

# Global Intellectual Property Protection for U.S. Exporters

**Thank you for joining us today.**

- All participants will be muted for the duration of the webinar.
- Please submit your questions using the Q&A function. Questions will be answered at the end of the presentation.
- This webinar is being recorded. A link to the recording and the presentation will be emailed to all attendees within a few days after the program.



# Massachusetts Export Center

Export Guidance & Technical Assistance | International Business Development | Export Training

*October 16*

**Recent Changes to the Foreign Produced Direct Product Rule: Implications for Huawei and Beyond** (webinar)

*October 23*

**Best Practices for End Use & End User Due Diligence** (webinar)

**Global Marketing and Sales Series:  
Information You Need to Market in a Global Pandemic**  
*Three Part Series*

*November 4*

**Drive Inbound Global Sales** (webinar)

*November 12*

**Reach Global Markets Through Social Media and Creative Content Development** (webinar)

*November 19*

**Global Privacy, Cybersecurity and Data Protection Laws** (webinar)



January 14 & 15 | Export Expo (virtual)

[www.mass.gov/export](http://www.mass.gov/export)

# Today's Speakers



**Susan Anthony**

Attorney-Advisor

Office of Policy and International Affairs

U.S. Patent and Trademark Office

**Harry Kim**

Special Program Examiner

International Patent Legal Administration

U.S. Patent and Trademark Office

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **Pursuing patent protection abroad: Including the Patent Cooperation Treaty and the Hague System for Industrial Designs**

**Harry Kim**

Special Program Examiner

International Patent Legal Administration

October 2020

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# What is a patent?

- **Property right**

- Right to exclude others from making, using, selling, offering for sale or importing the claimed invention
- Limited term
- Territorial – protection only where patent granted

- **Exchange**

- Inventor discloses the invention in exchange for the opportunity to receive the patent grant and its associated rights

# Who grants patents?

- National patent offices

- E.g., U.S. Patent and Trademark Office (USPTO), Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO)

- Regional patent offices

- Grants patents with effect in some or all member countries
  - European Patent Office (EPO)
  - Eurasian Patent Organization (EAPO)
  - African Regional Intellectual Property Organization (ARIPO)
  - African Intellectual Property Organization (OAPI)
  - Patent Office of the Cooperation Council for the Arab States of the Gulf (GCC Patent office)



# Types of U.S. patents

- **Utility**
  - Inventions
  - 20 year term from filing date
- **Design**
  - Ornamental design described and shown
  - 15-year term from grant date (For applications filed on or after May 13, 2015)
- **Plant**
  - New variety of asexually reproduced plant
  - 20 year term from filing date



# Where to patent?

- Patent rights are territorial.
  - Protection against infringing activities only within the country or region in which patent was granted
- There is no worldwide patent.
  - Must apply for and be granted a patent in each country or region of interest
- Patent protection can be an important part of overall global business strategy.

# Where to patent:

## Patent law considerations

- Standards of patentability in country/region
  - Patentable subject matter differences
  - Prior art differences
    - Grace period
  - Some countries have only a registration system.
    - No substantive examination
- Types of protection differ
  - Patent, inventor's certificate, utility certificate, utility model, petty patent, patent of addition, certificate of addition, inventor's certificate of addition, utility certificate of addition, industrial design

# Grace period

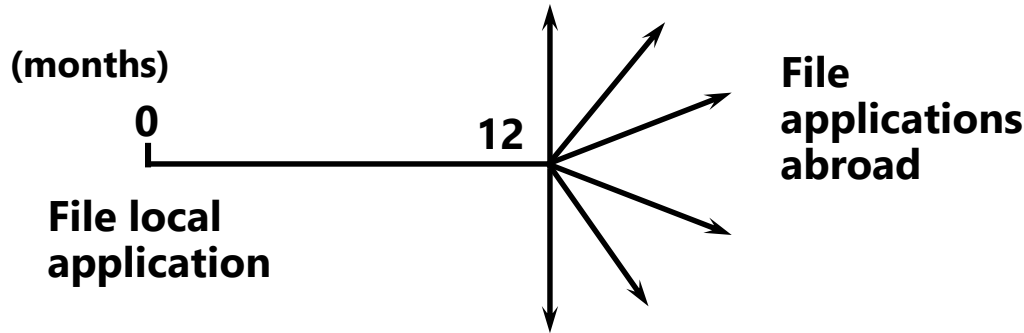
- Time prior to filing during which public disclosure by an inventor will not be considered prior art.
- It differs in different jurisdictions.
  - U.S.: One year (35 U.S.C. 102(b))
  - EPO: None
  - JP: Six months under certain circumstances

# Options for foreign filing

- File a patent application directly in a national or regional patent office (Paris Convention).
  - A foreign filing license from the USPTO may be required.
- File an international patent application under the Patent Cooperation Treaty (PCT).
  - A foreign filing license from the USPTO may be required, if filing in a foreign receiving office.



