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Articles

THE MADRID PROTOCOL: SPECIAL ISSUES FOR U.S. PRACTITIONERS

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**Table of Contents**

Introduction	70
I. Overview of the International Registration Process	71
A. The Basic Application or Registration and the International Application	71
B. Date and Effect of the International Registration	73
C. Possible Refusal of Protection in a Designated Contracting Party	75
II. U.S. Application or Registration as Basis for International Registration	78
A. Submission of an International Application through the USPTO under the Final Rules	78
B. USPTO's Certification of International Application	80
C. Temporary Postponement of Electronic Filing and Payment Provisions of the Final Rules	81
D. Correction of Irregularities	82
E. Paris Convention Priority	85
F. Designation of Goods/Services	86
G. Dependency and Transformation	89
H. Effect of Petition to Divide	94
III. Protecting Marks of Foreign Nationals in the United States	95
A. Protection Under Section 44 and the Paris Convention	95
B. New Section 66(a) of the Lanham Act	98

C. Comparison of Sections 44 and 66(a)	99
D. Restriction of International Registration Goods/Services in the United States	101
E. Impact of U.S. Use Requirement for Registration	101
IV. Selection of Marks: Impact of U.S. Adherence to the Madrid Protocol on Trademark Clearance	102
A. Extension of Period of Uncertainty	102
B. Searching for Conflicting International Registrations	104
V. Changes in Opposition Practice	104
A. Enforcement Strategy	104
B. Impact on Timing of U.S. Oppositions	105
C. Amendment of Pleadings in Opposition Proceedings	109
Conclusion	110

## **\*70 Introduction**

On November 2, 2002, President George W. Bush signed legislation implementing U.S. adherence to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (“Madrid Protocol” or the “Protocol”)<sup>1</sup> adopted in Madrid, Spain on June 27, 1989. This legislation, known as the Madrid Protocol Implementation Act<sup>2</sup> (“MPIA”), marks what could be considered the most significant development in U.S. trademark law since the Trademark Law Revision Act of 1988 (“TLRA”) enabled the filing of an application for registration on the Principal Register by an applicant with a bona fide intention to use a mark in commerce.

As of November 2, 2003 (the effective date of the MPIA<sup>3</sup>) U.S. trademark owners can take advantage of the Protocol’s provisions for obtaining protection of a mark in more than one country by filing one application, in one place, with one set of <sup>\*71</sup> documents, in one language, with one fee. The resulting registration will have one number and one renewal date.<sup>4</sup> U.S. trademark owners are expected to benefit from cost savings when international protection of a mark is sought through the Protocol instead of individual national filings. Further benefits to U.S. trademark owners are expected due to the Protocol’s time limitations for examination of an international application as compared to national filings in certain countries. U.S. trademark owners, however, are not the only beneficiaries of U.S. adherence to the Protocol. Under the Protocol, qualified foreign applicants will have the opportunity to extend their international registrations into the United States, providing an alternative to the provisions of Section 44 of the Lanham Act.<sup>5</sup> The implications of U.S. adherence to the Protocol, both as they pertain to U.S. and to foreign trademark owners, are expected to significantly impact U.S. trademark practitioners.

This paper will explore some of the issues affecting U.S. trademark practitioners as a result of U.S. adherence to the Protocol, including the implications of new rules promulgated by the United States Patent and Trademark Office (“USPTO”) to implement the MPIA (“Final Rules”).<sup>6</sup> First, an overview of the international registration process is provided. Next, the significance of a U.S. trademark application or registration as the basis for an international registration will be considered, followed by issues pertaining to protection of the marks of qualified foreign applicants in the United States. Finally, this paper will examine the impact of U.S. adherence to the Madrid Protocol on trademark clearance and opposition practice.

### **I. Overview of the International Registration Process**

#### **A. The Basic Application or Registration and the International Application**

Before considering the issues affecting U.S. practitioners as a result of the MPIA, an overview of the international registration process is in order. The Madrid system is founded on the requirement of a basic national or regional registration or application for registration.<sup>7</sup> Under the Protocol, an international application may <sup>8</sup>72 be based on either a registration with the Office of Origin (basic registration) or on an application for registration filed with the Office of Origin (basic application).<sup>9</sup> “Office of Origin” under the Protocol refers to the country or inter-governmental organization<sup>9</sup> (known as a “Contracting Party”) that submits the international application to the International Bureau of the World Intellectual Property Organization in Geneva, Switzerland (“WIPO” or “International Bureau”).<sup>10</sup> The international application may relate only to goods and services covered by the basic application or registration in the relevant jurisdiction.<sup>11</sup>

A U.S. application or registration can serve as the basis of an international application if the applicant can establish that the United States can serve as the Office of Origin. Under the Protocol, an applicant can choose his Office of Origin based on his nationality, domicile, or “real and effective industrial or commercial establishment;” however, there can be only one Office of Origin for a given international application.<sup>12</sup> The MPIA thus provides that a U.S. application or registration can serve as the basis of an international application if the owner of the application or registration is a “qualified owner,” that is, is a national of the United States, is domiciled in the United States, or has a real and effective industrial or commercial establishment in the United States.<sup>13</sup> The interpretation of “national,” “domicile,” and “real and effective commercial or industrial establishment” is a matter for each individual Contracting Party to determine.<sup>14</sup>

The international application may include a claim of priority based on an earlier national filing pursuant to Article 4 of the Paris Convention.<sup>15</sup> Such a filing will normally be the application with the national office serving as the Office of Origin for the basic application.<sup>16</sup> The International Bureau will disregard any <sup>17</sup>73 priority claim that is more than six months earlier than the international registration date.<sup>17</sup>

The international application must be submitted by the Office of Origin. The applicant cannot submit it directly to the International Bureau.<sup>18</sup> Further, an international application must be presented to the International Bureau on either the official form<sup>19</sup> or on a self-produced form that has the same content and format as the official form.<sup>20</sup> Form MM2 is the official form for applications governed exclusively by the Protocol.<sup>21</sup> Prior to presenting the international application to the International Bureau, the Office of Origin must sign the international application and certify the date on which it received the request to present it, as well as certify certain facts concerning the relationship between the international application and the basic registration or basic application.<sup>22</sup> The Office of Origin must also certify that the mark in the international application is identical to the mark in the basic registration or application.<sup>23</sup> Moreover, the Office of Origin must certify that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic registration or application.<sup>24</sup> In other words, each of the goods and services named in the international application must either appear in the basic registration or application or fall within a broader term included in that list; the list of goods and services in the international application may, of course, be narrower than in the basic application or registration.<sup>25</sup>

## **B. Date and Effect of the International Registration**

If the International Bureau is satisfied that the international application conforms to all applicable requirements, it will register the mark on the International Register, notify the offices of the Designated Contracting Parties,<sup>26</sup> <sup>27</sup>74 inform the Office of Origin, and send a certificate of registration to the holder.<sup>27</sup> An international registration will bear the date on which the international application was received by the Office of Origin, provided that the international application is received by the International Bureau within two months from this date, and further provided that the application received by the International Bureau is not missing one of the following elements: (1) an indication of the identity of the applicant and contact information; (2) a reproduction of the mark; (3) a list of goods and services for which registration of the mark is sought; or (4) an indication of the Contracting Parties designated.<sup>28</sup>

Any deficiency in these areas must be corrected within two months in order for the international registration date to be the same as the date the application was received by the Office of Origin.<sup>29</sup> Otherwise, the international registration will receive the date on which the last of these missing elements is received (provided they are received within three months of the notice of deficiency sent by the International Bureau).<sup>30</sup> As far as the International Bureau is concerned, fee deficiencies or irregularities in the classification of goods will not affect the date of the international registration, again provided that any such deficiencies are remedied within three months.<sup>31</sup> As discussed more fully in Section III.A., under the Final Rules, the USPTO will not accord a date of receipt to the international application until both the requisite fees due to the USPTO for certifying and processing the international application and international application fees due to the International Bureau are

paid.

It is important to understand the effect of the issuance of the international certificate of registration. The Protocol provides that from the date of the international registration (or, in the case of a subsequent designation of a Contracting Party; that is, a request to extend the international registration into a territory after the initial filing of the international application,<sup>32</sup> from the date of that designation), the protection of the mark must be the same as if the application for the mark had been deposited directly with the national office of the Contracting Party.<sup>33</sup> In other words, a request for the extension of protection to a Contracting \*75 Party should be treated no differently than an application for registration filed directly with that Contracting Party's national office.<sup>34</sup>

There is, however, a fundamental difference between an international registration and an application filed directly with the national or regional office. National and regional systems for registering marks differ widely. In some systems, registration takes place only after an examination by the office, with a possibility of opposition by third parties. In other systems, registration may be a simple administrative procedure.<sup>35</sup> Both systems, however, have in common the fact that registration is a positive act on the part of that office.<sup>36</sup> In other words, where an application for a national or regional registration is filed, the mark is generally not protected unless and until the mark is actually recorded in the register, even if the protection is recognized from an earlier date once registered.<sup>37</sup>

In contrast, a mark that is the subject of an international registration is protected automatically in a Designated Contracting Party unless protection is actually refused by the office of that Contracting Party in accordance with and within the time limits specified in the Protocol.<sup>38</sup> Although an office may issue a statement of granted protection, no legal consequences result if this is not done.<sup>39</sup> If a refusal is not notified to the International Bureau or is subsequently withdrawn, the protection of the mark in the Contracting Party concerned shall, from the date of the international registration, be the same as if the mark had been registered by the office of that Contracting Party.<sup>40</sup> Where a refusal relates to only some of the goods and services covered by the international registration, the mark stands protected with respect to the remaining goods and services.<sup>41</sup>

### **C. Possible Refusal of Protection in a Designated Contracting Party**

An international registration based on a U.S. application or registration will still be examined in accordance with the law of the Designated Contracting Party. Similarly, the owner of an international registration issued through a foreign jurisdiction as Office of Origin will be examined by the USPTO in accordance with U.S. law. The owner of an international registration can expect to respond to office actions issued by the Contracting Party in whose territory protection is sought and \*76 to respond to refusals resulting from actions brought by third parties based on the laws of the territory. The international registration owner will need to engage local counsel to deal with such office actions or refusals. Initial refusals issued by a Contracting Party are known as "provisional refusals." A Contracting Party can refuse protection in its territory upon any grounds which would apply under the Paris Convention, for example, the mark infringes the rights of third parties in the Contracting Party or the mark is devoid of distinctive character.<sup>42</sup>

Under the Protocol, refusals must issue within twelve months of the international registration date or within eighteen months of such date if the Contracting Party has filed the appropriate declaration under the Protocol.<sup>43</sup> Refusals can also be issued after the expiration of the eighteen-month period provided both of the following conditions have been fulfilled:

the office has, before the expiry of the 18-month time limit, informed the International Bureau that there is a possibility that oppositions may be filed after the expiry of this time limit; and

the notification of provisional refusal based on an opposition has been sent to the International Bureau before the expiry of the period of one (1) month from the expiry of the opposition period, or  
the period of seven (7) months from the beginning of the opposition period,  
whichever is sooner.<sup>44</sup>

Provisional refusals of extension of protection into a particular country are sent by the Designated Contracting Party to the International Bureau, which then transmits a copy of the notification to the holder of the international registration as well as

to the Office of Origin if that office has informed the International Bureau that it wishes to receive such copies.<sup>45</sup> The refusal is also recorded in WIPO's International Register.<sup>46</sup> A provisional refusal must state the grounds for refusal, time limits for response, and whether the refusal is total or partial.<sup>47</sup> Subsequent procedure before the office of the Designated Contracting Party should, as much as possible, be the same as for an application filed directly with that office.<sup>48</sup> The holder of the international registration who wishes to respond to the refusal should \*77 do so directly with the office concerned. The response must not be sent to the International Bureau.<sup>49</sup>

An office that has sent a notification of provisional refusal to the International Bureau must, once all procedures before the office relating to the protection of the mark have been completed, send the International Bureau a statement indicating either:

