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# Demystifying the Madrid Protocol

John M. Murphy\*

## I. INTRODUCTION

¶1 While the Madrid Protocol (“the Protocol”) is not the sequel to *The Da Vinci Code*,<sup>1</sup> it has created a similar aura of suspense and mystery among trademark lawyers in the United States. Metaphorically, it has been something of a Holy Grail for trademark practitioners; the International Trademark Association has been urging the United States to join the Madrid Union for over a century.<sup>2</sup>

¶2 In fact, the Protocol is neither the Holy Grail nor humbug. Rather, it is one of several means for obtaining international trademark protection. This paper summarizes the major provisions of the Protocol, and explains how it works both from the standpoint of a U.S. applicant seeking protection abroad, and a foreign applicant seeking protection in the United States. In addition, this paper examines the pros and cons of the Madrid filing system. While the Madrid Protocol creates significant opportunities for U.S. trademark owners, it is not the best alternative in every case. Trademark owners are advised to discuss with counsel all possible alternatives before investing resources in a large-scale trademark filing program.

## II. WHAT IS THE MADRID PROTOCOL?

¶3 The Madrid Protocol is a treaty administered by the World Intellectual Property Organization (“WIPO”). The United States joined the Madrid Protocol in 2002, and the Madrid Protocol Implementation Act (“MPIA”) took effect on November 2, 2003.

¶4 The Madrid Protocol and its companion treaty, the Madrid Agreement of 1891, are the governing instruments of the Madrid System for the International Registration of Marks. The United States has adopted the Madrid Protocol but not the Madrid Agreement. As of this writing, fifty-four states, or “Contracting Parties,” have adopted the Madrid Agreement, and a total of sixty-two states have adopted the Madrid Protocol. The members of the Agreement and the Protocol are referred to collectively as the Madrid Union.<sup>3</sup>

¶5 Under the Agreement and the Protocol, an “International Application” is filed with the International Bureau of WIPO in Geneva, Switzerland, and the Bureau then issues what is termed an “International Registration.” This Madrid-speak leads to a great deal of unnecessary confusion. The Bureau does not, in fact, issue a single trademark

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<sup>1</sup> DAN BROWN, *THE DA VINCI CODE* (Doubleday 2003).

<sup>2</sup> See *Value of Trade Marks*, *NEW YORK TIMES*, Oct. 15, 1897, at 16.

<sup>3</sup> See *infra* Appendix A. .

registration enforceable in multiple jurisdictions (like a Community Trade Mark registration, for example). Rather, the Madrid Agreement and the Madrid Protocol create a centralized filing system which simplifies the process of obtaining and maintaining national trademark registrations in the member countries of the Madrid Union.

### III. HOW DOES THE MADRID PROTOCOL FILING SYSTEM WORK?<sup>4</sup>

#### A. Procedure From the Perspective of a U.S. Applicant

¶6 This perspective focuses on practice under the Madrid Protocol from the standpoint of an applicant in the United States seeking protection abroad. Much of the perspective applies to a foreign applicant seeking an extension of protection in the United States. Some unique features of U.S. practice under the Madrid Protocol will be discussed in the next section.

#### 1. Who May Apply for an International Registration?

¶7 To apply for an International Registration under the Madrid Protocol as a U.S. applicant, the applicant must: (1) be a national of the United States; (2) be domiciled in the United States; or (3) have a real and effective industrial or commercial establishment in the United States.<sup>5</sup> The application must include certification to this effect.<sup>6</sup>

¶8 The phrase “real and effective industrial or commercial establishment” was borrowed by the drafters of the Madrid Protocol from Article 3 of the Paris Convention<sup>7</sup>.

The expression “real and effective industrial or commercial establishment” . . . was added [to Article 3] at the first conference for the revision of the [Paris] Convention which took place in 1897-1900. It was felt that the original provision, which simply referred to “an establishment,” was too broad and should be restricted. The intention was that, by using the French term “*sérieux*” (“real” in English), fraudulent or fictitious establishments would be excluded. The term “effective” makes it clear that, while the establishment must be one at which some industrial

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<sup>4</sup> See United States Patent and Trademark Office (USPTO) Exam Guide No. 2-03 (Effective Oct. 28, 2003) available at <http://www.uspto.gov/web/trademarks/madrid/madridguide.htm> (last visited April 15, 2004). See generally The Madrid Protocol Implementation Act, 15 U.S.C. §1141 available at [http://www.uspto.gov/web/trademarks/PL107\\_273.pdf](http://www.uspto.gov/web/trademarks/PL107_273.pdf) and implementing rules 37 CFR §7.1- §7.41 available at [www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf](http://www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf) (last visited Apr. 15, 2004). See generally World Intellectual Property Organization (WIPO), Guide to the International Registration of Marks under the Madrid Agreement and the Madrid Protocol available at <http://www.wipo.int/madrid/en/guide/index.htm> (last visited Apr. 15, 2004) [hereinafter *WIPO Guide*].

<sup>5</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 15 U.S.C. § 1141a(b) (2004) [hereinafter Madrid Protocol].

<sup>6</sup> Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 37 C.F.R. § 7.11(a)(10) (2004). [hereinafter Rules of Practice].

<sup>7</sup> The full name of the Paris Convention, September 28, 1979, 21 USR 1583 is the "Paris Convention for the Protection of Industrial Property" [hereinafter Paris Convention].

or commercial activity takes place (as distinct from a mere warehouse) it need not be the principal place of business.<sup>8</sup>

¶9 Although there is no case law in the United States interpreting either the Madrid Protocol or the MPIA, there are a few cases interpreting 15 U.S.C. § 1126(c), which incorporates Article 3 of the Paris Convention. In *Ex parte Blum*,<sup>9</sup> the applicant, a resident and national of Germany, sought to register the mark PRESSEX under Section 44(e) of the Lanham Act based on a prior registration in the United Kingdom. The applicant alleged that in the U.K. he carried on the business of licensing inventions and patents relating to “non-electric domestic cleaning instruments,” and derived a royalty income through this activity. He did not, however, engage in the manufacture or sale of goods or maintain a place of business in the U.K. The Commissioner held that mere licensing of the mark in Great Britain did not qualify as a “bona fide and effective industrial or commercial establishment” and upheld the Trademark Office’s refusal to register. Also worth noting is *In re Aktiebolaget Electrolux*,<sup>10</sup> in which the applicant, a Swedish corporation, sought registration in the United States pursuant to Section 44(e) based on prior registrations in Austria and Denmark. The applicant had wholly owned subsidiaries in Denmark and Austria but did not, as far as the record indicated, do business in either country. The Board held that the “existence of a wholly-owned subsidiary in a foreign forum does not mean that the non-resident parent company has a ‘bona fide and effective [industrial] or commercial establishment’ in that foreign forum.”<sup>11</sup>