# Direct filing (Paris Convention) timeline

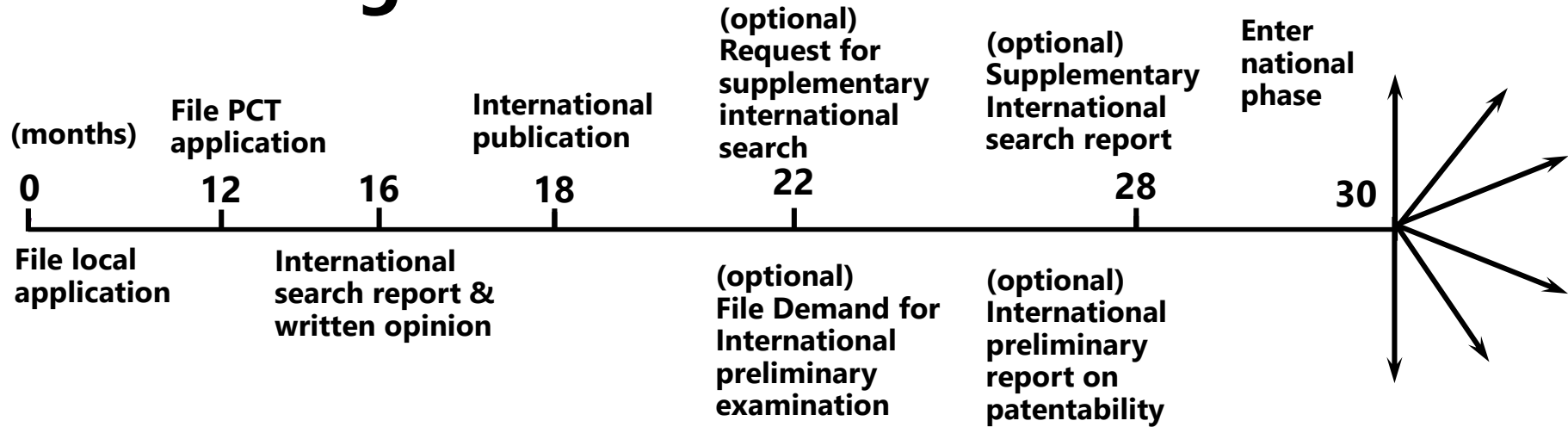


- Local patent application filed first
  - Multiple foreign applications filed at 12 months, claiming priority under the Paris Convention to the first application
    - Multiple formality requirements
    - Multiple prosecutions of applications
    - Translations, costs for Office fees and local agents at 12 months

# Why file directly in foreign national or regional patent office?

- May be cost effective
  - If filing in only a few countries
- When certain
  - As to which countries applications are to be filed
- Prepared to pay the filing costs early
  - E.g., filing fees, translation costs, attorney fees
- Necessary for countries not party to the PCT

# PCT filing timeline



- Local patent application filed first
  - Single international application filed under the PCT at 12 months, claiming priority under the Paris Convention
    - One set of formalities requirements
    - One international phase prosecution
    - Translations, costs for Office fees and local agents not required until 30 months

# International patent?

- An international application is filed under the Patent Cooperation Treaty (PCT) but...
  - There is no “international patent”
  - The PCT functions as a patent application filing system
  - The international application must still be prosecuted in each national or regional office where patent protection is desired



# PCT benefits for applicants

- Simplifies the process of filing foreign applications
  - One set of formality requirements
  - Establishes a filing date in all PCT Contracting States
- Postpones costs
  - Translation fees, filing fees, attorney fees
- Provides
  - An early indication of prior art and
  - A written opinion as to the novelty, inventive step and industrial applicability of the claimed invention
- Gives extra time for assessment of commercial viability in designated States

# The international application (IA)

- A single application
  - Filed in one language
  - Filed in one patent office
    - The Receiving Office (RO)
    - Usually the applicant's home patent office
  - Treated as a national application in each designated State as of the international filing date
- Formalities in compliance with the PCT
  - Must be accepted during national phase

# Why foreign file via the PCT

- May be cost-effective
  - If filing in more than a few countries
- When uncertain
  - As to which countries applications are to be filed
  - Preserves rights
- Provides additional time
  - To assess the commercial potential in the various foreign markets
- Defers national patent fees and other costs
  - E.g., translations, local associate fees, etc.
- Provides an assessment opportunity
  - Of international search and written opinion results, before incurring additional filing costs

# Hague system for the International Registration of Industrial Designs

- A single international application for a single international registration (IR)
  - Designating one or more Contracting Parties
  - Capable of being registered in 74 Contracting Parties
  - Register up to 100 industrial design with a single application
    - All designs must belong to the same Locarno class
- Issues governed by the law of each designated Contracting Party
  - If no refusal, the resulting international registration has the effect of a grant of protection
  - The conditions for protection or the rights which result from protection

# Avoiding common mistakes

- Confidentiality
  - Avoid making the invention public prior to filing a patent application
- Be familiar with key dates and deadlines
  - Under U.S., foreign, and international laws
- Recommend securing the services of a registered patent attorney or agent
  - If unfamiliar with the complexities in obtaining foreign patent rights
  - To avoid potentially losing patent rights

# USPTO international filing resources

- PCT Help Desk
  - 571-272-4300
  - Monday-Friday, 8:30 a.m. to 5 p.m. ET
- Pursuing international IP protection
  - <https://www.uspto.gov/learning-and-resources/pursuing-international-ip-protection>
- International Patent Legal Administration website
  - [www.uspto.gov/PatentCooperationTreaty](http://www.uspto.gov/PatentCooperationTreaty)
- Office of International Patent Cooperation website
  - [www.uspto.gov/InternationalPatentCooperation](http://www.uspto.gov/InternationalPatentCooperation)
- USPTO Hague website:
  - [www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs](http://www.uspto.gov/patent/initiatives/hague-agreement-concerning-international-registration-industrial-designs)

# Additional USPTO resources

- Inventors Assistance Center
  - 800-786-9199
- Inventor resources on USPTO.gov
  - [www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources](http://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources)
- Searching U.S. patents and U.S. patent application publications
  - <https://patft.uspto.gov>
- USPTO Pro Se Assistance Program
  - [www.uspto.gov/ProSePatents](http://www.uspto.gov/ProSePatents)
- USPTO Pro Bono Program
  - [www.uspto.gov/ProBonoPatents](http://www.uspto.gov/ProBonoPatents)



