GIORDANO, HALLERAN & CIESLA
A PROFESSIONAL CORPORATION
ATTORNEYS AT LAW
PLEASE RESPOND TO:
U.S. POSTAL SERVICE ADDRESS:
POST OFFICE BOX 190
MIDDLETOWN, NEW JERSEY 07748
OR:
HAND DELIVERY AND OVERNIGHT SERVICE ADDRESS:
125 HALF MILE ROAD
RED BANK, NEW JERSEY 07701
(732) 741-3900
FAX: (732) 224-6599
www.ghclaw.com

March 2007

International Trademark Registration (the Madrid System)

By Kurt E. Anderson, Esq.

Overview

The Madrid System provides a centralized system for obtaining and managing trademarks in multiple countries. The Madrid System is comprised of two treaties: (1) the Madrid Agreement (the "Agreement") and (2) the Madrid Protocol (the "Protocol"). Countries which are party to these treaties are referred to as "Contracting Parties." A Contracting Party may be party to the Agreement, the Protocol, or both. China, Italy, France, Germany, and Spain, for example, are party to both the Agreement and the Protocol. The United States, Australia, United Kingdom, and Japan, however, are party only to the Protocol.

International Applications

An application under the Madrid System is referred to as an "international application." An international application is essentially the same as filing individual applications in multiple countries. It may be filed only by an applicant who has an establishment in, is domiciled in, or is a national of a Contracting Party.

As a general rule, an international application can be filed for a mark that has already been registered in one of the Contracting Party countries. The trademark office of the Contracting Party in which the national mark has been registered (or applied for) is referred to as the "Office of Origin." The one exception to this general rule is where the international application is governed exclusively by the Protocol. An international application governed

solely by the Protocol can be based on a national *application*. In other words, no national registration is required to file the international application.

An international application is governed by the treaty that is common to both the Office of Origin and the countries designated in the application. An application is governed exclusively by the Protocol when only the Protocol (and not the Agreement) is the only Madrid System treaty in common between the country of the Office of Origin and the countries designated in the application. Since the U.S. is only part to the Protocol (and not the Agreement), any international application which is based on a U.S. national registration or application will be governed exclusively by the Protocol. Thus, one advantage of a U.S. trademark application is that it allows the applicant to also file an international application before the U.S. trademark is registered. This is also true of those other countries which are party to the Protocol only.

Rules for Designating Other Countries

An international application must designate each Contracting Party in which protection is sought. Where the Office of Origin is in a country which is party to the Agreement, but not the Protocol (an "Agreement-Only" Contracting Party), only other countries which are party to the Agreement may be designated. Where the Office of Origin is in a country which is a party to the Protocol, but not the Agreement (a "Protocol-Only" Contracting Party), only other countries that are party to the Protocol may be designated. Finally, where the Office of Origin is in a country that is party to both the Agreement and the Protocol, the countries of any other Contracting Parties may be designated.

Rules of Ownership

A person may not be a record holder of an international application or registration for a country if that person would not have been entitled to designate that country in an international application in the first instance. For example, a person in a Protocol-Only country may not be a

record holder of an international application in respect of any country that is not also party to the Protocol. As mentioned above, the U.S. is a Protocol-Only country.

This information is not to be construed as legal advice. If you have any questions please do not hesitate to contact the following attorney:

Kurt E. Anderson – kanderson@ghclaw.com - 732-741-3900