

## How to file a Madrid Protocol trademark application on paper with the USPTO

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The Final Rules promulgated by the USPTO on September 26, 2003 provide that Madrid Protocol applications filed with the USPTO as Office of Origin must be filed electronically. The envisioned e-filing system offers numerous benefits to filers, including:

- same-day filing 24x7 with immediate acknowledgment by the Trademark Office
- automated and immediate certification to WIPO of many filings
- automated and convenient online calculation of international fees
- convenient payment of all fees, including international fees, in US currency
- USPTO serving to forward international fees to WIPO and to attend to currency conversion

On October 24, however, the USPTO announced a temporary suspension of these rules (from November 2, 2003 to January 2, 2004) so that filers may file on paper. To this date the e-filing system has been unavailable. Thus the only permitted means of filing for some time will be paper filing.

**What you need to know.** This means that each would-be filer of a Madrid Protocol trademark application needs to know some important things, including:

- how do I do a paper filing of an MP application?
- what needs to be in the envelope on filing day to get a filing date?
- how may I get the best possible filing date?
- what may I omit from the envelope on filing day without jeopardizing my filing date?
- as for items which I omitted from the envelope on filing day, how and when must I remedy the omission so as to avoid abandonment?
- how may I maximize my chances of smooth processing and certification by the USPTO?
- how may I minimize delays in processing after certification and transmittal to WIPO?

This article answers these questions.

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**Getting a same-day filing date.** Any discussion of paper filing of MP applications necessarily begins with the October 24, 2003 Federal Register notice “Temporary Postponement of Electronic Filing and Payment Rules for Certain Madrid Protocol-related Rules.” Most importantly the Notice states that Express Mail, which for some months now has not been available to US trademark filers as a way of obtaining a same-day filing date, will temporarily again be available to filers of MP applications as a way of obtaining a same-day filing date.

Those who wish to file on November 2, 2003 (a Sunday) may not be able to find a post office that is open on Sunday. I have been told by a Trademark Office person that for this reason, filers who file by Express Mail on Saturday, November 1, will be given a November 2 filing date.

Filers should carefully follow the requirements of 37 CFR section §2.198 (the present-day successor to 37 CFR section 1.10). In particular, the Express Mail tracking number should appear on the topmost sheet in the filing package. When you take the package to the Post Office, make sure the “date in” completed by the Post Office employee is today’s date, and put the receipt in a safe place. We suggest using the free Raptor software ( <http://www.patents.com/raptor> ) to track the Express Mail package on its way to the Trademark Office.

Under MP rules, the Office of Origin (here, the USPTO) is required to transmit the MP application to WIPO within two months of filing, a task that it can perform only after it has done the work to determine whether or not it can “certify” the application to WIPO. The USPTO has set up a “Madrid Processing Unit” (MPU) which will undertake these activities. The MPU has a dedicated post office box. Thus, importantly, address the package not to any of the usual Trademark Office mailing addresses, but instead to the address set forth in the “Temporary Postponement” notice, namely:

Attn: MPU  
Commissioner for Trademarks  
PO Box 16471  
Arlington, VA 22215-1471

If you send your MP application to any other Trademark Office address, you risk delays and perhaps even loss of substantive rights if the two-month period passes without transmission to WIPO.

**Physical requirements.** WIPO requires that all submissions be on A4 paper. This requirement is an important one as the application may be forwarded in print form to trademark offices in designated countries, most of which use A4 paper and do not use 8½ by 11 inch paper. If you submit your MP application on 8½ by 11 inch paper you risk (at a minimum) being told by USPTO, or by WIPO, that your application is irregular.

WIPO also requires that you use its official form. MP applications may be filed in French or English,

and most US filers will prefer to file in English. The correct form for this purpose is WIPO Form MM2. This form is available on the WIPO web site at <http://www.wipo.int/madrid/en/forms/index.htm> in three formats: Microsoft Word 97, Adobe PDF and editable PDF. The best choice is the editable PDF form. Again, be sure to print the form (after completing it by means of on-screen editing) on A4 paper. (A copy of the form is attached.)