## 2. The Basic Application or Registration

¶10 An International Application must be based on a pending application or registration for the same mark in the applicant’s country of origin (as defined above).<sup>12</sup> The country of origin application and registration are referred to in the Madrid Protocol and in the Lanham Act as the “basic application” and the “basic registration,” respectively.<sup>13</sup>

## 3. Filing the International Application

¶11 The regulations recently adopted by the USPTO state that all applications for International Registration must be filed through the Trademark Electronic Application System (“TEAS”).<sup>14</sup> In light of technical difficulties, however, the USPTO has delayed the posting of electronic forms relating to the Madrid Protocol. For the time being, International Applications may be submitted to the USPTO in paper form.<sup>15</sup>

<sup>8</sup> See *WIPO Guide*, *supra* note 4, pt B, ch. II, § 02.06 available at [www.wipo.int/madrid/en/guide/index.htm](http://www.wipo.int/madrid/en/guide/index.htm). See *infra* Part II (C), *infra*.

<sup>9</sup> 138 U.S.P.Q. (BNA) 316 (Ct., CI 1963).

<sup>10</sup> 182 U.S.P.Q. (BNA) 255 (E.D.W.I. 1974).

<sup>11</sup> *Id.* at 256. See also TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1002.04 (3rd ed., Jan. 2002).

<sup>12</sup> Madrid Protocol, *supra* note 5, § 1141a(a).

<sup>13</sup> Madrid Protocol, *supra* note 5, § 1141(1) and (2)).

<sup>14</sup> 37 C.F.R. § 7.11(a) (2004).

<sup>15</sup> See United States Patent and Trademark Office, *USPTO Tips for Filing on Paper*, available at [http://www.uspto.gov/web/trademarks/madrid/madrid\\_tipspaperfilers.htm](http://www.uspto.gov/web/trademarks/madrid/madrid_tipspaperfilers.htm) (last visited Apr. 15, 2004).

¶12 The minimum requirements for completion of an International Application originating from the United States are: (1) the filing date and serial number of the basic application, or the registration date and registration number of the basic registration;<sup>16</sup> (2) the name of the applicant, which must be identical to the name of the applicant or registrant in the basic application or registration;<sup>17</sup> (3) a reproduction of the mark; (4) a color claim, if appropriate; (5) a description of the mark that is the same as the description appearing in the basic application or registration; (6) an indication of the type of mark, if the mark is a three-dimensional mark, a sound mark, a collective mark or a certification mark; (7) a list of goods or services, which must be identical to or narrower than the goods or services listed in the basic application or registration; (8) a list of the designated Contracting Parties; (9) the certification fee; (10) a statement to certify that the applicant is a national of the United States, is domiciled in the United States, or has a real and effective industrial or commercial establishment in the United States; and (11) an e-mail address.<sup>18</sup> The USPTO (referred to in Madrid parlance as the “Office of Origin”) reviews each application to determine whether it meets these requirements.<sup>19</sup> If all is in order, the Office will certify the application and forward it to the Bureau.

¶13 If the International Application is not in order, the USPTO will refuse to certify it and refund any international fees to the applicant. The USPTO certification fee will not be refunded. The applicant will not be allowed to correct deficiencies in the application; the only remedy is to file a new International Application.

#### 4. Fee Structure

¶14 A trademark owner seeking International Registration must pay fees to: (1) the USPTO; (2) the Bureau; and (3) the national trademark office of each Contracting Party designated in the application. Only Contracting Parties that have signed the Madrid Protocol may be designated; members of the Union that have signed only the Madrid Agreement may not.<sup>20</sup> USPTO fees must be paid directly to the USPTO, in U.S. dollars.<sup>21</sup> Bureau fees may be paid either through the USPTO or directly to the Bureau.<sup>22</sup> Direct payments to the Bureau must be in Swiss francs.<sup>23</sup> Payments of Bureau fees through the USPTO must be made in U.S. dollars.<sup>24</sup>

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<sup>16</sup> *Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement*, Apr. 1, 2002, Rule 9(5)(e) available at [www.wipo.int/madrid/en/legal\\_texts/common\\_regulations.htm](http://www.wipo.int/madrid/en/legal_texts/common_regulations.htm) [hereinafter *Common Regulations*].

<sup>17</sup> The application may be filed in the name of joint applicants. *Id.* at Rule 8(2). A paralegal at the USPTO's Madrid Processing Unit (MPU) will check the name of the applicant on the International Application against the name of the applicant appearing on the TRAM (Trademark Reporting and Monitoring) system. If the names are not identical, the paralegal will check the Assignment Database to determine whether there is a clear chain of title to the International Applicant. If there is not a clear chain of title, the application will not be certified.

<sup>18</sup> Rules of Practice, *supra* note 6, § 7.11(a).

<sup>19</sup> *Id.* at § 7.13 (2004).

<sup>20</sup> See *infra* Appendix B for a list of fees.

<sup>21</sup> Rules of Practice, *supra* note 6, § 7.6(b).

<sup>22</sup> *Id.* at § 7.7 (2004).

<sup>23</sup> *Common Regulations*, *supra* note 16, rule 35(1).

<sup>24</sup> Rules of Practice, *supra* note 6, § 7.7(b)(2). See WIPO for a calculator which converts Swiss Francs into U.S. dollars, available at [www.wipo.it](http://www.wipo.it)

## 5. Examination by the Bureau

¶15 After certification, the USPTO transmits the International Application to the Bureau. The Bureau examines the application to determine whether it meets the minimum requirements of Rule 9 of the Common Regulations. In addition to minimum requirements of the USPTO,<sup>25</sup> the Bureau requires (1) the name and address of the applicant; (2) the name and address of the applicant’s representative; (3) an indication, if appropriate, that the applicant wishes to claim priority under the Paris Convention; (4) a declaration, if appropriate, that the applicant wishes the mark to be considered as a mark in standard characters; (5) an indication, if appropriate, that the mark consists of a color or combination of colors; (6) a transliteration of the mark into Roman characters or Arabic numerals, if appropriate; (7) the applicant’s nationality, if he or she is a natural person; (8) the applicant’s state or country of incorporation, if it is a legal entity; (9) a translation of the mark into English or French, if the mark consists of a word or words in another language; and (10) any appropriate disclaimers.

