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# Is The Madrid Protocol Working For U.S. Trademark Owners?

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FOR COMPANIES and individuals that sell goods and services outside the U.S., international trademark filing is a necessary and important business consideration. Unlike the U.S., which recognizes unregistered trademark rights, most countries are registration rights countries, which means the first party to register a trademark is the party who owns exclusive rights to use and license others to use the trademark in that country.

In the past, U.S. trademark owners were limited to foreign filing of trademarks via direct filings with each individual international Trademark Office. However, over the past few years, U.S. trademark owners have been able to avail themselves of the International Trademark Registration filing and registration process, offered through the World Intellectual Property Organization.

It has been 10 years since the U.S. joined the Madrid Protocol, which is the international treaty that allows U.S. trademark owners to file a single International Trademark Registration and designate countries for trademark protection that are also members of the Madrid Protocol.

So now that the honeymoon period is over, how is the international filing process working? For some trademark owners, it is the ideal way to foreign file trademarks in a more cost-effective manner than direct filing with each foreign trademark office. For others, however, the recommended filing strategy is via direct filing with each international trademark office.

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Any U.S. company or individual that owns a U.S. (also known as "federal") trademark application or registration, filed with the U.S. Patent and Trademark Office, or USPTO, is eligible to file an application for an international registration for the same mark as covered in the U.S. filing and for the same, or narrower, goods and services as listed in the U.S. filing. The international filing, made through the U.S. office, is based upon the U.S. application or registration, and the cost of the filing depends upon the countries that are designated in the international application.

Not all countries in the world are members of the Madrid Protocol, however, many countries of interest to U.S. trademark owners are members, such as numerous countries in Asia and Europe, including a Community Trademark or CTM filing, which covers all countries in the European Union. A list of countries that can be designated, currently almost 90, may be found at www.wipo.int.

After the international filing is made with the USPTO, the registration is certified by the USPTO, sent to the World Intellectual Property Organization and, if found acceptable, registered as an International Trademark Registration. The term registered is a bit deceptive as each country that is designated in the filing must also review and accept the application before it is considered registered with the country. Once reviewed and accepted by the designated countries, an international registration is effective in all the designated countries for an initial 10-year registration period and is renewable for additional 10-year periods.

Owners of international filings typically need to hire local counsel in a designated country only if a refusal is received or an objection is filed in that country. Those who file international registrations typically spend much less money on international filing of their trademarks than those who file directly with each individual country trademark office, which requires hiring local counsel at the time of filing.

However, not every trademark is an ideal candidate for an international filing. It is dependent upon the USPTO filing for five years. If there is a risk that the USPTO filing may not register, due to a refusal in the examination stage or an objection filed in the opposition period, an international filing may be risky. If the USPTO filing does not register, the international filing must be converted to separate trademark applications in each designated country, which may be a lengthy and expensive process.

There are other considerations that must be weighed when considering whether an international filing is appropriate, such as the fact that international registrations cannot be filed with a broader goods-and-services description than the USPTO filing, whereas national filings filed with an individual country trademark office may be filed for goods and services coverage as broad as the country law allows.

In sum, the international registration is a cost-effective method for foreign filing of trademarks but is not suitable for all U.S. trademark owners. For some trademark owners, international trademark coverage is more appropriately obtained the old fashioned way, by filing individual trademark applications directly with each country's trademark office. •

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