

**INTERNATIONAL NOTE:  
EU ENLARGEMENT & MADRID PROTOCOL  
EXPAND THE OPTIONS FOR INTERNATIONAL  
TRADEMARK REGISTRATION**

Several factors make foreign trademark registration important. First, trademark rights are territorial. Even if a company has a strong U.S. trademark portfolio, those registrations may afford little or no protection beyond U.S. borders. For companies that operate in foreign markets now, or that anticipate doing so in the next three to five years, it is important to implement a brand protection strategy in those markets. Second, unlike the U.S., most foreign countries allow anyone to register your trademark without proof of either actual or intended use, and there is little the U.S. owner can do – except pay potentially costly legal or settlement fees in an effort to obtain rights to their own mark in the relevant country. Implementing an international branding strategy early can minimize that risk. Two recent developments make it easier for businesses to implement such a strategy.

**E.U. ENLARGEMENT**

Effective May 1, 2004, the European Union will expand from 15 member countries to 25. The 15 original members are: Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, Netherlands, Portugal, Spain, Sweden and the United Kingdom. The 10 new members are: Poland, Hungary, Czech Republic, Slovakia, Estonia, Latvia, Lithuania, Slovenia, Cyprus and Malta. The Community Trademark (CTM) appeals to many businesses because a single registration affords protection throughout all 15 (and soon 25) states in the EU, much like a single federal registration affords protection throughout all 50 states in the U.S.

**MADRID PROTOCOL**

A separate, but related development is the U.S. joining the Madrid Protocol, which for the first time allows U.S. companies to seek an International Registration (IR) under the Protocol. Like the CTM, an IR is appealing because a single registration extends protection to multiple states; unlike the CTM, the IR applicant can pick and choose among the 61, and growing, member countries in which it desires protections.

How should U.S. businesses respond to these developments?

- First, retain competent trademark counsel. Your market identity is too valuable an asset to manage without professional advice.
- Second, make sure the company's U.S. trademark portfolio is in order.
- Third, consider whether expansion beyond the U.S. is reasonably likely within the next few years. If so, identify the countries into which the business will likely expand, rank those countries in the order of priority, and create a long-term international branding budget.
- Next, conduct a trademark clearance search and, if the search indicates the mark is available, apply to register your mark(s) in as many of the relevant countries as your budget permits, but at least in those countries that have highest priority.
- Finally, police the market (automated "trademark watch" services are helpful in this regard); if you discover any infringements, work with your lawyer to address them.

*For further information, contact Tom Dunn by email at [tfd@mbbp.com](mailto:tfd@mbbp.com) or by telephone at (781) 622-5930.*

The MORSE, BARNES-BROWN & PENDLETON TECHNOLOGY LICENSING & INTELLECTUAL PROPERTY PRACTICE counsels businesses of all sizes on creating, protecting and transferring IP assets, including advice on trademark, copyright, advertising, Internet and technology law.

Peter N. Barnes- Brown  
*pbb@mbbp.com*

Howard G. Zaharoff  
*hgz@mbbp.com*

Jeffrey P. Somers  
*jps@mbbp.com*

Jeffrey P. Steele  
*js@mbbp.com*

Thomas F. Dunn  
*tfd@mbbp.com*

Michael J. Cavaretta  
*mjc@mbbp.com*

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Reservoir Place ♦ 1601 Trapelo Road ♦ Waltham, MA 02451 ♦ (p)781-622-5930 ♦ (f)781-622-5933 ♦ [www.mbbp.com](http://www.mbbp.com)

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