

Trends and Recent Developments in International Intellectual Property Law

2005 HSBA Annual Bar Convention
International Law Program
Section on Intellectual Property
And Technology Law

International Protection for Designations of Source and Origin

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EXTRATERRITORIAL APPLICATION OF THE LANHAM ACT

McBee vs. Delica Co., (Fed. Cir.
August 2, 2005)

- McBee, a well known jazz musician, sought to enjoin Defendants from using her name as a brand for defendant's adolescent female clothing line in Japan
 - No subject matter jurisdiction to enjoin access (from U.S.) to Defendant's (Japanese language) website
 - No subject matter jurisdiction to entertain damages claim for activities taking place in Japan

McBee vs. Delica Co., (Federal Circuit) continued

- Rejected existing 9th and 2nd Circuit tests and adopted tripartite test for extraterritorial application of Lanham Act
 - Whether defendant a U.S. citizen
 - Whether (extraterritorial) activities have a substantial effect on U.S. commerce viewed in light of purposes of Act
 - Comity considerations if conflict with foreign TM law
- Analogous to the rule in *Hartford Fire Ins. Co. vs. California*, 509 U.S. 764, 795-99 (1993) for extraterritorial application of antitrust laws

International Trademark Protection

- Country by Country Protection
 - Via individual national filings
 - Via centralized treaty filing, i.e., Madrid System
- Regional Protection through Regional Trademark Unions
 - Benelux
 - European Community

Multi-Country Protection

- Multi-country protection by centralized treaty filing
 - Bundle of rights that
 - Are defined by the national law
 - More flexible; more durable; more variable
- Multi-country protection through regional trademark union
 - Unitary right
 - Overlaid upon national trademark system
 - Conflicts with national system; i.e. and results in higher number of oppositions (CTM)
 - All or nothing; CTM cheapest if just the EU

Regional Protection via Geographic TM Unions

- Benelux
 - Early trademark union
 - Belgium, Luxembourg, Netherlands
- Community Trade Mark (“CMT”)
 - Since December 1993

Regional Protection Via Regional Trademark Unions - Community Trade Marks

- Coverage recently expended from 10 to 20 plus European countries (with the expansion of the EU)
 - Windfall for those holding CMTRs
- Any national conflict spoils the registration
 - But can “convert” into national applications
 - No examination based upon likelihood of confusion; up to the registrants to file a oppositions
 - High level of oppositions and high level of settlements; European fee shifting rule applies

Straight Country Filings

- Retain Foreign Correspondent
- No Priority
- Less Bases for Registration
 - May be a use requirement

Individual Treaty Filings

- Retain foreign correspondent
- Claim priority if within six months of first filing in a member country
- More bases for registration
 - May obviate use requirement
 - E.g., Section 44 filings in U.S.

Individual Treaty Filings

- Paris Convention

- More than 160 member countries
- National application based on member country application or registration
- 6 month priority claim possible

Individual Treaty Filings

- Inter-American Convention aka Pan-American Convention
 - 9 Latin American countries
 - National application based on member country application or registration
 - 6 month priority claim possible
- Buenos Aires Convention
 - 12 Latin American countries
 - National application based on member country registration but not application
 - Priority claims not possible

Multi-Country Treaty Filings

- Centralized Filing via the Madrid System
 - Madrid Agreement and the Madrid Protocol
 - Since November 2003 for U.S. citizens and businesses with a real and effective commercial presence in the U.S.
 - Currently 77 countries and IGOs (CTM and Benelux) are members

Inbound Protection (U.S. Protection for Foreigners)

- Straight filing Under 1(a) or 1(b) of the Trademark Act
- Filing under Section 44 for applicants from treaty countries
- Filing under Section 66(a) for applicants holding an International Registration under the Madrid Protocol

Inbound Protection

- Straight filing Under 1(a) or 1(b) of the Trademark Act
 - No claim of priority of a foreign application
 - No claim of benefit of a foreign registration
 - Appointment of Domestic Representative if applicant using foreign address
 - Based upon (written) instructions; no POA required

Inbound Protection

Filings Under Section 44

- Section 44(d) - based upon foreign application
 - Claim of priority
- Section 44(e) - based upon foreign registration
 - Registration without use in interstate or foreign commerce
 - Also afforded in the case of a section 66(a) extension of protection under the Madrid
 - Subject to cancellation if not used within reasonable period; If no fifth year declaration of use under section 8
- Scope cannot be broader than underlying foreign application/registration

Inbound Protection

Filings Under Section 44

- Section 44(d) - foreign application
 - Claim of priority
- Section 44(e) - foreign registration
- Country of origin must be a treaty country (reciprocity) where applicant
 - Has real or effective commercial establishment
 - Or is domiciled or national of
 - Can be a U.S. National if can show a basis claiming a treaty country as a country of origin

Inbound Protection Filings Under Section 44

- Can file under section 44(d), but must issue under either section 1(a) or 44(e)
 - If foreign application does not mature, amend basis to section 1(a)
 - If foreign application matures, shift amend basis to 44(e)

Inbound Protection Filings Under Section 44

- Can file under multiple bases
 - i.e., under §§ 44 and 1(b)
 - Can change bases within the 6 months priority period without losing the priority date, but changes thereafter affect priority of application
- Many options; many strategies

Electronic Filing via TEAS Allows Multiple Bases Filing

the 60 minute time limit, the form will not validate and you must begin the entire process again. Therefore, you should have all information required to complete the form available prior to starting your session.

