

Madrid Protocol: United States of America

Alan Morgan Datri

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1

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Patents

Trademarks

IP Policy

Learning and Resources

Quick Links

Home / Trademarks / Laws & Regulations / Madrid Protocol

Share | Print

Helpful 24

Not Helpful 9

Laws & Regulations

Fastener Quality Act (FOA)

Madrid Protocol

Forms

Native American Tribal
Insignia

Rule Making

ACCESSION OF THE LAO PEOPLE'S DEMOCRATIC REPUBLIC TO THE MADRID PROTOCOL: Effective March 7, 2016, international applications may now include designations to the Lao People's Democratic Republic. Further information can be found at http://www.wipo.int/edocs/madrdocs/en/2016/madrid_2016_2.pdf.

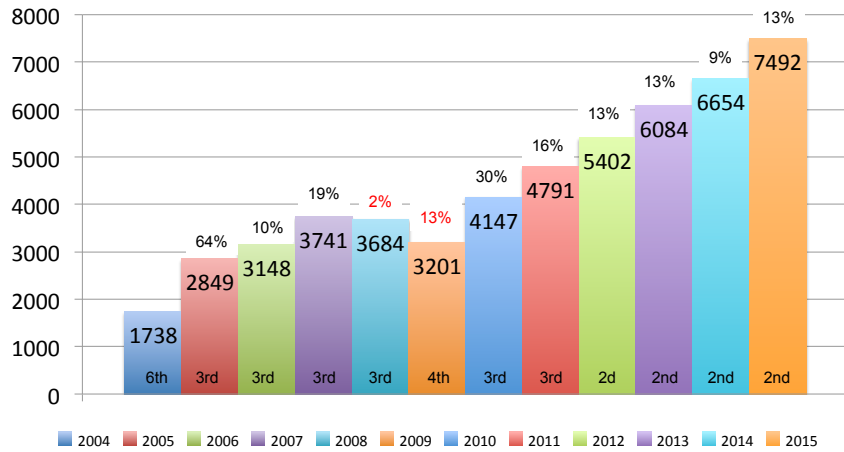
Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Trademarks. The protocol is a **filing** treaty and not a substantive law. It provides an effective and efficient way for trademark holders -- individuals and companies -- to register their trademarks in multiple countries through the filing of one application with the USPTO. Registration may be issued, it remains the right of each country to determine whether or not protection for a mark may be granted. If a country grants protection, the mark is protected in that country just as if it were registered there. The Protocol also simplifies the subsequent management of the mark to record subsequent changes in ownership or in the name or address of the holder with World Intellectual Property Organization (WIPO).

Basics
Procedures and Guides
Rules
Laws
Seminars
WIPO Notices
Special Notices

USPTO as “Office of Origin”

International Applications Received by WIPO



WIPO Statistics Database

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3

Top “Countries of Origin”

Applicant’s Country of Origin	2014	Growth
United States of America	6,595	+9.1%
Germany	6,506	-4.8%
France	3,802	-9.9%
Switzerland	3,144	2.4%
United Kingdom	2,946	19.3%
Italy	2,742	-1.5%
China	2,225	-5.5%
Japan	2,081	8.3%
Australia	1,556	23.3%
Netherlands	1,402	4.2%

WIPO Statistics Database

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4

US Applicants in Top 50

Applicant	2014	Rank
Apple	50	16
Wikimedia Corporation	41	19
Microsoft	31	33
Payless Shoesource Worldwide	31	33
Avon Products	27	41
Trident Group LLC	26	43
IBM	25	49
All others	< 25	N/A

Madrid Processing Unit

- **Role as Office of Origin**
 - Examines the international application
 - Responds to irregularity letters issued by IB
 - Examines subsequent designations
 - Notifies IB of ceasing of effect of goods and services in basic mark
- **Role as Designated Contracting Party**
 - Reviews provisional refusals by examiners for compliance before sent to IB
 - Correction notices
 - Limitation notices
 - Restrictions
 - Final Decisions
 - Transformation and Replacement Requests
 - Invalidations

USPTO: OFFICE OF ORIGIN

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7

Entitlement to File with USPTO

- **National**
 - National citizenship or jurisdiction of formation/
incorporation of legal entity
- **Domicile**
- **Real and Effective Industrial or Commercial Establishment (“Establishment”)**
 - Need not be principle place of business, but must
not be fraudulent or fictitious

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8

Fees

- In conjunction with international application
 - If TEAS, pay in USD directly to USPTO
 - If paper application, pay in CHF directly to WIPO
 - Deposit account; bank transfer
- In conjunction with WIPO irregularity letter
 - E-Payment; deposit account; bank transfer; credit card
 - USPTO will not accept or forward deficient fees set forth in irregularity letter

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9

Certification by USPTO

- Common Reasons for Denial
 - Ownership
 - Not the same mark
 - Description of the mark
 - Goods and services in international application exceed the scope of those in the basic mark
- Petition to Review Denial of Certification
 - Only way to respond to denial and/or amend international application
 - File immediately after notification via TEASi

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10

WIPO Irregularities

Types

- Classification of goods and services
 - Not classified or in wrong class
- Indication of goods and services
 - Too vague for the purposes of classification, linguistically incorrect or incomprehensible
- Other irregularities
 - Improper form; missing or defective particulars; defective certification; insufficient fees; etc.

