

# 401 Protecting IP in a Global Marketplace

**Charles D. Brown**

*Patent Counsel, Division*  
QualComm Incorporated

**Scott W. Pink**

*Former Vice President and General Counsel*  
Prima Communications, Inc.

**Leslie Wheelock**

*Assistant General Counsel*  
Euronet Worldwide

## Faculty Biographies

### Charles D. Brown

Charles D. Brown is division patent counsel for the CDMA (Code Division Multiple Access) Technologies business unit of QUALCOMM Incorporated in San Diego. His responsibilities include the management of four patent professionals providing patent preparation and prosecution services, both domestic and foreign, and litigation support.

Prior to joining QUALCOMM, Mr. Brown was division patent counsel for Hughes Electronics' Missile Systems Company with facilities in Tucson, Arizona, and in Canoga Park, California. During his 16 years with Hughes he provided full IP services to the Missile Systems Company including patent preparation and prosecution, both foreign and domestic, international technology licensing, government contracts and data rights, and IP due diligence for acquisitions.

Mr. Brown received his BSEE and MSEE from Loyola University of Los Angeles and graduated from Loyola Law School, Los Angeles. He is a registered patent attorney.

### Scott W. Pink

Scott W. Pink is former vice president and general counsel for Prima Communications, Inc., a worldwide publisher of computer games and other books.

He is a leading expert on intellectual property and internet law and vice chair of ACCA's Intellectual Property Committee. He is the author of the upcoming book *The Internet and E-Commerce Legal Handbook: A Clear and Concise Reference to Help You and Your Business*, to be published this fall.

Mr. Pink is a graduate of Harvard University and Harvard Law School.

### Leslie Wheelock

Leslie A. Wheelock is assistant general counsel for Euronet Worldwide. From Washington, DC, she supports Euronet's corporate headquarters in Kansas City, operational headquarters in Budapest, and software development and sales staffs stretching from Indonesia to Egypt. She spends the majority of her time on matters related to intellectual property, data protection, software licensing, and corporate transactions.

Prior to joining Euronet, Ms. Wheelock ran her own legal and management consulting firm, providing legal support and strategy consulting to telecommunications and technology businesses. Earlier, she spent four years as chief legal counsel for Concert, the joint venture of British Telecom and MCI, three years at MCI, and seven years at IBM.

Ms. Wheelock received a BA from DePauw University in Indiana, and her MBA and JD from Cornell University.

First and Foremost: Need a foreign filing license or wait 6 months. (US receiving office of PCT).

Q1. What guidance can you offer to help me decide whether my company should be filing patent applications in foreign countries?

A1. Evaluate Legal, Technical and Business considerations. Remember, the ultimate question is "Will the patent provide *effective protection* that warrants the *future cost* of obtaining and maintaining it?"

What is your objective: defensive, offensive or licensing?

Who are your competitors and where do THEY file patent applications?

Where are you likely to litigate?

Where do YOU manufacture, distribute and sell?

Where do your competitors manufacture, distribute and sell?

Can you as a foreigner expect fair treatment in the courts of that country?

Will that country allow you to take royalty earnings out of the country?

Different standards of patentability. Examination vs. registration.

Are you willing and able to spend the money necessary to enforce?

Some legal considerations regarding acquisition:

Different filing routes available?

Novelty requirement.

Inventive step.

Utility

Business method/software/medicine claims permitted?

Likelihood of opposition

Some legal considerations regarding Enforcement:

Claim construction.

Doctrine of Equivalent.

Available remedies (damages, injunction, seizure, criminal)

Discovery available?

Prerequisites? (working in country).

Compulsory license?

Some Technical Considerations:

Scope of invention (ability to design around).

Reverse engineer or independently develop?

Relation of invention to product lines and technology portfolio.

Will you be able to detect infringement? (discovery available?)

What is the lifetime of the "protected" product?

Some Business Considerations:

Patent is an intangible business asset.

Patent is an enforcement tool or a bargaining chip (horse trade)

Patent is a barrier to entry by competitors.

What is the lifetime of the "protected" product?

Length of time to prosecute application.

Q2. Are there some tried and true strategies to identify those particular countries in which I should file?

A2. Budget constraints (what will it cost?)

Bednarik's List Using Global I. P. Estimator\*, Total Projected Cost

USA	\$18,000
India	\$ 4,000
United Kingdom	\$10,000
Canada	\$ 6,000
Japan	\$23,000
Germany	\$24,000
Brazil	\$ 9,000
France	\$14,000
South Africa	\$ 6,000
Australia	\$10,000

\*Bednarik, "Planning a Global Patent Strategy to Maximize Value" JPTOS Vol. 77, No. 5, Pages 381-390 (May 1995).

The 80% rule. File in those countries whose cumulative Gross Domestic Product accounts for 80% of the world's total Gross Domestic Product. About 15 countries(?).

Different strategy/countries for each product/technology.

Checkerboard

Other Strategies.

Q3. Are there any other processes available to protect my company's patent position?

A3. Watch Services.

Opposition Proceedings.

Preferential Examination (Make Special) cost, prerequisites

Provisional Rights, prerequisites

Q4. Are there some things that I should be doing now to ensure maximum value for a foreign patent portfolio?

A4. Keep excellent, corroborated records.

No public disclosures until after the US application is filed.

Select competent and experienced patent counsel.

Prepare thorough, enabling patent applications with multiple embodiments.

Consistent patent prosecution in all countries, OR NOT!

Prune the deadwood!

Q5. Is there such a thing as a worldwide patent or do I have to file in each country?

A5. There is no worldwide patent. However,  
Patent Cooperation Treaty (PCT) -- 111 member countries, all or a selection.  
Selection can be deferred for up to 30 months  
National Phase prosecution  
Treaty "formalities", search.

NOTE: PCT provides no protection unless pursued in the individual member countries/regions, so not really an application for patent.

#### Regional Patent Offices

European Patent Office (EPO) 19 members, regional prosecution  
subject to Opposition

Eurasia 14 members

OAPI - Africa

ARIPO - Africa

#### National Patent Offices (>160 countries)

Q6. I have a pending US patent application, no foreign. My sales people are selling in listed countries. What else do I need to do to protect my IP?

A6. File foreign applications within 1 year of US filing date to retain priority date. If not within 1 year, file foreign applications prior to any public disclosure/publication of the invention.

Q7. Is there any reason to file a National Application in a country that is a member of PCT?

A7. Get a head start on prosecution, perhaps leading to a quicker grant of patent. This could be useful if you know that infringement is currently taking place and you want to move quickly, i.e., don't want to wait for the PCT processing to conclude. An advantage of a national application over an EPO application is that the national application might not be subject to the Opposition procedure. So, file the EPO application and a national application. There will come a time when the patent office will require you to elect which application to "keep", because the patent office will not grant two patents.

Q8. My client develops new applications "on the run" -- often during discussions with potential customers outside the US. Is there any way to protect my IP while I throw together a Provisional patent application in the US? Does a non-disclosure agreement help?

A8. A non-disclosure agreement is a good idea, because it would prevent the other party from "publishing" the invention, thus giving you time to prepare the US application.

Otherwise, publication before filing the US application would immediately forfeit foreign filing rights in almost all countries. But remember, an NDA is only as "good" as the integrity of the other party. If you must file a Provisional application, prepare it with care, don't throw it together. Give it careful thought. Prepare an appropriate claim set. Follow up with diligent preparation of the Standard Application. Remember, you won't get the benefit of the filing date of the Provisional unless at least one issued claim of the Standard application finds full support in the Provisional application. One additional issue, if the application (invention) is developed during discussions with potential customers, you may have joint inventorship with the potential customer, resulting in *joint ownership* of the invention with the potential customer! (unless you have an agreement to the contrary with the customer).

Q9. I have written software code that performs the functions of the business method covered in my US application. Should I copyright the code?

A9. You obtain copyrights in the code as soon as it is reduced to written (tangible) form. Should you *register* your claim to copyright? I'll shuttle that question to Scott. But I definitely recommend that your US application include claims directed to the software, and to the storage medium bearing the computer instructions (also known as Beauregard style claims).

