

**THE MADRID PROTOCOL: WILL THIS INTERNATIONAL SYSTEM  
SUCCEED IN THE UNITED STATES?**

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**ABSTRACT**

The Madrid Protocol, adopted in 1989, is an international system for the registration of marks. Currently, there are over sixty nations that are members of the Protocol, including the United States, which officially became a member in 2003. Beginning November 2, 2003, U.S. businesses were afforded the opportunity of applying for mark protection under the Protocol, yet this paper concludes there is no guarantee that the Protocol will be successful within the United States. This purpose of this paper is threefold: (1) to present an overview of the Madrid Protocol and detail the procedural requirements that make up the system, (2) to provide the reader with a historical account on the United States' accession to this Protocol, taking time to outline the amendments made to the Lanham Act and analyze the various advantages and disadvantages to filing for protection under the Protocol, and (3) to foreshadow the possible impact the Protocol will have within the United States.

**I. INTRODUCTION**

“Lightning Consulting” is a New York-based firm that focuses on providing consulting services to private schools across the United States, and the small twenty-person firm is considering whether to expand their business internationally over the next few years. While the

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firm has not protected its name by registering “Lighting Consulting” with the United States Patent and Trademark Office (“USPTO”), President Jane Smith and her staff are considering doing so in the next few months. The consulting firm is also considering registering its mark in Mexico, Canada, the United Kingdom, and other nations across Europe and Asia, to protect the name should they wish to venture into these foreign markets.

While it may seem that manually registering its trademark name on a country-by-country basis is the most logical solution for the consulting firm, it has other options. As of November 2, 2003, United States’ businesses now have the option of registering marks under the Madrid Protocol (“Protocol”) with the USPTO. “The Protocol, which is administered by the International Bureau (“Bureau”) of the World Intellectual Property Organization (“WIPO”), augments a framework for the international registration of trademarks initially created by the Madrid Agreement (“Agreement”).”<sup>1</sup> Currently, there are over 400,000 international trade mark registrations in force under the Madrid System for registering trademarks.<sup>2</sup> Because it is a new option, the Protocol could be relatively misunderstood by businesses. The Protocol is *not* the correct solution for every firm’s trademark needs, but is the Protocol the right answer for Lightning Consulting and Ms. Smith? Before this question can be answered, it is important to look at the requirements for filing for international trademark protection using the Protocol and the advantages and disadvantages to using the system. This paper’s purpose is to educate the reader on Protocol basics and foreshadow the effect the Protocol will have within the United States. Ultimately, this paper will conclude that the Protocol is an excellent first step toward an

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<sup>1</sup> Peter Wilner, *The Madrid Protocol: A Voluntary Model for the Internationalization of Trademark Law*, 13 DEPAUL-LCA J. ART & ENT. L. 17, 17 (2003).

<sup>2</sup> Sam Mamudi, *Swimming Against the Tide*, MANAGING INTELLECTUAL PROPERTY, Mar. 1, 2003, available at <http://legalmediagroup.com/mip>.

efficient, global system for the registration of marks, but this paper will also note there are uncertainties as to how successful the Protocol will initially be within the United States.

Part II of this paper will focus on the Madrid Protocol, detailing the various requirements necessary to file for international trademark protection. Part III of this paper will discuss the road to U.S. membership in the Protocol, looking at the debated issues in the history of the Protocol and the decision of the U.S. government to join the Protocol. This section will also detail the sections added to the Lanham Act and study the various advantages and disadvantages to using the Protocol for registering an international mark. Part IV of this paper will foreshadow the effect the Protocol will have within the United States, looking at current Protocol membership and the needs of U.S. businesses, firms, and practitioners. Finally, Part V will conclude this paper.

## **II. UNDERSTANDING THE MADRID PROTOCOL**

### *A. Defining the Madrid Agreement & the Madrid Protocol*

The Madrid System for the registration of trademarks is governed by two specific treaties: the Madrid Agreement Concerning the International Registration of Marks, first adopted in 1891, and the Protocol Relating to the Madrid Agreement, adopted in 1989.<sup>3</sup> Before moving into the specifics of the Protocol, it is necessary explain the purpose behind and objectives of the Madrid Agreement and why there was a need to update the Agreement via the adoption of the Protocol. Briefly, the Madrid Agreement:

allowed nationals of the countries who are members of the Agreement to protect their trademarks, whether for goods or for services, in any or all of the other member countries. This is done by means of a single international application that is filed in one place, in one language (French), with a minimum of

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<sup>3</sup> WIPO, *The Madrid Agreement and Protocol: Objectives, Main Features, Advantages*, at [http://www.wipo.int/madrid/en/pub\\_418/intro.htm](http://www.wipo.int/madrid/en/pub_418/intro.htm) (last visited Oct. 30, 2003).

formalities, with one fee and paid in a single currency. This results in only one registration, with one number and one renewal date.<sup>4</sup>

Many nations, however, were uninterested in signing the Agreement. In fact, “[t]hese features of the Agreement proved to be bars to U.S. accession.”<sup>5</sup> It is beyond the scope of this paper to more particularly describe why hundreds of nations were uninterested in joining as a Member State to the Madrid Agreement; however, this paper does submit that a reason for drafting the Protocol was to attract additional nations, including the United States, into the trademark registration system.

The Protocol was drafted in Madrid, Spain on June 27, 1989, close to one hundred years following the adoption of the Madrid Agreement.<sup>6</sup> The Protocol appears similar in structure to the Agreement, but various changes were made in order to improve the treaty from its predecessor of the nineteenth century. Overall, the main objectives of the Protocol remain the same as the Agreement: (1) assist firms with obtaining protection for marks and (2) ease the management of the marks on an international level.<sup>7</sup> The Protocol’s requirements for registering a mark, as presented in the following section, are more liberal than those set in place by the Madrid Agreement.

## B. *The Basics of the Madrid Protocol*

### 1. **Who Can Apply?**

An application for international mark protection can be filed “by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is

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<sup>4</sup> Int’l Trademark Ass’n., *Madrid Protocol*, at <http://www.inta.org/madrid> (last visited Oct. 30, 2003) [hereinafter INTA Overview].

<sup>5</sup> Wilner, *supra* note 1, at 24.

<sup>6</sup> INTA Overview, *supra* note 4.

