

“One-click” Filing of Madrid Protocol Trademark Applications in the USPTO

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November 2, 2003 will be an exciting day for US trademark practitioners — it will be the first day that US applicants will be able to file international trademark applications under the Madrid Protocol.¹ The USPTO has said that it will only receive Madrid Protocol (“MP”) applications electronically. The USPTO has designed several online filing paths, one of which provides nearly “one-click” filing capability. As will be described below, the “one-click” filing process saves tedious typing for the applicant, is handled quickly by the USPTO, and is automatically “certified” to the International Bureau of WIPO (the World Intellectual Property Organization) for publication and later international processing. USPTO should be commended for developing this “one-click” filing path which will save time for filers and will reduce errors and delays.

Other articles in *IP Today* have discussed the advantages of Madrid Protocol (“MP”) filings and the factors to consider when choosing whether to follow the MP route or to file ordinary national applications. This article will focus on a particular way to do the MP filings with a “single click” that will result in easier filings and faster processing of the filed applications.

To understand the “one-click” filing procedure, it is necessary to consider a bit of background. To file an MP international trademark application in the US, it is necessary that the would-be applicant have previously filed in the US a so-called “basic application” that is still pending or that has matured into a so-called “basic registration” in the US. The MP application is then said to be “based on” the basic application or registration.

After an MP application has been filed (in what is termed the “Office of Origin”), the Madrid Protocol requires the Office of Origin (here, the USPTO) to study each MP application filed therein to determine whether it can “certify” the application and pass it along to the International Bureau of

WIPO. This study includes checking to see whether:

- the applicant named in the MP application is the same as the applicant named in the basic application or registration;
- the mark in the MP application is the same as in the basic application or registration;
- any indications (e.g. color, sound) in the MP application are the same as in the basic application or registration; and
- the goods and services in the MP application are “covered by” the goods and services in the basic application or registration.

If the Office of Origin finds these conditions to be satisfied, it “certifies” the application and passes it along to the International Bureau. If, however, the Office of Origin finds the MP application to be defective in any of these respects, it cannot “certify” the application and cannot pass it along to WIPO. The applicant, who will have paid \$100 or \$150 per class for this certification study, will lose those fees as the USPTO deems them non-refundable. The bad news of the refusal to certify might come days or even weeks after filing, at which time the applicant would face the prospect of having to refile the application, which then will have a less favorable filing date.

For some types of MP applications, the certification process is necessarily complicated and requires manual processing. For example, under the Protocol, a filer of an international application is permitted to base the application upon more than one “basic” application/registration. The Protocol also permits a filer to *narrow* the goods and services as compared with the goods and services in the basic application(s)/registration(s). Finally, the Protocol permits a filer to narrow the goods/services on a country-by-country basis for the various countries designated in the international application. The USPTO has online application forms to handle each of these cases.

In any of these cases, the certification study to be performed by the Office of Origin must necessarily be done manually, by a human being. Depending on the backlog, this could take days or weeks. What’s more, even a very careful filer might make a mistake (e.g. omitting a limiting word) so that the goods/services in the basic application(s)/registration(s) might fail to “cover” what is in the international application.

But it seems likely that a large fraction of MP applications (perhaps a majority of them) will be very simple — relying upon a single basic application/registration, and using the exact same goods/services as in the basic application/registration. A filer who intends to file such an international application, who wishes to minimize the risk of flunking the “certification” study, would want to make absolutely sure that the text that is entered into the international application is identical to the text that is already in the records of the Trademark Office (the TARR server²). What comes to mind is the idea of painstakingly copying and pasting each field from the TARR record of the basic application/registration into the corresponding fields in the international application. In that way the applicant would be able to reduce to a minimum the risk of flunking the “certification” study.

Importantly, the USPTO has developed a “one-click” filing path for this type of simple international application. The user launches a “Madrid Protocol Wizard” which asks some preliminary questions and then opens an application form. A first choice offered to the user is whether or not to use a “pre-populated” form. The user can say “yes” at which time the USPTO server asks for the application number of the basic application, or the registration number of the basic registration. The USPTO server then copies information from the TARR server into the international application, resulting in fields that have been “pre-populated”. In this way the applicant is saved the work of having to hand-copy the information into the fields of the international application.

The user is then asked whether the user wishes to modify the pre-populated goods and services in the international application. If the user says “yes”, then the user is permitted to modify the goods/services. Of course this means the application will have to be manually reviewed for certification, but at least it may save the applicant from lots of typing because much of the pre-

populated information will be usable without the need for changes.

The other filing path open to the applicant is to say “no,” that the applicant does not desire to modify the pre-populated fields of the international application. The point of this article is to describe this filing and its consequences. Consider what this choice is like from the point of view of the USPTO. The international application is received by the USPTO. The USPTO must, as with any international application, decide whether or not to “certify” it to the International Bureau. But in the particular case where the user has chosen “pre-populated” fields and where the user has chosen *not to modify* any of the pre-populated fields, the certification is easy and does not require any human review. Because of technical capabilities, the USPTO currently plans to certify the international application automatically, for immediate transmission to the International Bureau.

From the applicant’s point of view this filing path offers the benefit that there is no delay between the filing of the MP application with the PTO and the receipt of the certified application by the International Bureau. It offers a further benefit that there is no risk of the PTO refusing to certify the application.

Why wouldn’t all MP filers choose this filing path? First, if you wish to rely upon two or more “basic” filings, you can’t use this “automatic certification” filing path because the situation is too complicated for purely automated processing. Second, if you wish to *narrow* the goods/services for some or all of the designated countries, this again requires manual (human) review since a computer can’t know whether a particular change broadens or narrows the goods/services. (Some countries require an MP filer to have an “intention to use” which might prompt narrowing the goods/services in those countries.) Third, it might happen that the information in TARR is not up to date. (For example a recently recorded assignment might not be reflected in TARR.)

But for the majority of MP filers, the “one-click” filing path will save time for the applicant, will reduce greatly the risk of a refusal to certify, and will result in faster processing of the application in the USPTO and at the International Bureau. **IP**

ENDNOTES

1. An email discussion group has been set up for US filers of Madrid Protocol trademark applications. Signup instructions may be found at <http://www.patents.com/madrid>.
2. [Http://tarr.uspto.gov](http://tarr.uspto.gov).

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