# Other resources

- Protecting Intellectual Property Rights
  - [www.StopFakes.gov](http://www.StopFakes.gov)
- Office of U.S. Trade Representative
  - [www.ustr.gov/issue-areas/intellectual-property](http://www.ustr.gov/issue-areas/intellectual-property)
- World Intellectual Property Organization (WIPO) ([www.wipo.int](http://www.wipo.int))
  - ePCT, PCT Newsletter, PCT Applicant's Guide
  - PATENTSCOPE
    - Searchable PCT publication database, image file wrapper, translation functionality
    - WIPO Pearl - Linguistic Search
    - <http://patentscope.wipo.int/search/en/structuredSearch.jsf>
  - Hague
    - [www.wipo.int/hague](http://www.wipo.int/hague)
- European patent database (Espacenet)
  - [www.epo.org/searching-for-patents/technical/espacenet.html](http://www.epo.org/searching-for-patents/technical/espacenet.html)
- Japanese patent database
  - [www.j-platpat.inpit.go.jp](http://www.j-platpat.inpit.go.jp)







# Thank you!

**Harry Kim**

Special Program Examiner

IPLA

PCT Help Desk: 571-272-4300

8:30 – 5:00pm ET (M-F)

[www.uspto.gov](http://www.uspto.gov)

[www.uspto.gov/patentcooperationtreaty](http://www.uspto.gov/patentcooperationtreaty)

[www.uspto.gov/internationalpatentcooperation](http://www.uspto.gov/internationalpatentcooperation)

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# International trademark practice

Susan Anthony

Office of Policy and International Affairs

October 2020

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Agenda

- Protecting trademarks nationally
- Protecting trademarks internationally
  - Direct national route
  - Madrid system route

# Hypothetical

Mark: **T-MARKEY TRINKETS**

Goods: **Jewelry, Class 14**

*How do you protect your mark in the United States and in other countries?*



# National protection of trademarks for U.S. owners

- Select trademark
- Use or intend to use trademark
- Obtain U.S. federal trademark registration from USPTO to protect trademark

# International protection of trademarks – Madrid system

- Madrid system is a convenient and cost-effective means to **register and manage** trademarks worldwide.
- File one application and pay one set of fees to apply for protection in up to **122 countries**.
- **Modify, renew, or expand** your global trademark portfolio through one centralized system:
  - [www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/)

**WIPO | MADRID**

**Madrid – The International Trademark System**

# Madrid system administration

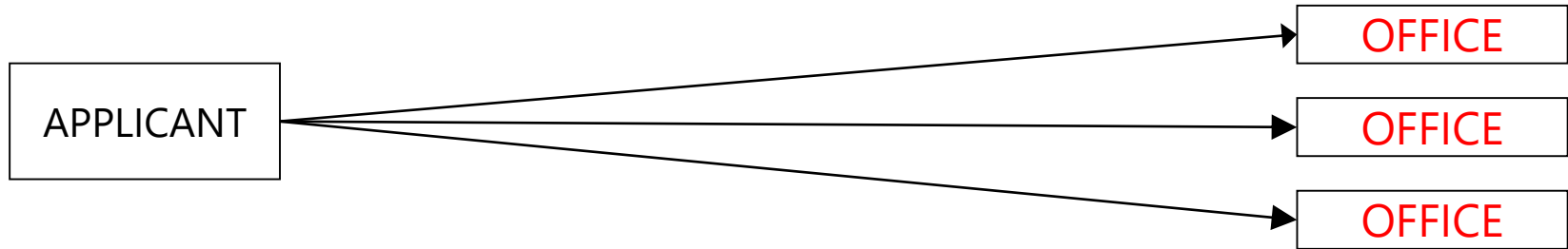


- Administered by the International Bureau (IB) of the World Intellectual Property Organization (WIPO), in Geneva, Switzerland.

