

**Trademarking With an International Perspective:
10 Practical Considerations**

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INTRODUCTION

Today's economy is a global economy in which all nations are interdependent. Similarly, most companies these days are global in nature or aspire to be: If they don't sell abroad, they manufacture abroad. If they don't manufacture abroad, they at least source some or all of their raw materials abroad.

Moreover, the Internet has ensured that the reputations of today's companies exceed national borders. And, with that enhanced exposure comes an increased potential for trademark piracy from every corner of the globe.

Given the international perspective of today's companies, today's trademark lawyers must also have a global mindset to serve their clients effectively. Gone are the days when a trademark lawyer need only be expert in his or her own national trademark law. It is now imperative that trademark lawyers understand trademark law from an international perspective, including how to protect, maintain, and enforce their clients' marks abroad.

With that in mind, we now focus on 10 of the most important practical considerations of which all lawyers practicing in the international trademark arena must be aware.

10 Practical Considerations

1. Consider whether you should search internationally before filing and, if so, how extensively.

You have searched in your home country and found your client's mark is clear; therefore you have filed a national application in your home country for your client's mark. Your client wants to roll out an international filing program for the mark in an additional 20 countries. Searching in 20 additional countries will be very expensive – probably in the range of \$500 – \$1,500 each – particularly if opinions of counsel are sought. Should you search internationally?

A. Why search at all?

There are numerous good reasons to search internationally prior to filing. First, searching helps to determine if there are obstacles to the client's use and registration of its mark in the countries of interest. In "first to file countries," such as France and Vietnam, one need only consider marks that are registered or applied for, unless a potentially confusing mark that is unregistered is already well-known to consumers in that country. By contrast, in common laws countries, such as the United States, Canada, and the UK, one must consider prior use as well as registration, since use confers trademark rights.

In addition to revealing obstacles, searching helps the trademark lawyer to better assess how to deal with the obstacles that are revealed. If a prior registration is vulnerable to cancellation for non-use, it may be possible to eliminate the obstacle by petitioning to cancel it. Alternatively, if the mark has only recently been registered and is in use, the trademark lawyer

may counsel his client to attempt to purchase the mark, request a consent, or choose a new mark altogether.

Searching can also reveal to the trademark lawyer whether the term searched is weak or strong – whether it is generic, descriptive, or diluted. For example, without searching the term YAKY for hair pieces, the trademark lawyer might never discover that YAKY is a term used to describe the texture of African American hair.

Finally, by consulting trademark colleagues in other countries, a trademark lawyer can learn the meaning or connotation of a mark in a language or culture different from his own, thereby assisting his clients to avoid marks with bad meanings or connotations. The classic example of a mark with a bad connotation is NOVA for a sports car, as NO VA means “it will not go” in Spanish speaking countries.

B. How can you search internationally?

There are several different types of searches that the trademark lawyer can conduct or have conducted on an international level. For example, a World Identical Screening Search (or a “WISS”) screens for identical marks that have been published for the first time since 1976 in approximately 200 countries. It is a quick and cost-effective way to get a rough impression of the availability of a mark worldwide. While you cannot clear a mark with a WISS (since it does not provide you with full register details or subsequent history of the mark post-publication), it can be used to pinpoint potentially serious problems with the adoption of a particular mark that require further follow-up research. A more detailed international search is the in-house “knockout” search, supplied by Corsearch and other suppliers. It is useful to search for identical and near identical marks in countries covered by the trademark lawyer’s subscription. For those marks outside the trademark lawyer’s subscription, it is possible to use TMview, a free product, which enables the lawyer to connect with the national trademark offices of numerous countries internationally. Of course, the trademark lawyer can also accomplish this by consulting national trademark registers on a country-by-country basis. Finally, for the trademark lawyer who requires more detail, wider search parameters, and the convenience of a bound report, an international search report, with or without opinion, can be procured from Corsearch or another provider.