¶16 If the requirements of Rule 9 are not met, the Bureau will send a “Notice of Irregularity” to both the Office of Origin and the applicant’s representative.<sup>26</sup> The applicant will be given three months in which to respond.<sup>27</sup> If the irregularity relates to the payment of fees, the required fees must be paid directly to the Bureau.<sup>28</sup> In the case of an irregularity relating to the specification of goods or services, the applicant must respond to the Bureau.<sup>29</sup>

¶17 If there is an issue regarding classification, the applicant may respond through the Office of Origin.<sup>30</sup> If the applicant does not respond, the Bureau will reclassify the goods or services as deemed appropriate and require the applicant to pay any resulting additional fees within four months of the Notice of Irregularity. If the applicant responds, it must pay any additional fees within three months of the date when the Bureau either accepts or rejects the response.<sup>31</sup> If payment is not received, the application is deemed abandoned.

¶18 When the Bureau concludes that the goods or services listed in the International Application are vague, incomprehensible or linguistically incorrect, it will look to the Office of Origin for a response within three months and may, in some instances, propose a revised specification.<sup>32</sup> The USPTO, in turn, will look to the applicant for suggestions.<sup>33</sup> The examiner will transmit the applicant’s proposed specification to the Bureau if it does not identify goods or services broader than those specified in the basic application or registration.<sup>34</sup> If the Bureau does not receive an acceptable proposal within

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<sup>25</sup> *Id.* at § 7.11.

<sup>26</sup> *Common Regulations*, *supra* note 16, rules 11-13.

<sup>27</sup> *Id.* In certain instances, the deficiency must be remedied by the Office of Origin rather than the applicant—if for example Office of Origin fails to sign the International Application. *Id.* at Rule 11(4).

<sup>28</sup> 37 C.F.R. § 7.14(c) (2004).

<sup>29</sup> *Common Regulations*, *supra* note 16, rules 12 and 13; *Rules of Practice*, *supra* note 6, § 7.14(b).

<sup>30</sup> *Common Regulations*, *supra* note 16, rule 12(2); *Rules of Practice*, *supra* note 6, § 7.14(b).

<sup>31</sup> *Common Regulations*, *supra* note 16, rule 12(7).

<sup>32</sup> *Id.*, rule 13(1).

<sup>33</sup> *Rules of Practice*, *supra* note 6, § 7.14(b).

<sup>34</sup> *Id.*

three months, it may delete the term in question or retain it, with a notation that the Bureau deems it to be unacceptable.<sup>35</sup>

¶19 Several of the requirements may present difficulties for some applicants. First, the classification of goods or services may be a headache for some applicants. The Protocol requires that goods and services be classified according to the Nice Agreement. In general, U.S. practice follows the Nice Agreement, but there are exceptions. For example, International Applications based on U.S. Classes A, B, or 200 (used for collective and certification marks) must be reclassified. Similarly, the USPTO allows registration of kits and gift baskets in a single class, contrary to the practice of the Bureau and most foreign countries. The specification of goods and service services may also be a problem, particularly if the International Application is based on a pending U.S. application, since the applicant may receive contradictory instructions from the U.S. examiner and the Bureau.

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#### 6. Publication by the Bureau

¶21 If the Bureau finds the application to be in order, it issues an “International Registration” for the mark.<sup>36</sup> The registration is published in the *WIPO Gazette of International Marks*, which issues every two weeks.<sup>37</sup> The Bureau notifies each Contracting Party designated by the applicant that the International Registration has issued.<sup>38</sup>

#### 7. Date Appearing on the Certificate of Registration

¶22 The certificate of registration bears either (1) the filing date of the International Application, if the International Application is received by the Bureau within two months of the filing date, or (2) the date when the application was received by the Bureau, if the application was received by the Bureau more than two months after the filing date.<sup>39</sup> If the Bureau receives an incomplete application, the constructive date of receipt by the Bureau is the date on which all deficiencies have been remedied.<sup>40</sup> An application is incomplete if it does not identify the applicant, its representative or the Contracting Parties designated by the applicant, or lacks a reproduction of the mark or a specification of goods and services.

#### 8. Review of the International Registration by Designated Contracting Parties

¶23 Ordinarily, the date appearing on the certificate of International Registration determines trademark priority. That is to say, the trademark office (“Office”) of each designated Contracting Party must treat the International Registration as it would a national application filed on that date.<sup>41</sup> In addition, the owner of the International

<sup>35</sup> *Common Regulations*, *supra* note 16, rule 13(2)(b).

<sup>36</sup> Madrid Protocol, *supra* note 5, art. 3; *Common Regulations*, *supra* note 16, rule 14(1).

<sup>37</sup> Madrid Protocol, *supra* note 5, art. 3(4); *Common Regulations*, *supra* note 16, rule 32.

<sup>38</sup> Madrid Protocol, *supra* note 5, art. 3(4); *Common Regulations*, *supra* note 16, rule 14(1).

<sup>39</sup> Madrid Protocol, *supra* note 5, art. 3(4).

<sup>40</sup> *Common Regulations*, *supra* note 16, rule 15(1).

<sup>41</sup> Madrid Protocol, *supra* note 5, art. 3(4) and 4(1)(a).

Registration may claim priority under Article 4 of the Paris Convention.<sup>42</sup> This convention priority claim will usually be based on the basic national application, but it may also be another application made in a country party to the Paris Convention or the World Trade Organization (even if the latter is not a party to the Paris Convention), or an application which, by treaty, is equivalent to a regular national filing (e.g., a CTM application).<sup>43</sup>

¶24 Each Office reviews the International Registration according to its domestic trademark laws and may provisionally refuse protection of the mark in whole or in part.<sup>44</sup> The refusal may only be based on one of the grounds specified in Article 6 *quinquies* (B) of the Paris Convention.<sup>45</sup> A Contracting Party may not refuse protection on the ground that local law permits registration only in a limited number of classes or for a limited number of goods.<sup>46</sup>

¶25 If the mark is refused, a Notification of Provisional Refusal must be forwarded to the Bureau.<sup>47</sup> The Bureau then forwards a copy of the notification to the registrant.<sup>48</sup> The notice must indicate a reasonable time limit for responding to the refusal, identify the authority to whom the response should be directed, and state whether the response must be filed through local counsel.<sup>49</sup> The notice may be in either English or French, at the option of the Contracting Party.<sup>50</sup>

#### 9. Time Limit for Refusal

¶26 The Office of each Contracting Party has a time limit of either twelve or eighteen months in which to issue a provisional refusal of protection.<sup>51</sup> If the Office does not issue a provisional refusal, and no oppositions are filed, the International Registration receives the same protection in that Contracting Party as a national registration, subject to the possibility of central attack as described below.<sup>52</sup>

<sup>42</sup> Madrid Protocol, *supra* note 5, art. 4(2).

<sup>43</sup> *WIPO Guide*, *supra* note 4, pt. B, ch. II, §13.01 (2002).

<sup>44</sup> Madrid Protocol, *supra* note 5, art. 5(1).

