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How to Transform International Registrations Under the Madrid Protocol

Robert P. Felber, Jr., Waller Lansden Dortch & Davis, LLP, Nashville, Tennessee, USA

The Madrid system for the International Registration of trademarks is a convenient and economical system for applicants in member countries to secure trademark registrations in other member countries throughout the world. There are 98 contracting parties to the Madrid Protocol, covering 114 countries, including the United Kingdom, the United States, Mexico, China, and much of Europe and the Pacific Rim (<http://www.wipo.int/madrid/en/>). The International Registration system is administered by the World Intellectual Property Organization (WIPO) through its International Bureau (IB).

Uniformity and Efficiency

By establishing a system through which an applicant may seek trademark protection in multiple jurisdictions through a single filing with the trademark office in the applicant's country of origin, the Protocol facilitates uniformity and efficiency. The many benefits of the system include elimination of the high cost of pursuing independent national applications; simplification of registration renewals; and simplification of the recordation of assignments, name changes, and address changes.

Dependence on Basic Application or Registration

Although the system has many benefits, using the Protocol does come with some risks. One of those risks relates to the fact that an international application governed by the Protocol must be based on either an application filed with or a registration issued by the national trademark office of a contracting party to the Protocol (Office of Origin) (Article 2(1) of the Madrid Protocol). This is referred to as the basic application or the basic registration. For a period of five years following the date of an International Registration, the International Registration is dependent on the validity of the underlying basic application or basic registration. For the purposes of counting the five-year dependency period, the International Registration will, as a rule, bear the date on which the international application was received by the Office of Origin (Article 3(4) of the Madrid Protocol).

The protection provided by an International Registration and the extension of protection to other jurisdictions may no longer be invoked if, or to the extent that, the basic application or basic registration is withdrawn, abandoned, cancelled, revoked, invalidated or has otherwise lapsed, either within a period of five years following the date of the International Registration; or as a result of an action that began within that five-year dependency period (Article 6(3) of the Madrid Protocol). The dependency applies not only to any extension of protection claimed in the original application for International Registration but also to any subsequent designations made under that International Registration. Only at the end of the dependency period will the International Registration live on, independent of the basic mark.

Consequently, before proceeding with international registration, it is important that applicants carefully assess the condition and strength of the national basic trademark application or registration that will serve as the foundation for the International Registration. In some cases, however, an applicant cannot predict the untimely demise of its basic application or basic registration.

Extinguishment and Transformation

If your basic application or registration that serves as the foundation of a recently filed International Registration extended to multiple jurisdictions is lost during the five-year dependency period, the Office of Origin notifies the IB that the basic mark is no longer in effect. As a result, your International Registration is extinguished. What happens next?

The good news is that the Protocol anticipates this situation and provides a mechanism to mitigate the consequences of a cancellation of an International Registration during the dependency period. The Protocol permits the owner of an International Registration that has been cancelled as a result of the failure of the basic application or registration to apply, within three months of the date of cancellation of the International Registration, for registration of the mark with the trademark office in each of the countries to which the owner had requested an extension of protection (Article 6(4) of the Madrid Protocol). This process is referred to as “transformation” because it permits the International Registration to be transformed into one or more national or regional applications.

Under the Protocol, these transformed national or regional applications will be deemed to have been filed on the date of the original International Registration (Article 9 quinquies of the Madrid Protocol). If the International Registration claimed priority, the transformed national or regional application will benefit from that priority claim. Otherwise, the applications resulting from the transformation are treated as ordinary national or regional applications and the filings are not governed by the Protocol; nor will the IB be involved in the transformation process.

Transformation is available only when the International Registration is cancelled as a result of the IB’s receiving notification from the Office of Origin that the basic application or basic registration has been abandoned or cancelled. It is not available if the International Registration expires for failure to renew, or is cancelled, in whole or in part, at the request of the registrant or for any other reason (Article 9 quinquies of the Madrid Protocol). For example, the holder of the International Registration cannot voluntarily cancel the International Registration with the IB and then request transformation of that registration into national applications in the designated contracting countries. Transformation is available, however, if the holder voluntarily abandons or cancels its basic application or registration during the dependency period, which results in the Office of Origin’s notifying the IB of the abandonment or cancellation.

