, that after a party owns an extension of protection in a country, those rights may still be invalidated by cancellation or a civil lawsuit as with any national trademark registration.

[f] – Inbound Applications: Requests for Extension of Protection to the United States

The holder of an international registration based on a mark filed outside of the United States can file a request for extension of protection to the United States. This request will be made in a Section 66(a) application. 37 C.F.R. § 7.25(b). Section 66(a) is a new filing basis in the United States, as of November 2, 2003, and if it is claimed, it must be the only basis in the application.

There have been around 500 extensions of protection per month requested from the United States thus far. As of March 5, 2004,

²⁴ See USPTO Examination Guide 2-03, “Guide to Implementation of Madrid Protocol in the United States,” § II.G, at www.uspto.gov/web/trademarks/madrid/madridguide.htm, for more on irregularities in international applications. This Examination Guide is reprinted in its entirety in Gilson & Gilson LaLonde, *Trademark Protection and Practice*, Appendix 9.

approximately four months after the advent of the Madrid Protocol in the United States, 1094 requests for extension of protection to the United States were pending and 1212 requests were registered in the WIPO database. German requests represented 23%, French requests were 13% and Switzerland, Benelux and the United Kingdom were each 6 to 9% of the total.

A request for extension of protection to the United States must include a declaration that the applicant has a *bona fide* intention to use the mark in commerce that can be controlled by the United States Congress.²⁵ This declaration must be made on official Form MM18, found on WIPO's web site.²⁶ The USPTO does not require use prior to registration for incoming Madrid Protocol applications.²⁷ But owners of registered U.S. extensions of protection must maintain them by filing affidavits of use or excusable nonuse under Section 71. These affidavits must be filed between the fifth and sixth year after the date on which the USPTO issues the certificate of extension of protection *and* within the six-month period preceding the end of every ten-year period after the date on which the USPTO issues the certificate of extension of protection.²⁸

The USPTO will examine Section 66(a) applications according to the same standards it will use in examining applications under Sections 1 and 44,²⁹ and the mark must be registrable on the Principal Register.³⁰ The USPTO has 18 months within which to notify the International Bureau of WIPO of (1) a final or provisional refusal of a Section 66(a) application based on examination; (2) a final or provisional refusal of a Section 66(a) application based on an opposition; or (3) the possibility that an opposition

²⁵ 15 U.S.C. § 1141f(a).

²⁶ See www.wipo.int/madrid/en/forms/pdf/mm18.pdf. Form MM18 is reproduced as Appendix D to this pamphlet.

²⁷ 15 U.S.C. § 1141h(a)(3).

²⁸ 15 U.S.C. § 1141k.

²⁹ See USPTO Examination Guide 2-03, "Guide to Implementation of Madrid Protocol in the United States," § IV.B.2 at www.uspto.gov/web/trademarks/madrid/madridguide.htm ("The examining attorney will examine a § 66(a) application, including the identification of goods/services, according to the same standards of specificity used in examining applications under § 1 and § 44 of the Trademark Act . . ."). This Examination Guide is reprinted in its entirety in Gilson & Gilson LaLonde, *Trademark Protection and Practice*, Appendix 9.

³⁰ 15 U.S.C. § 1141h(a)(4).

might be filed *after* the 18-month period is over. If the USPTO does notify WIPO of the possibility of a later opposition, the PTO may send a notification of refusal within seven months after the start of the opposition period *or* within one month after the end of the opposition period, whichever is earlier.³¹

Once filed, oppositions under Section 66(a) are nearly identical to oppositions against an application based on Trademark Act Sections 1 or 44. The substantive grounds for opposing an application are no different than they were before the Madrid Protocol,³² and a party may oppose a Madrid Protocol-based request for extension of protection on the same grounds that it could assert against a non-Madrid Protocol application. The period of time to oppose will not be extended beyond 180 days from the date of publication.³³ Oppositions to extensions of protection under the Madrid Protocol may not be amended to change goods or services opposed or to change grounds for opposition.³⁴ Oppositions to Section 1 or Section 44 applications, on the other hand, may be amended to add grounds for opposition.³⁵

At any point in time, a registered extension of protection to the U.S. may be invalidated due to a petition for cancellation or a judicial proceeding, as with any U.S. registration.

[g] – Issues Common to Outbound and Inbound Applications

[i] – Dependence on Basic Application or Basic Registration and “Central Attack”

For the first five years of its existence, the international registration depends upon the national trademark application or registration on which it is based. If the basic application is refused, the international registration and all rights obtained in member countries are cancelled. Similarly, if the basic registration is cancelled, the international registration and the

³¹ 15 U.S.C. § 1141h(c).

³² See Gilson & Gilson LaLonde, 3 *Trademark Protection and Practice* § 9.03[2] for a discussion of those grounds.

³³ 37 C.F.R. § 2.102(c).

³⁴ 37 C.F.R. § 2.107(b).

³⁵ 37 C.F.R. § 2.107(a).

concomitant rights are cancelled. This cancellation is known as “central attack,” even though it need not result from an “attack” by a third party. Central attack has been rare under the Madrid Protocol system; only one percent of international registrations have been cancelled each year due to central attack.

The five-year period is measured from the date of the international registration, which is either the date the Office of Origin received the international application (if the Office of Origin sent it to WIPO within two months) or the date WIPO’s International Bureau received it.

Note that each extension of protection is independent of the other; if one designates ten countries and is refused protection in nine of them, the other country may grant protection and the international registration will remain in force, allowing for subsequent designations in other countries.

[ii] – Transformation

If an international registration fails as a result of a central attack, the mark owner may transform its Madrid Protocol-based rights into separate national applications. The mark owner has three months from the cancellation of the international registration to do so.³⁶ Transformation can be expensive; the mark owner must pay filing fees for each national application and pay for local counsel. However, the direct filings of transformation keep the original date of the international registration. The mark owner need not transform all of its designated countries into national applications upon transformation; it can pick and choose among them. The owner of an international registration may not use the transformation procedure if it abandoned or failed to renew its international registration.³⁷

[iii] – Replacement of an Existing National Registration

It is possible to *replace* a prior national registration with a Madrid Protocol extension of protection, though it is very rarely done. If the applicant and the mark in the national registration are identical to those in the international registration *and* the goods or services in the national

³⁶ See 37 C.F.R. § 7.31(a) for the requirements of transforming a U.S. extension of protection into a regular U.S. application.

³⁷ 15 U.S.C. § 1141j(c); Article 9*quinquies* of the Madrid Protocol.

registrations are covered by those in the international registration, the mark owner can stop maintaining the national registration and continue to have the same rights as the replaced national registration. In other words, if a U.S. company has a 20-year-old trademark registration in France, if its international registration is for exactly the same mark and the same or more goods and services, that U.S. company can replace its French trademark registration with an extension of protection to France of its Madrid Protocol international registration. The U.S. company can choose to maintain its original French registration, and most companies in that situation do so.

[iv] Searching

Trademark owners can search WIPO's International Register, which includes all trademarks filed through the Madrid Agreement and the Madrid Protocol. WIPO publishes its *Gazette of International Marks* every two weeks, and it contains data on new international registrations, renewals, and subsequent designations. It is available on paper or on CD-ROM. In addition, WIPO publishes the current status of all international registrations in CD-ROM under the name ROMARIN. Data about all international registrations in force or expired within the past six months, as well as international applications and subsequent designations that have not yet been published in the *Gazette*, is accessible in searchable form on the WIPO web site under the name Madrid Express.³⁸

[v] – Post-Registration Issues

[A] – Duration and Renewal

The term of an international registration is ten years. Registration holders may renew their registrations for subsequent ten-year terms by filing with WIPO and paying the relevant fees. Failure to renew the international registration results in an expiration of the extensions of protection in member countries. The owner of an international registration also must comply with national trademark laws if the extensions of protection are to continue. Renewal must be made directly with WIPO.

³⁸ See <http://ipdl.wipo.int/>.

[B] – Subsequent Designations

The owner of an international registration may request extensions of protection in additional member states or intergovernmental organizations by submitting a subsequent designation. For example, when the EU joins the Madrid Protocol, those currently holding international registrations may choose to make a subsequent designation of the EU and request an extension of protection there.

Trademark Rule 7.21(b) lists the requirements for a date of receipt of a subsequent designation in the USPTO: the international registration number; name and address of the holder of the international registration; a statement that the holder is entitled to file a subsequent designation through the USPTO; a list of goods or services that is covered by the goods or services in the international registration; and a list of the newly-designated Contracting Parties.³⁹

[C] – Assignments

The holder of an international registration may only assign that registration to someone who would be entitled to file an international application at the time of the assignment. The assignee, therefore, must be a national or domiciliary of a Contracting Party or a country that is a member of an intergovernmental organization that is a Contracting Party, or someone who has a “bona fide and effective industrial or commercial establishment” in such a country.⁴⁰ Thus, the owner of an international registration could not assign that registration to a Canadian company, for example, because Canada is not a member of the Madrid system, unless it had a bona fide presence in a member country.

If the international registration is invalidated as a result of a central attack and transformed into separate national applications, the owner of those national applications can freely transfer them to any party. In addition, in the United States, the owner of a basic application or registration may assign those freely, though that must be done carefully, if at all, during the five-year dependency period.