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11

WIPO Irregularities

Actions

- Corrected by USPTO
 - Missing particulars; defective certification
- Corrected by Applicant via the USPTO
 - Classification and indication/identification of goods and services
- Corrected by Applicant
 - Fees
- Corrected by Applicant or via USPTO
 - Defective particulars

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12

Notification of Ceasing of Effect

- Applies to the indication/identification of goods and services only
 - Changes to reproduction of mark, owner, address, any other indication (disclaimer, description of the mark, translation, etc.), etc., not notified
- Basic Application: notification sent at time of registration

USPTO: OFFICE OF DESIGNATED CONTRACTING PARTY




HIGHLIGHTS

SPECIAL EDITION
THE UNITED STATES PATENT AND
TRADEMARK OFFICE (USPTO)

CONTENTS

A SPECIAL EDITION OF MADRID HIGHLIGHTS	3
THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO) AS DESIGNATED CONTRACTING PARTY (DCP)	
TERMINOLOGY	4
REQUEST FOR EXTENSION OF PROTECTION TO THE UNITED STATES OF AMERICA	4
Introduction	4
Examination of Requests for Extension of Protection to the United States of America	5
Matter Registrable in the United States of America	5
Provisional Refusals Based on Absolute and Relative Grounds – Statutory Refusals	6
Provisional Refusals Based on Non-compliance with USPTO Requirements – Procedural Requirements	7
Search Mark for Availability in the United States of America	7

15


English

[Tutorial](#) | [Help](#) | [FAQ](#) | [Disclaimer](#) | [Madrid System](#) | [Nice Classification](#) | [Explanatory Notes](#) | [Contact us](#)

MGS • Madrid Goods & Services Manager

Import list
Export list
Print list
Delete list
Display preferences
Translate into...

Browse Search

Class 5

Class... NICE only

- N₀₅ alginates for pharmaceutical purposes
 - alginates for agricultural purposes
 - alginates for swimming pools
- N₀₅ alginate dietary supplements
- N₀₅ alginates for pharmaceutical purposes
- N₀₅ alkaline iodides for pharmaceutical purposes
- N₀₅ alkaloids for medical purposes
 - allergy capsules
 - allergy medication
 - allergy relief medication
 - allergy tablets
- N₀₅ alloys of precious metals for dental purposes

Edit class Clear class Check acceptance by designated Contracting Party (dCP)

5

Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

dCP	Accepted by dCP	dCP	Rejected by dCP	dCP	Status unknown		
US	050291	acetates for pharmaceutical purposes					
US	050433	alginates for pharmaceutical purposes					
US		chewing tobacco	Misclassified				
US		coti	NOT FOUND				

Terms: 4 - Words: 11

8

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Home / Trademarks / Trademark Updates and Announcements / Trademarks Next Generation Acceptable Identification of Goods and Services Manual (ID Manual-NG) Share Print

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Not Helpful 2

More Trademarks

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Recent Postings

Statutory and Regulatory Changes

User Input

Laws & Regulations

Trademarks Next Generation Acceptable Identification of Goods and Services Manual (ID Manual-NG)

The USPTO is pleased to announce the production Version 2.1 of the Trademarks Next Generation Acceptable Identification of Goods and Services Manual (ID Manual-NG). See <https://tmidm.uspto.gov>. The ID Manual-NG features basic and advanced searching options, results returned in a sortable table that may be printed from within the application, relevance ranking of entries that correlate to the search criteria, and highlighted search terms in all returned results. The ID Manual-NG is best viewed in Microsoft® Internet Explorer® Version 10 and higher, but is also accessible in Google® Chrome® browser version 42. Display resolution settings above 900px are recommended for optimal viewing of the search window and results table.

Available in tandem with the long-established “**legacy**” ID Manual, both systems will continue to be maintained and contain synchronized data. The USPTO encourages users to compare and contrast the two systems and provide feedback and suggestions.

Affidavits of Use

- Affidavits of use or excusable non-use
 - To be distinguished from renewals filed with WIPO every ten years after date of IR
- Affidavits of use must be filed between:
 - 5th and 6th year after registration by USPTO
 - 9th and 10th year after registration by USPTO
 - Every 9th and 10th year thereafter
- Time period runs from date of registration indicated in US registration certificate

Alan Morgan Datri

IPDatri@att.net

<https://www.linkedin.com/in/ipdatri>

Memphis, TN
(901) 201 6696

Washington, DC
(202) 657 6763

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19