

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



International Registration of Trademarks via The Madrid Protocol: Practice Tips for Avoiding Common Mistakes

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Topics

- Review Basic Records
- Methods of Filing International Application
- Madrid Processing Unit
- Certification and Denial of Certification of International Application
- Key Elements of International Application for Certification
- Other Considerations for International Application
- Irregularities Issued by IB
- After Registration

It's All About Ducks

- Get your ducks in a row BEFORE filing international application (IA)



- Clean up all **basic** applications/registrations **before** filing IA



Get Your Ducks in a Row

- Review information in **each basic** application/registration and ensure it is correct
- Mistakes and inaccuracies should be **fixed before** IA is filed
- **TSDR Data**: When filling out IA, use basic record data shown in Trademark Status and Document Retrieval (TSDR) system and not the Trademark Electronic Search System (TESS)

Get Your Ducks in a Row

Fixing Mistakes and Inaccuracies in Basic Record

- Amend Basic Application
 - If **assigned** to examining attorney → contact examiner to request necessary amendment(s)
 - If **not assigned** to examining attorney → may file voluntary amendment
- Amend Basic Registration
 - File §7 amendment with USPTO Post Registration Unit. 37 C.F.R. §2.173; TMEP §1609.01
- Filing Assignment in Basic Application/Registration
 - May file assignment with USPTO Assignment Recordation Branch using the USPTO Electronic Trademark Assignment System (ETAS). See TMEP Chapter 500



Methods of Filing IAs

- **Electronic:** Trademark Electronic Application Submission International System (TEASi) forms on USPTO website
 - **Pre-Populated Form:** One US base application/registration
 - **Free-Text Form:** More than one US base applications/registrations
- **Paper:** Must be submitted to USPTO on official WIPO MM2 form, available on WIPO website
 - Must use WIPO MM2 form
 - WIPO MM2 must be typewritten; no handwritten form accepted

Methods of Filing IAs – Pre-Populated Form

- Automatically loads with information already in USPTO database for one US basic application or registration number
 - If **no changes** to any data → automatically certified and transmitted to IB. No independent/human review of data at all
 - If **changes** to any to data → independent review by Madrid Processing Unit (MPU) before certified and forwarded to IB

Methods of Filing IAs – Pre-Populated Form

- If there are **mistakes** in basic → mistakes will be in IA, will be in international registration (IR), and cannot be corrected
 - Examples: hyphens, punctuation, wrong type of mark
 - This may affect protection in designated countries
 - Color image but no color claim will generate a black and white mark image
 - Assignment of change of ownership did not automatically upload – check assignment record

Methods of Filing IAs – Free-Text From

- Use when
 - More than one US basic applications/registrations serve as basis for IA; or
 - US basic application **not yet uploaded** in USPTO database as of filing of IA
- Information NOT automatically pre-populated; must be manually entered
- IA not automatically certified → routed to MPU for independent/human review
- Because form must be manually completed, if data of basic record is not replicated exactly as required, IA may be denied certification

Madrid Processing Unit (MPU)

Staff

- 1 Supervisor + 1 lead + number of specialists
- All are non-attorneys
- All are specially trained and have production requirements
- Providers of customer service for Madrid information and main points of contact to internal and external users
- Staff attorney liaisons to MPU to provide legal policy and petition guidance

Duties

- Review IAs
- Review subsequent designations
- Review applicants' responses to notices of irregularities
- Issue notices of ceasing of effect of basic applications/registrations that serve as bases of IAs/IRs
- Perform variety of other Madrid Protocol-related tasks

Madrid Processing Unit (MPU) – Review IA

- Review IA for minimum filing requirements – **compare** data in IA with data in each basic record. TMEP §1902.03
 - If requirements **met** → **certify** and forward IA to IB
 - If requirements **not met** → **deny** and notify applicant
- Information in IA must be **same** as information in each basic record
 - Goods/Services in IA must be **same as or narrower** than goods/services in each basic record