C. How extensively should you search?

If cost were not a factor, it would always be better to search in as many of the relevant countries and in as much depth as possible. But, searching is expensive and cost will always be a factor, so it is important to prioritize the searching. First and foremost, consider the importance of the mark: Core marks and marks for new product launches will generally merit more extensive searching than secondary or seasonal marks. Consider also the importance of the country to the international strategy of the client. Countries that will be significant markets for the client’s goods or important manufacturing centers should be prioritized. Also, consider the timing: Can the client wait for the examination/opposition process to expose conflicts or is it going to market soon? If time is “of the essence” in a particular country, prioritize the search. One way to reign in costs is to conduct the search in phases, starting with the most critical countries and, should the mark be clear in those countries, moving on to the countries of lesser

importance. That way, if an insurmountable obstacle is found early, the international search can be curtailed.

2. Consider whether to file internationally with one owner or several different owners.

Another key consideration is whether to file with one or several different owners.

A. Why might there be several different owners?

There might be tax reasons for your client wanting to file internationally in the names of different owners. For example, some US companies that own their marks domestically set up a foreign subsidiary to own the same marks outside the United States. This allows them to obtain favorable tax treatment in another country outside the United States that has little or no income taxes. Recently, some retailers that have experienced hard times financially, such as Neiman Marcus, have transferred portions of their trademark portfolio to their subsidiaries as a means of restructuring their debt. Other trademark owners divide up responsibility for their trademark portfolio into several centers of control. Sotheby's, for example, has two different centers of control, namely New York and London, and each center uses different trademark owners and administers the SOTHEBY'S trademark portfolio in a different hemisphere, while at all times coordinating their efforts. Other companies want their subsidiaries to own and manage their marks in the countries in which they operate. Finally, some companies file abroad in the name of different owners to hide their identities from competitors.

B. Why is it better to have one owner (or at least as few owners as possible) internationally?

Sometimes filing in the name of different owners is unavoidable. That being said, from the trademark standpoint, it is certainly better to have one owner or at least as few owners as possible internationally. The reasons are not hard to understand: Since a trademark indicates to consumers the source of goods and services, more owners dilutes the mark. Having one owner also promotes a consistency of branding and legal positioning. Two or more owners that do not closely coordinate their efforts are likely to take inconsistent positions in contested proceedings, undercutting each other. It is also easier to show acquired distinctiveness when there is just one trademark owner. For example, if one must show acquired distinctiveness in a descriptive English term in the European Union countries in which English is widely spoken, it is much easier to do that with one trademark owner than with several. Similarly, in a contested proceeding in a particular country, when one is relying on a mark that is not registered in that country, it is easier to show fame of the mark relied upon – for example, by providing copies of trademark registration from other countries – when there is only one trademark owner.

3. Consider whether to file internationally in standard characters or in a stylized format or with a design.

Whether you should file your client's mark in standard characters or either in a stylized format or with a design depends entirely on the circumstances.

A. Why file in standard characters?

Filing in “standard characters” means filing a word mark with a typed drawing (sometimes called “block letters”). Thus, when you file a word mark in standard characters, you are not claiming a special form of display for those words. In some countries, such as the United States and Canada, use of a word mark in any form of display will support a standard character registration. Therefore, a registration of a word mark in standard characters is the most flexible type of registration, allowing for modernization over time and an easier-to-satisfy use requirement. Generally speaking, a standard character registration is also the strongest type of registration from the enforcement perspective.

B. Why file stylized or with a design?

In some countries (e.g., Spain, Germany, China), a mark must be used in the format in which it is registered. Thus, use of a mark in a stylized format or with a design may not support a standard character registration in these countries. Another reason for filing in a stylized format or with a design is to add distinctiveness to an otherwise non-distinctive mark. While the mark CHEF’S TOOLS may not be registrable for kitchen utensils if applied for in standard characters, it may be registrable if filed with the fanciful design of a chef or with a logo comprised of the stylized letters “CT.” Filing with stylized lettering or a design can also help to distinguish one mark from others in the field, thereby avoiding a citation of another mark or a trademark conflict. Say, for example, a term is highly diluted and there are many formatives (e.g., PURE NECTAR, PURE PEACH, PURE AIR, PURE FLOWER, etc.). In such circumstances, two marks consisting solely of the diluted term PURE depicted in different stylizations or with different designs may be able to coexist, even for similar goods or services.

