

THE DOCKETING EXCELLENCE™ SERIES



Options and Best Practices for Docketing Madrid and Foreign Convention Trademark Filings

Best Practices for Docketing Madrid and Foreign Convention Trademark Filings

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Foreign Filing Dates Depending from U.S. Trademark Filing

- **Foreign Filing Docket Actions after U.S. Filing**
 - Foreign filing priority date
 - 6 months for trademarks
 - Timing of Reminders
 - Secure instructions at least 3 days in advance of deadline due to:
 - Time Differences
 - Corporate Documents
 - Powers of Attorney
 - Foreign filing after priority date

Foreign Filing Dates Depending from U.S. Trademark Filing

Docketing Tips:

- Some docketing systems docket the deadline for every new filing, but foreign filings may not be an option in every instance
- Keep date open until the deadline if some filings already ordered, or until client advises otherwise

Foreign Registration Process and Related Docketing

- **Use Not Required to Obtain Foreign Protection**

- Registration Issues without Use but Can Become Vulnerable

- Vulnerability timeline differs depending on country

- 3 years or 5 years

- Soft Use Deadlines

- Importance
 - Does docketing launch off filing date or registration date

Docketing Tip: There is no uniformity to docketing soft use deadlines. There is no “right or wrong” way to docket these deadlines. They are decided at a country level.

Foreign Filing Options: Madrid and Common Foreign Convention Filings

- **The International Application - Filing Under the Madrid Protocol**
 - Makes it possible to protect a mark in numerous countries by obtaining an international registration that has effect in each designated country
 - Based on application or registration with an “office of origin”
 - Office of Origin is a TM Office with which the Applicant has connection
 - Must have a connection with a “Contracting Party to the Protocol”
 - Connection established through establishment, domicile, or nationality
 - Must designate one or more countries
 - Designated countries must be “Contracting Party” under the Protocol

Foreign Filing Options: Madrid and Common Foreign Convention Filings

- **Filing Under the Madrid Protocol**

- **Advantages**

- Overall Cost
 - Easy to Manage
 - Multi-class applications allowed in even in single class jurisdictions

- **Disadvantages**

- Vulnerability
 - Scope of goods and/or services if based on U.S. Application
 - Inability to amend mark
 - Inability to divide application

Foreign Filing Options: Madrid and Common Foreign Convention Filings

- **Madrid Docketing Tips:**

- Be sure to docket the extension countries in a way that makes it clear that they are dependent upon the Madrid filing. THIS IS THE SINGLE BIGGEST POINT I WANT TO MAKE ON THIS TOPIC.
- You don't need to docket renewal dates in extension countries, but you do need to docket soft use deadlines.
- Some countries require Affidavits of Use, so make sure these are docketed as well.
- If you receive a "ceasing of effect" notification, be sure you docket it as well as the deadline to transform in each of the extension country records.

Foreign Filing Options: Madrid and Common Foreign Convention Filings

- **Europe: Filing a European Union Application (EUTM)**
 - Previously known as a CTM Application
 - One registration, 28 countries
 - No contact with individual countries
 - Cost considerations
 - Challenges to a EUTM Application or Registration
 - If protection refused or if the filing is successfully challenged, you can transform the remaining countries into national registrations
 - Confusingly similar marks do not necessarily block registration
 - Seniority Claims – if filing in the EU after registration in a member state

Foreign Filing Options: Madrid and Common Convention Filings

- **EUTM Docketing Tips:**

- The EUTM covers all the countries in the EU, with no variance. It's all of them or none of them so separate country records should not be docketed.
- If the application fails, or if it is successfully challenged, make sure to docket the conversion deadline.

Foreign Filing Options: Madrid and Common Convention Filings

- **Filing Under the Andean Pact**
 - Agreement among the member countries
 - Bolivia
 - Colombia
 - Ecuador
 - Peru
 - Provides for common trademark law
 - Does not provide for common trademark registration
 - Use in one country can support activities in another country

Foreign Filing Options: Madrid and Common Convention Filings

- **Docketing Tips:**

- Since the registrations are not dependent upon each other in any way, you can't really connect them to each other in docketing, unless you have a useful "related matter" option.