- (i) that protection of the mark is refused in the Contracting Party concerned for all goods and services;
- (ii) that the mark is protected in the Contracting Party concerned for all goods and services requested; or
- (iii) the goods and services for which the mark is protected in the Contracting Party concerned.<sup>50</sup>

In particular, a statement as to the goods and services protected in that Contracting Party will correspond to the indication that would be published by the office at the end of the proceedings with respect to a direct national application, stating the goods and services for which the mark is being registered.<sup>51</sup>

Under the MPIA, the USPTO will issue a certificate of extension of protection and publish a notice in the Official Gazette.<sup>52</sup> The statement as to the protection granted should be sent as soon as all possibilities of review or appeal before the office have been exhausted, or at the time requesting review or appeal before the office has expired.<sup>53</sup> Therefore, the office refusing the extension request should not wait to see whether an appeal is lodged with a tribunal or other body external to the office.<sup>54</sup> This appears to mean that in the United States, the statement will be issued after a decision has been made by the Trademark Trial and Appeal Board and will not be withheld based on an appeal to the Federal Circuit. The statement as to the grant of protection will be recorded in the International Register and a copy transmitted to the holder.<sup>55</sup>

## **\*78 II. U.S. Application or Registration as Basis for International Registration**

### **A. Submission of an International Application through the USPTO under the Final Rules**

With the foregoing overview as background, this article will consider issues pertaining to a U.S. application or registration as the basis of an international registration. Consistent with the USPTO's objective of encouraging electronic filing of all papers, under the Final Rules (issued September 26, 2003), all international applications must be filed electronically.<sup>56</sup> The USPTO has developed a form on its Trademark Electronic Application System ("TEAS") for use in filing an application for international registration that conforms to the International Bureau's official form.<sup>57</sup>

Under Final Rule 7.11(a), the USPTO will grant a date of receipt to an international application that is submitted through TEAS, provided the application contains all of the following:

- (1) the filing date and serial number of the basic application and/or the registration date and registration number of the basic registration;
- (2) the name of the international applicant that is identical to the name of the applicant or registrant as it appears in the basic application or basic registration;
- (3) a reproduction of the mark that is identical to the mark in the basic application or registration;
- (4) a color claim, if appropriate;
- (5) a description of the mark that is identical to the description of the mark in the basic application or registration, as appropriate;

- (6) an indication of the type of mark if the mark in the basic application and/or registration is a three-dimensional mark, a sound mark, a collective mark or a certification mark;
- (7) a list of the goods and/or services that is identical to, or narrower than, the list of goods and services in each claimed basic application or registration and classified according to the international classification system;
- (8) a list of the Contracting Parties designated for an extension of protection;

\*79 (9) the certification fee payable to the USPTO and WIPO's international application fees for all classes and Designated Contracting Parties;

(10) a statement that the applicant is entitled to file an international application with the USPTO specifying that the applicant is a national or domicile of the United States or has a real and effective industrial or commercial establishment in the United States; and

(11) an email address for receipt of correspondence from the USPTO.<sup>58</sup>

TEAS will require the applicant to select between two different types of forms: a pre-populated form containing information from the basic application or registration or a free-text form.<sup>59</sup> The applicant can use the pre-populated form if: (1) the international application is based on a single basic application or registration; and (2) applicant's changes to the international application are limited to narrowing the list of goods or services.<sup>60</sup> For all other international applications, the applicant must fill in all the fields in the free-text form.<sup>61</sup>

To certify the international application based on a single basic application or registration, the USPTO will charge a processing fee of \$100 per class. If the international application or registration is based on more than one basic application or registration, the per class certification fee is \$150.<sup>62</sup> Fees payable to WIPO for an international application consist of: (1) a basic fee; (2) where a Contracting Party has elected to receive an individual fee, that fee; (3) a complementary fee for each Designated Contracting Party for which no individual fee is payable; and (4) a supplementary fee for each class of goods or services in excess of three.<sup>63</sup> However, where all Designated Contracting Parties are ones that have elected to receive an individual fee, no supplementary fee is required.<sup>64</sup> In addition to a schedule of fees, WIPO's website contains an electronic fee calculator that enables the applicant to determine the exact amount due to the International Bureau for the international application fee by inputting the number of classes, Office of Origin, and Designated Contracting Parties.<sup>65</sup> Under the Final Rules, an applicant submitting an international application to the International Bureau through the USPTO will have the option of paying the international application fees directly to \*80 the International Bureau or through the USPTO.<sup>66</sup> Fees paid through the USPTO must be paid in U.S. dollars at the time of submission.<sup>67</sup> Fees paid directly to the International Bureau must be paid in Swiss francs.<sup>68</sup>

## **B. USPTO's Certification of International Application**

Pursuant to Final Rule 7.13, when an international application contains all of the elements set forth in Final Rule 7.11(a), the USPTO will certify to the International Bureau that the information contained in the international application corresponds to the basic application or basic registration at the time of certification and will forward the international application to the International Bureau.<sup>69</sup> An international application failing to meet these requirements will not be certified or forwarded to the International Bureau.<sup>70</sup> The USPTO will refund the international application fees payable to the International Bureau if they were submitted through the USPTO, but the USPTO will not refund the certification fee.<sup>71</sup>

The Office will automatically certify and forward to the International Bureau all international applications based on a single basic application or registration, with no limitations on the goods or services and no color claim, that meet the requirements of Final Rule 7.11(a).<sup>72</sup> A new business unit in the USPTO, the Madrid Processing Unit ("MPU"), will conduct a limited review for international applications where the goods or services have been narrowed or where color is claimed.<sup>73</sup> International applications that are completed on TEAS free text forms will be reviewed by the MPU.<sup>74</sup>

In one respect, the USPTO's requirements for certification of the international application under the Final Rules go beyond the strict requirements of the Protocol for purposes of obtaining an international registration date. As discussed in Section II.B., the international applicant need not submit the international application fees to the International Bureau when the

application is filed with the Office of Origin or when the application is forwarded by the Office of Origin to the International Bureau, provided any deficiencies in fees are corrected within three months of notification by the International Bureau. However, under the Final \*81 Rules, the international application must be complete per Section 7.11(a) or else the USPTO will not certify and forward the international application to the International Bureau. The proposed USPTO rules issued March 28, 2003 ("Proposed Rules") would have also required the address of the applicant in the international application be identical to the address as it appears on the basic application or registration in order for the USPTO to certify the international application.<sup>75</sup> The result would have been that if the international applicant has not made sure that the records in the USPTO's assignment division are current, its international application would be rejected. Since there is no requirement for this provision in the Protocol, the regulations governing the Protocol, or the MPIA, this requirement was deleted in the Final Rules.<sup>76</sup>

Correspondence relating to international applications, international registrations, and requests for extension of protection transmitted electronically to the USPTO will be accorded the date and time when the complete transmission is received in the USPTO based on Eastern Time.<sup>77</sup> Upon certification of the international application, the USPTO will forward the international application to the International Bureau.<sup>78</sup> As noted previously in Section II.B, the International Registration will bear the date the application is received by the USPTO, provided the international application is transmitted to the International Bureau within two months from the date it is received by the USPTO.

### **C. Temporary Postponement of Electronic Filing and Payment Provisions of the Final Rules**

Subsequent to issuing the Final Rules, the USPTO announced delays in implementation of the provisions mandating electronic filing and allowing payment of fees to WIPO through the USPTO. First, on October 24, 2003, the USPTO announced that it would allow international applicants to make Madrid submissions (to include correction of irregularities discussed in Section III.D. below) on paper, using the forms available on WIPO's website, until at least January 2, 2004 ("Postponement Rules").<sup>79</sup> The USPTO established a special mailing address for Madrid-related filings and, under the Postponement Rules, will grant a date of \*82 receipt to a Madrid submission based on the date it was deposited with the United States Postal Service as Express Mail (assuming compliance with the USPTO's Express Mail rules).<sup>80</sup> Under the Postponement Rules, the USPTO also announced that applicants would not be allowed to pay any fees due to the International Bureau through the USPTO and, hence, temporarily suspended the requirements of Final Rule 7.11(a)(9) requiring payment of all international application fees at the time of submission.<sup>81</sup> Then, on October 31, 2003, the USPTO issued a notice advising that, due to technical difficulties, it would delay deployment of TEAS forms to be used for Madrid submissions until sometime after November 2, 2003.<sup>82</sup> Thus, at present, all Madrid submissions to the USPTO must be submitted on paper using WIPO's official forms.<sup>83</sup> It is not known when the electronic forms will be available, but the USPTO has said that there will be a transitional period during which it will accept both electronic and paper submissions for Madrid-related filings.<sup>84</sup>

### **D. Correction of Irregularities**

The USPTO will not accord a filing date to the international application unless the minimum requirements to receive an international registration date by the International Bureau are satisfied. Therefore, there should be no irregularities in the international application impacting the international registration date. Nevertheless, any other irregularities in the application must be corrected within three months of the receipt of a notice of deficiency issued by the International Bureau. Final Rule 7.14 sets forth the process for correction of irregularities. The International Bureau will notify both the international applicant and the USPTO of any irregularities in the international application.<sup>85</sup> To avoid abandonment of the international application, the international applicant is responsible for correcting the irregularities before the end of the response period set forth in the International Bureau's notice.<sup>86</sup> Final Rule 7.14(b) provides that a response to a notice of \*83 irregularities in the classification or identification of goods or services in an international application must be submitted through the USPTO for forwarding to the International Bureau.<sup>87</sup>

Because the USPTO must certify that the goods or services in an applicant's response are within the scope of the basic application or registration at the time the response is filed, responses to irregularities in the identification (but apparently not in the classification) of goods and services will be reviewed by the MPU.<sup>88</sup> If the goods or services in the basic application or registration have been amended since the date the international application was submitted to the USPTO, the goods and services in the response to the International Bureau notice must be within the scope of the amended goods and services.<sup>89</sup> If

the response includes goods and services that exceed the scope of the goods and services in the basic application or registration as amended, the MPU will reject the response and notify the applicant.<sup>90</sup> If there is time remaining in the International Bureau response period, the applicant may submit a corrected response.<sup>91</sup> If the goods and services in an applicant's response do not exceed the scope of the goods and services in the basic application or registration as amended, and the International Bureaus response period has not expired, the MPU will certify the goods and services and forward the response to the International Bureau.<sup>92</sup>

Under Final Rule 7.14(c), if the International Bureau notifies an international applicant that fees filed in connection with the international application are insufficient or that irregularities in the classification of goods or services require additional fees, the international applicant must pay the additional fees directly to the International Bureau.<sup>93</sup> In accordance with Final Rule 7.14(b), this is true even if the applicant is filing a response to correct other irregularities, including irregularities concerning classification or identification of goods or services, through the USPTO.<sup>94</sup> At the time the Final Rules were issued, the USPTO said TEAS would not be able to process fees to correct irregularities in an international \*84 application.<sup>95</sup> With the delay in the USPTO's deployment of TEAS forms, it is doubtful such an option will be made available in the near future. Under Final Rule 7.14(d), a response to any irregularities other than in the identification or classification of goods and services under Final Rule 7.14(b) or concerning payment of additional fees under Final Rule 7.14(c), may be submitted through the USPTO or filed directly with the International Bureau.<sup>96</sup> The USPTO will forward any timely responses it receives pursuant to Final Rule 7.14(d) to the International Bureau, but it will not review the responses or respond to any irregularities on behalf of the applicant.<sup>97</sup>

Once the USPTO announces deployment of its electronic forms, under Final Rule 7.14(e), the international applicant must use the TEAS system to submit a response to a notice of irregularities to the International Bureau through the USPTO.<sup>98</sup> The International Bureau must receive the response before the end of the response period set forth in the notice even if the response is sent through the USPTO.<sup>99</sup> To assist the USPTO in its efforts to timely submit the response to the International Bureau, Final Rule 7.14(e) states that the international applicant should submit the response no later than one month before the end of the response period in the International Bureau's notice.<sup>100</sup> The Final Rules make clear that this one month provision is only a guideline. Ultimately, responsibility for timely filing the response rests with the applicant.<sup>101</sup> Until the TEAS system for Madrid submissions is operational, applicants should anticipate that the USPTO will need additional time to submit responses to irregularities to WIPO and should consider submitting responses directly to WIPO when possible. Moreover, international applicants should be aware that the USPTO will not assist them in resolving classification or identification issues raised by the International Bureau.<sup>102</sup> In response to public comments to the Proposed Rules requesting that the USPTO provide such assistance, the USPTO states in the Final Rules that the International Bureau will propose changes to the identification and classification of goods and services in its notice of irregularities.<sup>103</sup> Since the International Bureau has final \*85 authority in this regard, the USPTO recommends that the applicant adopt the International Bureau's suggested changes, if accurate.<sup>104</sup>

## **E. Paris Convention Priority**

U.S. practitioners counseling trademark owners seeking to protect their marks internationally should understand the relationship between a claim of priority under the Paris Convention and the international registration date. In order for a U.S. trademark owner to claim the benefit of that priority back to the date of its filing of an application in the United States, the international application must be submitted to the USPTO as Office of Origin within six months of the filing of the U.S. application. Provided the international application with the priority claim is received by the International Bureau within two months of when the international application was received by the USPTO, the international registration date will be the same as the date of the filing of the international application, and hence, preserve the claim of priority under the Paris Convention.

