

Pros and Cons of a Madrid Protocol IR

Under the Madrid Protocol, US trademark owners may now file a single online application for an International Registration (IR) with the United States Patent and Trademark Office (USPTO) and obtain protection in all the member countries. However, there are both pros and cons to an IR.

Filing Benefits

Significant Cost savings. An IR filing can save the cost of filing in multiple countries and streamline administration of a global trademark portfolio

Single Application. For countries that are parties to the Madrid Protocol, an IR may be obtained by filing an international application with the International Trademark Office at the WIPO on the basis of a national application or registration in the applicant's home country.

Ease of Renewal. An IR will be valid for a period of 10 years and can be renewed for successive periods of 10 years.

Priority date. The priority claim is based on the underlying filing date in the trademarks home country.

Filing Risks

Danger of Central Attack. If an application is rejected or successfully challenged within five years from the date of application, the IR will be invalid for all covered countries.

Potential Added Time and Costs. Defending a central attack can be very, very costly and may ultimately require separate registrations.

No Transfers to Non-Member Entities. IR's cannot be transferred to a business of a non-contracting state.

No Variants Allowed. An IR does not allow for variants in the mark or its specification of goods and services.

Single Owner Required. There can be only one owner for the IR.

Careful Consideration Necessary. US businesses should be careful in deciding to file for an IR registration.

KEY CONCEPTS

- 1 Understand the risks and benefits before deciding on a global filing strategy
- 2 Know the member countries of the Madrid Protocol
- 3 Weigh the costs of an IR against community filings and individual filings
- 4 Do not underestimate the consequences of a "central attack" and the resulting domino effect

"IR filings under the Madrid Protocol can be a powerful means of protecting a trademark, but registrants must be aware of the potential pitfalls."



Partner David Baker

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