Madrid Processing Unit (MPU) – Review IA

- IA must be in condition to certify **as submitted** or will be denied
- MPU must certify or deny IA within **2 months** of date of receipt of IA in USPTO
 - Generally reviewed within 2 business days
- Documents not retained
 - Scanned and forwarded to IB or returned to applicant

Denial of Certification of IA by MPU

- If IA does **not meet** filing requirements → MPU denies certification
 - MPU sends letter to applicant informing of reasons for denial
- MPU decision to deny certification is **final**
 - Applicant cannot respond to MPU's denial – no back and forth
 - Applicant cannot amend IA

Denial of Certification of IA - Petition

- Applicant's only recourse after MPU denies certification → file a **petition** to the Director of USPTO. 37 C.F.R. §7.40; TMEP §1902.03(a)
- Petitions regarding denials are **expedited** to meet the 2-month deadline
 - If denial due to USPTO error → petition fee refunded
 - If denial due to applicant error → petition fee not refunded
- Contact USPTO Petitions Office at 571-272-8950 with questions and guidance **before** filing IA

Transmission of Information Between USPTO and IB

From USPTO to IB

- USPTO sends transactions to IB every day in a batch file (not individually)
- USPTO sends fees to IB once a week

From IB to USPTO

- USPTO receives transactions from IB once a week – every Thursday
- USPTO receives fees from IB once a month

Before Filing IA Get Your Ducks in a Row

Key Elements of IA for Certification

- Ownership: Name, Entity, and Citizenship
- Reproduction of Mark (Drawing)
- Description of Mark
- Identification and Classification of Goods/Services
- Entitlement

Key Elements – Ownership



Owner Name, Entity, and Citizenship

- Must be **same** in IA and in each basic record. Common Regs., Rule 9(4)(a)(i)
- **Fixing** ownership issues in basic application/registration
 - Amend basic record, or file assignment
 - If assignment filed within days of filing IA: Wait until Assignment Recordation Branch has recorded it before filing IA to ensure that correct owner appears in USPTO records
 - Example: Mistake in owner name or legal entity may or may not be correctible. See TMEP §1201.02(c)

Key Elements – Ownership

Owner Address

- If applicant's current address is outside of US → must provide address of US domicile or establishment

Key Elements – Reproduction of Mark (Drawing)



- Must be **same** in IA and in each basic application/registration
 - **Basic – B&W / No Color**: If basic mark is depicted in black and white but no color is claimed → mark image in IA must be black and white
 - **Basic – Color**: If basic mark is depicted in color and regardless of if color is claimed → mark image in IA must be color

Common Regs., Rule 9(4)(a)(v)-(vii*bis*)

Key Elements – Reproduction of Mark (Drawing)

Old US Registrations

- For old US registrations with black and white mark and lining statements
 - **Basic – B&W / Color:** If basic mark is depicted in black and white and color is claimed → IA must contain both black and white and color images

Key Elements – Reproduction of Mark (Drawing)

Color Claim – TEASi Forms

- Color **intended** in IA
 - If basic mark depicted in color but no color claim → must use free-text TEASi form to upload color image in IA
 - Using pre-populated TEASi form will generate black and white image in IA, resulting in denial of certification as marks are not same
- Color **not intended** in IA
 - If basic mark depicted in color but no color claim → must amend basic mark to black and white before filing IA

Key Elements – Reproduction of Mark (Drawing)

- Paper IA: Mark must appear and fit in **Box 7** on WIPO MM2 form
- Special Types of Marks: **Check box** in IA to indicate if basic mark is
 - Three-Dimensional mark: Trade dress (e.g., product design or packaging, interior/exterior of buildings)
 - Sound mark
 - Collective mark or certification mark

Common Regs., Rules 9(4)(a)(viii)-(x); 37 C.F.R. §7.11(a)(6); TMEP §1902.02(l)

Key Elements – Description of Mark



- Must be **same** as in each basic application/registration **even if** description of mark in basic record is inaccurate or incomplete. Common Regs., Rule 9(4)(a)(xi)
- Nature of mark
 - Standard character: Are legally equivalent to typed drawings
 - Non-standard character: Color claim, color location statement, and/or description of mark
- USPTO does **not** send notifications of mark changes to IB
- Color claim and color location statements **must** be included, if color is claimed in each basic application/registration
 - List of colors claimed in mark
 - Explanation of where each color appears in mark