1. What is your filing basis?

NOTE: More than one basis may be selected, but do NOT claim both §§1(a) and 1(b) for the identical goods or services in one application. If claiming a Section 1(a) basis, it is NOT necessary or appropriate also to claim a Section 1(b) basis for the same goods or services, simply to indicate an intent to *continue* using the mark for those goods or services - the Section 1(a) basis covers this.

[Intent to Use \(Section 1\(b\)\)](#)

☒ Yes ☐ No

[Use in Commerce \(Section 1\(a\)\)](#)

☒ Yes ☐ No

[Right of Priority based on Foreign Application \(Section 44\(d\)\)](#)

☒ Yes ☐ No

[Foreign Registration \(Section 44\(e\)\)](#)

☒ Yes ☐ No

2. Are your Goods and/or Services in [more than one class](#)?

☐ Yes ☒ No

If the answer is Yes, enter the number of classes

3. Do [joint applicants](#) own the mark?

[Main Index](#)



[[Standard Form - HELP](#) | [Wizard - HELP](#)]
[[Help Desk](#) - [Bug Report](#) - [Feedback](#)]
[[TEAS Home](#) | [Trademark Home](#) | [USPTO](#)]

TEAS Also Facilitates Amending the Basis of An Existing Application

status of the application changes to "Notice of Allowance issued").

NOTE: If your application status is already "Approved for Publication" then you must wait until the status changes to "Notice of Allowance issued"; otherwise, you are in what is called the "blackout period," during which submissions cannot be processed. Please check the status of the application at <http://tarr.uspto.gov>.

This form uses pop-up windows to display critical information. To use this site properly, you must disable any existing pop-up filters (through either anti-virus software or a pop-up killer program).

■ **Request for Extension of Time to File a Statement of Use**

You must file a Statement of Use within six (6) months after the mailing date stamped on the Notice of Allowance (a written notice mailed when the examining attorney approves the mark, signifying that everything is acceptable for registration purposes BUT for the fact that the mark has not yet actually been used in commerce); UNLESS, within that same period, you submit a request for a six-month extension of time to file the Statement of Use. You must file the request within six (6) months after the issue date of the Notice of Allowance, or previously-granted extension period. You may request five (5) extensions of time. No extensions may extend beyond thirty-six (36) months from the issue date of the Notice of Allowance. We must receive the second (2nd), third (3rd), fourth (4th), and fifth (5th) extensions within the previously-granted extension period. Do NOT wait until the request for extension has been granted before filing the next request. You may submit one (1) extension request during the six-month period in which you file the Statement of Use, unless the granting of this request would extend the period beyond thirty-six (36) months from the issue date of the Notice of Allowance.

This form uses pop-up windows to display critical information. To use this site properly, you must disable any existing pop-up filters (through either anti-virus software or a pop-up killer program).

■ **Request To Delete Section 1(B) Basis, Intent To Use**

Use this form **only** to delete the Section 1(b) basis for an **entire application or an entire class** of goods and/or services, and to rely on an alternative, previously-claimed basis for registration. Do **not** use this form for any of the following:

- To delete the Section 1(b) basis when Section 1(b) is the only basis currently stated in the application;
- To delete the Section 1(b) basis for only some of the goods and/or services within a class. See [Preliminary Amendment form](#).
- To delete goods, services, and/or class(es) from an application. See [Preliminary Amendment form](#).
- To file a request to divide. (You must currently file a paper request.)

[FAQ About Trademarks](#)

[Help Desk & Bug Report](#)



[Trademark Home](#)

[USPTO Home](#)



Outbound Protection

- Individual Country Filings
 - Through foreign correspondents
 - If not more than two
 - Special circumstances
- Regional Filings
 - CTM
 - Large Choice of Foreign Correspondents
- Centralized Multi-country Filing via the Madrid

Madrid System

- Madrid System Advantages
 - Huge potential savings in time and money to file
 - Sometimes even for a single foreign filing
 - Huge potential savings in time and money to maintain foreign registrations
 - Renewal term and renewal fees
 - Change of name, address, representative, ownership
 - Greater efficiency in prosecution and protection
 - 12 or 18 month deadline for refusing grant of protection

Madrid System

- Madrid System Limitations
 - Generally need to retain foreign correspondent to prosecute if refusals issued by national offices
 - The potential for stricter scrutiny given to Madrid filings
 - Local bars may oppose loss of monopoly
 - Country by country
 - Insufficient track record to reach any conclusion
 - Also could be that less scrutiny is given, for example in order to meet 18 month deadline

Madrid System

- Madrid Agreement vs. Madrid Protocol
 - Countries member of one, the other, or both
 - Agreement has 56 members vs. Protocol with 66 members
 - Safeguard clause: where country is member of both, agreement applies
 - Some aspects of protocol more attractive than agreement
 - U.S. Member of the protocol only; Only protocol available
 - U.S. Citizens and businesses with a “real and effective presence” in the U.S. And not in an agreement country can file based on the protocol
 - USPTO is “office of origin”