	A	B	C	D	E	F	G	H	I	J	K	L	M	N	O	P
1	<b>A LIST / B LIST STRATEGY</b>															
2																
3																
4		C1	C2	C3	C4	C5	C6	C7	C8	C9	C10	C11	C12	C13	C14	C15
5	VIP1	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
6	VIP2	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
7	VIP3	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
8	VIP4	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
9	VIP5	X	X	X	X	X	X	X	X	X	X	X	X	X	X	X
10	IP6	X	X	X	X	X	X	X	X							
11	IP7	X	X	X	X	X	X	X	X							
12	IP8	X	X	X	X	X	X	X	X							
13	IP9	X	X	X	X	X	X	X	X							
14	IP10	X	X	X	X	X	X	X	X							
15	P11							X								
16	P12	X		X					X							
17	P13						X									
18	P14			X							X					
19	P15				X					X						
20																
21		VIP = VERY IMPORTANT PATENT														
22		IP = IMPORTANT PATENT														
23		P = NOT IMPORTANT														
24																
25		C1 - C15 = COUNTRIES 1 TO 15														
26		C1 - C15 = A LIST														
27		C1 - C8 = B LIST														
28																
29		IF WE ASSUME \$8,000 PER X, THIS REPRESENTS \$992,000														
30		DUPLICATE THIS STRATEGY FOR EACH PRODUCT/TECHNOLOGY														

	A	B	C	D	E	F	G	H	I	J	K	L	M	N	O	P
1	<b>CHECKERBOARD STRATEGY</b>															
2																
3																
4		C1	C2	C3	C4	C5	C6	C7	C8	C9	C10	C11	C12	C13	C14	C15
5	VIP1	X	X	X	X	X										
6	VIP2						X	X	X	X	X					
7	VIP3											X	X	X	X	X
8	VIP4	X	X	X	X	X										
9	VIP5						X	X	X	X	X					
10	IP1	X	X	X												
11	IP2				X	X	X									
12	IP3							X	X	X						
13	IP4	X	X	X												
14	IP5				X	X	X									
15	P1					X					X					
16	P2	X						X								
17	P3			X									X			
18	P4		X													
19	P5						X			X						
20																
21		VIP = VERY IMPORTANT PATENT														
22		IP = IMPORTANT PATENT														
23		P = NOT IMPORTANT														
24																
25		C1 - C15 = COUNTRIES 1 TO 15														
26		C1 - C15 = A LIST														
27		C1 - C9 = B LIST														
28																
29		AGAIN, ASSUME \$8000 PER X, THE ABOVE STRATEGY THEN RESULTS IN A COST OF \$392,000														
30		AGAIN, DUPLICATE THE STRATEGY FOR EACH PRODUCT/TECHNOLOGY														



## ACCA ANNUAL MEETING – OCTOBER 2001 Protecting IP in a Global Marketplace

By Scott W. Pink

Copyright 2001 Scott W. Pink. All rights reserved.

### I. What is the scope of international copyright protection for U.S. works?

There is no such thing as an "international" copyright. Copyright protection for works depends on the individual laws of each country. However, most countries are members of international treaty organizations, which require that member countries accord foreign works a certain minimum set of copyright protections. These international treaties mean that most U.S. works will receive some form of copyright protection internationally. While a discussion of copyright protections in each foreign country is beyond the scope of this paper, I will discuss some of the key international treaties.

#### A. Berne Convention

The Berne Convention is the primary international copyright treaty with 77 member countries. The governing principle is that of "national treatment." In other words, authors should enjoy in other countries the same protection for their works as those countries provide their own authors. A country cannot discriminate against foreign copyright holders by providing protection to its nationals and not to foreigners. However, a country could provide less protection to its own nationals than it does to foreigners.

The Berne Convention defines copyrightable subject matter to include "literary and artistic works." Such works are further defined as including "every production in the literary, scientific, and artistic domain, whatever may be the mode or form of its expression, such as books, pamphlets and other writings. This broad description gives

each country some discretion in determining whether particular works are protected. For instance, there is wide variation among nations in the scope of protection given to computer software.

The Berne Convention prescribes a number of "minimum standards" to which all countries must adhere:

1. It dispenses with formalities for copyright protection, stating that compliance with statutory or other formalities shall not be a prerequisite to such protection. Thus, no country can require a foreign copyright holder to have filed a copyright registration or have placed a copyright notice on a work to obtain copyright protection in that country.
2. It requires each member nation to provide a minimum term of protection of the life of the author plus 50 years.
3. It requires each member nation to provide for seizure as a remedy.
4. It requires each member nation to give the author of a copyrighted work certain exclusive rights, including the right to copy, distribute and perform the work.

The Berne Convention includes most of our trading partners. The United States did not become a member of the Berne Convention until 1988 because of its desire to retain the requirement of a copyright notice. However, with the Berne Convention Implementation Act of 1998, the United States finally dispensed with all formalities for copyright protection.

If you are trading in a Berne Convention country, a U.S. work will receive the same copyright protection as indigenous works. However, it is advisable to consult the individual laws of that country because certain works may not be protected under

copyright or there may be broader fair use rights. If you are trading in a country that is not a party to the Berne Convention, then you run the risk that you copyrighted materials will not receive any protection.

### **B. The Universal Copyright Convention**

The Universal Copyright Convention (U.C.C.) is an alternative copyright treaty to the Berne Convention, with 80 signatory countries. Like Berne, it sets certain minimum (albeit lower) standards of protection in all member countries and implemented the doctrine of national treatment. The main difference from Berne is that the U.C.C. allows its member countries to condition copyright protection on the use of a prescribed copyright notice. Given the adoption of Berne by the U.S., however, the U.C.C. clearly has taken a back seat to Berne.

### **C. The WIPO Copyright Treaty**

In December 1996, the contracting parties of World Intellectual Property Organization (WIPO) entered into two treaties that were designed to adapt copyright law to the digital age: the WIPO Copyright Treaty (Copyright Treaty) and the WIPO Performances and Phonograms Treaty (Phonogram Treaty). Both of these treaties were ratified by the U.S. Senate in 1998 and enacted into U.S. law under Title I of the Digital Millennium Copyright Act. The key provisions of these treaties are:

- They provide an exclusive right to authors, performers and producers of phonograms (sound recordings) to authorize their works to be made available by wire or wireless means. This language is broad enough to cover interactive Internet communications.
- They recognize for the first time the copyright in United States sound recordings by providing the owner of such copyright the exclusive right to distribute such works digitally via computer networks. It also grants a minimum 50-year copyright term for such works.
- It recognizes that the mere provision of facilities for transmission of communications does not in and of itself give rise to copyright liability, thus giving some measure of immunity to Internet Service Providers.

## **D. The TRIPS Agreement**

The TRIPS (Trade-Related Aspects of Intellectual Property Rights) agreement went into force on January 1, 1996. It reinforces a number of concepts in Berne, such as minimum standards of protection and national treatment. It clarifies that copyright protects expression and not ideas. It also requires certain additional copyright protections such as:

- Computer programs are protected as literary works, regardless of whether the programs are in source code or object code and authors of such works shall have the right to control their rental;
- The selection or arrangement of databases shall be protected as an independent copyrighted work, even if the underlying data is not protected;
- The minimum copyright term for works not based on the life of the author shall be 50 years from publication or 50 years from creation for unpublished works; and
- Performers shall have the right to prevent bootlegging of their performances and producers of phonograms shall have the exclusive reproduction and rental right in those phonograms.

## **II. What steps do I have to take to obtaining and protecting copyrights outside the United States?**

As a result of the Berne Convention, in nearly all countries, copyright itself does not depend on official procedures or formalities. A created work is considered protected by copyright as soon as it exists. With relatively few exceptions, you do not need to either register the work or put a copyright notice on the work in order to obtain copyright protection.

However, many countries have a national copyright office. In some countries, the registration of works can have certain benefits, such as identifying and distinguishing titles of works or giving registered works certain evidentiary presumptions:

- In the United States, you cannot sue for infringement of a U.S. work unless you have first registered the copyright with the Copyright Office (this

requirement does not apply, however, to foreign works created in Berne Convention countries).

- In Japan, registration can create a rebuttable presumption that the work was created on the date declared in the application, but the work must be registered within six months of its creation.
- In Canada, registration serves as evidence that copyright exists in the work and that the person registered is the copyright owner. The certificate can be used in court to establish ownership.
- In Venezuela, unless a U.S. author has already registered its software in the U.S. Copyright Office, when the author seeks to register its copyright in Venezuela (which one might do to prove originality for purposes of possible litigation in Venezuela), the author must also file assignments from each person who worked on the software.