<sup>7</sup> WIPO, *The Madrid Agreement and Protocol: Objectives, Main Features, Advantages*, at [http://www.wipo.int/madrid/en/pub\\_418/objective.htm](http://www.wipo.int/madrid/en/pub_418/objective.htm) (last visited Oct. 30, 2003).

domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid Protocol . . . .”<sup>8</sup> Thus, if a person or legal entity has no connection to one of the nations<sup>9</sup> that are currently a Member State to the Madrid Protocol, the person or entity cannot apply for Protocol protection.<sup>10</sup>

## 2. What Is Protected Under the Protocol?

By applying for protection under the Protocol, each mark is protected in the same way it would have been if the mark was independently registered in that country.<sup>11</sup> Or, more specifically, in each designated nation that does not refuse protection,<sup>12</sup> “[t]he owner of a trademark has exclusive right to use it on the product it was intended to identify and often on related products. Service-marks receive the same legal protection as trademarks but are meant to distinguish services rather than products.”<sup>13</sup> Many of the protections in each nation will be dependent on the federal and/or state laws of the particular country. Because of these possibilities, the author strongly recommends a business retain competent counsel before applying for protection using the Madrid Protocol.

## 3. Where Can Protection Be Obtained?

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<sup>8</sup> WIPO, *Who May Use the System?*, at [http://www.wipo.int/madrid/en/pub\\_418/who.htm](http://www.wipo.int/madrid/en/pub_418/who.htm) (last visited Oct. 30, 2003); see also Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, art. 2(1), June 27, 1989, available at [http://www.wipo.int/madrid/en/legal\\_texts/pdf/madrid\\_protocol.pdf](http://www.wipo.int/madrid/en/legal_texts/pdf/madrid_protocol.pdf) (last visited Nov. 10, 2000) [hereinafter Madrid Protocol].

<sup>9</sup> For a listing of the nations that are members to the Madrid Agreement and Madrid Protocol, see generally <http://www.wipo.int/treaties/en/documents/english/word/g-mdrd-m.doc> (last visited Nov. 19, 2003) [hereinafter Member States Listing].

<sup>10</sup> *Id.*

<sup>11</sup> See Madrid Protocol art. 4; WIPO, *Protecting Your Trademark Abroad: Twenty Questions About the Madrid Protocol*, 14 available at [http://www.wipo.org/freepublications/en/marks/428/wipo\\_pub\\_428.pdf](http://www.wipo.org/freepublications/en/marks/428/wipo_pub_428.pdf) (last visited Nov. 13, 2003) [hereinafter *Twenty Questions*].

<sup>12</sup> See *infra* Part II.B.8.

<sup>13</sup> Legal Information Institute, *Trademark Law: An Overview*, at <http://www.law.cornell.edu/topics/trademark.html> (last visited Nov. 19, 2003).

An applicant must apply for protection in one or more of the Member States<sup>14</sup> where the mark is to be protected.<sup>15</sup> “A country may be designated only if that country and the country of origin are both party to the same treaty (Agreement or Protocol).”<sup>16</sup> It is possible to list additional Member States after filing the initial application.<sup>17</sup> Thus, if a new nation joins onto the Protocol after the registration is filed, the Protocol allows a registrant to supplement one’s application to add the new Member State.

#### 4. **How Much Does Registration Cost?**

Fees under the Madrid Protocol<sup>18</sup> are calculated using Swiss francs, and the fees required must be paid in Swiss francs directly to the International Bureau of the WIPO.<sup>19</sup> Each applicant must pay a basic fee of 653 Swiss francs (roughly \$500.00 USD) for a black and white mark or 903 Swiss francs (roughly \$692.00 USD) for a color mark.<sup>20</sup> In addition, each applicant must pay a certain fee for each Member State to which the applicant is applying for protection.<sup>21</sup> This fee is currently set at either (1) 73 Swiss francs (roughly \$56.00 USD) per nation or (2) a custom fee fixed by the specific country, although this custom fee cannot be set higher than the amount

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<sup>14</sup> See Member States Listing, *supra* note 9.

<sup>15</sup> See WIPO, *Where Can a Mark Be Protected?*, at <http://www.wipo.int/madrid/en/general/where.htm> (last visited Oct. 30, 2003).

<sup>16</sup> *Id.*

<sup>17</sup> *Twenty Questions*, *supra* note 11.

<sup>18</sup> See generally Madrid Protocol art. 8.

<sup>19</sup> See *Twenty Questions*, *supra* note 11, at 10. In some cases, the Office of origin may handle sending the fees to the International Bureau. *Id.* For the actual fee schedule used in the United States, see USPTO, 2004 Fee Schedule, at <http://www.uspto.gov/web/offices/ac/qs/ope/fee2004jan01.htm> (last modified Jan. 1, 2004).

<sup>20</sup> See *Twenty Questions*, *supra* note 11, at 9. For the conversions used in this paper, the author used the Currency Converter application available free of charge on Yahoo! Finance. See generally Yahoo! Currency Converter, at <http://finance.yahoo.com/m3?u> (last visited Nov. 19, 2003). As of November 19, 2003, \$1.00 U.S. dollar was equivalent to \$1.30 Swiss franc.

<sup>21</sup> *Twenty Questions*, *supra* note 11.

that would be paid for independently registering the mark with the country.<sup>22</sup> Each nation can also charge a supplementary fee of 73 Swiss francs (roughly \$56.00 USD) for each class of goods and services listed beyond the third class.<sup>23</sup> An Office of origin is allowed to charge a handling fee to the applicant for forwarding the application materials to the WIPO, but some Offices of origin forego this fee.<sup>24</sup> From the preceding discussion of fees, it becomes clear that the fee system of the Protocol is complicated; therefore, this author suggests interested parties use the fee calculator available on WIPO's web page.<sup>25</sup>

### 5. How is a Mark Registered?

After the applicant has picked the Member States in which he or she wishes to apply for international mark protection, the applicant must send their mark to the central mark office in his or her nation, the Office of origin, or the USPTO in the United States.<sup>26</sup> The application can be filed either in English or French, although a particular Office of origin may restrict the applicant to using only one of these two languages.<sup>27</sup> It is initially up to the Office of origin to certify that

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<sup>22</sup> *Id.* “The USPTO charges \$100.00, per class, if the international application is based on more than one basic U.S. application or registration.” See USPTO, *Trademark Electronic Application System: USPTO Tips for Filing on Paper*, at <http://madridforms.uspto.gov/MiTEAS/notices.html#tips> (last visited Nov. 20, 2003); see also 37 C.F.R. § 7.11(a)(9) (2003).

