



Mesmer & Deleault, PLLC  
41 Brook Street, Manchester, NH 03104



Independence Day

## “Tip of the Month”

### International Trademark Application Now Possible!

**Why?** Since November 2, 2003, US trademark owners are now able to submit international trademark applications to the US Patent and Trademark Office (USPTO) for forwarding to the International Bureau in Geneva, Switzerland. This has been made possible because the US signed an international treaty known as the Madrid Protocol. The treaty allows a trademark owner to seek registration in any of the 61 countries (also known as Contracting Parties) that have joined the Madrid Protocol.

**Who?** Any trademark owner with an application filed in or a registration issued by the USPTO, and who is a national of, has a domicile in, or has a real and effective industrial or commercial establishment in the US can submit an international application through the USPTO.

**Requirements?** An applicant must have a US application or a US registration, must pay the US certification fee(s) at the time of submission and must identify at least one Contracting Party in which an extension of protection is sought. The mark and the owner of the international application must be the same as the mark and the owner of the US application or registration, and the international application must include a list of goods and services that is identical to or narrower than the list of goods or services included in the US application or registration.

**Cost?** An international applicant must pay fees to the USPTO and to the International Bureau. The USPTO charges a fee (a certification fee) for “certifying” the international application and transmitting the application to the International Bureau. The certification fee is \$100.00 per class, if the international application is based on a single US application or registration. The International Bureau charges fees based on whether the reproduction of the mark is in black and white and/or in color, the particular Contracting Parties designated in the international application and the number of classes of goods and services indicated in the international application.

**Registration?** If the Madrid Protocol filing requirements are met, then the International Bureau will register the mark. Once registered with the International Bureau, the International Bureau will notify each of the Contracting Parties designated in the international registration of the request for an extension of protection to that country. Each designated Contracting Party will then examine the request for an extension of protection the same as it would a national application under its laws. If the application meets the requirements for registration in that country, then the Contracting Party will grant protection of the mark in its country.

**Duration of international registration?** The initial 10-year term may be renewed for additional 10-year periods by paying a renewal fee to the International Bureau.

**Can the international registration be automatically canceled?** Possibly yes, during the first 5 years because it is completely dependent on the US application or registration.

If you have questions about the Madrid Protocol International Trademark application process, please call us at 668-1971 or contact us through the Internet at *Meslaw @ aol.com*.

Frank B. Mesmer, Jr., Esq.  
Robert R. Deleault, Esq.

(603) 668-1971

Fax (603) 622-1445

E-mail: *Meslaw @ aol.com*

Visit our web site at: *www.biz-patlaw.com*