A copyright notice is no longer required for copyright protection, except in a very few countries. However, it is still advisable to put a copyright notice on every work as follows:

© [date of publication][name of copyright owner]. All rights reserved.<sup>1</sup>

Such a notice can be a deterrent to piracy and can be used to defeat claims of innocent infringement.

### **III. Are there significant differences in copyright protection between the United States and foreign countries?**

The basic protections of copyright law are similar in many of the Berne Convention countries. The original creators of works protected by copyright hold the exclusive right to use or authorize others to use the work on agreed terms. The creator of a work can prohibit or authorize:

- its reproduction in various forms, such as printed publication or sound recording;
- its public performance, as in a play or musical work;
- recordings of it, for example, in the form of compact discs, cassettes or videotapes;

- its broadcasting, by radio, cable or satellite;
- its translation into other languages, or its adaptation, such as a novel into a screenplay.

These economic rights have a minimum time limit of 50 years after the creator's death.

However, many countries offer longer copyright terms.

One of the biggest differences between U.S. law and foreign copyright laws concerns moral rights. Moral rights, as reflected in Article *6bis* of the Berne Convention, include the right of an author to be named as the author of a work and the right to object to uses of the work which could bring dishonor or discredit on the author's reputation. Often, in civil law systems, moral rights reflect a part of the author's personality and are non-transferable, and may be not waivable. Moral rights are not recognized in the United States to the same extent as in Europe and other foreign countries.

Another concept is "related" or "neighboring" rights. Related rights developed *around* copyrighted works, and provide similar, although often more limited and of shorter duration, rights to:

- performing artists (such as actors and musicians) in their performances;
- producers of sound recordings (for example, cassette recordings and compact discs) in their recordings;
- broadcasting organizations in their radio and television programs.

Another significant difference is database protection. Under the U.S. Supreme Court decision in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1992), the factual information in a database is not protected by copyright law; only an original selection and arrangement of factual information is protected. This differs from

European law, which recognizes *sui generis* protections for databases. In 1996, the European Union passed the Database Directive of 1996, which extends protection to the database itself, regardless of whether there was any creativity in the selection or arrangement. A database is protected where there has been "qualitatively and/or quantitatively a substantial investment in either the obtaining, verification or presentation of the contents." This is basically the "sweat of the brow" doctrine that was rejected by the U.S. Supreme Court in the *Feist* case.

The EU database directive prevents (a) the unauthorized extraction and/or reutilization of the whole or a substantial part, evaluated qualitatively and/or quantitatively, of the contents of the database and (b) the repeated extractions and/or utilizations of insubstantial parts of the database. This *sui generis* protection lasts for a period of 15 years from completion of the database. The EU is supposed to reexamine this protection in 2001.

You will want to be careful not to extract and/or utilize information from European databases because of the risk of liability under this Directive. If you do decide to use such databases, you should carefully review the Directive and whether your proposed use does not conflict with the extraction and utilization right or might qualify as a fair use. Ironically, you may be better off using databases in the United States for sources of factual information (provided you do not copy any copyrightable selection, organization and arrangement) since the copyright protections are more limited than the *sui generis* protections of the Directive.

**IV. What practical problems will I face enforcing copyrights internationally?**

The most daunting challenge for copyright owners, particularly with the development of the Internet and digital technology, is detecting and preventing piracy. The problem of piracy has long been associated with developing countries. Countries such as Thailand, Malaysia, India, Taiwan, Indonesia, and the People's Republic of China have had a particularly high rate of piracy over the years and have been charged with lax enforcement of copyright laws. The problem is not limited to the Third World, however. Software piracy is also rampant in many Western countries. Indeed the estimated annual loss due to software piracy in all of Western Europe is in the billions of dollars each year. Most of these losses are borne by American companies.

An anti-piracy program should involve consideration of the following issues:

**A. Understanding the laws of the jurisdictions in which you do business.** As noted above, international copyright treaties are very helpful in providing certain minimum levels of protection for U.S. works. However, before you initiate any enforcement action in any particular country, you should first consult a local expert in copyright law to determine the scope of copyright protection for the work in question. As noted above, Berne allows individual countries some discretion in what kinds of works they consider protected by copyright law. You will also want to understand the viability of enforcement actions. In certain countries it is very difficult to obtain injunctive relief or damages.



**B. Catching the pirates.** Once you have an understanding of the copyright laws of the subject country, the next step is figuring out how to prevent infringement and catch the pirates in that country. A variety of measures can be used:

- Develop technological means for detecting pirated materials. This may include special stamps and other identifying markers, including digital markers, that can be used to distinguish authentic copies for pirated copies.
- Require your local distributors and licensees to report incidents of infringement. If your local distributor is trustworthy, they can be very useful sources of information.
- Hire local investigators in potential problem areas to conduct checks of local stores and other outlets for pirated materials.
- Routinely police the Internet for piracy and infringement. You can monitor your licensees, Usenet groups, and listservs. You can also use search engines to locate violations (e.g. by using key words like "free", "hack" , "warez" ).
- Join trade associations, such as the Software Publishers Association or the Business Software Alliance, which have substantial budgets to fight piracy worldwide.

**C. Technical Solutions.** In our digital age, technical solutions have taken on increasing importance. The movie companies use heat stamps or laser stamps to differentiate legitimate from pirated videotapes. In the software industry, encryption, copy-protection and other security devices can be used to prevent others from copying or reverse-engineering the technology. Some examples of digital security include:

- Sealed Content. This is content that can only be opened by an authentic unique token. One weakness of this technology is that once the content is opened, it can be copied and passed along.
- Device Binding. This is where the key for decrypting is tied to a specific computer's CPU. With this system, the content can only be read by an authorized user of that particular computer.
- Trusted Player. This is used for electronic books. A key specific to a "reader" is embedded in the content. The content can only be opened by the reader with the correct key.
- Trusted Device. This is a means to fight video and audio piracy. A certain mask or code must be detected by the playback device before the CD can be played. This is designed to ensure that only authentic CDs can be played.
- Digital Rights Management. These are software systems that can track both the usage of digital content and payment for that usage.

## **D. Trade Regulation and Sanctions**

### **1. "Special 301"**

Another method of preventing foreign piracy of intellectual property is through unilateral trade actions by the United States government against foreign countries with the most flagrant violations of intellectual property rights. One of the most valuable tools for restraining piracy is "Special 301", a provision of the Omnibus Trade and Competitiveness Act of 1988.

Under "Special 301," the U.S. Trade Representative determines whether any act, policy or practice of a foreign country is violating the rights of the United States under any trade agreement or whether such act, policy or practice burdens or restricts U.S. commerce. If the foreign country refuses to cooperate in eliminating or phasing out the offending act, policy or practice, the U.S. Trade Representative has broad authority to impose duties or other import restrictions on the goods and/or services of a foreign country. The Trade Representative is authorized to take action such that the goods or services of the foreign country are affected in an amount equivalent in value to the burden or restriction being improperly imposed by the foreign jurisdiction on United States commerce.

The U.S. Trade Representative conducts investigations of potential violations on its own accord and in response to petitions. Any individual may file a petition with the Trade Representative requesting that action be taken under "Special 301." Under the statutory scheme, the Trade Representative is required to respond to a petition within 45 days with a decision as to whether or not an investigation will be conducted. If the Trade Representative decides to initiate the investigation, the Trade Representative must

publish a summary of the petition in the Federal Register and hold a public hearing concerning the issues presented by the petition.

## **2. The Watch Lists**

Special 301 requires the U.S. Trade Representative to identify which countries have inadequate or ineffective protection of intellectual property rights. These countries are placed in one of three categories based on the nature and extent of the violations. First, the U.S. Trade Representative determines which countries have the most egregious practices and the greatest negative impact on American goods. These countries are designated "priority foreign countries." In 2001, the U.S. Trade Representative identified the Ukraine as a "priority foreign country." China and Paraguay are also under special investigation.