<sup>23</sup> *Twenty Questions*, *supra* note 11, at 9.

<sup>24</sup> *Id.* at 24.

<sup>25</sup> See WIPO, *International Registration of Marks - Fee Calculation*, at <http://www.wipo.int/madrid/feecalc/FirstStep> (last visited Nov. 20, 2003). The author used the fee calculator to determine the following calculation, which may have taken hours of research without the online fee calculator: a non-color mark from the United States of America registered in Armenia, Japan, Norway, and Turkmenistan would cost 1,768 Swiss francs.

<sup>26</sup> Although the electronic forms are currently unavailable, an applicant will soon be able to register one's Madrid Protocol trademark application completely over the Internet. See USPTO, *Trademark Electronic Application System*, at <http://www.uspto.gov/teas/index.html> (last visited Nov. 20, 2003). Madrid Protocol forms are available on the USPTO's website. See USPTO, *Madrid Protocol Forms*, at <http://madridforms.uspto.gov/MiTEAS/> (last visited Nov. 20, 2003).

<sup>27</sup> *Twenty Questions*, *supra* note 11.

the basic information listed in the application is correct and authentic.<sup>28</sup> Upon certifying the information, the Office of origin will forward the application to the WIPO office.

The International Bureau at the WIPO is then responsible for ensuring the application has been correctly filed.<sup>29</sup> Once it determines the mark has been successfully filed, the Bureau publishes the mark in the *WIPO Gazette of International Marks* and forwards the registration application to the designated countries.<sup>30</sup> It is important to note that the Bureau has no role in checking for duplicate marks or similar marks in the designated countries; this role is purely the responsibility of the designated Member States that receive the application.<sup>31</sup>

After the Bureau reviews the information, the office will distribute the application to the designated Member States around the globe for their review.<sup>32</sup> “For the first five years, the international registration is dependent on the application or registration with the Office of origin . . .”<sup>33</sup> The effective date of the application used for judging time requirements and the like is “the date on which the international application was filed with the Office of origin, provided that it reaches the International Bureau within two months and that no essential elements . . . are missing.”<sup>34</sup> Thus, if the basic registration is somehow cancelled within five years from the date the registration is submitted to the Office of origin, the international registrations may also be

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<sup>28</sup> *Id.*

<sup>29</sup> *Id.*

<sup>30</sup> See *id.*; WIPO, *The International Registration*, at <http://www.wipo.int/madrid/en/general/rgstrn.htm> (last visited Mar. 05, 2004).

<sup>31</sup> *Twenty Questions*, *supra* note 11.

<sup>32</sup> R.G.C. Jenkins & Co., *The Madrid Protocol*, at [http://www.jenkins-ip.com/serv/t\\_trad06.htm](http://www.jenkins-ip.com/serv/t_trad06.htm) (last visited Mar. 05, 2004).

<sup>33</sup> *Twenty Questions*, *supra* note 11.

<sup>34</sup> *Id.* at 11.

cancelled;<sup>35</sup> however, once the five-year period passes, “the international registration becomes independent of the basic registration or basic application.”<sup>36</sup> The process of canceling the international registration, known as a “central attack,” can be mitigated, as the Protocol allows the registrant, if he or she performs certain administrative steps, to continue using the same applications on a country-by-country basis.<sup>37</sup> Central attacks, however, are quite infrequent, as in 2000, only 140 international registrations were canceled due to central attacks.<sup>38</sup> Overall, registration for a mark “is effected for ten years,”<sup>39</sup> and each international mark can be renewed for additional ten year periods, provided the applicant pays all required fees.<sup>40</sup>

## 6. Replacing a National Registration.

Article 4bis of the Protocol announces that an international registration in a designated nation replaces the earlier-submitted application for mark protection.<sup>41</sup> Such replacement occurs only when: (1) both the prior and current registrations are owned by the same entity and (2) the goods/services listed in the prior registration are the same goods/services listed in the current international Protocol application.<sup>42</sup> “[I]t is up to each member country of the Protocol to determine the legal effect of these [replacement] provisions . . . .”<sup>43</sup>

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<sup>35</sup> WIPO, *Dependence on Basic Registration or Application*, at <http://www.wipo.int/madrid/en/general/depend.htm> (last visited Mar. 05, 2004); see also *Twenty Questions*, *supra* note 11, at 13.

<sup>36</sup> WIPO, *Dependence on Basic Registration or Application*, at <http://www.wipo.int/madrid/en/general/depend.htm> (last visited Mar. 05, 2004).

<sup>37</sup> *Twenty Questions*, *supra* note 11, at 13..

<sup>38</sup> *Id.*

<sup>39</sup> Madrid Protocol, *supra* note 8, art. 6(1).

<sup>40</sup> *Id.* art. 7; WIPO, *Term of Registration; Renewal*, at <http://www.wipo.int/madrid/en/general/renewal.htm> (last visited Mar. 05, 2004).

<sup>41</sup> R.G.C. Jenkins & Co., *supra* note 32 (under subheading “Replacement of National Registration by an International Registration”).

## 7. **Assignment/Licensing of a Trademark.**

“A Madrid Protocol registration can be assigned in respect of some or all of the designated countries, and in respect of some or all of the goods or services.”<sup>44</sup> The applicant is required to notify the Bureau of the assignment, and each designated country has the right to refuse recognition of the trademark after the assignment.<sup>45</sup> Also, the assignee must be a person who could have originally filed the Protocol application.<sup>46</sup> In addition to assigning a Protocol trademark, an applicant can also license some or all of the trademark to some or all of the designated countries.<sup>47</sup>

## 8. **Explanation of the Right of Refusal.**

Each designated country has the right to refuse protection of a mark.<sup>48</sup> A country’s refusal, which is published in the International Register, “may be made on any of the grounds on which an application for registration filed direct with that Office might be refused.”<sup>49</sup> Generally, a nation has twelve months to review an application and either permit or refuse protection. However, Article 5(2) of the Protocol gives Member States upon request either eighteen months or more, in limited circumstances, to refuse protection.<sup>50</sup> In most cases, over eighteen months is

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<sup>42</sup> *Id.*

<sup>43</sup> *Id.*

<sup>44</sup> *Id.* (under subheading “Assignment”).

