

UNITED STATES
PATENT AND TRADEMARK OFFICE





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UNITED STATES
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International Protection for Trademarks

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Session on International Protection

- Trademark Protection Outside the U.S.
 - International Trademark Basics
 - Paris Convention Basics
 - Madrid Protocol Basics
 - Filing Tips and General Precautions

Trademark Protection Outside the United States



Why protect in other countries?

- Are you exporting to another country?
 - Are you setting up business in another country?
 - Do you plan to?
 - Are counterfeits being produced or sold in another country?
-
- **Trademark rights are territorial. Your U.S. registration protects you only in the U.S.**



Recap: Trademark Basics

- Trademarks are source identifiers. They tell consumers the source of goods/services and help distinguish between different products.
- This is a universal concept.
- But different countries implement protections differently.



International Trademark Basics

- Most other countries are first-to-file systems.
- Most other countries do not have use requirements to register.
- Most other countries do not search for conflicting marks.
- Some do not register slogans, trade dress, or non-visual marks.
- All allow broader IDs than U.S.*



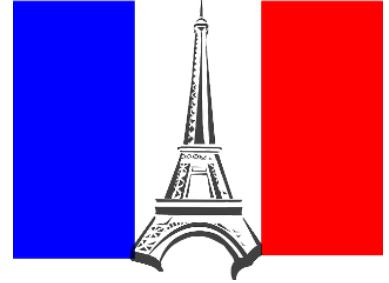
Options for Foreign Filing



- **File a trademark application directly with a foreign national or regional trademark office.**
 - You will file directly if you want to use the Paris Convention filing mechanism.
 - Developed countries typically have an efile process.
- **File for an International Registration under the Madrid Protocol.**



Paris Convention Filing



- File directly in any Paris Convention member country.
- Use a U.S. registration as the basis.*
- If filed w/in 6 months of U.S. filing date, you will be given the U.S. filing date as your priority date.
- Foreign filing must be the same as the U.S. registration.



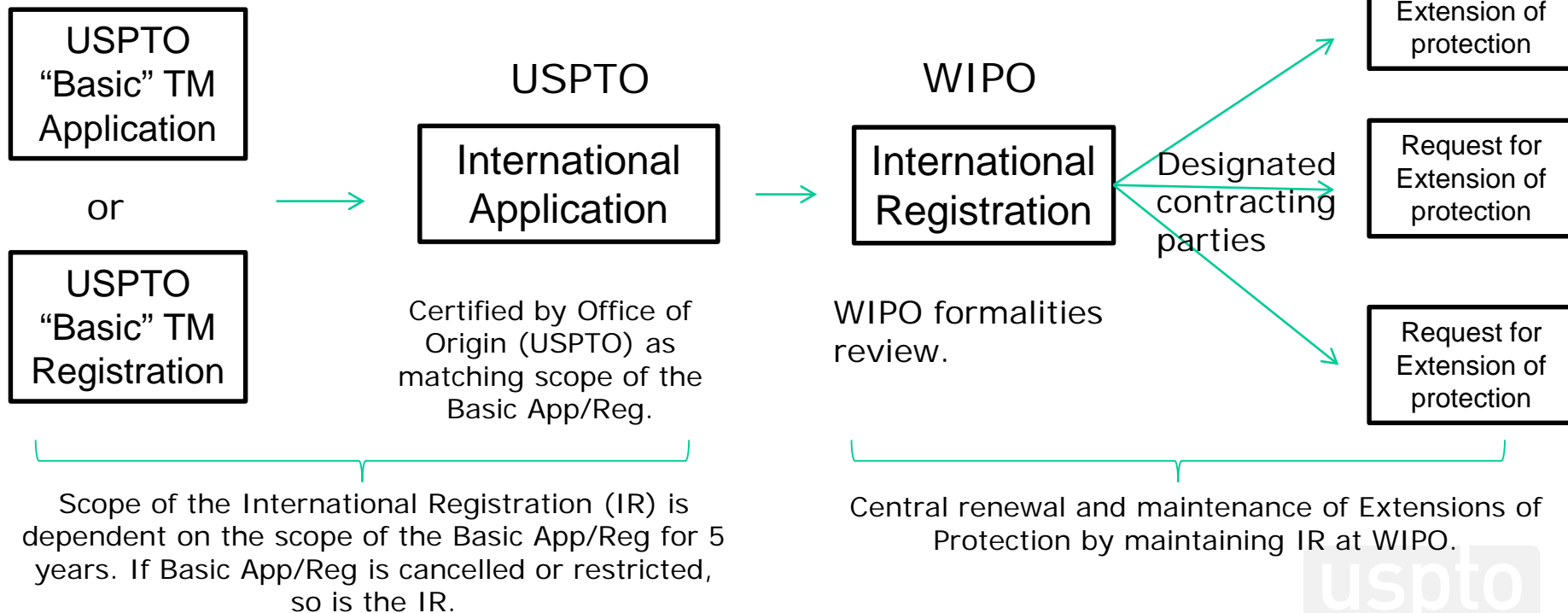
Madrid Protocol

- Provides centralized application and maintenance processing through the International Bureau (IB).
- Use one or more U.S. applications/registrations as the basis, but must be same owner, same mark, same or narrower listing of goods/services.*
- If filed w/in 6 months of U.S. filing date, you will be given the U.S. filing date as your priority date.