<sup>45</sup> See Paris Convention, *supra* note 7, Art. 6 *quinquies*(B). Under this article, a national Office may only refuse registration of a mark that is: (1) of such a nature as to infringe rights acquired by third parties in the country where protection is claimed; (2) devoid of any distinctive character, or consisting exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods, or the time of production, or have become customary in the current language or in the bona fide and established practices of the trade of the country where protection is claimed; or (3) contrary to morality or public order and, in particular, of such a nature as to deceive the public.

<sup>46</sup> Madrid Protocol, *supra* note 5, art. 5(1).

<sup>47</sup> Madrid Protocol, *supra* note 5, art. 5(2)(a).

<sup>48</sup> Madrid Protocol, *supra* note 5, art. 5(3); *Common Regulations*, *supra* note 16, rule 17(5)(c).

<sup>49</sup> *Common Regulations*, *supra* note 16, rule 17(2)(vii).

<sup>50</sup> *Common Regulations*, *supra* note 16, rule 6(2).

<sup>51</sup> Madrid Protocol, *supra* note 5, article 5(2)(a). Article 5(2)(a) of the Madrid Protocol specifies a twelve-month time limit. However, Article 5(2)(b) states that any Contracting Party may opt for an eighteen month limit instead. The United States has opted for an eighteen month time limit. 15 U.S.C. 1141h(c).

<sup>52</sup> *WIPO Guide*, *supra* note 38, pt. B, ch. II, § 27.02.

## 10. Local Oppositions

¶27 A Contracting Party may declare that International Registrations are subject to opposition after the eighteen month deadline set forth in Article 5(b) of the Protocol.<sup>53</sup> In such a case, the Office of the Contracting Party must notify the Bureau of the possibility that the mark may be opposed after close of the eighteen month period.<sup>54</sup> As in the case of an ex parte refusal, the holder of the International Registration must be allowed a time period, “reasonable under the circumstances,” to respond to the opposition.<sup>55</sup>

## 11. Central Attack, Independence and Transformation

¶28 As noted above, the Madrid Protocol does not provide for an “international” trademark registration as such. Rather, it is a system for obtaining trademark registrations (or “extensions of protection”) among Contracting Parties designated by the applicant. These extensions of protection are enforceable to the same extent as a national registration issued by a Contracting Party.

¶29 For the first five years following the date of the International Registration, its validity depends on the continued validity of the basic application or registration.<sup>56</sup> That is to say, the International Registration and all of its territorial extensions will be cancelled if the basic application or registration is refused or cancelled. If the basic application or registration is partially refused or cancelled, the International Registration and all territorial extensions will be limited to the same extent.

¶30 In some cases an International Registration may continue to be vulnerable after the fifth anniversary of the date of registration. For example, an International Registration based on a U.S. intent-to-use application will be invalidated if the applicant fails to file a Statement of Use in the U.S. application, even if the U.S. application was still pending on the fifth anniversary of the International Registration. If the owner of a basic application appeals a refusal of registration before the fifth anniversary, and an adverse decision issues, the International Registration will be cancelled. Similarly, if an opposition or cancellation proceeding is filed before the fifth anniversary, and the basic application or registration is refused or cancelled after the fifth anniversary, the International Registration will be cancelled. On the other hand, if there are no pending appeals, opposition or cancellation proceedings at the end of five years, the International Registration and its territorial extensions will become independent of the basic application or registration.<sup>57</sup>

¶31 If the International Registration is cancelled as described above, the holder may request that its former International Registration be “transformed” into national applications bearing the same priority date as the international registration.<sup>58</sup> To effect this transformation, within three months of the cancellation date the registrant must file a national application in each Contracting Party where protection is desired.<sup>59</sup> The

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<sup>53</sup> Madrid Protocol, *supra* note 5, art. 5(2)(c).

<sup>54</sup> Madrid Protocol, *supra* note 5, art. 5(2)(c)(i).

<sup>55</sup> *Common Regulations*, *supra* note 16, rule 17(2)(vii).

<sup>56</sup> Madrid Protocol, *supra* note 5, art. 6(3).

<sup>57</sup> Madrid Protocol, *supra* note 5, art. 6(2).

<sup>58</sup> Madrid Protocol, *supra* note 5, art. 9quinquies.

<sup>59</sup> Madrid Protocol, *supra* note 5, art. 9quinquies (i).

application may only specify goods or services listed in the former territorial extension to that Contracting Party, and must otherwise comply with local law.<sup>60</sup>

## 12. Subsequent Designations of Contracting Parties

¶32 A trademark owner may request an extension of protection to additional Contracting Parties even after the International Registration issues.<sup>61</sup> Generally speaking, the procedure is the same as in the case of filing any other International Application.<sup>62</sup> However, the holder of the International Registration may file the request for subsequent designation directly with the Bureau rather than proceeding through the USPTO.<sup>63</sup> A subsequent designation is effective from the date on which it is recorded in the International Register.<sup>64</sup>

## 13. Renewal

¶33 An International Registration must be renewed every ten years.<sup>65</sup> The renewal application must be filed directly with the Bureau. The registrant need not file renewal applications with each designated Contracting Party.

## 14. Assignment, Licensing and Other Matters

¶34 If the owner of an International Registration assigns its rights to another party, the assignment may be recorded with the Bureau.<sup>66</sup> Partial assignments also may be recorded. For example, the owner may assign the mark in connection with certain goods listed in the registration, or in connection with only some of the Contracting Parties to which the International Registration is extended. The validity of an assignment is determined by local law, however. For example, U.S. law requires that an extension of protection to the United States be assigned in connection with the goodwill associated with the mark.<sup>67</sup>

¶35 In addition to assignments, the Bureau will record license agreements,<sup>68</sup> changes of name, changes of the registrant's designated representative, or any renunciation of rights with respect to goods, services or Contracting Parties.<sup>69</sup>

## 15. Replacement of National Registrations

¶36 If the owner of an International Registration obtains a territorial extension to a Contracting Party where it already owns a national registration for the same mark, the International Registration will replace the national registration, provided that: (a) the

<sup>60</sup> Madrid Protocol, *supra* note 5, art. 9quinquies (ii)-(iii). In the United States, transformation of International Registrations is governed by 15 U.S.C. § 1141j(c).

<sup>61</sup> Madrid Protocol, *supra* note 5, art. 3ter (2).

<sup>62</sup> *Common Regulations*, *supra* note 16, rule 24.

<sup>63</sup> Rules of Practice, *supra* note 6, § 7.21(a).

<sup>64</sup> Madrid Protocol, *supra* note 5, art. 3ter (2).

<sup>65</sup> Madrid Protocol, *supra* note 5, art. 7.