As discussed in Sections III.A. and B., the USPTO will not grant a date of receipt to the international application unless all of the requirements of Final Rule 7.11(a) are satisfied. There is no provision in the Final Rules for correction of any deficiencies in the requirements of Rule 7.11(a), either before or after the Paris Convention priority deadline. Public comments to the Proposed Rules requested that the USPTO treat international applications that do not meet the requirements of Rule 7.11(a) as informal and allow applicants an opportunity to correct any deficiencies.<sup>105</sup> The USPTO declined, stating that setting up a docketing system for informal international applications is unnecessary and inefficient.<sup>106</sup> The USPTO reasoned:

Since an international application is filed in "real" time through TEAS, if required information is omitted from an international application, the applicant will immediately receive a TEAS error message. If the Office cannot certify an international application, the MPU will send an e-mail message. In either case,

the applicant may immediately re-file the international application with the correct information through TEAS.<sup>107</sup>

The USPTO has made no interim provision for correction of deficiencies under Final Rule 7.11(a) pending deployment of the electronic forms for Madrid Protocol submissions. The lack of a provision in the Final Rules for correction of deficiencies is mitigated by (1) the availability of the pre-populated form (once the Madrid Protocol TEAS forms are deployed) and (2) the USPTO's proposal to automatically certify international applications based on a single basic application \*86 or registration, with no limitations on the goods/services and no color claim.<sup>108</sup> It is not clear, however, how soon the MPU will examine other international applications for compliance with Final Rule 7.11(a) after the application is submitted by the applicant. In order to reduce the risk of errors resulting from discrepancies in owner name, the USPTO has created an interface between the automated system in the Assignment Services Division of the USPTO and the Trademark database (also known as the TRAM database).<sup>109</sup> This interface will enable the USPTO to update ownership information in the Trademark database when an assignment of the entire interest and goodwill, a name change, or a merger has been recorded in the Assignment Services Division.<sup>110</sup> This change in practice will apply only to documents recorded on and after November 2, 2003.<sup>111</sup>

Despite the aforementioned safeguards, prudence dictates that an international application being submitted with a claim of Paris Convention priority be submitted as soon as possible to ensure timely submission to WIPO and to allow for correction of any errors before the priority deadline, particularly until the TEAS forms for Madrid Protocol filings are available. Otherwise, the international registration date will be more than six months from the date of the application serving as the basis for priority, and the benefits of the Paris Convention priority claim will be lost in all countries designated in the international application.

#### **F. Designation of Goods/Services**

The Protocol's requirement that the goods and services in the international application be identical with the basic application or registration creates two issues for U.S. trademark owners seeking to use a U.S. trademark application or registration as the basis for an international application. The first issue is the U.S. requirement for specificity in the identification of goods and services named in the application or registration. As U.S. trademark practitioners are well aware, the USPTO will not allow registration of a mark for an entire class heading as is allowed in some foreign jurisdictions. Using "computer programs" as an example, the USPTO would require the applicant to specify the function of the program and, if the program is field specific, then the field of use.<sup>112</sup> In contrast, some countries that are \*87 presently Contracting Parties to the Protocol allow the applicant to designate the goods broadly, in some cases to the entire class heading.<sup>113</sup>

Accordingly, a U.S. trademark owner seeking protection of its mark in one of these jurisdictions could obtain substantially broader protection for the mark by naming additional goods and services in a national application, even if priority could be claimed only for those goods specifically named in the U.S. application serving as the basis for priority under the Paris Convention. Thus, in the computer programs example, it would be possible to obtain a registration of the mark in these jurisdictions for computer programs of all kinds, and in some cases, the entire listing of goods covered by International Class 9 under the Nice Agreement.<sup>114</sup> Furthermore, in countries that require a specific wording of a designation of goods to comport with their national system, the inclusion of broader terms along with the specific designation provided in the U.S. application can facilitate an acceptable amendment to the designation of goods or services.

The significance of the U.S. requirements for specificity in the designation of goods for any particular trademark owner will depend upon the importance of obtaining a broad scope of protection for any particular mark and upon the countries in which protection of that mark is desired. Not all trademark owners need protection of a mark for an entire class heading. Further, at least some of the countries that are Contracting Parties to the Protocol do not permit the filing of an application for a broad designation of goods or a class heading under their national system. For example, Singapore, Australia, the United Kingdom, and South Korea are all parties to the Protocol but allow an application under their national systems only for those goods on which the mark is used or intended to be used in the territory.<sup>115</sup> Therefore, an extension of protection of an international registration into these territories will be similarly restricted. A U.S. trademark owner able to establish a "real and effective industrial or commercial establishment"<sup>116</sup> in a country outside the U.S. that allows a broad designation of goods may wish to use an application or registration in that country as the basis for the international registration, to possibly include an extension of protection into the United States. Such an applicant would have the advantage of a broad designation in countries permitting this practice, even if a narrower designation is required in the U.S. or in other Protocol member countries.

**\*88** A client should also understand that national filings will still be necessary to protect a mark in countries that are not members of the Protocol, such as Canada, Mexico, and Brazil. Moreover, there may continue to be advantages for a client to register a mark in the European Community even though certain member countries are parties to the Protocol. The Community Trade Mark's benefits of protecting a mark in all countries in the European Union, even if use is not made in all, may make a European Community registration beneficial to a client as either an alternative or a supplement to an international registration. There are expectations that the European Union itself may join the Protocol as early as September 2004.<sup>117</sup>

The second issue created by the U.S. requirements with respect to the designation of goods and services is that in order to file an application for the mark in the United States, the applicant must have used or have a bona fide intent-to-use the mark on all of the goods and services named in the application. Accordingly, even if it were not for the dependency issue discussed in Section III.G., a U.S. applicant could still not name all of the goods in a class in order to obtain a broader protection in the international registration unless the applicant indeed had the intention to use the mark on each and every item designated. Accordingly, the scope of protection of an international registration based on a U.S. application or registration will necessarily be narrower in some jurisdictions than international registrations in the same jurisdiction originating from an Office of Origin that permits a broader designation of goods and services. U.S. practitioners counseling U.S. trademark owners will need to balance these various considerations to determine the most effective strategy for a particular client.

It is worth noting that U.S. trademark owners protecting their marks in foreign jurisdictions through the Protocol have the advantage of a predetermination by the International Bureau as to the proper international classification for the designated goods and services. Final responsibility for the classification and grouping of goods and services listed in the international application lies with the International Bureau, although the International Bureau must try to resolve any disagreement with the Office of Origin.<sup>118</sup> It is not appropriate for the office of a Designated Contracting Party to object to the classification of the goods and services in the international registration.<sup>119</sup> An office may, however, use its own interpretation of the classification, for example, to carry out a search for earlier conflicting marks. It is explicitly provided that the indication of the classes does not bind Contracting Parties with regard to the determination of the scope of the protection of the mark.<sup>120</sup>

**\*89** Another advantage to trademark owners seeking international protection through the Protocol is that protection may not be refused, even partially, because applicable legislation for the Designated Contracting Party allows registration in only a limited number of classes or for a limited number of goods or services.<sup>121</sup> In other words, in countries that require a separate application under their national system for each class of goods, such as China, the Designated Contracting Party will not be able to raise an objection to extension of the international registration into their territory on this basis.

## **G. Dependency and Transformation**

The relationship between the international registration and the U.S. application or registration does not end with the issuance of the international registration and examination of the extension request by the Designated Contracting Party. For a period of five years from the date of the international registration, the protection resulting from the international registration remains dependent on the basic application or registration.<sup>122</sup> The protection resulting from the international registration may no longer be invoked if, or to the extent that, the basic registration or the registration resulting from the basic application is canceled, renounced, revoked, invalidated, or has lapsed, or if the basic application is the subject of a final decision of rejection or is withdrawn, either within that five-year period or as a result of an action commenced within that period.<sup>123</sup> This dependence is absolute and is effective regardless of the reasons why the basic application or registration is rejected, withdrawn, or ceases to have legal effect.<sup>124</sup>

The process by which an international registration may be defeated for all countries in which it is protected by means of a single invalidation or revocation action against the basic registration is known as a "central attack" when brought by a third party.<sup>125</sup> Therefore, a successful third party opposition against the underlying U.S. application pursuant to Section 13<sup>126</sup> of the Lanham Act or cancellation of the underlying registration pursuant to Section 14<sup>127</sup> or 37<sup>128</sup> of the Lanham Act will not merely defeat the trademark owner's rights in the U.S. application or registration. It will also result in the loss of rights in foreign jurisdictions designated in the international registration if such action is commenced within five years of the international registration date.<sup>129</sup>

However, it is not only a central attack by a third party that can result in the basic application or registration ceasing to have

effect and the attendant loss of rights in the international registration. The U.S. application underlying the basic application may be refused protection by the USPTO on the basis of absolute grounds such as descriptiveness or likelihood of confusion in the course of examination at the USPTO. Further, because of U.S. requirements that a mark be used in commerce before a registration can be obtained, the failure to provide an acceptable specimen of use can result in refusal of the underlying U.S. application or loss of the underlying U.S. registration, and hence, a loss of rights under the international registration. This could occur where a U.S. applicant is unable to provide an acceptable specimen showing use of the mark within the requisite period of time following the issuance of a notice of allowance in connection with a U.S. intent-to-use application or is unable to provide satisfactory specimens in connection with a U.S. registration pursuant to Section 8 of the Lanham Act.<sup>130</sup>

Suppose, for example, that an applicant obtains an international registration on January 1, 2004 based on a then-pending U.S. intent-to-use application. Suppose further that the notice of allowance of the U.S. application issues on April 1, 2004. Six months later, on October 1, 2004, the applicant files a statement of use and supporting specimens but does not concurrently file a so-called “insurance” extension request.<sup>131</sup> If the examiner rejects the specimens as not supporting use of the mark in connection with the goods and services named in the application, the applicant may file substitute specimens, but he must provide a declaration that the substitute specimens were in use as of the time for filing the statement of use, in this case October 1, 2004. If the applicant is unable to provide substitute specimens satisfactory to the examining attorney and is unable to successfully appeal the refusal, rights in the U.S. application and the international registration are lost, even if a decision on the appeal did not issue until after the expiration of five years from the date of the international registration. This suggests another reason to file an insurance extension request, along with the statement of use, when international rights, as well as rights in the U.S. application, are at stake.

