

## International Trademark Searching and Filing Strategies

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PLI, New York, July 20, 2010

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### Introduction

- How do we create global brands?
- Three ways in which to create trademark rights: use, registration, and fame.
- Best practices dictate the “search and file” model.
- Where do we start to create a global trademark portfolio management system?

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### Working with Local Foreign Counsel

- Contrary to popular myth, there is no “World Trademark”. Trademark rights are territorial and need to be created in all trademark jurisdictions, which roughly correspond to countries.
- Local counsel come in many varieties, including, searching, filing, licensing, domain name, litigation, anti-counterfeiting, customs, etc. Meet them personally.
- Beware of local cultural differences and laws on attorney client and legal professional privilege with “agents” (who in many countries are called “attorneys”).
- Create a network a few deep in each jurisdiction for various trademark needs and in case of conflicts.

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### Which Trademarks and Where?

- Major trademarks in home country, and in major markets, future markets, and counterfeiting countries.
- Management driven focus on certain trademarks and areas (e.g., territory - all of Asia, trademarks - all cardiovascular trademarks).
- Collateral goods/services and classes.
- Design trademarks, translations, and transliterations.
- Consider related domain names in relevant ccTLD registries (xyz.de, xyz.ca, etc.).
- Beware of long time line in trademark registration, averaging around 3-5 years.

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### How do we “clear” a trademark?

- Online and “full” searches.
- Analysis by attorney or agent who renders an opinion.
- Factors include: goods/services, countries, classes, use, federal or local jurisdiction/multi-jurisdiction registered/unregistered trademarks, corporate names, domain names, state registrations, and slogans.
- Clear for both use and registration.

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### Trademark Clearance Steps

- Identify group of trademarks to be scanned/searched (preliminary elimination process).
- Scope of goods and services and relevant classes.
- Identify countries - key markets, commercial countries, counterfeiting areas.
- Online scans first to reduce costs.
- Full searches as needed.

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### Search Report Evaluation

- Key issues are likelihood of confusion and scope of protection for trademark/goods nexus.
- Likelihood of confusion factors include: strength of cited mark (including fame, common use/registration, distinctiveness spectrum: coined/arbitrary/suggestive/descriptive/generic), similarity between marks, competitive proximity of products, likelihood that cited mark will bridge the gap, quality of products, and sophistication of purchasers.
- Use and cited trademark owner investigations may assist.
- Relative (prior rights) v. Absolute (inherent distinctiveness) grounds issues.

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### Attorney-Client (Legal Professional) Privilege

- Ends of privilege spectrum: attorney opinion letter and search report itself.
- Foreign “agent” issue.
- Beware of *Akzo* case on LPP in ECJ on lack of in-house counsel privilege. “Write Right” method.
- Should the client waive the attorney-client privilege on opinion letters?

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### Summary

- Avoid difficulties in use (injunction) and registration (rejected application to register).
- Obtain attorney opinion letter on availability coupled with local counsel opinions as appropriate.
- If clear, proceed to register since in many countries trademark rights arise primarily out of registration, not use.

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## How To File A Trademark Program

- National Route
- Paris Convention Priority (6 months)
- Regional Trademarks (e.g., African Union OAPI and European Community Trademark CTM).
- Global Filing Treaty (Madrid System – Agreement and Protocol)

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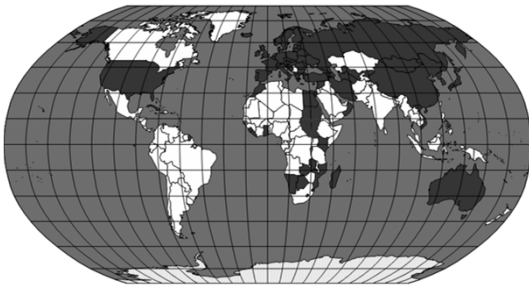
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## Current Madrid Protocol Countries



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## Madrid Protocol: 81 Countries

- Bosnia
- Egypt
- Ghana
- Liberia
- Sudan
- Israel (effective 9/1/10)

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## USPTO Filings: The Madrid Protocol in the U.S.

- November 2, 2002 - U.S. Madrid Protocol Implementation Act signed
- November 2, 2003 - Protocol became effective in U.S. under new Title VII (Sections 60-74) of the Lanham Act of 1946
- New TMEP Chapter 1900
- New Trademark Rules Part 7
- Currently, about 80,000 inbound and 20,000 outbound applications filed
- The US now accounts for about 10% of Madrid applications annually

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## U.S. Outbound and Inbound

Year	Outbound	Inbound
2003	139	238
2004	1737	7109
2005	2849	11863
2006	3148	13994
2007	3741	14618
2008	3684	15715
2009	3201	13406
2010 thus far	1559	3489
2010 (est. total)	3120	7000

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## High, Low or Just Right?

