

WHAT'S NEW AT HOLLAND & BONZAGNI

Welcome to the Fall 2003 edition of Holland & Bonzagni's Intellectual Property Newsletter. We're excited that the United States, at long last, has joined the Madrid Protocol -- a new system for filing foreign trademark applications that cuts costs and paperwork dramatically. We've been advising clients to hold off on "volume" foreign trademark filings, until they were able to take advantage of the cost savings under the new system.

On a more personal note, we're pleased to welcome back Maria Vega, Administrative Assistant, and Cari Mazza, Paralegal.

New System Cuts Costs

IN INTERNATIONAL TRADEMARK PROTECTION

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Starting November 2, 2003, U.S. trademark owners will have the opportunity to file a single international trademark application that works for over 50 countries. That's when the United States becomes part of the Madrid Protocol, one of the most important trademark treaties in many years.

U.S. trademark owners will be able to register their trademarks in Madrid Protocol member countries by simply filing a single application with the U.S. Patent and Trademark Office (USPTO). Currently 57 countries are members of the Madrid Protocol, including many European countries, China, and Japan.

Unlike the Community Trade Mark centralized registration system in which one registration takes the place of national registrations in all European Union member countries,

the Protocol offers a centralized filing procedure for acquiring and maintaining separate national trademark registrations in each designated Protocol member country. When the process is complete, the applicant will own a bundle of foreign trademark rights, all bearing the same International Registration number.

The Madrid Protocol should significantly reduce costs for international trademark protection where, although each Protocol member country can charge its normal application fee, there will be no need for local attorneys or agents, powers of attorney, legalizations or translations (everything can be filed in English). Simple application forms and centralized maintenance filings ease administration under the Protocol. In addition, examination

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The moment the work is created, you are legally permitted to place a copyright notice on it to deter copying. Typical copyright notices in the U.S. consist of: the copyright symbol "©" (with or without the word "Copyright"); followed by the year the work was published or created (if unpublished); and then the author's name. For example:

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HOLLAND & BONZAGNI, P.C. Registered Patent Attorneys

Patents/Trademarks/Copyrights/Computer Law/Cyber Law

171 Dwight Road
Longmeadow, MA 01106

Telephone: 413-567-2076

Facsimile: 413-567-2079

Email: h-b@hblaw.org

Visit us on the web!

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New System Cuts Costs

IN INTERNATIONAL TRADEMARK PROTECTION

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under the Protocol is limited to eighteen months, while in some countries it normally can take years. The reduced costs and streamlined procedures offered by the Madrid Protocol will therefore greatly benefit American companies, especially small- and medium-sized companies that previously may not have been able to afford international trademark protection.

What does this mean in dollars and cents? Foreign trademark applications typically run \$1100-\$3900 to file per country. Using the Madrid Protocol system, a company applying in 12 countries could save over \$15,000 in initial filing costs alone. Additional costs would also be saved during the application process.

Further, renewals, assignments, and name changes would be simplified. Instead of paying to file the paperwork in each country, at approximately \$750-\$1000 apiece, only one set of papers will have to be filed for International Registrations in the USPTO.

In addition to the advantages of the Madrid Protocol, there are also limitations inherent in this system. The Madrid Protocol allows for

International Registration based upon a home application or registration. In other words, a U.S. company may use a U.S. trademark application or registration as the basis for seeking an International Registration in Madrid Protocol countries.

The fate of the International Registration will be tied to the fate of that home application or registration for a period of five years from the date of issuance of the International Registration. If the home application is abandoned or is canceled for any reason, the International Registration will also be abandoned or canceled.

In addition, the International Registration has to list the same identification of goods or services found in the home application or registration. Since the U.S. Trademark Office requires more specific identifications than foreign countries such as China, an International Registration would offer narrower protection in China than that offered by way of a separate or independent Chinese trademark registration.

Thus, while securing international trademark protection under the Madrid Protocol has many advantages, there are also limitations that will need to be considered and weighed in each circumstance and in each country before a decision is made to proceed under the Protocol.