³⁹ 37 C.F.R. § 7.21(b).

⁴⁰ Article 9 of the Madrid Protocol; 15 U.S.C. § 1141I.

[D] – Amendments

A trademark owner can never amend the trademark in an international registration. Period. If the mark owner wants even a slightly different trademark than that in the international registration, it will have to file a new national application and make that the basic application for a new international application.

[E] – Change of Name or Address

The owner of an international registration may change its name or address or the name or address of its representative on its international registration using an official form from the International Bureau of WIPO. This procedure is a substantial improvement over filing separate changes of name or address with each national trademark office.

[vi] – Enforcement

What should a mark owner do when it searches the international register and finds an international registration that infringes its mark? It has two main options, which may be pursued simultaneously.

[A] – Central Attack

First, a mark owner can "attack" the basic application or registration on which the infringing international registration is based. Imagine the Madrid Protocol Superhero casing the main power source of Dastardly Man, ready to pull the plug and deprive the bad guy of all of his power wherever he would exercise it. (Note that even if the basic application or registration falls due to abandonment or action by a trademark office rather than a third party's challenge, the process is still known as "central attack.")

Because the international registration – and all of the resulting extensions of protection – remains dependent on the basic mark during the first five years, if the basic mark is invalidated for any reason during that time, the international registration will be invalidated as well. So the international registration will fall if the basic mark is successfully "attacked" in an opposition or cancellation proceeding or a civil lawsuit.

Note that the mark owner pursuing the attack has five years to institute a proceeding against the basic mark; the actual invalidation of the

application does not need to occur in the first five years for central attack to be effective. If a proceeding is *pending* within those five years, a final decision canceling the mark that issues *after the five year period is over* still invalidates the international registration.⁴¹

The impact of a successful central attack is much stronger where the extensions of protection are governed by the Madrid Agreement rather than the Madrid Protocol. This is true because where the basic registration or application is invalidated, the international registration owner can transform Madrid Protocol-based extensions of protection into separate national applications. Under the Agreement, however, there is no ability to transform the extensions of protection into national applications.

For one international registration, the Agreement may apply to some extensions of protection and the Protocol may apply to other extensions of protection. Where the Office of Origin is a Protocol-only country and the designated Contracting Party is a Protocol-only country, the Protocol governs. Where the Office of Origin is an Agreement-only country and the designated Contracting Party is an Agreement-only country, the Agreement governs. Where the Office of Origin is a member of *both* treaties and the designated Contracting Party is also a member of *both* treaties, the *Agreement* governs under the so-called safeguard clause.⁴²

Here's an example of how to determine which treaty applies to a given extension of protection: A Spanish company files an international application in Spain (Agreement and Protocol) and designates Egypt (Agreement only), the United States (Protocol only), and Germany (Agreement and Protocol). This chart shows which treaty governs which extension of protection:

	Extension of Protection to Egypt (A)	Extension of Protection to USA (P)	Extension of Protection to Germany (A&P)
Spain (A&P) is Office of Origin	<i>Agreement</i> governs	<i>Protocol</i> governs	<i>Agreement</i> governs (due to safeguard clause)

⁴¹ 15 U.S.C. § 1141c.

⁴² Art. 9*sexies* of the Madrid Protocol ("Safeguard of the Madrid (Stockholm) Agreement").

Practice Tip: Why does this matter? Well, the Spanish trademark owner *cannot* transform the extensions of protection in Egypt and Germany into national applications if its international registration is cancelled. If there is a central attack on the Spanish basic registration, it is much more powerful because two of its extensions of protection are at risk of being totally eliminated. The threat of a central attack can be good leverage in settlement negotiations, especially where one or more of the extensions of protection is governed by the Madrid Agreement, because those extensions can't be transformed into national applications.

[B] – Invalidation of Extensions of Protection

Second, a mark owner protecting its mark can try to invalidate the individual extensions of protection in the designated Contracting Parties. Here, the Madrid Protocol Superhero is eliminating Dastardly Man's henchmen, one by one, so the bad guy won't have anyone left to do his dirty work for him.

In some cases, the mark owner may have no choice but to pursue this option rather than central attack: After five years, if no adverse proceeding has been filed, the international registration no longer depends upon the basic mark and it would be necessary to challenge the separate extensions of protection in each designated Contracting Party. One would challenge an extension of protection just as one would challenge any trademark registration. In the United States, for example, one would file an opposition (electronically) against the Section 66(a)⁴³ application.

If a challenger successfully opposes the extension of protection to the United States, then the applicant will not have a trademark registration in the U.S. And the USPTO reports that to WIPO. However, the challenger's success in the U.S. does not affect the status of the mark in any other countries the mark's owner designated in its international application. If the mark owner designated the U.S., Japan and France, and the challenger

⁴³ Note that when filing an opposition to a Section 66(a) application, the challenger needs to get it right the first time. After an opposition to a Madrid Protocol-based application is filed, it *may not* be amended to add grounds for opposition or to add to the goods or services opposed. 37 C.F.R. § 2.107(b).

successfully opposed only the U.S. extension of protection, the mark may still receive protection in Japan and France.

Also, countries that are party to the Madrid Agreement have only 12 months to refuse protection to a trademark, so deadlines for challenging that mark will probably be shorter.

III Community Trade Mark Developments

The European Union is expected to submit its Instrument of Accession to the Madrid Protocol in late 2004. When the EU joins the Madrid Protocol, applicants may make a single designation to request Extension of Protection in all of the EU countries by designating the EU territory as one member state. As early as the end of 2004, businesses may be able to use their Community Trade Mark as a basic mark for an international registration, as well as obtain a Community Trade Mark on the basis of an international registration. And as of May 1, 2004, ten more countries have joined the EU: Cyprus; Czech Republic; Estonia; Hungary; Latvia; Lithuania; Malta; Poland; Slovakia and Slovenia.⁴⁴

The EU can never become a member of the Madrid Agreement because it does not permit intergovernmental organizations to join. The Protocol, on the other hand, does allow accession by intergovernmental organizations, which is one of the many improvements of the Protocol over the Agreement.

[a] – Changes to Madrid Protocol Common Regulations

On April 1, 2004, certain changes to the Common Regulations of the Madrid Protocol entered into force; these changes are designed to accommodate the upcoming inclusion of the Community Trademark into the Madrid system. The amended provisions will not, however, be applicable until the European Community has in fact acceded to the Madrid Protocol.

⁴⁴ For more on the enlargement of the EU, see von Mühlendahl, Alexander, "The Enlargement of the European Union and Community Trade Marks – Harmony or Conflict?" ECTA Special Newsletter No. 49 (Oct. 2003).

[i] – Choice of a Second Language

In addition to the language of the international application, applicants who designate the European Union under the Protocol must also choose a second language.⁴⁵ The second language chosen must be one of the five official languages of the Office for Harmonization in the Internal Market (“OHIM”): English, French, German, Italian or Spanish. Third parties may then file legal proceedings before the OHIM in one of these two languages.

[ii] – Claim of Seniority

The Community Trade Mark Regulation provides that the owner of a national mark registered in any EU member state has seniority when it applies for an identical Community Trade Mark with the same or included goods and services.⁴⁶ The owner of a CTM can surrender its earlier national mark and the mark is deemed to have the same rights it would have had if the registration had been maintained. In the Madrid Protocol system, those holding an international registration and designating the European Union will be able to claim seniority from a previous registration for the same mark when the EU joins the Madrid system.⁴⁷

[iii] – Opting Back

When the owner of an international registration designates the EU and OHIM refuses protection to the mark, the registration owner has two options: It may convert its designation of the EU into either a national application filed directly with the trademark office of an EU member state

⁴⁵ Rule 9(5)(g)(ii) (“Where an international application contains the designation of a Contracting Organization, it may also contain the following indications: . . . where, under the law of that Contracting Organization, the applicant is required to indicate a second working language before the Office of that Contracting Organization, in addition to the language of the international application, an indication of that second language.”), found at www.wipo.int/madrid/en/legal_texts/pdf/common_regulations_04.pdf (entered into force April 1, 2004).

⁴⁶ Article 34, Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark.

⁴⁷ Rule 9(5)(g)(i), found at www.wipo.int/madrid/en/legal_texts/pdf/common_regulations_04.pdf (entered into force April 1, 2004).

or a subsequent designation of that member state under the Madrid Protocol system.⁴⁸ As with transformation, the mark owner will have three months to present the designation, using form MM16.

[b] – Changes to Community Trade Mark Regulations

Likewise, there will be changes to the Community Trade Mark regulations giving effect to the EU's accession to the Protocol.⁴⁹ The designation of the EU will have the same effect as applying for a Community Trade Mark, and the application will be searched and examined on absolute grounds for refusal and will be subject to a possible opposition or invalidation in the same way as would a regular Community Trade Mark application.⁵⁰ Finally, the period for refusal of an international registration designating the EU will be 18 months.

