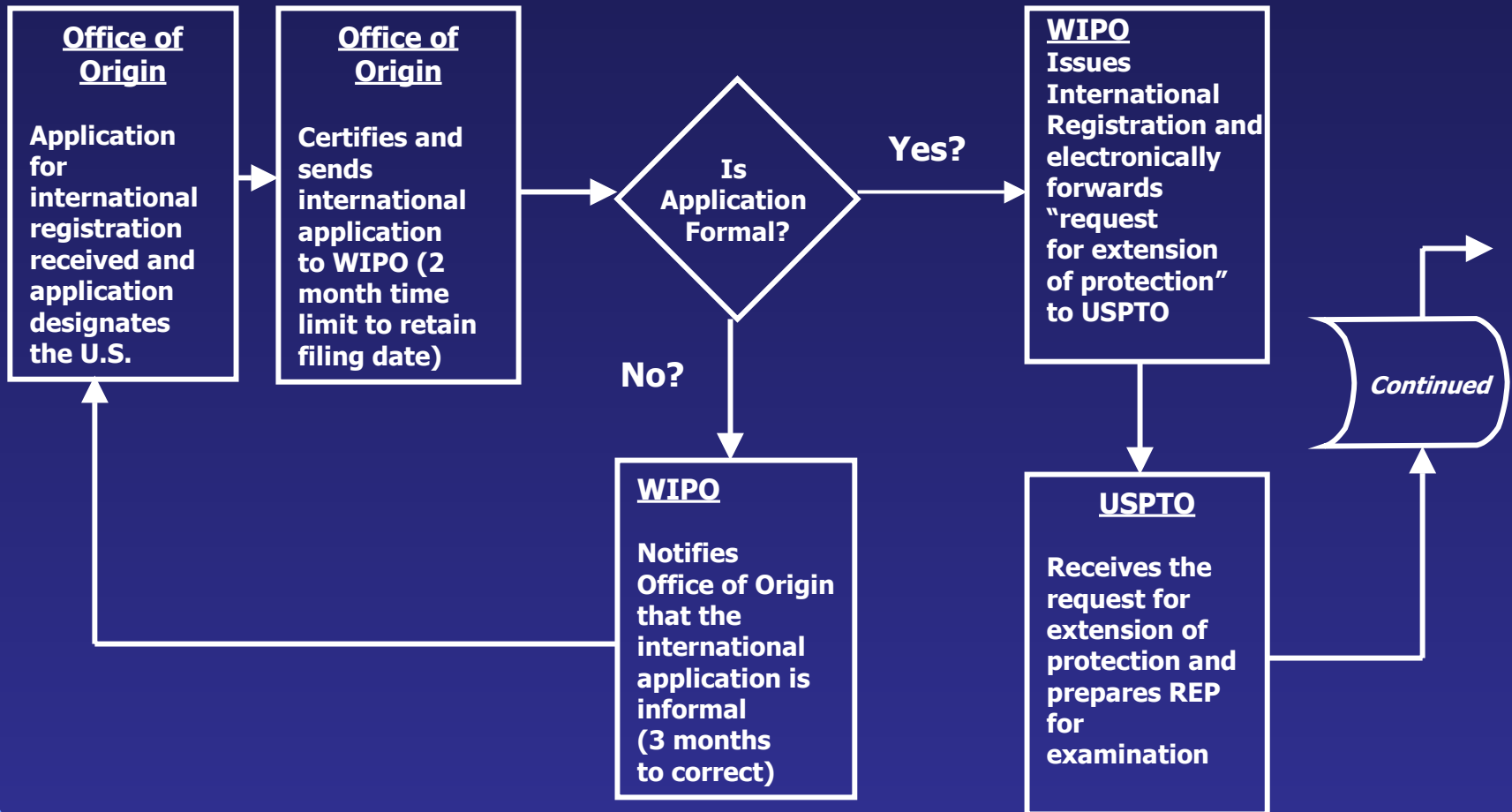


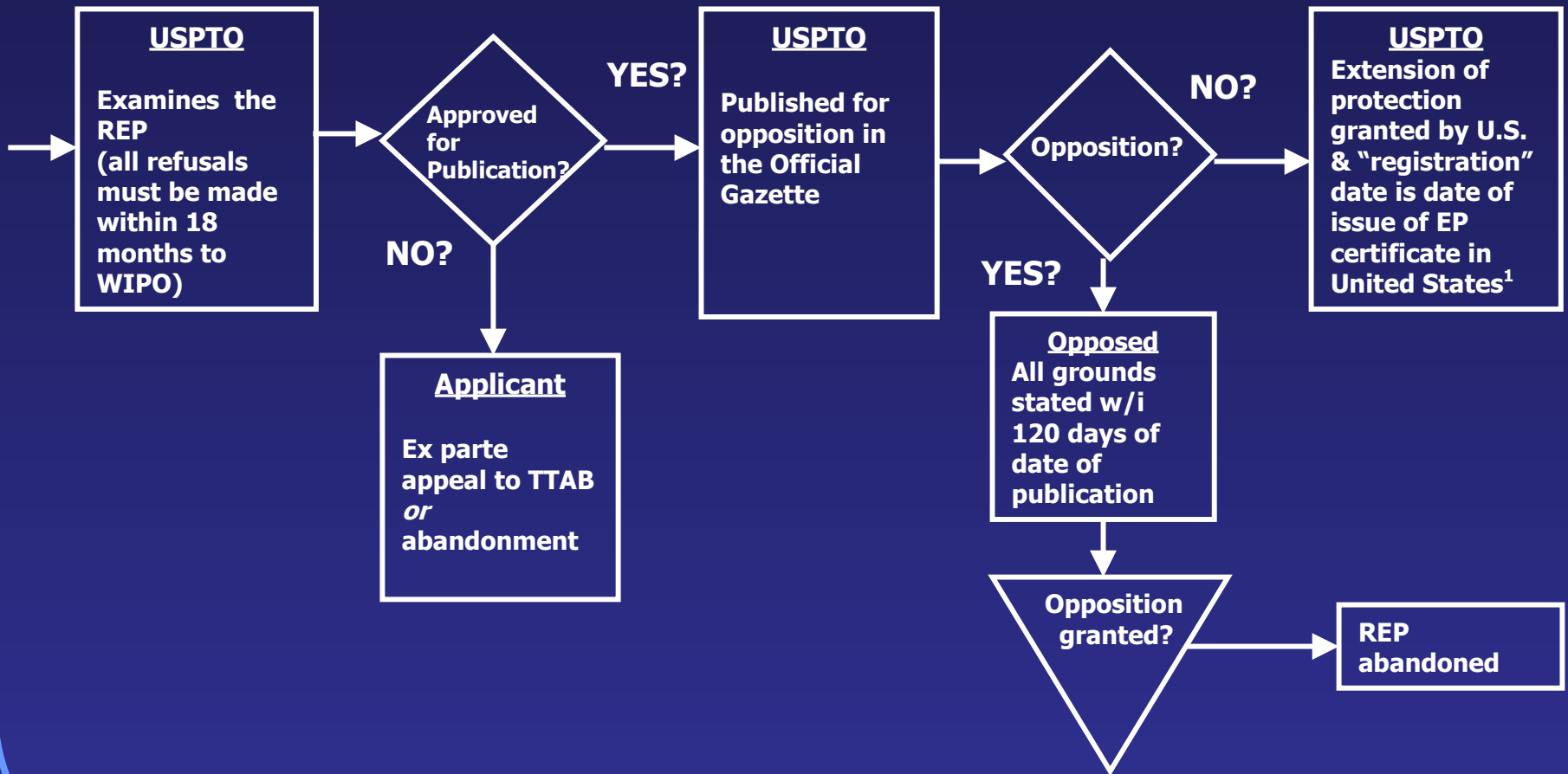
**MADRID PROTOCOL BASICS
AND U.S. PRACTICE FOR
NON-U.S. TRADEMARK OWNERS**

David Ehrlich
Tokyo, Japan 2003

Trademark Owner Seeking Extension of Protection to United States



Trademark Owner Seeking Extension of Protection to United States



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

Recordation of International Registration and Madrid Extension Title Changes

File in WIPO

Assignments

Mergers

Change of Name

Change of Address

Licenses

Security Interests in
IR (called
“restriction of the
right of disposal” in
Common Rule 20)

File also in local trademark office or elsewhere

Licenses (in some
countries)