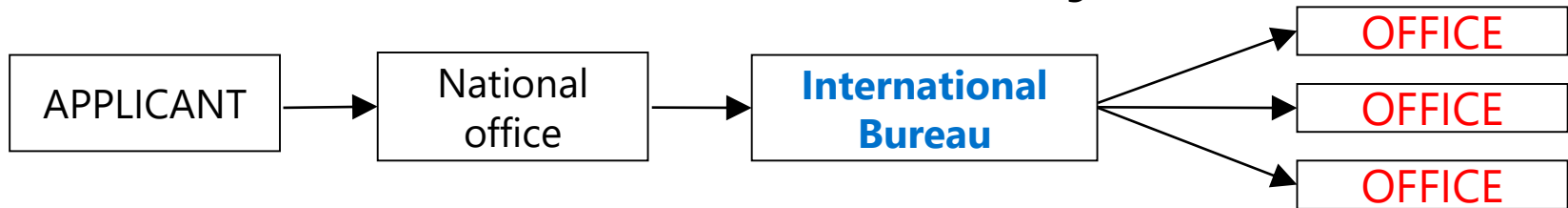


# Madrid system at a glance

## National route



## International route – Madrid System



# Madrid system at a glance

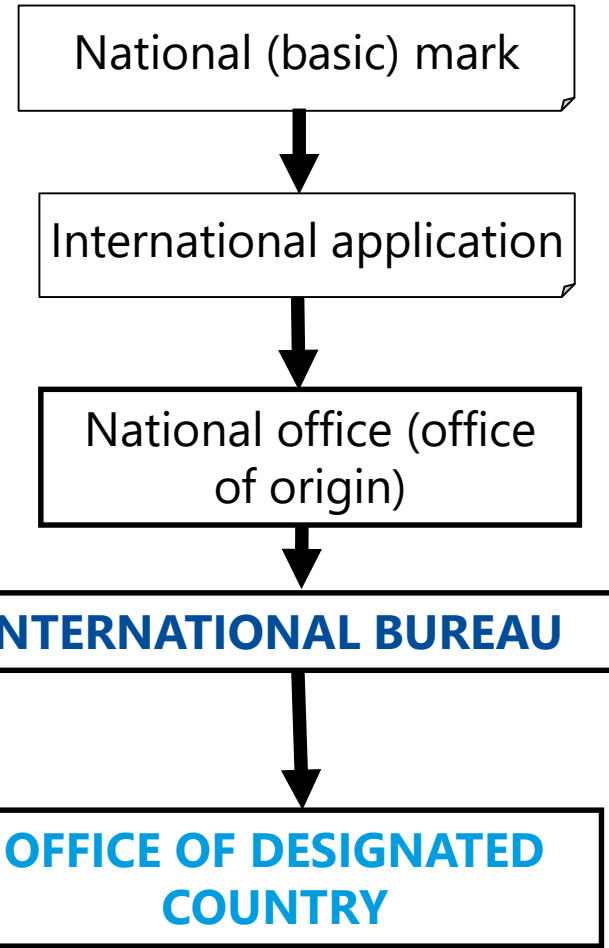
## Certification

- Formalities examination
- Publication in International Register
- Issuance of International Registration
- Notification to designated countries

## Substantive examination

**No refusal**

**refusal**



# Madrid system – designated countries

- After satisfactory examination of formalities, the International Bureau issues an **international registration**.
  - International registration is a misnomer – no legal rights vested.
- International Bureau forwards the international application information to **each designated country** where applicant seeks protection. Each country:
  - Examines under its own **national** trademark laws;
  - Determines **independently** whether to grant or refuse registration.
    - Legal rights vested if registration is granted.

# Madrid system key provisions

- **National application or registration:** serves as the basis for international filing under the Madrid Protocol.
  - Also called “basic application” or “basic registration.”
- **Mark:** same as in national filing.
- **Entitlement:** Must have a “connection” with a Madrid Protocol member country that serves as office of origin:
  - Nationality;
  - Domicile; or
  - Real and effective industrial or commercial establishment.

# Madrid system key provisions

- **Goods and services:** same as or less than those in national filing.
  - Limitation of goods and services: of the goods and services in the international application, **may pick and choose** which go to which designated country
    - Indicate initially in international application; or
    - File limitation notice after international registration issues.
  - Why limit goods and services?
    - Not entered, selling in that market;
    - Anticipate/overcome refusal;
    - Agreement with third party.

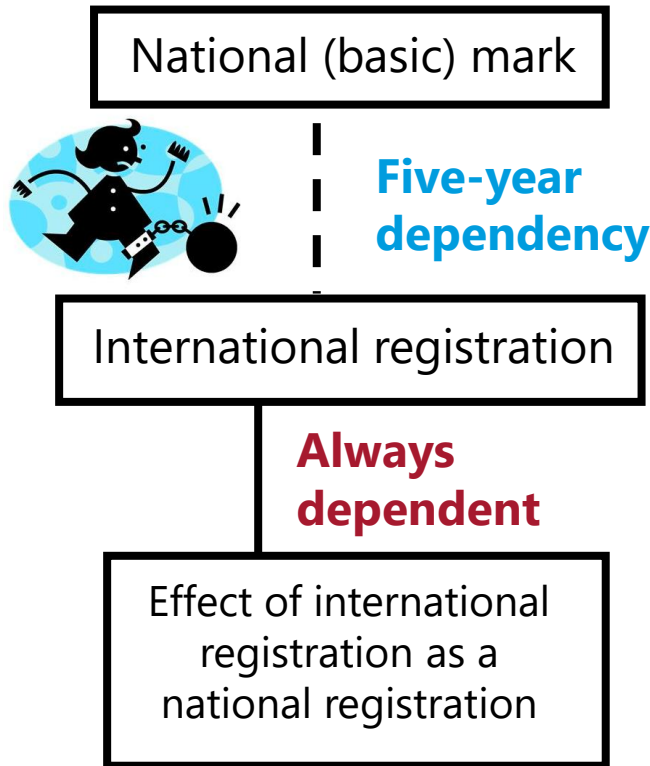
## National route

- many offices for filing
- many languages
- many currencies
- many registrations
- many renewals
- many modifications
- foreign attorney or agent  
**first needed at filing**

## International route (Madrid)

- one office for filing
- one language
- one currency
- one international registration
- one renewal
- one modification
- foreign attorney or agent  
**needed if refused**

# Ceasing of effect of national application or registration



If a national (basic) mark “ceases to have effect,” in whole or in part, **national office (office of origin)** notifies International Bureau and requests partial or total cancellation of international registration.



**International Bureau** cancels international registration to the extent requested by office of origin. International Bureau records, publishes, and notifies all designated countries of the partial or total cancellation of international registration.



**Designated countries** cancel, in whole or in part, the extensions of protection in their countries.

# Request for transformation after ceasing of effect

- Cancellation of goods and services, in whole or in part, in international registration triggers a right to file a national application in each designated country.
- Rights preserved:
  - Date of international registration becomes filing date;
  - Priority date, if any, claimed in international registration is retained.
- Must meet certain requirements to request transformation.



# Centralized management and maintenance of registrations at WIPO

## Every 10 years with WIPO

- Renew international registration with the International Bureau of WIPO to keep all designations alive

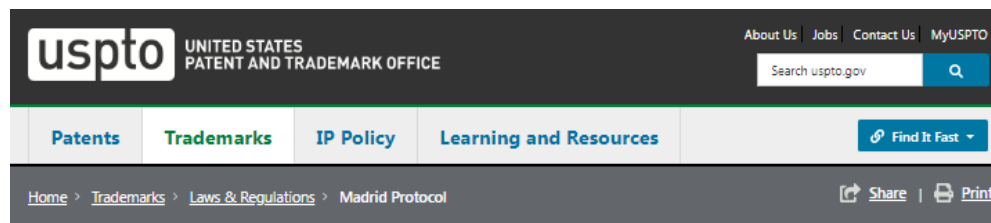
**Note:** May also need to file maintenance documents with designated countries to keep national designations alive – check with each designated country.