Madrid System

- Entitlement
 - Domicile
 - Nationality
 - “Real and Effective” Industrial or Commercial Establishment
 - As determined by the domestic law of the country
 - Member Country
 - Member IGO (CTM)

Madrid System

- Language Regime
 - Under Protocol
 - Application may be in English, Spanish or French, and
 - Registration published in English, Spanish and French
- Representation before the International Bureau
 - Practitioners licensed in a Madrid member country
 - No power of attorney necessary

Madrid System

- Madrid System Applications
 - Via National Office to WIPO
 - Based on national application or registration
 - Can narrow but not expand goods and services
 - If within 6 months of a first application, can claim priority
 - Otherwise foreign priority based upon date of Madrid Application

Madrid System

- Madrid Subsequent Designations
 - Based upon an existing International (Madrid) Registration
 - Designates protection in additional member countries
 - Can narrow but not expand goods and services

Madrid System

- Prosecution of Madrid Application Before the International Bureau (“IB”)
 - Monitor application for notice of irregularities
 - Respond to notice of irregularities via National Office
 - Most will concern classification and identification of goods and services
 - determined by international (Nice) agreement and not national law

Madrid System

- Prosecution of International Registrations (“IR”) before National Offices
 - Typically need to retain local counsel
 - Governed by domestic law
 - May need to file a use declaration (Singapore) or additional fee (Japan)
 - May receive an early SGP (statement of grant of protection) issued from national office
 - If not, then if no refusal within 12 (or 18) months
 - USPTO issues “Certificate of Extension of Protection”

IR Management and Maintenance

- Invalidation proceedings
 - Initiated by national offices under national laws
 - Opportunity to defend
 - Rare
- Subsequent Designations
- Change in Ownership
- Limitations, Renunciations and Cancellations

IR Management and Maintenance

- Subsequent Designations
 - Application to the IB via national “office of origin”
 - International Registration Management and
 - Priority date is date of application for subsequent designation and not date of IR
 - Term is that of IR and not on date of SD filing

IR Management and Maintenance

- Change in Ownership
 - Considered separately by each contracting party based on domestic law
- Limitation of IR
 - Some goods and services *in some or all* designated countries
 - Includes intra-class limitations on goods and services
- Cancellation
 - Some or all goods and services, or all goods and service *in all designated countries*
- Renunciation
 - *All the goods and services* in some designated countries

NRR Management and Maintenance

- Replacement of National or Regional Registrations (“NRR”)
 - Incorporate pre-existing NRRs into the IR
 - So long as the NRR is for the same mark and the same or narrower goods and services in a contracting state
 - Combine several NRRs into one IR for a designated country
 - Automatic
 - Without prejudice to earlier acquired NRR rights
 - National office “takes note”
 - May need to use local counsel
 - Low use to date because of uncertainty?

IR Ceasing of Effect

- IR dependent upon underlying national application/registration for first five years -- “dependency period”
- If national application/registration cancelled during this period then
 - Office of original notifies IB, requests cancellation of IR
 - IB cancels IR and notifies all designated countries
- Referred to as “central attack” since invalidates all grants of protection issuing from IR.

IR Transformation

- If IR cancelled because of involuntary cancellation of the underlying national application during the dependency period, the
- Given opportunity to transform application into individual national applications without loss of priority rights
 - Left with national applications with priority date of IR
 - Loss of cost and efficiency advantages
 - Comparable to “conversion” procedure available under the CTM

IR Term Of Protection

- Initial term 10 years
- Renewal terms 10 years
- Payment within 6 months of renewal
- Payment through the IB

WIPO Madrid Resources

<http://www.wipo.int/madrid/en/index.html>

The screenshot shows the WIPO Madrid System website. The browser window has a standard toolbar with back, forward, and search buttons. The website header includes the WIPO logo, a navigation bar with 'Madrid System' and 'Activities & Services', and a search bar. A sidebar on the left lists various links like 'Welcome', 'General Information', and 'Filing Information'. The main content area is titled 'Madrid System for the International Registration of Marks' and includes a 'New' announcement about the WIPO Gazette. It also contains a detailed paragraph about the Madrid system's history and purpose, and a 'Warning' box regarding unofficial publications. On the right, there are three boxes: 'Newsletter' with a 'New' issue announcement, 'E-mail Updates' with a subscription form, and 'Forthcoming Meeting' for a seminar on the Madrid system.

WIPO Madrid System

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[Home](#) > [Activities & Services](#) > [Madrid System for the International Registration of Marks](#)

Madrid System for the International Registration of Marks

New: [The WIPO Gazette of International Marks is now available online](#)

The Madrid system for the international registration of marks (the Madrid system) established in 1891 functions under the Madrid Agreement (1891), and the Madrid Protocol (1989). It is administered by the International Bureau of WIPO located in Geneva, Switzerland.

Thanks to the international procedural mechanism, the Madrid system offers a trademark owner the possibility to have his trademark protected in several countries ([Members of the Madrid Union](#)) by simply filing one application directly with his own national or regional trademark office. An international mark so registered is equivalent to an application or a registration of the same mark effected directly in each of the countries designated by the applicant. If the trademark office of a designated country does not refuse protection within a specified period, the protection of the mark is the same as if it had been registered by that Office.