Security Interests (in the
U.S., file in state office)

Madrid Protocol Members (on June 9, 2003)

Asia Pacific (9)

Australia, Bhutan, China (PRC), Japan, Korea (South), Korea (North), Mongolia, Singapore, Turkmenistan

Americas (3)

Antigua and Barbuda, Cuba, United States

Africa (7)

Kenya, Lesotho, Morocco, Mozambique, Sierra Leone, Zambia

Europe (39)

Albania, Armenia, Austria, Belarus, Belgium, Bulgaria, Czech Republic, Denmark, Estonia, Finland, France, Georgia, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Macedonia, Moldova, Monaco, Netherlands, Norway, Poland, Portugal, Romania, Russia, Serbia and Montenegro, Slovakia, Slovenia, Spain, Switzerland, Turkey, Ukraine, U.K.

Some Economically Important Non-Members

(on June 9, 2003)

European Union (as a whole)

Canada

Mexico

Latin American countries (Brazil, Argentina, Chile, etc.)

New Zealand

South Africa

Taiwan

Hong Kong

Malaysia

Philippines

Indonesia

Thailand

Israel

Iran

**Arab countries (Egypt, Syria, Iraq, Saudi Arabia, Kuwait,
etc.)**

Advantages and Disadvantages of a Madrid Protocol Extension compared to a U.S. National Registration

U.S. Registration

Madrid Protocol Extension to U.S.

Dependent on Other Registration

Fully Independent: The continued validity of a U.S. registration does not depend on any other registration

Dependent: The U.S. extension is (1) dependent forever on the continued existence of the international registration, and (2) dependent for five years or more (see note 4 above) on the home country application.

Assignability

Unlimited: Can be assigned or transferred by merger to any party.

Limited: Can only be assigned or transferred by merger to a party whose home country is a Madrid Protocol member country.

Advantages and Disadvantages of a Madrid Protocol Extension compared to a U.S. National Registration

U.S. Registration

Madrid Protocol Extension to U.S.

Amendment of Mark

Possible: Can be amended to change the mark (such as to modernize a logo) if the change is not a “material alteration” of the mark as originally registered.

Not Possible: The mark in the U.S. extension must always be identical to the mark in the international registration, and the mark in the international registration can never be amended, under current International Bureau rules.

Advantages and Disadvantages of a Madrid Protocol Extension compared to a U.S. National Registration

U.S. Registration

Madrid Protocol Extension to U.S.

Transformation of U.S. Application or Extension If Underlying Home Application Fails

No Fee: A U.S. application based on a home country application can be changed to a different basis (such as intent-to-use) with no fee, no loss of priority and no new examination..

Fee: Transformation to a national U.S. application is possible, within three months after international registration is canceled, but a full U.S. application filing fee must be paid (currently \$335 per international class) and the U.S. application will be examined again.

Advantages and Disadvantages of a Madrid Protocol Extension compared to a U.S. National Registration

U.S. Registration

Madrid Protocol Extension to U.S.

Non-distinctive Marks

Registrable on the Principal Register, if acquired distinctiveness (fame) in the U.S. is proven, but also registrable on the Supplemental Register of the U.S.

Not Accepted under Madrid Protocol extensions in the U.S., unless acquired distinctiveness (fame) in the U.S., is proven.

PTO in all types of U.S. national applications, except applications based on intent-to-use.

Unusual Types of Marks

Possible: The U.S. PTO will register sound marks, such as Tarzan's yell, smell marks, marks in motion (animated sequences) and marks for retail store services.

Limited to types registrable in home country.

Possible Objections in U.S. Examination

- **Prior similar application for confusingly similar marks, for same or “related” goods or services in any class (objection is conditional until prior application matures to registration)**
- **Prior similar registration for confusingly similar mark for same or “related” goods or services in any class**
- **More specific identification of goods or services needed**
- **Disclaimer of descriptive term needed**
- **Whole mark is descriptive or misdescriptive**
- **Whole mark is a surname**

Possible Objections in U.S. Examination

- **Whole mark is geographically descriptive or misdescriptive**
- **Goods are not goods in trade (such as brochures) or services are “incidental” to sales of goods or are not rendered to others**
- **Translation or transliteration needed**
- **Description of design needed**
- **Claim of ownership of prior registrations**
- **Consent of living person needed**
- **False suggestion of connection with a person**
- **Immoral matter**
- **Flag or national symbol**
- **For device or configuration marks - ornamental, non-distinctive or functional**

