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Intellectual Property Law Update

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SIMPLIFICATION OF FOREIGN TRADEMARK FILINGS: UNITED STATES IMPLEMENTS THE MADRID PROTOCOL

Following more than a decade of legal and political wrangling, the *Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks* becomes effective in the United States in November of 2003, one year after President Bush signed the implementing bill. The *Madrid Protocol* will afford United States citizens a procedure to register their trademarks—both in the United States and in foreign countries—using a single trademark application.

Under the *Madrid Protocol*, an applicant for registration of a United States trademark may file an “international application,” designating each foreign country in which protection is desired for the same trademark simultaneously with the filing of a United States application. This international application process provides a means for substantial reduction in paperwork and savings in costs by allowing the trademark applicant to file only one application, in one place and with one fee. In other words, no longer will a United States applicant for trademark be required to file a separate application, and incur separate filing, processing and attorney fees, in each foreign country in which a registration is desired.

The *Madrid Protocol* also addresses a major concern that arises under the terms of the predecessor “Madrid Agreement.” Under the Madrid Agreement, a “central attack” provision permits an international application for registration to be cancelled, within five years of filing, if the national registration upon which it is based was cancelled. Under the *Madrid Protocol*, however, a modified central attack provision now permits the trademark applicant to reapply in each designated foreign country while retaining the priority date of the original international application. This modification to the central attack provision was paramount in convincing the United States to finally become a signatory to the *Madrid Protocol*.

The simplified procedure described above is expected to become effective in November of 2003, once the regulations implementing the *Madrid Protocol* become final. HRO will continue to monitor the implementation of this treaty and will be in a position to assist clients by filing applications under the new *Madrid Protocol* as soon as the system is put into full operation. In the interim, please contact any member of the HRO Intellectual Property Group for assistance with your United States or foreign trademark related matters and for assistance with your trade secret, copyright or patent related matters.

At present HRO assists its clients by filing and advancing applications for trademark registrations not only in the United States but in other countries through out the world. In addition, HRO assists its clients by attending to their other intellectual property needs including trade secret and copyright matters and the preparation and advancement of applications for patents and related litigation and transactional concerns.

This Update is a publication of Holme Roberts & Owen LLP and should not be construed as legal advice or a legal opinion on any specific facts or circumstances. Nor is it intended to address specific issues that may arise in particular circumstances or all of the provisions relating to the subject matter addressed. This Update is published for general informational purposes only, and you are urged to consult legal counsel concerning your own situation and any specific legal questions you may have. For further information regarding the subject matter addressed by this Update, please contact any of the persons listed.

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