Upon the loss of rights in the basic application or registration, the USPTO, as Office of Origin, must notify the International Bureau of the event affecting the basic application or registration, along with the number of the international \*91 registration concerned and the name of the holder.<sup>132</sup> The notification must also indicate the facts and decisions affecting the basic application or the basic registration and the effective date of those facts and decisions.<sup>133</sup> When the facts and decisions affect only some of the goods and services covered by the international registration, the notification must indicate which goods and services are affected or which goods and services are not affected.<sup>134</sup> This notification should not be sent until it is clear that there is no possibility of reversal.<sup>135</sup> For example, in the case of an administrative or judicial decision, the notification should not be sent until the period allowed for filing an appeal has expired or until the lapse of any grace period allowed with respect to an action required in connection with the basic application or registration.<sup>136</sup> Thus, in theory, problems such as the inadvertent abandonment of an application during the prosecution phase should not affect the protection afforded in the international registration, provided a petition to revive is timely filed and ultimately granted, even if such does not occur until after the expiration of five years from the date of the international registration.

The USPTO, however, has recognized that third parties may be harmed by the revival of a pending application many months after its abandonment and removal from the USPTO database.<sup>137</sup> The Proposed Rules contained two amendments to address this issue. First, the USPTO proposed to amend Rule 2.66(a) to require that a petition to revive an abandoned application based on an unintentional delay be filed within two months of the mailing date of the notice of abandonment.<sup>138</sup> The Proposed Rules would have removed Rule 2.66(a)(2) which provides that a petition to revive may be filed within two months of actual knowledge of the abandonment if the applicant did not receive the notice of abandonment and the applicant was diligent in checking the status of the application.<sup>139</sup> Diligence under Rule 2.66(a)(2), as in effect prior to promulgation of the Final Rules, required the applicant to check the status of the application within one year of the last filing or receipt of a notice from the USPTO for which further action by the USPTO should be expected.<sup>140</sup> Second, the Proposed Rules would amend Rule 2.146(i) to change the standard for showing due diligence for petitions to revive in which the petitioner seeks to reactivate an application or registration that was abandoned, \*92 cancelled, or expired due to the loss or mishandling of papers.<sup>141</sup> Prior to promulgation of the Final Rules, diligence under Rule 2.146(i) required petitioners to check the status of pending matters within one year of the last filing or receipt of a notice from the USPTO for which further action by the USPTO should be expected.<sup>142</sup> The Proposed Rules would shorten that time period from one year to six months.<sup>143</sup>

In response to public comments to the Proposed Rules, the Final Rules retained Rule 2.66(a)(2),<sup>144</sup> but amended it to change the standard for a showing of due diligence in a petition to revive from one year to six months as set forth in Rule 2.146(i).<sup>145</sup> Despite comments objecting to the proposal to shorten the Rule 2.146(i) due diligence standard from one year to six months, the USPTO declined to omit its proposed change.<sup>146</sup> Under Final Rule 2.146(i), a showing of due diligence will require the petitioner: (1) to check the status of a pending application every six months between the filing date of the application and issuance of a registration; (2) to check the status of a registration every six months after filing of an affidavit of use or excusable non-use or a renewal application until the petitioner receives notice that the affidavit or renewal application has

been accepted; and (3) to request corrective action where necessary.<sup>147</sup>

Final Rule 2.66(a)(2) thus provides some recourse for applicants who are diligent in monitoring the status of their applications. Nevertheless, if a petition to revive an abandoned application that forms the basis of an international registration is filed more than two months after the mailing date of the notice of abandonment, it is likely that the international registration will be cancelled.<sup>148</sup> If the basic application is abandoned and a petition to revive is not filed within two months of the mailing date of the notice of abandonment, the USPTO says it will notify the International Bureau of the abandonment of the application.<sup>149</sup> The International Bureau will then cancel the international registration that was based on the U.S. application.<sup>150</sup> A cancelled international registration will not be revived even if the \*93 basic application is revived.<sup>151</sup> The practice announced by the USPTO to notify the International Bureau of abandonment based on the mailing of the notice of abandonment makes it incumbent on international applicants to ensure that the USPTO has current information with respect to the name and address of the filing correspondent. This is particularly important should the international applicant change trademark counsel.

The Final Rules delay the effective date for the amendment to Rule 2.146(i). For petitions filed on or after May 2, 2004, petitioners will be held to the new six-month standard of diligence in monitoring the status of applications and registrations.<sup>152</sup> Petitions filed prior to May 2, 2004 will be reviewed under the one-year diligence standard, even if the application was filed on or after November 2, 2003.<sup>153</sup>

The International Bureau will record in the International Register any notification that it receives from the Office of Origin concerning the continued effect of the basic application or registration.<sup>154</sup> The International Bureau will also transmit a copy of the notification to the offices of all Designated Contracting Parties and will inform them of cancellation of the international registration.<sup>155</sup> Any such notification of cancellation will be published in WIPO's Official Gazette.<sup>156</sup>

In order to mitigate the consequences of the five-year dependency feature of the Madrid System, the Protocol allows for the holder of an international registration which is cancelled as a result of the ceasing of effect of the basic application, the registration resulting therefrom, or the basic registration to apply, within three months of the date of cancellation of the international registration, for a registration of the same mark with the offices of all Designated Contracting Parties designated under the Protocol where the international registration had effect.<sup>157</sup> The national or regional applications resulting from this so-called "transformation" are treated as if they had been filed on the date of the original international registrations.<sup>158</sup> When the international registration claims priority, the national or regional application will benefit from that claim.<sup>159</sup>

\*94 Apart from the special provisions regarding date, an application resulting from transformation is in effect an ordinary national or regional application and must comply with the requirements of the law of the Contracting Party concerned, and the application must be filed with the office concerned.<sup>160</sup> Thereafter, this filing is not governed by the Protocol, nor is the International Bureau involved in any way.<sup>161</sup> Thus, should a U.S. trademark owner lose its rights in the international registration as a result of a loss in the basic application or registration, it can act to protect its mark in the Contracting Parties designated in the international application and be in the same position, as far as priority is concerned, as if a national or regional application had been filed on that date. The cost savings and other advantages that may have resulted from seeking protection initially through the Protocol will, of course, be lost.

## **H. Effect of Petition to Divide**

The dependency of the international registration on a U.S. application raises the question of the effect of a division of the basic U.S. application. U.S. trademark regulations permit an applicant to divide an application into two or more separate applications and preserve the filing date for all of the goods and services covered in the application.<sup>162</sup> The U.S. applicant may request a division of an application for any reason.<sup>163</sup> For example, in the case of an intent-to-use application, the applicant may wish to proceed to publication or registration with the goods or services on or in connection with which the applicant has used the mark in commerce and retain an active intent-to-use application for any remaining goods and services.<sup>164</sup> Further, the applicant must file a request to divide if the applicant files an amendment to allege use or a statement of use before making use on all the goods or services for which registration is sought.<sup>165</sup>

Where this occurs during the five-year period of dependence, the USPTO must notify the International Bureau accordingly and indicate the number of each application or registration resulting from the division.<sup>166</sup> The International Bureau will record the notification in the International Register and notify the offices of the Designated Contracting Parties. The date of the

division is also published in WIPO's Gazette.<sup>167</sup>

\*95 WIPO's Common Regulations provide that such a division has no legal effect on the international registration.<sup>168</sup> The purpose of the notification by the Office of Origin and its recording, notification, and publication by the International Bureau is simply to provide the offices of Designated Contracting Parties and third parties with information concerning the situation of the basic mark during the period when the international registration is dependent upon it.<sup>169</sup>

### **III. Protecting Marks of Foreign Nationals in the United States**

#### **A. Protection Under Section 44 and the Paris Convention**

The effects of U.S. adherence to the Madrid Protocol extend beyond the impact on U.S. trademark owners seeking to protect their marks internationally. The MPIA also impacts qualified foreign applicants seeking to protect their marks in the United States. Understanding the implications of the MPIA is critical to U.S. practitioners counseling foreign clients as to the protection of their marks in the United States. However, U.S. practitioners should also understand these issues to effectively counsel U.S. clients as to trademark availability and potential enforcement actions.

To understand the significance of the MPIA as it affects qualified foreign applicants seeking protection of a mark in the United States, a brief review of the provisions of Section 44<sup>170</sup> of the Lanham Act is in order. The Lanham Act provides that any person whose country of origin is a party to any trademark convention or a treaty to which the United States is a party, or extends reciprocal rights to U.S. nationals, is entitled to the special statutory benefits of Section 44 extended to foreign persons or firms.<sup>171</sup> These benefits extend to foreign nationals whose home countries are parties to the Paris Convention. The "country of origin" under Section 44 is the country where the applicant has a "bona fide and effective industrial or commercial establishment," or the country where the applicant is domiciled or is a national.<sup>172</sup>

Qualified foreign applicants, at present, have four bases under the Lanham Act for filing for trademark protection in the United States: (1) a Section 1(a) use-based application based on actual use of the mark in U.S. interstate or foreign commerce prior to filing of the application; (2) a Section 1(b) intent-to-use application filed by an applicant with a bona fide intention to use the mark in commerce; (3) a Section 44 application by a qualified foreign \*96 firm with a foreign application under Section 44(d); or (4) a Section 44 application by a qualified foreign firm with a foreign registration under Section 44(e).<sup>173</sup> There is no need for pre-filing use of the mark anywhere in the world.<sup>174</sup> The applicant must state its bona fide intention to use the mark in the United States but need not prove actual use in order to get a registration.<sup>175</sup>

If the application is filed under Section 44(d) claiming a priority filing date based on a pending foreign application, the application must mature into a registration in the applicant's country of origin before the corresponding U.S. registration can be granted.<sup>176</sup> Thus, while there are four bases for the application in the case of a qualified foreign party, there are only three grounds of registration.<sup>177</sup> This is because, while a qualified foreign applicant can file a U.S. application pursuant to Section 44(d) on the basis of a pending foreign application, it cannot receive a registration until it has satisfied the requirements of one of the other grounds for application; that is, Section 1(a), Section 1(b), or Section 44(e).<sup>178</sup> It is important to note that a pending application in a foreign country can serve as the basis for a filing under Section 44(d) only if the application in the United States is filed within six months from the date on which the application was first filed in the foreign country.<sup>179</sup> Provided this requirement is satisfied, the application filed under Section 44(d) has the same force and effect as would be accorded to the same application if it was filed in the United States on the same date on which the application was first filed in the foreign country.<sup>180</sup>

A qualified foreign applicant cannot obtain a U.S. registration under Section 44 which is broader in scope than the registration in the foreign country of origin.<sup>181</sup> The description of goods in the U.S. Section 44 application cannot include goods not covered in the foreign application or registration.<sup>182</sup> If the description of goods in the foreign registration is overly broad or vague by U.S. standards, the USPTO can require a more specific identification than the one in the \*97 foreign registration, just as it would a filing under Section 1(a) or 1(b) by a U.S. applicant.<sup>183</sup>

The most important of the special benefits of Section 44 is that, under Section 44(e), a qualified foreign applicant can obtain a U.S. registration even though such applicant has never used the mark in American interstate or foreign commerce.<sup>184</sup> A mark duly registered in the country of origin of the foreign applicant may be registered on the Principal Register, if eligible,

whether or not the application was filed initially based on a pending application under Section 44(d) or on the basis of an existing registration under Section 44(e).<sup>185</sup>

While a qualified foreign applicant under Section 44 is given the procedural advantage in obtaining a U.S. trademark registration, the continuing validity of such a registration is placed on equal footing with any other U.S. registration.<sup>186</sup> An application under Section 44 is published in the same manner as an application under Section 1(a) or 1(b) by a U.S. applicant and is therefore subject to oppositions or cancellation proceedings under Sections 13<sup>187</sup> and 14<sup>188</sup> respectively, and can further be subjected to cancellation by a court under the provisions of Section 37.<sup>189</sup> The owner of any U.S. registration issued pursuant to Section 44 must file the necessary affidavits of use under Section 8<sup>190</sup> between the fifth and sixth year of the U.S. registration and again upon the ten-year renewal date. Such a registrant is also entitled to the benefits of Section 15<sup>191</sup> providing for incontestability of the mark.