<sup>45</sup> *See* Madrid Protocol art. 9ter.

<sup>46</sup> John L. Welch, *Madrid Bound: The United States Approaches Ratification of the Madrid Protocol*, INTELLECTUAL PROPERTY TODAY, Jan. 2001, at 30.

<sup>47</sup> R.G.C. Jenkins & Co., *supra* note 32.

<sup>48</sup> *See* Madrid Protocol art. 5(1); *Twenty Questions*, *supra* note 11, at 11.

<sup>49</sup> *Twenty Questions*, *supra* note 11, at 11.

allowed only if the Member State notifies the International Bureau within eighteen months that there is a possibility the mark will be refused or unless the designated country refuses marks based on an opposition.<sup>51</sup> If a designated nation refuses protection, the applicant can contest the refusal.<sup>52</sup>

### 9. Supplementing One's Application.

Provided the applicant is willing to pay a fee, the applicant must only fill out a form and send the form to the International Bureau in order to supplement the Protocol application.<sup>53</sup> Potential items that may need to be supplemented include: (1) name and address changes; (2) cancellation of the international registration; or (3) canceling registration in one or more of the designated countries.<sup>54</sup> An applicant may not, however, record or publish information concerning licenses or security interests for a mark.<sup>55</sup>

#### C. A Look at the Differences Between the Two Treaties

The Agreement and the Protocol have many similarities; however, a nation's membership within one of the two treaties does not guarantee the nation's membership with the other treaty. In fact, there are substantial differences between the Agreement and the Protocol. First, the Protocol is more flexible than the Agreement in terms of what a person can petition for

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<sup>50</sup> See Madrid Protocol art. 5(2); *Twenty Questions*, *supra* note 11, at 12; WIPO, *Effects in Designated Countries; Refusal*, at <http://www.wipo.int/madrid/en/general/refusal.htm> (last visited Mar. 05, 2004) [hereinafter WIPO Effects].

<sup>51</sup> See *Twenty Questions*, *supra* note 11, at 12; WIPO Effects, *supra* note 50.

<sup>52</sup> *Twenty Questions*, *supra* note 11, at 12.

<sup>53</sup> See Madrid Protocol arts. 9, 9bis, 9ter; see also *Twenty Questions*, *supra* note 11, at 14.

<sup>54</sup> *Twenty Questions*, *supra* note 11, at 14.

<sup>55</sup> Mikael Pawlo, *General Information on Trademark Law*, at <http://www.algonet.se/~mpawlo/general.html> (last updated Dec. 22, 1996).

protection from Member States.<sup>56</sup> More specifically, the Protocol allows an applicant to apply for a mark simply filed with the Office of origin, while the Agreement requires an applicant to register a mark registered with the Office of origin.<sup>57</sup> Second, the Protocol affords more time for each Member State to review applications and declare if the petitioned mark cannot be afforded protection.<sup>58</sup> Third, the Protocol allows for each Member State to collect more fees for each application.<sup>59</sup> Nevertheless, while fees have increased, each applicant should still expect to pay less than if filing independent national applications.<sup>60</sup> Fourth, the Protocol is more flexible in that if the initial application is refused, “the international registration may be converted into national applications.”<sup>61</sup> Fifth, as mentioned above, the language requirements for filing under the Protocol changed, giving applicants the option of filing in either English or French.<sup>62</sup>

These five major differences all have one common theme: each is an attempt by the Member States to attract more nations to join the Protocol. For example, by increasing the amount of fees a nation can charge for each review of an application, fewer nations will have a monetary complaint to joining the Protocol. By allowing the applicant to file their application in English, some 677 million persons around the globe now have the ability to apply for protection

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<sup>56</sup> WIPO, *The Madrid System: Basic Features*, at [http://www.wipo.int/madrid/en/guide/part\\_a/madrid.htm](http://www.wipo.int/madrid/en/guide/part_a/madrid.htm) (last visited Nov. 13, 2003) [hereinafter *Madrid System: Basic Features*].

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*; see also Madrid Protocol art. 5(2).

<sup>59</sup> *Madrid System: Basic Features*, *supra* note 56.

<sup>60</sup> Int’l Trademark Ass’n, *Madrid Protocol*, at [http://www.inta.org/info/basics\\_mprotocol.html](http://www.inta.org/info/basics_mprotocol.html) (last visited Nov. 13, 2003).

<sup>61</sup> *Id.*; see also *Madrid System: Basic Features*, *supra* note 56.

<sup>62</sup> Int’l Trademark Ass’n, *supra* note 60.

under the Protocol.<sup>63</sup> Overall, these five differences helped convince the U.S. to join the Protocol, but as presented in the following section, the decision to join was not a simple or short road for the United States.

### **III. THE ROAD TO UNITED STATES MEMBERSHIP**

#### *A. Debating the Issues*

Although all may seem calm today between the Member States, a host of issues were hotly debated at the Diplomatic Conference regarding the Madrid Protocol, which took place in Madrid, Spain in 1989.<sup>64</sup> In fact, many of the debated issues centered around the United States, who, although not a party to the Conference, was squarely in the minds of many of the Member States. Without explaining every situation that was debated at the Conference, it is important to look at two specific issues. First, Article 5(2) of the Protocol lays out the time in which a Member State has to reject a trademark application for a host of reasons.<sup>65</sup> Swiss delegates argued before the Conference that eighteen months was a sufficient time to complete an examination of the proposed mark, especially considering this timeframe was six months more than offered under the Agreement (that only gave Member States twelve months to refuse protection).<sup>66</sup> Delegates from the Federal Republic of Germany and Austria, however, pushed for a more liberal timeline requirement.<sup>67</sup> Instead of a specific number of days for review, Germany and Austria recommended the Protocol adopt a timeline that gave some nations, if

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<sup>63</sup> The English-Speaking Union, *Frequently Asked Questions*, at <http://www.esu.org/faqs.html#howmany> (last visited Nov. 19, 2003).

<sup>64</sup> Wilner, *supra* note 1, at 27.

<sup>65</sup> See Madrid Protocol art. 5(2) (mentioning that a nation has either twelve months, eighteen months, or even longer to refuse protection to a trademark).