Yet another circumstance in which it is desirable to protect the stylization of the lettering in a mark or a design is where the format of the mark is what you most want to protect. Consider the COCA-COLA (Stylized) mark for example:



In other countries – particularly those in which English is not commonly understood – it is the stylization of the lettering in the COCA-COLA mark that the trademark owner would want to protect, more so than the actual words “coca-cola.” Thus, in Thailand for example, a Thai word depicted on a can of soda in the famous COCA-COLA script in white lettering on a red background might easily confuse a Thai consumer into believing that a bogus soft drink is “the real thing.”

4. Consider whether to file internationally in black and white or in color.

As with the format of the mark, the determination of whether to file a mark internationally in black and white or in color is both mark- and country-specific.

A. Why file in black and white?

In many, if not most countries, use of a mark in color will support a registration of that mark in black and white for user requirement purposes, provided the commercial impression of that mark is not changed. This makes for an easier user requirement, and allows for changes in the color or colors of a mark over time. Generally speaking, the registration of a mark in black and white is also considered stronger from the enforcement standpoint than a more limited registration of the mark in color. For these reasons, black and white is usually the preferred form of registration.

B. Why file in color?

In some countries, use of a mark in color may not support a registration in black and white. In most countries of the European Union, for example, under a rule change implemented in July 2014, a trademark in black and white is not considered identical to the same mark in color, unless the differences in color are “insignificant” (defined as a difference that a reasonably observant consumer would perceive only upon side-by-side examination). Therefore, to insure that one’s use of a mark in color will support one’s EUTM registration, one should probably file in color, particularly if the mark is only used in color.

Another circumstance in which one should file in color is where it is important to protect a color or color combination that is distinctive and important to the overall commercial impression of the mark. In the following marks, for example, color is important to the overall commercial impression of each mark:



In the mark on the left, blue is important to the mark’s overall commercial impression since it is associated with IBM, which is nicknamed “Big Blue.” In the mark on the right, the yellow and green suggests the refreshing taste of lemon-lime. Therefore, consideration should be given to filing these marks in color.

Similarly, in special circumstances, the registration of a mark in color may help to avoid a conflict with another mark not in color. For example, the mark US depicted in alternating stripes of red, white and blue would have an entirely different commercial impression than, and hence be distinguishable from, the mark US depicted in plain black and white.

5. Consider whether to file internationally in English or in local languages.

Suppose a motion picture company in the United States is about to launch a major motion picture – GODFATHER III – in over 50 international markets, including in North and South America, throughout Europe, and in Asia. In addition to the movie itself, the company expects to market DVD’s and all sorts of licensed products from t-shirts to action figures to soft drinks. Should the company apply for its mark in English or in the various local languages of the countries in which it will show the movie and sell its products? That depends.

First, the motion picture company must consider whether the local audience in any given country will understand the mark in English. In some countries, the Netherlands, for example, English is widely spoken, so it may be presumed that the mark in English will be understood. Similarly, in some countries, the English mark will look like the mark in the local language. The English word GODFATHER, for example, is GUDFADERN in Swedish. Thus, it may be presumed that a Swede would understand the English word GODFATHER.

The use of the mark in the local language is more likely to support a registration of the mark in English for user requirement purposes when it can be shown that the local audience is familiar with English or when the mark in the local language and the English language are very similar. By contrast, that is less likely to be the case in a country where English is not as commonly spoken and the English and the local equivalent of the mark are very different (e.g., THE GODFATHER in English is IL PADRINO in Italian).

Another consideration is whether use of the mark in the local language by a third party will infringe the trademark owner's English language registration. In China, that is unlikely to be the case, since not only are many Chinese not familiar with English, but the language is very different from English and utilizes different characters. Even English marks that are transliterated into Chinese characters in such a way as to make them sound somewhat like their English counterparts, can have wildly different meanings based on the unique meaning of the Chinese characters of which they are composed. In such circumstances, it may be important to register the mark in the local language or in both English and the local language to afford maximum protection and enforcement capability.

