

The Madrid Protocol & the U.S.

Jay Erstling



PATTERSON |
THUENTE | IP

Edward R. Courtney



Dean R. Karau



Sandra Epp Ryan



U.S. Accession to Madrid Protocol

- In November 2002, President Bush signed legislation permitting U.S. accession
- Beginning on November 2, 2003, USPTO began accepting Madrid Protocol applications

Madrid Protocol – What It Is Not

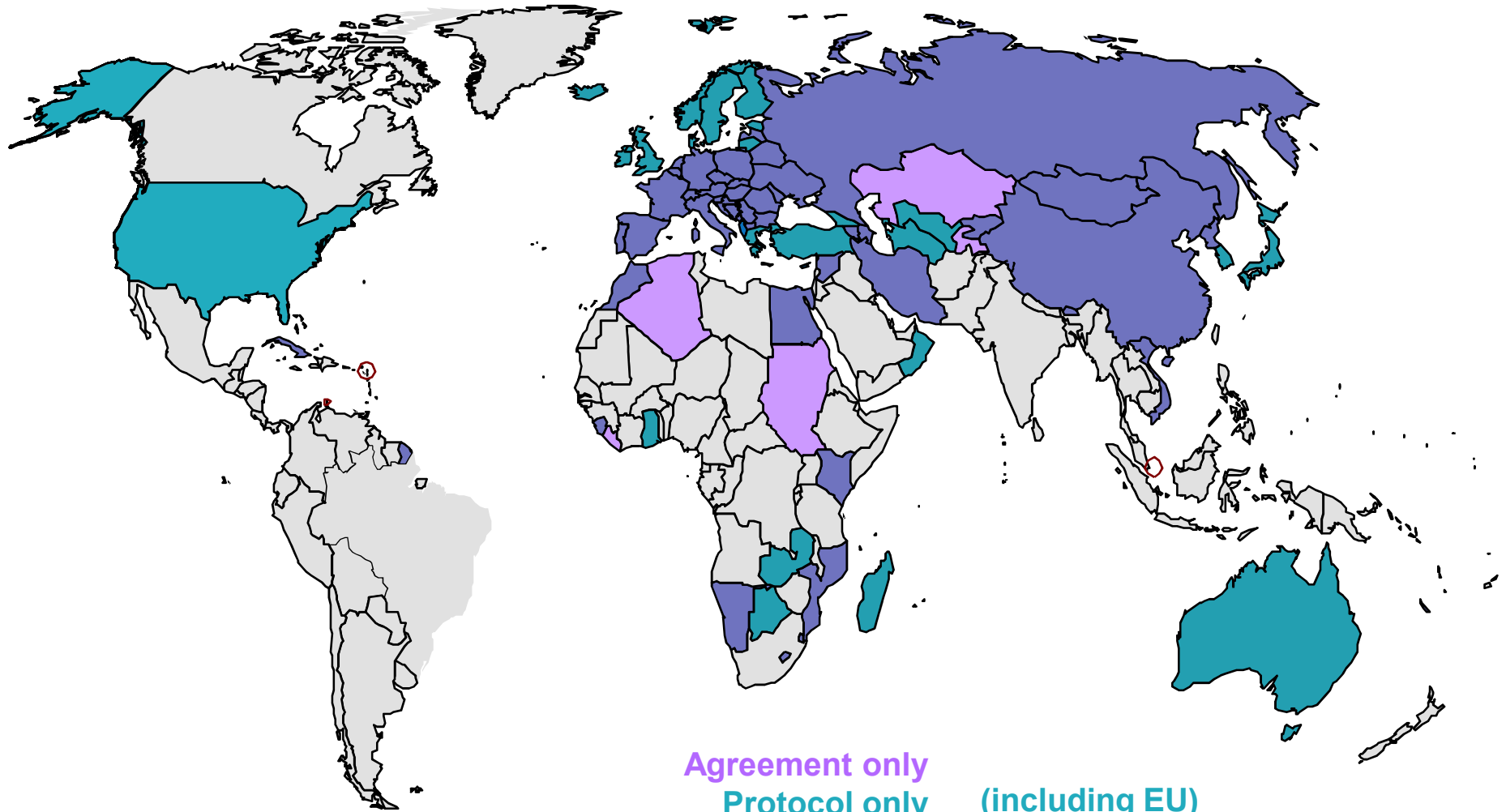
- Not a substantive law of trademarks
- No change or harmonization of national trademark laws

Madrid Protocol touted as “one does it all”

- One single application form
- One language
- One set of fees to One office
- One registration number
- One renewal
- One POA
- One attorney

Mark protected in over 80 countries

Scope of Madrid Union



Agreement only
Protocol only (including EU)
Agreement and Protocol

USPTO List of Contracting States

Albania	AL	<input type="checkbox"/>	Ghana	GH	<input type="checkbox"/>	Oman	O
Antigua and Barbuda	AG	<input type="checkbox"/>	Greece	GR	<input type="checkbox"/>	Poland	PL
Armenia	AM	<input type="checkbox"/>	Hungary	HU	<input type="checkbox"/>	Portugal	P
Australia	AU	<input type="checkbox"/>	Iceland	IS	<input type="checkbox"/>	Romania	R
Austria	AT	<input type="checkbox"/>	Iran	IR	<input type="checkbox"/>	Russian Federation	R
Azerbaijan	AZ	<input type="checkbox"/>	Ireland	IE	<input type="checkbox"/>	San Marino	SI
BES Islands (Bonaire, Saint Eustatius, and Saba)	BQ	<input type="checkbox"/>	Israel	IL	<input type="checkbox"/>	Sao Tome and Principe	S
Bahrain	BH	<input type="checkbox"/>	Italy	IT	<input type="checkbox"/>	Serbia	R
Belarus	BY	<input type="checkbox"/>	Japan	JP	<input type="checkbox"/>	Sierra Leone	SI
Benelux	BX	<input type="checkbox"/>	Kazakhstan	KZ	<input type="checkbox"/>	Singapore	SI
Bhutan	BT	<input type="checkbox"/>	Kenya	KE	<input type="checkbox"/>	Sint Maarten	S
Bosnia and Herzegovina	BA	<input type="checkbox"/>	Korea, Democratic People's Republic of	KP	<input type="checkbox"/>	Slovakia	SI
Botswana	BW	<input type="checkbox"/>	Korea, Republic of	KR	<input type="checkbox"/>	Slovenia	S
Bulgaria	BG	<input type="checkbox"/>	Kyrgyzstan	KG	<input type="checkbox"/>	Spain	E
China	CN	<input type="checkbox"/>	Kyrgyzstan	KG	<input type="checkbox"/>	Sudan	SI
Croatia	HR	<input type="checkbox"/>	Latvia	LV	<input type="checkbox"/>	Swaziland	S
Cuba	CU	<input type="checkbox"/>	Lesotho	LS	<input type="checkbox"/>	Sweden	SI
Curacao	CW	<input type="checkbox"/>	Liberia	LR	<input type="checkbox"/>	Switzerland	C
Cyprus	CY	<input type="checkbox"/>	Liechtenstein	LI	<input type="checkbox"/>	Syrian Arab Republic	S
Czech Republic	CZ	<input type="checkbox"/>	Lithuania	LT	<input type="checkbox"/>	Tajikistan	T
Denmark	DK	<input type="checkbox"/>	Macedonia, The Former Yugoslav Republic of	MK	<input type="checkbox"/>	Turkey	TI
Egypt	EG	<input type="checkbox"/>	Madagascar	MG	<input type="checkbox"/>	Turkmenistan	TI
Estonia	EE	<input type="checkbox"/>	Moldova, Republic of	MD	<input type="checkbox"/>	Ukraine	U
European Union *	EM	<input type="checkbox"/>	Monaco	MC	<input type="checkbox"/>	United Kingdom	G
Please select second language		<input type="checkbox"/>	Mongolia	MN	<input type="checkbox"/>	Uzbekistan	U
Select Second Language <input type="text" value="Select Second Language"/>		<input type="checkbox"/>	Montenegro	ME	<input type="checkbox"/>	Vietnam	VI
Finland	FI	<input type="checkbox"/>	Morocco	MA	<input type="checkbox"/>	Zambia	ZI
France	FR	<input type="checkbox"/>	Mozambique	MZ			
Georgia	GE	<input type="checkbox"/>	Namibia	NA			
Germany	DE	<input type="checkbox"/>	Norway	NO			

But . . .

- Dependency/central attack
 - base application/registration vulnerable for 5 years
- U.S. narrower descriptions of goods/services
- Office actions negate savings
- Restrictions on assignment of IR

So we advised . . .

- Be careful
- Only strong marks need apply
 - to avoid office actions & central attacks
- Avoid house marks
 - Too dangerous
- Think hard about broad descriptions
- Watch out for restrictions on transfers

Where are we now?

Madrid System - Two Treaties

- Madrid Agreement Concerning the International Registration of Marks;
- Protocol Relating to the Madrid Agreement
 - The US is party to the Protocol
- 85 members of the Madrid Union
- Administered by the International Bureau of WIPO (IB)

Objectives of the Madrid System

- Facilitates obtaining protection for marks
- IR equivalent to bundle of national registrations
 - subsequent management of protection easier (only one registration to renew)
- Possibility of having mark protected in up to 85 countries through one application

Madrid System Statistics for 2010

- 39,687 applications in 2010
 - 12.8% growth over 2009
- 21,949 trademark renewals in 2010
 - up 14.1% from 2009
- Fun fact
 - Oldest IR still in effect belongs to Swiss watchmaker Longines, first registered in 1893

Madrid System Statistics for 2010

- Top 6 Countries with largest growth in 2010:
 - Republic of Korea +42.2%
 - China +42%
 - Italy +38.7%
 - USA +29.6%
 - EU +26.9%
 - Japan +20.2%

Madrid System Statistics for 2010

- Most designated Member States in which applicants want their mark to be protected:
 - China (16,143)
 - European Union (up from 5th)
 - USA
 - Russian Federation (down from 2nd)
 - Switzerland
 - Japan

Madrid System Statistics for 2010

<u>Office of Origin</u>	<u>2010</u>	<u>Percentage</u>
Germany	5,006	12.6%
European Union	4,707	11.9%
United States	4,147	10.4%
France	3,565	9.0%
Switzerland	2,893	7.3%
Italy	2,596	6.5%
China	1,928	4.9%
Benelux	1,922	4.8%
Japan	1,577	4.0%
Russian Federation	1,218	3.1%

Madrid System Statistics for 2010

Share/Growth

	<u>Contracting Party of Origin</u>	<u>2006</u>	<u>2007</u>	<u>2008</u>	<u>2009</u>	<u>2010</u>	<u>Share</u>	<u>Growth</u>
1	Germany (DE)	5,663	6,090	6,214	4,793	5,006	12.6%	4.4%
2	European Union (EM)	2,445	3,371	3,600	3,710	4,707	11.9%	26.9%
3	United States of America (US)	3,148	3,741	3,684	3,201	4,147	10.4%	29.6%
4	France (FR)	3,705	3,930	4,218	3,523	3,565	9.0%	1.2%
5	Switzerland (CH)	2,468	2,657	2,885	2,671	2,893	7.3%	8.3%
6	Italy (IT)	2,958	2,664	2,763	1,872	2,596	6.5%	38.7%
7	China (CN)	1,328	1,444	1,585	1,358	1,928	4.9%	42.0%
8	Benelux (BX)	2,639	2,510	2,667	1,968	1,922	4.8%	-2.3%
9	Japan (JP)	847	984	1,278	1,312	1,577	4.0%	20.2%
10	Russian Federation (RU)	622	889	1,190	1,068	1,218	3.1%	14.0%

Madrid System Statistics for 2010

- The most popular classes registered
 - IC 009 – 8.5% - computer hardware and software
 - IC 035 – 7.0% - office functions, advertising & business mgmt
 - IC 025 – 5.4% - clothing, footwear, headgear
 - IC 042 – 5.2% - scientific, industrial or technological engineers and computer specialists
 - IC 005 – 5.1% - pharmaceuticals and other preparations for medical purposes
 - IC 041 – 4.4% - education, training, entertainment, sporting, cultural activities

Madrid System Statistics for 2010

The largest filers of 2010:

1. Philip Morris (Switzerland) (137)
2. Novartis (Switzerland)
3. Boehringer Ingelheim (Germany)
4. Da Lian Ya Tu Tou Zi Zi Xun You Xian Gong Si (China)
5. Ministero Delle Politiche Agricole (Italy)
6. Zhejiang Chengpeng Industry (China)
7. KRKA (Slovenia)
8. Henkel (Germany)
9. Novo Nordisk (Denmark)
10. Nestlé (Switzerland)
11. Galenka (Serbia)
12. Janssen Pharmaceutica (Belgium)
13. BSH Bosch und Siemens (Germany)
14. Syngenta (Switzerland)
15. Glaxo Group (UK)
16. Biofarma (France)
17. Egis Gyógyszergyár (Hungary)
18. EkoSan (Bosnia& Herzegovina),
19. Apple Inc (USA)
20. Phillips (Netherlands)

Madrid System Statistics for 2010

Top holders of int'l trademark registrations:

1. Henkel (Germany) - 2,973
2. Novartis (Switzerland)
3. Janssen Pharmaceutica (Belgium)
4. l'Oréal (France)
5. Nestlé (Switzerland)
6. Unilever (Netherlands)
7. Sanofi-Aventis (France)
8. BASF (Germany)
9. ITM Enterprises (France)
10. Lidl (Germany)
11. Lidl (Germany)
12. Siemens (Germany)
13. Bayer (Germany)
14. Biofarma (France)
15. Boehringer Ingelheim (Germany)
16. Richter Gedeon (Hungary)
17. Syngenta (Switzerland)
18. Philips (Netherlands)
19. Deutsche Telekom (Germany)
20. Merck (Germany)
21. Ecolab (Germany)

Ecolab Trademark Demographics: Worldwide

Filings / Registrations

– National Filings	3,514
– Benelux Filings	50
– CTM Filings	86
– WIPO Filings	703

Totals **4,353**

Ecolab IR Filing Statistics

- Base registration dependent on non-US filing - 97%
- Base registration dependent on USA filing – 3%
- Designate ~ 25-30 countries per filing
- Designated country demographics:
 - Europe 90%
 - Africa 5%
 - Asia 4%
 - Middle East 1%

Countries Recently Joining Madrid Protocol

- Liberia December 2009
- Sudan February 2010
- Israel September 2010
- Kazakhstan December 2010
- Tajikistan June 2011

Countries Soon to Join ?

- ASEAN
 - Brunei Darussalam
 - Cambodia
 - Indonesia
 - Lao PDR
 - Malaysia
 - Myanmar
 - Philippines
 - Singapore
 - Thailand
 - Viet Nam
- Colombia
- New Zealand



Using the Madrid Protocol A Quick Overview

Who May Use the Madrid Protocol?

Any person who:

- Has a real and effective industrial or commercial establishment in a contracting party;
- Is domiciled in a contracting party;
- Is a national of a contracting state; or
- Is a national of a state member of a contracting organization.

The International Application

International Application must be based on one or more existing applications or registrations in the Office of Origin -- “basic application(s) / registration(s)”

- Same mark
- Same applicant
- Goods/services covered by the basic

The International Application

- Must designate one or more Contracting Parties
- Additional Contracting Parties may be designated subsequently

The International Application

- 3 Types of Applications
 - Governed exclusively by Agreement
 - Governed exclusively by Protocol
 - Governed by both Agreement and Protocol
- A Contracting Party may be designated only if that Contracting Party and the Contracting Party whose Office is Office of Origin are both party to the same treaty

Application Procedure

- Application filed in Office of Origin
- Office of Origin certifies:
 - Mark, applicant, indications (e.g. description of mark, color claim) are same as in basic
 - Goods/services are covered by goods/services in basic
 - Applicant is qualified to file
 - Date on which it received request to present international application to IB = IR date if IB receives application within two months
- Office of Origin forwards certified application to IB or notifies applicant of any problems

Application Procedure

- IB Reviews Application for Formalities
 - Mark, goods/services, classification, fees
 - Not in compliance
 - Irregularity Notice to Office of Origin and applicant (3-month deadline to remedy)
 - Some irregularities must be remedied by USPTO, some by applicant
 - Some irregularities must be remedied via USPTO, some directly to IB
 - In compliance
 - Mark recorded in International Register, published in *WIPO Gazette of International Marks*, issues IR Certificate
 - IB notifies each designated Contracting Party of “Requests for Extension of Protection” (REPs)

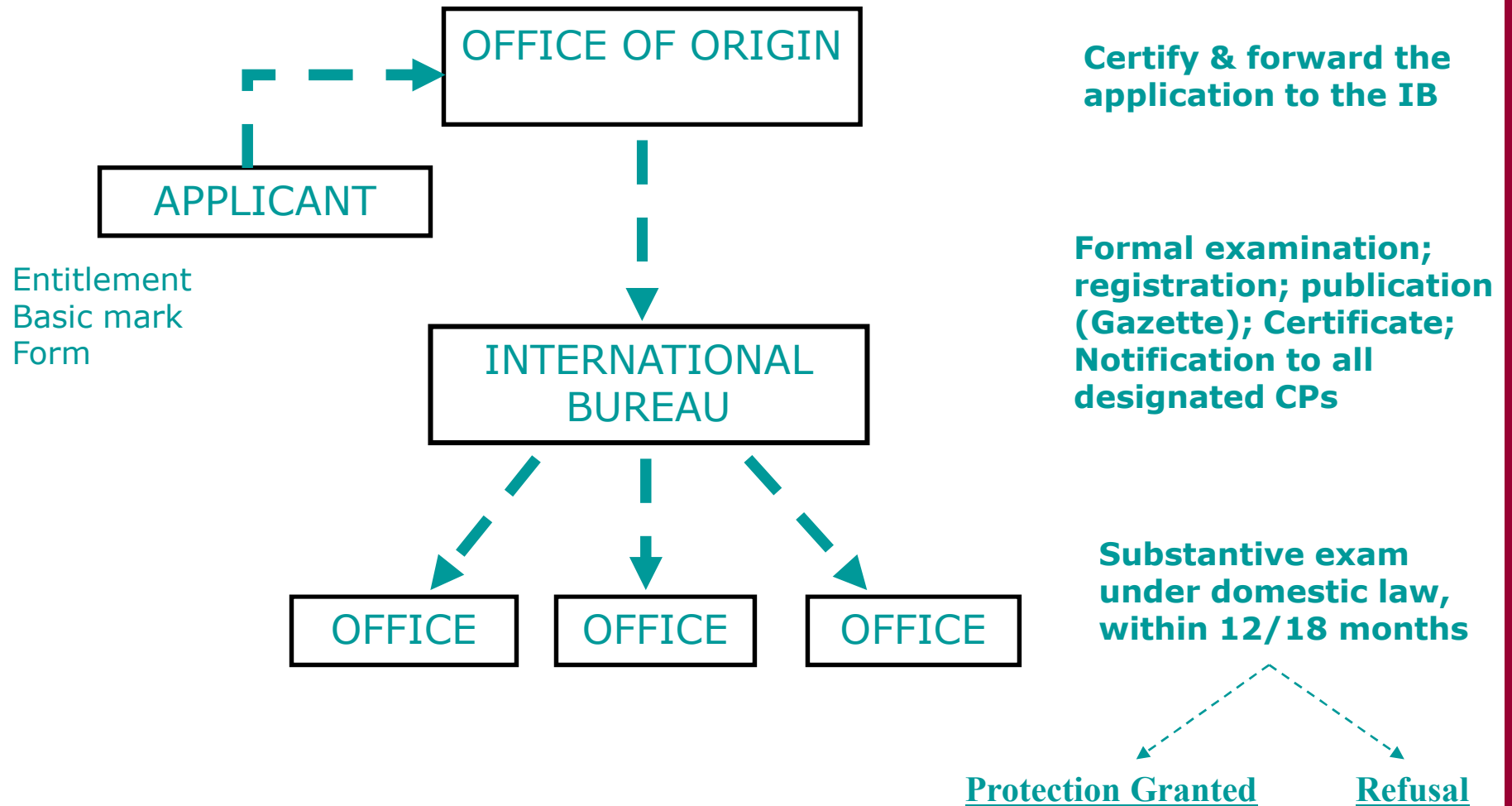
Application Procedure

- Contracting Party Examines REP
 - Same examination as a national application
 - Each Contracting Party can refuse protection within 12 or 18 months (longer if opposition if filed)
 - Provisional Refusal - notification to IB, published in *Gazette*, copy transmitted to Applicant
 - If no refusal, as of the IR date, protection of mark in each designated Contracting Party is same as if mark was filed directly with Office of that Contracting Party, unless protection is refused
 - Statement of Grant of Protection *should* be sent to IB, as of January 1, 2011 (but IB can not enforce this)

After Protection is Granted

- IR dependent on basic application/registration for five years from IR date
 - If basic application/registration ceases to have effect during five-year period, IR is longer be protected
 - If basic application/registration is restricted during five-year period, IR is similarly restricted
- After five year period, IR is independent of basic application/registration
- IR may be maintained in force indefinitely by payment of fee every 10 years (caveat: individual Contracting Parties may have additional requirements to maintain protection)

International Filing & Registration Flow



Filing Under the Madrid Protocol

Application Fees:

- USPTO Certification Fee
 - \$100.00 per class if application is based on one US application/ registration,
 - \$150.00 per class if the application is based on *multiple* US applications/registrations.
 - Non-refundable
- WIPO Basic Fee – varies
 - B/W or color; contracting parties designated; number of classes (Supplemental Fee if more than 3)
 - WIPO fee calculator and fee schedule at WIPO [Madrid web site](#)
- Contracting Party - Complementary Fee or Individual Fee - varies
 - Can not exceed national application filing fee
 - Complementary Fee applies if Individual Fee is not designated

Filings Under The Madrid Protocol

Subsequent Designation Fees:

- USPTO Transmittal Fee: \$100
- WIPO Basic Fee
- Contracting Party - Complementary Fee or Individual Fee

Filings Under The Madrid Protocol

- Two Options for Filing Application
 - electronic application available at USPTO website
 - Pre-populates form with details of basic application/registration
 - Fee is automatically calculated; all fees payable in US dollars
 - Certification is automated
 - paper form available at WIPO website
 - MM2 for applications; MM4 for subsequent designations
 - Must be printed by machine; handwritten form not accepted by IB
 - USPTO Certification Fee payable in US dollars
 - All other Fees must be paid in Swiss Francs directly to IB by check, WIPO deposit account, wire transfer, or cash in Geneva
 - Certification requires review by USPTO staff

Electronic Filing

Trademark Electronic Application System *file online*

MADRID PROTOCOL FORMS

NOTE: To submit the **required maintenance filings under Section 71** for a registered extension of protection (Madrid Protocol), see Form #9 in the overall category "REGISTRATION MAINTENANCE/RENEWAL FORMS" on the TEAS front page.

■ **1. Application for International Registration**

Use this form to submit an international application for registration. If the international application meets the requirements of [37 C.F.R. §7.11\(a\)](#), the USPTO will certify and forward the international application to the International Bureau of the World Intellectual Property Organization (IB). An international application submitted through the USPTO must be based on either (1) an application(s) that is currently pending in the USPTO; or (2) a registration(s) that the USPTO already issued. The international application may be based on more than one basic application or registration only if the mark and the owner are the same for all of the basic applications and/or registrations.

NOTE: All fees associated with the international application, i.e., the U.S. certification fee and the international application fees, must be paid at the time of submission. The U.S. certification fee is \$100.00, per class, if the international application is based on one single basic application or registration; or \$150.00 per class, if the international application is based on more than one basic application or registration. A schedule of international fees and fee calculator are available online at <http://www.wipo.int/madrid/en/>. The international application fees may be paid through the USPTO in U.S. dollars or directly to the IB in Swiss francs.

■ **2. Subsequent Designation**

A subsequent designation is a request by the holder of an international registration for an extension of protection of the registration to additional countries that are party to the Madrid Protocol (Contracting Parties). The holder of an international registration may use this form to submit a subsequent designation through the USPTO for forwarding to the International Bureau of the World Intellectual Property Organization (IB), provided that: (1) the holder is a U.S. national, either domiciled in the United States, or having a real and effective industrial or commercial establishment therein; and (2) the international registration is based on a U.S. basic application or registration.

NOTE: All fees associated with the subsequent designation, i.e., the U.S. transmittal fee and the international fees for filing a subsequent designation, must be paid at the time of submission. The U.S. transmittal fee is \$100.00. A schedule of international fees and a fee calculator are available online at <http://www.wipo.int/madrid/en/>. The international fees may be paid through the USPTO in U.S. dollars or directly to the IB in Swiss francs.

WARNING: To limit the Goods and/or Services listed within the International Registration for purposes of Subsequent Designation in different ways to different countries, you can use this form to limit each designated country by class. However, when using the fee calculator, the highest total number of classes being designated to any one country will determine the amount of individual fees due. Therefore, you may wish to calculate the individual fees due based on classes designated separately and then use an alternative payment method to assure appropriate fees are paid to WIPO's International Bureau.

■ **3. Response to a Notice of Irregularity**

Use this form only if (1) you are submitting a response to a notice of irregularity in an international application issued by the International Bureau of the World Intellectual Property Organization (IB); and (2) the IB response deadline has not expired. You may not use this form to respond to any IB irregularities notice concerning another Madrid-related filing.

■ **4. Replacement request**

Use this form to request the USPTO to note the replacement of a U.S. national registration with a registered extension of protection pursuant to Section 74 of the Trademark Act, 15 U.S.C. §1141n; 37 C.F.R. §7.28(a). The USPTO will only note the replacement in USPTO records and notify the International Bureau if the registered extension of protection and the U.S. national registration are (1) owned by the same party; (2) identify the same mark; and (3) list the same goods and/or services.

WARNING: You cannot file the request to note replacement of the U.S. national registration until the registration based on the request for extension of protection of the international registration issues. For more information on replacement, see [TMEP §1904.12](#).

■ **5. Transformation request**

Use this form if as the holder of an international registration that has been cancelled, in whole or in part, you want to request the USPTO to transform the cancelled extension of protection into an application under Section 1 or 44 of the Trademark Act for registration of the same mark for any or all of the cancelled goods and/or services. The holder, or a practitioner meeting the requirements of 37 C.F.R. §11.14(a), must file such a request directly with the USPTO, and the transformed application will be examined as a domestic application.

You must file this form within three (3) months after the date on which the international registration is cancelled, in whole or in part, and must include the elements required by 37 C.F.R. §7.31(a), including the holder's name and address, the domestic application filing fee for at least one class of goods or services (currently \$325), and an email address for receipt of USPTO correspondence. For further information on transformation, see [TMEP §1904.09 et seq.](#)





United States Patent and Trademark Office

Application for International Registration

INSTRUCTIONS FOR APPLICATION FOR INTERNATIONAL REGISTRATION

NOTE: If you have installed Anti-Spam filters or software on your email service, please ensure that legitimate emails from TEAS@uspto.gov are not falsely identified as spam or junk.

1. Important Filing Requirement:

You may file this application for International Registration only if the applicant is either a national of the United States or the applicant has either (1) a domicile in the United States or (2) a real and effective commercial establishment in the United States. If there is more than one owner, each must satisfy this filing requirement.

2. To navigate through each separate section of this form

Do not use your browser's "Back" or "Forward" buttons. Instead, use the "< Previous" or "Next >" buttons at the bottom of each section of the form. As you navigate through the sections, each section is validated before the next section is displayed. If there are any errors, you must fix them before proceeding to the next section. **To save data already entered within a section, you must first click on "Next" prior to using the "Previous" button to return to any previous section.**

3. To file the application electronically, please complete the following steps:

- Complete all fields for which information is known. Fields prefaced with an asterisk (*) are required fields for filing purposes and must be completed.
- Use the Pay/Submit button at the bottom of the Validation Page. After accessing the proper screen for payment and making the appropriate entries, you will receive a confirmation screen if your transmission was successful.
- You will also receive an e-mail acknowledgement of your submission providing a summary of your filing. Please contact TEAS@uspto.gov within 24 hours of transmission (or by the next business day) if you do **not** receive this e-mail acknowledgement.

4. Help Instructions:

Each field name links to the relevant section of the "HELP" instructions that will appear at the bottom of the screen.

Check here if you do **not** want the scrolling help to display automatically at the bottom of each screen in the instructions page, AND/OR if the screen reader must allow the filer to enter the information with no problems.

5. Contact Information:

If you need help resolving technical glitches, you can e-mail us at TEAS@uspto.gov. For general information about the Madrid Protocol, please contact the Madrid Processing Unit at MPU@uspto.gov, or (571) 272-8910. Please include your telephone number in your e-mail so we can talk to you directly, if necessary. Or, to view the information provided by the International Bureau concerning the Madrid System for the international registration of marks, click [Madrid System for the International Registration of Marks](#).

6. Browser Requirement:

IMPORTANT: To use this form successfully, please note the following requirements:

1. You must use one of the following browsers: Internet Explorer 5.5+; Netscape 7.0+; Mozilla/FireFox 1.0+. You can **NOT** use Netscape 4.x;
2. You must have the cookies and javascript features of your browser enabled;
3. Do **NOT** use your browser's "BACK" or "FORWARD" buttons at any time to navigate through any portion of this form. Always use the navigational tools provided specifically at the bottom of the form pages; and
4. If you have installed Anti-Spam filters or software on your email service, please ensure that legitimate emails from TEAS@uspto.gov are not falsely identified as spam or junk.

7. Other:

NOTE: This form has a session time limit of 60 minutes. A session begins once you create and enter the form via the Form Wizard. If you exceed the 60 minute time limit, the form will not validate and you must begin the entire process again; however, you can [extend the time limit](#). You are encouraged to have all information required to complete the form available prior to starting your session.

Next :

4. In what country or countries do you want to extend protection through this International Application?

Select **ALL** countries listed below.

- | | | | | | |
|--|----|--|----|---|----|
| <input checked="" type="checkbox"/> Albania | AL | <input checked="" type="checkbox"/> Ghana | GH | <input checked="" type="checkbox"/> Oman | OM |
| <input checked="" type="checkbox"/> Antigua and Barbuda | AG | <input checked="" type="checkbox"/> Greece | GR | <input checked="" type="checkbox"/> Poland | PL |
| <input checked="" type="checkbox"/> Armenia | AM | <input checked="" type="checkbox"/> Hungary | HU | <input checked="" type="checkbox"/> Portugal | PT |
| <input checked="" type="checkbox"/> Australia | AU | <input checked="" type="checkbox"/> Iceland | IS | <input checked="" type="checkbox"/> Romania | RO |
| <input checked="" type="checkbox"/> Austria | AT | <input checked="" type="checkbox"/> Iran | IR | <input checked="" type="checkbox"/> Russian Federation | RU |
| <input checked="" type="checkbox"/> Azerbaijan | AZ | <input checked="" type="checkbox"/> Ireland | IE | <input checked="" type="checkbox"/> San Marino | SM |
| <input checked="" type="checkbox"/> BES Islands (Bonaire, Saint Eustatius, and Saba) | BQ | <input checked="" type="checkbox"/> Israel | IL | <input checked="" type="checkbox"/> Sao Tome and Principe | ST |
| <input checked="" type="checkbox"/> Bahrain | BH | <input checked="" type="checkbox"/> Italy | IT | <input checked="" type="checkbox"/> Serbia | RS |
| <input checked="" type="checkbox"/> Belarus | BY | <input checked="" type="checkbox"/> Japan | JP | <input checked="" type="checkbox"/> Sierra Leone | SL |
| <input checked="" type="checkbox"/> Benelux | BX | <input checked="" type="checkbox"/> Kazakhstan | KZ | <input checked="" type="checkbox"/> Singapore | SG |
| <input checked="" type="checkbox"/> Bhutan | BT | <input checked="" type="checkbox"/> Kenya | KE | <input checked="" type="checkbox"/> Sint Maarten | SX |
| <input checked="" type="checkbox"/> Bosnia and Herzegovina | BA | <input checked="" type="checkbox"/> Korea, Democratic People's Republic of | KP | <input checked="" type="checkbox"/> Slovakia | SK |
| <input checked="" type="checkbox"/> Botswana | BW | <input checked="" type="checkbox"/> Korea, Republic of | KR | <input checked="" type="checkbox"/> Slovenia | SI |
| <input checked="" type="checkbox"/> Bulgaria | BG | <input checked="" type="checkbox"/> Kyrgyzstan | KG | <input checked="" type="checkbox"/> Spain | ES |
| <input checked="" type="checkbox"/> China | CN | <input checked="" type="checkbox"/> Latvia | LV | <input checked="" type="checkbox"/> Sudan | SD |
| <input checked="" type="checkbox"/> Croatia | HR | <input checked="" type="checkbox"/> Lesotho | LS | <input checked="" type="checkbox"/> Swaziland | SZ |
| <input checked="" type="checkbox"/> Cuba | CU | <input checked="" type="checkbox"/> Liberia | LR | <input checked="" type="checkbox"/> Sweden | SE |
| <input checked="" type="checkbox"/> Curacao | CW | <input checked="" type="checkbox"/> Liechtenstein | LI | <input checked="" type="checkbox"/> Switzerland | CH |
| <input checked="" type="checkbox"/> Cyprus | CY | <input checked="" type="checkbox"/> Lithuania | LT | <input checked="" type="checkbox"/> Syrian Arab Republic | SY |
| <input checked="" type="checkbox"/> Czech Republic | CZ | <input checked="" type="checkbox"/> Macedonia, The Former Yugoslav Republic of | MK | <input checked="" type="checkbox"/> Tajikistan | TJ |
| <input checked="" type="checkbox"/> Denmark | DK | <input checked="" type="checkbox"/> Madagascar | MG | <input checked="" type="checkbox"/> Turkey | TR |
| <input checked="" type="checkbox"/> Egypt | EG | <input checked="" type="checkbox"/> Moldova, Republic of | MD | <input checked="" type="checkbox"/> Turkmenistan | TM |
| <input checked="" type="checkbox"/> Estonia | EE | <input checked="" type="checkbox"/> Monaco | MC | <input checked="" type="checkbox"/> Ukraine | UA |
| <input checked="" type="checkbox"/> European Union * | EM | <input checked="" type="checkbox"/> Mongolia | MN | <input checked="" type="checkbox"/> United Kingdom | GB |
| Please select second language | | <input checked="" type="checkbox"/> Montenegro | ME | <input checked="" type="checkbox"/> Uzbekistan | UZ |
| <input type="text" value="French"/> | | <input checked="" type="checkbox"/> Morocco | MA | <input checked="" type="checkbox"/> Vietnam | VN |
| <input checked="" type="checkbox"/> Finland | FI | <input checked="" type="checkbox"/> Mozambique | MZ | <input checked="" type="checkbox"/> Zambia | ZM |
| <input checked="" type="checkbox"/> France | FR | <input checked="" type="checkbox"/> Namibia | NA | | |
| <input checked="" type="checkbox"/> Georgia | GE | <input checked="" type="checkbox"/> Norway | NO | | |
| <input checked="" type="checkbox"/> Germany | DE | | | | |



United States Patent and Trademark Office

Application for International Registration

Wizard Application Applicant(s) Entitlement Representative Mark Info Goods/Services **Fee Calculation** Validation

To navigate this form, use the "Previous" or "Next" buttons at the bottom of this page.

FEE SECTION

International Registration Fees and USPTO Certification Fee

The International Registration fees are based on the specific election of fees by the designated countries. The calculation of the International Registration fees can be determined from the [WIPO fee calculator](#)*. Total fees also include a set USPTO certification fee based on the total number of classes in the International Application, with each class only counting once, even if that class is claimed multiple times for different Contracting Party countries within this International Application.

NOTE: Both the International Registration fees and the USPTO certification fee must be fully paid at the time of filing this application, through the Pay/Submit process accessed after successful validation of this form.

*NOTE: To calculate fees correctly through the WIPO fee calculator page, you must (1) select the latest date (but not a future date) from the "For date:" pull-down menu; and (2) select "United States of America" from the "Country of Origin" pull-down menu.

Number of Classes	<input type="text" value="1"/>	Note: The Class Number is based on the number of classes actually being extended in either the International Application or the Subsequent Designation.
International Registration fees	<input type="text" value="20737.57"/>	For information on this calculation, see WIPO fee calculator *. Conversion from Swiss francs to U.S. dollars was based on the exchange rate of 1.1399909.
USPTO Certification Fee	<input type="text" value="100.00"/>	=USPTO Certification Fee x Number of Classes
Total Amount	<input type="text" value="20837.57"/>	=International Registration Fees + USPTO Certification Fee

Filing National Applications

Global IP Estimate

Albania	\$1,407	Japan	\$2,956	Oman	\$1,832
Armenia	\$1,053	Kazakhstan	\$1,500	Russia	\$2,455
Australia	\$1,886	Kenya	\$690	San Marino	\$1,182
Azerbaijan	\$1,080	Korea (No)	\$1,909	Sao Tome . . .	\$1,666
Bahrain	\$1,185	Korea (So)	\$1,278	Serbia	\$2,120
Belarus	\$1,456	Kyrgyzstan	\$1,485	Sierra Leone	\$809
Bosnia . . .	\$2,089	Lesotho	\$875	Singapore	\$1,041
Botswana	\$740	Liberia	\$1,645	Sudan	\$849
Bhutan	\$909	Liechtenstein	\$1,798	Swaziland	\$822
China	\$693	Macedonia	\$1,603	Switzerland	\$2,496
Croatia	\$2,591	Madagascar	\$898	Syria	\$1,377
Cuba	\$1,299	Moldova	\$1,794	Tajikistan	\$2,040
Cyprus	\$1,434	Monaco	\$1,163	Turkey	\$1,842
Egypt	\$672	Mongolia	\$885	Turkmenistan	\$1,631
EU	\$3,245	Montenegro	\$1,692	Ukraine	\$1,379
Georgia	\$1,065	Morocco	\$1,370	Uzbekistan	\$3,230
Ghana	\$976	Mozambique	\$1,930	Vietnam	\$652
Iran	\$1,220	Namibia	\$699	Zambia	\$973
Israel	\$1,797	Norway	\$2,217		\$83,580.00

Total | \$83,580.00

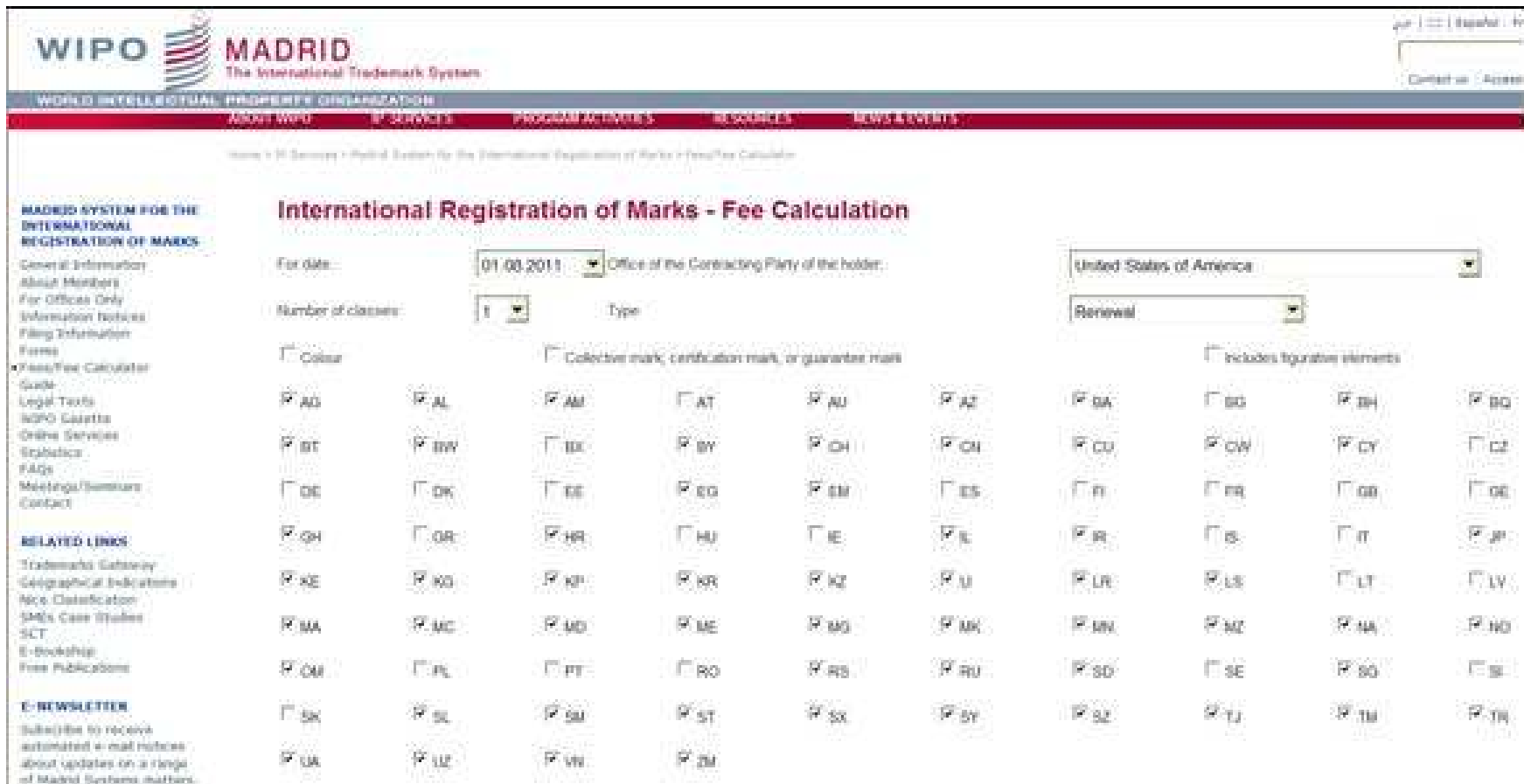
Example: Prosecution to Registration in China, EU & Japan (1 Class) (Assuming no office actions)

Madrid Protocol

National Filing

Basic Fee	\$735	N/A
China	\$350	\$700
EU	\$1,250	\$3500
Japan	\$160	\$3000
Totals	\$3020	\$7200

Renewing An International Registration



WIPO MADRID The International Trademark System

WORLD INTELLECTUAL PROPERTY ORGANIZATION

Home > IP Services > Madrid System for the International Registration of Marks > Fee/Fee Calculator

International Registration of Marks - Fee Calculation

For date: 01.08.2011 Office of the Contracting Party of the holder: United States of America

Number of classes: 1 Type: Renewal

Colour Collective mark, certification mark, or guarantee mark Includes figurative elements

<input type="checkbox"/> AG	<input type="checkbox"/> AL	<input type="checkbox"/> AM	<input type="checkbox"/> AT	<input type="checkbox"/> AU	<input type="checkbox"/> AZ	<input type="checkbox"/> BA	<input type="checkbox"/> BG	<input type="checkbox"/> BH	<input type="checkbox"/> BO
<input type="checkbox"/> BT	<input type="checkbox"/> BV	<input type="checkbox"/> BR	<input type="checkbox"/> BY	<input type="checkbox"/> CA	<input type="checkbox"/> CH	<input type="checkbox"/> CL	<input type="checkbox"/> CN	<input type="checkbox"/> CO	<input type="checkbox"/> CZ
<input type="checkbox"/> DE	<input type="checkbox"/> DK	<input type="checkbox"/> EE	<input type="checkbox"/> EG	<input type="checkbox"/> EM	<input type="checkbox"/> ES	<input type="checkbox"/> FI	<input type="checkbox"/> FR	<input type="checkbox"/> GB	<input type="checkbox"/> GE
<input type="checkbox"/> GR	<input type="checkbox"/> HR	<input type="checkbox"/> HU	<input type="checkbox"/> IE	<input type="checkbox"/> IL	<input type="checkbox"/> IN	<input type="checkbox"/> IS	<input type="checkbox"/> IT	<input type="checkbox"/> JP	
<input type="checkbox"/> KE	<input type="checkbox"/> KG	<input type="checkbox"/> KP	<input type="checkbox"/> KR	<input type="checkbox"/> KZ	<input type="checkbox"/> LU	<input type="checkbox"/> LR	<input type="checkbox"/> LS	<input type="checkbox"/> LT	<input type="checkbox"/> LV
<input type="checkbox"/> MA	<input type="checkbox"/> MC	<input type="checkbox"/> MD	<input type="checkbox"/> ME	<input type="checkbox"/> MG	<input type="checkbox"/> MK	<input type="checkbox"/> MW	<input type="checkbox"/> MZ	<input type="checkbox"/> NA	<input type="checkbox"/> ND
<input type="checkbox"/> OM	<input type="checkbox"/> PL	<input type="checkbox"/> PT	<input type="checkbox"/> RO	<input type="checkbox"/> RS	<input type="checkbox"/> RU	<input type="checkbox"/> SD	<input type="checkbox"/> SE	<input type="checkbox"/> SG	<input type="checkbox"/> SI
<input type="checkbox"/> SK	<input type="checkbox"/> SL	<input type="checkbox"/> SM	<input type="checkbox"/> ST	<input type="checkbox"/> SX	<input type="checkbox"/> SY	<input type="checkbox"/> SZ	<input type="checkbox"/> TJ	<input type="checkbox"/> TM	<input type="checkbox"/> TW
<input type="checkbox"/> UA	<input type="checkbox"/> UZ	<input type="checkbox"/> VN	<input type="checkbox"/> ZM						

Total \$17,294.21

Renewing National Registrations

Global IP Estimate

Albania	\$739
Armenia	\$668
Australia	\$1,090
Azerbaijan	\$487
Bahrain	\$399
Belarus	\$1,040
Bhutan	\$357
Bosnia . . .	\$879
Botswana	\$319
China	\$590
Croatia	\$882
Cuba	\$734
Cyprus	\$447
Egypt	\$197
EU	\$3,037
Georgia	\$520
Ghana	\$694
Iran	\$745
Israel	\$1,270

Japan	\$2,125
Kazakhstan	\$558
Kenya	\$430
Korea (No.)	\$874
Korea (So.)	\$1,224
Kyrgyzstan	\$730
Lesotho	\$393
Liberia	\$935
Liechtenstein	\$1,247
Macedonia	\$1,015
Madagascar	\$590
Moldova	\$815
Monaco	\$942
Mongolia	\$295
Montenegro	\$613
Morocco	\$692
Mozambique	\$613
Namibia	\$224
Norway	\$1,033

Oman	\$1,182
Russia	\$1,064
San Marino	\$742
Sao Tome . .	\$0
Serbia	\$830
Sierra Leone	\$604
Singapore	\$539
Sudan	\$438
Swaziland	\$309
Switzerland	\$2,496
Syria	\$1,083
Tajikistan	\$1,020
Turkey	\$741
Turkmenistan	\$960
Ukraine	\$724
Uzbekistan	\$1,025
Vietnam	\$278
Zambia	\$740

Total \$45,217.00

Example: Renewal in China, European Community & Japan (1 Class) (Assuming no office actions)

Madrid Protocol

National Renewal

Basic Fee	\$735	N/A
China	\$700	\$575
EU	\$1,725	\$2,650
Japan	\$675	\$1,450
Totals	\$3835	\$4675

Advantages of the Madrid Protocol

- File only one application in one language
- Pay fees only to one Office, in US dollars
- No foreign agent fees for filing
- No POA forms, legalization fees, translation fees, etc.
- Fixed deadline for confirmation of refusal
- Changes to IR recorded/paid for by single procedure at IB, *e.g.*,
 - Change in name/address
 - Change in ownership
 - Limitation of goods/services
- Renewal of IR requires single procedure at IB
- Subsequent designations possible

Disadvantages of Madrid Protocol

- Only 85 countries – none from Latin America
- U.S. requires more specificity in identification of goods/services compared to many countries
- Loss or restriction of basic application or registration within 5 years of IR date will cause loss/restriction of IR
- No savings in local counsel costs if provisional refusals are issued
- Restrictions on assignment of IR
- No amendment to the mark
- Possible delay by IB in forwarding REPs to designated countries

Transformation

- Mitigates the effects of loss of basic application/registration
- IR “transformed” into individual registrations in each of designated contracting parties
- retains priority date of IR
- But negates cost savings

Types of MP Users

- Multi-national companies with established global portfolios
- Companies going international in specific, defined current and future markets
- Companies going international but exact future markets are not defined
- Strategy may vary
 - search v. no search
 - foreign counsel input before filing
 - careful selection of members v. shotgun approach

Searching Strategies

Same considerations as if filing national applications:

- Full availability search – before filing in home country
- Screening search – in some or all countries of interest
- Full search - in countries of primary interest

Filing Strategies

- Offense v. defense?
 - Enforcement v. right to use
- Consider waiting for basic application to clear opposition period before filing international application (risk of central attack)
- Consider using incontestable registration as basic
- May not want to use European Community trademark application as basic (potentially heightened risk of opposition)
- US applicants may prefer national or regional route in order to maximize scope of protection in each jurisdiction

Why not use Madrid Protocol?

- Countries of interest are not MP members
- Not concerned with protection outside US (e.g., don't care about defensive filings)
- Form of mark may vary from country to country
- Form of mark may change over time
- Rights in mark in U.S. are quite weak or vulnerable
- Sale/assignment of rights likely in near future
- “Bet the farm” mark
- Mark for new product/technology – difficult to describe goods/services

Additional Concerns

- Delays a problem? (e.g., need registration for trade show?)
- Ease of enforceability - IR grant of protection v. national registration certificate?
- Carve out countries where risk tolerance is low to avoid potential for central attack

Is the Madrid Protocol for You?

- More U.S. companies are taking advantage of the Protocol
- Even if transformation required, at most slightly more costly than starting with national filings

Thanks!

Jay Erstling



PATTERSON |
THUENTE | IP

Edward R. Courtney



Dean R. Karau



Sandra Epp Ryan