Key Elements – Identification of Goods/Services



- Must be **same as or narrower than** goods/services in basic application/registration
- If goods/services are not the same for each designated country → include a **limitation** in IA
 - List specific goods/services that apply to each designated country
 - Ensure limited goods/services are within scope of basic goods/services

Common Regs., Rule 9(4)(a)(xiii); 37 C.F.R. §7.11(a)(7); TMEP §1902.02(f); see also TMEP §1402.07

Key Elements – Classification of Goods/Services

- MPU does **not certify** classification stated in IA. TMEP §1902.02(g)
- IB determines proper classification, based on Nice principles
- Applicant must use edition of Nice Agreement in effect as of filing date of IA
- If classification incorrect → IB will issue notice of irregularity and require applicant to re-classify and pay any fees due, if appropriate
- Applicant may add, delete, or change classification but only in accordance with the Nice Agreement. TMEP §§1902.02(g)-(g)(i)
 - Example: Applicant may delete goods/services instead of adding class and/or paying more fees

Key Elements – Entitlement



- Applicant must **specify entitlement grounds**, i.e., applicant:
 - Is a national of (citizen of) US;
 - Has domicile in US – must indicate US address of the claimed entitlement; or
 - Has real and effective commercial or industrial establishment in US – must indicate US address of the claimed entitlement

Common Regs., Rule 9(5)(b); 37 C.F.R. §7.11(a)(11); TMEP §1902.02(j)

Key Elements – Entitlement



- “United States” includes and embraces all territory under US jurisdiction and control
 - Includes: 50 states, District of Columbia, commonwealths (Puerto Rico, Northern Mariana Islands), and territories and possessions of the US (Guam, U.S. Virgin Islands, American Samoa)
- “National” has same meaning as in Article 2 of Paris Convention. Can be national citizenship of an individual or jurisdiction of formation or incorporation of a legal entity
 - Question of whether a natural person or a legal entity is a “national” of or has a “domicile” in a particular country is a **matter of law of each designated country**

Key Elements – Entitlement

- “Real and effective industrial or commercial establishment” is taken from Article 3 of Paris Convention
 - Need not be the principal place of business, but must be “real,” i.e., not fraudulent or fictitious
 - No case law exists relating to Madrid filings, but same meaning of “real and effective industrial or commercial establishment” that applies in §44 filings applies to Madrid entitlement. Section 44 is based on Paris Convention and Madrid incorporates provisions of Paris Convention
- Establishing country of origin. TMEP §1002.04
 - The presence of an applicant’s wholly owned subsidiary in a country does not, by itself, establish country of origin. *In re Aktiebolaget Electrolux*, 182 USPQ 255 (TTAB 1974)
 - Fact that applicant is wholly owned by a foreign company does not establish country of origin. *Karsten Mfg. Corp. v. Editoy AG*, 79 USPQ2d 1783 (TTAB 2006)
- USPTO cannot advise about entitlement
 - An enterprise may have several real and effective industrial or commercial establishments in different countries that are party to the Madrid Protocol and, thus, may have option of several countries of origin

Other Considerations for IA

- Marks on Supplemental Register
- Additional Information in IA: Translation and Disclaimer
- Dependence

Other Considerations – Marks on Supplemental Register

- Marks applied for or registered in US on USPTO Supplemental Register → **may be used** as basic application/registration
- Substantive refusals in US basic application/registration
 - Example: If mark is found descriptive in US → does not mean it will be found descriptive in other designated countries

Other Considerations – Additional Information in IA

- Information may be provided in IA to avoid a requirement by a designated country. Examples:
 - **Translation** of elements of mark into English, French, or Spanish. Common Regs., Rule 9(4)(b)(iii); TMEP §1902.05
 - Indication that terms in mark have no meaning and cannot be translated
 - **Disclaimer** of any part of mark. Common Regs., Rule 9(4)(b)(v); TMEP §1902.05
 - Just because disclaimer exists in basic application/registration, it is not required to be included in IA