6. Consider whether to file internationally in local characters.

The trademark attorney should also consider whether to register the mark in local characters in those countries that do not use the same characters as the mark that is sought to be registered.

A. In what countries is this consideration relevant?

Assuming the mark is in Roman characters, the trademark attorney must consider whether to register his client's mark in non-Roman characters in those countries that do not use Roman characters, for example, China, Japan, South Korea, Russia, and many Middle Eastern countries.

B. Why file in local characters?

There are a number of reasons why it is prudent to register a mark in local characters. First, assuming the mark is used in a particular country exclusively in local characters, use of the mark in local characters may not support a registration in Roman characters. Similarly, use of a mark in local characters may not infringe a registration in Roman characters, so without a registration in local characters, the trademark owner may be left without an effective way to enforce its mark. It is also important to bear in mind that third parties, including the media and consumers, are going to refer to the mark in writing (e.g., in newspapers, magazines, social media) in local characters. Thus, if the trademark owner does not choose a mark for itself in

local characters, the media and/or consumers will, and the trademark owner may not like the results. In other words, in order to control its own brand image, the trademark owner should proactively choose a mark in local characters that reflects that brand image in an accurate and positive light. Finally, if the trademark owner does not promptly file for its mark in local characters, the pirates will, thereby hijacking the trademark owner's mark.

C. Methods of Creating Local Character Marks

There are three basic methods of creating a mark in local characters. The first is to create an entirely new mark that has no relationship in sound or meaning to the original mark. The second method, is merely to translate the original mark into local characters, even if the mark in local characters sounds nothing like the original. Of course, this is not always possible, especially if the mark is a personal name or a coined word. The third method, called "transliteration," is to create a mark in local characters that sounds as much like the original mark as possible, even if the meaning of the mark in local characters is completely different. This method is often used for marks comprised of personal names or coined words.

China is a case in point. Creating a good Chinese character mark is particularly difficult for a number of reasons. First, Chinese dialects vary from region to region (e.g., the dialect in Beijing is Mandarin, whereas the dialect in Hong Kong is Cantonese), and character styles vary from country to country (e.g., mainland China uses simplified characters, whereas Taiwan uses traditional characters). Further, in the Chinese language, each character has both a sound and a meaning. Thus, a mark that is transliterated into Chinese characters from English may sound like the English original, but may mean something entirely different. Additionally, as noted above, some marks, such as personal names, cannot be translated. Thus, devising a transliteration that means the same as the original mark, or at least that has a good connotation, is extremely difficult and may require the assistance of a branding company that is specialized in devising Chinese character marks. One such example of a mark that sounds like the original, but has an excellent meaning, is the Chinese version of the COCA-COLA mark: It sounds like KE KU KE LE, and it means "tasty fun."

7. Consider whether to file internationally with goods and services identifications that are broad or narrow.

The traditional notion that it is best to file applications on an international level with the broadest identification of goods and services possible no longer always holds true, and in some cases is not even possible.

A. General Considerations

Generally, it has been thought that it is best to file broadly for three reasons: First, it has been assumed that if one can obtain broad protection for one's mark in a particular class, this will keep others from adopting and registering identical and similar marks for other goods and services in that class. Second, it has been assumed that the broader the coverage one has for one's mark in a particular class, the greater the infringement protection the registration for that mark will afford. Third, since counterfeiting is use of a mark by an unauthorized person on

goods or services contained in someone else's registration, it has been assumed that the broader the scope of the registration, the broader the scope of the protection against counterfeiting.

But, in some countries, these assumptions are not necessarily correct. And, at times, there are also good reasons to file narrowly. As for infringement protection, for example, the scope of protection in countries like the United States and the UK extends beyond the exact goods and services in the registration to similar goods and services that consumers would likely think came from the same source as the registered goods and services. By contrast, in China, a likelihood of confusion and therefore infringement protection is much more narrowly limited to what is actually covered by the registration. Furthermore, there are times when filing broadly can be detrimental as it may create conflicts with pre-existing marks. Consider Classes 3 and 9, for example, both of which contain a broad spectrum of goods. If a manufacturer of beauty products and sunglasses conducts a search that reveals pre-existing registrations of the mark being searched for laundry detergents in Class 3 and CD's in Class 9, it would make little sense to file so broadly as to encompass those goods. Filing with a narrow scope of protection limited to beauty products and optical products would help to avoid a citation and a possible claim.