Madrid Process Overview for U.S. Filers

Basic Mark



Filing via the USPTO TEAS International Application Form

PTO Form 2131 (07/31/2009)
OMB No. 0651-0051 (Exp. 07/31/2009)



United States Patent and Trademark Office

Application for International Registration

SELECTION OF FORM TYPE FOR APPLICATION FOR INTERNATIONAL REGISTRATION

What type of form do you wish to use?

PRE-POPULATED FORM

(Use for **one** U.S. serial/registration number; *narrowing* of goods/services and/or substitute color drawing are permissible data change within this form.)

Enter the **one** U.S. serial number or registration number as the basis of this International Application.

Enter the number with NO punctuation or other symbols included.

OR

FREE-TEXT FORM

(Use for multiple U.S. serial/registration numbers and/or for cases that do not yet appear in TAR and/or if changing data **other** than only *narrowing* goods/services and/or substituting color drawing.)

Enter the U.S. serial number(s) or registration number(s) as the basis of this International Application. Separate multiple numbers with a comma.



Paper-filed Applications

- For paper filing, U.S. rules of practice require applicants to use the official form as issued by the IB.
- The MM2 form is available for download on the WIPO website.
(<http://www.wipo.int/madrid/en/forms/>)
- The form must be typewritten. No hand-written forms will be accepted by the IB.

Maintenance



- The holder of the IR files renewals, address changes, assignments, changes to representatives, etc. through the IB.
- The IB then transmits the updates to all of the relevant national offices so they can update their records.
- This is one of the biggest advantages of using the Madrid System.

Dependency

- For 5 years from the IR registration date, the IR remains tied to the basic app/reg.
- During this time, whatever happens to the basic app/reg will happen to the IR.
- What happens to the IR happens to all of the designations (for life).
 - If the basic application/registration is canceled, the IR will be cancelled as well as all designations.
 - If the listing of goods/services in the basic app/reg gets narrowed, the same will happen to the IR and all designations.



End of Dependency

- At the end of the 5 year dependency period, the IR becomes independent of the basic(s).
- All designations are tied to the IR for the same period, regardless of when designated.
- So all designations break free from the basic(s) on the same day as the IR.



Madrid System Pros and Cons

Pros

- Centralized maintenance at the IB
- Single language – no translation costs
- Single currency

Cons

- Stuck with very narrow U.S. ID that may not adequately cover you under foreign laws.
- 5 year dependency – if the basic(s) is/are cancelled or g/s are removed from basic(s), the same happens to the IR and all designations.



Madrid Filing Tips



Filing Tips – Matchy-Matchy

- **Owner Info:**
 - All of the basic(s) must be identical before you file the IA.
 - The IA must be identical to the basic(s).
- **Marks:**
 - All of the basic(s) must be identical before you file the IA.
 - The IA must be identical to the basic(s).



Filing Tips– Matchy-Matchy

- **Mark Descriptions:**
 - All the basic(s) must be identical before you file the IA.
 - The IA must be identical to the basic(s).
- **Color Claim:**
 - All the basic(s) must be identical before you file the IA.
 - The IA must be identical to the basic(s).



Ninja Filing Tips

- Wait until you have received the first office action for your basic(s) before you file the international application (IA). **DEPENDENCY**
- Use the pre-populated TEASi form whenever possible.
- The goods/services in the IA don't have to be identical. It cannot list things not covered by the goods/services in the basic(s).



General Precautions

- If you will be doing business in a foreign country, you should consult with local counsel about all relevant local requirements, including those for protecting IPRs.
- Get a clearance search done before filing. Most IPOs do not check for prior conflicting marks during the application process.
- A TM registration does not give you a right to do business in a foreign country.



General Precautions

- Likelihood of confusion standards vary. To get the same scope of rights that you have in the U.S., you may need to file an additional foreign application (outside Madrid) that covers more g/s than your U.S. registration.
- Most countries allow much broader IDs than the U.S. Therefore, if you file directly in the country, you can get a broader scope of protection than you could via Madrid.
- A foreign TM registration may mean you can be sued in the foreign courts on a TM-related matter even if you are not yet doing business there.



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