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Registering Trademarks Under the Madrid Protocol

Sean C. Fifield*

In this article, the author explains that the United States is a party to the Madrid Protocol, an international treaty simplifying and centralizing the process for registering trademarks on an international basis. This treaty allows owners of U.S. trademark registrations and pending applications for registration to utilize a simplified and streamlined procedure for obtaining trademark protection in many foreign jurisdictions.

Summary of the Madrid Protocol System

For a modest fee, any trademark owner based in the United States may apply to register a trademark covered by a U.S. trademark application or registration on an International Register maintained by the World Intellectual Property Organization (WIPO). The application is filed through the U.S. Patent and Trademark Office and registration on the International Register is automatic upon compliance with the proper filing formalities and payment of the appropriate filing fees. Registration of a mark on the International Register provides no trademark protection on its own, but the owner of a trademark registered on the International Register obtains trademark protection in jurisdictions that are parties to the Madrid Protocol by "designating" one or more such jurisdictions. A list of the jurisdictions that are parties or soon to become parties to the Madrid Protocol is set forth in Appendix Table 1.

When the trademark owner designates countries to be covered by the international registration, WIPO forwards the details of the international registration to the trademark authorities in each designated country. Each trademark office then has up to 18 months to review the application to determine whether it complies with local legal requirements for registration. If any substantive objection is raised, the applicant must address it in accordance with the local laws of the designated country. If the designated country fails to raise an objection to the application during the 18-month examination period or if all objections raised are resolved, the international registration becomes effective as a trademark registration in the

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designated country, with the same effect as if the applicant had obtained a trademark registration by applying under the laws of the designated country.

When filing an application for registration on the International Register, the applicant must designate at least one foreign jurisdiction and pay the applicable jurisdiction-specific fee for each jurisdiction covered (in addition to the filing fees for the international registration itself).

Additional jurisdictions covered by the Madrid Protocol may be subsequently added to the international registration by the applicant at any time by payment of a subsequent designation fee of CHF 300 and the applicable jurisdiction-specific fees.

Filings Fees and Renewal

The filing fees under the Madrid Protocol are denominated in Swiss Francs. The base filing fee for the international registration is currently CHF 653 for a trademark (CHF 903 when the mark is in color). The jurisdiction-specific filing fees vary and are set forth in Appendix Table 1.

Registration on the International Register remains in force for a period of 10 years. The registration may be renewed for additional 10-year terms by payment of a base renewal fee (currently CHF 653) plus a country-specific fee for each country then designated under the international registration. Like the application fee, the renewal fee varies by country and the number of classes of goods covered by the registration.

The international registration and associated rights in designated countries are dependent upon the U.S. trademark registration or application upon which the international registration is based for a period of five years after registration of the mark on the International Register. If the U.S. application is denied or if the U.S. registration is cancelled within this five-year period, the international registration and all associated benefits in designated countries will be cancelled.

The owner of an international registration that has been cancelled due to termination of the underlying U.S. registration may file local trademark applications with each of the designated countries in which protection was previously afforded by the international registration. The trademark owner must pay all applicable application fees and complete the application process as provided for any other trademark application submitted under local law, but the trademark owner will receive the priority date of the cancelled international registration for all local trademark applications filed within three months after cancellation of the international registration.

After the five-year period has passed, the international registration ceases to be dependent upon the U.S. registration or application and will remain valid irrespective of the abandonment, cancellation, or expiration of the underlying U.S. registration or application.

Benefits of Registration Through the Madrid Protocol

- Eliminates need to prepare and file separate trademark applications in each country in which protection is sought;
- Necessary filings are handled through the U.S. Patent and Trademark Office;
- Not necessary to retain local counsel at filing stage;
- Local counsel need only be retained if trademark office of a designated country raises objections to the registration;
- Streamlined process generally results in substantial application fee savings;
- Simplifies administrative burden of registering in multiple countries;
- Single registration, with one renewal date, replaces multiple registrations with varying renewal requirements;
- Changes in ownership of international registration accomplished with single filing; and
- The 18-month deadline for local trademark offices to object to the extension of registration to a country designated in the international registration significantly accelerates the registration process in certain countries.