- Some commentators believe it is high compared to other countries, particularly in the inbound applications – were companies waiting to file in the U.S.?
- Some commentators believe it is low given the expectations and strong support for implementation – perhaps a skeptical view until there is more experience with the system?
- Recession dip in filings.

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## Costs

- <http://www.wipo.int/madrid/en/fees/calculator.jsp>  
WIPO Madrid Cost Calculator
- A US application extended to all Madrid countries will be CHF 17,569 (approx. USD 16,535)
- Much lower filing costs but still need to file applications nationally outside of the Madrid system and hire local counsel if an objection to an extension is raised by the local trademark office.

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## Madrid Protocol – U.S. Filing Factors

- USPTO practice – limited goods and services; oppositions
- Use needed before registration for basic U.S. application
- Mark must be identical in all countries
- Must have identical owner
- Still need local counsel to reply to official actions
- Dependency on basic application
- Assignment only to MP eligible entity/person
- New system for U.S. applicants
- Lower cost
- One language
- One set of documents
- Fast global priority date
- No legalization
- One registration date and number
- One renewal date
- Easier access to registration in difficult countries

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## National - U.S. Filing Factors

- More expensive
- Need local counsel first
- Multiple documents
- Multiple languages
- Legalization
- Different practices
- Multiple registration numbers and renewal dates
- Need a registration if basis of U.S. application is Section 44(e)
- Can have multiple owners
- More expansive goods and services available
- Assignable to any entity wherever located
- Different forms of the mark in each country
- Supplemental register
- No dependency for Section 44(e) basis

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## Common U.S. Problems

- Deadlines – Section 71 use affidavit is 6 years from U.S. EP (*de facto* U.S. registration) not filing or another date and every 10 years thereafter (renewal date is calculated from the IR).
- ITU Declaration (1b and/or 65a; confer 1a, 44d, and 44e)).
- Strict fraud rules (*Medinol* case) as moderated by the *Bose* case.
- No Supplemental Register for 65a but available for 66a (vide 68(4)).
- Cannot add ground or goods/services to Notice of Opposition for Madrid Protocol applications (Rule 2.107) due to IB notification deadlines.
- Still need to hire U.S. attorney for application prosecution and oppositions.

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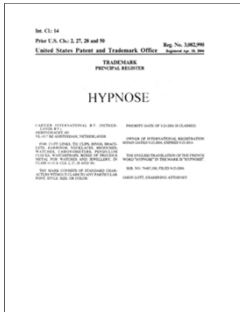
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## Deadline Example – U.S. Reg. No. 3082990 on HYPNOSE



- IR registered 25 September 2004
- REP registered in U.S. on 18 April 2006
- Renewal due 25 September 2014
- Section 71 use affidavits due by 18 April 2012 and 18 April 2016

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## Madrid Protocol U.S. Decisions



### *In re Borlind*

73 USPQ2d 2019 (TTAB, 13 January 2005)

If extension of time to oppose request for a Madrid application is not electronic using the ESTTA system, the request will be **dismissed** – Trademark Rule 2.102(a)(2).

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Madrid Protocol U.S. Decisions



**Kellogg North America v. Provea**

Opposition No. 91166663 (TTAB, 21 October 2005)

The USPTO did not notify the IB within 18 months of the date the REP transmitted to USPTO whether opposition was filed or whether opposition may be filed pursuant to Trademark Act Section 68(c)(1)(B) and 68(c)(1)(C). Opposition was dismissed.

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Madrid Protocol U.S. Decisions



**In re Healthier Choice Flooring, LLC**

Serial No. 78682683 for SOUND SOLUTION (TTAB, 12 February 2008)

The Examining Attorney cited a Madrid Protocol registration in support of her argument that other registrations supported the contention that certain goods were related concerning a 2(d) citation. The TTAB discounted this registration since there was no evidence of use in the file.

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**What does the future hold?**

- **Expect increased activity in the U.S.**
  - Wait and see approach for a “track record”
  - Electronic filing has increased filing
  - CTM link has increased filing
  - Increased REPs are raising comfort level for inbound applicants
  - More use of IRs and REPs in licensing and other transactions
  - Eventual absorption of Madrid Protocol as another form of trademark protection in the U.S.

