

United States Patent and Trademark Office

Public Hearing Concerning the Proposed Rules of Practice for  
Trademark-Related Filings under the Madrid Protocol

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Comments of

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I begin by stating that I am speaking for myself today, and not on behalf of any association or organization that I may be, or may have been, affiliated with. I speak based on my current work as trademark counsel, speaking and writing on the U.S. implementation of the Madrid Protocol. And I speak based on my experience as Director of Industrial Property at WIPO, having worked extensively from that point of view with international trademark treaties, including the Madrid Protocol.

It may be common in public hearings to focus on what is wrong with the proposed regulations being examined. But I find myself in the pleasant position of being able to praise the draft regulations. I have studied them, and found them to accurately reflect U.S. obligations under the Protocol, and to show a profound understanding of how the international system works, and how it will interface with the U.S. trademark system.

I would particularly like to praise the decision on the part of the USPTO to make the Madrid Protocol application procedure an exclusively electronic application process. TEAS has proven itself to be a highly usable system, and its user-friendliness promises to encourage participation in the trademark system by SMEs. Effective electronic filing makes the system accessible world-wide, and will become a model for the offices of other countries, and the international community as a unit.

I would encourage the USPTO to continue their efforts to extend the electronic requirement to processing as well as filing, to make TTAB practice fully

electronic, to lobby WIPO to modify the TLT to accommodate electronic filing, and to provide effective incentives (namely, monetary and accelerated time of processing) for use of electronic systems. I also encourage the USPTO to promote the use of TEAS world-wide, and to continue upgrading and improving TEAS, in particular to simplify the signature procedures.

With respect to specific comments concerning the implementing regulations for the Madrid Protocol, I would add my voice to the others in asking that the USPTO not make the rules less user-friendly than they currently are, especially if those changes also affect non-Protocol applications. I would encourage the USPTO to work toward harmonizing the Protocol with the user-friendly provisions of the TLT, even if that means lobbying for changes within the WIPO bodies.

I further encourage the USPTO to clarify the legal status of the signature on the declaration of intent to use that is contained in the international application or subsequent designation. If those documents are signed by a foreign trademark owner's representative before WIPO, but that representative is not entitled to represent the holder before the USPTO, the status of the declaration may be in doubt.

I agree with the comments of others concerning the effect of the narrowness of the description of goods and services in the U.S. compared to other countries, but with an additional reason. When speaking with European contacts about this issue, I have learned that European companies regularly monitor the U.S. trademark filings of U.S. companies. These filings typically contain the narrow

list of goods or services required under U.S. practice, especially in the case of intent to use applications. European companies regularly use this list to determine the future marketing strategies of their U.S. competitors and make use of that knowledge in designing their own marketing plans, giving them an unfair competitive advantage over their U.S. counterparts. This is not an imagined practice; it is a regular practice in Europe, and is apparently quite effective.

The practice does not work the other way around, since European companies typically file in the U.S. using the broader list of goods or services from their European applications. The list will of course be narrowed during examination, but this information is not as easily accessible to the public, and will occur later in the marketing cycle when the information is of less use.

Thus, the U.S. requirements for a narrow list of goods and services should be revisited, even without accession to the Protocol.

My proposed solution to the handicap mentioned by other speakers, that U.S. users of the Madrid Protocol are limited to their narrow U.S. lists of goods and services and therefore receive narrower protection abroad than they would through national filings, is to lobby WIPO to do away with dependency of the international registration on the basic application or registration.

The principle of dependency is not needed for the Protocol. In the U.S., Section 44 applications in the United States, which like Protocol extensions are based on Article 6*quinquies* of the Paris Convention, do not remain dependent on the home registration.

Dependency is an historical anomaly that has been carried over from the Madrid Agreement. It may have had some utility under that agreement, since very few if any members performed a substantive examination of the request for extension of protection. However, under the Madrid Protocol, every member is entitled to utilize the extended 18-month time limit for refusals to perform a substantive examination. Under these circumstances, dependency makes little sense. Why should a user of the Protocol, whose application is fully examined in the office of a member country, receive less rights than the filer of a national application that is examined in the same way by the same office?

Further, the five-year dependency violates the spirit, and perhaps the word, of the Madrid Protocol itself. Article 4 of the Madrid Protocol states that the protection of the mark in Contracting Party shall "be the same as if the mark had been registered by the Office of that Contracting Party." This requirement is contradictory to the five-year dependency, since registration based on a national application, even one based on Article 6*quinquies* as mentioned, is not dependent in any way on the continuation of foreign rights.

While this change would require a modification of the text of the Protocol, if only to make it internally consistent, I would encourage the USPTO to engage in lobbying the Member States of WIPO to consider making that change in the near future.

Finally, I would encourage the USPTO to be vigilant in assuring that WIPO puts sufficient resources into their Madrid Protocol operations to ensure so that the

shock of starting up U.S. operations can be handled smoothly, and that continuing operations are efficiently and effectively run.

In summary, excellent job! Keep up the good work. Make further good changes to the international system.

Thank you.