



MEUNIER CARLIN & CURFMAN LLC

INTELLECTUAL PROPERTY LAW



THE INTERNATIONAL REGISTRATION OF TRADEMARKS USING THE MADRID SYSTEM: SOME STRATEGY CONSIDERATIONS

P R E S E N T E D T O :

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“Value Without Compromise”



OVERALL ADVANTAGES FOR US TRADEMARK OWNERS

- ONE FILING – IN ENGLISH – AND ITS EASY
 - PRIORITY IN LARGE NUMBER OF COUNTRIES
- COST SAVINGS (e.g., NO LOCAL ASSOCIATE FEES, AT LEAST INITIALLY)
- ONE INTERNATIONAL REGISTRATION WITH ONE RENEWAL
- FLEXIBILITY TO ADD ADDITIONAL COUNTRIES
- CENTRALIZED MAINTENANCE BY EXPERT ORGANIZATION
 - RENEWALS, RECORDING TRANSFERS



OVERALL DISADVANTAGES

- ❖ DEPENDENT ON BASIC APPLICATION/ REGISTRATION
- ❖ NARROW (POSSIBLY) IDENTIFICATION OF GOODS AND SERVICES- INTERNATIONAL REGISTRATION RIGHTS ARE ONLY AS BROAD AS BASIC APPLICATION/ REGISTRATION
- ❖ NO AMENDMENTS TO MARK
- ❖ CAN USE U.S. SUPPLEMENTAL REGISTRATION AS BASIS, BUT WHY?
- ❖ “CENTRAL ATTACK”- DOMINOES!





SELECTING COUNTRIES- 97 TO CHOOSE FROM

❖ http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf

❖ KEY NON-SIGNATORIES

- ARGENTINA
- BRAZIL
- CANADA
- INDONESIA
- MALAYSIA
- SOUTH AFRICA

❖ THERE ARE OTHERS!!





BASICS, BUT ITS AN OVER SIMPLIFICATION!!

- ❖ U.S. TM OWNER SHOULD STRONGLY CONSIDER MADRID WHERE:
 - INCONTRESTABLE REGISTRATION
 - BROAD DESCRIPTION OF GOODS
 - AVOID RENEWING OLD NATIONAL REGISTRATIONS

- ❖ U.S. TM OWNER SHOULD STRONGLY CONSIDER OTHER FILING STRATEGIES WHERE:
 - ❖ CLIENT/COMPANY HAS SIGNIFICANT COMMERCIAL INTEREST IN RELATIVELY FEW COUNTRIES
 - ❖ MARK IS RELATIVE WEAK
 - ❖ DESCRIPTION OF GOODS/SERVICES IN NARROW

- ❖ EXAMPLES