IV Advantages and Disadvantages of Different Filing Choices

[a] – Advantages to the Madrid Protocol

The Madrid Protocol system presents several advantages, but only under the right circumstances. There is the potential for cost savings because there is no immediate need for local representatives, powers of attorney or translations. In addition, there is less attorney and paralegal time spent reviewing several individual filings. The application process involves payment of one fee in one currency (when the USPTO's electronic filing system is in place) and an application in English. In addition, the maintenance efficiencies can be advantageous, including one registration number with one renewal date for all extensions of protection, and one filing for renewal, change of address and assignments. (Efficient renewal, however, would only be advantageous if the mark is used for over

⁴⁸ Rule 24(7)(a), found at www.wipo.int/madrid/en/legal_texts/pdf/common_regulations_04.pdf (entered into force April 1, 2004).

⁴⁹ Council Regulation (EC) No. 1992/2003 of 27 October 2003 amending Regulation (EC) No. 40/94 on the Community trade mark to give effect to the accession of the European Community to the Protocol relating to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989, found at http://oami.eu.int/EN/mark/aspects/pdf/madrid_basicreg.pdf.

⁵⁰ *Id.*, new Article 149 (took effect April 1, 2004).

10 years and needs to be renewed.) There are strict time limits for national trademark office examination, so registration may be faster. And trademark owners can base their international registrations on trademark applications, enabling them to take advantage of Paris Convention priority.

Filing under the Madrid Protocol could be a good choice where the trademark is intended for global use, will only be used in one language, and will not have to be amended. A mark owner should be confident that its basic application or registration will not meet serious objections over the first five years.

[b] – Disadvantages to the Madrid Protocol

Protocol filing is *not* recommended where there is a substantial possibility that the basic application or registration will fail (more likely in the United States). It is important for a U.S. trademark owner contemplating filing under the Madrid Protocol to evaluate the likelihood of central attack on its basic application or registration. It would be more advantageous to have the basic application or registration in a country where trademark applications are not examined, there is no use requirement, and there can be a broad claim of goods or services.

It is true that a mark owner need not employ foreign associates to file an international application. All one needs to do is check off the box for each desired designated country. However, this ease of filing may encourage applicants to forego seeking out the valuable advice of local counsel until there is an office action. And it is quite likely that the mark owner *will* need the advice of a foreign associate, in order to respond to an office action or to explain local prosecution or maintenance requirements.

Another disadvantage is the restriction on the ability to assign an international registration: The owner of an international registration can only assign it to a person or entity that would be entitled to file an international application at the time of the assignment. Another important limitation is that many countries are not members of the Protocol, and an international applicant cannot designate non-member countries for a request for extension of protection. Canada and Latin America, for example, are not members of the Madrid System.

Where a trademark owner wishes to use its mark in local languages in different countries, the Madrid Protocol is also not the proper filing mechanism because the trademark must be identical throughout all of the extensions of protection. In addition, the owner of an international registration cannot amend the mark in that registration, which can be a serious issue when filing the mark in a product area where logos often change. Nor can Madrid Protocol extensions of protection include goods and services that are not covered by the basic registration.

There are some disadvantages that are specifically related to U.S. practice. The international registration will be limited if a U.S. application or registration is used as the basic mark because the USPTO requires a much narrower specification of goods and services than most Protocol member countries. Similarly, an extension of protection to the United States must also be limited to specific goods or services.

Because United States examination is so strict, there is a greater likelihood that an international registration based on a U.S. basic application or registration will fail, and thus that all of the extensions of protection will fail. There is no benefit to filing under the Madrid Protocol if the United States basic application is refused or successfully opposed or if the United States basic registration is cancelled during the first five years. And the process of transforming extensions of protection into individual national applications is expensive, involving the payment of new filing fees and the hiring of foreign associates.

Finally, the United States will not register an extension of protection that could only be registered on the Supplemental Register,⁵¹ making it of more limited appeal.

[c] – Madrid Protocol vs. Community Trade Mark

The Community Trade Mark system is a centralized *registration* system where one can obtain a single registration instead of separate national registrations for all European Union countries. In contrast, the Madrid Protocol is a centralized *filing* system for obtaining and maintaining separate national trademark registrations in any or all of the countries party to the Protocol. Here are some other differences:

⁵¹ 37 C.F.R. § 2.47(c).

Under the Community Trade Mark system, a successful application can result in registration throughout the EU and one infringement action in any EU jurisdiction can lead to an injunction across the EU. In 2004, a trademark owner should be able to register throughout the EU using the Madrid Protocol system, in addition to being able to file nationally or file for a CTM. Until then, however, a trademark owner cannot use "central attack" and will have to file separate infringement actions in each member state to protect its national European extensions of protection.

A CTM applicant may file for whatever goods or services it chooses, though a Madrid Protocol applicant is limited to the goods or services in its basic application or registration. However, a filing obstacle in any one EU country can prevent the mark owner from obtaining a Community Trade Mark and under the Protocol, an applicant can designate all EU member states, if desired, except those in which there is a filing obstacle.

For United States trademark owners, filing for a CTM requires the presence of a foreign agent whereas filing an international application under the Madrid Protocol does not, at least not until there is an office action.

[d] – Madrid Protocol vs. National Applications

When filing individual national applications, one must file a separate application in each country in the local language, as well as pay a fee in the currency of that country. The help of a foreign associate is required to file the application. The mark owner must file renewals in each country with various currencies, and the same with changes of address and assignments.

In contrast, Madrid Protocol applications require only one application and one fee in one currency even for several registrations. The mark owner only needs to file one form for renewal, changes of address and assignment recordation, and the forms may be in English, French or Spanish, depending upon the policy of the local trademark office.

Despite those advantages of the Protocol, with a national application, it is possible to amend a trademark application in many countries, unlike under the Protocol. And the holder of the international registration must still continue to monitor its extensions of protection and maintain them. For example, in the United States, one must file affidavits of use or

excusable nonuse at the appropriate times for extensions of protection.⁵² Trademark owners must therefore still docket national extensions of protection through the Protocol. Madrid Protocol extensions of protection are renewed through WIPO.

It is questionable whether the processing time to registration under the Madrid Protocol really is shorter than that for national applications. Examination time under the Protocol is limited to 18 months at the most, but local opposition proceedings can delay registration significantly. In the United States, for example, even if an opposition is filed within the required 180 days of publication, the opposition proceeding can potentially continue for years.

V Conclusion

The Madrid Protocol Superhero is here among us, at last, ready to swing into action. As she becomes better known, her popularity should grow by leaps and bounds. Trademark owners should get to know the Superhero. With her strengths and even her limitations, she will become a strong if not all-powerful ally in the protection of trademarks, worldwide.

⁵² See 15 U.S.C. § 1141k.

APPENDIX A

Members of the Madrid Union (February 2004)

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5. Madrid Agreement Concerning the International Registration of Marks

Madrid Agreement (Marks) (1891), revised at Brussels (1900), Washington (1911),
The Hague (1925), London (1934), Nice (1957) and Stockholm (1967), and amended in 1979

and

Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

Madrid Protocol (1989)

(Madrid Union)¹

Status on February 1, 2004

State	Date on which State became party to the Madrid Agreement ²	Date on which State became party to the Madrid Protocol (1989)
Albania.....	October 4, 1995	July 30, 2003
Algeria.....	July 5, 1972	—
Antigua and Barbuda.....	—	March 17, 2000
Armenia.....	December 25, 1991	October 19, 2000 ^{6,10}
Australia.....	—	July 11, 2001 ^{5,6}
Austria.....	January 1, 1909	April 13, 1999
Azerbaijan.....	December 25, 1995	—
Belarus.....	December 25, 1991	January 18, 2002 ^{6,10}
Belgium.....	July 15, 1892 ³	April 1, 1998 ^{3,6}
Bhutan.....	August 4, 2000	August 4, 2000
Bosnia and Herzegovina.....	March 1, 1992	—
Bulgaria.....	August 1, 1985	October 2, 2001 ^{6,10}
China.....	October 4, 1989 ⁴	December 1, 1995 ^{4,5,6}
Croatia.....	October 8, 1991	January 23, 2004
Cuba.....	December 6, 1989	December 26, 1995
Cyprus.....	November 4, 2003	November 4, 2003
Czech Republic.....	January 1, 1993	September 25, 1996
Democratic People's Republic of Korea.....	June 10, 1980	October 3, 1996
Denmark.....	—	February 13, 1996 ^{5,6,7}
Egypt.....	July 1, 1952	—
Estonia.....	—	November 18, 1998 ^{5,6,9}
Finland.....	—	April 1, 1996 ^{5,6}
France.....	July 15, 1892 ⁸	November 7, 1997 ⁸
Georgia.....	—	August 20, 1998 ^{6,10}
Germany.....	December 1, 1922	March 20, 1996
Greece.....	—	August 10, 2000 ^{6,10}
Hungary.....	January 1, 1909	October 3, 1997
Iceland.....	—	April 15, 1997 ^{6,10}
Iran (Islamic Republic of).....	December 25, 2003	December 25, 2003
Ireland.....	—	October 19, 2001 ^{5,6}
Italy.....	October 15, 1894	April 17, 2000 ^{5,6}
Japan.....	—	March 14, 2000 ^{6,10}
Kazakhstan.....	December 25, 1991	—
Kenya.....	June 26, 1998	June 26, 1998 ⁵
Kyrgyzstan.....	December 25, 1991	—
Latvia.....	January 1, 1995	January 5, 2000
Lesotho.....	February 12, 1999	February 12, 1999
Liberia.....	December 25, 1995	—
Liechtenstein.....	July 14, 1933	March 17, 1998
Lithuania.....	—	November 15, 1997 ⁵
Luxembourg.....	September 1, 1924 ³	April 1, 1998 ^{3,6}
Monaco.....	April 29, 1956	September 27, 1996
Mongolia.....	April 21, 1985	June 16, 2001
Morocco.....	July 30, 1917	October 8, 1999
Mozambique.....	October 7, 1998	October 7, 1998
Netherlands.....	March 1, 1893 ^{3,11}	April 1, 1998 ^{3,6,11}
Norway.....	—	March 29, 1996 ^{5,6}
Poland.....	March 18, 1991	March 4, 1997 ¹⁰
Portugal.....	October 31, 1893	March 20, 1997