**Consider screening the proposed mark.** WIPO provides a Madrid Express database which permits searching, free of charge, all Madrid registrations and pending applications. You might consider using this database to see if there are previous filings that would affect the decision to proceed with an MP filing.

**Figure out if MP is for you.** Many factors influence whether you should file via MP or in some other way. These include US identification practice, central attack, inability to assign to an owner in a non-MP country, and the fact that some important countries do not belong to MP.

**Figure out when to file the MP application.** By waiting a while, you may be able to cover more countries in a single filing. Example: US filers will be able to file as early as November 2, 2003. Cyprus, however, only belongs effective two days later, November 4, 2003. Thus, by waiting until November 4, 2003 to file, you could add Cyprus to your list.

#### **Avoiding mistakes that will lead to a bounced application.**

Mistake: in the international application, ask for more goods or services than are listed in the basic application or registration. To avoid this mistake, as described below, copy and paste from the TARR record for the basic application or registration, into the international application. If you are narrowing the goods/services, then structure the wording to make crystal clear that there is a narrowing.

Mistake: in the international application, apply for a mark that is not identical to the mark in the basic application or registration. To avoid this mistake, copy the mark exactly from the TARR record into the international application.

Mistake: in the international application, applying with a name that differs from the name in the basic application or registration. To avoid this mistake, as described below, copy the name exactly from the TARR record into the international application.

Mistake: filing an international application in the US if the applicant fails to have a real and effective industrial or commercial establishment in the US.

**Avoid other mistakes.** For example, designating an ITU country if the applicant lacks an intention to use the mark in that country. See Ireland, Singapore, and United Kingdom. As another example, designating the US in an MP application filed in the US. The rules do not permit such a designation. Form MM2 will list the US as an option beginning November 2, 2003, yet it cannot be designated if the

US is the OOO.

**Minimal substantive requirements to obtain a filing date.** Form MM2, when properly completed, permits you to ensure that you have satisfied the minimal substantive requirements for obtaining a filing date. Consider each field carefully and do not leave a field blank if it needs to be completed.

**Payment of fees.** Under USPTO rules for ordinary national trademark applications a filing date will be lost if the filer fails to pay at least a minimum fee for a single trademark class. This prompts US practitioners to pay close attention to the circumstances under which an MP filing date might be lost for reasons relating to filing fees.

Anyone filing an MP application must pay a certification fee to the Office of Origin and must also pay a “base fee” to WIPO as well as individual fees relating to the states designated in the MP application. The USPTO e-filing system contemplates a very convenient single means of payment of all of these fees directly to the USPTO. The USPTO would then forward the base fee and individual fees to WIPO after performing the needed currency conversion. Such payment to USPTO could be made by any of the familiar means, including credit card (form PTO-2038), USPTO deposit account, and bank check. Importantly, an applicant would be able to authorize that any deficiency be charged to the USPTO deposit account, thereby saving the filer from having to worry about receiving some sort of deficiency notice regarding the exact amount of a credit card or check payment.

The “Temporary Postponement” notice, however, states that for paper filings the USPTO will not collect the international fees or perform currency conversion relating to those fees. The notice states instead that:

if there is an international fee associated with that submission, the applicant may not pay that fee through the USPTO. Instead, the applicant should send that fee directly to the IB.

The notice does not say *when* the fee should be sent to WIPO nor how to send the fee to WIPO.

Careful study of the WIPO web site for Madrid Protocol makes one thing very clear — any payment to WIPO relating to the Madrid Protocol must be in Swiss Francs. No other currency will be accepted.

Acceptable means of payment to WIPO are detailed in Form MM2 and include:

- a. paying in advance in Swiss Francs in person at WIPO in Geneva
- b. paying by means of a Swiss-Francs check attached to the MP application

- c. paying by means of a Swiss-Francs check sent separately to WIPO in Geneva
- d. paying by means of a wire transfer in Swiss Francs to WIPO's bank account in Geneva
- e. paying by means of a wire transfer in Swiss Francs to WIPO's postal cheque account in Geneva
- f. paying by means of an authorization to charge a WIPO deposit account.

