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MADRID PROTOCOL CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Tips for Holders of International Registrations Seeking Extension of Protection to the United States of America: Avoiding Provisional Refusals

1. The International Bureau has received, on November 27, 2008, a communication from the United States Patent and Trademark Office (USPTO), which contains useful information for applicants for, or holders of, international registrations designating the United States of America.

2. The said communication reads as follows:

“Requests for extension of protection (REP) to the United States submitted under the Madrid Protocol are examined by the USPTO in the same manner as a national application under domestic laws and regulations. Therefore, if the data provided to the USPTO from the International Bureau (IB) in a REP does not include all of the information required under U.S. law for a “complete application”, the USPTO will issue a provisional total refusal.

“In order to expedite the examination of REPs, the USPTO provides the following suggestions and explanations based upon the most commonly issued refusals and informal requirements under U.S. law, namely:

- entity and citizenship of the holder/applicant;
- translation of word or words in mark;
- color statement and color description;
- consent to register name or likeness of a living individual;

- overly broad language used to identify the goods or services* ;
- subsequent incorrect classification due to modification of identification of goods or services.

U.S. Requirement	Explanation	Suggestion
Entity and citizenship of the holder/applicant	Section 2.32 of Title 37 of the code of Federal Regulations (C.F.R.) requires applications to include the citizenship of the applicant(s); or, if the applicant is a corporation, association, partnership or other juristic person, the jurisdiction (usually State or Nation) under the laws of which the applicant is organized; and, if the applicant is a partnership, the names and citizenship of the general partners. 37 C.F.R. §2.32(a)(3)(i)-(iii). See also Section 803.03(i), “Common Terms Designating Entity of Foreign Applicants”, of the Trademark Manual of Examining Procedure of the USPTO http://tess2.uspto.gov/tmdb/tmep/appendix_d.htm , which contains a list of known terms used by several countries other than United States to identify commercial entities that would be accepted by the USPTO without an indication of their equivalent, if any, within the United States.	Rule 9(4)(b)(i) and (ii) of the Common Regulations under the Madrid Agreement and Protocol permits the inclusion of an indication of the State of which an applicant is a national or, where the applicant is a legal entity, indications concerning the legal nature of that legal entity, the State and, where applicable, the territorial unit within that State, under the law of which the said legal entity has been organized. The USPTO encourages the inclusion of this information to avoid a total provisional refusal.

* With respect to the identification (or “indication” in the Madrid forms) of goods and services, Section 2.32(a)(6) of Title 37 of the Code of Federal Regulations (C.F.R.) requires a list of the particular goods and services on, or in connection with which, the applicant uses or intends to use the mark. The identification of goods and services should set forth common names, using terminology that is generally understood. The identification must be specific, definite, clear, accurate and concise. The accuracy of the identification language in the original REP is important because the identification cannot later be expanded. The USPTO provides free access on the USPTO website to the Acceptable Identification of Goods and Services Manual (ID Manual), available at <http://tess2.uspto.gov/netathtml/tidm.html>. The ID Manual is a listing of phraseology that can be accepted in an application without further question. It is not an exhaustive list of acceptable wording, so entries can often be adapted and reworked according to the needs of an applicant.