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## Summary

- The pace of harmonization is accelerating.
- National laws are conforming to international standards through the TRIPS Agreement.
- Treaties such as the Madrid Protocol, TRIPS Agreement and the TLT are creating new, harmonized obligations.
- Trade and technology continue to move the law forward.
- The real challenge for the 21st Century will be harmonized enforcement not just harmonized legal texts.

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## The Community Trademark (CTM)

- Since 1996, the Community Trade Mark (CTM) system offers trademark owners a unified system of protection throughout the European Union (EU) with the filing of a single application in the Office of Harmonization for the Internal Market (OHIM) in Alicante, Spain.
- U.S. applicants account for about 57% of the CTM applications (compare to 10% of Madrid applications).

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## EU Member States

- **27 Member States:**  
Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, The Netherlands, Poland, Portugal, Romania, Slovak Republic, Slovenia, Spain, Sweden, and the United Kingdom

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## Centralized filing, registration and maintenance procedures

- One filing fee
- One application in one language
- One renewal fee
- One trademark office:
  - WIPO in Geneva
  - CTM Office (OHIM) in Alicante
- Centralized recordal for any corporate changes

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## Application process

### Madrid Protocol

- An applicant for an International Registration must be a national of, or domiciled in, one of the member countries of the Protocol or have an industrial or commercial establishment in one of the member countries.
- The Protocol System requires the existence of a "basic application", i.e., a previously filed application or a registration for the same mark in the applicant's home country.
- No seniority.

### CTM

- The CTM process is available to nationals of the EU countries, countries that are parties to the Paris Convention and other countries granting reciprocal rights. A CTM applicant is not required to have a commercial establishment in the EU.
- The CTM system does not require the existence of an application or registration in the applicant's home country.
- The owner of a CTM can claim the prior rights of his existing national registrations in the European Union if the national registrations are allowed to lapse.

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## Examination process

### Madrid Protocol

- National examination by each Trademark Office
- Rules of examination vary in each country
- Applications filed under the Madrid Protocol may mature to registration more quickly in many countries than if individual applications had been filed.
- The description of goods and services must be the same as those in the home application regardless of whether priority is claimed

### CTM

- One examination by OHIM
- No examination of prior trademark rights (only absolute grounds of refusal, i.e., is the term a trademark?)
- The CTM registration process can take longer than in some individual countries of the European Union.
- Freedom to file for any goods and services. Priority under the Paris Convention based on a previously filed application may be claimed, but additional goods and services may also be covered (without priority).

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## Opposition process

### Madrid Protocol

- Oppositions filed in each National TM Office
- Limits invalidity/opposition to a country per country basis
- Dependency of basic application for 5 years (Central Attack)

### CTM

- All oppositions before the OHIM
- Oppositions can be filed based on any CTM or national TM Regn.
- Independent of home registration

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## Duration of protection

### Madrid Protocol

- The initial international registration period is ten years from filing; however, it is dependent upon a valid home application or registration for the first five years. If the home application or registration fails for any reason during this period (e.g., is refused, withdrawn or cancelled), so is the international registration.
- After five years, the international registration becomes independent.

### CTM

- The initial CTM registration period is ten years from the date of filing the application.
- The application is immediately independent of any other application or registration.

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## Extension and assignment

### Madrid Protocol

- Needs to file a new extension and pay an extra fee
- Date of protection = Date of the extension
- Do not need to assign all countries together
- Cannot be assigned to non-Madrid members

### CTM

- Automatic extension to new Member States - No additional fees or procedure
- Date of protection = Date of filing of the CTM Application
- Trademark can only be assigned as a whole (not only for certain Member States)
- Can be assigned to any foreign entity.

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## Enforcement and use

### Madrid Protocol

- Separate infringement actions in each of the countries where infringing acts occurred
- National injunctive relief and damages
- Use must be shown by the trademark owner for each country claimed in order to maintain its rights

### CTM

- Only one infringement action for all EU infringing acts
- EU-wide injunction (Pan European injunctive relief and damages)
- Use in one Member State is sufficient to fulfill the use requirements for the CTM registration as a whole

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## Conclusion

- Meet your local foreign counsel at professional meetings and get to know them and their capabilities.
- Create your trademark protection strategy before you start searching and filing.
- Beware of local differences in law and culture.
- Always exercise independent judgment and do not act as a “mailbox” between local counsel and the client.
- Always keep a flexible approach to create the best search and file system for a particular company.

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