Choices (a) and (e) are likely to be awkward and difficult for US filers.

In the case of (d), I am advised by WIPO that a frequent problem is that the sending or receiving bank, or both, may deduct fees from the transfer. When this happens, there is thus a deficiency in the international fees and WIPO is forced to write to the applicant (and to the Office of Origin) to report this deficiency. To avoid this problem, it is suggested that the filer specify in the wire transfer payment order that "all bank charges are to be borne by the payer".

Payment by means of a WIPO deposit account is said to be among the easiest and most convenient ways to pay the international fees. A chief advantage is that there is no need, in the form MM2, to specify any particular amount of payment. Instead, WIPO is authorized to charge the correct fee (whatever its amount) from the deposit account and thus avoids having a fee deficiency.

Some US filers may already have a WIPO deposit account opened for use with PCT applications. That same deposit account may be used for MP filings.

Instructions for opening a deposit account at WIPO may be found at [http://www.wipo.int/madrid/en/guide/part\\_d/pdf/account.pdf](http://www.wipo.int/madrid/en/guide/part_d/pdf/account.pdf) . A copy is attached.

### **Figuring out how much money to pay to the USPTO.**

The most crucial fee calculation for the filer is the USPTO fee, for the simple reason that failure to pay the proper USPTO fee will result in a loss of the filing date. Fortunately the fee calculation is rather simple.

If the MP application relies on two or more basic filings, then the fee is \$150 per international class. If the MP application relies only upon one basic filing, then the fee is \$100 per international class.

Example: an MP application is based upon a first basic filing in classes 9 and 16, and upon a second basic filing in classes 10 and 16. Three classes are involved, hence the fee is \$450.

Payment may be made by check or Form PTO-2038 (credit card) or USPTO deposit account. Use of Form PTO-2038 permits earning frequent flyer miles. Replenishment of the USPTO deposit

account by means of a credit card likewise permits earning frequent flyer miles.

Most importantly, regardless of the method of payment selected, the filer should always authorize charging of any deficiency to the filer's USPTO deposit account. This saves the filing date in the event that a fixed-fee payment is later determined by the MPU to have been deficient in some way.

### **Figuring out how much money to pay to WIPO.**

The USPTO e-filing system is contemplated to provide an online calculation of WIPO fees due, as well as a real-time currency exchange rate calculation so that the filer can pay in US dollars directly to the USPTO for all fees including WIPO fees.

For paper filings, the applicant faces the task of working out the calculation. Fortunately WIPO provides an online fee calculator which takes all the guesswork out of the fee calculations.

The next page you will see provides check boxes for indicating the countries in which you wish to request extensions of protection. You can also indicate whether the mark is in color, or includes figurative elements, as well as the number of international trademark classes.

Some countries choose to be paid a so-called "complementary fee" while others choose to be paid an "individual fee". The fee calculator takes all of this into account as well as the number of classes involved.

**Timing of payment of fees to WIPO.** Is it necessary that the international fees to WIPO be delivered to WIPO on the filing date? Stated differently, may one pay the international fee "late" and still retain the filing date of the Express Mail shipment to the USPTO?

The answer turns out to be that if you fail to pay the international fees in the envelope on filing day, you will not lose your filing date. WIPO has a specific procedure to cover such situations in its Rule 11(3). When WIPO receives an MP application from an Office of Origin and finds that there is a deficiency in the international fees, it will mail an irregularity letter being sent to the applicant and to the Office of Origin. If the missing fees are not transmitted to WIPO within three months of the date of the notice the application will go abandoned.

In plain language this means that if you wish, you can ignore the international fees completely when preparing your submission via Express Mail to the USPTO. Then, if you wish, you can wait until the irregularity letter arrives from WIPO at which time you may take up to three months to obtain a Swiss-Francs check in the desired amount. And indeed this seems to be precisely what USPTO suggests you do, since the notice says the international fees should be paid to WIPO directly.