Any registration issued pursuant to an application under Section 44 will bear a registration date based upon when it has successfully passed through the opposition period. Thus, under Section 44, there will necessarily be a gap in time between the application date and the registration date. The Section 44 applicant, however, is afforded the benefits of the constructive date of first use under Section 7(c)<sup>192</sup> of the Lanham Act, contingent on ultimate registration of the mark. While Section 44(c) provides that a U.S. registration cannot be granted until the registration is granted in the country of origin (unless the applicant alleges actual \*98 use in commerce), once the registration is issued, under Section 44(f), it is independent of the registration of the country of origin and the duration, validity, or transfer in the United States of such registration will be governed by U.S. law.

## **B. New Section 66(a) of the Lanham Act**

With the enactment of the MPIA, qualified foreign applicants have an additional basis for obtaining protection of a mark in the United States under Lanham Act Section 66(a). Rule 7(2) of the Common Regulations governing the Protocol that allows a Contracting Party to require a declaration of intention to use in a territory is key to the United States' ability to become a party to the Protocol. Unless a Contracting Party requires a separate declaration of use signed by the applicant or his representative, no special action is needed, as the statement on the international application form indicates, by designating such a party, the applicant declares that he has the intention that the mark will be used by him in that Contracting Party for the goods and services covered by the international application.<sup>193</sup> As of January 1, 2002, no Contracting Party had required a separate form for the declaration of use.<sup>194</sup> However, under the MPIA, the United States requires that an extension for protection of an international registration to the United States submitted by the International Bureau have attached to it a declaration of bona fide intention to use the mark in commerce that is verified by the applicant or holder of the international registration.<sup>195</sup>

The International Bureau will certify that the request for extension of protection contains a declaration of bona fide intention to use the mark in commerce when it forwards the request to the USPTO.<sup>196</sup> The declaration will remain part of the international registration on file with the International Bureau. The International Bureau will forward the request for extension of protection to the USPTO electronically; the holder cannot file a request for extension of protection to the United States directly with the USPTO.<sup>197</sup> In accordance with the provisions of the Protocol discussed in Section III.E., the MPIA affords the foreign applicant seeking protection of its mark in the United States the benefits of Paris Convention priority if the request for extension contains such a claim and the international \*99 registration date is within six months of the foreign application on which priority is claimed.<sup>198</sup>

Under the MPIA, unless extension of protection is refused, the USPTO will issue a certificate of extension of protection.<sup>199</sup> From the date on which the certificate of extension of protection is issued, it shall have the same effect as a registration on the Principal Register.<sup>200</sup> Thus, a qualified foreign applicant protecting its mark in the United States pursuant to the Protocol will enjoy the constructive use benefits of Section 7(c), as of the international registration date or as of the date of the earlier priority claim named in the international application. A request for extension of protection of the international registration will be examined in the same manner as an application for registration on the Principal Register.<sup>201</sup> If it appears, based on the examination by the USPTO, that the mark is entitled to protection, it will be published for opposition in the USPTO's Official Gazette. Under the MPIA, the United States will provide for the notification under the Protocol to refuse extensions of protection requests within eighteen months after the international registration date, as well as for notification of the possibility that an opposition to the request may be filed after the end of that eighteen-month period.<sup>202</sup> Notification of the refusal based on an opposition must be made in accordance with the provisions of the Protocol discussed in Section II.C.

above.<sup>203</sup> However, the MPIA specifically provides that extension of protection shall not be refused on the ground that the mark has not been used in commerce.<sup>204</sup>

### **C. Comparison of Sections 44 and 66(a)**

Thus, a qualified foreign applicant seeking to protect its mark in the United States under either Section 44 or under Section 66(a) has (1) the benefits of constructive use priority under Section 7(c); (2) priority under the Paris Convention back to an earlier filed national application; and (3) the ability to obtain a U.S. registration without first proving use of the mark in the United States. In this sense, a qualified foreign applicant seeking extension of its mark in the United States pursuant to the Protocol has the same benefits as qualified applicant filing directly in the United States. However, a request for extension under Section 66(a) provides a further advantage by allowing the foreign applicant to seek extension of \*100 protection in the United States even after the priority date has passed if it has a pending application with its Office of Origin. In contrast, as noted earlier, a pending application in a foreign country can serve as the basis for a U.S. filing under Section 44 only if it is filed within six months of the date of the foreign application.

There are, however, differences in the position of an applicant seeking protection of a mark in the United States pursuant to Section 66(a) as compared to an applicant under Section 44. First, an applicant under Section 44 can claim an additional basis for filing under Section 1 of the Lanham Act based on actual use or bona fide intention to use the mark in commerce. In contrast, under the Final Rules, a Section 66(a) applicant may not include any other basis in the initial application.<sup>205</sup> Second, because Section 68(a)(4) of the MPIA provides that registration of an extension of protection of an international registration shall be refused to any mark not eligible for registration on the Principal Register, an application under Section 66(a) is not eligible for registration on the Supplemental Register.<sup>206</sup>

The most significant difference in position for a qualified foreign applicant seeking to protect its mark in the United States under Section 44, as compared to the Madrid Protocol under Section 66(a), is the dependency issue discussed in Section III.G. in connection with a U.S. application or registration as the basis of an international registration. Once the registration pursuant to Section 44 is obtained, it becomes independent of the registration in the trademark owner's home country. In contrast, as is the case for U.S. applicants filing in foreign countries based on a U.S. application or registration, a qualified foreign applicant seeking protection under the Protocol faces the issue of dependency on its home country application or registration for a period of five years from the date of the international registration.

As required by the Protocol, the MPIA provides for the transformation of an extension of protection into a U.S. application if filing pursuant to Sections 1 or 44 is made within three months of the date from which the international registration was cancelled.<sup>207</sup> Under the Final Rules, such a request for transformation must be submitted through TEAS and include the filing fee for at least one class of goods or services.<sup>208</sup> When this occurs, such an application is treated as if it had been filed on the international registration date and retains the benefit of priority to any earlier national filing claimed in the international application.<sup>209</sup> Nevertheless, the foreign \*101 applicant loses the benefits of any initial cost savings obtained by protecting its mark under the Protocol.

### **D. Restriction of International Registration Goods/Services in the United States**

As discussed previously, because of differences in the degree of specificity required with respect to the designation of goods and services in some countries, a qualified foreign applicant seeking to protect a mark in the United States based on a foreign country application can expect to narrow the designation of goods and services, if that foreign country permits a broad designation of goods or services or coverage under an entire class heading. This is true whether the applicant is proceeding pursuant to a national filing in the United States under Section 44 or seeks to extend the protection of its mark into the United States pursuant to the Madrid Protocol. The USPTO would not be able to apply different standards to applicants seeking protection under the Protocol than it would under its national system, as this would disadvantage both U.S. applicants and applicants under Section 44.

Regardless of whether an applicant proceeds pursuant to the Protocol or under a national filing in the United States, the foreign applicant seeking to protect a mark in the United States should bear in mind the significance of the U.S. requirements for a bona fide intention to use the mark in commerce. This bona fide intent-to-use requirement applies regardless of the basis on which the foreign applicant seeks to obtain a registration in the United States. While the Office of Origin of the foreign

applicant must certify that the goods and services named in the international application conform to those in the basic application and registration, the applicant seeking to extend its mark into the United States under the Protocol should recognize the significance of the bona fide intent-to-use declaration that it will sign in connection with its extension request. Descriptions broader than the actual intent-to-use might give rise to the possibility of attack on protection of the mark under the international registration in the United States on the basis that the applicant lacked the requisite intent-to-use in the event such rights are asserted in a later litigation proceeding. Thus, the foreign applicant seeking to protect its mark in the United States pursuant to the Protocol would be well advised to consider limiting the list of goods and services it seeks to protect in the United States. Form MM2 specifically provides for an applicant to specify more narrow designations of goods and services for individual Designated Contracting Parties than that appearing in the basic application or registration.

#### **E. Impact of U.S. Use Requirement for Registration**

While a qualified foreign applicant need not prove use of the mark in the United States before obtaining a registration pursuant to either Section 44 or Section 66(a), non-use of the mark in the United States can still result in a loss of rights. One of the hallmarks of the Protocol is that renewal of the international registration is effected on the payment of a fee with no other conditions for obtaining renewal, including proof of use. However, there seems to be no \*102 limitation on the ability of a country to require submission of affidavits and proofs of use at any time for purposes of maintaining trademark rights. Hence, the MPIA provides that an affidavit of use must be filed between the fifth and sixth year anniversary of the date on which the extension of protection in the United States was issued and again at the end of ten years from the date of issuance of certificate of extension of protection.<sup>210</sup> As with the affidavits required under Section 8 of the Lanham Act, the affidavit of use must set forth the goods or services on which the mark is being used and provide a specimen showing use of the mark.<sup>211</sup> The MPIA also gives an extension of an international registration in the United States the benefits of incontestability under Section 15 if the holder files the requisite affidavit.<sup>212</sup> The period of use for purposes of Section 15 cannot begin earlier than the date on which the certificate of extension of protection is issued.<sup>213</sup>

### **IV. Selection of Marks: Impact of U.S. Adherence to the Madrid Protocol on Trademark Clearance**

#### **A. Extension of Period of Uncertainty**

Since the implementation of the TLRA on November 16, 1989, trademark practitioners have recognized the need for comprehensive, accurate, and up-to-date trademark clearance searches due to the constructive use benefits conferred in the United States by the application filing date. These benefits apply whether an application is based on use, intent-to-use, or a foreign application or registration under Section 44. United States adherence to the Protocol affects U.S. trademark searching and clearance in at least two respects. First, the “period of uncertainty” (the time during which a search will not reveal all possible conflicts) is longer, thus increasing the risk that a third-party application may have been filed in the interim.<sup>214</sup> Second, U.S. trademark owners are likely to expand their search parameters to include the International Register. Such a practice will increase the cost of trademark clearance, particularly with regard to evaluating and investigating potentially conflicting marks.

Prior to the effective date of the MPIA, the period of uncertainty in the United States for trademark searching and clearance was considered to be approximately seven months.<sup>215</sup> This accounted for six months of time to cover Paris Convention priority filings, plus one month before information pertaining to a new application \*103 is made available for searching on the USPTO’s database.<sup>216</sup> This time period is expected to increase to eight months or more with U.S. adherence to the Protocol.<sup>217</sup> If a foreign applicant files its international application at the end of the six-month Paris Convention priority period and the Office of Origin takes the full two months it is allotted to transmit the Madrid application to the International Bureau, eight months may elapse before the International Bureau receives information pertaining to the application.<sup>218</sup> Further, assuming the application is not deficient in any of the respects discussed in Section II.B. or that any such defects are remedied within the requisite two-month period, there is still the possibility of a delay based on insufficient fees or irregularities in the classification of goods that the applicant or the Office of Origin will have three months to remedy from date of notification of such a deficiency. Thus, in the event there is an application defect, almost a year can elapse before the USPTO will receive an official notification of the extension request and enter the data from the international registration into its searchable database.<sup>219</sup>

However, this should not significantly impact U.S. trademark owners because of the availability of information concerning

international registrations that is publicly available from WIPO, including (1) the WIPO Gazette of International Marks; (2) the electronic publication on CD-ROM known as ROMARIAN; and (3) the electronic database.<sup>220</sup> If an international application or subsequent designation is not recorded in the International Register within three working days following its receipt by the International Bureau, the data contained in it will nonetheless be entered into the electronic database. This is notwithstanding any irregularities that may exist in the international application or designation as received.<sup>221</sup> For the general public, data concerning all international registrations in force, as well as international applications and subsequent designations which have not yet been published in the Gazette, are accessible in searchable form on the Internet at WIPO's website under the heading "Madrid Express."<sup>222</sup> While there is no practical way to avoid this extended period of uncertainty, a second follow-up search of the WIPO database two months after the filing of a U.S. application (to account for the time the Office of Origin has to transmit the international application to the International Bureau) could place the applicant in substantially \*104 the same position with respect to possible conflicts as under the present period of uncertainty.