<sup>66</sup> Madrid Protocol, *supra* note 5, art. 9.

<sup>67</sup> 15 U.S.C. § 1141i.

<sup>68</sup> *Common Regulations*, *supra* note 16, rule 20bis.

<sup>69</sup> Madrid Protocol, *supra* note 5, art. 9bis.

goods and services listed in the national registration also are listed in the International Registration; and (b) the extension takes place after the date of the national registration.<sup>70</sup> The replacement is without prejudice to any rights (e.g. priority) flowing from the national registration.

¶37 After replacement, the national registration will remain on the national register of the Contracting Party for as long as the owner maintains it. Given the possibility of “central attack” (see below), a trademark owner may choose to maintain the national registration at least until the fifth anniversary of the International Registration.<sup>71</sup>

### B. Foreign Applicants Seeking U.S. Registrations

¶38 This section will focus on features of the MPIA and its implementing registrations, which foreign applicants seeking protection in the United States under the Madrid Protocol may find unfamiliar.

#### 1. Nomenclature and Filing Basis

¶39 Before the enactment of the MPIA, the Lanham Act allowed trademark applications based on use in commerce (Section 1(a)), bona fide intent to use in commerce (Section 1(b)), and ownership of a foreign registration (Section 44(e)). In some instances, an applicant was permitted to add, substitute or delete a filing basis.<sup>72</sup>

¶40 Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), creates an entirely new filing basis, namely, “[a] request for extension of protection of an international registration to the United States. . .” The U.S. Patent and Trademark Office refers to a request for extension as a “Section 66(a) application.”<sup>73</sup> In an application under Section 66(a), the applicant may not add, substitute or delete a basis, unless the application is “transformed” pursuant to Article 9 *quinquies* of the Madrid Protocol and Section 70(c) of the Lanham Act. The subject of “transformation” will be discussed below.

#### 2. Declaration of Intent to Use

¶41 A Section 66(a) application must include a declaration that the applicant has a bona fide intent to use the mark in U.S. commerce.<sup>74</sup> The United States is perhaps the only Contracting Party to the Madrid Protocol which requires such a declaration. As in the case of applications under Section 44(e), however, the applicant need not demonstrate use in commerce in order to receive a certificate of registration.<sup>75</sup>

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<sup>70</sup> *Id.* at art. 4bis.

<sup>71</sup> *WIPO Guide*, *supra* note 43, pt. B, ch. II, § 87.01-06.

<sup>72</sup> Rules of Practice, *supra* note 6, § 2.34.

<sup>73</sup> U.S. PATENT AND TRADEMARK OFFICE, EXAM GUIDE NO. 2.03, GUIDE TO IMPLEMENTATION OF MADRID PROTOCOL IN THE UNITED STATES (Oct. 28, 2003), available at <http://www.uspto.gov/web/trademarks/madrid/madridguide.htm> [hereinafter EXAM GUIDE].

<sup>74</sup> 15 U.S.C. § 1141f(a).

<sup>75</sup> 15 U.S.C. § 1141h(a)(3).

### 3. Prosecution of the Application

¶42 Generally speaking, a Section 66(a) application will be examined in the same manner as any other application. However, the Bureau's classification of goods and services is controlling on the USPTO. That is to say, the examiner must accept the Bureau's classification of the goods and services stated in the application, even if it conflicts with the *Manual of Acceptable Identification of Goods and Services*.<sup>76</sup> If a Section 66(a) application appears to be a collective or certification mark, the examiner may not reclassify the goods or services into U.S. Classes A, B, or 200.<sup>77</sup>

¶43 Although the USPTO may not reclassify the applicant's goods or services, it may require that the goods be described with greater particularity.

Foreign registrations will often include broad statements of the identification of goods and services. In many cases the identification is merely a repetition of the entire general class heading for a given class. These broad identifications are generally unacceptable in United States applications. The identification of goods and services in the United States application must be definite and specific even if the foreign registration includes an overly broad identification.<sup>78</sup>

### 4. Mark Must be Registrable on the Principal Register

¶44 A Section 66(a) application will be granted only if the mark is registrable on the Principal Register. That is to say, the mark must be one "by which the goods of the applicant may be distinguished from the goods of others."<sup>79</sup> Applications to register marks which would be registrable only on the Supplemental Register will be refused.

### 5. No Amendments Permitted

¶45 Ordinarily, a U.S. applicant may amend the mark shown in its application, as long as the amendment "does not materially alter the mark."<sup>80</sup> No such amendments are permitted in the case of a Section 66(a) application.<sup>81</sup>

### 6. Response to Notice of Refusal

¶46 Historically, failure to respond to an Office Action issued by the USPTO resulted in complete abandonment of the application.<sup>82</sup> This rule has been amended to conform to the Madrid Protocol, so that failure to respond to a partial refusal only results in abandonment of the part of the application that was refused. This change applies to all trademark applications, and not just applications under Section 66(a).

<sup>76</sup> Madrid Protocol, *supra* note 5, art. 3(2); Exam Guide, *supra* note 73, at § IV(B)(2).

<sup>77</sup> EXAM GUIDE, *supra* note 73, at § IV(B)(2).

<sup>78</sup> U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1402.01(b) (3d. ed., Jan. 2002), *available at* <http://www.uspto.gov/web/offices/tac/tmep/>.

<sup>79</sup> 15 U.S.C. §§ 1052, 1141h(a)(4).

<sup>80</sup> Rules of Practice, *supra* note 6, § 2.72(a)(2).

<sup>81</sup> EXAM GUIDE, *supra* note 73, § IV(B)(7).

<sup>82</sup> Rules of Practice, *supra* note 6, § 2.65.

### 7. Oppositions to Section 66(a) Applications

¶47 Section 66(a) applications are subject to opposition pursuant to Section 13 of the Lanham Act. If a Section 66(a) application is not refused by the USPTO within eighteen months, the USPTO will notify the Bureau that the application has not been refused, but is nonetheless possibly subject to future opposition.<sup>83</sup>

¶48 A notice of opposition regarding a Section 66(a) application, or a request for extension of time to oppose a Section 66(a) application, must be filed electronically through the Electronic System for Trademark Trials and Appeals (ESTTA).<sup>84</sup> Trademark owners seeking to oppose a Section 66(a) application must take particular care in drafting pleadings, since the opposition, once filed, may not be amended to add additional grounds for opposition.<sup>85</sup>

### 8. Issuance of Registration, Maintenance and Incontestibility

¶49 If a Section 66(a) application survives the examination and opposition process, a certificate of extension of protection will issue, and a notice will be published in the *Official Gazette*.<sup>86</sup> The certificate of extension shall have the same legal effect and validity as a registration on the Principal Register.<sup>87</sup> For this reason, the USPTO refers to extensions of protection as “registrations,” “registered extensions of protection” or “Section 66(a) registrations.”<sup>88</sup>