<sup>66</sup> Wilner, *supra* note 1, at 28.

<sup>67</sup> *Id.*

needed, more than eighteen months to review a proposed mark.<sup>68</sup> England, for example, uses a method of examining marks whereby firms first rely on the national office's review of the mark before publicly opposing a mark.<sup>69</sup> Thus, certain nations, like England, whose firms rely on extensive national review, and the United States, which has an opposition system, would need more than eighteen months to review the thousands of international applications they would receive each month, if a member of the Protocol. Eventually, the Swiss delegates and their proponents withdrew their objection, and the current language of the Protocol, which offers Member States sufficient time to review marks, was included.<sup>70</sup>

Second, Article 9*quinquies* states that if an international mark is somehow cancelled, the applicant can proceed to convert his application into various national applications. Spain's delegates requested a provision that allowed for such a procedure to be acceptable not only when the Office of Origin requested the cancellation but also when the registration was cancelled "for any other reason."<sup>71</sup> Other delegates, including those from the European Commission and from Germany, disagreed with Spain and wanted the conversion provision applicable only when the application had fallen pray to a "central attack."<sup>72</sup> In the end, the more specific language requested by Germany and the European Commission was adopted, giving Member States and applicants specific guidelines. As one commentator notes, this would prevent "an applicant, upon seeing that his basic application was about to be cancelled, [from withdrawing] that

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<sup>68</sup> *Id.*

<sup>69</sup> *Id.*

<sup>70</sup> *Id.* at 28-29.

<sup>71</sup> Wilner, *supra* note 1, at 30.

<sup>72</sup> *See id.* at 30-31; *see also supra* Part II.B.5 (discussing the procedure of "central attacks").

application in order to apply to individual countries for separate registrations.”<sup>73</sup> The finalized language of the Protocol offers more security to Member States that their central mark office will not perform countless hours of work on an application, only to see the applicant pull the application in exchange for greener pastures.

Both of these issues “were resolved with an eye toward maintaining a balance between an efficient registration process and a frame work that could accommodate different registration systems.”<sup>74</sup> While the United States was in favor of such a balance, there was another key problem that nearly prevented the United States from joining the Protocol. One of the major hurdles for the United States to join the Protocol was a particular provision that gave the European Union a vote in the Assembly.<sup>75</sup> U.S. officials were dissatisfied with this provision, which they claimed “gave Europe a double vote and set a precedent for other treaties.”<sup>76</sup> In February 2000, however, the Protocol Member States voted to reject the European Union’s right to a vote in the Assembly, which was assigned, among other matters, the task of “deal[ing] with all matters concerning the implementation of [the Madrid] Protocol.”<sup>77</sup> After voting that the EU would not have a vote in the Assembly, the United States had no remaining opposition to the Protocol,<sup>78</sup> and it was simply a matter of time before the United States would complete the administrative steps necessary to become a Member State.

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<sup>73</sup> Wilner, *supra* note 1, at 31.

<sup>74</sup> *Id.* at 31.

<sup>75</sup> Sabra Chartrand, *After 13 Years of Ruminating, the United States Agrees to Join a Global Trademark System*, N.Y. TIMES, Dec. 16, 2002, at C16.

<sup>76</sup> *Id.*

<sup>77</sup> Madrid Protocol art. 10(2)(1), *supra* note 8, available at [http://www.wipo.int/madrid/en/legal\\_texts/pdf/madrid\\_protocol.pdf](http://www.wipo.int/madrid/en/legal_texts/pdf/madrid_protocol.pdf) (last visited Nov. 10, 2003).

<sup>78</sup> Chartrand, *supra* note 75.

B. Congress' Role & Changes to the Lanham Act

It took almost fourteen years from the inception of the Protocol for the United States to become an active Member State. Overall, the decision to join the Protocol was based upon the need of U.S. businesses to expand globally. As Gary Duvall and Elizabeth Buckingham note, “U.S. participation in the Madrid Protocol is related to increasing globalization in several ways, including the recognition that U.S. businesses value their trademarks on a global level and the remarkable concession that English is in widespread use in international commerce.”<sup>79</sup> In fact, Undersecretary of Commerce for Intellectual Property James E. Rogan stated that “U.S. participation in the Madrid Protocol is another sign of the growing importance that American businesses place on protecting their intellectual property globally.”<sup>80</sup> After successful lobbying attempts by the INTA, the WIPO, the Executive Branch, and many business organizations, the U.S. Congress presented potential legislation for amending current law to allow the U.S. to join the Protocol. Nevertheless, the U.S. Congress was not quick in passing legislation to add the United States as a member of the Protocol. After failed attempts in 1992,<sup>81</sup> 1993,<sup>82</sup> 1995,<sup>83</sup> 1997,<sup>84</sup> and 1999,<sup>85</sup> the Protocol finally made progress in the U.S. Congress in 2001.

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<sup>79</sup> Gary R. Duvall & Elizabeth Buckingham, *Madrid Translates Into Expedient Global Trademarks*, PUGET SOUND BUS. J., Nov. 3, 2003, available at <http://seattle.bizjournals.com/seattle/stories/2003/11/03/focus10.html?t=printable>.

<sup>80</sup> USPTO, *United States Joins the Madrid Protocol*, at <http://www.uspto.gov/web/trademarks/usjoinsmadrid.html> (last modified Nov. 15, 2003).

<sup>81</sup> See H.R. 6211, 102d Cong. (1992).

<sup>82</sup> See S. 977, 103d Cong. (1993); H.R. 2129, 103d Cong. (1993).

<sup>83</sup> See H.R. 1270, 104th Cong. (1995).

<sup>84</sup> See H.R. 567, 105th Cong. (1997); S. 2191, 105th Cong. (1998).

<sup>85</sup> See S. 671, 106th Cong. (1999); H.R. 769, 106th Cong. (1999).

In 2001, H.R. 741 and S. 407 were officially introduced into the U.S. House of Representatives and U.S. Senate, respectively. Passed on March 14, 2001, H.R. 741, the “Madrid Protocol Implementation Act” was introduced by Rep. Howard Coble, former Chairman of the House Judiciary Committee’s Subcommittee on Courts, the Internet, and Intellectual Property.<sup>86</sup> The Senate’s Bill, S. 407, was introduced by Senator Orrin Hatch and Senator Patrick Leahy on February 27, 2001, and the Bill is similar to the House Bill.<sup>87</sup> Because of their similarities, both of these bills will be reviewed and discussed as one.