Mechanics for Seeking an International Registration

The mechanics for seeking an International Registration are shown in the accompanying flowchart and are described below:

1. Applicant will file a national trademark application for the purpose of establishing a home or basic application;
2. The applicant will then file an international trademark application in the USPTO claiming priority from the home application along with a request designating those Madrid Protocol countries in which protection is being sought;
3. The USPTO will submit the international application to the World Intellectual Property Organization (WIPO) in Geneva, Switzerland;
4. WIPO will provide each designated member country



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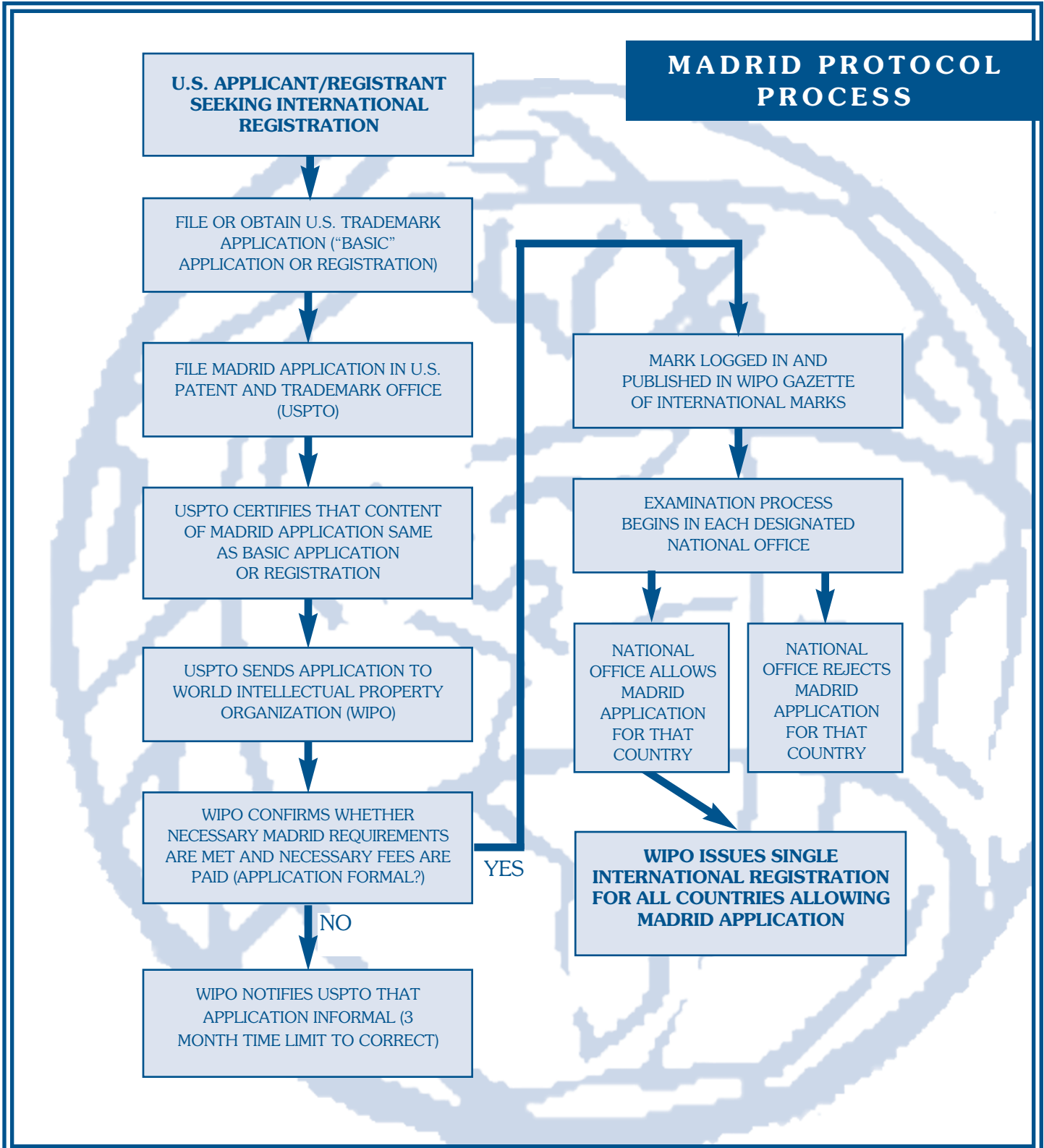
an extra line: "All Rights Reserved."

Obtaining a registration is not mandatory, but is recommended for valuable works that might be copied. If you file an application to register a work before any unauthorized copying occurs, you are entitled to recover both automatic statutory damages and attorney's fees in a lawsuit, provided you have used a proper copyright notice. However, waiting to register until after copying has occurred bars recovery of automatic damages and attorney's fees. ■

with information regarding the international application and each country will then determine whether all local registration requirements are met by the subject application; and

5. If all registration requirements are met in each designated country, or if the application is withdrawn from any country that has rejected it, WIPO will issue an International Registration and the mark will be

published in the International Gazette. The International Registration will be effective for renewable ten-year terms. ■



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