The Madrid system also simplifies greatly the subsequent management of the mark, since it is possible to record subsequent changes or to renew the registration through a single procedural step. Further countries may be designated subsequently.

Warning: On several occasions, the attention of the International Bureau has been drawn to the fact that certain organizations are sending letters to the owners of international registrations, inviting them to register their marks in publications which appear to be of an official nature. The International Bureau warns the owners of international registrations and their agents that such a publication has absolutely no legal effect in regard to the protection of the said marks and is therefore unnecessary.

Newsletter

New The third issue of the WIPO Newsletter on Marks, Industrial Designs & Geographical Indications is now [available](#). [\[Archive\]](#)

E-mail Updates

Subscribe to receive automated e-mail notices about updates on a range of Madrid Systems matters:

E-mail Address

Forthcoming Meeting

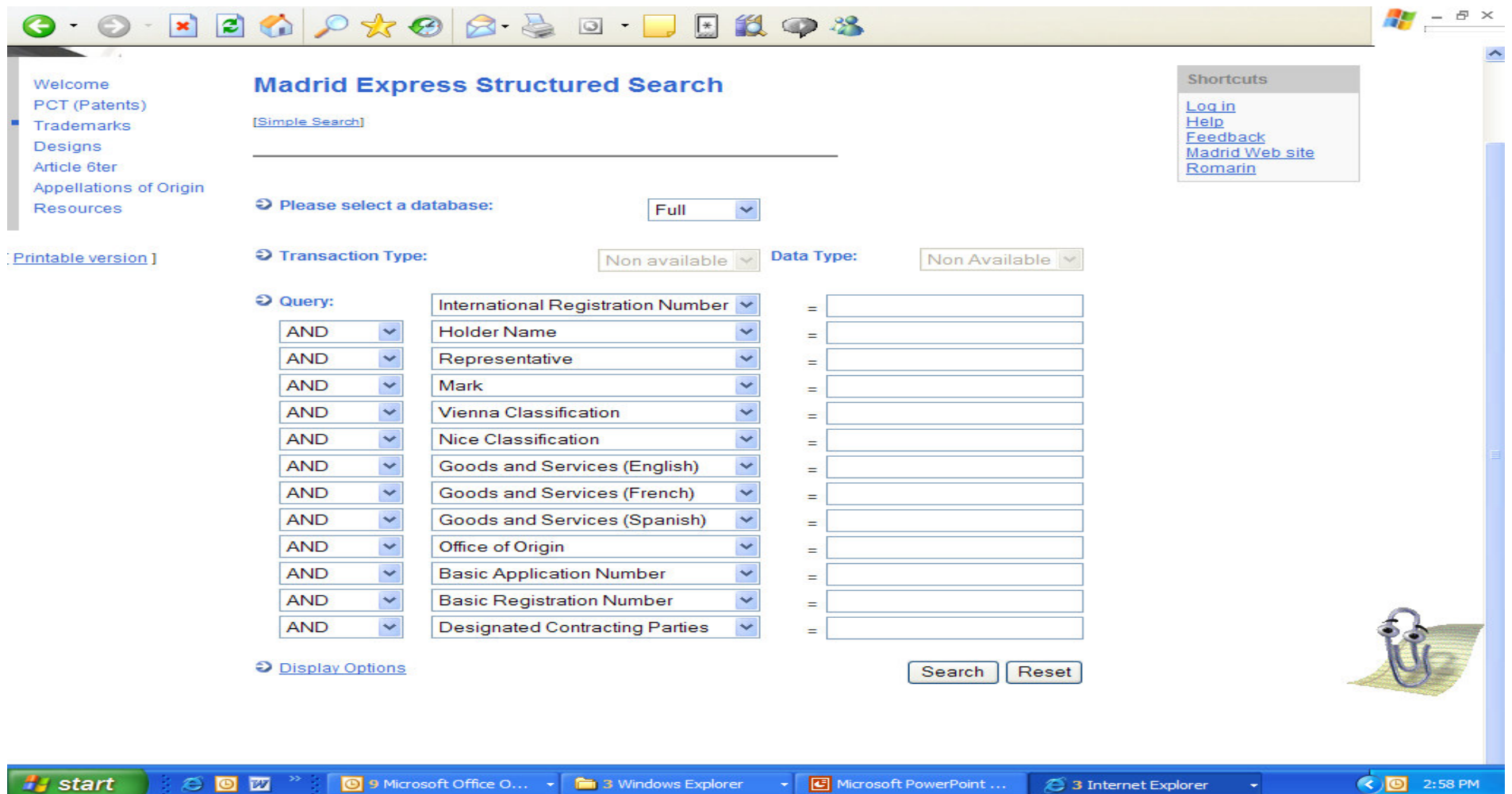
[Seminar on the Madrid System of the International Registration of Marks](#)
(Geneva, November 3 and 4, 2005):
[We regret to inform you that **this Seminar is already fully booked**. The International Bureau will organize further Seminars on the Madrid System of International Registration of Marks, for which you will be informed well in advanced.]