¶50 Most Contracting Parties require only that holders of International Registrations file periodic renewal applications through the Bureau. Under U.S. law, however, the registrant must file an affidavit of use or excusable nonuse with the USPTO: (a) between the fifth and sixth year anniversary of the issuance of the Section 66(a) registration, and (b) within the six month period preceding every tenth anniversary of the Section 66(a) registration.<sup>89</sup>

## IV. IMPLICATIONS OF THE MADRID PROTOCOL FOR TRADEMARK SEARCHING

¶51 Historically, a trademark owner seeking to clear a proposed trademark in the United States searched the records of the U.S. Patent and Trademark Office, state trademark records, and various common-law databases. Such “full” searches have never been foolproof, since the federal and state trademark databases are never completely up to date, and common-law sources are incomplete. Moreover, there is always the risk that a U.S. applicant will be trumped by a foreign applicant claiming priority under the Paris Convention. The latter risk is relatively small, since applications claiming convention

<sup>83</sup> EXAM GUIDE, *supra* note 73, § IV(D).

<sup>84</sup> Rules of Practice, *supra* note 6, §§ 2.101(b)(2), 2.102(a)(2).

<sup>85</sup> *Id.* at § 2.107(b).

<sup>86</sup> 15 U.S.C. § 1141i(a).

<sup>87</sup> 15 U.S.C. § 1141i(b).

<sup>88</sup> EXAM GUIDE, *supra* note 73, §IV(E). For more information specific to the United States, see EXAM GUIDE 2-03, *Guide to Implementation of the Madrid Protocol in the United States*, available at <http://www.uspto.gov/web/trademarks/madrid/madridguide.htm>

<sup>89</sup> 15 U.S.C. § 1141k.

priority have historically accounted for a very small portion of the total applications filed with the USPTO.<sup>90</sup>

¶52 The Madrid Protocol may lead to a slight increase in the level of uncertainty, since the Office of Origin of a foreign applicant may delay transmission of an International Application to the Bureau. In addition, the Bureau may delay issuance of the International Registration because of irregularities in the specification of goods, failure to pay sufficient fees, or the like. To minimize the degree of risk, trademark owners should include a search of the International Register when clearing trademarks in the U.S.

## V. ADVANTAGES AND DISADVANTAGES OF THE MADRID PROTOCOL

### A. Lower Filing Fees and Associate Charges

¶53 Trademark owners seeking trademark protection through the Madrid Protocol can expect a significant cost savings in terms of filing fees and foreign associate charges, particularly in the case of a large filing program. For example, a U.S. applicant seeking to extend protection for a single basic application in a single class, without color designation, can expect to pay: (1) a certification fee of one hundred dollars to the USPTO; (2) a basic application fee of CHF 653 (about five hundred nine dollars) to the Bureau; and (3) a fee of CHF 73 (about fifty-seven dollars) for each country designated. These fees are considerably lower than the filing fees charged by each country in the case of national applications. Of the sixty-two Contracting Parties to the Madrid Protocol, thirteen, including the United States, have elected to charge an “individual fee” in lieu of the standard fee of CHF 73 set by the Bureau. This fee varies, but must (in theory, at least) be less than the fee charged by each country for a national trademark application.<sup>91</sup>

¶54 Use of the Madrid Protocol filing system also should result in lower foreign associate charges, since a trademark owner seeking an extension of protection need only appoint a local agent if the application is rejected by the national trademark office. According to INTA, during the first two years following implementation of the Madrid Protocol on April 1, 1996, France accepted ninety-six percent of all requests for extension of protection, Germany seventy-six percent, Norway seventy-four percent, Russia sixty-six percent, Switzerland eighty-one percent and Spain fifty-one percent.<sup>92</sup> On average, an International Registration designates twelve countries, with over forty percent receiving no refusals at all.<sup>93</sup> INTA estimates that an eleven-country filing

<sup>90</sup> Of the 2,163,865 applications filed with the U.S. Patent and Trademark Office since January 1, 1993, only 79,341, or about 3.6%, contained a Section 44(d) priority claim. These numbers were generated using raw data available through the Trademark Electronic Search System (TESS), available through the U.S. Patent and Trademark Office, at <http://www.uspto.gov>.

<sup>91</sup> “Individual fees” vary from CHF 94 (about US\$73) for a single class application, in Greece, to CHF 600 (about US\$467) for three classes, in the case of Belarus. Under Article 8(7)(a) of the Madrid Protocol, *supra* note 5, the individual fee charged by a Contracting Party may not exceed “the equivalent of the amount which the said Contracting Party’s Office would be entitled to receive from an applicant for a ten-year registration, or from the holder of a registration for a ten-year renewal of that registration, of the mark in the register of the said Office, the said amount being diminished by the savings resulting from the international procedure.”

<sup>92</sup> Int’l Trademark Association, Issue Brief, *The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice*, p. 32 (Apr. 2003) at [http://www.inta.org/downloads/tap\\_usmadrid2003.pdf](http://www.inta.org/downloads/tap_usmadrid2003.pdf).

<sup>93</sup> *Id.*

program<sup>94</sup> costing US\$5,831 under the Madrid Protocol would cost US\$14,593 if separate national applications were used.<sup>95</sup> Presumably, the cost savings are greater in countries that issue fewer refusals.

¶155 Not surprisingly, requests for extension of protection represent an extremely high percentage of total trademark filings by foreign residents in countries where applications are not subjected to rigorous examination, such as Austria (89.6%), Finland (86.5%), Denmark (85.9%), and Portugal (85.6%). Conversely, Madrid filings represent a low percentage of total filings by foreign residents in United Kingdom (49.4%), Japan (30.0%), China (22.9%) and Australia (6.4%),<sup>96</sup> where goods and services must be specifically identified,<sup>97</sup> and application requirements are otherwise fairly rigorous. Similarly, countries without rigorous examination requirements account for a disproportionately large share of International Applications filed.<sup>98</sup>

¶156 Foreign trademark owners seeking to extend protection to the United States via the Madrid Protocol should not expect dramatic cost savings, since the examination of applications is at least as rigorous as in the United Kingdom, Japan, China and Australia, if not more so. Consequently, prosecution costs are higher, and the initial filing fee represents a smaller portion of the overall cost of obtaining registration. According to the most recent survey conducted by the AIPLA, the median charge of a U.S. firm for prosecuting a U.S. application (US\$997) is approximately double the charge for filing a foreign origin application for trademark registration (US\$498).<sup>99</sup>

### B. Less Paperwork

¶157 Before the United States joined the Madrid Union, U.S. companies seeking trademark protection abroad had to file separate applications in each country or jurisdiction where they sought protection. Now, U.S. companies can seek protection throughout the member countries of the Madrid Protocol by filing a single International

<sup>94</sup> Countries include the U.S., Austria, China, Denmark, France, Germany, Japan, Russia, Sweden, Switzerland and the United Kingdom.