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State	Date on which State became party to the Madrid Agreement ²	Date on which State became party to the Madrid Protocol (1989)
Republic of Korea	—	April 10, 2003 ^{5,6}
Republic of Moldova.....	December 25, 1991	December 1, 1997 ⁶
Romania	October 6, 1920	July 28, 1998
Russian Federation	July 1, 1976 ¹²	June 10, 1997
San Marino.....	September 25, 1960	—
Serbia and Montenegro.....	April 27, 1992	February 17, 1998
Sierra Leone.....	June 17, 1997	December 28, 1999
Singapore.....	—	October 31, 2000 ^{5,6}
Slovakia.....	January 1, 1993	September 13, 1997 ¹⁰
Slovenia.....	June 25, 1991	March 12, 1998
Spain	July 15, 1892	December 1, 1995
Sudan	May 16, 1984	—
Swaziland.....	December 14, 1998	December 14, 1998
Sweden	—	December 1, 1995 ^{5,6}
Switzerland.....	July 15, 1892	May 1, 1997 ^{6,10}
Tajikistan	December 25, 1991	—
The former Yugoslav Republic of Macedonia	September 8, 1991	August 30, 2002
Turkey.....	—	January 1, 1999 ^{9,10}
Turkmenistan.....	—	September 28, 1999 ^{6,10}
Ukraine.....	December 25, 1991	December 29, 2000 ^{5,6}
United Kingdom	—	December 1, 1995 ^{5,6,13}
United States of America	—	November 2, 2003 ^{5,6}
Uzbekistan.....	December 25, 1991	—
Viet Nam.....	March 8, 1949	—
Zambia	—	November 15, 2001
(Total: 74 States)	(54)	(62)

¹ The Madrid Union is composed of the States party to the Madrid Agreement and the Contracting Parties to the Madrid Protocol.

² All the States party to the Madrid Agreement have declared, under Article 3bis of the Nice or Stockholm Act, that the protection arising from international registration shall not extend to them unless the proprietor of the mark so requests.

³ The territories of Belgium, Luxembourg and the Kingdom of the Netherlands in Europe are to be deemed a single country, for the application of the Madrid Agreement as from January 1, 1971, and for the application of the Protocol as from April 1, 1998.

⁴ Not applicable to either the Hong Kong Special Administrative Region or the Macau Special Administrative Region.

⁵ In accordance with Article 5(2)(b) and (c) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months and that, where a refusal of protection results from an opposition to the granting of protection, such refusal may be notified after the expiry of the 18-month time limit.

⁶ In accordance with Article 8(7)(a) of the Protocol, this Contracting Party has declared that, in connection with each request for territorial extension to it of the protection of an international registration and the renewal of any such international registration, it wants to receive, instead of a share in the revenue produced by the supplementary and complementary fee, an individual fee. As regards the Kingdom of the Netherlands, such a declaration was made only in respect of the Kingdom in Europe, not in respect of the Netherlands Antilles.

⁷ Not applicable to the Faroe Islands and to Greenland.

⁸ Including all Overseas Departments and Territories.

⁹ In accordance with Article 14(5) of the Protocol, this Contracting Party has declared that the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it.

¹⁰ In accordance with Article 5(2)(b) of the Protocol, this Contracting Party has declared that the time limit to notify a refusal of protection shall be 18 months.

¹¹ The instrument of ratification of the Stockholm Act and the instrument of acceptance of the Protocol were deposited for the Kingdom in Europe. The Netherlands extended the application of the Madrid Protocol to the Netherlands Antilles with effect from April 28, 2003.

¹² Date of accession by the Soviet Union, continued by the Russian Federation as from December 25, 1991.

¹³ Ratification in respect of the United Kingdom and the Isle of Man.

APPENDIX B

37 C.F.R. Part 7

Rules of Practice in Filings Pursuant to the Protocol
Relating to the Madrid Agreement
Concerning the International Registration of Marks

SUBPART A -- GENERAL INFORMATION**§ 7.1 Definitions of terms as used in this part.**

- (a) *The Act* means the Trademark Act of 1946, 60 Stat. 427, as amended, codified in 15 U.S.C. § 1051 *et seq.*
- (b) *Subsequent designation* means a request for extension of protection of an international registration to a Contracting Party made after the International Bureau registers the mark.
- (c) The acronym *TEAS* means the Trademark Electronic Application System available on-line through the Office's web site at: **www.uspto.gov**.
- (d) The term *Office* means the United States Patent and Trademark Office.
- (e) All references to sections in this part refer to 37 Code of Federal Regulations, except as otherwise stated.

§ 7.2 [Reserved]**§ 7.3 Correspondence must be in English.**

International applications and registrations, requests for extension of protection and all other related correspondence with the Office must be in English. The Office will not process correspondence that is in a language other than English.

§ 7.4 Receipt of correspondence.

Correspondence relating to international applications and registrations and requests for extension of protection submitted through TEAS will be accorded the date and time on which the complete transmission is received in the Office based on Eastern Time. Eastern Time means eastern standard time or eastern daylight time, as appropriate.

§ 7.5 [Reserved]**§ 7.6 Schedule of U.S. process fees.**

- (a) The Office requires the following process fees:
- (1) For certifying an international application based on a single basic application or registration, per class — \$100.00
 - (2) For certifying an international application based on more than one basic application or registration, per class — \$150.00
 - (3) For transmitting a subsequent designation under § 7.21 — \$100.00

- (4) For transmitting a request to record an assignment or restriction, or release of a restriction, under § 7.23 or § 7.24 — \$100.00
 - (5) For filing a notice of replacement under § 7.28, per class — \$100.00
 - (6) For filing an affidavit under § 71 of the Act, per class — \$100.00
 - (7) Surcharge for filing an affidavit under § 71 of the Act during the grace period, per class — \$100.00
- (b) The fees required in paragraph (a) of this section must be paid in U.S. dollars at the time of submission of the requested action. *See* § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.

§ 7.7 Payments of fees to International Bureau.

- (a) The following fees may be paid either directly to the International Bureau or through the Office:
- (1) International application fees;
 - (2) Subsequent designation fees; and
 - (3) Recording fee for an assignment of an international registration under § 7.23.
- (b) The fees in paragraph (a) of this section may be paid as follows:
- (1) (i) Directly to the International Bureau by debit to a current account with the International Bureau. In this case, an applicant or holder's submission to the Office must include the International Bureau account number; or
 - (ii) Directly to the International Bureau using any other acceptable method of payment. In this case, an applicant

or holder's submission to the Office must include the International Bureau receipt number for payment of the fees; or

- (2) Through the Office. Fees paid through the Office must be paid in U.S. dollars at the time of submission. *See* § 2.207 of this chapter for acceptable forms of payment and § 2.208 of this chapter for payments using a deposit account established in the Office.
- (c) The International Bureau fee calculator may be viewed on the web site of the World Intellectual Property Organization, currently available at: <http://www.wipo.int/madrid/en/>.

SUBPART B — INTERNATIONAL APPLICATION ORIGINATING FROM THE UNITED STATES

§ 7.11 Requirements for international application originating from the United States.

- (a) The Office will grant a date of receipt to an international application that is submitted through TEAS and contains all of the following:
 - (1) The filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;
 - (2) The name of the international applicant that is identical to the name of the applicant or registrant as it appears in the basic application or basic registration and applicant's current address;
 - (3) A reproduction of the mark that is the same as the mark in the basic application and/or registration and meets the requirements of § 2.52 of this chapter. If the mark in the basic application and/or registration is depicted in black and white and the basic application or registration does not include a color claim, the

reproduction of the mark in the international application must be black and white. If the mark in the basic application or registration is depicted in black and white and includes a color claim, the international application must include both a black and white reproduction of the mark **and** a color reproduction of the mark. If the mark in the basic application and/or registration is depicted in color, the reproduction of the mark in the international application must be in color;

- (4) A color claim as set out in § 7.12, if appropriate;
- (5) A description of the mark that is the same as the description of the mark in the basic application or registration, as appropriate;
- (6) An indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;
- (7) A list of the goods and/or services that is identical to or narrower than the list of goods and/or services in each claimed basic application or registration and classified according to the *Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks*;
- (8) A list of the designated Contracting Parties. If the goods and/or services in the international application are not the same for each designated Contracting Party, the application must list the goods and/or services in the international application that pertain to each designated Contracting Party;
- (9) The certification fee required by § 7.6, the international application fees for all classes, and the fees for all designated Contracting Parties identified in the international application (*see* § 7.7);
- (10) A statement that the applicant is entitled to file an international application in the Office, specifying that applicant: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in

the United States. Where an applicant's address is not in the United States, the applicant must provide the address of its U.S. domicile or establishment; and

(11) An e-mail address for receipt of correspondence from the Office.