Drawbacks of Registration Through the Madrid Protocol

Scope of Protection

- The scope of the trademark registration on the International Register must be identical to (or narrower than) the scope of underlying U.S. application or registration;

- Because the U.S. Patent and Trademark Office requires relatively specific descriptions of the goods and services, the description of goods and services in the extension of an international registration to a foreign country may be significantly narrower than the description of goods and services that would be permitted in an application filed directly in the foreign country; and
- Because U.S. trademark law generally requires the mark to be actually used on the goods or services within three years after publication of the U.S. trademark application, the scope of goods and services protected may be limited to goods and services sold in the United States during the relevant time frame, where an application filed directly in the foreign country may not be limited in this manner.

Dependence on U.S. Registration/Application

- Registration on the International Register will depend on continued validity of the underlying U.S. trademark application or registration for a period of five years;
- If underlying application or registration terminates, all fees and resources expended on international registration will be lost;
- By filing in each local jurisdiction (in the event the underlying application of registration terminates) the trademark owner may preserve the priority date of the international registration but must essentially start from scratch and incur all of the costs it sought to avoid by using the Madrid Protocol procedure (e.g., retaining local counsel, etc.); and
- Under these circumstances, it is often worthwhile to exercise any necessary rights of appeal to prevent cancellation of underlying registration or at least delay any cancellation until after the five-year period of dependence has expired.

Conclusion

In determining whether to utilize the Madrid Protocol system for protecting their trademarks internationally, U.S. businesses will need to weigh the cost and time savings provided by the Madrid Protocol against the potential to obtain broader coverage under trademark registrations filed in foreign countries. For many trademarks, the advantages of the Madrid Protocol system will probably outweigh the slight reduction in the scope of protection afforded in certain foreign jurisdictions.

On the other hand, companies seeking to protect their marquee brands and house marks may elect to continue to file local applications under the laws of each foreign country in order to obtain the maximum protection afforded to trademarks under local laws. Moreover, it is possible to follow a hybrid approach and utilize the Madrid Protocol system to efficiently obtain protection in a number of countries, while also pursuing local trademark applications under the laws of the jurisdictions that are most important to the trademark owner.

Appendix Table 1. Jurisdictions Party to the Madrid Protocol, Status as of August 15, 2024

Country	**Jurisdiction Fee (CHF)***
Afghanistan	100 + 100/class over 3
African Intellectual Property Org.**	572 + 119/additional class
Albania	100 + 100/class over 3
Algeria	100 + 100/class over 3
Antigua and Barbuda	220/flat fee
Armenia	187 + 19/additional class
Australia	232/class
Austria	100 + 100/class over 3
Azerbaijan	100 + 100/class over 3
Bahrain	1517/class
Belarus	600 + 50/class over 3
Belize	226 + 48/additional class
Benelux***	224 + 75/additional class
Bhutan	100 + 100/class over 3
Bonaire, Saint Eustatius, and Saba	195 + 20/class over 3
Bosnia and Herzegovina	100 + 100/class over 3
Botswana	100 + 100/class over 3
Brazil	210/class
Brunei	196 + 107/additional class
Bulgaria	327 + 21/class over 3
Cabo Verde	169 + 62/additional class

