

# International Registration and Protection of Trademarks Under The Madrid Agreement and Protocol

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Many companies are engaged in, or seek to be engaged in, commerce that transcends the borders of the United States. With developments in technology today, entrance into the global marketplace is easier, more efficient and financially rewarding. For domestic U.S. companies that have invested heavily in protecting and promoting their trademarks and/or service marks in the United States, protection of their marks and the substantial goodwill associated with those marks in international markets is vitally important. International registration and protection of trademarks is a must for any U.S. company marketing and promoting the sale of its products overseas.

Two regional registration systems should be considered with regard to international registration and international protection of trademarks. One system involves protection within the European Union countries and is known as the Community Trademark (CTM). The other involves protection under the Madrid Agreement and the Madrid Protocol. Forty countries are signatories to the international treaty referred to as the Madrid Agreement. The Madrid Agreement provides a system in which an owner of a national registration in its country of origin can obtain an international registration designating other nations for extension. Under the Madrid Agreement, an applicant can effectively obtain a bundle of national registrations which can be renewed centrally. The central filing bureau is the Central Registration Bureau (CRB) in Geneva, Switzerland, which is administered by the World Intellectual Property Organization (WIPO). After a company obtains a national registration in its own country, it files a single application with the CRB in Geneva. Registrations under the Madrid Agreement last for a period of up to 20 years and are renewable for additional 20-year terms. The "Madrid System" is only available to nationals of countries which are members of the Madrid Union.

The "Madrid Protocol" was created in 1989 and was intended to expand the membership in the Madrid System. Among other things, the Madrid Protocol changed certain facets of the Madrid System, which required registration in the home country before international protection would be afforded to a trademark owner. Under the Madrid Protocol, instead of requiring home country registration, home country application is enough on which to base the international registration. In countries like the United Kingdom and the United States, where an application often takes a substantial amount of time from issue to registration, allowing registration on an application is important. It should be noted that the United States is not a signatory to the Madrid Agreement or to the Madrid Protocol. Regardless, U.S. companies regularly file applications for registration and regularly seek international protection under this system. The initial and renewal terms of protection under the Madrid Protocol system are ten years, as is the case with a U.S. Federal registration.

International registration can be performed through the United States Patent and Trademark Office (USPTO) utilizing the "Madrid Protocol Forms." If the international application meets the requirements, the USPTO will certify and

forward the international application to the International Bureau of the WIPO. An international application submitted through the USPTO must be based on either (1) an application currently pending in the USPTO; or (2) a registration that the USPTO has already issued. All fees associated with the international application, i.e., the U.S. certification fee and the international application fees, must be paid at the time of submission to the USPTO. The U.S. certification fee is \$100 per class if the international application is based on a single basic application or registration; or \$150 per class if the international application is based on more than one basic application or registration. A schedule of international fees and a fee calculator are available online at the USPTO website. The international application fees for a recent client were in excess of twelve thousand dollars. The international application fees may be paid through the USPTO in U.S. dollars or directly to the WIPO in Swiss francs. Many of the European Union countries now adhere to the Madrid Protocol.

Before embarking upon the international registration of a mark, it is important to conduct a "Madrid Protocol Search." The results of this search will enable the client to determine if there may be any conflicting marks for which applications are pending or which are registered under this international registration system.