Second, the U.S. Trade Representative places some countries on its "Priority Watch List." This is for countries that have inadequate intellectual property protection and a potential for being placed on the "priority foreign country" list. The countries listed on the Priority Watch List as of 2001 are Argentina, Costa Rica, Dominican Republic, European Union, Hungary, India, Indonesia, Israel, Korea, Lebanon, Malaysia, Philippines, Russia, and Taiwan.

Third, the U.S. Trade Representatives places some countries on a "Watch List". This list is for countries with certain specific deficiencies in intellectual property protection, but not as great a problem as priority watch list countries. It currently includes Armenia, Belarus, Bolivia, Brazil, Canada, Chile, Colombia, Greece, Guatemala, Italy, Jamaica, Kazakhstan, Kuwait, Latvia, Macau, New Zealand, Pakistan, Peru, Poland,

Romania, Saudi Arabia, Slovakia, Tajikistan, Thailand, Turkey, Turkmenistan, United Arab Emirates, Uzbekistan, Venezuela, and Vietnam.

#### **E. Litigation in Foreign Jurisdiction**

Suing in a foreign country may be the only truly effective remedy for an American company faced with a large-scale piracy problem. Most countries provide for both civil and criminal remedies in cases of copyright infringement. By and large, civil actions are prosecuted by the copyright holder in civil courts, and criminal actions are prosecuted by the governmental authorities.

The viability of bringing legal action will depend in large part on the particular country's attitude toward infringement of copyright laws. It is critical to understand whether injunctive relief is likely to be obtained and in what time frame. Obviously, countries on the U.S. Trade Representative's Priority Watch List would be countries with lax enforcement of copyright and may be difficult places to file a copyright lawsuit. You will need to consult with competent local counsel to determine the viability of an enforcement proceeding.

#### **F. Suing for Foreign Piracy in the United States.**

##### **1. Liability Under the U.S. Copyright Act**

If a pirate's acts of infringement occur on foreign soil, can the pirate be found liable under the U.S. Copyright Act? Generally, American copyright law has no extraterritorial effect and cannot be applied to secure relief for acts of infringement occurring outside the United States. U.S. copyright law has been held to apply in the following two scenarios: (1) if part of an act of infringement occurs within the United States, but the act is completed in a foreign jurisdiction, or (b) if the act of infringement is

commenced outside the United States, but is completed here.<sup>2</sup> For example, a foreign web site that transmits infringing material to web surfers located in the United States could be sued for violation of U.S. copyright law. U.S. law does not apply, however, if the infringement was merely authorized in the U.S., but no act of infringement occurred here. Thus, sending an e-mail authorizing the manufacture of infringing material outside the United States would not implicate U.S. copyright law.

## **2. Liability Under Foreign Copyright Laws in a U.S. Court**

Can an action be brought in a U.S. court for infringement of a foreign copyright law? It is unclear the extent to which U.S. courts have authority to exercise jurisdiction over claims based on foreign copyright laws, and conflicting views have been expressed in district court opinions. You face several hurdles in bringing suit in the United States. First, you must show enough contacts with the U.S. for a court to exercise personal jurisdiction over the foreign defendant. Second, you must demonstrate to the court that it will not violate principles of international comity for a U.S. court to decide a dispute involving foreign law. Third, you will have difficulty enforcing the judgment of the court if the defendant does not have any assets or operations here.

---

1 The "All Rights Reserved" language derives from a minor copyright treaty called the Buenos Aires Convention. Although it is probably unnecessary except in a few South American countries, it is still standard practice to include the language after the copyright notice.

2 For an excellent discussion of the territorial limitations of the U.S. copyright laws, see 4 *Nimmer on Copyright* §17.02 (New York: Matthew Bender 2000).

# INTERNATIONAL TRADEMARK PRACTICE

A COMPARISON OF THE REGULATIONS APPLICABLE TO  
REGISTRATION OF TRADEMARKS UNDER THE MADRID  
SYSTEM AND THE EUROPEAN UNION

LESLIE WHEELock

October 2001

The following text is designed to provide a summary of the regulations governing the trademark application processes for an International Trade Mark under the Madrid System and a Community Trade Mark in the European Union.

With the introduction of The Madrid Protocol Implementation Act in the 107<sup>th</sup> Congress, U.S. trademark counsel should note the potential importance of the Madrid Protocol with respect to protecting their mark domestically and filing for protection internationally. The Madrid Protocol Implementation Act was placed on the U.S. Senate Legislative Calendar under General Orders on July 25, 2001. The Committee on the Judiciary written report is No. 107-46.

## THE MADRID SYSTEM

The Madrid system of international registration of marks is governed by two treaties: the Madrid Agreement Concerning the International Registration of Marks (1891), and the Protocol Relating to the Madrid Agreement (1996). The system is administered by the International Bureau of the World Intellectual Property Organization (WIPO) in Geneva, Switzerland. Signatories to either of the treaties are designated as "**Contracting Parties**". A list of the Contracting Parties to the Agreement and the Protocol is appended to this document. Together the Contracting Parties constitute the Madrid Union, which is classified as a Special Union under Article 19 of the Paris Convention.

The Madrid system of international registration of marks may be used only by someone who:

- n has a real and effective industrial or commercial establishment in, or
- n is domiciled in, or
- n is a national of

a country which is a member of the Madrid Union (a party of the Madrid Protocol or Madrid Agreement). The country in which a person fulfills one or more of the above conditions is referred to as the "**Country of Origin**". A mark may be the subject of an international registration only if it has already been registered (or, where the international application is governed exclusively by the Protocol, if registration has been applied for) in the Country of Origin.

An international application must be based on a national trademark registration or application in the Country of Origin. The applicant must designate in the application the Contracting Parties (not the Country of Origin) in which the registration should be valid. Each designated country has 12 to 18 months to approve the registration or not. Additional Contracting Parties may be designated subsequently.

## A Comparison between the Madrid Agreement and the Madrid Protocol

The Madrid Protocol was adopted in 1989 in order to remove the difficulties that prevented certain countries from becoming signatories to the Madrid Agreement. As compared with the Madrid Agreement, the Protocol introduces the following main innovations:

- n the applicant may base his application for international registration on an application filed with the Office of Origin; under the Agreement, an international application must be based on a registration in the Office of Origin;
- n each designated country in which the applicant seeks protection may elect a period of 18 months (instead of one year), and an even longer period in the case of opposition, to declare that protection cannot be granted to the mark in its territory;
- n the local trademark office of each Contracting Party may receive higher fees than under the Madrid Agreement (that the applicant is required to pay in addition to the application fee for countries designated in the application);
- n an international registration which is cancelled at the request of the Office of origin (for example because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration), may be transformed into national (or regional) applications in the respective designated countries in which the international registration had effect, with each application benefiting from the date of the international registration and, where applicable, its priority date (a possibility which does not exist under the Madrid Agreement).

Furthermore, the Protocol will make possible the establishment of links with the trademark system of the European Community. Once the European Community is party to the Protocol, it will be possible for an application for international registration under the Protocol to be based on an application filed with, or a registration effected by, the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of the European Community, and it will be possible to obtain the effects of a European Community registration by designating the European Community under the Protocol in an international application or subsequent to the international registration.

## The Applications

The Madrid Agreement and the Madrid Protocol are parallel but independent treaties, with different but overlapping membership. As a result, there are three kinds of international applications. An international application may be governed exclusively by the Agreement, governed exclusively by the Protocol, or governed by both the Agreement and the Protocol. The determination of the governing procedure depends on which treaty or treaties (Agreement or Protocol) are



applicable to, on the one hand, the Office of Origin and, on the other hand, the Contracting Parties designated in the application.

## 1. Determining the applicable regulations

### a. The international application is governed exclusively by the Agreement if:

- n the Office of Origin is the Office of a Contracting Party bound only by the Agreement, or
- n the Office of Origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and the applicant has designated only Contracting Parties which are bound by the Agreement (even if some of them are also bound by the Protocol).

### b. The international application is governed exclusively by the Protocol if:

- n the Office of Origin is the Office of a Contracting Party bound only by the Protocol, or
- n the Office of Origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and the applicant has designated no Contracting Party which is bound by the Agreement

### c. The international application is governed by both the Agreement and the Protocol if:

- n the Office of Origin is the Office of a Contracting Party bound by both the Agreement and the Protocol, and
- n the applicant has designated at least one Contracting Party bound by the Agreement (whether or not it is also bound by the Protocol) and at least one Contracting Party bound only by the Protocol.

