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Increased Interest in the International Protection of Trademarks through the Madrid System

Key Dates

- January 2000: The Madrid System includes 62 countries.
- November 2003: US joins the Madrid System, which then includes 75 countries.
- April 2004: Spanish becomes the 3rd working language (after French and English) within the Madrid System which is now more accessible to Latin American countries.
- End of 2004: EU will join the Madrid System.

Main Features of the International Trademark

The Madrid System is a highly valuable tool that centralizes all the administrative procedures for filing and managing trademarks with WIPO (World Intellectual Property Organisation). Based on a first filing or a first registration in his country of origin, (Benelux, for example) the applicant may designate countries among the members of the Madrid Arrangement or of the Madrid Protocol (see list overleaf), by filing a single international application with WIPO. The national trademark offices will be advised by WIPO of the international registration extending to their respective country and they will have to notify WIPO of any possible refusal or opposition raised in their country at the latest 12 to 18 months after the filing. In the absence of such a notification, the trademark is deemed registered in all designated countries as from the date of the international registration. The international registration is valid for successive periods of 10 years and enjoys a protection identical to national registrations. Moreover, the subsequent management of the

trademark (assignment, license, renewal, etc.) requires a single procedure before WIPO. Finally, official fees to be paid are much lower than in case of separate national filings in the designated countries.

Advantages and Weaknesses of the System

Simplicity, flexibility and low costs are the key advantages of the system. Its main weakness is that it is closely linked to the national filing in the country of origin. For example, the applicant will not be able to broaden the scope of protection of the original list of goods and services in the international registration. Afterwards, the validity of the international registration will be linked to the validity of the original national filing for a period of 5 years. This implies that the invalidation of the basic filing will automatically lead to the invalidation of the international registration. In this case, the owner will have to file new applications in the designated countries even if priority can be maintained in certain countries, such as in the USA, provided additional administrative formalities be complied with (notification and additional taxes within a 3 month term).

Entry in Force of the System in the USA

Based on their national filings, individuals and companies located in the Benelux (or in any other member state of the Madrid System) or having a serious and effective business address in the Benelux, will be able to protect their trademark in the USA through the filing of a single application with WIPO, without appointing a US trademark attorney. Nevertheless, it will still remain compulsory to appoint a local representative in case of refusal or opposition.

Contact

Antonietta Arcuri
manager of trademark dept.
a.arcuri@office-kirkpatrick.com

Dominique Kaesmacher
chief IP counsel
d.kaesmacher@office-
kirkpatrick.com

Avenue Wolfers, 32
B 1310 La Hulpe (Brussels)
Belgium
Tel: +32 2 652 1600
Fax: +32 2 652 1900
www.office-kirkpatrick.com

Our recommendation :

In order to avoid or at least limit possible risks of refusal or opposition in the USA, it is highly recommended that Benelux trademark applications be carefully prepared; in particular, the list of goods and services will be carefully drafted and complete availability searches will be conducted prior to filing. As Benelux and European registered agents and considering our long-lasting practice of the Madrid System, we will assist you to draft the application, to conduct the search, to elaborate the best strategy of protection, as well as to reply to any refusal or opposition from the US Office, in coordination with our international network of trademark agents.

Should you wish to receive future issues by e-mail, please notify us at :
info@office-kirkpatrick.com



Madrid System Member Countries (February 2004)

AG	Antigua-and-Barbuda	KG	Kyrgyzstan
AL	Albania	KP	Democratic People's Rep. of Korea
AM	Armenia	KR	Republic of Korea
AN	Netherlands Antilles	KZ	Kazakhstan
AT	Austria	LI	Liechtenstein
AU	Australia	LR	Liberia
AZ	Azerbaijan	LS	Lesotho
BA	Bosnia and Herzegovina	LT	Lithuania
BG	Bulgaria	LV	Latvia
BT	Bhutan	MA	Morocco
BX	Benelux (Belgium, The Netherlands and Luxembourg)	MC	Monaco
BY	Belarus	MD	Republic of Moldova
CH	Switzerland	MK	The former Yugoslav Rep. of Macedonia
CN	China	MN	Mongolia
CU	Cuba	MZ	Mozambique
CY	Cyprus	NO	Norway
CZ	Czech Republic	PL	Poland
DE	Germany	PT	Portugal
DK	Denmark	RO	Romania
DZ	Algeria	RU	Russian Federation
EE	Estonia	SD	Sudan
EG	Egypt	SE	Sweden
ES	Spain	SG	Singapore
FI	Finland	SI	Slovenia
FR	France	SK	Slovakia
GB	United Kingdom	SL	Sierra Leone
GE	Georgia	SM	San Marino
GR	Greece	SZ	Swaziland
HR	Croatia	TJ	Tajikistan
HU	Hungary	TM	Turkmenistan
IE	Ireland	TR	Turkey
IR	Iran (Islamic Republic of)	UA	Ukraine
IS	Iceland	US	United States of America
IT	Italy	UZ	Uzbekistan
JP	Japan	VN	Viet Nam
KE	Kenya	YU	Serbia and Montenegro
		ZM	Zambia

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