## **B. Searching for Conflicting International Registrations**

Hence, U.S. adherence to the Protocol will likely lead U.S. trademark practitioners to include international searches as a regular part of their trademark search and clearance procedures, even if the applicant intends only to seek registration in the United States.<sup>223</sup> However, applicants seeking to protect a mark outside the United States, or applicants planning to invest substantially in a mark in the United States, should still consider searching national registers, as well as the International Register, to reduce uncertainty when adopting a mark.

It should be noted here, however, that because of the breadth of the designation of goods and services that may appear in the international application as filed, it could be more difficult to evaluate a potential conflict than in the case of a national filing with the USPTO, where the applicant must specifically identify the goods used or on which the mark is intended to be used. It will most likely be necessary to engage in more substantive investigations to ascertain whether a proposed mark will conflict with an international registration seeking an extension into the United States.

## **V. Changes in Opposition Practice**

### **A. Enforcement Strategy**

In addition to the implications of the Protocol on selection of a mark, U.S. practitioners may also wish to include the International Register as a part of a watch service and enforcement strategy to ensure that marks on the International Register that could potentially conflict with the trademark owner's rights in the United States are detected as early as possible. Further, the opportunity for the central attack means that the U.S. trademark owner could potentially defeat the extension of the international registration into the United States by attacking the basic application or registration in the Office of Origin. Allowing for possible transformation of the international registration into national application, this could potentially eliminate the necessity of bringing an action separately in the United States and in each foreign jurisdiction where the conflicting mark has been filed or registered. When a trademark owner opposes an international registration and has also initiated a central attack, the trademark owner may wish to seek a stay of the opposition filed in the United States pending the outcome of the attack on the home application or registration. Whether in practice such a stay would be granted, or \*105 would be considered to defeat the objectives of the Madrid System, remains to be seen.

### **B. Impact on Timing of U.S. Oppositions**

As discussed above in Section II.C., the Protocol sets forth time limitations on which a provisional refusal based on an opposition must be communicated to the International Bureau. Accordingly, the MPIA provides that, within eighteen months after the date on which the International Bureau transmits a request of extension for protection to the USPTO, the USPTO must send one of the following to the International Bureau: (1) a notification of refusal based on examination of the request for extension of protection; (2) a notification of refusal based on the filing of an opposition to the request; or (3) a notification of the possibility that an opposition to the request may be filed after the end of that eighteen-month period.<sup>224</sup>

The Common Regulations provide that, when it becomes apparent with regard to a given international registration that the opposition period will expire too late for any provisional refusal based on an opposition to be notified to the International

Bureau within the eighteen-month time limit, the office must inform the International Bureau of the number and the name of the holder of the international registration concerned.<sup>225</sup> Such notice should be given on a case-by-case basis; it should not be given routinely for all notifications of refusal issued by an office, since this would simply restate the fact that the Contracting Party has made the declaration provided for in Article 5(2)(c) of the Protocol.<sup>226</sup> Where, at the time the information is given, the dates on which the opposition period begins and ends are known, they should be indicated; otherwise, at the latest they should be communicated to the International Bureau at the time when the notice of refusal based on an opposition is sent to the International Bureau.<sup>227</sup> As required by the Protocol, the MPIA provides that, where the USPTO has notified the International Bureau of the possibility of an opposition filed after the end of the eighteen-month period, the actual refusal based on the filing of the opposition must nevertheless be notified to the International Bureau, together with a statement of all grounds for the opposition, within seven months after the beginning of the opposition, or within one month after the end of the opposition period, whichever is earlier.<sup>228</sup>

There is, however, a conflict between these notice provisions and the USPTO's historical practice concerning extensions of time to file a notice of \*106 opposition. Prior to the effectiveness of the MPIA, USPTO practice provided that extensions of time to file an opposition could be granted for good cause. While extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application required the consent of the applicant or his representative or a showing of extraordinary circumstances, there was no absolute limit on the length of the time for filing an opposition.<sup>229</sup> With the MPIA, depending on when the extension request is published for opposition in the USPTO Official Gazette, the seven-month time limit to notify the International Bureau of a refusal based on an opposition restricts the parties' ability to agree to an unlimited number of further extensions of the opposition deadline in order to negotiate a possible settlement, as would have been allowed under historical USPTO practice. Furthermore, these time limits create other issues with respect to the USPTO's processing of requests for extension of time to file an opposition and notices of opposition in order to comply with the Protocol's time limitations.

The following example will illustrate these issues. Suppose that X is the holder of an international registration dated January 1, 2004, such that the eighteen-month period to notify WIPO of a provisional refusal would end on July 1, 2005. The USPTO examines the extension protection request as it would an application seeking registration on the Principal Register and eventually approves the mark for publication in the USPTO Official Gazette on May 1, 2005.<sup>230</sup> The latest an opposition could be communicated, therefore, is December 1, 2005 (seven months from the beginning of the opposition period). Under the provisions of 37 C.F.R. § 2.102, the opposition period would expire on May 31, 2005. However, because the provisions for extensions of time to file an opposition pursuant to 37 C.F.R. § 2.102 could extend the opposition period past July 1, 2005, the USPTO should notify the International Bureau of the possibility that an opposition to the request for extension protection in the United States may be filed after the end of the eighteen-month period, or after July 1, 2005.<sup>231</sup>

Suppose further that Y files a request for extension of time to oppose X's extension request on May 31, 2005, seeking a sixty-day extension of time to oppose until July 30, 2005, and the request is ultimately granted. On July 30, 2005, Y files yet another thirty-day extension request which is again granted by the USPTO such that the opposition period now expires on August 29, 2005 (and marks the end of 120 days from the date of publication of X's extension request in the USPTO Official Gazette). However, prior to August 29, 2005, X and Y agree to a sixty-day extension of time for Y to oppose X's extension request in order to attempt a \*107 settlement, thereby extending the expiration of the opposition period to October 29, 2005.

As a practical matter, no further extension of the opposition period beyond October 29, 2005 is possible. If X and Y reach an impasse, but Y does not file a notice of opposition until October 29, 2005, the USPTO must notify the International Bureau of the particulars concerning the opposition within one month of the end of the opposition period, or by November 29, 2005. This is because, in this instance, one month after the end of the opposition period is earlier than seven months after the beginning of the opposition period.<sup>232</sup> Suppose, however, that X and Y have not reached an impasse by October 29, 2005 but would like to obtain a further extension of the opposition period to allow settlement negotiations. As a practical matter, it would not be possible for the USPTO to grant even another thirty-day extension until November 28, 2005 because, assuming Y were to file an opposition on November 28, 2005, the USPTO would have only a few days (until December 1, 2005) to send the provisional refusal to WIPO. In this case, seven months from the beginning of the opposition period is earlier than one month from the end of the opposition period.

The USPTO rules that allow the filing of a notice of opposition by regular mail with a certificate of mailing would, as a practical matter, simply not allow sufficient time for the USPTO to determine whether a notice of opposition had been filed and timely notify WIPO of the provisional refusal based thereon. Even where the opposition was timely filed on October 29, 2005, a filing of the notice of opposition by regular mail with a certificate of mailing could make it difficult for the USPTO to

comply with the one month deadline. In recognition of the conflict created by the present rules with respect to oppositions and the notification requirements and logistical issues created by filings under the Protocol, the Final Rules will: (1) mandate electronic filing of oppositions to requests for extension of protection into the United States under the Protocol and extensions of time to file oppositions to same; and (2) restrict the parties' ability to agree to further extensions of time to file an opposition.

The Final Rules add a new section stating that an opposition to an application based on Sections 1 or 44 of the Lanham Act may be filed either on paper or electronically through the Electronic System for Trademark Trials and Appeals ("ESTTA") but that an opposition to an application based on Section 66(a) may be filed only through ESTTA.<sup>233</sup> Further, the Final Rules allow a written request to extend the time for filing an opposition to an application based on Sections 1 or 44 of the Lanham Act to be submitted either on paper or electronically through \*108 ESTTA but require extensions of time for filing an opposition to an application based on Section 66(a) to be filed only through ESTTA.<sup>234</sup>

Of greater significance are the provisions concerning the time for filing of requests for extensions of time to file an opposition. Under the Final Rules, the time for filing an opposition may not be extended beyond 180 days from the date of publication.<sup>235</sup> At the option of the potential opposer, a thirty-day extension request will be granted automatically.<sup>236</sup> A second extension of sixty days may be granted for a good cause.<sup>237</sup> Alternatively, the potential opposer may file a single request for extension of time for ninety days for a good cause.<sup>238</sup> After receiving extensions of time totaling ninety days, the potential opposer may file one final request for an extension of time for an additional sixty days, which will be granted provided the potential opposer has obtained the consent of the applicant or else shows extraordinary circumstances.<sup>239</sup> This 180-day limitation period will apply to all applications--not merely to those based on Section 66(a).<sup>240</sup>

Under the Proposed Rules the time for filing an opposition would have been strictly limited to 120 days from the date of publication.<sup>241</sup> The parties would have had no option to agree to a further extension of time to file an opposition, hence restricting their ability to delay filing the opposition pending negotiation of a settlement. Comments to the Proposed Rules disagreed with the proposed 120-day limitation and further recommended that any restrictions on the time to file an opposition mandated by the Protocol's time limits apply only to applications under Section 66(a).<sup>242</sup> The Final Rules adopted the recommendation that potential opposers be permitted to extend the time for filing an opposition to up to 180 days from the date of publication.<sup>243</sup> Allowing the parties to agree to extensions of time up to 180 days after the publication date of the request for extension of protection still allows the USPTO a full month to meet the requirements for notification of the \*109 opposition to the International Bureau. The USPTO declined, however, to adopt the recommendation that the 180-day limitation pertain only to Section 66(a) applications.<sup>244</sup> The USPTO reasoned:

The Office encourages use of its electronic systems and does not have the resources at this time to develop an electronic opposition filing system that can handle different filing deadlines for different types of applications. Further, different opposition filing deadlines for different types of applications will be difficult for the Board to handle administratively and would be likely to confuse potential opposers. . . . [T]he Board is continuing its practice of permitting suspension of an opposition, once filed, to facilitate and encourage settlement negotiations.<sup>245</sup>

The Final Rules set forth how changes in USPTO practice concerning extensions of time to file an opposition will be implemented. If a first request for an extension of time to oppose was filed before November 2, 2003, the rules in effect on the filing date of that first request will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it.<sup>246</sup> If a first request for an extension of time to oppose is filed on or after November 2, 2003, the amended regulation will apply to the first request and any subsequent request filed by the same potential opposer or one in privity with it.<sup>247</sup>

### **C. Amendment of Pleadings in Opposition Proceedings**

Finally, U.S. practitioners should be aware of differences concerning amendment of pleadings as between oppositions against applications filed under Sections 1 or 44 as compared to oppositions of Section 66(a) applications. Under Final Rule 2.107(a), while an opposition against an application under Sections 1 or 44 may not be amended to add to the goods or services opposed, it can be amended to add additional grounds.<sup>248</sup> In contrast, under Final Rule 2.107(b), an opposition against an application under Section 66(a) may not be amended to add new grounds for the opposition or to add the goods or services opposed.<sup>249</sup> This difference places the opposer against an application under Section 66(a) at a disadvantage in that, at the point

at which the opposition must be filed, the opposer may not be aware of all possible grounds on which the opposition might be based.