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WIPO Madrid Resources

Madrid Express Search

http://www.wipo.int/madrid/en/services/madrid_express.htm



The screenshot shows a web browser window with the title bar "Internet Explorer" and the address bar displaying the URL http://www.wipo.int/madrid/en/services/madrid_express.htm. The browser's toolbar includes standard navigation buttons (Back, Forward, Stop, Reload) and a search bar. The main content area is titled "Madrid Express Structured Search" and features a sidebar on the left with links to "Welcome", "PCT (Patents)", "Trademarks", "Designs", "Article 6ter", "Appellations of Origin", and "Resources". The "Trademarks" link is highlighted. The main search area contains a "Simple Search" link and a "Please select a database:" dropdown menu set to "Full". Below this is a "Transaction Type:" dropdown set to "Non available" and a "Data Type:" dropdown set to "Non Available". The "Query:" section consists of a table with 12 rows, each containing a dropdown menu for the field name and a text input box for the search value. The fields are: International Registration Number, Holder Name, Representative, Mark, Vienna Classification, Nice Classification, Goods and Services (English), Goods and Services (French), Goods and Services (Spanish), Office of Origin, Basic Application Number, Basic Registration Number, and Designated Contracting Parties. Each row is preceded by an "AND" dropdown menu. At the bottom of the query section is a "Display Options" link. The "Search" and "Reset" buttons are located at the bottom right of the search area. A cartoon notepad character is visible in the bottom right corner of the browser window. The Windows taskbar at the bottom shows the "start" button and several open applications: "Microsoft Office O...", "Windows Explorer", "Microsoft PowerPoint ...", and "Internet Explorer". The system clock in the bottom right corner indicates the time is 2:58 PM.

Welcome
PCT (Patents)
Trademarks
Designs
Article 6ter
Appellations of Origin
Resources

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Madrid Express Structured Search

[Simple Search](#)

Please select a database: Full

Transaction Type: Non available Data Type: Non Available

Query:

AND	International Registration Number	=	
AND	Holder Name	=	
AND	Representative	=	
AND	Mark	=	
AND	Vienna Classification	=	
AND	Nice Classification	=	
AND	Goods and Services (English)	=	
AND	Goods and Services (French)	=	
AND	Goods and Services (Spanish)	=	
AND	Office of Origin	=	
AND	Basic Application Number	=	
AND	Basic Registration Number	=	
AND	Designated Contracting Parties	=	

[Display Options](#) Search Reset

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start 9 Microsoft Office O... 3 Windows Explorer Microsoft PowerPoint ... 3 Internet Explorer 2:58 PM

Madrid Resources WIPO Gazette

<http://www.wipo.int/madrid/en/gazette/>

The screenshot shows a web browser window displaying the WIPO Madrid System website. The browser's address bar shows the URL <http://www.wipo.int/madrid/en/gazette/>. The website has a header with the WIPO logo and navigation links: Home, Search, Contact, and Home. Below the header, there is a sidebar with a list of links: Welcome, General Information, About Members, Information Notices, Filing Information, Forms, Fees / Fee Calculator, Guide, Legal Texts, WIPO Gazette, Online Databases, Meetings/Seminars, FAQ, and Contact. The main content area is titled "WIPO Gazette of International Marks" and contains three paragraphs of text. The first paragraph describes the Gazette as the official publication of the Madrid System, published weekly by the International Bureau. The second paragraph explains the various codes used in the Gazette, such as INID codes and Standard ST.60. The third paragraph states that the Gazette is also available on paper and on CD-ROM. To the right of the main content, there is a "Links" section with links to ROMARIN, Madrid Express, Gazette on CD, Gazette on paper, ST 60 (INID codes), ST 3 (Country codes), Nice Classification, and Vienna Classification. At the bottom of the page, there is a table with four columns: Gazette Issue, Publication Date, Registration Numbers, and File Type. The table lists two issues: No 34/2005 and No 33/2005. Below the table, there is a link to the WIPO Gazette of International Marks Archive: [\[Browse by Year\]](#).

WIPO

Madrid System

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WIPO Gazette of International Marks

The WIPO Gazette of International Marks, the official publication of the Madrid System, is published by the International Bureau every week. It contains all relevant data on new international registrations, renewals, subsequent designations and changes and other entries affecting international registrations. The bibliographic data is identified by the WIPO INID codes (INID stands for "Internationally agreed Numbers for the Identification of Data"), that is, the codes of Standard ST.60 ("Recommendation concerning bibliographic data relating to marks") and Standard ST.3 ("Recommended standard two-letter code for the representation of States, other entities and international organizations issuing or registering industrial property titles").

The various codes used in the Gazette and the bibliographic data to which they relate are given in each issue of the Gazette. The Gazette also contains information of general interest such as declarations and notifications made by Contracting Parties under the Agreement, the Protocol or the Regulations regarding particular requirements, the amounts of individual fees under Article 8(7) of the Protocol or information on the days on which the International Bureau is not scheduled to be open to the public.

The Gazette is also available on paper and on CD-ROM. The CD-ROM edition is published every four weeks and is cumulative, so that the first disc of each year contains all the data published in the first four issues of the paper edition, the second disc contains all the data published in the first eight issues, and so on. It is possible to take out an annual subscription to the Gazette with the International Bureau or to buy individual issues of the paper edition. Orders should be addressed to the Marketing and Distribution Section of WIPO.

