

# Protect your product's name abroad

Christopher Columbus may have demonstrated that the earth is round, but advances in technology are "flattening" the world. Easy access to foreign markets raises issues relative to protecting the intellectual property of Tech Valley businesses including the "good name" of products or services being marketed abroad.

A brand name (a trademark or service mark) identifies a source of goods or services and can develop strong customer appeal and extraordinary economic value.

Overseas, trademark registration is essential to prevent unauthorized use of your trademark. The first step in preserving trademark rights in foreign jurisdictions is to secure rights to the mark in this country by filing an application on the Principal Trademark Register maintained by the U.S. Patent and Trademark Office.

Europe is a prime market for Tech Valley goods and services—the newly expanded European Union includes 25 countries and a population of about 455 million people. After filing a U.S. Trademark Application, a trademark owner is presented with several different options for protecting his/her brand

name in Europe.

The trademark owner may: 1) file individual trademark applications in individual countries; 2) file a Madrid Protocol International Trademark

Application which designates individual countries within the European Union; 3) file a stand-alone European Community Trademark (CTM) application; or 4) file a Madrid Protocol Application which designates the CTM System, instead of individual European countries. Each in-

dividual country has its own trademark office, except for Belgium, the Netherlands and Luxembourg, which share one. National trademark rights may be obtained by filing for the trademark registration in each of these trademark offices. That is the traditional, but expensive, route.

Alternatively, a trademark owner may seek a single CTM registration which provides protection in all of the countries of the European Union. However, if a trademark holder encounters a mark similar to his being used in any of the member states, the owner of that other mark could prevent the registration of the later-filed mark.

A trademark holder might avoid that by identifying potential conflicts and seeking to obtain protection in only those European countries where no other entity is using a similar mark. That would be done by filing directly in individual member states and outside the CTM system.

The Madrid Protocol, which the U.S. recently joined, provides a system for filing a single international trademark application in an Office of Origin (the U.S. Trademark Office, for example) which may then eventually become effective in the 64-member countries of the Madrid Protocol.

After International Application formalities have been approved by the Office of Origin and the International Bureau of the World Intellectual Property Organization, the application is forwarded to each foreign trademark office designated by the applicant.

Although an International Application must be filed within six months of the filing of a U.S. application to claim the benefit of the U.S. filing date, an International Application may also be "extended" to additional countries at any time. However, the resulting national applications will only be entitled to the date on which a request for "extension" is filed.

Within 18 months of the date a Madrid Protocol application is filed, it is forwarded to a national trademark office. That office must act on the trademark application or it will automatically enter into force in that country.

The Madrid Protocol system also provides for streamlined registration renewals and recording of changes in ownership of applications. One risk under the Madrid Protocol is that the International Application is dependent on its base application (the U.S. application for U.S. residents) for a period of five years from filing date.

If at any time during this period the base

application is invalidated, applications based on that application will need to be converted into national applications in each individual country to allow the applications or registration to remain in effect.

Filers have the option of designating the CTM system when filing Madrid Protocol Applications. That option can result in significant cost savings for U.S. applicants due to decreased official and legal fees.

Returning to the choice of options above, an applicant wishing trademark protection in Europe may file foreign trademark applications directly in each individual country where protection is desired. That option is cost-effective relative to the other options only when protection is desired in a small number of European countries.

Another option would be for a U.S. applicant to merely file a CTM application based on his/her U.S. application. That option would be most desirable when there is no desire to enter any countries which are members of the Madrid Protocol besides the CTM System.

When trademark protection is desired in Japan, China, Australia and other countries besides the European community and the United States, the Madrid Protocol is usually the most desirable option. It should also be noted, however, that there are several countries outside Europe which are not members of the Madrid Protocol, such as Canada, Mexico and India.

When protection is desired in those countries, direct individual national trademark filings are necessary.

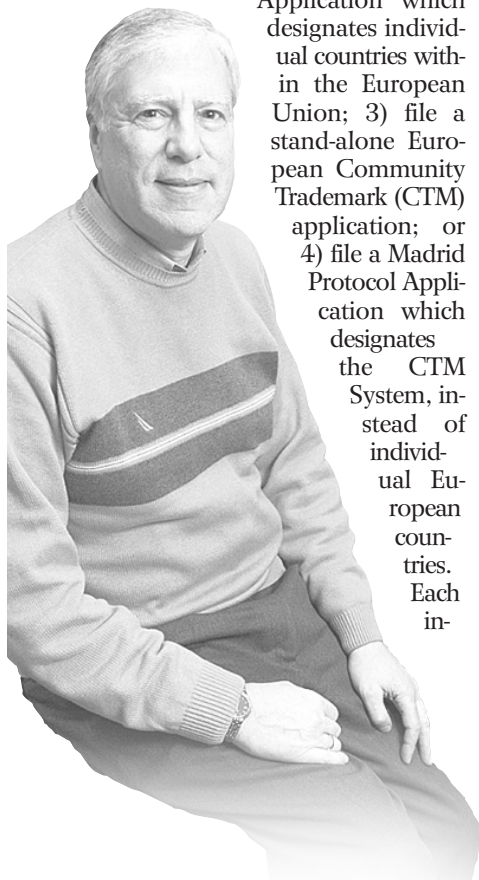
A Community Trademark Application is most desirable when little or no opposition is expected. In contrast, when it is known that one might encounter opposition in individual countries, the designation of individual European states and excluding those questionable countries when making designations under the Madrid Protocol, or when filing directly in individual countries, is desirable.

As the world has become "flatter," knowledge of the available options, and risks/costs and benefits of each approach, is essential in designing an effective foreign intellectual property strategy.

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## NEW FRONTIERS

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