This restriction pertaining to amendments to oppositions against Section 66(a) applications provides yet another reason for the potential opposer to conduct an early investigation as to the applicant's activities. Even with such an investigation, \*110 however, the opposer may, during the course of discovery, become aware of additional grounds for opposition. Accordingly, the potential opposer of a Section 66(a) application may wish to await issuance of the registration and then file a petition to cancel. Unlike opposition proceedings, cancellation pleadings against Section 66(a) applications can be amended to add additional grounds or new goods and services. The practitioner will need to weigh the risk of possible discovery of additional grounds for opposition against the disadvantages of delay, both in terms of leverage against the applicant and increased difficulty in reaching an amicable resolution of the matter once the international registrant has invested in use of the mark.

## Conclusion

U.S. adherence to the Protocol holds great promise for U.S. trademark owners in terms of cost savings and simplicity in protecting a mark internationally. These benefits will also extend to qualified foreign applicants seeking to protect their marks in the United States. However, as this paper illustrates, an individual client's situation must still be evaluated by the U.S. trademark practitioner to assess whether national, regional, or Protocol filings are best for a client's situation. Now, more than ever, it is important for the U.S. trademark practitioner to understand the scope and nature of a client's business objectives with respect to protection of a mark to formulate the best strategy for protection.

## Footnotes

<sup>1</sup> Senior Associate, Fulbright & Jaworski L.L.P., Dallas, TX; J.D., 1994, University of Kansas School of Law; M.B.A., 1995, Rockhurst College; Program Vice-Chair and Speaker, American Intellectual Property Law Association's 2003 Madrid Protocol Seminar.

<sup>2</sup> The World Intellectual Property Organization [hereinafter WIPO], Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, available at <http://www.wipo.int/clea/docs/en/wo/wo016en.htm> (last visited July 10, 2003) [hereinafter Protocol].

<sup>3</sup> Madrid Protocol Implementation Act, Pub. L. No. 107-273, Title III, subtitle D, §§13401-13403, 116 Stat. 1913-1921 (2002) (to be codified at 15 U.S.C. §1141) [hereinafter MPIA].

<sup>4</sup> See id. §13403. The United States completed the formal process for joining the Madrid Protocol on Aug.2, 2003 when it deposited the accession document with WIPO. USPTO, United States Joins the Madrid Protocol, available at <http://www.uspto.gov/web/trademarks/usjoinsmadrid.html> (last visited Oct.8, 2003).

<sup>5</sup> Int'l Trademark Ass'n, Issue Brief: The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice, at 1 (Nov. 2002), available at <http://inta.org/downloads/tapusmadrid2003.pdf> (last visited Sept. 10, 2003) [hereinafter INTA Issue Brief].

<sup>6</sup> Lanham Act, 15 U.S.C. §§1051-1129 (1999).

<sup>7</sup> Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; Final Rules, 68 Fed. Reg. 55748 (Sept. 26, 2003) (to be codified at 37 C.F.R. pts. 2 & 7), available at <http://www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf> (last modified Sept. 27, 2003).

<sup>8</sup> WIPO, Guide to the Int'l Registration of Marks Under the Madrid Agreement and the Madrid Protocol (2002 version), part B, ch. II, § 01.01, at B.II.2, available at <http://www.wipo.org/madrid/en/index.html> (last visited Sept.7, 2003) [hereinafter Guide].

<sup>8</sup> Id. Note that it is possible to file a single international application based on more than one basic application and/or registration that together cover the goods and services sought to be protected by the international registration, provided such applications or registrations are in the name of the same person filing the international application and have been made in the same Office of Origin. See *id.* § 01.02.

<sup>9</sup> Article 9quater of the Protocol permits several countries, which are all parties to the Protocol and have agreed to adopt a uniform legislation on marks, to act as a single state for purposes of the Protocol. To date, only one such notification has been made. The Benelux Office registers marks in Belgium, the Netherlands and Luxembourg. See *Guide*, *supra* note 7, §§ 04.02-04, at A.8.

<sup>10</sup> See *Protocol*, *supra* note 1, art. 1; *Guide*, *supra* note 7, § 02.05, at A.3; *MPIA*, *supra* note 2, § 60(3) and § 60(16).

<sup>11</sup> See *Guide*, *supra* note 7, § 01.01, at B.II.2.

<sup>12</sup> See *Protocol*, *supra* note 1, art. 2; *Guide*, *supra* note 7, § 02.03, at B.II.3.

<sup>13</sup> See *MPIA*, *supra* note 2, § 61.

<sup>14</sup> See *Guide*, *supra* note 7, §§ 02.04-08, at B.II.3-4.

<sup>15</sup> See *Protocol*, *supra* note 1, art. 4(2).

<sup>16</sup> See *Guide*, *supra* note 7, § 13.01, at B.II.12.

<sup>17</sup> See *id.* § 13.05, at B.II.13. See also discussion *infra* Part II.B.

<sup>18</sup> See *id.* § 05.01, at B.II.6.

<sup>19</sup> See *id.* § 07.01, at B.II.7.

<sup>20</sup> See *id.* §§ 04.02-04, at B.I.4.

<sup>21</sup> Form MM2 and other Madrid Protocol related forms are available at <http://www.wipo.int/madrid/en/forms/index.htm> (last visited November 8, 2003).

<sup>22</sup> See *Protocol*, *supra* note 1, art. 3(1).

<sup>23</sup> See *Guide*, *supra* note 7, § 07.20(a)-(d), at B.III.10-11.

<sup>24</sup> See *id.* § 07.20(e), at B.III.11.

<sup>25</sup> See *id.*

26 A list of countries that are parties to the Protocol and can be designated for extension of protection of an international registration is available at WIPO's website: <http://www.wipo.int/madrid/en/geninf.html> (last visited November 8, 2003).

27 See Guide, *supra* note 7, § 14.01, at B.III.20. The Office of Origin may request that the International Bureau send the certificate to it instead. Based on the Final Rules, it does not appear that the USPTO will request that it receive the international registration certificate.

28 See Protocol, *supra* note 1, art. 3(4); Guide, *supra* note 7, §§ 15.01-04, at B.III.20-21.

29 See Guide, *supra* note 7, §§ 15.01-04, at B.III.20-21.

30 See *id.* § 15.03, at B.III.21.

31 *Id.* § 15.04, at B.III.21.

32 See *id.* §§ 38.01-48.03, at B.II.40-51 (discussion of the subsequent designation process).

33 See Protocol, *supra* note 1, art. 4(1).

34 See Guide, *supra* note 7, § 36.02, at B.III.36.

35 See *id.* § 36.03, at B.III.36.

36 See *id.*

37 See *id.*

38 See *id.* § 36.04, at B.III.36.

39 See *id.* The MPIA provides that the United States will issue a certificate of extension of protection. See MPIA, *supra* note 2, § 69.

40 See Protocol, *supra* note 1, art. 4(1).

41 See Guide, *supra* note 7, § 36.04, at B.III.36.

42 See Protocol, *supra* note 1, art. 5(1); Guide, *supra* note 7, §§ 43.01-02, at B.III.43.

43 See *id.* art. 5(2)(b).

44 *Id.* art. 5(2)(c); Guide, *supra* note 7, § 44.04, at B.III.45-46.

<sup>45</sup> See Guide, *supra* note 7, § 49.01, at B.III.55.

<sup>46</sup> See *id.*

<sup>47</sup> See *id.* § 45.01, at B.III.46-47.

<sup>48</sup> See *id.* § 49.02, at B.III.55.

<sup>49</sup> See *id.*

<sup>50</sup> *Id.* § 49.03, at B.III.55.

<sup>51</sup> See Guide, *supra* note 7, § 49.04, at B.III.56.

<sup>52</sup> See MPIA, *supra* note 2, § 69(a).

<sup>53</sup> See Guide, *supra* note 7, § 49.05, at B.III.56.

<sup>54</sup> See *id.*

<sup>55</sup> See *id.* § 49.07, at B.III.56.

<sup>56</sup> Final Rules, 68 Fed. Reg. 55748, 55770 (to be codified at 37 C.F.R. § 7.11(a)).

<sup>57</sup> *Id.* at 55749.

<sup>58</sup> See *id.* at 55770-71 (to be codified at 37 C.F.R. § 7.11 (a)).

<sup>59</sup> *Id.* at 55749.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> See Final Rules, 68 Fed. Reg. 55748, 55770 (to be codified at 37 C.F.R. § 7.6).

<sup>63</sup> See Guide, *supra* note 7, § 20.06, at B.II.21; Protocol, *supra* note 1, art. 8.

<sup>64</sup> See Guide, *supra* note 7, § 20.06, at B.II.21; Protocol, *supra* note 1, art. 8.

65 See WIPO, Madrid Protocol for the International Registration of Marks: Fees, available at <http://www.wipo.org/madrid/en/fees/index.htm> (last visited Sept. 7, 2003).

66 See Final Rules, 68 Fed. Reg. 55748, 55770 (to be codified at 37 C.F.R. § 7.7).

67 Id.

68 See id. at 55749.

69 See id. at 55771 (to be codified at 37 C.F.R. § 7.13(a)).

70 See id. at 55771 (to be codified at 37 C.F.R. § 7.13(b)).

71 Id.

72 Final Rules, 68 Fed. Reg. 55748, 55750.

73 Id.

74 Id.

75 Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 15119, 15134-35 (proposed March 28, 2003) (to be codified at 37 C.F.R. §7.11(a)), available at [http://www.uspto.gov/web/trademarks/fr\\_madrid.htm](http://www.uspto.gov/web/trademarks/fr_madrid.htm) (last modified Mar. 28, 2003) [hereinafter Proposed Rules].

76 Final Rules, 68 Fed. Reg. 55748, 55753 and 55770 (to be codified at 37 C.F.R. § 7.11(a)(2)).

77 See id. at 55770 (to be codified at 37 C.F.R. § 7.4).

78 See id. at 55771 (to be codified at 37 C.F.R. § 7.13(a)).

79 Temporary Postponement of Electronic Filing and Payment Rules for Certain Madrid Protocol-Related Rules, 68 Fed. Reg. 60850, 60851 (Oct.24, 2003), available at <http://www.uspto.gov/main/newsandnotices.htm> (last visited Nov. 14 2003).

80 Id.

81 Id.

82 Modification to Temporary Postponement of Electronic Filing and Payment Rules for Certain Madrid Protocol-Related Rules, 68 Fed. Reg. 63019, 63020 (Nov. 7, 2003), available at <http://www.uspto.gov/main/newsandnotices.htm> (last visited Nov. 14, 2003); see also USPTO, Electronic Forms For Submitting Madrid-Protocol Related Documents are Unavailable (Oct. 31, 2003), available at <http://uspto.gov/web/trademarks/madrid/noforms.htm> (last visited Nov. 14, 2003).

83       Id.

84       Id.

85       Final Rules, 68 Fed. Reg. 55748, 55750; see also 68 Fed. Reg. at 55771 (to be codified at 37 C.F.R. § 7.14(a)).

86       Final Rules, 68 Fed. Reg. 55748, 55750; see also 68 Fed. Reg. at 55771 (to be codified at 37 C.F.R. § 7.14(a)).

87       See Final Rules, 68 Fed. Reg. 55748, 55771 (to be codified at 37 C.F.R. § 7.14(b)).

88       Final Rules, 68 Fed. Reg. 55748, 55750; see also 68 Fed. Reg. at 55771 (to be codified at 37 C.F.R. § 7.14(b)).

89       Final Rules, 68 Fed. Reg. 55748, 55750.

90       Id.

91       Id.

92       Id. at 55750-51.

93       See Final Rules, 68 Fed. Reg. 55748, 55751 (to be codified at 37 C.F.R. § 7.14(c)); see also 68 Fed. Reg. 55771 (to be codified at 37 C.F.R. § 7.14(c)).

94       See Final Rules, 68 Fed. Reg. 55748, 55751 (to be codified at 37 C.F.R. § 7.14(c)); see also 68 Fed. Reg. 55771 (to be codified at 37 C.F.R. § 7.14(c)).

95       See Final Rules, 68 Fed. Reg. 55748, 55751 (to be codified at 37 C.F.R. § 7.14(c)); see also 68 Fed. Reg. 55771 (to be codified at 37 C.F.R. § 7.14(c)).

