



Question Q239

National Group: AIPPI-US Division of AIPLA

Title: **The Basic Mark Requirement Under the Madrid System**

Summary:

The Madrid Protocol to the International Arrangement of Madrid for the International Registration of Trademarks has been available in the United States since 2003, but is used by only a small fraction of potential international applicants. The reasons are diverse. In part the lack of use can be attributed to unfamiliarity, but also skepticism plays a role as there is minimal initial cost saving and the cost reallocation brings additional bureaucratic intrusion. Moreover the so-called Triple Identity Rule -- same mark, same applicant same goods/services -- prevents advantageous variation of coverage among member states. United States applicants are at a disadvantage, because of narrow and specific lists of goods and services, and the duration of prosecution and opposition procedures. Removal of the basic mark requirement is thought to offer a possible solution, but doing away with it would also eliminate central attack and any modifications of the Protocol would have to be the subject of negotiations between members and probably a diplomatic conference, which would be expensive.

United States practitioners broadly agree that if the system is to be changed, it should be modified to provide for central filing at WIPO, with WIPO functioning as a mailbox and this would eliminate or at least minimize uneven registrability standards among current national "home" trademark offices.