Overall, both the House and Senate bills “[made] no substantive change[s] to the Lanham Act, but rather set up new procedures for trademark applicants who will eventually want to obtain an international trademark registration.”<sup>88</sup> The bills do amend the Lanham Act<sup>89</sup> by adding sections 60-74 to the Act’s provisions; these provisions detail how the United States will handle Protocol registrations.<sup>90</sup> To begin, section 60 defines key terms for the Lanham Act, and section 61 discusses who is eligible to obtain an international registration via a U.S.-based USPTO application.<sup>91</sup> The bills note that one “who is a national of the U.S., is domiciled in the U.S., or has a real and effective industrial or commercial establishment in the U.S.” is entitled to register for mark protection.<sup>92</sup>

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<sup>86</sup> H.R. 741, 107th Cong. (2001).

<sup>87</sup> *See generally* S. 407, 107th Cong. (2001).

<sup>88</sup> Maria Guerra, *Legislative Updates: The Rocky Road of the U.S. Accession to the Madrid Protocol: Could This Be the Year?*, 11 DEPAUL-LCA J. ART & ENT. L. 525, 547 (2001).

<sup>89</sup> 15 U.S.C. § 1051 (2003).

<sup>90</sup> *See* H.R. 741, 107th Cong. (2001); S. 407, 107th Cong. (2001).

<sup>91</sup> *Id.*

<sup>92</sup> *Id.*

Section 62 explains how the international registration is certified by the USPTO. More specifically, the provisions note that “the Director shall examine the international application for the purpose of certifying that the information contained in the international application corresponds to the information contained in the basic application or basic registration at the time of the certification . . . [and ultimately] transmit the international application to the International Bureau.”<sup>93</sup> Section 63 details the “central attack” provision discussed, *supra*, and explains that the USPTO must notify the Bureau if a mark is somehow restricted, cancelled, or abandoned within the first five years following the application.<sup>94</sup>

Section 64 notes that the applicant can renew his or her application either directly with the International Bureau or directly with the USPTO,<sup>95</sup> and section 65 provides that international registrants will be entitled to protection of their mark within the United States, “to the extent necessary to give effect to any provision of the Madrid Protocol.”<sup>96</sup> Sections 66-69 require international registrants to declare the mark will be used in commerce, discuss time requirements and priority dates, outline the examination and opposition process, and detail the extension of protection, which includes “the same rights and remedies as the owner of a registration on the Principal Register.”<sup>97</sup> The United States notes it must notify the Bureau within eighteen months whether the mark has been refused protection or not, and the provisions require that international registrants designate an agent for service of process located within the United States.<sup>98</sup>

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<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> See H.R. 741, 107th Cong. (2001); S. 407, 107th Cong. (2001).

<sup>96</sup> *Id.*

<sup>97</sup> *Id.*

Section 70 of the Lanham Act conditions an international mark's validity in the United States on the mark being valid and renewed by the International Bureau.<sup>99</sup> This section also allows for "transformation," which is the process outlined *supra* that allows an applicant to convert an international application to various local applications should the application fall victim to a central attack.<sup>100</sup> Section 71 discusses fees for applications, and section 72 sets out provisions for assigning mark protection and for renewing mark protection.<sup>101</sup> Sections 73 and 74 detail the right of a mark holder to a period of continuous use and explain the rights of extension of protection for a mark holder.<sup>102</sup> Overall, the fifteen new sections added to the Lanham Act codify the basic Protocol requirements discussed above in Part II of this paper.

After these bills both made their way through Congress, the groundwork was underway for the United States to join the Protocol. Although it would take almost two full years from the passing of the legislation to the first day the USPTO began accepting Madrid Protocol applications,<sup>103</sup> U.S. businesses now have the option of using the Protocol for international mark protection.

C. *Advantages and Disadvantages to U.S. Membership*

1. **Applicant Advantages**

While U.S. businesses can use the Protocol to apply for international mark protection, it remains to be seen whether the Protocol will actually benefit a large number of individuals. To begin, there are some clear advantages to applying for protection under the Protocol. First, there

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<sup>98</sup> *Id.*

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.*

<sup>102</sup> *Id.*

<sup>103</sup> The USPTO began accepting Protocol applications on November 2, 2003.

are administrative advantages. One such advantage takes place at the application stage of the registration process. As WIPO announces, an applicant need only concern him or herself with “one registration, in one place, with one set of documents, in one language, with one fee.”<sup>104</sup> By having to deal with only a few registration procedures for close to sixty marks, the mark holder saves time, administrative costs, and hassle. With less to worry about, corporations will be more likely to take advantage of the Protocol, if it is generally feasible. Another advantage takes place at the post-registration stage. After applying for protection, (1) an applicant is guaranteed to know if the application has been accepted or refused within a certain period of time, (2) the applicant is allowed to designate additional countries after registration, and (3) the applicant is afforded the opportunity of easily supplementing and renewing the application.<sup>105</sup> Again, similar to pre-registration benefits, these post-registration benefits will save mark holders time, money, and hassle. By knowing when a mark is accepted, a business can more adequately plan for the future. In addition, a company can save thousands of dollars in reduced attorneys fees by handling one-step renewal and supplemental registration matters. Overall, the Protocol makes registering a mark cheaper and easier to complete.

Second, there may be substantial registration cost savings to using the Protocol.<sup>106</sup> In order to persuade persons to use the Protocol, the White House released a particular survey that explained the cost savings when applying one mark in ten different countries. Without the Protocol, the registration fees would total nearly \$14,000; however, by using the Protocol, the

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<sup>104</sup> Carles Prat, *Why the Madrid Protocol Can Benefit Practitioners*, MANAGING INTELLECTUAL PROPERTY, 24 (July 1, 2003) (emphasis added); see also *Twenty Questions*, *supra* note 11.

<sup>105</sup> *Twenty Questions*, *supra* note 11.

<sup>106</sup> Welch, *supra* note 46.

same fees would cost roughly \$4,700.<sup>107</sup> On top of the nearly \$10,000 in savings on registration fees, the mark holders will save via decreased registration costs, post-registration savings, and reduced attorney's fees. Fewer attorneys will be needed to perform the research that was previously required to independently register a mark in nations across the globe.

