

## Foreign Trademark Clearance and Filing

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A trademark owner should consider a protection strategy for its trademarks outside the U.S. At a minimum, it would appear that most U.S. companies should consider protection in Mexico, Canada and the European Union. However a specific strategy should be developed according to a company's actual products and markets.

**Timing: Searching:** If a mark is important enough to the company for a full search, we recommend searching the on-line trademark records of the E.U. and Canada at that time. It would be useful at that point to know if there is any obvious obstacle to registration in these jurisdictions, and will help establish a mark's availability.

**Timing: Filing:** Once an application is filed in the United States, it should be extended to foreign jurisdictions of interest, if possible using the 6-month priority under the Paris Convention. Generally it is advisable to "extend" the application under the Madrid Protocol. This means that the non-U.S. applications are for the same goods or services as the U.S. application or registration. Filing under the Protocol is cheaper than filing on a stand-alone basis. The disadvantage is that only the goods and services in the U.S. application can be the subject of the application, and the U.S. has very restricted, use-based registrations. Therefore if a trademark owner wishes to have very broad protection, it should not "extend" under the Protocol, but file stand-alone applications outside the U.S.

- Madrid Protocol "extension" of U.S. applications or registrations is possible in the following jurisdictions:

### **MADRID PROTOCOL MEMBER COUNTRIES**

Albania	Greece*	Netherlands* (includes Netherlands Antilles) <sup>A</sup>
Antigua and Barbuda	Hungary*	Norway
Armenia	Iceland	Poland*
Australia	Iran, Islamic Republic of	Portugal*
Austria*	Ireland*	Romania*
Azerbaijan	Italy*	Russian Federation
Bahrain	Japan	Serbia and Montenegro
Belarus	Kenya	Sierra Leone
Belgium <sup>A*</sup>	Korea, The Democratic People's	Singapore

<sup>A</sup> The territories of Belgium, Luxembourg and the Kingdom of Netherlands in Europe are deemed to be a single country for purposes of this Protocol.

	Republic of	
Bhutan	Korea, The Republic of	Slovakia*
Botswana	Kyrgyzstan	Slovenia**
Bulgaria*	Latvia*	Spain*
China	Lesotho	Swaziland
Croatia	Liechtenstein	Sweden*
Cuba	Lithuania*	Switzerland
Cyprus*	Luxembourg <sup>A</sup> *	Syria Arab Republic
Czech Republic*	Malta* (via European Union only)	Turkey
Denmark*	Macedonia, The former Yugoslav Republic of	Turkmenistan
Estonia*	Moldova, Republic of	Ukraine
European Union	Monaco	United Kingdom*
Finland*	Mongolia	United States of America
France*	Morocco	Uzbekistan
Georgia*	Mozambique	Vietnam
Germany*	Namibia	Zambia
*These countries are members of the European Union		72 Jurisdictions (15 January 2007)

Filing under the Madrid Protocol incurs a WIPO basic fee and an individual country fee. The United States Patent and Trademark Office also charges a certification fee. By way of example, an application to register a standard word mark based on a United States application in one trademark class in France and Turkey would be as follows:

	<b>CHF</b>	<b>USD at current exchange rate</b>
Basic Fee – No Color	653	\$538.00
France – Individual Fee	73	\$63.00
Turkey – Individual Fee	424	\$349.00
U.S. Certification Fee		\$100.00
Our Attorneys' Fees		\$550.00
Total		\$1600.00

If any objections are raised to registration or if any oppositions are filed, local foreign counsel must be maintained. However, if no objections arise, there are no additional costs to finalize the registration.

- For countries that are not members of the Madrid Protocol, it will be necessary to retain local foreign counsel and file on a country-by-country basis. We generally estimate approximately \$2000 per country, assuming no objections or oppositions.<sup>1</sup>

<sup>1</sup> These are **estimates only** based on our past experience and may vary depending on choice of foreign counsel.

For U.S. entities, Canada and Mexico are typically important jurisdictions for protection. Neither is currently a member of the Madrid Protocol, so stand-alone applications would need to be filed. An example of the cost of filing in these jurisdictions is as follows:

**Canada**

Application (one mark/one class)	\$ 800
Certified copy of US Application from PTO	\$ 15
<i>Response to Office Action(s)</i>	<i>varies</i>
Publication	\$ 300
Registration	<u>\$ 800</u>
<b>Approximate Total</b>	<b>\$ 1915</b>

**Mexico**

Application (one mark/one class)	\$ 800
Certified copy of US Application from PTO	\$ 15
Translation	\$ 350
<i>Response to Office Action(s)</i>	<i>varies</i>
Publication	\$ 200
Registration	<u>\$ 400</u>
<b>Approximate Total</b>	<b>\$ 1765</b>