Objections That Can Be Anticipated in Request for Extension Form MM2

- **Translation**
- **Transliteration**
- **Disclaimer**
- **Description of design portion of mark or color**

Role of U.S. Attorney in Responding to Official Objection

- **Review USPTO's objection**
- **Factual Research (such as on relatedness)**
- **Legal Research**
- **Advise owner on possibility of overcoming objections**
- **Respond by phone, if possible**
- **Call Examiner, if advisable, to find out what he needs to withdraw objection**
- **File written argument, if needed, including citations to reported cases, Trademark Manual of Examining Procedure and existing marks on Register**

Role of U.S. Attorney in Responding to Official Objection

- **Telephone or personal interview with Examiner, if needed**
- **If needed, file appeal**
- **If needed, prepare declaration, under Section 2(f), to prove acquired distinctiveness**
- **If needed, seek consent from blocking mark owner and draft agreement in proper form for U.S. (simple consents are not accepted)**
- **If needed, investigate blocking mark and advise client on possible purchase or cancellation**
- **If needed, file cancellation proceeding**
- **File appointment of domestic representative**

Maintenance Filings

In WIPO

International Registration and National Extensions

- File renewals every 10 years after IR date

In USPTO

File Section 71 Use declaration

- During 6th year after U.S. issuance of extension (typically about 2 years after IR date)
- at 10th year
- at 20th year, etc.

First International Services Corp. v. Chuckles, Inc.

5USPQ 2d 1628 (TTAB 1988)

- U.S. trademark opposition against application for SUKESHA & Design
- Goods applied for, based on use in U.S., claimed in statement in application form at time of filing:

shampoo, hair conditioner, hair setting lotion, hair spray, permanent waves, hair colors, skin and body lotions, skin moisturizers, skin cleansing cream, skin toners and body shampoo

- Good actually sold at time of filing, according to applicant's testimony in opposition:

shampoo and hair setting lotion

- **RESULT: FRAUD.** Whole application invalid, because the applicant “knew or should have known of the falsity of the statement” and “the errors cannot be characterized as mere carelessness or misunderstanding...” 5 USPQ 2d at 1636

Practical Tips for Extensions to the U.S.

Avoiding Fraud

Use the limitation feature in the extension request form, part 10 of WIPO form MM2, to omit overbroad goods in the international registration from the extension to the U.S.

Proof of Use Deadlines

Docket the 6 year, 10 year, 20 year, etc. U.S. PTO proof of use deadlines for the U.S. extension, under Section 71, calculated from the extension issuance date in the U.S. (a later date than the international registration date). Ask a U.S. law firm to add the dates to their records to send reminders (and handle the Section 71 filings).

Practical Tips for Extensions to the U.S.

Specific Identification of Goods / Services

Acceptable identifications of goods and services in the U.S.PTO are stated in a database on the U.S. PTO website, www.uspto.gov/web/offices/tac/doc/gsmmanual/search.html. If the identification of goods/services in the Madrid Protocol extension contains words or phrases that are not in the U.S. PTO's approved database, or are not comparably specific, then the U.S. Examiner will object and require amendment. Therefore, if the U.S. extension will cover a short list of goods or services, it is worthwhile to visit the website and use U.S. PTO-approved terms in the home country national application and carry them forward into the international registration and the U.S. extension.

Consider a Search

Practical Tips for Extensions to the U.S.

Replacement

If replacement is desired, draft the home country and international registration identification of goods, if possible, to include the exact language in the identification of goods in the owner's existing U.S. registrations for the same mark.

Do Not Rely on Replacement Prematurely

Continue to renew the old U.S. registrations (which the U.S. extension will replace) until five years after the international registration date.

U.S. Attorney

Employ a U.S. attorney to respond to official objections and give the attorney sufficient time to do so before the deadline.

Ignore Deceptive Notices Requesting Fee Payments

**Obtain a Home Country and International
Registration for the Version of the Mark to Be Used in
the U.S.**

This: DONGWON

Not This:



**Consider Separate Registrations for Roman Letters
and Other Characters**