Country	Jurisdiction Fee (CHF)*
Cambodia	139/class
Canada	299 + 91/additional class
Chile	251/class
China	249 + 125/additional class
Colombia	288 + 144/additional class
Croatia	100 + 100/class over 3
Cuba	356 + 91/additional class
Curaçao	294 + 35/class over 3
Cyprus	100 + 100/class over 3
Czech Republic	100 + 100/class over 3
Denmark	257 + 77/additional class
Egypt	100 + 100/class over 3
Estonia	151 + 47/additional class
European Union	798 + 144/class
Finland	222 + 93/additional class
France	100 + 100/class over 3
Gambia	97/class
Georgia	314 + 115/additional class
Germany	100 + 100/class over 3
Ghana	379/class
Greece	127 + 21/additional class
Guernsey	226 + 23/additional class
Hungary	100 + 100/class over 3
Iceland	247 + 53/additional class
India	110/class
Indonesia	125/class
Iran (Islamic Republic of)	100 + 100/class over 3
Ireland	257 + 73/additional class
Israel	413 + 310/additional class
Italy	95 + 32/additional class
Jamaica	188 + 25/additional class
Japan	266 + 250/additional class
Kazakhstan	100 + 100/class over 3
Kenya	312 + 223/additional class
Korea (DPR)	100 + 100/class over 3

Country	**Jurisdiction Fee (CHF)***
Korea (Republic of)	191/class
Kyrgyzstan	340 + 160/additional class
Laos	51 + 36/additional class
Latvia	100 + 100/class over 3
Lesotho	100 + 100/class over 3
Liberia	100 + 100/class over 3
Liechtenstein	100 + 100/class over 3
Lithuania	100 + 100/class over 3
Macedonia (Republic of)	100 + 100/class over 3
Madagascar	100 + 100/class over 4
Malawi	100 + 100/class over 3
Malaysia	221/class
Mauritius	124 + 41/additional class
Mexico	132/class
Moldova	252 + 52/additional class
Monaco	100 + 100/class over 3
Mongolia	100 + 100/class over 3
Montenegro	100 + 100/class over 3
Morocco	219 + 44/additional class
Mozambique	100 + 100/class over 3
Namibia	100 + 100/class over 3
New Zealand	55/class
Norway	309 + 81 /additional class
Oman	484/class
Pakistan	54/class
Philippines	89/class
Poland	100 + 100/class over 3
Portugal	100 + 100/class over 3
Qatar	1127/class
Romania	100 + 100/class over 3
Russian Federation	100 + 100/class over 3
Rwanda	100 + 100/class over 3
Saint Martin	298 + 31/class over 3
Samoa	173/class
San Marino	206 + 51/class over 3

Country	**Jurisdiction Fee (CHF)***
Sao Tome and Principe	100 + 100/class over 3
Serbia	100 + 100/class over 3
Sierra Leone	100 + 100/class over 3
Singapore	261/class
Slovakia	100 + 100/class over 3
Slovenia	100 + 100/class over 3
Spain	100 + 100/class over 3
Sudan	100 + 100/class over 3
Swaziland	100 + 100/class over 3
Sweden	194 + 76/additional class
Switzerland	400 + 50/additional class
Syrian Arab Republic	134/class
Tajikistan	274 + 21/additional class
Thailand	360/class
Trinidad and Tobago	191 + 20/additional class
Tunisia	180 + 36/additional class
Turkey	160 + 51/additional class
Turkmenistan	228 + 91/additional class
Ukraine	429 + 86/class over 3
United Arab Emirates	1630/class
United Kingdom	202 + 56/additional class
Uzbekistan	1028 + 103/additional class
Vietnam	142/class
Zambia	57 + 45/additional class
Zimbabwe	97 + 58/additional class

* Fee (in Swiss francs) charged by designated jurisdiction, which is based on number of international classes covered by registration. In most jurisdictions, the base fee covers the first three classes, with an additional fee for the fourth and each additional class. In other jurisdictions, the base fee covers the first class, with an additional fee for the second and each additional class. Additional fees may be due where the mark is a collective mark rather than a trademark.

** The African Intellectual Property Organization (OAPI) covers Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoros, Congo, Ivory Coast, Equatorial Guinea, Gbon Guinea, Ginea-Bissau, Mali, Mauritania, Niger, Senegal, and Togo. However, local legislation has not been implemented, so registration in OAPI through the Madrid Protocol will not be effective until such legislation is adopted.

*** The Benelux Customs Union, consisting of Belgium, Luxembourg, and Netherlands, is considered a single jurisdiction for trademark purposes.

Note

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