<sup>95</sup> Int'l Trademark Association, Issue Brief, *The Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice*, p. 34 (Apr. 2003) at [http://www.inta.org/downloads/tap\\_usmadrid2003.pdf](http://www.inta.org/downloads/tap_usmadrid2003.pdf).

<sup>96</sup> Statistical analysis based on data contained in WORLD INTELLECTUAL PROPERTY ORGANIZATION, INDUSTRIAL PROPERTY STATISTICS 2001, at [http://www.wipo.int/ipstats/en/publications/a/pdf/pub\\_a.pdf](http://www.wipo.int/ipstats/en/publications/a/pdf/pub_a.pdf). [hereinafter WIPO STATISTICS]. See *infra* Appendix C for more complete analysis C.

<sup>97</sup> *Mercury Communications Ltd. v. Mercury Interactive (UK) Ltd.*, [1995] FSR 850, (1995) IP & T Digest 17 (Chancery Division) (“a registration of a mark simply for ‘computer software’ will normally be too wide”); *Thomson Holidays Ltd. v. Norwegian Cruise Line Ltd.*, [2002] EWCA Civ. 1828 (2002) (Civil Division) (“it would be commercially nonsense to maintain the registration for all goods caused by the wide words”); JAPAN PATENT OFFICE, TRADEMARK EXAMINATION MANUAL § 46.01 (July 2001), at [http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/pdf/46-01.pdf](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/pdf/46-01.pdf) (“when the content or scope of the designated goods or services are unclear, the trademark application does not comply with the requirement in this subsection due to an insufficient ‘designation’ of goods or services”); ETHAN HORWITZ, WORLD TRADEMARK LAW AND PRACTICE, China, at § 1.04 (“an application must cover more than one class of goods or services but the specifications of goods and services must be specific”); IP AUSTRALIA, TRADEMARKS MANUAL OF PRACTICE AND PROCEDURE, pt. 14, § 6.6, at [http://xeno.ipaustralia.gov.au/D:/Exmanual/pt10\\_19/part14.htm](http://xeno.ipaustralia.gov.au/D:/Exmanual/pt10_19/part14.htm), (“An applicant may not claim as part of the specification of goods and/or services a range of goods or services in a particular class which is unrealistically broad in that in commercial terms it is unlikely that the applicant would deal in or provide that range of goods or services”).

<sup>98</sup> See *infra* Appendix D.

<sup>99</sup> AIPLA, *Report of the Economic Survey 2003*, at 20.

Application. Moreover, the Madrid Protocol provides for centralized renewal, assignment, and recording of licenses. These are significant advantages in the case of a large trademark filing program.

### C. Dependency and Vulnerability to Central Attack

¶58 The possibility of central attack is perhaps the single greatest disadvantage of the Madrid Protocol. As noted above, an International Registration becomes invalid if the basic application or registration lapses or is refused, withdrawn, or cancelled within five years from the date of the International Registration. This is an issue of particular importance for U.S. applicants. Less than half of the applications filed with the USPTO between 1995 and 2000 resulted in registrations that remain valid as of this writing.<sup>100</sup>

¶59 In addition, the scope of the International Registration depends on the scope of the basic registration. Consider, for example, the case of a company filing a U.S. application covering an entire class heading. The applicant may seek an International Registration based on this application, and in many countries, the request for extension of protection would be granted. Nonetheless, the USPTO will inevitably require a narrowing of the specification of goods in the basic application, and this will result in a corresponding limitation of the International Registration.

## VI. CONCLUSION

¶60 The Madrid Protocol creates opportunities for U.S. trademark owners, but it is by no means the best alternative for every international trademark filing program. It may be the best choice in the case of a large filing program, if overall cost and subsequent ease of administration are the most important considerations. Applicants seeking coverage for a broad range of goods and services may wish to consider other alternatives, since the scope of an International Registration cannot exceed the relatively narrow scope of the basic U.S. registration. In addition, trademark owners should consider the possibility that their U.S. application will be rejected, either on substantive grounds or for failure to file a Statement of Use, as well as the possibility of central attack on any resulting registration.

## VII. APPENDICES

### A. Members of the Madrid Agreement and Madrid Protocol

Contracting Party	Madrid Agreement	Madrid Protocol
Albania	✓	✓
Algeria	✓	
Antigua and Barbuda		✓
Armenia	✓	✓
Australia		✓
Austria	✓	✓

<sup>100</sup> See *infra* Appendix E.

Azerbaijan	✓	
Belarus	✓	✓
Belgium	✓	✓
Bhutan	✓	✓
Bosnia and Herzegovina	✓	
Bulgaria	✓	✓
China	✓	✓
Croatia	✓	✓
Cuba	✓	✓
Cyprus	✓	✓
Czech Republic	✓	✓
Denmark		✓
Egypt	✓	
Estonia		✓
Finland		✓
France	✓	✓
Georgia		✓
Germany	✓	✓
Greece		✓
Hungary	✓	✓
Iceland		✓
Iran	✓	✓
Ireland		✓
Italy	✓	✓
Japan		✓
Kazakhstan	✓	
Kenya	✓	✓
Korea (North)	✓	✓
Korea (South)		✓
Kyrgyzstan	✓	
Latvia	✓	✓
Lesotho	✓	✓
Liberia	✓	
Liechtenstein	✓	✓
Lithuania		✓
Luxembourg	✓	✓
Macedonia	✓	✓
Moldova	✓	✓
Monaco	✓	✓
Mongolia	✓	✓
Morocco	✓	✓
Mozambique	✓	✓
Netherlands	✓	✓
Norway		✓

Poland	✓	✓
Portugal	✓	✓
Romania	✓	✓
Russian Federation	✓	✓
San Marino	✓	
Serbia and Montenegro	✓	✓
Sierra Leone	✓	✓
Singapore		✓
Slovakia	✓	✓
Slovenia	✓	✓
Spain	✓	✓
Sudan	✓	
Swaziland	✓	✓
Sweden		✓
Switzerland	✓	✓
Tajikistan	✓	
Turkey		✓
Turkmenistan		✓
Ukraine	✓	✓
United Kingdom		✓
United States of America		✓
Uzbekistan	✓	
Viet Nam	✓	
Zambia		✓