In respect of each year, the International Bureau is required to publish an index to the Gazette indicating all the international registrations, with the names of the holders, in respect of which an entry was published in the Gazette during that year. This index is available only on CD-ROM and is constituted by the final issue of the CD-ROM edition of the Gazette for the relevant year. It is distributed to the subscribers to the paper edition of the Gazette.

Gazette Issue	Publication Date	Registration Numbers	File Type
No 34/2005	29-09-2005	856598 - 857682	(28298 KB)
No 33/2005	22-09-2005	855456 - 856597	(45241 KB)

WIPO Gazette of International Marks Archive: [\[Browse by Year\]](#)

Madrid Resources - Paper Forms

<http://www.wipo.int/madrid/en/forms/>



The screenshot shows a web browser window displaying the WIPO Madrid System website. The browser's address bar shows the URL <http://www.wipo.int/madrid/en/forms/>. The website has a blue header with the WIPO logo and navigation links: Search, Contact, Home, and language options (عربي, 中文, Español, Français, Русский). A sidebar on the left lists various resources: Welcome, General Information, About Members, Information Notices, Filing Information, Forms (highlighted), Fees / Fee Calculator, Guide, Legal Texts, WIPO Gazette, Online Databases, Meetings/Seminars, FAQ, and Contact. The main content area is titled "Madrid System for the International Registration of Marks" and "Forms". It includes a "Links" box with "Instructions for the completion of editable PDF forms" and "Nice Classification". A "[Search]" button is also present. Below, a section titled "All the Madrid forms are available in a single MS Word PK-Zipped file [6809 KB]" is followed by a heading "Madrid Agreement Concerning the International Registration of Marks". A table lists five forms (MM1 to MM5) with their descriptions and download links for DOC, PDF, and EDIT PDF formats. A cartoon paperclip icon is visible on the right side of the page.

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Madrid System for the International Registration of Marks

Forms

Links:

- [Instructions](#) for the completion of editable PDF forms
- [Nice Classification](#)

[Search]

All the Madrid forms are available in a single MS Word PK-Zipped file [\[6809 KB\]](#)

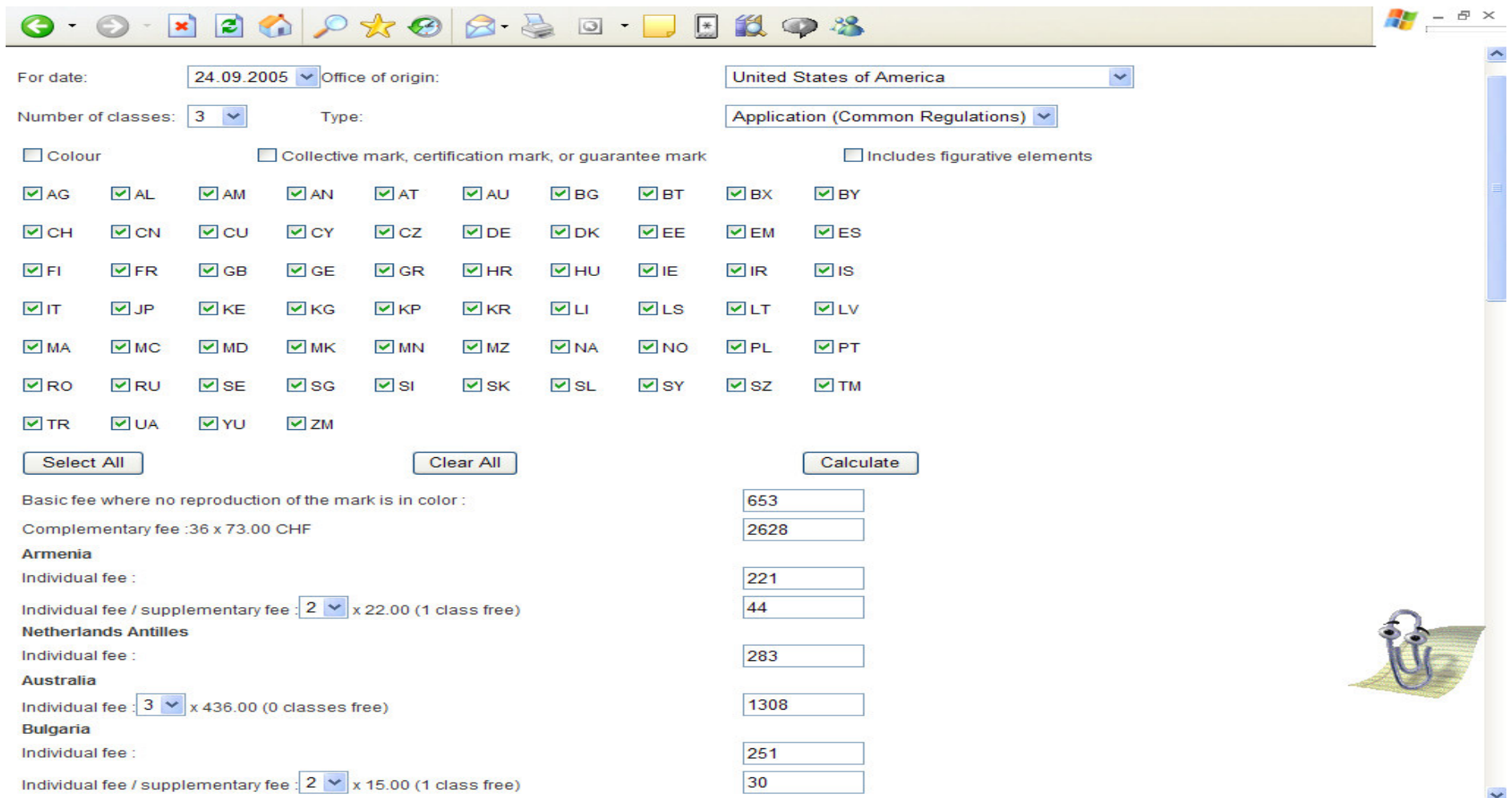
Madrid Agreement Concerning the International Registration of Marks