Other Considerations – Dependence

- **IR** is dependent on basic application/registration for **5 years**
- Any **extension of protection granted** in a designated country is also dependent on basic application/registration for **5 years**
- Within 5-year period → USPTO must **notify IB** to restrict or cancel IR, either totally or partially: if basic application abandons, registers, or is divided; or if basic registration cancels or is divided
- **IB** will **restrict or cancel IR** accordingly and notify all designated countries

Common Regs., Rule 22(2)(b); TMEP §§1902.09, 1902.12

Other Considerations – Dependence

- USPTO obligation to notify IB of outcome of basic application/registration extends **only** to:
 - Registration of basic application – all or some goods/services protected in US
 - Abandonment of basic application – no goods/services protected in US
 - Cancellation of the basic registration – goods/services no longer protected in US
- “**Ceasing of effect**” – informing IB of specific goods/services protected in US
- Changes in basic record to drawing, description, translation, owner, and address are **not notified** to IB
- End of 5 Years: IR and every extension of protection becomes **independent** of basic application/registration

Other Considerations – Caution About Dependency

- **Changes** in basic record during prosecution or after registration may have unintended **negative consequences** in IR
 - Mark may be **different** by the time basic application registers
 - Example: Basic mark filed as RIGHT-ON. IA mark registers as RIGHT-ON. Basic mark registers as RIGHT ON (no hyphen). No provision in Madrid rules to change mark in IR to RIGHT ON
 - Goods/Services may be **different** by the time basic application registers
 - Example: In response to USPTO refusal, “headgear” in Class 025 is amended to “motorcycle helmets” in Class 9. USPTO will notify IB that “headgear” in Class 25 has “ceased” to have effect in US
- Applicants encouraged to **wait** until at least USPTO issues **first Office action**
 - Priority may be claimed if IA is filed within 6 months of filing date of US basic application
- If changes in basic record → IR only updated with final basic goods/services
 - May result in IR protecting one type of mark and/or goods/services and basic registration protecting different type of mark and/or goods/services

Irregularities Issued By IB

Notice of Irregularity Issued by IB

- When examining IA, IB may issue 1 or more irregularity if there are deficiencies in IA
- Irregularities may be issued for any reason, e.g.,:
 - Classification of goods/services
 - Identification of goods/services
 - Fees

37 C.F.R. § 7.14; TMEP §1902.07

Response to Notice of Irregularity

- Some irregularities → remedied by **USPTO**, e.g., omission of drawing or USPTO signature
- Other irregularities → remedied by **applicant directly with IB**, e.g., fees
- Yet other irregularities → remedied by **applicant through USPTO** and forwarded to IB, e.g., amending goods/services
 - Classification of goods/services not proper. Common Regs., Rule 12
 - Identification of goods/services is too vague for purposes of classification, incomprehensible, or linguistically incorrect. Common Regs., Rule 13
- Applicant's response deadline is generally **3 months** from the date of notice
 - Suggest filing response with USPTO at least **1 month before deadline** to allow review
 - MPU will not process response received after IB's response deadline

Applicant's Response to Notice of Irregularity

Goods/Services

- MPU will review goods/services in response to ensure they are **within scope** of basic goods/services at the time response is reviewed
 - If basic goods/services were amended since the date IA was filed → goods/services in response must be **within scope** of amended goods/services
- If goods/services in response **exceed scope** of basic goods/services as amended → MPU will **not forward** response to IB and will notify applicant that proposed amendment does not conform to basic goods/services
 - If response deadline not expired → applicant may submit new response and, if acceptable, MPU will forward to IB

Applicant's Response to Notice of Irregularity

Goods/Services

- If goods/services are **not amended** to remedy the irregularity within IB's response deadline and all other IA requirements are met, IB will:
 - **Include** the unacceptable wording/terms in goods/services in IR with indication that IB considers such wording/terms to be unacceptable, if **classification** of problem wording/terms was **specified** in IA; or
 - **Delete** the unacceptable wording/terms and notify both USPTO and applicant, if **classification** of problem wording/terms was **not specified** in IA