*B. Madrid Protocol Fees*

1. USPTO Process Fees

Item	Amount (US\$)
Certifying an international application based on a single basic application or registration, per class	100
Certifying an international application based on more than one basic application or registration, per class	150
Transmitting a subsequent designation to the International Bureau	100
Transmitting a request to record an assignment or restriction, or release of a restriction	100
Filing a notice of replacement, per class	100
Filing an affidavit under Section 71 of the Lanham Act, per class <sup>101</sup>	100
Surcharge for late filing of Section 71 affidavit, per class	100

<sup>101</sup> Section 71 provides for cancellation of an extension of protection. 15 U.S.C. 1141k. The Madrid Protocol requires that an affidavit of continued use (similar to a Section 8 affidavit) be filed on the sixth anniversary of the date on which the certificate of extension of protection issues, or at the end of any ten year period following the issuance of the certificate of extension. *Id.*

2. International Bureau Fees

Item	Amount	
	CHF	US\$ (approx.)
Basic application fee	653	509
Basic application fee if reproduction of the mark is in color	903	704
Supplementary fee for each class of goods or services beyond three classes, unless only Contracting Parties requiring payment of "individual fees" (see below) are designated	73	57
Complementary fee for each Contracting Party designated, unless the Contracting Party requires payment of an "individual fee" (see below)	73	57
Additional fee if goods and services are not grouped in classes	77 + 4 per term in excess of 20 terms	60 (+ 3)
Additional fee for incorrect classification (not payable if less than CHF 150)	20 + 4 per incorrectly classified term	16 (+ 3)
Basic fee for subsequent designation	300	234
Complementary fee for each designated Contracting Party, unless the Contracting Party requires payment of an "individual fee" (see below)	73	57
Basic renewal fee	653	509
Supplementary fee, unless renewal is made only for Contracting Parties which require payment of "individual fees" (see below)	73	57
Complementary fee for each designated Contracting Party for which an "individual fee" (see below) is not required	73	57
Surcharge for late renewal	50% of Basic Fee	50% of Basic Fee
Total transfer of International Registration	177	138
Partial transfer (for some goods or services only)	177	138
Limitation of International Registration (if limitation is the same for all Contracting Parties designated)	177	138
Change of name or address	150	117
Recording of a license	177	138

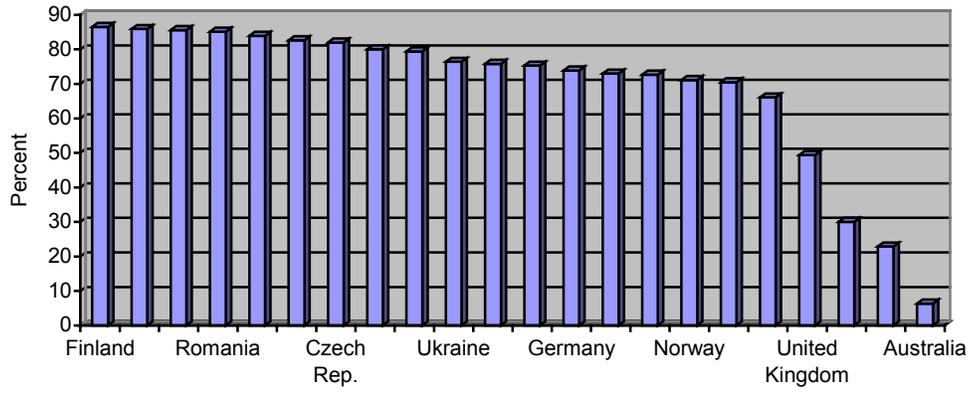
3. Individual Fees<sup>102</sup>

Country	Item	CHF	US\$ (approx)
Armenia	for one class	221	175
	for each additional class	22	17

<sup>102</sup> The amounts of individual fees specified in this table must be paid when the Contracting Parties mentioned below are designated under the Protocol in the international application or in a designation subsequent to international registration. Common Regulations, Rule 34 and Schedule of Fees.

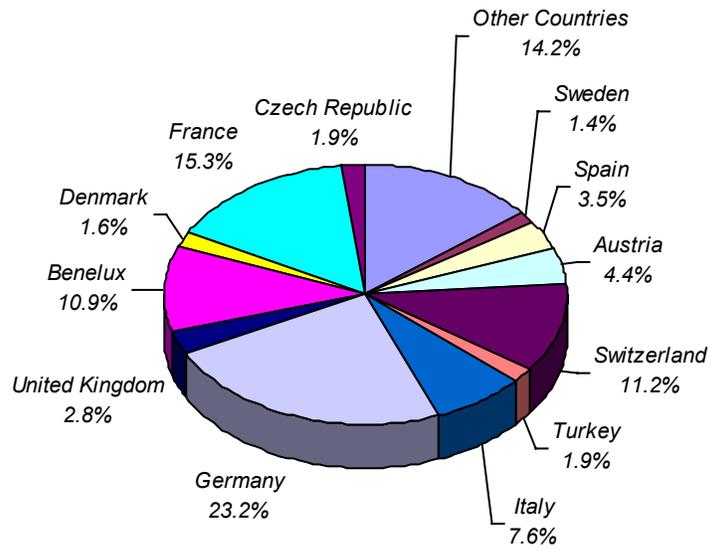
Country	Item	CHF	US\$ (approx)
Australia	for one class	397	315
	for each additional class	397	315
Belarus	for three classes	600	476
	for each additional class	50	40
Benelux	for three classes	201	159
	for each additional class	19	15
	for three classes (collective/certification mark)	286	227
	for each additional class (collective/certification mark)	19	15
Bulgaria	for one class	251	199
	for each additional class	15	12
	for one class (collective/certification mark)	502	398
	for each additional class (collective/certification mark)	30	24
China	for one class	345	274
	for each additional class	172	136
	for one class (collective/certification mark)	1036	821
	for each additional class (collective/certification mark)	518	410
Denmark	for three classes	487	386
	for each additional class	124	98
Estonia	for one class	291	231
	for each additional class	104	82
	for one class (collective mark)	364	288
	for each additional class (collective mark)	104	82
Finland	for three classes	236	187
	for each additional class	88	70
	for three classes (collective mark)	340	270
	for each additional class (collective mark)	88	70
Georgia	for one class	285	226
	for each additional class	113	90
Greece	for one class	94	75
	for each additional class	23	18
Iceland	for one class	226	179
	for each additional class	48	38
	for one class (collective mark)	274	217
	for each additional class (collective mark)	48	38

C. Madrid Applications as Percentage of Total Applications by Non-Residents in 2001<sup>103</sup>



<sup>103</sup> Source: WIPO Statistics, *supra* note 90. Data not available for all countries

*D. Madrid Registrations by Office of Origin - 2002*



*E. Status of U.S. Applications Filed 1995-2000 (total filed = 987,225)*

