

ADDITIONAL DEVELOPMENTS—TRADEMARK

RULES OF PRACTICE FOR TRADEMARK-RELATED FILINGS UNDER THE MADRID PROTOCOL IMPLEMENTATION ACT

68 FED REG. 55, 748 (Sept. 26, 2003) (codified at 37 C.F.R. § 7.1 to .41 (2004))

The United States Patent and Trademark Office (USPTO) promulgated new regulations to implement the Madrid Protocol Implementation Act of 2002 (“the Act”). The Act amended the Trademark Act of 1946, and authorizes owners of a United States trademark to seek protection of marks in any country that is a party to the Madrid Protocol by submitting an application to the International Bureau (“IB”) of the World Intellectual Property Organization (WIPO). The Act also enables owners of foreign trademarks to seek protection in the United States.

To apply for international registration under the Act, a United States applicant must prepare an application based on a registered trademark or pending trademark application in the United States. An application must be submitted to the USPTO, which certifies the application and forwards it to the IB for review. If the application is approved, the IB registers the marks, publishes the international registration in the WIPO Gazette of International Marks, sends a certificate to the holder, and notifies the offices of state in the countries in which an extension of protection is sought. Registration by the IB does not automatically grant protection in the designated foreign jurisdiction—the mark must be reviewed by the foreign office from which protection is sought.

Part 7 of 37 C.F.R. provides the regulations and procedures by which the USPTO will implement this scheme. 37 C.F.R. § 7.11 to .24 set out the requirements for international applications based on United States trademarks, including guidelines for identifying goods and services, correcting errors and irregularities in applications, and extending protection to additional jurisdictions. International applications can be based on more than one U.S. application or registration if the marks are all the same and have a common owner.

37 C.F.R. § 7.25 to .40 provide rules for requests by owners of internationally registered trademarks for extension of protection to the United States. These sections describe the requirements for asserting a priority claim under the Paris Convention for the Protection of Industrial Property, replacement of domestic registration by international registration, effects of a cancellation of international registration, and the requirements for transformation of an international application into a U.S. application.

Under § 66(a) of the Act, a request for extension of protection to the United States must be accompanied by a declaration of an intention to use the mark in commerce that the U.S. Congress has authority to regulate. The specific declarations that must be made at registration can be found in 37 C.F.R. § 2.33(e). Requirements for declarations of use of the trademark in commerce, and excusable nonuse between the fifth and sixth year after registration and every ten years after registration, can be found at 37 C.F.R. § 7.36 to .40.

Finally, 37 C.F.R. § 7.41 describes the process of renewal of registration. The initial term of international registration is ten years, which can be renewed for up to twenty additional years upon payment of a renewal fee. Renewal of international registration and its extension of protection to the United States must be made directly with the IB.