(b) For requirements for certification, *see* § 7.13.

§ 7.12 Claim of color.

- (a) If color is claimed as a feature of the mark in the basic application and/or registration, the international application must include a statement that color is claimed as a feature of the mark and set forth the same name(s) of the color(s) claimed in the basic application and/or registration.
- (b) If color is not claimed as a feature of the mark in the basic application and/or registration, color may not be claimed as a feature of the mark in the international application.

§ 7.13 Certification of international application.

- (a) When an international application contains all the elements set forth in § 7.11(a), the Office will certify to the International Bureau that the information contained in the international application corresponds to the information contained in the basic application(s) and/or basic registration(s) at the time of certification, and will then forward the international application to the International Bureau.
- (b) When an international application does not meet the requirements of § 7.11(a), the Office will not certify or forward the international application. If the international applicant paid the international application fees (*see* § 7.7) through the Office, the Office will refund the international fees. The Office will not refund the certification fee.

§ 7.14 Correcting irregularities in international application.

- (a) *Response period.* Upon receipt of a notice of irregularities in an international application from the International Bureau, the applicant must respond to the International Bureau within the period set forth in the notice.
- (b) *Classification and Identification of Goods and Services.* Responses to International Bureau notices of irregularities in the classification or identification of goods or services in an international application must be submitted through the Office for forwarding to the International Bureau. The Office will review an applicant's response to a notice of irregularities in the identification of goods or services to ensure that the response does not identify goods or services that are broader than the scope of the goods or services in the basic application or registration.
- (c) *Fees.* If the International Bureau notice of irregularities requires the payment of fees, the fees for correcting irregularities in the international application must be paid directly to the International Bureau.
- (d) *Other Irregularities Requiring Response from Applicant.* Except for responses to irregularities mentioned in paragraph (b) of this section and payment of fees for correcting irregularities mentioned in paragraph (c) of this section, all other responses may be submitted through the Office in accordance with § 7.14(e), or filed directly at the International Bureau. The Office will forward timely responses to the International Bureau, but will not review the responses or respond to any irregularities on behalf of the international applicant.
- (e) *Procedure for response.* An international applicant submitting a response to the International Bureau through the Office must use TEAS. To be considered timely, a response must be received by the International Bureau before the end of the response period set forth in the International Bureau notice. Receipt in the Office does not fulfill this requirement. Any response submitted through the Office for forwarding to the International Bureau should be submitted as soon

as possible, but at least one month before the end of the response period in the International Bureau's notice. The Office will not process any response submitted to the Office after the IB response deadline.

SUBPART C — SUBSEQUENT DESIGNATION SUBMITTED THROUGH THE OFFICE

§ 7.21 Subsequent designation.

- (a) A subsequent designation may be filed directly with the International Bureau, or, if it meets the requirements of paragraph (b) of this section, submitted through the Office.
- (b) The date of receipt in the Office of a subsequent designation is the date that the subsequent designation is submitted through TEAS, if it contains all of the following:
 - (1) The international registration number;
 - (2) The serial number of the U.S. application or registration number of the U.S. registration that formed the basis of the international registration;
 - (3) The name and address of the holder of the international registration;
 - (4) A statement that the holder is entitled to file a subsequent designation in the Office, specifying that holder: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where a holder's address is not in the United States, the holder must provide the address of its U.S. domicile or establishment;

- (5) A list of goods and/or services that is identical to or narrower than the list of goods and/or services in the international registration;
 - (6) A list of the designated Contracting Parties. If the goods and/or services in the subsequent designation are not the same for each designated Contracting Party, the holder must list the goods and/or services covered by the subsequent designation that pertain to each designated Contracting Party;
 - (7) The U.S. transmittal fee required by § 7.6 and the subsequent designation fees (*see* § 7.7); and
 - (8) An e-mail address for receipt of correspondence from the Office.
- (c) If the subsequent designation is accorded a date of receipt, the Office will then forward the subsequent designation to the International Bureau.
- (d) If the subsequent designation fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the subsequent designation to the International Bureau. The Office will notify the holder of the reason(s). If the holder paid the subsequent designation fees (*see* § 7.7) through the Office, the Office will refund the subsequent designation fees. The Office will not refund the transmittal fee.
- (e) Correspondence to correct any irregularities in a subsequent designation must be made directly with the International Bureau.

SUBPART D — RECORDING CHANGES TO INTERNATIONAL REGISTRATION

§ 7.22 Recording changes to international registration.

Except as provided in §§ 7.23 and 7.24, requests to record changes to an international registration must be filed with the International Bureau. If a request to record an assignment or restriction of a holder's right of disposal of an international registration or the release of such a restriction meets the requirements of § 7.23 or 7.24, the Office will forward the request to the International Bureau. Section 10 of the Act and part 3 of this chapter are not applicable to assignments or restrictions of international registrations.

§ 7.23 Requests for recording assignments at the International Bureau.

A request to record an assignment of an international registration may be submitted through the Office for forwarding to the International Bureau only if the assignee cannot obtain the assignor's signature for the request to record the assignment.

- (a) A request to record an assignment submitted through the Office must include all of the following:
 - (1) The international registration number;
 - (2) The name and address of the holder of the international registration;
 - (3) The name and address of the assignee of the international registration;
 - (4) A statement that the assignee: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial establishment in the United States. Where an assignee's address is not in the United States, the

assignee must provide the address of its U.S. domicile or establishment;

- (5) A statement that the assignee could not obtain the assignor's signature for the request to record the assignment;
 - (6) An indication that the assignment applies to the designation to the United States;
 - (7) A statement that the assignment applies to all the goods and/or services in the international registration, or if less, a list of the goods and/or services in the international registration that have been assigned that pertain to the designation to the United States; and
 - (8) The U.S. transmittal fee required by § 7.6 and the international fee required to record the assignment (*see* § 7.7).
- (b) If a request to record an assignment contains all the elements set forth in paragraph (a) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the assignment or the effect that the assignment has on the title of the international registration.
- (c) If the request fails to contain all the elements set forth in paragraph (a) of this section, the Office will not forward the request to the International Bureau. The Office will notify the assignee(s) of the reason(s). If the assignee paid the fees to record the assignment (*see* § 7.7) through the Office, the Office will refund the recording fee. The Office will not refund the transmittal fee.
- (d) Correspondence to correct any irregularities in a request to record an assignment must be made directly with the International Bureau.

§ 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

- (a) A party who obtained a security interest or other restriction of a holder's right to dispose of an international registration, or the release of such a restriction, may submit a request to record the restriction or release through the Office for forwarding to the International Bureau only if:
- (1) the restriction or release
 - (i) is the result of a court order; or
 - (ii) is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, and the signature of the holder cannot be obtained for the request to record the restriction or release;
 - (2) the party who obtained the restriction is a national of, is domiciled in, or has a real and effective industrial or commercial establishment in the United States; and
 - (3) the restriction or release applies to the holder's right to dispose of the international registration in the United States.
- (b) A request to record a restriction or the release of a restriction must be submitted by the party who obtained the restriction of the holder's right of disposal and include all the following:
- (1) The international registration number;
 - (2) The name and address of the holder of the international registration;
 - (3) The name and address of the party who obtained the restriction;
 - (4) A statement that the party who submitted the request: is a national of the United States; has a domicile in the United States; or has a real and effective industrial or commercial

establishment in the United States. Where a party's address is not in the United States, the party must provide the address of its U.S. domicile or establishment;

- (5) (i) A statement that the restriction is the result of a court order, or
 - (ii) where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a statement that the signature of the holder of the international registration could not be obtained for the request to record the restriction or release of the restriction;
- (6) A summary of the main facts concerning the restriction;
 - (7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States; and
 - (8) The U.S. transmittal fee required by § 7.6.
- (c) If a request to record a restriction, or the release of a restriction, contains all the elements set forth in paragraph (b) of this section, the Office will forward the request to the International Bureau. Forwarding the request to the International Bureau is not a determination by the Office of the validity of the restriction, or its release, or the effect that the restriction has on the holder's right to dispose of the international registration.
 - (d) If the request fails to contain all the elements set forth in paragraph (b) of this section, the Office will not forward the request. The Office will notify the party who submitted the request of the reason(s). The Office will not refund the transmittal fee.
 - (e) Correspondence to correct any irregularities in a request to record a restriction of a holder's right to dispose of an international registration or the release of such a restriction must be made directly with the International Bureau.

SUBPART E — EXTENSION OF PROTECTION TO THE UNITED STATES

§ 7.25 Sections of part 2 applicable to extension of protection.