Although WIPO has made available to Protocol members a set of “Model Provisions on Transformation of an International Registration into a National (or Regional) Application,” each contracting party to the Protocol is responsible for establishing its own process for giving effect to the transformation of an International Registration into a national or regional application (Article 9 quinquies of the Madrid Protocol). The contracting party may require that the party applying for transformation comply with all requirements that would otherwise apply to a newly-filed national or regional application filed in that office, including the payment of relevant filing fees. Consequently, notwithstanding the fact that the holder paid fees to extend the International Registration to a particular jurisdiction, if the International Registration is cancelled and transformed into a national application in that jurisdiction, the applicant will likely be required to pay additional national application fees.

Examples of Transformation

For example, if an International Registration extending protection to the United States has its basic application filed with the Danish Patent and Trademark Office (DKPTO) and, within five years of the date of the International Registration, the Danish application is abandoned, the DKPTO, in its capacity as the Office of Origin, will report the ceasing of effect to the IB. The IB will then extinguish the International Registration and notify the holder of the International Registration of the extinguishment. As a result, the corresponding extension of protection to the United States will cease to be valid.

Within three months of the date of that extinguishment, however, the Danish applicant may file documentation with the U.S. Patent and Trademark Office (USPTO) to transform the extension of protection for the International Registration to the United States into a national application to register the

mark in the United States for any or all of the goods or services covered by the original extension of protection to the United States (Section 1902.10 USPTO Trademark Manual of Examining Procedure). The transformed application may be based on use in the United States or a good faith intent to use in the United States, or it may be based on a foreign national application or registration (i.e., the same bases on which any other national application may be filed in the United States). The transformed application will then be examined by the USPTO as a domestic application.

If this U.S. application is filed within three months of the International Registration's being cancelled, the transformed application will have the same effective filing date as the cancelled extension of protection to the United States: the International Registration date, if the request for extension of protection to the United States was made in the original International Registration; or the date of the subsequent designation, if the request for extension to the United States was made as a subsequent designation under the International Registration.

If the extension of protection was entitled to priority under the Paris Convention for the Protection of Industrial Property, the new transformed U.S. application is entitled to the same priority (Section 1902.10 USPTO Trademark Manual of Examining Procedure). Notwithstanding the fact that the applicant paid a fee in connection with the international application to extend protection to the United States, the USPTO will require that the holder pay standard new application fees to the USPTO in connection with the transformation (currently ranging from USD 225 to USD 400 per International Class). Furthermore, even if the mark in the extension of protection had already been published or registered in the United States, the USPTO will require reexamination and republication of the transformed application due to the change in the basis for registration (Section 1902.10 USPTO Trademark Manual of Examining Procedure). It is also worth noting that only the trademark holder or individuals authorized to practice before the USPTO may file the transformed application with the USPTO.

In another example, if an International Registration extending protection to Denmark has its basic application filed in the United States and, within five years of the date of the International Registration, the U.S. application is abandoned, the USPTO, in its capacity as the Office of Origin, will report the ceasing of effect to the IB. As a result, the IB will extinguish the International Registration and notify the holder of the International Registration of the extinguishment. As a result, the corresponding extension of protection to Denmark will cease to be valid. Within three months of the date of that extinguishment, however, the U.S. applicant may file documentation with the DKPTO to transform the extension of protection for the International Registration to Denmark into a national application to register the mark in that country for any or all of the goods or services covered by the original extension of protection to Denmark. The transformed application will then be examined by the DKPTO as a domestic application.

If this Danish application is filed within three months of the International Registration's being cancelled, the transformed application will have the same effective filing date as the cancelled extension of protection to Denmark. The DKPTO will require that the holder pay standard new application fees of DKK 2,355 for the first three classes, plus DKK 600 for each additional class, in connection with the transformation. The DKPTO will then examine the transformation as it would any other new application. Although the holder or its non-Danish counsel would be permitted to file the transformation application with the DKPTO, as a practical matter the holder will likely wish to retain Danish counsel to file the application, because, if the application is filed in English, the DKPTO will require that the application be accompanied by a Danish translation of the goods and services and the DKPTO may invite the applicant to appoint a representative in Denmark to prosecute the application (<http://iprights.dkpto.org/trademark/how-to-file.aspx>).

An Expensive Second Chance

Fortunately, the failure of a basic application or registration during the dependency period does not mean that a trademark owner has lost the opportunity to have its trademark protected in the countries for which it sought protection through the Protocol and maintain its priority date. The process of transformation, however, will involve additional time and expense. If an International Registration extended to multiple jurisdictions is extinguished and is transformed into multiple national applications, the applicant could experience significant additional expenses in both filing fees and local counsel fees. It is important that trademark applicants adequately assess the strength and viability of the basic application or registration before pursuing an International Registration.

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