Form	Description	DOC	PDF	EDIT PDF
MM1	Demande d'enregistrement international relevant exclusivement de l'Arrangement de Madrid Règle 9 du règlement d'exécution commun	DOC	PDF	EDIT PDF
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks				
MM2	Application for international registration governed exclusively by the Madrid Protocol Rule 9 of the Common Regulations	DOC	PDF	EDIT PDF
Madrid Agreement Concerning the International Registration of Marks and Protocol Relating to that Agreement				
MM3	Application for international registration governed by both the Madrid Agreement and the Madrid Protocol Rule 9 of the Common Regulations	DOC	PDF	EDIT PDF
MM4	Designation subsequent to the international registration Rule 24 of the Common Regulations	DOC	PDF	EDIT PDF
MM5	Request for the recordal of a Change in Ownership Rule 25 of the Common Regulations	DOC	PDF	EDIT PDF

Fee Calculator

3 Classes in 66 Countries = CHF19,403

<http://www.wipo.int/madrid/feecalc/FirstStep>

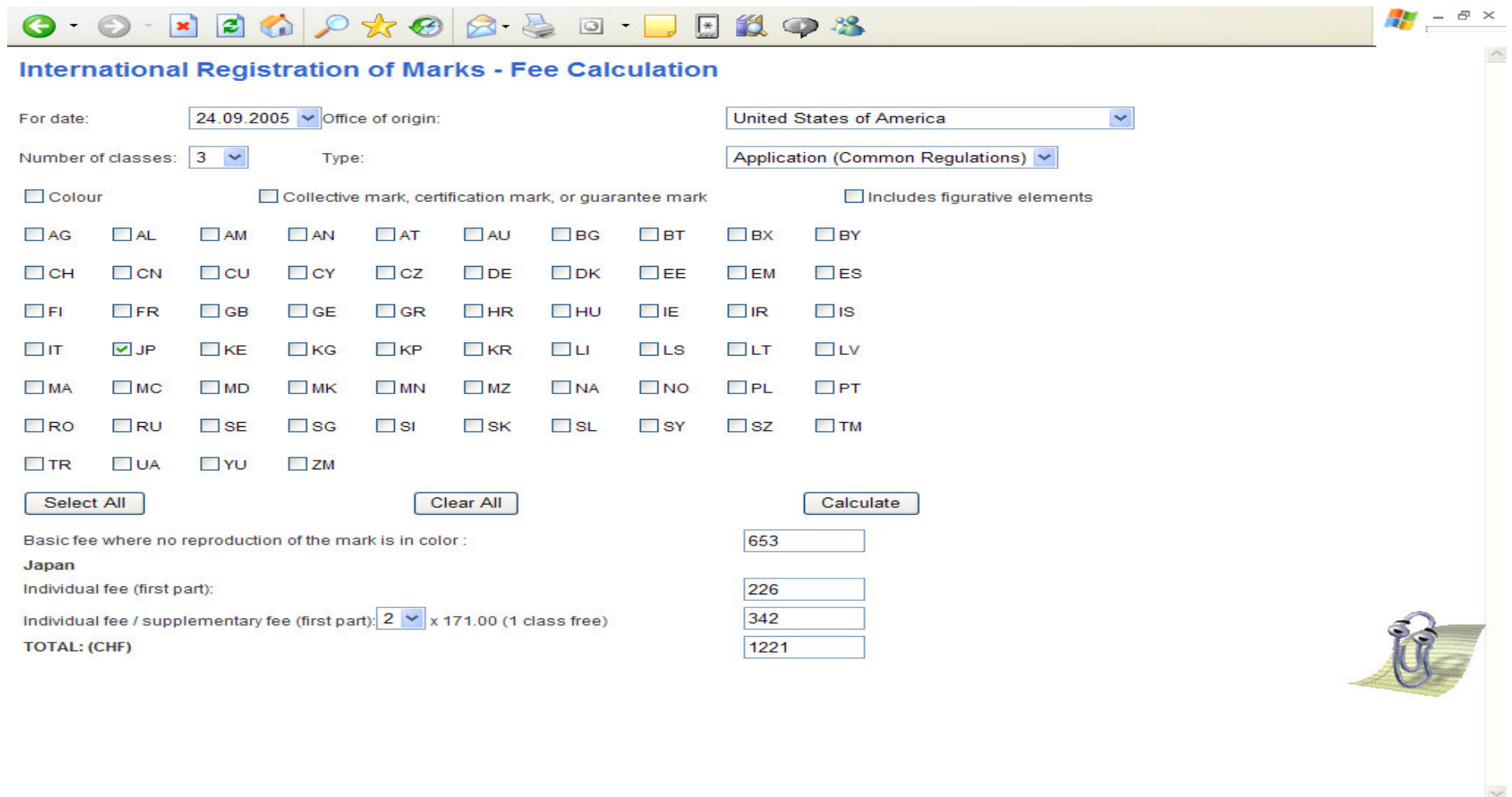


The screenshot shows the WIPO Madrid Fee Calculator interface. At the top, there is a browser toolbar. Below it, the form includes fields for 'For date:' (24.09.2005), 'Office of origin:' (United States of America), 'Number of classes:' (3), and 'Type:' (Application (Common Regulations)). There are three checkboxes: 'Colour', 'Collective mark, certification mark, or guarantee mark', and 'Includes figurative elements'. A grid of 66 country checkboxes is displayed, all of which are checked. Below the grid are buttons for 'Select All', 'Clear All', and 'Calculate'. To the right of the 'Calculate' button is a vertical scrollbar and a cartoon notepad character.

Country	Individual fee	Supplementary fee	Total fee
Armenia	221	44	265
Netherlands Antilles	283		283
Australia	1308		1308
Bulgaria	251	30	281

Fee Calculator

3 Classes just in Japan = CHF 1,221



International Registration of Marks - Fee Calculation

For date: 24.09.2005 Office of origin: United States of America

Number of classes: 3 Type: Application (Common Regulations)

☐ Colour ☐ Collective mark, certification mark, or guarantee mark ☐ Includes figurative elements

<input type="checkbox"/> AG	<input type="checkbox"/> AL	<input type="checkbox"/> AM	<input type="checkbox"/> AN	<input type="checkbox"/> AT	<input type="checkbox"/> AU	<input type="checkbox"/> BG	<input type="checkbox"/> BT	<input type="checkbox"/> BX	<input type="checkbox"/> BY
<input type="checkbox"/> CH	<input type="checkbox"/> CN	<input type="checkbox"/> CU	<input type="checkbox"/> CY	<input type="checkbox"/> CZ	<input type="checkbox"/> DE	<input type="checkbox"/> DK	<input type="checkbox"/> EE	<input type="checkbox"/> EM	<input type="checkbox"/> ES
