

USE OF THE MADRID PROTOCOL TO OBTAIN TRADEMARK PROTECTION IN THE EUROPEAN COMMUNITY

The European Community joined the Madrid Protocol on 1 October 2004. Since that time, applicants have had a choice of obtaining a Community trademark registration by filing an application directly or by designating the European Community ('EC') in a Madrid Protocol application.

File direct or use the Madrid Protocol?

There is a marginal saving of costs (of the order of €200) by seeking a EC trademark registration via the Madrid Protocol rather than filing directly at the European Trade Mark Office.

However, for the following reasons, we believe there are, at present, some significant benefits to be gained by filing Community trademark applications direct rather than using the Madrid Protocol. The benefits outweigh the marginal saving in cost:

1. **Broader protection may be available.** The specification of goods and/or services for the European Community designation through the Madrid Protocol cannot be greater than that used in the home application/registration. That is of particular relevance when the US is the country of the home application/registration.

In contrast an application filed directly at the European Community Trade Mark Office can have a broader specification of goods and/or services.

2. **Procedural uncertainty – application procedure.** When the European Community is designated through the Madrid Protocol, the searches carried out by the European Community Trade Mark Office will be sent to the applicant, not to the attorney of record unless the attorney of record for the EC designation is a European trademark attorney. Sending the searches directly to the applicant may result in the searches being mislaid or lost.

In contrast, if an application is filed directly at the European Community Trade Mark Office on behalf of a non-European applicant, the applicant has to nominate a European trademark attorney and so all the communications regarding the searches will be sent directly to the European trademark attorney and not the applicant.

3. **Procedural uncertainty – opposition procedure.** When the European Community is designated through the Madrid Protocol, any opposition filed against that application will initially be notified to the attorney of record. The purpose of this first notification is to alert the attorney that an opposition has been filed. Following this first notification, the European Community Trade Mark Office will issue a second, more substantive notification concerning the opposition. This second notification will contain relevant due dates and will be sent directly to the applicant, unless a European Community trademark attorney has already been appointed. Sending the opposition documents, which include the due dates, directly to the applicant may result in critical due dates being missed.

In contrast, where an application is filed directly at the European Community Trade Mark Office, all the communications regarding the opposition will be sent directly to the European trademark attorney of record.

Recommendations

1. **We recommend that you continue to file directly at the European Community Trade Mark Office when wishing to obtain a Community trademark registration.**
2. In the event that you choose to use the Madrid Protocol to obtain a Community trademark registration, our recommendation is that **at the time of filing** you should appoint a European trademark attorney as attorney of record for the European Community designation.

There will be no charge levied by our firm for merely being appointed as the European trademark attorney of record in these circumstances. However, of course, we would charge for subsequent work.

The information in this Newsletter was correct at the date of release. More up to date information is available by contacting Eric Potter Clarkson. All comments contained here are of a general nature and full professional advice should be sought on any specific problem.

Please note that all our Newsletters can be found on our website at www.eric-potter.com.

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