## 2. The differences in the applications

### a. An international application governed exclusively by the Agreement:

- n must be based on a registration of the mark in the Country of Origin;
- n must be filed on form MM1;
- n must be in French; and
- n the applicant's Country of Origin is determined by the so-called "cascade"; that is:
  - it is the country party to the Agreement in which he has a real and effective industrial or commercial establishment, or

if he has no such establishment in a country party to the Agreement, it is the country party to the Agreement in which he has his domicile, or  
 if he has neither an establishment or a domicile in a country party to the Agreement, it is the country party to the Agreement of which he is a national.

**b. An international application governed exclusively by the Protocol:**

- n may be based on either a registration or an application for registration of the mark in the Country of Origin;
- n must be filed on form MM2
- n may be in either English or French (the Office of Origin may, however, restrict the applicant's choice to one of these languages); and
- n the applicant's Country of Origin is defined as any country party to the Protocol in which the applicant has a real and effective industrial or commercial establishment or domicile, or of which the applicant is a national (the cascade does not apply).

**c. An international application governed by both the Agreement and the Protocol:**

- n must be based on a registration of the mark in the Country of Origin;
- n must be filed on form MM3
- n may be in either English or French (subject to any restriction by the Office of Origin); and
- n the applicant's Country of Origin is determined by the cascade.

## The Application Process

The international application is subject to the payment of the following fees:

- n a basic fee;
- n a complementary fee for each designated Contracting Party for which no individual fee is payable;
- n an individual fee for any Contracting Party which is designated under the Protocol and has declared that it wishes to receive such a fee; (the amount of the individual fee is determined by each Contracting Party; it may not be higher than the amount that would be payable for the registration of a mark in the Office of that Contracting Party; the amounts of the respective individual fees are published in the Gazette);
- n a supplementary fee for each class of goods and services beyond the third; no supplementary fee is payable however where all the designations are countries to which an individual fee has to be paid.

These fees may be paid direct to the International Bureau or, where the Office of Origin collects and forwards such fees, through that Office.

The Office of Origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as a description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application.

The Office of Origin must also certify the date on which it received the request to present the international application. Provided the application is received by the International Bureau within two months of the certified date, it is that date that will be the date of the international registration.

The International Bureau checks that the international application complies with the requirements of the Agreement or Protocol and the regulations, including requirements relating to the indication of goods and services and their classification, and that the required fees have been paid. The Office of Origin and the applicant are informed of any irregularities; these must be remedied within three months, otherwise the application will be considered abandoned.

Where the international application complies with the applicable requirements, the mark is recorded in the International Register and published in the Gazette. The International Bureau then notifies each Contracting Party in which protection has been requested.

### **Registration and Term**

When the international application complies with the applicable requirements, the mark will be recorded in the International Register and will be published in the WIPO Gazette of International Marks. The international registration will bear the date on which the international application was filed with the Office of Origin, provided it has been received by the International Bureau within two months of that date; otherwise it will bear the date on which it was received by the International Bureau. An international registration is effective for a period of ten years. It may be renewed for additional periods of ten years.

### **Dependence on Basic Registration or Application**

For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the Country of Origin. If the basic registration ceases to have effect in the Country of Origin, whether through cancellation or through non-renewal, within this five-year period, the international registration will no longer be protected and may be cancelled. Similarly, where the international registration was based on an

application in the Country of Origin (under the Protocol), it will be cancelled if that application is refused or withdrawn within the five-year period, or if the registration resulting from that application ceases to have effect within that period. After the expiry of the five-year period, the international registration becomes independent of the basic registration or basic application.

### **Madrid Union - Advantages**

#### **1. Unitary Character**

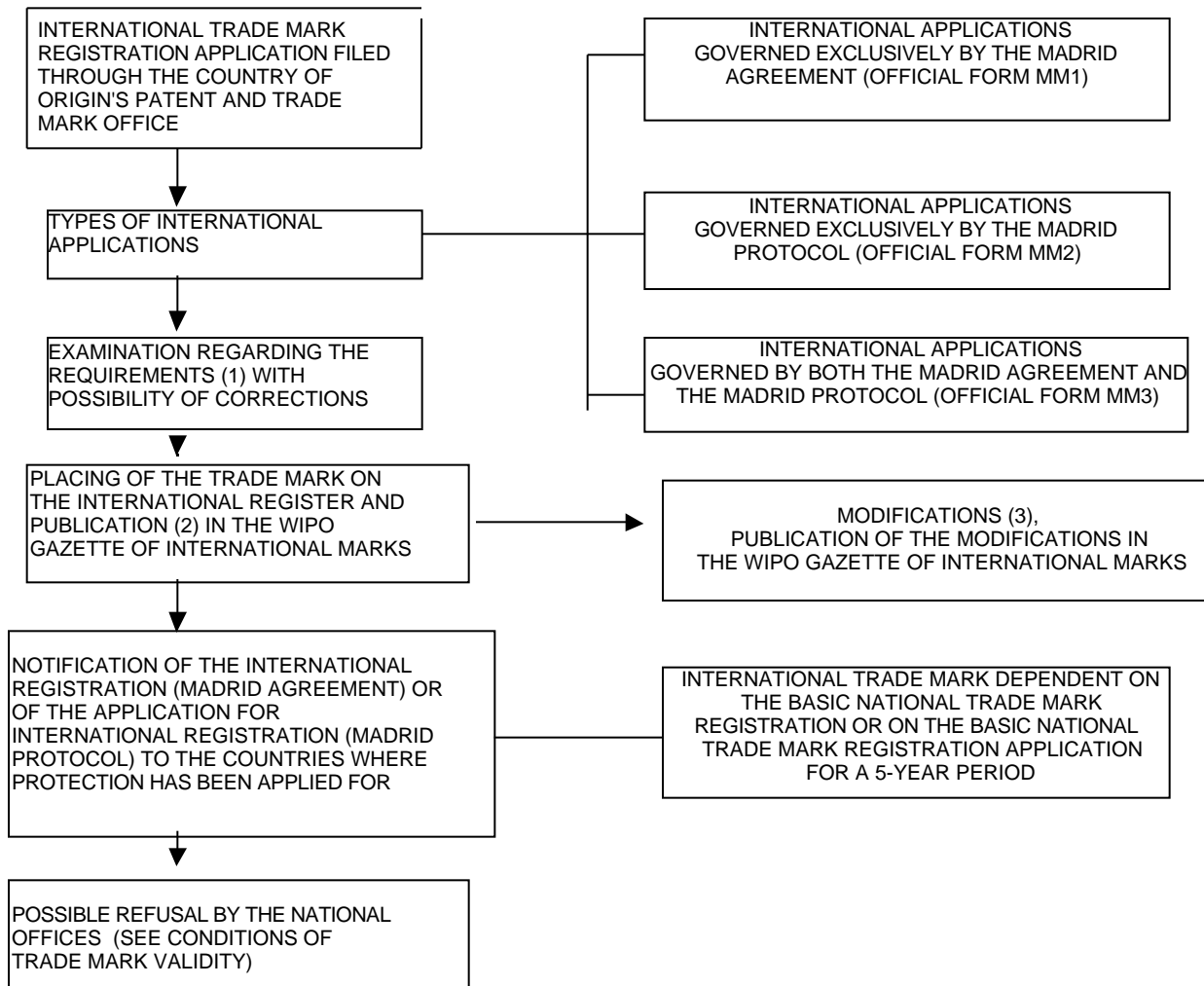
- n Same value and protection as a national registration in all designated Contracting Parties
- n one application
- n one administrative office
- n one language
- n one set of fees in one currency (Swiss Francs)
- n 12-18 months for registration refusal

### **Madrid Union - Disadvantages**

1. The Madrid system of international registration cannot be used to protect a trade mark in a country which is outside the Madrid Union.
2. The Madrid system cannot be used by a person who does not have the necessary connection, through establishment, domicile or nationality, with a country of the Madrid Union.
3. The scope of coverage of an international registration under the Protocol is tied to the scope of the home application/registration for at least the first five years. Because American trademark law requires a relatively specific identification of goods and services, the scope of the corresponding International Registration will likewise be limited.
4. Assignment is limited to a person who would be entitled to file an international application: a person who is a national or a domiciliary of, or has a real an effective industrial or commercial establishment in , a Contracting State..
5. The Madrid system utilizes the International Trademark Classification system called the Nice Agreement (7<sup>th</sup> ed. 1997), which allows for less-detailed descriptions of the goods/services than descriptions used in the US system.