96       Final Rules, 68 Fed. Reg. 55748, 55771 (to be codified at 37 C.F.R. § 7.14(d)).

97       Id.

98       See *id.* (to be codified at 37 C.F.R. § 7.14(e)).

99       Id.

100       Id.

101       Id. at 55753-54.

102 Final Rules, 68 Fed. Reg. at 55754.

103 *Id.*

104 *Id.*

105 *Id.* at 55753.

106 *Id.*

107 *Id.*

108 See discussion *supra* Sections III.A. and B.

109 Final Rules, 68 Fed. Reg. 55748, 55753; USPTO, Exam Guide No. 1-03; Changes Affecting all Applications and Registrations (Oct. 30, 2003), available at <http://www.uspto.gov/web/offices/tac/notices/examguide1-03.htm> (last visited Nov. 13, 2003).

110 *Id.*

111 *Id.*

112 See USPTO, Acceptable Identification of Goods and Services Manual, available at <http://www.uspto.gov/main/trademarks.htm> (last modified Sept. 3, 2003).

113 Examples include Portugal, France, Germany, Switzerland, and Japan. See generally John R. Olsen & Spyros M. Maniatis, *Trademarks, Trade Names and Unfair Competition: World Law and Practice* (Release 20, January 2003).

114 Nice Agreement Concerning the International Classification of Goods and Services to Which Trademarks are Applied, June 15, 1957, 23 U.S.T. 1336, 550 U.N.T.S.

115 See generally Olsen & Maniatis, *supra* note 113.

116 See Guide, *supra* note 7, §§ 02.04-08, at B.II.3-4.

117 See Mark Holah, *Linking the CTM and the Madrid Protocol*, Vol. 58, No. 18, INTA Bulletin, Oct. 1, 2003.

118 Guide, *supra* note 7, § 23.01, at B.II.25.

119 *Id.* § 43.05, at B.III.44.

120 *Id.*; see also Protocol, *supra* note 1, art. 4(1)b.

<sup>121</sup> See Protocol, *supra* note 1, art. 5(1).

<sup>122</sup> See *id.* art. 6(3).

<sup>123</sup> See *id.*; Guide, *supra* note 7, § 77.01, at B.II.79.

<sup>124</sup> See Guide, *supra* note 7, § 77.02, at B.II.79.

<sup>125</sup> See *id.*

<sup>126</sup> 15 U.S.C. § 1063 (1999).

<sup>127</sup> 15 U.S.C. § 1064 (1999).

<sup>128</sup> 15 U.S.C. § 1119 (1999).

<sup>129</sup> See Protocol, *supra* note 1, art. 6(3).

<sup>130</sup> 15 U.S.C. § 1058 (2002).

<sup>131</sup> See USPTO, Trademark Manual of Examining Procedure § 1108.03 (3d ed. 2002) [hereinafter TMEP].

<sup>132</sup> See Protocol, *supra* note 1, art. 6(4); MPIA, *supra* note 2, § 63.

<sup>133</sup> See Guide, *supra* note 7, § 18.05, at B.III.24.

<sup>134</sup> See *id.* § 18.06, at B.III.24.

<sup>135</sup> See *id.* § 18.08, at B.III.24-25.

<sup>136</sup> See *id.*

<sup>137</sup> See Proposed Rules, 68 Fed. Reg. 15119, 15124 (to be codified at 37 C.F.R. § 2.66).

<sup>138</sup> *Id.*

<sup>139</sup> *Id.*

<sup>140</sup> 37 C.F.R. § 2.66(a)(2) (64 Fed. Reg. 48921, Sept. 8, 1999).

<sup>141</sup> See Proposed Rules, 68 Fed. Reg. 15119, 15126 (to be codified at 37 C.F.R. § 2.146(i)).

<sup>142</sup> *Id.*

<sup>143</sup> *Id.*

<sup>144</sup> Final Rules, 68 Fed. Reg. 55748, 55756 (to be codified at 37 C.F.R. § 2.66(a)(2)).

<sup>145</sup> *Id.* at 55759 (to be codified at 37 C.F.R. § 2.66(a)(2)).

<sup>146</sup> *Id.* at 55761 (to be codified at 37 C.F.R. § 2.146(i)).

<sup>147</sup> *Id.* at 55758 (to be codified at 37 C.F.R. § 2.146(i)).

<sup>148</sup> *Id.* at 55759.

<sup>149</sup> *Id.* at 57756.

<sup>150</sup> Final Rules, 68 Fed. Reg. 55748, 57756.

<sup>151</sup> *Id.*

<sup>152</sup> *Id.* at 55748.

<sup>153</sup> *Id.*

<sup>154</sup> See Guide, *supra* note 7, § 18.12, at B.III.25.

<sup>155</sup> *Id.*

<sup>156</sup> *Id.*

<sup>157</sup> Protocol, *supra* note 1, art. 9quinquies; Guide, *supra* note 7, § 77.04, at B.II.79.

<sup>158</sup> *Id.*

<sup>159</sup> *Id.*, § 82.01, at B.II.83.

<sup>160</sup> Guide, *supra* note 7, § 82.05, at B.II.83.

<sup>161</sup> *Id.*

<sup>162</sup> 37 C.F.R. § 2.87; TMEP, supra note 131, § 1110.

<sup>163</sup> TMEP, supra note 131, § 1110.

<sup>164</sup> *Id.*

<sup>165</sup> *Id.*

<sup>166</sup> Guide, supra note 7, § 81.01, at B.II.82-83.

<sup>167</sup> *Id.* § 81.02, at B.II.83.

<sup>168</sup> *Id.* § 81.03, at B.II.83.

<sup>169</sup> *Id.*

<sup>170</sup> 15 U.S.C. § 1126 (2002).

<sup>171</sup> 15 U.S.C. § 1126(b) (1999).

<sup>172</sup> 14 U.S.C. § 1126(c) (1988).

<sup>173</sup> 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 29:15, at 29-31 (4th ed. 2002); 37 C.F.R. § 2.34.

<sup>174</sup> 4 McCarthy, supra note 173, § 29:15, at 29-31; see also 37 C.F.R. § 2.34.

<sup>175</sup> 4 McCarthy, supra note 173, § 29:15, at 29-31; see also 37 C.F.R. § 2.34.

<sup>176</sup> 4 McCarthy, supra note 173, § 29:15, at 29-31; see also 37 C.F.R. § 2.34.

<sup>177</sup> 4 McCarthy, supra note 173, § 29:15, at 29-31; see also 37 C.F.R. § 2.34.

<sup>178</sup> 4 McCarthy, supra note 173, § 29:15, at 29-31 to 29-32.

<sup>179</sup> 15 U.S.C. § 1126(d)(1) (1998).

<sup>180</sup> *Id.*

<sup>181</sup> 4 McCarthy, *supra* note 173, § 29:12, at 29-25.

<sup>182</sup> *Id.* § 29:12, at 29-26.

<sup>183</sup> *Id.*

<sup>184</sup> *Id.* § 29:11, at 29-25.

<sup>185</sup> *Id.*

<sup>186</sup> *Id.*; 4 McCarthy, *supra* note 173, § 29:19, at 29-42.

<sup>187</sup> 15 U.S.C. § 1063 (1999).

<sup>188</sup> 15 U.S.C. § 1064 (1999).

<sup>189</sup> 15 U.S.C. § 1119 (1999).

<sup>190</sup> 15 U.S.C. § 1058 (2002).

<sup>191</sup> 15 U.S.C. § 1065 (1999).

<sup>192</sup> 15 U.S.C. § 1057(c) (1988).

<sup>193</sup> Guide, *supra* note 7, § 17.05, at B.II.19.

<sup>194</sup> *Id.* § 17.04, at B.II.19.

<sup>195</sup> MPIA, *supra* note 2, § 66(a); Final Rules, 68 Fed. Reg. 55748, 55762 (to be codified at 37 C.F.R. § 2.33(e)).

<sup>196</sup> MPIA, *supra* note 2, § 66(a); Final Rules, 68 Fed. Reg. 55748, 55762 (to be codified at 37 C.F.R. § 2.33(e)).

<sup>197</sup> MPIA, *supra* note 2, § 66(a); Final Rules, 68 Fed. Reg. 55748, 55762 (to be codified at 37 C.F.R. § 2.33(e)).

<sup>198</sup> MPIA, *supra* note 2, § 67.

<sup>199</sup> *Id.* § 69(a).

<sup>200</sup> *Id.* § 69(b).

201       Id. § 68.

202       Id. § 68(c).

203       Id.

204       MPIA, *supra* note 2, § 68(a)(3).

205       Final Rules, 68 Fed. Reg. 55748, 55763 (to be codified at 37 C.F.R. § 2.34(b)).

206       Id. at 55763 (to be codified at 37 C.F.R. § 2.47(c)).

207       MPIA, *supra* note 2, § 70.

208       Final Rules, 68 Fed. Reg. 55748, 55773 (to be codified at 37 C.F.R. § 7.31).

209       MPIA, *supra* note 2, § 70.

210       MPIA, *supra* note 2, § 71.

211       Id.

212       Id. § 73.

213       Id.

214       INTA Issue Brief, *supra* note 4, at 25.

215       Id.

216       Id.

217       Id.

218       INTA Issue Brief, *supra* note 4, at 26.

219       Id.

220       Guide, *supra* note 7, § 6.01, at A.14.

<sup>221</sup> Id. §§ 9.01-02, at A.16.

<sup>222</sup> Id. § 09.04 at A.16.

<sup>223</sup> INTA Issue Brief, *supra* note 4, at 27.

<sup>224</sup> MPIA, *supra* note 2, § 68(c)(1).

<sup>225</sup> Guide, *supra* note 7, § 47.01, at B.III.50-51.

<sup>226</sup> Id.

<sup>227</sup> Id. § 47.02, at B.III.51.

<sup>228</sup> MPIA, *supra* note 2, § 68(c)(2).

<sup>229</sup> 37 C.F.R. § 2.102(c) (48 Fed. Reg. 3976, Jan. 28, 1983, as amended at 61 Fed. Reg. 36825, July 15, 1996; 63 Fed. Reg. 48097, Sept. 9, 1998).

<sup>230</sup> MPIA, *supra* note 2, § 68(a).

<sup>231</sup> Id. § 68(c)(1)(C).

<sup>232</sup> Id. § 13402, § 68(c)(2).

<sup>233</sup> Final Rules, 68 Fed. Reg. 55748, 55765 (to be codified at 37 C.F.R. 2.101(b)(1)-(2)).

<sup>234</sup> Id. at 55765-66 (to be codified at 37 C.F.R. § 2.102(a)(1)-(2)).

<sup>235</sup> Id. at 55766 (to be codified at 37 C.F.R. § 2.102(c)).

<sup>236</sup> Id.

<sup>237</sup> Id.

<sup>238</sup> Id.

<sup>239</sup> Final Rules, 68 Fed. Reg. 55748, 55766.

<sup>240</sup> Id. at 55760.

<sup>241</sup> Proposed Rules, 68 Fed. Reg. 15119, 15130 (to be codified at 37 C.F.R. § 2.102(c)).

<sup>242</sup> Final Rules, 68 Fed. Reg. 55748, 55760. Commentators advocating that limitations concerning extensions of time to oppose be restricted to Section 66(a) applications included the American Intellectual Property Law Association and the International Trademark Association. See Comments to the Proposed Rules, available at <http://www.uspto.gov/web/trademarks/madrid> (last modified June 19, 2003).

<sup>243</sup> Final Rules, 68 Fed. Reg. 55748, 55760.

<sup>244</sup> *Id.*

<sup>245</sup> *Id.*

<sup>246</sup> *Id.* at 55748.

<sup>247</sup> *Id.*

<sup>248</sup> *Id.* at 55766.

<sup>249</sup> Final Rules, 68 Fed. Reg. 55748, 55766.