A drawback of the Notice-of-Deficiency approach is that it is likely to slow down the processing of the

MP application by WIPO. Up to three months could pass during which the application would not be moving forward in the system.

Thus it is desirable, and indeed recommended, that if you pay WIPO directly, you do it right away rather than waiting for the irregularity letter. With the help of the fee calculator you should be able to determine the correct number of Swiss Francs and thus should be able to send a check to WIPO that will be sufficient to avoid an Irregularity letter.

How will WIPO know which file your check relates to?

WIPO suggests that such a check be accompanied by:

- The Applicant reference (from page 1 of the application form)
- The basic application number (i.e the national (US) filing number ) on page 2 of the form
- The basic registration number (i.e the national (US) registration number ) on page 2 of the form
- The verbal elements of the mark (where the mark is a word mark)

Of course if you are sending a check in response to an irregularity letter, then the best way to let WIPO know the correct file is to refer to WIPO's reference from the irregularity letter.

Yet another option is to enclose the Swiss-Franc check with the MP filing at the USPTO. I am told the MPU will forward such checks to WIPO when the application is transmitted to WIPO.

**The Paris Convention.** The Madrid Protocol permits filing an MP application that claims priority under the Paris Convention. If, for example, you are within a couple of months of the filing date of the priority filing, then there is no particular rush or urgency in the exact date the MP application is filed. This will permit some time to obtain a Swiss-Franc check, and indeed might permit waiting to do the filing at such time as the e-filing system is available.

**Minimizing risk of a refusal to certify.** The e-filing system contemplates an automated and immediate certification to WIPO for many MP filing (see article “One-Click filing of Madrid Protocol Applications,” copy attached).

With a paper MP filing, however, the MPU, when reviewing an MP application to determine whether or not to certify the application to WIPO, must perform a side-by-side comparison of the TARR records of the basic filings with the MP filing.

To minimize the risk of a refusal to certify, the filer should take several precautions.

*Check the TARR record first.* The prudent filer will check the TARR record before embarking on an MP filing. The mark, for example, might be represented in TARR in some surprising way, such as an

illegible drawing due to gray-scale issues or a drawing that has been greatly reduced or enlarged on its way into the TARR system.

The goods and services might be mistyped relative to the paper filing that was used to file the basic filing.

Changes of ownership and mergers may not be reflected in an up-to-date way in the TARR record.

When completing the form MM2, the filer should *not* simply hand-type information into the form. Instead, every field that is going to be later compared with TARR data *should be carefully copied and pasted* from the TARR record directly into the MM2 form. In this way, the MPU study to see if the two documents have identical information will yield the desired result, namely a certification that the two documents are identical in relevant particulars.

In your review of the TARR records, you may find that the listed owner in TARR is out of date relative to the owner who is to be listed in the MP filing. Ideally you should next get to work trying to convince the Trademark Office to correct the TARR records, perhaps by citation to reel and frame numbers of recorded assignments and the like. This will, however, take time, and you may feel you do not have time. In such a case, you could consider including with the MP filing everything that is needed to explain the discrepancy between the TARR record and the MP filing. Certified copies of recorded assignments, citations to reel and frame numbers, all could be enclosed with the MP filing in the hope that the MPU would go to the trouble to see that any discrepancies are accounted for (especially if such discrepancies are due to past Trademark Office errors).

Likewise if the drawing as shown in TARR is in error you will need to get that straightened out before doing your MP filing.

**Post card.** You should include a return post card with your Express Mail filing. The MPU will indicate the MPU tracking number on the card and will mail it back to you. This tracking number can later be matched up with the WIPO IR registration number as well as the basic filing number or numbers.

**Docketing.** One prudent docketing step is to check the Madrid Express database ( <http://ipdl.wipo.int> ) about a month after your MP filing, to see if it is in the WIPO database. If it is not, then you have some time before the end of the two-month certification period to try to get things straightened out.

Likewise, when the MPU processes the MP application, a field will be added to the TARR record for the basic filing or filings, indicating that an MP filing has been made. Thus you should also check in TARR to see if this field has been added.