- (a) Except for §§ 2.130-2.131, 2.160-2.166, 2.168, 2.172, 2.173, 2.175, and 2.181-2.186, all sections in part 2 and all sections of part 10 of this chapter apply to a request for extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless stated otherwise.
- (b) The Office will refer to a request for an extension of protection to the United States as an application under section 66(a) of the Act, and references to applications and registrations in part 2 of this chapter include extensions of protection to the United States.
- (c) Upon registration in the United States under section 69 of the Act, an extension of protection to the United States is referred to as a registration, a registered extension of protection, or a section 66(a) registration.

[Added 68 FR 55748, Sep't 26, 2003, effective Nov. 2, 2003]

§ 7.26 Filing date of extension of protection for purposes of examination in the Office.

- (a) If a request for extension of protection of an international registration to the United States is made in an international application and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e) of this chapter, the filing date of the extension of protection to the United States is the international registration date.

- (b) If a request for extension of protection of an international registration to the United States is made in a subsequent designation and the request includes a declaration of a bona fide intention to use the mark in commerce as set out in § 2.33(e), the filing date of the extension of protection to the United States is the date that the International Bureau records the subsequent designation.

§ 7.27 Priority claim of extension of protection for purposes of examination in the Office.

An extension of protection of an international registration to the United States is entitled to a claim of priority under section 67 of the Act if:

- (a) The request for extension of protection contains a claim of priority;
- (b) The request for extension of protection specifies the filing date, serial number and the country of the application that forms the basis for the claim of priority; and
- (c) The date of the international registration or the date of recording of the subsequent designation at the International Bureau of the request for extension of protection to the United States is not later than six months after the filing date of the application that forms the basis for the claim of priority.

§ 7.28 Replacement of U.S. registration by registered extension of protection.

- (a) A registered extension of protection affords the same rights as those afforded to a previously issued U.S. registration if:
 - (1) Both registrations are owned by the same person and identify the same mark; and
 - (2) All the goods and/or services listed in the U.S. registration are also listed in the registered extension of protection.

- (b) The holder of an international registration with a registered extension of protection to the United States that meets the requirements of paragraph (a) of this section may file a request to note replacement of the U.S. registration with the extension of protection. If the request contains all of the following, the Office will take note of the replacement in its automated records:
- (1) The serial number or registration number of the extension of protection;
 - (2) The registration number of the replaced U.S. registration; and
 - (3) The fee required by § 7.6.
- (c) If the request to note replacement is denied, the Office will notify the holder of the reason(s) for refusal.

§ 7.29 Effect of replacement on U.S. registration.

A U.S. registration that has been replaced by a registered extension of protection under section 74 of the Act and § 7.28 will remain in force, unless cancelled, expired or surrendered, as long as:

- (a) The owner of the replaced U.S. registration continues to file affidavits or declarations of use in commerce or excusable nonuse under section 8 of the Act; and
- (b) The replaced U.S. registration is renewed under section 9 of the Act.

§ 7.30 Effect of cancellation or expiration of international registration.

When the International Bureau notifies the Office of the cancellation or expiration of an international registration, in whole or in part, the Office shall cancel, in whole or in part, the corresponding pending or registered extension of protection to the United States. The date of cancellation of an

extension of protection or relevant part shall be the date of cancellation or expiration of the corresponding international registration or relevant part.

§ 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

If the International Bureau cancels an international registration in whole or in part, under Article 6(4) of the Madrid Protocol, the holder of that international registration may file a request to transform the corresponding pending or registered extension of protection to the United States into an application under section 1 or 44 of the Act.

- (a) The holder of the international registration must file a request for transformation through TEAS within three months of the date of cancellation of the international registration and include:
 - (1) The serial number or registration number of the extension of protection to the United States;
 - (2) The name and address of the holder of the international registration;
 - (3) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and
 - (4) An e-mail address for receipt of correspondence from the Office.
- (b) If the request for transformation contains all the elements set forth in paragraph (a) of this section, the extension of protection shall be transformed into an application under section 1 and/or 44 of the Act and accorded the same filing date and the same priority that was accorded to the extension of protection.
- (c) The application under section 1 and/or 44 of the Act that results from a transformed extension of protection will be examined under part 2 of this chapter.

- (d) A request for transformation that fails to contain all the elements set forth in paragraph (a) of this section will not be accepted.

SUBPART F — AFFIDAVIT UNDER SECTION 71 OF THE ACT FOR EXTENSION OF PROTECTION TO THE UNITED STATES

§ 7.36 Affidavit or declaration of use in commerce or excusable nonuse required to avoid cancellation of an extension of protection to the United States.

- (a) Subject to the provisions of section 71 of the Act, a registered extension of protection shall remain in force for the term of the international registration upon which it is based unless the international registration expires or is cancelled under section 70 of the Act due to cancellation of the international registration by the International Bureau.
- (b) During the following time periods, the holder of an international registration must file an affidavit or declaration of use or excusable nonuse, or the registered extension of protection will be cancelled under section 71 of the Act:
 - (1) On or after the fifth anniversary and no later than the sixth anniversary after the date of registration in the United States; and
 - (2) Within the six-month period preceding the end of each ten-year period after the date of registration in the United States, or the three-month grace period immediately following, with payment of the grace period surcharge required by section 71(a)(2)(B) of the Act and § 7.6.

§ 7.37 Requirements for a complete affidavit or declaration of use in commerce or excusable nonuse.

A complete affidavit or declaration under section 71 of the Act must:

- (a) Be filed by the holder of the international registration within the period set forth in § 7.36(b);
- (b) Include a statement that is signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter by a person properly authorized to sign on behalf of the holder, attesting to the use in commerce or excusable nonuse of the mark within the period set forth in section 71 of the Act. The verified statement must be executed on or after the beginning of the filing period specified in § 7.36(b). A person who is properly authorized to sign on behalf of the holder is:
 - (1) A person with legal authority to bind the holder; or
 - (2) A person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the holder; or
 - (3) An attorney as defined in § 10.1(c) of this chapter who has an actual written or verbal power of attorney or an implied power of attorney from the holder.
- (c) Include the U.S. registration number;
- (d)
 - (1) Include the fee required by § 7.6 for each class of goods or services that the affidavit or declaration covers;
 - (2) If the affidavit or declaration is filed during the grace period under section 71(a)(2)(B) of the Act, include the grace period surcharge per class required by § 7.6;
 - (3) If at least one fee is submitted for a multi-class registration, but the class(es) to which the fee(s) should be applied are not specified, the Office will issue a notice requiring either the submission of additional fee(s) or an indication of the class(es) to which the original fee(s) should be applied. If the required fee(s) are not submitted within the time period set out in the

Office action and the class(es) to which the original fee(s) should be applied are not specified, the Office will presume that the fee(s) cover the classes in ascending order, beginning with the lowest numbered class;

- (e) (1) Specify the goods or services for which the mark is in use in commerce, and/or the goods or services for which excusable nonuse is claimed under § 7.37(f)(2);
- (2) Specify the goods or services being deleted from the registration, if the affidavit or declaration covers less than all the goods or services or less than all the classes in the registration;
- (f) (1) State that the registered mark is in use in commerce on or in connection with the goods or services in the registration; or
- (2) If the registered mark is not in use in commerce on or in connection with all the goods or services in the registration, set forth the date when use of the mark in commerce stopped and the approximate date when use is expected to resume and recite facts to show that nonuse as to those goods or services is due to special circumstances that excuse the nonuse and is not due to an intention to abandon the mark; and
- (g) Include a specimen showing current use of the mark for each class of goods or services, unless excusable nonuse is claimed under § 7.37(f)(2). The specimen must meet the requirements of § 2.56 of this chapter.

§ 7.38 Notice to holder of extension of protection.

The registration certificate for an extension of protection to the United States includes a notice of the requirement for filing the affidavit or declaration of use or excusable nonuse under section 71 of the Act. However, the affidavit or declaration must be filed within the time period required by section 71 of the Act regardless of whether this notice is received.

§ 7.39 Acknowledgment of receipt of affidavit or declaration of use in commerce or excusable nonuse.

- (a) The Office will issue a notice that states an affidavit or declaration of use in commerce or excusable nonuse is acceptable or if the affidavit or declaration is refused, an Office action that states the reason(s) for refusal.
- (b) A response to a refusal under paragraph (a) of this section must be filed within six months of the mailing date of the Office action, or before the end of the filing period set forth in section 71(a) of the Act, whichever is later. The Office will cancel the extension of protection if no response is filed within this time period.

§ 7.40 Petition to Director to review refusal.

- (a) A response to the examiner's initial refusal to accept an affidavit or declaration is required before filing a petition to the Director, unless the examiner directs otherwise. *See* § 7.39(b) for the deadline for responding to an examiner's Office action.
- (b) If the examiner maintains the refusal of the affidavit or declaration, the holder may file a petition to the Director to review the examiner's action. The petition must be filed within six months of the mailing date of the action maintaining the refusal, or the Office will cancel the registration.
- (c) A decision by the Director is necessary before filing an appeal or commencing a civil action in any court.