## Changes/updates as needed with WIPO

- Record transfer of ownership
- Limit or renounce goods and services in one or more designated countries
- Cancel goods and services in the international registration
- Record restriction on right of ownership
- Record license
- Appoint a domestic representative
- Change name or address of holder or representative



# USPTO Madrid Protocol webpage



## Laws & Regulations

Fastener Quality Act (FQA)

**Madrid Protocol**

Native American Tribal  
Insignia

Rule Making

[Current Madrid Contracting  
Parties](#) 

[Madrid Highlights Special  
Edition: The United States Patent  
and Trademark Office \(March  
2015\)](#) 


## Madrid Protocol

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks -- the **Madrid Protocol** -- is one of two treaties comprising the Madrid System for international registration of trademarks. The protocol is a **filing** treaty and not a substantive harmonization treaty. It provides a cost-effective and efficient way for trademark holders -- individuals and businesses -- to ensure protection for their marks in multiple countries through the filing of one application with a single office, in one language, with one set of fees, in one currency. Moreover, no local agent is needed to file the initial application.

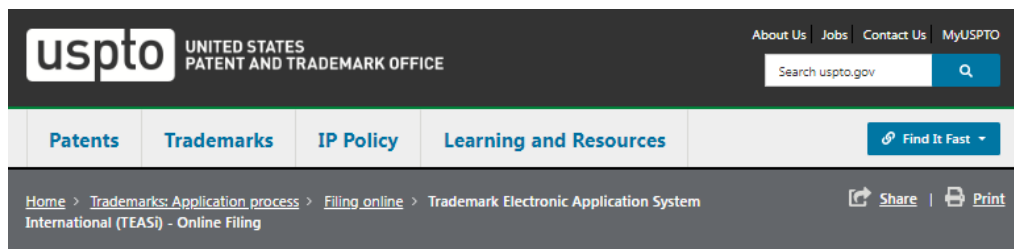
While an International Registration may be issued, it remains the right of each country or contracting party designated for protection to determine whether or not protection for a mark may be granted. Once the trademark office in a designated country grants protection, the mark is protected in that country just as if that office had registered it.

The Madrid Protocol also simplifies the subsequent management of the mark, since a simple, single procedural step serves to record subsequent changes in ownership or in the name or address of the holder with World Intellectual Property Organization's International Bureau. The International Bureau administers the Madrid System and coordinates the transmittal of requests for protection, renewals and other relevant documentation to all members.

## Basics

- [MADRID FAQs](#)
- [Madrid System for International Registration of Trademarks](#) 
- [Section 66\(a\) Timeline: Application based on Madrid Protocol](#)
- [Post Registration Timeline for Madrid Protocol-Based Registrations](#)

# USPTO Madrid Protocol electronic forms webpage



[www.uspto.gov/trademarks-application-process/filing-online/trademark-electronic-application-system-teasi-online](https://www.uspto.gov/trademarks-application-process/filing-online/trademark-electronic-application-system-teasi-online)

## Main menu

- Patents
- Trademarks
- IP Policy
- Learning and Resources
- About Us
- Jobs
- Contact Us
- MyUSPTO

## Trademark Electronic Application System International (TEASi) - Online Filing

### Madrid Protocol forms

**System Availability:** All filers should check [Systems Status and Availability](#) before beginning the application process. If you have a filing due today and the document cannot be filed via TEASi, you must use an [alternative method of filing](#) to ensure that the document is timely received by the USPTO.

### Log in to access forms

To access TEAS and TEASi forms, select a form listed below. If you are not already signed into MyUSPTO using your USPTO.gov account, then you will be prompted to log in with two-step authentication.


For the latest information or to create a USPTO.gov account, review the [Log in to TEAS and TEASi page](#).

#### 1. [Application for International Registration](#)

The USPTO is experiencing intermittent delays with transmitting fees to WIPO. If you paid international fees to the USPTO with your international filing and receive an irregularity for the fees please contact the petitions office at 571-272-8950.

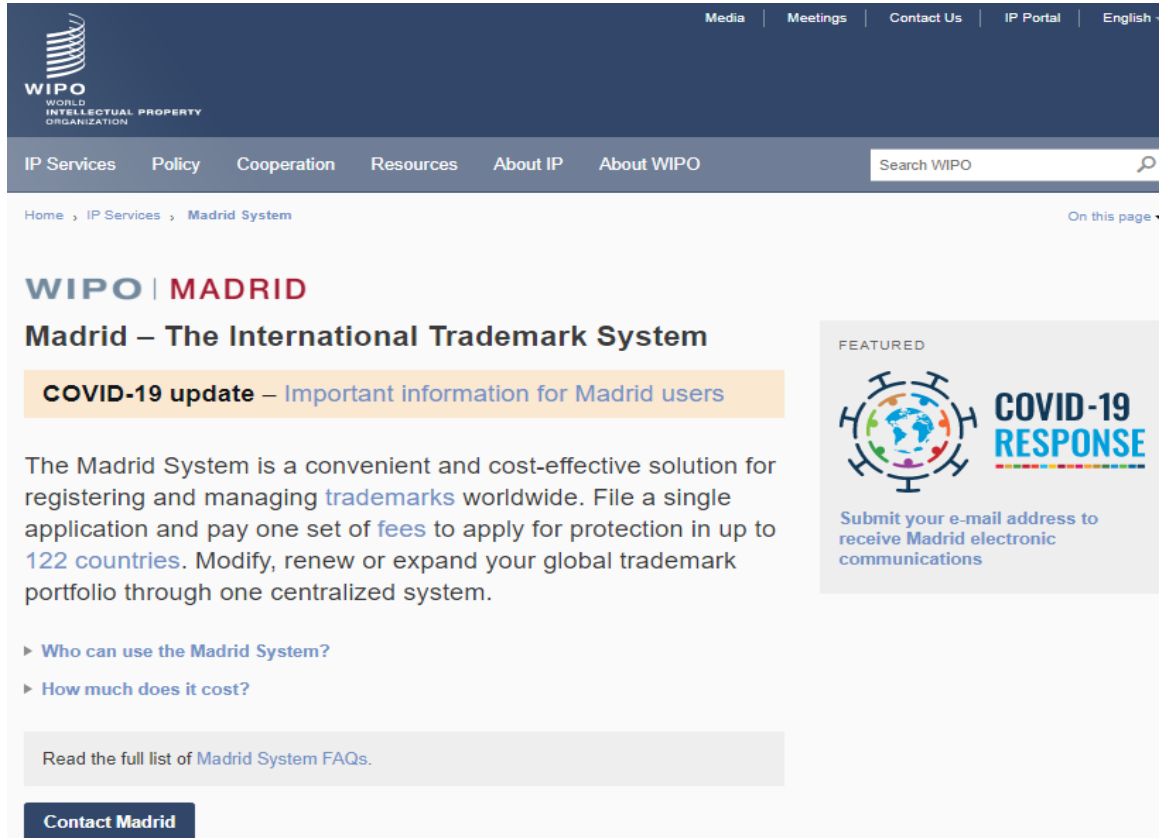
Use this form to submit an international application for registration. If the international application meets the