U.S. Requirement	Explanation	Suggestion
Translation of word or words in mark	For marks that are depicted in non-Latin characters, the USPTO requires both a translation of the English meaning of the mark AND a transliteration, or phonetic equivalent in Latin characters of the mark. See 37 C.F.R. §2.61(b) (In order to permit proper examination of the application, the USPTO can require the applicant to furnish such information that is reasonably necessary to accomplish this goal.)	Rule 9(4)(xii) of the Common Regulations requires the inclusion of a transliteration expressed in Latin characters and Arabic numerals of matter in characters other than Latin characters or numbers expressed in numerals other than Arabic or Roman numerals. Rule 9(4)(b)(iii) permits the inclusion of a translation of a word or words that can be translated into English. The inclusion of such information provides notice to third parties as to the significance of the mark and the possibility of similarities to marks that are foreign equivalents. The USPTO encourages the submission of the English translation as well as the transliteration to facilitate examination and avoid the issuance of a total provisional refusal. This suggestion also applies when the extension of protection to the United States is made in a subsequent designation (see Rule 24(3)(c)(i) of the Common Regulations).
Color statement and color description	37 C.F.R. §2.52(b)(1) requires applicants who seek registration of a mark that includes color to submit a drawing of the mark in color, the name of the color(s), and a description of where the color(s) appear in the mark. The applicant must also claim that the color(s) are a feature of the mark. All colors shown in the mark must be described and claimed or their appearance explained if they are not claimed as features of the mark.	Where color is claimed as a distinctive feature of the mark in an international application, Rule 9(4)(a)(vii) of the Common Regulations requires an indication by words of the color(s) claimed and one reproduction of the mark in color. That Rule permits the inclusion of a color claim in the international application

U.S. Requirement	Explanation	Suggestion
		<p>where the mark in the basic application/registration is in color, even if the said basic application/registration does not contain a color claim. The USPTO encourages the inclusion of a color claim whenever the mark is in color, along with an indication by words of the color(s) claimed and a description of where the color(s) appear in the mark.</p>
<p>Consent to register name or likeness of a living individual</p>	<p>Section 1052(c) of Title 15 of the United States Code (U.S.C.) prohibits registration on the principal register of a mark that consists of, or comprises a name, portrait or signature identifying a particular living individual without the written consent of such individual.</p>	<p>While the Common Regulations do not specifically provide for the optional provision of information of this type with the international application, the applicant may submit written consent directly to the USPTO at any time after notification of the REP is made by the International Bureau to the USPTO's Trademark Electronic Application System (TEAS) available online at http://www.uspto.gov/teas/index.html to submit a preliminary amendment to supplement the contents of the REP.</p>
<p>Overly broad language used to identify the goods or services*</p>	<p>The US is a member of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Agreement). However, the US considers the Nice Agreement to be a determination of classification only and does not accept the wording as set forth in the Nice Agreement in many instances, as it does not meet the domestic law requirement for particularity.</p>	<p>To the extent a holder does not wish to narrow the scope of the goods/services in the international registration as a whole, a holder may wish to have a limitation of goods/services with respect to the United States recorded with the International Bureau pursuant to Rule 9(4)(a)(xiii) of the Common Regulations. See the USPTO ID Manual at http://tess2.uspto.gov/netah</p>

U.S. Requirement	Explanation	Suggestion
		ml/tidm.html for an extensive list of acceptable wording for goods/services.
Subsequent incorrect classification due to modification of identification of goods or services	The USPTO does not assume the scope of goods/services are restricted by the classifications to which they are assigned. For example, the International Bureau may accept the goods “ladders” in an application in Class 6 (metal goods) with the assumption that the ladders are made primarily of metal. However, upon examination in the USPTO, the applicant will be required to specify the material composition of the ladders in order to ascertain the accuracy of the class claimed by the holder of the international registration. If the applicant responds by limiting such goods to those not included in Class 6, e.g. “wooden ladders,” the USPTO will not permit reclassification into Class 20. The International Bureau presumes the goods in the international registration are metal ladders as they were classified in Class 6.	Amendments made in response to a requirement by the USPTO for further specificity of goods and services must comply with 37 C.F.R §2.71(a). The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods/services. Amending the goods/services to include items not within the scope of the classification claimed by the holder of the international registration would be held an impermissible broadening. See the USPTO ID Manual at http://tess2.uspto.gov/netah/ml/tidm.html . Recording a limitation under Rule 25 of the Common Regulations with respect to the United States in response to a requirement by the USPTO does not relieve the applicant from responding directly to the USPTO. A timely response still must be received by the USPTO to avoid abandonment.”

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