B. Class Headings

At one point in time, many trademark lawyers assumed that filing for a class heading of the international classification system would cover all goods or services that *could* fall within that class. For example, as regards international Class 9, it was assumed by many trademark lawyers that "sunglasses," which is a good not explicitly mentioned in the class heading of Class 9, would be covered in a "gap" in the wording of that class heading even though the closest actual wording in the class heading of Class 9 is "optical apparatus and instruments."

In its "IP TRANSLATOR" decision, the Court of Justice of the European Union stated that the goods and services for which a trademark is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of protection conferred by the trademark. Thus, while it is permissible to use the wording of a class heading of the Nice Classification to identify the goods and services for which the protection of a trademark is sought, provided that such identification is sufficiently clear and precise as would be the case in Class 25 ("clothing, footwear, and headgear"), it is not permissible to do so where using a class heading (such as that of Class 9) would leave considerable ambiguity as to exactly what it is that the applicant intends to cover. Accordingly, as the "IP TRANSLATOR" case makes clear, it is vitally important for the trademark lawyer practicing on the international level to know how class headings are viewed under the local practice of the countries in which trademark protection is sought.

C. Chinese Subclasses

Although China subscribes to the International Classification system, it further subdivides international classes into Chinese subclasses and determines likelihood of confusion in strict conformity with the Chinese sub-classification system. So, for example, International Class 25 is divided into 13 Chinese subclasses and, generally speaking, the application for a mark covering an item from one Chinese subclass is considered likely to be confusing with a prior application or registration for that same mark for another item in the same Chinese

subclass, but not likely to be confusing with a prior application or registration for that same mark for an item in another Chinese subclass. Thus, under the Chinese sub-classification system, a mark for caps will be likely to be confused with the same mark for sun visors, but not necessarily with the same mark for gloves or scarves.

Thus, taking into account how the Chinese sub-classification system works, it may be prudent for trademark owners to register their marks in all Chinese sub-classes in a particular international class as this provides broader infringement protection against the pirates. On the other hand, since applicants in China are charged for their trademark applications on the basis of the number of goods or services covered above 10, the strategy of filing in all sub-classes in a given international class can get expensive, especially when the class involved is comprised of many Chinese sub-classes, as is the case with International Class 9.

8. Consider where to file.

Obviously the trademark lawyer is going to advise his or her client to file trademark applications where the client sells or intends to sell branded products. Here serious consideration should be given not only to current markets, but also potential markets in which the client would like to sell its products within the next 3-5 years. But where else should the client consider filing?

Most importantly, the client should consider filing in the countries in which it manufactures its products or is strongly considering manufacturing its products. In many countries (e.g., China) the manufacture of goods, even if solely for export, constitutes use for purposes of trademark infringement. Thus, if a US or French company manufactures its clothing in China and affixes the mark to the clothing in China prior to export, this could infringe a registration of the company's mark in the name of someone else, possibly even its own factory. Moreover, if the pirate were not only to register the company's mark, but were also to record it with Chinese Customs, it could block the company's shipment of branded products out of China.

Companies should consider where piracy for the particular types of goods they manufacture is most prevalent and file for their marks in those countries. For example, China, India, and Turkey are well known as manufacturing countries for clothing, other textile products, and jewelry and, unsurprisingly, they are also well known for trademark piracy in respect of these types of products. Therefore, it is prudent for clothing, textile and jewelry companies to register their core marks in these countries.

9. Consider filing priorities.

The United States and many other countries are members of the Paris Convention. Under Article 4 of the Paris Convention, there is what is known as a "right of priority." The right of priority provides that on the basis of a trademark application filed in one of the member countries of the Paris Union, the applicant may, within six months of that filing, apply for protection in any of the other member countries of the Union and have its subsequent application receive the filing date of the original application.