**SUBPART G — RENEWAL OF INTERNATIONAL
REGISTRATION AND EXTENSION OF PROTECTION****§ 7.41 Renewal of international registration and extension of
protection.**

- (a) Any request to renew an international registration and its extension of protection to the United States must be made at the International Bureau in accordance with Article 7 of the Madrid Protocol.
- (b) A request to renew an international registration or extension of protection to the United States submitted through the Office will not be processed.

APPENDIX C

Official Form for Application for International Registration
Governed Exclusively by the Madrid Protocol (Form MM2)

MM2(E)

MADRID AGREEMENT AND PROTOCOL CONCERNING THE
INTERNATIONAL REGISTRATION OF MARKS

APPLICATION FOR INTERNATIONAL REGISTRATION
GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

(Rule 9 of the Common Regulations)



World Intellectual Property Organization
34, chemin des Colombettes, P.O. Box 18,
1211 Geneva 20, Switzerland
Tel.: (41-22) 338 9111
Fax (International Trademark Registry): (41-22) 740 1429
e-mail: intreg.mail@wipo.int – Internet: <http://www.wipo.int>

MM2(E)

APPLICATION FOR INTERNATIONAL REGISTRATION
GOVERNED EXCLUSIVELY BY THE MADRID PROTOCOL

<p><u>For use by the applicant</u></p> <p>This request contains the following number of continuation sheets:</p>	<p><u>For use by the applicant/Office</u></p> <p>Applicant's reference:</p> <p>Office's reference:</p>
--	--

1 CONTRACTING PARTY WHOSE OFFICE IS THE OFFICE OF ORIGIN
.....

2 APPLICANT

(a) Name:

(b) Address:

(c) Address for correspondence:

(d) Telephone : Fax:

E-mail address:

(e) Preferred language for correspondence: English French

(f) Other indications (as may be required by certain designated Contracting Parties):

(i) if the applicant is a natural person, nationality of applicant:

(ii) if the applicant is a legal entity:

- legal nature of the legal entity:

- State and, where applicable, territorial unit within that State, under the law of which the legal entity is organized:

3 ENTITLEMENT TO FILE

(a) Check the appropriate box(es):

(i) where the Contracting Party mentioned in item 1 is a State, the applicant is a national of that State; or

(ii) where the Contracting Party mentioned in item 1 is an organization, the name of the State of which the applicant is a national:; or

(iii) the applicant is domiciled in the territory of the Contracting Party mentioned in item 1; or

(iv) the applicant has a real and effective industrial or commercial establishment in the territory of the Contracting Party mentioned in item 1.

(b) Where the address of the applicant, given in item 2(b), is not in the territory of the Contracting Party mentioned in item 1, indicate in the space provided below:

(i) if the box in paragraph (a)(iii) of the present item has been checked, the domicile of the applicant in the territory of that Contracting Party, or,

(ii) if the box in paragraph (a)(iv) of the present item has been checked, the address of the applicant's industrial or commercial establishment in the territory of that Contracting Party.

.....

.....

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4 APPOINTMENT OF A REPRESENTATIVE (if any)

Name:

Address:

Telephone: Fax:

E-mail address:

5 BASIC APPLICATION OR BASIC REGISTRATION

Basic application number: Date of the basic application: (dd/mm/yyyy)

Basic registration number: Date of the basic registration: (dd/mm/yyyy)

6 PRIORITY CLAIMED

The applicant claims the priority of the earlier filing mentioned below:

Office of earlier filing:

Number of earlier filing (if available):

Date of earlier filing: (dd/mm/yyyy)

If the earlier filing does not relate to all the goods and services listed in item 10 of this form, indicate in the space provided below the goods and services to which it does relate:

.....

If several priorities are claimed, check box and use a continuation sheet giving the above required information for each priority claimed.

7 THE MARK

(a) Place the reproduction of the mark, as it appears in the basic application or basic registration, in the square below.

(b) Where the reproduction in item (a) is in black and white and color is claimed in item 8, place a color reproduction of the mark in the square below.

(c) The applicant declares that he wishes the mark to be considered as a mark in standard characters.

(d) The mark consists of a color or a combination of colors as such.

Where the Office of origin has addressed this form by telefacsimile, the present space must be completed before addressing the original of this page to the International Bureau.

Number of basic application or registration or Office reference as shown on the first page of this form:

.....

Signature by the Office of origin:

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8

COLOR(S) CLAIMED

(a) The applicant claims color as a distinctive feature of the mark.

Color or combination of colors claimed:
.....
.....

(b) Indication, for each color, of the principal parts of the mark that are in that color (as may be required by certain designated Contracting Parties):

.....
.....
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9

MISCELLANEOUS INDICATIONS

(a) Transliteration of the mark (this information is compulsory where the mark consists of or contains matter in characters other than Latin characters, or numerals other than Arabic or Roman numerals):

.....
.....

(b) Translation of the mark (as may be required by certain designated Contracting Parties):

(i) into English:
.....
(ii) into French:
.....

(c) The words contained in the mark have no meaning (and therefore cannot be translated).

(d) Where applicable, check the relevant box or boxes below:

- Three-dimensional mark
- Sound mark
- Collective mark, certification mark, or guarantee mark

(e) Description of the mark (where applicable):

.....
.....

(f) Verbal elements of the mark (where applicable):

.....
.....

(g) The applicant declares that he wishes to disclaim protection for the following element(s) of the mark:

.....
.....
.....

11 DESIGNATED CONTRACTING PARTIES

Check the corresponding boxes:

- | | | | |
|--|---|---|---|
| <input type="checkbox"/> AG Antigua and Barbuda | <input type="checkbox"/> DK Denmark | <input type="checkbox"/> KE Kenya | <input type="checkbox"/> PL Poland |
| <input type="checkbox"/> AL Albania | <input type="checkbox"/> EE Estonia | <input type="checkbox"/> KP Democratic People's Republic of Korea | <input type="checkbox"/> PT Portugal |
| <input type="checkbox"/> AM Armenia | <input type="checkbox"/> ES Spain | <input type="checkbox"/> KR Republic of Korea | <input type="checkbox"/> RO Romania |
| <input type="checkbox"/> AN Netherlands Antilles | <input type="checkbox"/> FI Finland | <input type="checkbox"/> LI Liechtenstein | <input type="checkbox"/> RU Russian Federation |
| <input type="checkbox"/> AT Austria | <input type="checkbox"/> FR France | <input type="checkbox"/> LS Lesotho | <input type="checkbox"/> SE Sweden |
| <input type="checkbox"/> AU Australia | <input type="checkbox"/> GB United Kingdom ¹ | <input type="checkbox"/> LT Lithuania | <input type="checkbox"/> SG Singapore ¹ |
| <input type="checkbox"/> BG Bulgaria | <input type="checkbox"/> GE Georgia | <input type="checkbox"/> LV Latvia | <input type="checkbox"/> SI Slovenia |
| <input type="checkbox"/> BT Bhutan | <input type="checkbox"/> GR Greece | <input type="checkbox"/> MA Morocco | <input type="checkbox"/> SK Slovakia |
| <input type="checkbox"/> BX Benelux | <input type="checkbox"/> HR Croatia | <input type="checkbox"/> MC Monaco | <input type="checkbox"/> SL Sierra Leone |
| <input type="checkbox"/> BY Belarus | <input type="checkbox"/> HU Hungary | <input type="checkbox"/> MD Republic of Moldova | <input type="checkbox"/> SZ Swaziland |
| <input type="checkbox"/> CH Switzerland | <input type="checkbox"/> IE Ireland ¹ | <input type="checkbox"/> MK The former Yugoslav Rep. of Macedonia | <input type="checkbox"/> TM Turkmenistan |
| <input type="checkbox"/> CN China | <input type="checkbox"/> IR Iran (Islamic Republic of) | <input type="checkbox"/> MN Mongolia | <input type="checkbox"/> TR Turkey |
| <input type="checkbox"/> CU Cuba | <input type="checkbox"/> IS Iceland | <input type="checkbox"/> MZ Mozambique | <input type="checkbox"/> UA Ukraine |
| <input type="checkbox"/> CY Cyprus | <input type="checkbox"/> IT Italy | <input type="checkbox"/> NO Norway | <input type="checkbox"/> US United States of America ² |
| <input type="checkbox"/> CZ Czech Republic | <input type="checkbox"/> JP Japan | | <input type="checkbox"/> YU Serbia and Montenegro |
| <input type="checkbox"/> DE Germany | | | <input type="checkbox"/> ZM Zambia |

Others:

¹ By designating Ireland, Singapore or the United Kingdom, the applicant declares that he has the intention that the mark will be used by him or with his consent in that country in connection with the goods and services identified in this application.
² If the United States of America is designated, it is compulsory to annex to the present international application the official form (MM18) containing the declaration of intention to use the mark required by this Contracting Party.

12 SIGNATURE BY THE APPLICANT OR HIS REPRESENTATIVE
 (if required or allowed by the Office of origin)

..... (dd/mm/yyyy)

13 CERTIFICATION AND SIGNATURE OF THE INTERNATIONAL APPLICATION BY THE OFFICE OF ORIGIN

(a) Certification

The Office of origin certifies

- (i) that the request to present this application was received on (dd/mm/yyyy).
- (ii) that the applicant named in item 2 is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be, that any indication given in item 8(c), 9(d) or 9(c) appears also in the basic application or the basic registration, as the case may be, that the mark in item 7(a) is the same as in the basic application or the basic registration, as the case may be, that, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 without having been claimed in the basic application or basic registration, the mark in the basic application or basic registration is in fact in the color or combination of colors claimed, and that the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.

Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

(b) Office's signature:

Date of signature: (dd/mm/yyyy)

FEE CALCULATION SHEET

(a) INSTRUCTIONS TO DEBIT FROM A CURRENT ACCOUNT

The International Bureau is hereby instructed to debit the required amount of fees from a current account opened with the International Bureau (if this box is checked, it is not necessary to complete (b)).

Holder of the account: Account number:

Identity of the party giving the instructions:

(b) AMOUNT OF FEES; METHOD OF PAYMENT

Basic fee (653 Swiss francs if the reproduction of the mark is in black and white only; 903 Swiss francs if there is a reproduction in color)

Complementary and supplementary fees:

Number of designations for which complementary fee is applicable	Complementary fee	Total amount of the complementary fees
..... x	73 Swiss francs	= =>

Number of classes of goods and services beyond three	Supplementary fee	Total amount of the supplementary fees
..... x	73 Swiss francs	= =>

Individual fees (Swiss francs):

Designated Contracting Parties	Individual fee	Designated Contracting Parties	Individual fee
.....
.....
.....
.....
.....

Total individual fees =>

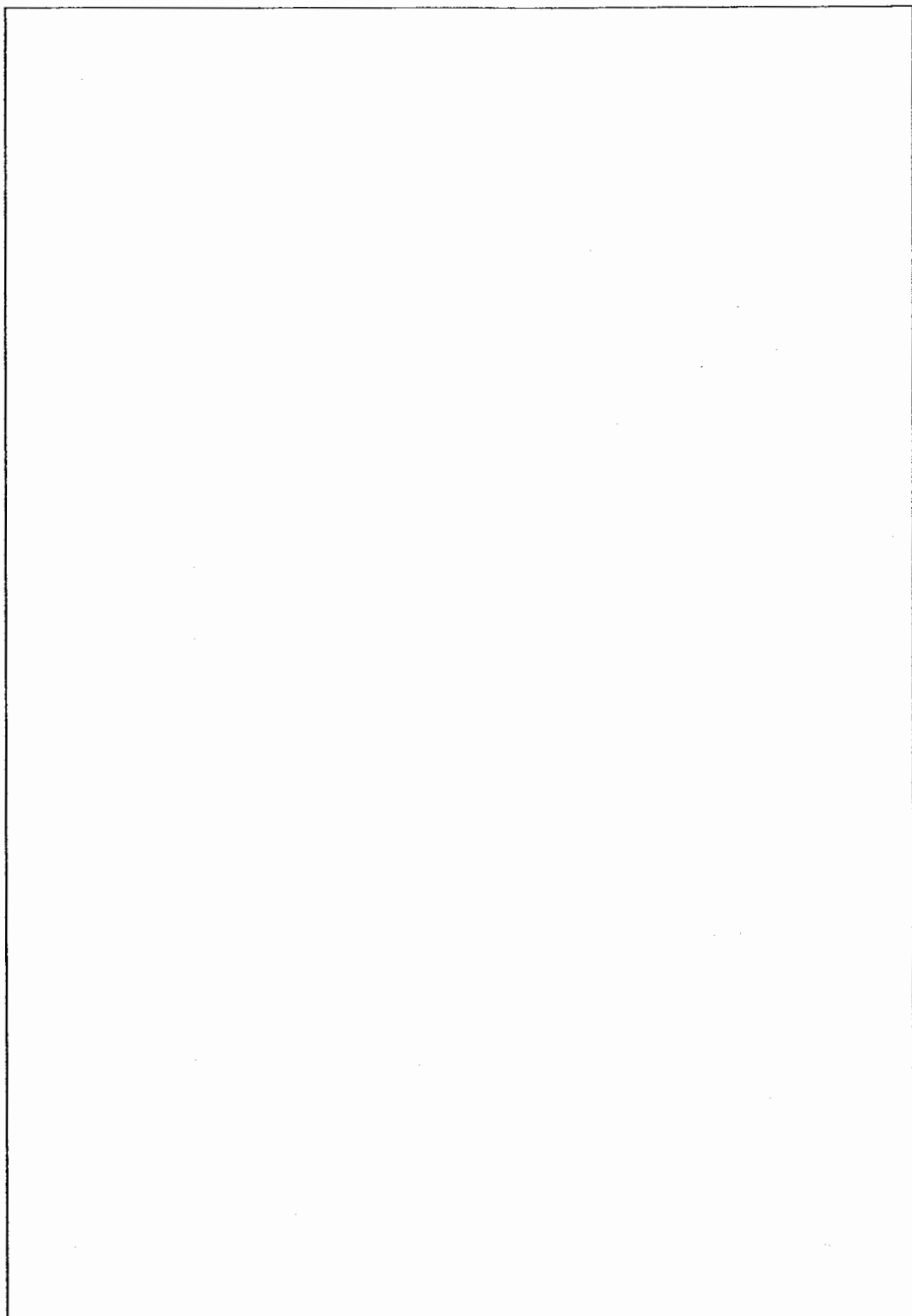
Grand total (Swiss francs)

Identity of the party effecting the payment:

Payment received and acknowledged by WIPO	<input type="checkbox"/>	WIPO receipt number
Payment made by banker's cheque (attached)	<input type="checkbox"/>	Cheque identification	dd/mm/yyyy
Payment made by banker's cheque (sent separately)	<input type="checkbox"/>	Cheque identification	dd/mm/yyyy
Payment made to WIPO bank account No. CH35 0425 1048 7080 8100 0 Credit Suisse, CH-1211 Geneva 70 Swift: CRESCH ZZ12A	<input type="checkbox"/>	Payment identification	dd/mm/yyyy
Payment made to WIPO postal cheque account N° 12-5000-8, Geneva	<input type="checkbox"/>	Payment identification	dd/mm/yyyy

CONTINUATION SHEET

No : of



MM2(E)-104

APPENDIX D

Declaration of Intention to Use the Mark --

United States of America (Form MM18)

MM18(E)

MADRID AGREEMENT AND PROTOCOL CONCERNING THE
INTERNATIONAL REGISTRATION OF MARKS

DECLARATION OF INTENTION TO USE THE MARK – UNITED STATES OF AMERICA

(to be annexed to each international application or subsequent designation in which the United States of America is a designated Contracting Party)

IMPORTANT

This form contains the exact wording of the declaration of intention to use the mark required by the United States of America. It should not be amended in any respect. Deletions, modifications or inclusions of text will result in the declaration being considered as irregular.

2. The United States of America has required that the declaration of intention to use the mark be made in English, even at the international application or the subsequent designation is in French. Therefore, this form is available in English only.

3. Where this form is used to remedy an irregularity notified by the International Bureau (either because the declaration of intention to use the mark was missing or did not comply with the applicable requirements), the mark holder must provide the information required by the International Bureau in the relevant sections of this form.



World Intellectual Property Organization
34, chemin des Colombettes, P.O. Box 18,
1211 Geneva 20, Switzerland
Tel.: (41-22) 338 9111

Fax (International Trademark Registry): (41-22) 740 1429
e-mail: intreg.mail@wipo.int -- Internet: <http://www.wipo.int>

MM18(E)

**DECLARATION OF INTENTION TO USE THE MARK:
UNITED STATES OF AMERICA**

By designating the United States in the international application/subsequent designation, the person signing below declares that:

- (1) the applicant/holder has a *bona fide* intention to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation;
- (2) he/she is properly authorized to execute this declaration on behalf of the applicant/holder;
- (3) he/she believes applicant/holder to be entitled to use the mark in commerce that the United States Congress can regulate on or in connection with the goods/services identified in the international application/subsequent designation; and
- (4) to the best of his/her knowledge and belief no other person, firm, corporation, association, or other legal entity has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

I declare under penalty of perjury under the laws of the United States of America that all the foregoing statements are true and correct to the best of my knowledge and belief. I understand that willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, and are punishable by fine or imprisonment, or both (18 U.S.C. §1001). 35 U.S.C. §25(b).

Signature

Date of execution (dd/mm/yyyy)

Signatory's Name (Printed)

Signatory's Title

INSTRUCTION

This declaration must be signed by:

- (1) the applicant/holder or a person with legal authority to bind the applicant/holder; or
- (2) a person with firsthand knowledge of the facts and actual or implied authority to act on behalf of the applicant/holder; or
- (3) an attorney who is authorized to practice before the United States Patent and Trademark Office under 37 C.F.R. §10.1(c), who has an actual written or verbal power of attorney or an implied power of attorney from the applicant/holder.

INFORMATION REQUIRED BY THE INTERNATIONAL BUREAU

(the information below, where available, must be furnished where this form is sent separately from the international application or subsequent designation)

International Bureau's reference (indicated in the irregularity notice):

Basic application number: Date of the basic application: (dd/mm/yyyy)

Basic registration number: Date of the basic registration: (dd/mm/yyyy)

International registration number:

Name of applicant/holder: