

Overview of the United States Accession Process to the Madrid Protocol



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Birth of the Madrid Protocol

- Between 1986 and 1989 the World Intellectual Property Organization (WIPO) held a series of meetings to draft a “protocol” to the Madrid Agreement.
- These meeting culminated in a diplomatic conference adopting the treaty on June 27, 1989.
- The two treaties – Madrid Agreement and Madrid Protocol – would share common regulations.



U.S. Involvement in Protocol

- The U.S. attended the working group on the Madrid Protocol regulations in early 1990's.
- We were interested in language to make the Madrid Protocol easier for the U.S. to join.
 - In the U.S., federal jurisdiction over trademark matters rests on the **interstate commerce** and **treaty powers** of the U.S. federal government. Therefore, Madrid applications would have to be covered by one or both provisions to give the USPTO jurisdiction.



Rules from the Common Regulations

- Rule 7(2) requires a contracting party that intends to require a statement of bona fide intention to use the mark must notify the Director at the time of its accession to the Madrid Protocol.
- Rule 7(2) also allows a contracting party to require that the intent to use declaration be signed by applicant itself.
- Rule 9(6)(d) contains language that allows the U.S. to require that a signed statement of bona fide intent to use be part of the designation to US (i.e., it must be filed with international application (IA) or later designation).



Madrid Protocol Implementation in the U.S.

- The Madrid Protocol became effective in the U.S. on November 2, 2003.
- The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 (“MPIA”), amended the U.S. Trademark Act to provide that:
 - The owner of a U.S. national application and/or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol by submitting a single IA to the International Bureau (IB) of WIPO through the USPTO, and
 - The holder of an international registration (IR) may request an extension of protection (REP) of the IR to the U.S.
- A notice of final rulemaking amending the USPTO Trademark Rules of Practice to incorporate the MPIA was published at 68 Fed. Reg. 55748 (Sept. 26, 2003).



Concerns

- Would there be a flood of applications?
- Would law firms lose business?



Statistics for the U.S.

- **International Registrations with the U.S. as the Office of Origin (Outgoing)**
 - 2004: 1025
 - 2005: 2584
 - 2006: 3296
 - 2007: 3561
 - 2008: 3864
 - 2009: 3225
 - 2010: 3897
 - 2011: 4652
 - 2012: 5073
 - 2013: 5893
 - 2014: 5414
- **Designations to the U.S. in International Registrations (Incoming)**
 - 2004: 5210
 - 2005: 10728
 - 2006: 12688
 - 2007: 13326
 - 2008: 14457
 - 2009: 12186
 - 2010: 13024
 - 2011: 14432
 - 2012: 15000
 - 2013: 15898
 - 2014: 15686



New Responsibilities

- Because there is no direct filing at WIPO, the Office of Origin has several roles to play:
 - Certifier of IA;
 - Transmitter of Information;
 - Fee Forwarding.
- These tasks must be performed or the rights of the owners may be affected.
- These new roles may impact current processes.



Decisions Needed

- Working language?
- Who will certify?
 - New staff or train existing staff?
- Who will learn the processes?
 - Specialists or current examiners?
- How will the Office of Origin communicate with WIPO?
 - Electronically or on paper?



Changes Made to U.S. Law

- Created a new filing “basis”
- Created “certification” power
- Defined relationship between basic application/registration and IR
- Effect of filing a REP to the US
- Examination of REP by USPTO
- Time limits for notifying WIPO of provisional refusal or opposition
- Effect of registered extension of protection
- Dependence of registered extension of protection on IR



Changes Made to U.S. Rules and Processes

- With the enactment of the Madrid Protocol, corresponding regulations were necessary to provide details of “how” the USPTO would operate.
- Rules were drafted, proposed for comment, and user input considered.
- Some rules were enacted to aid the USPTO in performing tasks (e.g., for paper filings, use of WIPO’s official form).



USPTO Implementation

- Madrid applications are integrated into the USPTO's national application stream.
- The Madrid Processing Unit (MPU) was created to handle all Madrid processing, except examination.
- The USPTO computerized as much of the Madrid application process as possible.
- Created an electronic form for filing the IA that “pre-populates” the form with information from the U.S. national application/registration.
 - Eliminated key entry and other data errors and simplified the IA certification process.
- The USPTO and WIPO agreed to exchange all data electronically.
- The USPTO and WIPO agreed to monthly accounting of fees.



Decisions USPTO Made: Post Registration

- Requirement for “Affidavit of Use”:
 - between the 5th and 6th year after registration
 - between the 9th and 10th year after registration
 - between the 19th and 20th year, etc.



Information Technology Considerations

- Inventory current capabilities.
- Creation of a workflow system for communication between the USPTO and WIPO.
 - The USPTO developed technology in conjunction with WIPO.
- WIPO software package?
- Creation of electronic forms for Madrid filings
- Changes to accommodate (including publishing) color images
- Accommodation of the IB character set.



Deadlines

- Many tasks of USPTO must be completed within the time limits set forth in Madrid Protocol
 - 2 months for certification and forwarding of IA to WIPO
 - 3 months for responding to irregularities from IB
 - 12-18 months for refusal of protection (i.e., provisional refusal)
- Must prioritize and develop work steps to ensure deadlines are not missed



Language

- Must choose working language to receive data from WIPO.
- Madrid Protocol vocabulary that must be learned and understood (e.g., provisional refusal, holder, final decision, renunciation).
- If official language of Office of Origin is not one of 3 working languages of WIPO, will a translation function be needed?



Outgoing Certification Considerations

- USPTO national applications are reviewed by examining attorneys.
- The USPTO decided to use non-attorneys for role of certification of IAs.
- Rules provide for no amendment of IA. If not in condition for certification, IA is denied.
- Existing mechanism for recourse in cases of error -- petition to the Director of Trademarks of USPTO.
- Strict standards in comparison of elements to be certified.



U.S. Applicant/Registrant Seeking International Registration

Request for international registration (an international application) is received by the USPTO

USPTO certifies that the information in the international application conforms to data in the basic U.S. application or registration

USPTO sends international application data to WIPO (2 month deadline to maintain international registration date)

Is the application formal?

YES?

WIPO registers and forwards extension requests to designated countries for examination

Examination process begins in each designated country (Contracting Party)

NO?

WIPO notifies Applicant and the USPTO if the international registration is informal



Processing Notices of Irregularity from the IB

- Additional workload in addition to certification of IAs.
- Time limits imposed by WIPO
- Decision to make: Passive versus active role?

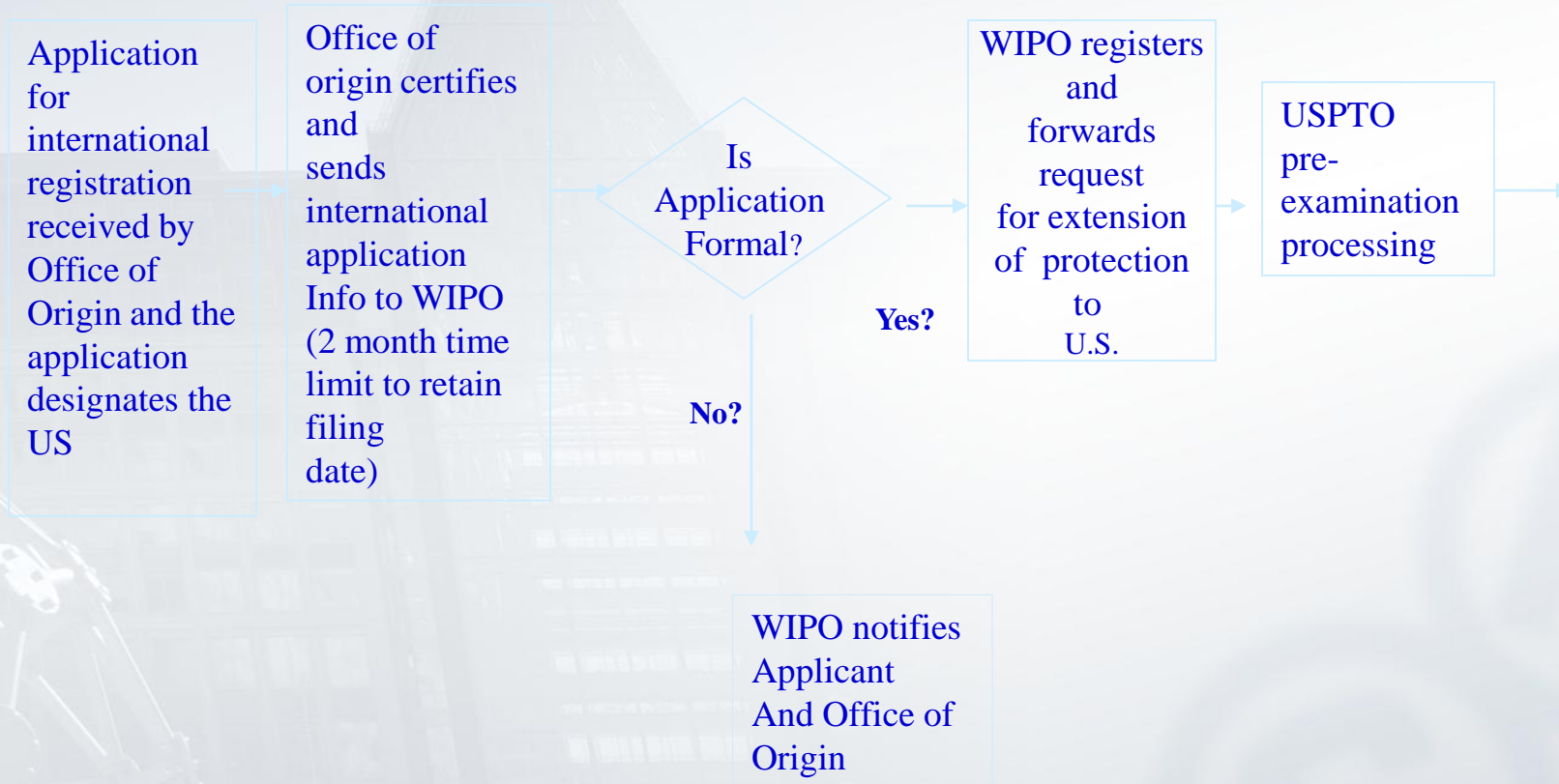


Incoming Examination Considerations

- Classification and identification of goods/services
 - WIPO controls classification – How will this be addressed if different?
- Corrections to filings (e.g., wrong mark, filing date, incorrect list of goods/services)
 - How will they be processed?
- Delayed notification of new applications from IB
 - How older filing dates may effect examination?



Non-U.S. Trademark Owner Seeks an Extension of Protection to the U.S.





Non-U.S. Trademark Owner Seeks an Extension of Protection to the U.S. Continued

Examination of the REP (all Issues must be raised within 18 months)

Approved for Publication?

YES?

Published in the Official Gazette?

Opposition ?

NO?

Extension of protection given effect from either date of international registration or date of extension request

YES?

All grounds identified w/in 7 months of Start opposition period

NO?

Appeal to TTAB or abandonment

Opposition granted ?

Extension Abandoned



Outreach

- Upon accession:
 - Internal: Created MPU, established examination guidelines, trained all examiners.
 - External: Lectures for practitioners, such as INTA, AIPLA, and various state bar groups.
- Recent/Current:
 - Intellectual Property Awareness Campaigns (IPACs)
 - USPTO Advanced Madrid Seminar (October 2013)
 - Online Resources

The USPTO does not provide legal advice or represent owners before other offices.



Outreach

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Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks -- the **Madrid Protocol** -- is one of two treaties comprising the Madrid System for international registration of trademarks. The protocol is a **filing** treaty and not a substantive harmonization treaty. It provides a cost-effective and efficient way for trademark holders -- individuals and businesses -- to ensure protection for their marks in multiple countries through the filing of one application with a single office, in one language, with one set of fees, in one currency. Moreover, no local agent is needed to file the application. While an International Registration may be issued, it remains the right of each country or contracting party designated for protection to determine whether or not protection for a mark may be granted. Once the trademark office in a designated country grants protection, the mark is protected in that country just as if that office had registered it. The Madrid Protocol also simplifies the subsequent management of the mark, since a simple, single procedural step serves to record subsequent changes in ownership or in the name or address of the holder with World Intellectual Property Organization's International Bureau. The International Bureau administers the Madrid System and coordinates the transmittal of requests for protection, renewals and other relevant documentation to all members.

Special Notices

UPCOMING EVENT: USPTO Announces [Madrid Protocol Seminar](#).

TEASi International Application Priority Deadline

If you have a priority filing deadline of today and cannot file electronically, please fill out the MM2 form from the WIPO website at <http://www.wipo.int/madrid/en/forms/> and then file a "Petition to the Director under Trademark Rule 2.146" (http://www.uspto.gov/trademarks/teas/petition_forms.jsp) using the basic application serial or registration number. Attach the MM2 form in the "File Upload" section. Request that the \$100 petition fee be applied to the U.S. certification fee (s). Indicate whether you would like to be contacted to provide the international application fees, that you authorize payment to USPTO deposit account or that you will pay WIPO directly. You will be notified of any certification fee deficiency. Once the petition is filed, contact the Petitions Office at 571-272-8950 and let them know that an International Application was filed by petition. Provide the basic application serial or registration number used for filing the petition and request that processing be expedited.

Basics

- [MADRID FAQs](#)
- [Madrid System for International Registration of Trademarks](#)
- [Section 66\(a\) Timeline: Application based on Madrid Protocol](#)
- [Post Registration Timeline for Madrid Protocol-Based Registrations](#)

Procedures and Guides

- [Electronic forms for submitting Madrid-Protocol related documents](#) (NOTE: Madrid TTAB e-forms are available)
- [FAQs After Filing an International Application](#)
- [Petition to Review Denial of Certification Information Sheet](#)
- [Registered Extension of Protection Maintenance Requirements](#) (UPDATE: 17Mar2010)
- [Sample Section 71 Declaration](#)
- [Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals](#) (a World Intellectual Property Organization Information Notice)
- [Tips for Filers of Responses to Notices of Irregularity](#)
- [Tips for Paper Filers](#)
- [Trademark Manual of Examining Procedure \(TMPE\), Chapter 1900 - Madrid Protocol](#)
- [WARNING: Communications Issued by 3rd Parties Unrelated to WIPO](#)

- Trademark Search
- Trademarks Process
- News & Notices
- Manuals, Guides, Official Gazette
- Laws & Regulations
 - Rule Making
 - **Madrid Protocol**
 - Forms
 - Fastener Quality Act (FQA)
 - Native American Tribal Insignia
- Online Filing
- Contact Trademarks

Tools

- [Trademark Electronic Search System \(TESS\)](#)
- [Trademark Electronic Application System \(TEAS\)](#)
- [Trademark Status and Document Retrieval \(TSDR\)](#)
- [Electronic Trademark Assignment System \(ETAS\)](#)
- [Assignments on the Web \(AOTW\)](#)
- [Trademark Trial and Appeal Board \(TTAB\)](#)
- [Trademark Manual of Examining Procedure \(TMPE\)](#)

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Madrid FAQs

The Madrid Protocol Frequently Asked Questions by U.S. Trademark Owners Seeking International Rights

- [What is the Madrid Protocol?](#)
- [Which countries are members of the Madrid Protocol?](#)
- [When did the Madrid Protocol become effective in the United States?](#)
- [Who can submit an international application through the USPTO?](#)
- [What are the requirements for submitting an international application through the USPTO?](#)
- [Can a U.S. trademark owner file an international application directly at the International Bureau?](#)
- [What is the cost for filing an international application through the USPTO?](#)
- [How can a U.S. trademark owner file an international application with the USPTO?](#)
- [What other electronic Madrid Protocol forms are available?](#)
- [What happens after the international application has been submitted to the USPTO?](#)
- [Will the International Bureau automatically register the mark in an international application once it has been certified by the USPTO?](#)
- [What is a Notice of Irregularity with respect to an International Application and how do I respond to it?](#)
- [What is the date of the international registration?](#)
- [Can an international applicant claim a priority filing date based on a U.S. basic application?](#)
- [What happens after the International Bureau registers the mark in the international application?](#)
- [After the mark in an international application registers, can the holder of the international registration request an extension of protection in additional countries?](#)
- [Can a subsequent designation be submitted through the USPTO for forwarding to the International Bureau?](#)
- [What is the duration of an international registration?](#)
- [If the U.S. application or registration that forms the basis of the international registration is abandoned, cancelled or expires, will the international registration be cancelled?](#)
- [Where can I get more information about the Madrid Protocol?](#)

What is the Madrid Protocol?

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol) is an international treaty that allows a trademark owner to seek registration in any of the countries that have joined the Madrid Protocol by filing a single application, called an "international application." The International Bureau of the World Intellectual Property Organization, in Geneva, Switzerland administers the international registration system.

The resulting "international registration" serves as a means for seeking protection in member countries, each of which apply their own rules and laws to determine whether or not the mark may be protected in their jurisdiction. Neither the Madrid Protocol nor the Madrid Agreement provide for registration of an "internationally effective" trademark.



Outreach

Madrid Protocol: Tips for Filers of Responses to Notices of Irregularity

Madrid Protocol: Responding to Madrid Notices of Irregularity

After an International Application is certified by the United States Patent and Trademark Office (USPTO), it is forwarded to the International Bureau ("the IB") of the World Intellectual Property Organization (WIPO). Whenever the IB considers that there is an irregularity in an International Application, the IB will notify both the USPTO (as Office of origin) and the applicant.

The USPTO has deployed [electronic forms](#) for the filing of a response to a Notice of Irregularity in an international application.

- [Types of Irregularities](#)
- [Nature of Review of Response by USPTO](#)
- [IB Proposal Requiring Transfer of Goods/Services and/or Additional Fees](#)
- [Responses Regarding Vague or Incomprehensible Language](#)
- [How to Respond to a Notice of Irregularity](#)
- [Timeliness Considerations for a Response to an Irregularity Notice](#)

Types of Irregularities

The IB identifies three general categories of irregularities:

- a. Irregularities with respect to the classification of goods/services
- b. Irregularities with respect to the indication of goods/services
- c. Other irregularities



Thank You!