## TEASi FAQs

[Current Madrid Contracting Parties](#) 



# WIPO Madrid homepage



The screenshot shows the WIPO Madrid homepage. At the top is a dark blue header with the WIPO logo on the left and navigation links (Media, Meetings, Contact Us, IP Portal, English) on the right. Below the header is a light blue navigation bar with links to IP Services, Policy, Cooperation, Resources, About IP, and About WIPO, along with a search bar. The main content area has a breadcrumb trail: Home > IP Services > Madrid System. The title 'WIPO | MADRID' is displayed in blue and red. Below it is the heading 'Madrid – The International Trademark System'. A yellow banner highlights a 'COVID-19 update – Important information for Madrid users'. The main text describes the Madrid System as a convenient and cost-effective solution for registering and managing trademarks worldwide, mentioning that users can apply for protection in up to 122 countries. To the right, a 'FEATURED' section titled 'COVID-19 RESPONSE' includes a graphic of a globe with colorful dots and a call to action to submit an email address for electronic communications. At the bottom, there is a link to 'Read the full list of Madrid System FAQs.' and a dark blue 'Contact Madrid' button.

WIPO  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

Media | Meetings | Contact Us | IP Portal | English

IP Services | Policy | Cooperation | Resources | About IP | About WIPO

Search WIPO

Home > IP Services > Madrid System

On this page

## WIPO | MADRID

### Madrid – The International Trademark System

**COVID-19 update** – Important information for Madrid users

The Madrid System is a convenient and cost-effective solution for registering and managing **trademarks** worldwide. File a single application and pay one set of **fees** to apply for protection in up to **122 countries**. Modify, renew or expand your global trademark portfolio through one centralized system.

- **Who can use the Madrid System?**
- **How much does it cost?**

Read the full list of **Madrid System FAQs**.

**Contact Madrid**

[www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/)

# WIPO Madrid homepage

## Madrid e-services

Madrid System online tools and resources to support trademark owners at each stage of the international trademark registration lifecycle. [Madrid e-services brochure](#).

**Search**



Global Brand Database

**File**



Madrid Goods & Services  
Manager  
Member Profiles Database  
Fee Calculator

International Application Form (MM2)

[PDF](#)

**Monitor**



Madrid Monitor

**Manage**



Madrid Portfolio Manager

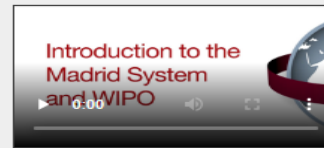
e-Subsequent Designation  
e-Renewal  
e-Payment  
Madrid System forms

## Using the Madrid System

The Madrid System supports you throughout the lifecycle of your trademark, from application through to renewal. Use these guides to find out more about how to search for existing trademarks before you apply for protection, how to file an international application, and how to manage your international trademark registration.

### Learn more

- [How the Madrid System works | Benefits of the Madrid System](#)
- [Making the Most of the Madrid System](#) [PDF](#) (how to complete your international application and other forms)



Video: An introduction to the International Trademark System.

## How to

### Search before filing

Before filing an international application, you should search to find out if identical or similar marks already exist in your

### File an international application

In order to file an international application [PDF](#), you must have already registered or

### Monitor an international application or registration

Once you've filed an international application with your "home" trademark office, it


### Manage your trademark registration

You can easily manage your international trademark registration through our

[www.wipo.int/madrid/en/](http://www.wipo.int/madrid/en/)

# USPTO Madrid Protocol guidance:

## Trademark Manual of Examining Procedure (TMEP), Chapter 1900

**TMEP** | Trademark Manual of Examining Procedure  
October 2018

Switch Version ▾ Settings ▾ Help ▾

☒ TMEP ☐ Notes ☐ Index

Operator

[1800 - Public Inquiries About Applications and Registrations](#)

