

Tips on Registering Your U.S. Entertainment & Sport Client's Trademarks Worldwide--The Madrid Protocol Treaty

Carbo

Law Offices Of
Kimberly Kolback
1395 Brickell Ave., Suite 800
Miami, FL 33131

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Register In the U.S.

- Register client trademarks with the United States Patent and Trademark Office (“USPTO”)
- <https://www.uspto.gov/trademarks/apply>

The Application Process

- If your client is already using the mark in commerce (which generally means that the client is offering goods or services bearing the mark for sale to the public) then you will file a "1(a)" or "In-Use" application. 15 U.S.C. 1051(a)
- If your client is intending, but has not yet used its trademark on goods or services in commerce, then you will file a "1(b)" or "Intent-To-Use" application. 15 U.S.C. 1051(b)

This type of application requires you to file a Statement Of Use once the client offers its goods or services for sale to the public. You must pay the USPTO an additional \$100.00 filing fee with your Statement Of Use.

Generally, it takes between 8-16 months to fully complete the trademark application process; however, the "effective" registration date is the date the application was filed.



International Registration from U.S. Using the Madrid Protocol Treaty

U.S. is a member of the Madrid Protocol Treaty and as such U.S. trademark applicants and registrants can use a single USPTO application filed through the World Intellectual Property Organization (“WIPO”) to designate member countries of the Madrid Union for trademark protection.

As of November 2024, 115 members representing 131 countries have joined the Madrid Union and represent over 80% of the world’s trade.

A list of present members of the Madrid Union may be found at: <http://www.wipo.int/madrid/en/members>

What is the cost for filing an international application through the USPTO?

USPTO - charges a certification fee for certifying international applications and transmitting them to WIPO. The certification fee is \$100.00, per class, if the international application is based on a single U.S. application or registration, or \$150.00, per class, if the international application is based on more than one U.S. application or registration.

WIPO then requires payment of a base fee, presently \$650, and additional fees based on:

- the particular Countries designated in the application,
- the number of classes of goods and services, and
- whether the reproduction of the mark is in black and white, or in color.

Understanding the Country designations

- An European Union (EU) designation will include all EU member states (except Malta), or you can designate each country separately.
- A designation of "United Kingdom" covers England, Wales, Scotland, Northern Ireland, the Isle of Man, Jersey, and the Falkland Islands and Gibraltar, and regions cannot be designated separately.
- The African Intellectual Property Organization ("OAPI") is a regional registration system that protects trademarks in many African nations (17) because many of the OAPI member countries do not have national registration systems. But it does not cover all African nations such as Angola, Ethiopia, Nigeria and South Africa.
- Argentina, Peru, Costa Rica, Dominican Republic and Panama are not members.
- Saudi Arabia only became a member in November 2023.

WIPO DESIGNATION SAMPLE FEES

BASIC FEE = \$650, PLUS--

United Kingdom \$202

European Union \$789 (27 Member states)

OAPI (17 Member states) \$572

China \$249

The schedule of fees and a Fee Calculator can be found at:

<http://www.wipo.int/madrid/en/fees/>.

The international application fees must be paid directly to WIPO in Swiss francs

Should you conduct a search prior to filing?



The Global Brand Database
at WIPO

Directly in national/regional
trademark registers.



When NOT to use Madrid Protocol

If a country is not a member of the Madrid Union.

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If you anticipate a challenge or rejection of the base U.S. trademark registration, since each subsequent country designation requires the survival of a valid base U.S. trademark.

Language barriers i.e. Countries using Asian characters.

When you need additional protection.

- mark is particularly famous in countries notorious for pirating
- manufacturing in the country

If you anticipate a provisional refusal or regional opposition to the trademark requiring local expertise.

If you need time sensitive trademark protection in a specific country.

If seeking protection for a complex or non-traditional trademark such as three-dimensional marks or complicated color or stylistic marks.