This right of priority can be very important in certain circumstances. Say, for example, a U.S. motion picture company is planning on releasing a major motion picture on Christmas day, December 25, 2017. Because the company expects the movie to be very popular with families, and particularly with children, it has lined up licensees to exploit the marketing potential of the movie. On October 1, 2017, two days prior to issuing a press release about the forthcoming movie, the movie company files for protection of its trademark in the United States for numerous products, among them, key chains, CD's, watches, backpacks, t-shirts, and toys and games, all of which are based on the movie. Foreign pirates and competitors of the movie company in other countries will have been closely following all press releases about the US movie company's upcoming holiday movies, with a view to filing trademark applications overseas for the titles of the upcoming movies in the most likely licensed categories. Thus, when they first learn of the new movie on October 3, they will immediately file trademark applications in their own countries, hoping to do so before the US movie company has a chance to act.

Because of its right of priority under the Paris Convention, the movie company will prevail. Any applications that it files for its movie title trademark in countries that are members of the Paris Union within 6 months of the US filing of the trademark will date back to the date it filed its first application, namely the US application filed on October 1, 2017. Thus, the client's right of priority under the Paris Convention is an important tool in the international trademark lawyer's arsenal that may be used to good effect in the appropriate circumstances.

10. Consider whether to file nationally or through an international filing system.

In some countries, trademarks may be filed nationally or through an international filing system. Knowing when, given a particular set of circumstances, it is better to use one method or the other is an important skill of the international trademark lawyer.

A. What are the most commonly used international trademark filing systems?

Perhaps the best known and most commonly used of the international trademark filing systems are the European Union Trademark ("EUTM") and the Madrid System, composed of the Madrid Agreement and the Madrid Protocol.

An EUTM registration is a single registration that protects a trademark in all 28 member states of the European Union ("EU"), which currently are: Austria, Belgium, Bulgaria, Croatia, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovak Republic, Slovenia, Spain, Sweden, and the United Kingdom. Notably absent from the EU are such commercially significant European countries as Norway, Switzerland, Turkey, and Russia.

Under the Madrid System, a trademark owner can obtain an International Registration ("IR") based on a home country application or registration and then designate that IR for extension to any of the countries that is a member of the Madrid System. Unlike the EUTM, the IR and the extensions of protection of the IR are not a single registration, but rather a bundle of national registrations that are centrally administered at the office of the World Intellectual Property Office ("WIPO") in Geneva, Switzerland.

B. What are the pros and cons of each system?

1. The EUTM System

The main advantages of the EUTM system over separate national filings in the 28 member countries of the EU are primarily the following: First, it is clearly less costly. Whereas obtaining trademark coverage nationally in each of the 28 member countries of the EU is likely to cost at least \$2,000 per country, or approximately \$56,000, obtaining coverage through the EUTM system is not likely to cost more than approximately \$6,000. Second, since it has only one trademark number and one trademark date, the EUTM is easier to administer than 28 national registrations. Further, assignments, changes of name and address, and other across-the-board changes can be accomplished centrally with an EUTM, but must be accomplished on a country-by-country basis with national registrations. Third, there is a simplified user requirement under the EUTM system than with national registrations. Whereas, with national registrations, the user requirement must be satisfied on the national level, with an EUTM, the user requirement can be satisfied by genuine commercial use in several commercially important EU countries. Finally, under the EUTM system, there are EU-wide enforcement mechanisms that make enforcing one's marks easier under the EUTM system than under the national system, which requires enforcement in each country.

Yet there are disadvantages to EUTM filing versus national filings as well. The EUTM system is what is known as an "all or nothing" system. That means that since an EUTM is a unitary right, if the mark fails in any one EU country (for example, because it is descriptive in Finnish), it fails as a whole. While the applicant of a failed EUTM application has the opportunity to convert the failed EUTM application into direct national filings in the member states of the EU where the mark did not fail (in the prior example, all countries other than Finland), nevertheless the conversion process is costly and may even be more expensive than filing nationally in the countries of interest would have been had the applicant filed nationally from the very beginning. Moreover, in some cases, the EUTM application can take longer to be examined and to mature into a registration than a direct national filing. For example, one can obtain a trademark registration in the Benelux within a matter of a few weeks on expedited examination, whereas obtaining a registration of an EUTM usually takes 6 months to a year.

