
New Members Join Madrid Protocol - Obtaining Foreign Trademark Rights Made Easier Than Ever

Legal Alert

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Brazil, a country having one of the largest economies in Latin America, has become the latest country to join the Madrid Protocol, effective October 2, 2019. The Madrid Protocol provides a cost-effective and efficient way for trademark owners to ensure protection for their valuable trademarks in foreign countries through the filing of a single application through the U.S. Patent and Trademark Office. At the time of filing, a trademark owner is able to identify other member countries and obtain a trademark registration in those countries just as if that country had registered the trademark through a direct filing. The Madrid Protocol also simplifies the subsequent management of the trademark, because a simple, single procedural step serves to record subsequent changes in ownership, address changes, and renewal of the trademark registration (at 10 year increments).

Securing foreign trademark registrations is important because trademark rights are territorial, meaning they are only granted on a country-by-country basis. In other words, having trademark protection in the U.S. does not protect or confer rights to a trademark in other key markets. Furthermore, in most countries, the only way to acquire recognized trademark rights is by obtaining a trademark registration, which is often given to the first applicant regardless of the applicant's (or any other company's) first commercial use of the mark. That means that even if you are using your trademark in a certain country, if you did not file for foreign trademark registrations early enough, someone else can lawfully own the trademark in a particular country.

In addition to Brazil, some countries that have joined the Madrid Protocol in recent years are Canada, Mexico and India. Other member countries include China, the European Community, Japan, Singapore, and South Korea. There are nearly 100 member countries in total.

For more information, please contact Jordan LaVine or another member of Flaster Greenberg's Intellectual Property practice group.

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