Common Regs., Rule 13(2)(b)

After Registration

- Maintaining International Registration
- Changes to International Registration
- Maintaining Extension of Protection to the United States

Maintaining International Registration

- IR is valid for **10 years**
- May be renewed for 10 years
- Must be renewed **directly with IB** on WIPO MM11 form and with payment of renewal fee
 - USPTO will not process or forward request for renewal of IR to IB
- If not renewed → IR will be **cancelled** and IB will notify all designated countries

See Madrid Protocol, Articles 6(a), 7(1); Common Regs., 20-31; 37 C.F.R. §7.41; TMEP §1905



Changes to International Registration

- Changes to IR must be filed directly with IB
 - Change in owner/holder name, entity, citizenship, and address
 - Change in name and/or address owner/holder representative
 - Limitations of goods/services
 - Renunciation of a designated contracting party
 - Cancellation of IR

Madrid Protocol, Articles 9, 9*bis*; Common Regs., Rule 25; TMEP §1906.01

- WIPO offers **official forms** for filing these changes



Changes to International Registration

Change in Owner Name, Entity, Citizenship, and Address

- **Change in Ownership:** To record a change due to transfer of property from one legal entity to another, or a change in the nature of legal entity → use WIPO **MM5** form
 - IB does not require evidence of change in ownership, so supporting documents should NOT be sent to IB (e.g., copies of deed of assignment or other contract)
- **Change in Name and/or Address:** To record a change in name and/or address only (including address for correspondence) → use WIPO **MM9** form

Maintaining US Registration – §71 Affidavit

- Must maintain the registered extension of protection to the US (i.e., USPTO §66(a) registration)
- Owner/Holder of US §66(a) registration must file affidavit of use in commerce or excusable nonuse (“§71 affidavit”) **directly with USPTO** during designated time periods
 - Use was not required to obtain US registration but use is required to maintain US registration
- Holder may sign up for USPTO electronic reminder notifications

Maintaining US Registration – §71 Affidavit

- “Holder” → natural or juristic person in whose name IR is recorded with IB
- If timely and acceptable §71 affidavit not filed → USPTO will **cancel** registration and notify IB
 - IB will **invalidate** protection in US
- Changing “holder” may only be done directly with IB and not USPTO
 - Holder cannot file assignment with the Assignment Recordation Branch of USPTO
 - Actual evidence cannot be submitted to USPTO to establish ownership

Maintaining US Registration – §71 Affidavit

Time Periods for Filing

- Between 5th and 6th year of the date USPTO issued certificate of registration
- Between 9th and 10th year of the date USPTO issued certificate of registration
- Each successive 10-year of the date USPTO issued certificate of registration

Filing Requirements

- Section 71 declaration itself
- One specimen, per class
- Fee, per class

Important Trademark Contact Information

- **Assignments Recordation Branch** → 571-272-3350 (M-F 8:30am-5pm ET)
- **Madrid Processing Unit (MPU)** → 571-272-8910 (M-F 8:30am-5pm ET) or email MPU@uspto.gov
- **Petitions Office** → 571-272-8950 (M-F 9am-5pm ET)
- **TEAS and TEASi** online forms technical difficulties → email TEAS@uspto.gov (M-F 8am-8pm ET)
- **Trademark Assistance Center (TAC)** → call 800-786-9199 (M-F 8:30am-8pm ET) or email TrademarkAssistanceCenter@uspto.gov



Resources

- *Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol*, Chapter II concerns international procedure
- US Rules of Practice in Trademark Cases, 37 C.F.R. §§7.11–7.14 govern international applications
- *Trademark Manual of Examining Procedure* Chapter 1900 concerns Madrid Protocol:
 - Section 1902 discusses international applications
 - Section 1904 discusses requests for extension of protection to the US
- Madrid Highlights
- Madrid Information Notices
- WIPO ROMARIN and USPTO website to check status of application/registration

THANK YOU

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