**▼ 1900 - Madrid Protocol**

- 1901 - Overview of the Madrid System of International Registration
- ▼ 1902 - International Application Originating from the United States
  - 1902.01 - Who Can File
  - ▶ 1902.02 - Minimum Requirements for Date of Receipt of International Application in USP
  - ▶ 1902.03 - Certification of International Application by USPTO
  - 1902.04 - Date of International Registration
  - 1902.05 - IB Requirements for Complete International Application
  - 1902.06 - Examination of Application by IB
  - 1902.07 - Irregularities in International Application
  - ▶ 1902.08 - Subsequent Designation - Request for Extension of Protection Subsequent to I
  - 1902.09 - Dependence and "Central Attack": Restriction, Abandonment, Cancellation, or
  - 1902.10 - Transformation When the USPTO Is the Office of Origin
  - 1902.11 - Representative
  - 1902.12 - USPTO Must Notify IB of Division or Merger of Basic Application or Registration
- ▶ 1903 - Payment of Fees
- ▼ 1904 - Request for Extension of Protection of International Registration to the United States
  - ▶ 1904.01 - Filing Request for Extension of Protection to United States
  - ▶ 1904.02 - Examination of Request for Extension of Protection to the United States
  - ▶ 1904.03 - Notice of Refusal
  - 1904.04 - Opposition
  - 1904.05 - Certificate of Extension of Protection
  - 1904.06 - Assignment of Extension of Protection to the United States
  - 1904.07 - Limitation of Protection to United States

1800 1900 **Oct2018 (Current)** Appendix A ▶

**Chapter 1900 - Madrid Protocol**

The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks ("Madrid Protocol") is an international treaty that allows a trademark owner to seek registration in any of the countries or intergovernmental organizations that have joined the Madrid Protocol by submitting a single application, called an international application. The international registration system is administered by the International Bureau ("IB") of the World Intellectual Property Organization ("WIPO"), in Geneva, Switzerland.

The Madrid Protocol became effective in the United States on November 2, 2003. The Madrid Protocol Implementation Act of 2002, Pub. L. 107-273, 116 Stat. 1758, 1913-1921 ("MPIA") amended the Trademark Act to provide that: (1) the owner of a United States application and/or registration may seek protection of its mark in any of the countries or intergovernmental organizations party to the Madrid Protocol by submitting a single international application to the IB through the United States Patent and Trademark Office ("USPTO"); and (2) the holder of an international registration may request an extension of protection of the international registration to the United States. A notice of final rulemaking amending the Trademark Rules of Practice to incorporate the MPIA was published at 68 Fed. Reg. 55748 (Sept. 26, 2003).

The Madrid Protocol, *Common Regulations Under the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to That Agreement* ("Common Regs."), *Guide to the*

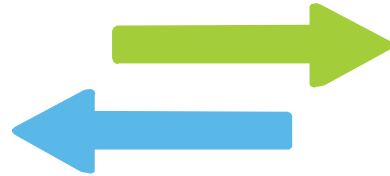
45

# Madrid system is a two-way process

## Outgoing – international applications

- U.S. trademark owners/applicants seeking protection in other countries.

**TMEP §§1900–1903** only apply to outgoing international applications.



## Incoming – requests for extension of protection

- Foreign trademark owners/applicants seeking protection in the U.S.