2. The Madrid System

As with the EUTM system, the chief advantage of the Madrid System is cost savings. Here the cost savings arise from the fact that, in the absence of problems, local agents are not necessary. Without local agents, there are no foreign associate fees and no powers of attorney to get signed or legalized. The Madrid System is also a simpler system to administer than separate national registrations: There is one simple application form; one registration (the IR registration) with one registration number and one renewal date; a simple renewal; and a centralized method for recording changes (e.g., assignments, address changes, etc.). There is also, in comparison to some national practice, a very speedy examination. For example, under the Madrid Protocol, the review period for applications is limited to 18 months, whereas for national applications (e.g., with an Italian or a Turkish application), it can go on for years.

Still there are serious limitations – some based on local practice and some based on problems inherent in the Madrid System itself.

Among the limitations based on local practice in the USA, for example, is the restricted specification of goods and services based on the US application or registration. The USPTO requires a detailed specification of goods and services, with the goods and services limited to those for which use or bona fide intent to use can be demonstrated. Since, for a US applicant, the IR will be based on the US application or registration, the IR is necessarily limited to the goods and services in the home country application or registration.

There are also limitations based on the form, color and language of the mark applied for. As noted above, local practice regarding the format, color and language of a mark can vary from country to country. Thus, since the filing in one's home country becomes the basis for an IR, the format, color and language of the home country mark is carried forward into the international filing. But, as we have previously seen, "one size does not fit all." In addition, whereas in one's home country, one might have chosen to file in standard characters, a standard character filing may not work in another country where the mark in standard characters presents registrability issues (because it is viewed locally as descriptive, a surname, etc.), where the use of the mark in a stylized format or with a design will not support the standard character registration, or where the standard character registration does not provide ample infringement protection against a "look alike" local mark that means something entirely different to the local population than the mark in the standard character registration.

Perhaps the most important disadvantage of the Madrid System is something known as "central attack." Under the Madrid Protocol's central attack provision, an IR is dependent for the first 5 years of its life on the validity of the underlying basic application or registration. Thus, if the basic right fails, partially or completely, the IR fails to the same extent. Thus, if within the first years of the life of an IR, the US application that forms the basis of the IR is successfully opposed, the IR and all of its designations of protection will fail. Similarly, if a US applicant files a Statement of Use for only some of the goods in its basic US application, then the IR and all the designations of that IR based on that US application will fail to the same extent. There is an opportunity to transform a failed IR into a national application in each of the designated countries; however, this is still a significant problem for an applicant from a common law country, like the US, since the chances of central attack are greater in such a country than in one based on statutory law.

C. What other major international trademark filing systems are there?

In addition to the EUTM and the Madrid System, the other major international trademark filing systems are the African Intellectual Property Organization ("ARIPO") and the African Regional Intellectual Property Organization ("OAPI"). Though less often used than the EUTM and Madrid Systems, they can still be useful tools under appropriate circumstances.

ARIPO is composed of members of certain English-speaking African countries, including Botswana, Gambia, Ghana, Kenya, Lesotho, Liberia, Malawi, Mozambique, Namibia, Rwanda, Sierra Leone, Sudan, Swaziland, Uganda, United Republic of Tanzania, Zambia, and

Zimbabwe. It enables applicants to obtain a single registration for a trademark covering the aforementioned members of the Lusaka Agreement.

OAPI is composed of members of certain French-speaking African countries, including Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoros, the Republic of Congo, Côte d'Ivoire, Gabon, Guinea, Equatorial Guinea, Mali, Mauritania, Niger, Guinea Bissau, Senegal, and Togo. It enables applicants to obtain a single registration for a trademark covering the aforementioned members of the Bangui Agreement.

CONCLUSION

The global economy requires today's trademark lawyers to have a global perspective. Only by understanding the similarities and differences in national trademark practice around the globe can today's trademark lawyers effectively guide their clients to protect, maintain, and enforce their marks internationally, and to do so in the most cost-effective manner.