## 2. National Advantages

It has also been argued that there are substantial advantages to a nation as a whole when applicants use the Protocol. For example, one commentator notes that “[t]he trade mark system of any given country will be more open and more international in today’s current global economy . . . .”<sup>108</sup> Moreover, “[t]he domestic industry will benefit from the number of potential foreign designations for its trade marks . . . [and] there is an opportunity to increase – or help increase – internationalization of certain businesses or economies.”<sup>109</sup> Whether or not the United States will benefit from the Protocol remains to be seen.

## 3. Applicant Disadvantages

The Protocol also presents several disadvantages for each applicant. To begin, “[t]he scope of coverage of an International Registration under the Protocol is tied to the scope of the home application/registration for at least the first five years of life of the International Registration.”<sup>110</sup> This is a potential disadvantage to U.S. applicants, because in the U.S., applicants must make a specific statement concerning their goods and services; however, foreign applicants applying into the U.S. will have the option of using broad statements to identify their

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<sup>107</sup> Guerra, *supra* note 88, at 552.

<sup>108</sup> Prat, *supra* note 104.

<sup>109</sup> *Id.*

<sup>110</sup> See Madrid Protocol art. 6; Welch, *supra* note 46.

goods and services.<sup>111</sup> In many cases, foreign registrants need only identify the entire class heading for the given class of goods or services.<sup>112</sup> Such a broad identification may protect classes of goods and services that could be used by U.S. businesses in the future. As one current mark holder stated, “there are some marks where I might prefer to have a broad identification or even a class heading so that as our business expands over the years we can grow into the registration.”<sup>113</sup> Thus, the Protocol may in fact inhibit future U.S. trademark registration.

On top of the U.S. system requiring a more detailed description of the mark, it is clearly more difficult to receive trademark protection in the United States than in some civil law jurisdictions, such as those nations that make up the European Union.<sup>114</sup> Because it will be easier for other nations to take marks that could be used by U.S. businesses, the U.S. economy will lose out on reserving various marks.

A final disadvantage for filing under the Protocol is the lack of nations that currently are members of the Madrid System. For example, while the United States is a member, both its neighbors Mexico and Canada and major South and Central American economies, including Brazil and Argentina, are not members.<sup>115</sup> Some Central and South American nations are unable to handle the inflow of applications, and other nations, including Brazil, feel that the Protocol is

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<sup>111</sup> See Welch, *supra* note 46; see also Wilner, *supra* note 1, at 37; Jeffrey J. Look, *International Trademark Filing to be Made Easier in 2003*, International Trademark Association, (2003) at <http://www.inta.org/articles/internationalfiling.html>.

<sup>112</sup> See Welch, *supra* note 46.

<sup>113</sup> Look, *supra* note 111.

<sup>114</sup> Wilner, *supra* note 1, at 36.

<sup>115</sup> *The Madrid Protocol & Latin America*, at [http://www.e-moeller.com/ingles/htm/Protocolo%20de%20Madrid%20y%20America%20Latina\\_in.htm](http://www.e-moeller.com/ingles/htm/Protocolo%20de%20Madrid%20y%20America%20Latina_in.htm) (last visited Nov. 13, 2003) [hereinafter *Latin America*]; see also Look, *supra* note 111.

unhelpful to its citizens.<sup>116</sup> Brazil, South America's largest economy, disfavors joining the Protocol for three specific reasons: (1) it feels the Protocol prioritizes international marks over local marks, (2) it currently takes the Brazilian government four years to examine a mark, a time frame which is clearly in excess of the eighteen month period established by the Protocol, and (3) the nation's official language of Portuguese is not a recognized option for filing under the Protocol.<sup>117</sup> Brazil is but one of many nations that currently disfavor joining the Protocol, and it does not appear in the near future that many other Western Hemisphere countries will sign onto the Protocol. The fewer members that are a part of the Protocol, the less meaningful it will be for a country to use the Protocol for trademark protection. For example, if a firm wishes to apply for international mark protection in France, Brazil, and Mexico, using the Protocol would seem a waste of time, since two of the three countries are not participating Member States. Addressing this disadvantage is crucial to the future of the Protocol, and although a Senior Director in WIPO feels that the U.S. joining the Protocol will convince many Latin American and Caribbean nations to join,<sup>118</sup> it remains to be seen whether the Protocol's future includes more Member States.

#### 4. Practitioner Disadvantages

Another disadvantage does not affect corporations but instead affects practitioners who specialize in trademark law in the United States.<sup>119</sup> While the Madrid Protocol may attract some businesses to register their mark outside of the United States, the Protocol will also reduce the

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<sup>116</sup> *Id.*

<sup>117</sup> Mamudi, *supra* note 2.

<sup>118</sup> *Id.*

<sup>119</sup> See Guerra, *supra* note 88, at 554 (“U.S. trademark lawyers expect to loose [sic] business . . . [and] have expressed concern the Protocol will cut down on their work on behalf of foreign companies applying for registration from the USPTO.”).

number of alien corporations and individuals that need local trademark counsel within the United States. As described above, the Protocol allows an individual to register a mark in multiple countries through their home nation's central mark registration office. Thus, a company from Spain will no longer need to retain local counsel in the United States to register their mark within the U.S., as the company can use the Protocol's system and their own local counsel in Spain. Granted, the USPTO does refuse many first-time applicants for mark registration.<sup>120</sup> Therefore, local counsel may still be retained at this stage of the process, as local counsel in foreign nations may not be as well suited to handle such a refusal. While it is unsure at this time how much international business U.S. practitioners will lose, it is certain that practitioners will have more free time in the coming months.

#### **IV. FORESHADOWING THE FUTURE**

The Madrid Protocol will save U.S. businesses time, money, and stress, as it allows a firm in one nation to register a mark internationally in over sixty other nations, yet there is no guarantee this Protocol will be successful within the United State. First, although they will definitely experience time savings and see a reduction in administrative hassle, it is uncertain to what extent conglomerate corporations and Fortune 500 companies will utilize the Protocol. These companies may use the Protocol at times, but when there is a need for a complicated mark registration, the companies have both the financial resources and the attorney power to conduct a country-by-country registration across the globe to ensure their mark is securely protected. For example, ExxonMobil Corporation's coordinator of Trademark Groups recently stated that he was unsure the extent that his company would utilize the Protocol; this sentiment was echoed by

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<sup>120</sup> *Id.* at 555.

corporate executives at Halliburton Energy Services and Blockbuster, Inc.<sup>121</sup> Because of the resources of large corporations, this author predicts small and medium-sized firms have more to initially gain from the Protocol, and this author predicts that the initial success of the Protocol will depend heavily on the extent that small and medium-sized businesses utilize the system.