### REGISTERING TRADE MARKS INTERNATIONALLY (MADRID SYSTEM)

Note: A trade mark can be registered internationally under the Madrid Agreement or Madrid Protocol only if it has been registered in its country of origin or registration has been applied for in its country of origin (if the latter is only a member of the Madrid Protocol)



#### 1. REQUIREMENTS

These vary according to the type of request (Madrid Agreement, Madrid Protocol or both). They mainly concern:

- the basis of the application (national registration, application for national registration)
- the language used in the international application
- the application form
- the designation of the country of origin

#### 2. MODIFICATIONS

Modifications can include:

- The later designation of a country
- A restriction of the classes for products or services or the designated countries referred to in the international registration
- A change of trade mark owner (partial or not, e.g. for certain product classes or product services or for some of the designated countries)
- A modification of the name or of the address of the trade mark owner or of the owner's agent

#### 3. REFUSAL PERIOD

The normal period for the notification of a refusal is 12 months. Under the terms of the Protocol and depending on the declaration of the signatory country, this period can be extended to 18 months (or more, if the refusal is based on an opposition.)

Source: www.ipr-helpdesk.com July 2001

## COMMUNITY TRADE MARKS

The Community Trade Mark registration system was enacted pursuant to the Council Regulation of the European Union on December 20, 1993 (the "Regulation"). Pursuant to the Regulation, the Office for Harmonisation in the Internal Market ("OHIM"), better known as the Community Trade Mark Office, has been operational in Alicante, Spain since April 1, 1996.

The Regulation allows any natural or legal person, national of a Member State of the European Union, of another state party to the Paris Convention or to the agreement establishing the WTO, to obtain uniform protection of a mark in the territory of all 15 Member States of the EU, by utilizing one single procedure. An applicant need not have a commercial establishment within the EU. The Community Trade Mark system is a first-to-file system. It does not replace the current national registration systems, but coexists with them.

### The Categories of Community Trade Marks

There are three types of trade marks identified for Community Trade Mark purposes (per European Council Directive No 89/104):

1. Trade marks for goods or services.

Trade marks applied by manufacturers or service providers to their goods or services.

examples: BMW, Heinz, Lego

2. Collective marks

Trade marks belonging to legal entities, associations, and so forth, which in general do not use them directly, but which protect them for use by their members according to rules of use prescribed by the trade mark owner.

example: "made in Luxembourg" (logo and word mark)

3. Guarantee or Certification marks

Trade marks affixed to goods or services which guarantee that the latter possess certain characteristics regarding their nature, properties, or qualities and their origin as specified in a use regulation.

example: "woolmark"

## Signs That Can Constitute a Community Trade Mark

Virtually all signs capable of graphical representation can be protected as a trade mark. A Community Trade Mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

## Additional Community Trade Mark Categories

Although they are not expressly mentioned, sounds, colors and odors are not completely excluded from Community trade mark protection. However, as an example of the difference in national trademark regulations that one may encounter, the recognition of "sensory" trademarks varies from country to country. For example:

- n Finland and the U.K. accept as trade marks scents, tastes and tactile trade marks.
- n Ireland accepts scents.
- n Germany accepts scents and tastes.
- n France does not accept tactile trade marks; and
- n Benelux do not yet accept the filing of sound trade marks, whereas other EU countries do.

## The Application Process

The application for a Community Trade Mark may be filed either directly with the Office for Harmonisation in the Internal Market (OHIM) or at the national trade mark offices which will transmit the application within two weeks to the OHIM. The application may be filed in any of the 11 languages of the EU (English, French, German, Italian, Spanish, Portuguese, Dutch, Danish, Swedish, Finnish, or Greek), which will be the language of the application proceedings for that particular mark; however the applicant must also designate a second language that one of the 5 official languages of the OHIM (Spanish, German, English, French or Italian), which will be used in the opposition, revocation and invalidation procedures.

The applicant for a Community trade mark may claim the seniority of a prior national trade mark application in a Member State of the EU, or in a state party to either the Paris Convention or the agreement establishing the WTO, filed less than 6 months preceding the Community application. Similarly, the proprietor of a national trade mark in a Member State of the EU may claim the seniority of the earlier trade mark application (unrestricted by timing) when filing an application or after registration of a Community Trade Mark. The filing date of the application will correspond to the time of filing of the application with the OHIM or, if applicable, to the earlier filing date of the application at the national office of a Member State.

Once the OHIM has established that the registration application is admissible, that the applicant can be the proprietor of a Community Trade Mark and that the Trade Mark can be subject to registration (including overcoming refusal on absolute grounds), the OHIM draws up a Community search report. The OHIM is responsible for the search of earlier Community Trade Marks or Community Trade Mark applications that may be in conflict with the mark in the application. Additionally, the OHIM forwards a copy of the application to the national trademark offices of all EU jurisdictions, except France, Germany, Italy and, recently, Ireland. Each national trademark office has three months to conduct a national search to identify prior conflicting domestic marks and to report back to the OHIM. The results of the Community search and the national searches are then compiled into a report and transmitted to the applicant. The applicant may choose to withdraw, limit, or amend the application based on the search report, or he may allow the application to proceed.

If the application is allowed to proceed, one month after the transmission of the search reports to the applicant, the application is published in the Community Trademark Bulletin in all 11 of the official languages of the EU. OHIM also notifies both the proprietors of Community Trade Marks and the applicants for Community Trade Marks of the publication in order to allow them to file opposition.

Any third party may file a notice of opposition or a written observation within three months after the publication of a Community Trade Mark application. Such oppositions/observations may be based on earlier national trademarks or Community Trade Marks (both, either filed or registered), proprietors of marks registered under the Madrid system, proprietors of well-known marks (as defined in the Paris Convention), and even proprietors of unregistered marks (provided the national law of the proprietor allows for such an opposition).

### **Registration and Term**

Once an application has meet all the requirements and where no notice of opposition has been given or where opposition has been rejected, the mark will be registered as a Community Trade Mark. The duration of a Community Trade Mark is ten years from the date of filing of the application, and the registration may be renewed indefinitely for further periods of 10 years.



### **Community Trade Mark - Advantages**

1. Unitary character
  - n one registration
  - n one procedure
  - n uniform protection in the 15 Member States of the European Union
  - n one administrative office
2. Granting of protection is faster than with the national procedures
3. Cost is lower than for several national registrations
4. If the Community trade mark registration fails, there remains the possibility of converting the application into national registrations.
5. The use of the trade mark in one country of the E.U. is sufficient.
6. Proceedings against counterfeiters are facilitated by the fact that the trade mark is protected uniformly in the 15 Member States; therefore, a single infringement action will be enforceable throughout the territory.
7. Access to the Community trade mark is not reserved exclusively for the nationals of the Member States, but is open to a large number of parties from third countries.
8. A Community trade mark registration does not cancel out a national trade mark registration.

