

THE DOCKETING EXCELLENCE™ SERIES



How Docketing Fits with Your International TM Filing Strategies



How Docketing fits with Your International TM Filing Strategies

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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 and Ancillary 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 EUTM

- **Filing Under the Madrid Protocol – The International Application**
 - Makes it possible to protect a mark in numerous countries by obtaining an international registration that has effect in each designated country
- **Filing A European Union Application (EUTM)**
 - One registration, 28 countries
 - No contact with individual countries

Foreign Filing Options: Andean Pact Considerations

- **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: Andean Pact Considerations

- **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.
- It can be helpful to enter a reminder about the Andean Pact countries at a prominent place in the record.

Foreign Filing Options: Filing an OAPI Application

- Filing an OAPI Application
 - Automatically grants protection in all organization members.
 - Currently affords protection in Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, Republic of Congo, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal, and Togo
 - Do not need to designate particular countries
 - OAPI is part of Madrid system
 - Vulnerable to cancellation if no effective use of the mark for period of 5 consecutive years

Foreign Filing Options: Filing an OAPI Application

- **Docketing Tips:**
 - Make sure your docket system's country-specific template includes all the current countries covered by the registration.
 - It might be helpful to include a list of the countries somewhere in the record for those that may not have this information at the tip of their fingers.

Foreign Filing Options: Amendments to MX Industrial Property Law

- Amendments to Mexico's Industrial Property Law with Possible Effect on Docketing
 - Declaration of Use required within 3 months from third anniversary of registration
 - No extensions and failure to file will cause registration to expire
 - Date of first use required for application even though not necessary to prosecute application or for registration
 - Closing arguments in opposition proceedings allowed within two business days from completion of proceedings

Foreign Filing Options: Amendments to MX Industrial Property Law

- Amendments to Mexico's Industrial Property Law
 - Concept of secondary meaning has been introduced
 - Examiners will be compelled to accept Consent Letter or Co-Existence Agreements
 - Grounds to object or oppose TM applications on bad faith now allowed
 - TM protection available for “plurality of operative elements and images” (essentially trade dress although not specifically called out)
 - Holographic signs, sounds and smells are now available for TM protection.

Foreign Filing Options: Amendments to MX Industrial Property Law

- **Docketing Tips:**
 - Make sure your docketing system updates the proof of use vulnerability deadline to indicate that an affidavit of use is now required. This is no longer a “soft” deadline.

Foreign Filing Options: Brexit

- **Brexit**

- EUTM Registration shall automatically become equivalent UK rights without any re-examination
- Resulting UK Registration will not be vulnerable to revocation on the ground that the corresponding EU right was not used in the UK before the end of the transition period.
 - Effectively provides a five year non-use period after the transition period
- There will be 9 month right of priority for any EUTM pending at the end of the transition period to file the same mark in UK
- There will be a transition period after the UK leaves on March 30, 2019, until December 31, 2020.

Foreign Filing Options: Brexit

- **Docketing Tips:**
 - Nothing to update at this time. Just watch your calendar and stayed tuned to your EU counsel. They are your best resource.

Foreign Filing Options: Ancillary Documents

- Ancillary Documents
 - Country-specific requirements
 - General POA versus Individual POA
 - Timing of legalization, if needed

Foreign Filing Options: Ancillary Documents

- **Docketing Tips:**
 - Status checks
 - Status checks
 - Status checks

Example Docketing Entries for Newly Filed US Trademark Application

- E-Filing Receipt Expected
 - 1 day from US filing date
- Status Check
 - 3 months from US filing date
- Foreign/Counterpart Filing in 3 months
 - 3 months from US filing date
 - Deadline type: REMINDER
- Foreign/Counterpart Filing in 2 months
 - 4 months from US filing date
- Foreign/Counterpart Filing in 1 month
 - 5 months from US filing date
- Foreign/Counterpart Filing
 - 6 months from US filing date
 - Deadline type: FINAL

Example Docketing Entries for an Application Forwarded to Associate for Filing

- Foreign/Counterpart Filing
- Foreign Associate Ack. Receipt of Instructions to File
- Foreign Agent Confirms Filing of Application
- Filing Receipt
- Application Status Check