There is no doubt that small and medium-sized firms will benefit through costs savings and reduced administrative hassle, similar to large corporations. But, these firms may find themselves in difficult positions when attempting to use the Protocol for international registration for two main reasons. First, as mentioned above, many regional countries are not members of the Protocol. Most small and medium-sized businesses limit their focus on a national scale, yet in today's global economy many businesses are beginning to venture into the international market to increase both sales and profits. It seems logical, therefore, that many of these same businesses would focus on entering regional international markets, including Canada, Mexico, and Latin American countries, before making an "all-out" registration via the Protocol in sixty nations across the globe, including Poland, Turkey, and Kenya.

If these firms are interested in registering their mark in a regional country, with the exclusion of Cuba, they could find themselves having to use both the Protocol *and* independent registrations. Having to use independent registration would cancel many of the benefits of using the efficient Madrid Protocol approach, as local counsel would have to be retained in countries around the globe to perform detailed searches and other legal matters. There are many steps that could be taken to encourage additional membership in the Protocol. However, this author submits that until the Protocol Member States consider adding either Spanish or Portuguese as a

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<sup>121</sup> Look, *supra* note 111.

third language choice for Protocol applications, some 580 million persons around the globe<sup>122</sup> will be uninterested and unable to use the Madrid System. This argument was recently addressed by Blockbuster, Inc.'s manager of intellectual property, who stated "If I got an e-mail today saying that [the Madrid Protocol] would take Spanish language applications and cover more Spanish-speaking countries, I would be very pro-Madrid."<sup>123</sup> Clearly, it is more likely that a country such as Mexico would be willing to join onto the Protocol if its citizens could use their native language on mark applications.

Second, in addition to the lack of regional Member States, many small and medium-sized businesses are likely to find themselves uncertain when and how the Protocol should be applied to their current business needs. If a business is not relatively confident that the proposed mark will be accepted, the business will be in danger of losing money, as there are no refunds when protection is refused by the designated Member States. Moreover, if a business is not entirely educated on using the Protocol, the firm could waste time and money studying the system, while the business loses out on registering their potential mark.

Assuming *arguendo* that small and medium-sized businesses do use the Protocol for their registration needs, it may take time before U.S. practitioners are more adequately prepared to handle the registration needs. First, today's trademark attorney is used to spending hours searching for possible duplicate and/or similar marks in each separate, international market and manually registering for mark protection. However, tomorrow's trademark attorney will be required to use an Internet-only registration system and CD-ROM/Internet searching tools to

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<sup>122</sup> *Latin America, supra* note 115.

<sup>123</sup> *Look, supra* note 111.

locate similar marks around the globe.<sup>124</sup> It could take years for attorneys to become familiar with the Protocol's registration structure, and it is likely that CLE seminars and training sessions will become commonplace throughout the legal community. Second, today's attorney can supplement national mark needs with international clients looking to register their marks in the United States, but tomorrow's attorneys must realize many of these international clients will disappear, unless a mark is somehow refused by the USPTO. As these fees disappear, U.S. practitioners will have to supplement their practice with other legal areas or raise their fees for Protocol registration help.<sup>125</sup>

Moreover, some large IP/Trademark specialty firms could also find themselves losing large U.S. corporate clients. Because the Protocol reduces the amount of paperwork and administrative hassle placed on a business, large corporations could hire in-house legal counsel to prepare, supplement, and renew Protocol applications. Keeping trademark matters in-house would save corporations money and the hassle of contacting outside help. It is unclear the extent that practitioners' responses might impact the success of the Protocol in the United States, yet it remains likely that practitioners' unfamiliarity with the system and the reduction in the number of international clients will have a definite effect.

## **V. CONCLUSION**

Trademarks have been a part of this society since the Stone Age, as “[c]ave murals in southwestern Europe indicate that bison were branded with marks in order to identify their

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<sup>124</sup> P. Jay Hines, *Practical Considerations of Using the Madrid Protocol*, at <http://www.oblon.com/Pub/Madrid-Protocol-article2003.pdf> (noting that WIPO's Madrid Express Database and the WIPO Gazette are search tools).

<sup>125</sup> See Welch, *supra* note 46 (“American practitioners will probably recover much of this lost revenue at the examination stage by appropriately setting the service charges for taking over an application at the point of refusal . . .”).

owners.”<sup>126</sup> Current day trademarks, however, consist of more than labeling bison, as businesses seek to separate their business and product name from other businesses around the globe. The Madrid Protocol should be a helpful tool as these businesses seek international protection for their various marks. After studying the Protocol and learning two countries are not Protocol Member States, Ms. Smith of Lightning Consulting may discover she and her firm are better off individually filing for trademark protection, rather than applying for protection under the Protocol. The choice will, ultimately, be up to her company and its counsel.

As stated throughout this paper, there are substantial advantages to using the Protocol, and the WIPO, the INTA, and the Protocol Member States should be pleased with the current progress made in establishing an international system for the registration of marks. However, more can and should be done to improve the Protocol. As one commentator states, “the Madrid Protocol should help small trademark owners . . . because individuals and small entities that can’t have all these layers will opt for international protection, to the extent that 60 countries is worldwide.”<sup>127</sup> Nevertheless, this author is unsatisfied with the availability of sixty countries, especially when the United States’ own two neighbors and are not members of the Madrid Protocol.

This paper applauds the current state of the Protocol, but at the same time it encourages the Protocol to grow and eventually encompass the entire globe. In order to achieve this goal, the current Member States must do more to educate the public and increase the number of Protocol Member States. In time, the Protocol may be the common means to register

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<sup>126</sup> James E. Rogan, Keynote Remarks at the International Trademark Association Annual Meeting (May 20, 2002), available at <http://www.uspto.gov/web/offices/com/speeches/roganskeynote.htm>. (last visited Feb. 13, 2004).

<sup>127</sup> Chartrand, *supra* note 75.

international marks; however, there is no guarantee the system will be a success within the United States.