

MADRID FILING AND REGISTRATION: Process, Basic Requirements, and Benefits
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Introduction

The Madrid Protocol (herein after “Madrid”) entered into force on December 1, 1995². The United States ratified Madrid in 2003³. Thanks to Madrid, trademark applicants and owners in Madrid member countries can file a single application in a single language, pay for the application with one currency, and allow for trademark protection in all Madrid member-countries. As of today, there are 91 Madrid member-countries.⁴

Madrid is operated by the World Intellectual Property Organization (WIPO), which maintains the International Registration of Marks and publishes the WIPO Gazette of International Marks. An applicant files a Madrid international trademark application with WIPO. In the application the applicant designates in which Madrid member countries, the applicant seeks a trademark registration. WIPO publishes the application in the WIPO Gazette. Later, WIPO forwards the application to the designated member-countries. Each designated country then examines the trademark pursuant to national laws. Consequently, Madrid provides trademark applicants an entree to potentially secure protection of trademarks in all member-countries.

U.S. Trademark Applications that Can Use Madrid

A natural person or a legal entity with a USPTO-registered trademark or an application filed with the USPTO (“basic application”) that is a “national of, ha[s] a domicile in, or ha[s] a real and effective industrial or commercial establishment in the United States,”⁵ is entitled to use Madrid.

The Madrid international trademark application must be “identical” to the national (basic) application: the owner of the national trademark must be the same as the owner of the international trademark, the national and international marks must be the same, and the good/services of the international mark cannot exceed the scope of the goods/services of the national mark.⁶

It is important to note that the applicant cannot directly file a Madrid international trademark application with WIPO. Instead, the USPTO (our national office) has to present the filing to WIPO.

WIPO requires various fees to use Madrid. WIPO's schedule of fees for Madrid is available at the link: <http://www.wipo.int/madrid/en/fees/>.

Application Procedure

An international trademark application can be filed in either English, French, or Spanish⁷; and requires language consistency between national and international applications: “applicants cannot use their basic mark to file an international application for the same mark in a different language.”⁸

According to the International Trademark Association (INTA), the average time from the date of filing of international trademark application to the date of grant of the international trademark registration is as follows: “if based on use, registration usually issues between 18 and 24 months from filing; if based on intent to use, 48-60 months is a possible time frame.”⁹

Duration of, and Renewal Of, International Registration

International trademark registration lasts 10 (ten) years from the date of registration and is renewable for another 10 years upon payment of a renewal fee to the WIPO.¹⁰

Benefits and Drawbacks of Using Madrid

In addition to being relatively easy to implement (by filing one trademark application in one language and payment of only one fee are needed for the Madrid registration), a Madrid Protocol registration is equivalent to a national trademark registration. However, an international trademark application can be refused registration by any of the designated countries for failure to comply with some national law. In that case, the international trademark applicant normally required local counsel in order overcome the refusal. Even if a designated country allows the application, assistance of local counsel may be needed.

If the trademark office of the designated country does not refuse the application within the specified period of time, the mark is automatically protected in that country. For the first five years from the date of registration, an international trademark registration is dependent on the basic mark (in the country of origin). Dependence means that if the national office refuses, withdraws, cancels or restricts application or registration, then the WIPO will cancel the international registration.¹¹ However, after the five-year period an international registration becomes independent.

Another advantage for the international trademark owner/applicant is that a change in his/her name or address, or a change in the ownership or a limitation of the list of goods and services can be recorded at WIPO by a single procedural step and single payment of fees.¹²

Summary

In summary, Madrid may be a very attractive method of trademark registration when the applicant intends to register in multiple foreign countries. Madrid offers simultaneous protection of a trademark and a convenient maintenance program. Given the benefits, drawbacks, and procedural details of Madrid, versus direct foreign national or regional filing in deciding how to pursue trademark protection internationally, it is important to consult with knowledgeable counsel before proceeding.

¹ Mr. Margulies and Ms. Dovgaya can be reached via telephone at 1-703-415-0012 or via the firm's website: <http://www.neifeld.com/cv.html>. We thank Rick Neifeld for helpful review and advice.

² World Intellectual Property Organisation 2010, "The Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement: Objectives, Main Features, Advantages", WIPO Publication No. 418(E).

³ http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

⁴ http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf.

⁵ <http://www.uspto.gov/trademarks/law/madrid/madridfaqs.jsp#q1>.

⁶ <http://www.wipo.int/madrid/en/faq/modifications.html>. Chaudhry Asfand Ali, Analysis on the Impact of Madrid Protocol for the Economies of Developing Countries, WIPO Six Months Study-cum-Research Fellowship, Tokyo, September 2008, at 13.

⁷ Article 16(1)(a) of the Madrid Protocol and Common Regulations, Rule 6(1)(b).

⁸ http://www.uspto.gov/trademarks/notices/madrid_feedback.jsp.

⁹ http://applications.inta.org/apps/madrids_presentation/search_result_complete/?iso=840.

¹⁰ <http://www.uspto.gov/trademarks/law/madrid/madridfaqs.jsp>.

¹¹ <http://www.uspto.gov/trademarks/law/madrid/madridfaqs.jsp>.

¹² http://www.wipo.int/export/sites/www/freepublications/en/marks/418/wipo_pub_418.pdf.