### **Community Trade Mark - Disadvantages**

1. The proprietor of a similar or identical trade mark of one single Member State may file an opposition to the application of a Community trade mark, resulting in an inability to register the mark as a Community trade mark.
  2. The depositor of a Community trade mark might have increased expense and time of working through a large number of oppositions (due, in part, to the rule that the loser of an opposition pays set fees).
  3. No choice of countries is available.
  4. A Community Trade Mark may be transferred or sold throughout the Community territory only.
- 

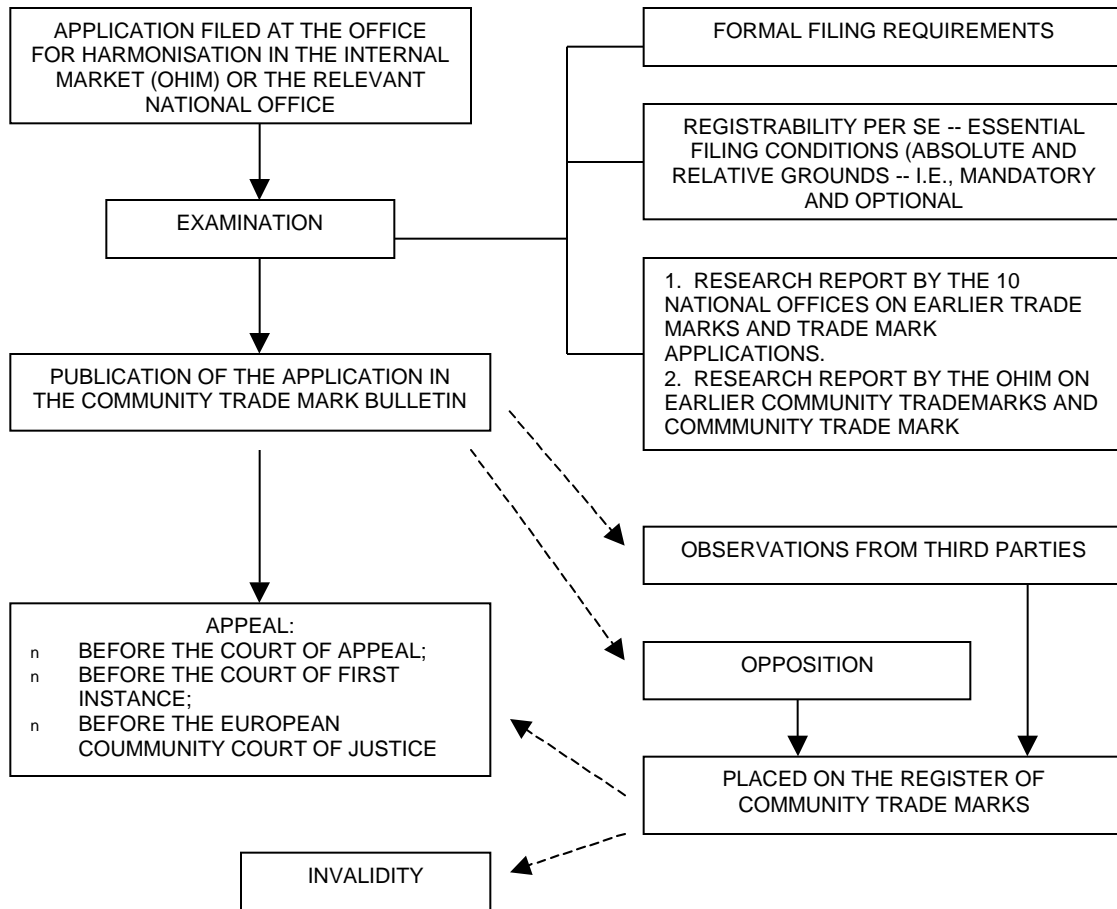
### **National Trade Marks in the Territory of the EU - Advantages**

1. Where a company is doing business in only a few of the EU countries, the costs of filing, opposition, etc. may be significantly lower for filing national marks than for filing a Community trade mark application.
2. National registration seniority may be cited to determine a priority date in the event a subsequent Community Trade Mark application is filed.

### **National Trade Marks in the Territory of the EU - Disadvantages**

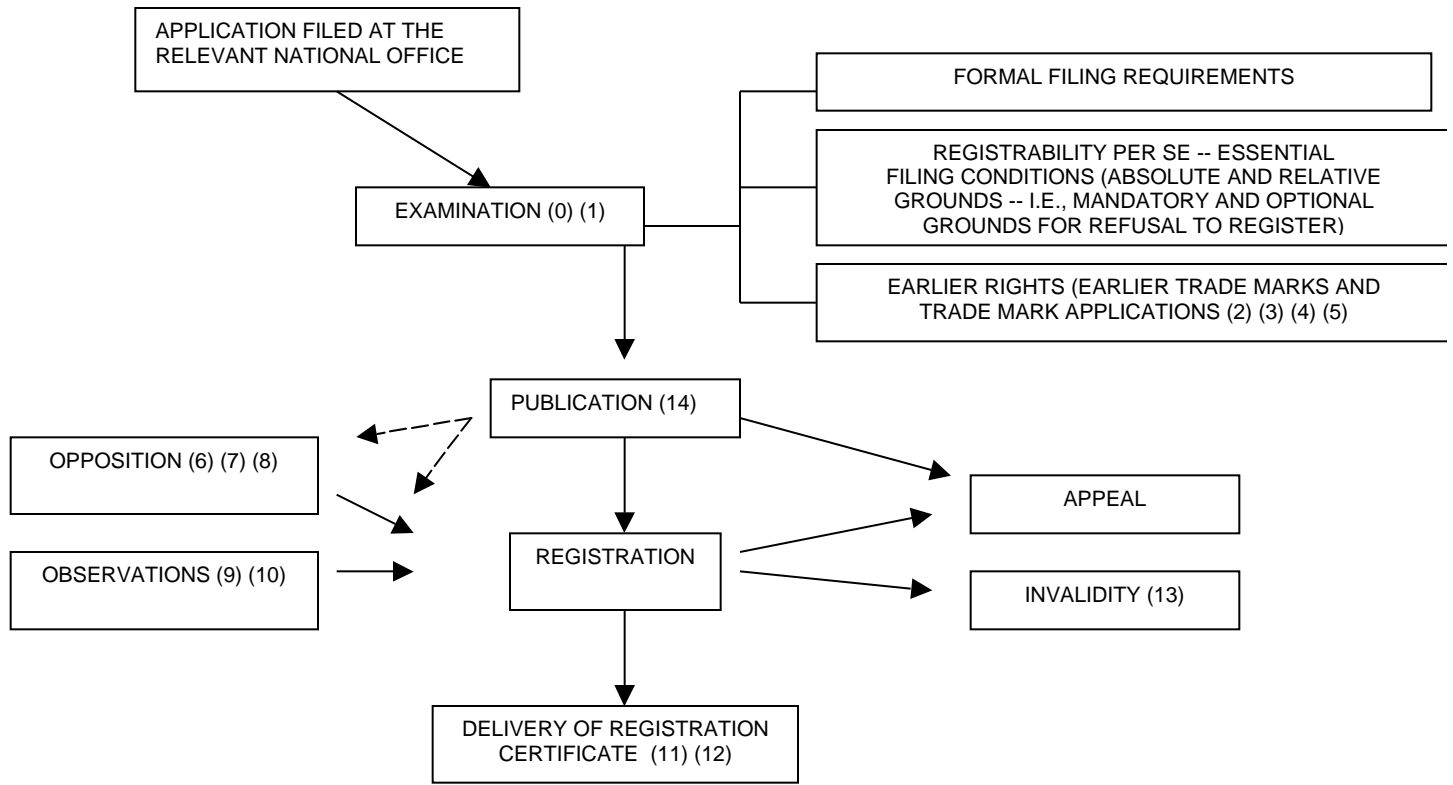
1. 13 different national laws in the Community on trade marks
  2. 13 national different national offices
  3. 13 different procedures to obtain trade marks
- note: Belgium, Luxembourg and the Netherlands have one joint office and procedure.

### OBTAINING A COMMUNITY TRADE MARK IN THE EUROPEAN UNION



Source: [www.ipr-helpdesk.com](http://www.ipr-helpdesk.com) July 2001

## REGISTERING A NATIONAL TRADE MARK IN THE EUROPEAN UNION



- (0) Accelerated Examination possible in DK.
- (1) Right to reply granted to the applicant in IE, PT, UK, DK, FI, FR
- (2) No examination for the existence of earlier trade mark applications or registrations in IT, PT, FR (no automatic examination)
- (3) In IT the examination covers conflicts with prior rights such as names, well-known trade marks, signs used in art, literature, science, politics and sports, denominations and signs. (The examination does not cover previously submitted trade marks or trade mark applications, company names or commercial names and signs.)
- (4) The examination for earlier rights is carried out after the publication of the application in ES, FR.
- (5) The examination for earlier rights is only on an informative basis in AT, BE-LU-NL. (A trade mark application is not rejected on the basis of an earlier right.)
- (6) No opposition procedure currently exists in IT, AT or BE.
- (7) Opposition procedure occurs after registration in SE, DK, FI, GR, DE.
- (8) Possible to ask for the official decision to be reconsidered in DE.
- (9) In IE and UK, third parties' comments are accepted from publication until registration.
- (10) In IT the third parties' comments can cover only formal or underlying requirements and conflicts with earlier rights such as names, well-known trade marks, signs used in art, literature, science, politics and sport, denominations and signs.
- (11) Issuing of a registration certificate in UK, GR, FR, BE-LU-NL.
- (12) Issuing and publication of the registration certificate in PT.
- (13) Trade mark invalidity procedure possible in IT, AT, BE-LU-NL.
- (14) In IT no official publication of trade marks exists on paper. Research on trade marks may be carried out in databases available at the chambers of commerce.