**TMEP §1904** only applies to incoming §66(a) applications, i.e., requests for extension of protection to the U.S.

# Hypothetical

Mark: **T-MARKEY TRINKETS**

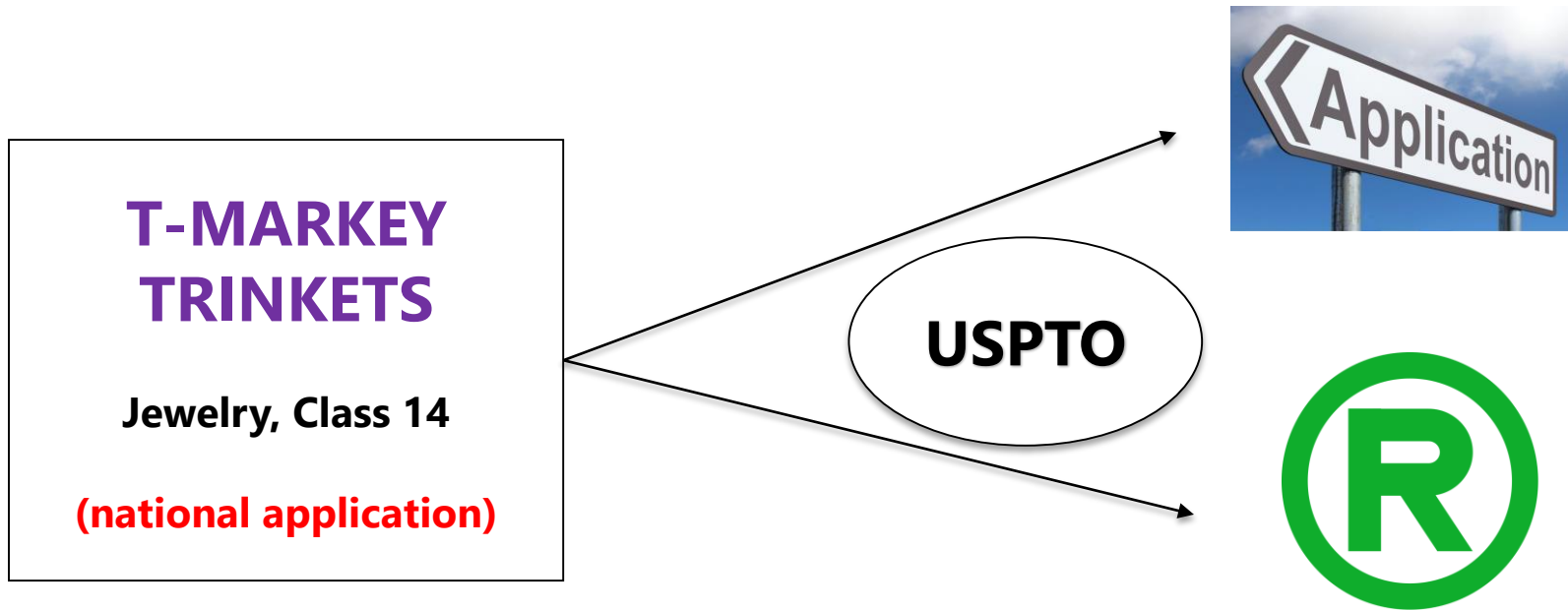
Goods: **Jewelry, Class 14**

*How do you protect your mark in the United States and in other countries?*



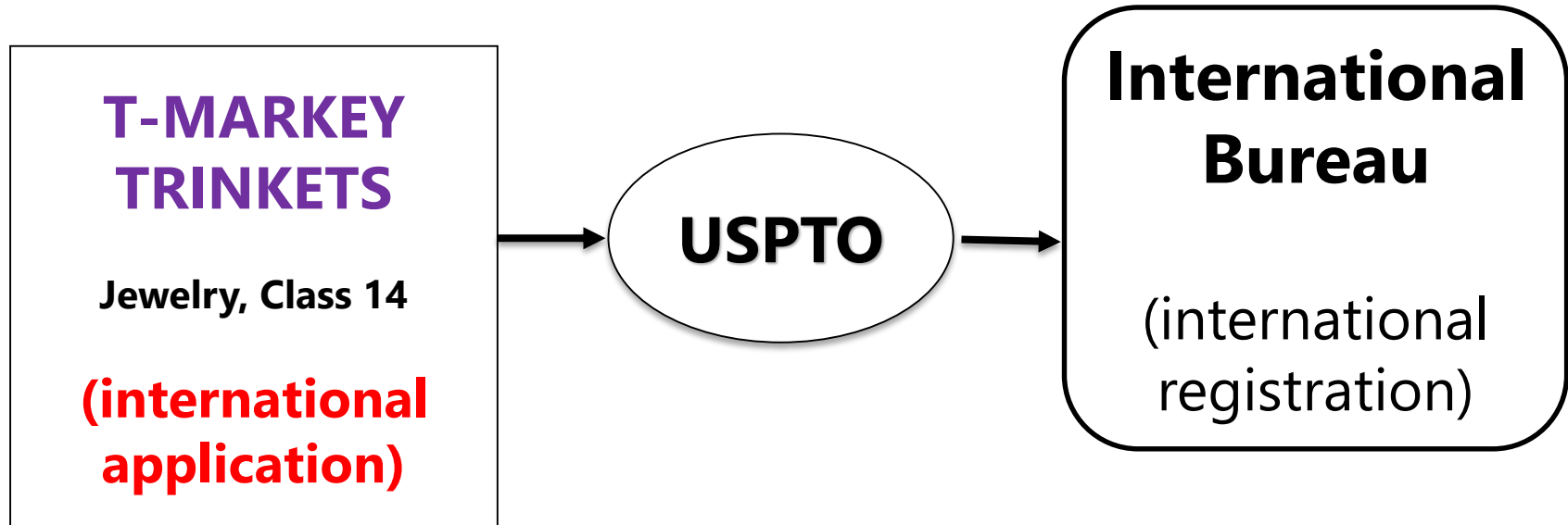
# Hypothetical: U.S. national application or registration

For U.S. trademark owners:



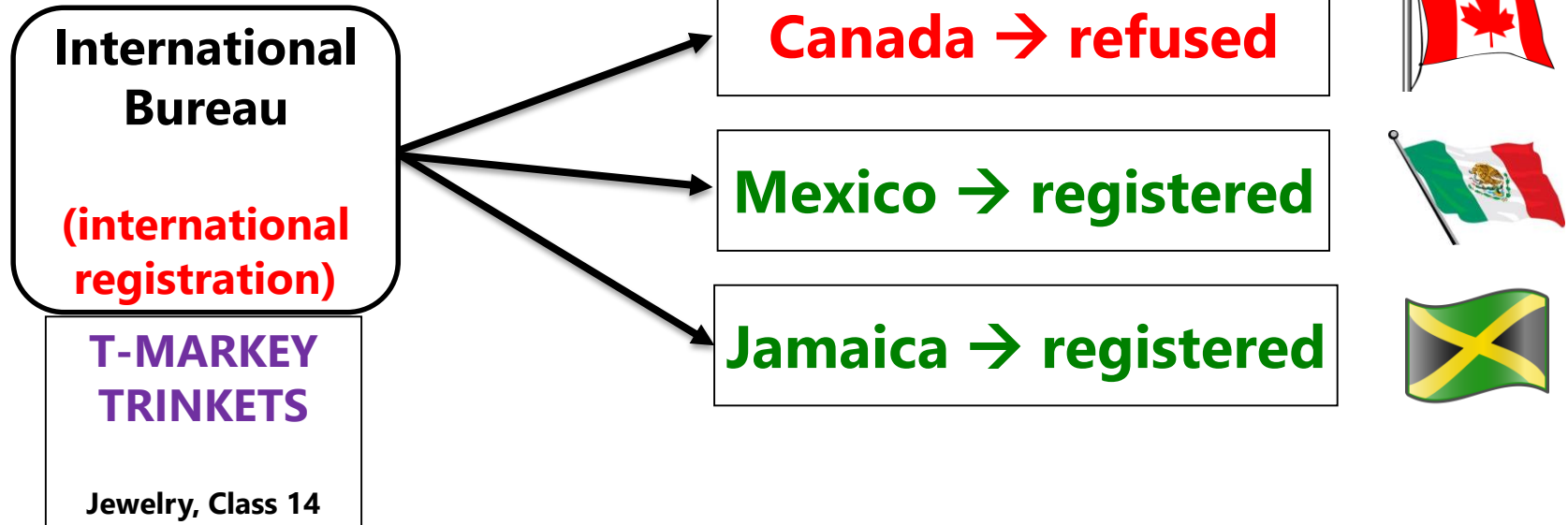
# Hypothetical: International application and international registration

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# Hypothetical: International application and international registration

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# Thank you!

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