-----  
 AT - Austria      BE - Belgium      DE - Germany      DK - Denmark      ES - Spain      IE - Ireland      FI - Finland  
 FR - France      GR - Greece      IT - Italy      PT - Portugal      SE - Sweden      UK - United Kingdom

Source: www.ipr-helodesk.com Julv 2001

## Members of the Madrid Union & European Union

Country	Madrid Agreement	Madrid Protocol	EU
Albania	X		
Algeria	X		
Antigua & Barbuda		X	
Armenia	X	X	
Austria	X	X	X
Azerbaijan	X		
Belarus	X		
Belgium	X	X	X
Bhutan	X	X	
Bosnia-Herzegovina	X		
Bulgaria	X		
China	X	X	
Croatia	X		
Cuba	X	X	
Czech Republic	X	X	
Denmark		X	X
Egypt	X		
Estonia		X	
Finland		X	X
France	X	X	X
Georgia		X	
Germany	X	X	X
Greece		X	X
Hungary	X	X	X
Iceland		X	
Ireland			X
Italy	X	X	X
Japan		X	
Kazakhstan	X		
Kenya	X	X	
Korea, Democratic People's Republic of	X	X	
Kyrgyzstan	X		
Latvia	X	X	
Lesotho	X	X	
Liberia	X		
Liechtenstein	X	X	
Lithuania		X	
Luxembourg	X	X	X

<b>Country</b>	<b>Madrid Agreement</b>	<b>Madrid Protocol</b>	<b>EU</b>
Macedonia, Former Yugoslav Republic of	X		
Moldova, Republic of	X	X	
Monaco	X	X	
Mongolia	X		
Morocco	X	X	
Mozambique	X	X	
Netherlands	X	X	X
Norway		X	
Poland	X	X	
Portugal	X	X	X
Romania	X	X	
Russian Federation	X	X	
San Marino	X		
Sierra Leone	X	X	
Singapore		X	
Slovakia	X	X	
Slovenia	X	X	
Spain	X	X	X
Sudan	X		
Swaziland	X	X	
Sweden		X	X
Switzerland	X	X	
Tajikistan	X		
Turkey		X	
Turkmenistan		X	
Ukraine	X		
United Kingdom		X	X
Uzbekistan	X		
Vietnam	X		
Yugoslavia	X	X	

**Average costs of domestic and foreign trade mark registrations in EURO  
in 3 goods and/or service classes (black and white - registration)**

While the office fees are fixed, for the purposes of the table, an average for the lawyers' fees had to be found. In each country several lawyers' chambers were asked about their respective costing and an average was calculated. A trade mark application of customary scope and degree of difficulty was then based on this information.

	International trade mark according to the MA <sup>*</sup> (10 countries)	International trade mark according to the MP <sup>**</sup> (10 countries)		EU trade mark (Community trade mark) (15 countries)	GDR	FRA	UK	BLX	US	J
		without Japan	with Japan							
<b>Filing</b> a trade mark application at the trade mark office	1090	3506 <sup>1</sup>	6049 <sup>1</sup>	975	294	200	500	100	1150	555
	<b>1600</b>	<b>1600</b>	<b>1600</b>	<b>1000</b>	<b>550</b>	<b>430</b>	<b>920</b>	<b>400</b>	<b>450</b>	<b>2350</b>
<b>Registration</b>	--	--	--	1100	--	--	--	--	--	2160
	--	--	--	<b>550</b>	--	--	--	--	--	<b>570</b>
<b>Extension</b> after 10 years	915	3645 <sup>1</sup>	7255 <sup>1</sup>	2500	590	215	500	160	1412	4240
	<b>515</b>	<b>515</b>	<b>515</b>	<b>2500</b>	<b>260</b>	<b>374</b>	<b>920</b>	<b>300</b>	<b>450</b>	<b>610</b>
All costs up to the 1st extension	2005	7151 <sup>1</sup>	13304 <sup>1</sup>	4575	884	415	1000	260	2562	6955
	<b>2115</b>	<b>2115</b>	<b>2115</b>	<b>4050</b>	<b>810</b>	<b>804</b>	<b>1840</b>	<b>700</b>	<b>900</b>	<b>3530</b>
<b>Opposition</b> against 1 trade mark in 3 classes <sup>3</sup>	<u>2</u>	<u>2</u>	<u>2</u>	350	120	305	340	-	353	300
	-	-	-	<b>1000<sup>3</sup></b>	<b>200<sup>3</sup></b>	<b>520<sup>3</sup></b>	<b>500<sup>3</sup></b>	-	<b>412<sup>3</sup></b>	<b>7828<sup>3</sup></b>

\*Madrid Agreement on International Trade Mark Registration

\*\*Madrid Protocol on International Trade Mark Registration

In each case the **lawyer's costs (in bold type)** as well as the **office fees** are indicated.

1. This concerns maximum costs. The costs depend on the individual fees, which the each country may charge according to the Madrid Protocol.

2. Opposition must be made separately in each country. The costs and periods are calculated according to the respective national legislation.

3. Minimum costs: dependent on the amount of work done.

Source: www.ipr-helpdesk.com July 2001

## Helpful Information

### 1. **WIPO** (World Intellectual Property Organization) ("OMP" in French & Spanish)

The WIPO was established by a convention in 1967 and entered into force in 1970. It became a specialized agency of the U.N. in 1974.

The WIPO administers many international unions or treaties in areas of intellectual property, such as the Paris and Berne conventions, through the WIPO secretariat, the "International Bureau."

The WIPO administers the following treaties related to trademarks:

- The Paris Union (for the protection of industrial property), est. 1883
- The Madrid Agreement (for the repression of false or deceptive indications of source on goods), est. 1891
- The Madrid Union (for the international registration of marks; consisting of the Contracting Parties of the Madrid Agreement), est. 1891
- The Hague Union (for the international deposit of industrial designs), est. 1925
- The Nice Union (for the international classification of goods and services for the purposes of the registration of marks), est. 1957
- The Lisbon Union (for the protection of appellations of origin and their international registration), est. 1958
- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, est. 1989
- The Trademark Law Treaty (for the simplification of formalities before trademark registries), est. 1994
- The WIPO-WTO Agreement that provides for cooperation between the two organizations (recognizing that the WTO is not a member of the U.N. system of organizations)

### 2. **TRIPS** (Trade-Related Aspects of Intellectual Property Rights)

The 1986-94 Uruguay Round resulted in the WTO's TRIPS Agreement providing a dispute settlement system under the WTO for trade disputes over intellectual property rights.

Starting with the agreements in effect under the WIPO, TRIPS also seeks to harmonize world trade mark practice.

## USEFUL WEBSITE ADDRESSES

### **WWW.IPR-HELPDESK.COM**

Useful information on international intellectual property regulations, practices and procedures.

### **WWW.EURUNION.ORG**

Site of the Delegation of the European Commission to the United States.

### **WWW.WTO.ORG**

Site of the World Trade Organization.

Includes information on TRIPS and related conventions, unions and treaties.

### **WWW.JUS.UIO.NO/LM/WIPO.DOC.HTML**

General Information on the WIPO

### **WWW.WIPO.ORG**

World Intellectual Property Organization site, providing information on

- The Paris Convention for the Protection of Industrial Property (1883)
- Trade-Related Aspects of Intellectual Property Rights ("TRIPS") (1996)
- (est. 1986-94 Uruguay Round)
- Patent Cooperation Treaty ("PCT") (1970)
- The Madrid System of International Registration of Marks
- Fees for filing, both basic and Country-by-country
- a spreadsheet for determining total fees applicable to an application
- annual statistics relating to international registrations
- under the heading Madrid Express, data concerning international applications, international registrations and subsequent designations not yet *published* in the *WIPO Gazette of International Marks*.

### **WWW.LEXMERCATORIA.ORG**

### **WWW.USPTO.ORG**