<input type="checkbox"/> FI	<input type="checkbox"/> FR	<input type="checkbox"/> GB	<input type="checkbox"/> GE	<input type="checkbox"/> GR	<input type="checkbox"/> HR	<input type="checkbox"/> HU	<input type="checkbox"/> IE	<input type="checkbox"/> IR	<input type="checkbox"/> IS
<input type="checkbox"/> IT	<input checked="" type="checkbox"/> JP	<input type="checkbox"/> KE	<input type="checkbox"/> KG	<input type="checkbox"/> KP	<input type="checkbox"/> KR	<input type="checkbox"/> LI	<input type="checkbox"/> LS	<input type="checkbox"/> LT	<input type="checkbox"/> LV
<input type="checkbox"/> MA	<input type="checkbox"/> MC	<input type="checkbox"/> MD	<input type="checkbox"/> MK	<input type="checkbox"/> MN	<input type="checkbox"/> MZ	<input type="checkbox"/> NA	<input type="checkbox"/> NO	<input type="checkbox"/> PL	<input type="checkbox"/> PT
<input type="checkbox"/> RO	<input type="checkbox"/> RU	<input type="checkbox"/> SE	<input type="checkbox"/> SG	<input type="checkbox"/> SI	<input type="checkbox"/> SK	<input type="checkbox"/> SL	<input type="checkbox"/> SY	<input type="checkbox"/> SZ	<input type="checkbox"/> TM
<input type="checkbox"/> TR	<input type="checkbox"/> UA	<input type="checkbox"/> YU	<input type="checkbox"/> ZM						

Select All Clear All Calculate

Basic fee where no reproduction of the mark is in color : 653

Japan

Individual fee (first part): 226

Individual fee / supplementary fee (first part): 2 x 171.00 (1 class free) 342

TOTAL: (CHF) 1221



CERTIFICATE OF REGISTRATION

The International Bureau of the World Intellectual Property Organization (WIPO) certifies that the indications appearing in the present certificate conform to the recording made in the International Register of Marks maintained under the Madrid Agreement and Protocol.

G. Bisson
Head

Examination and Registration Section
International Registrations Administration Department

Geneva, February 17, 2005

840 784

Registration date: November 5, 2004
Date next payment due: November 5, 2014

L & L Franchise, Inc.
931 University Ave., Suite 202
Honolulu, HI 96826

(United States of America)

Legal nature of the holder (legal entity) and place of organization: CORPORATION, HI

Name and address of the representative: Seth M. Reiss, God-bey Griffiths Reiss, 1001 Bishop St., Suite 2300, Pauahi Tower, Honolulu, HI 96813 (United States of America).

1 43 HAWAIIAN
HAWAIIAN

Indication relating to the nature or kind of mark: standard characters

List of goods and services - NCL(8):

43 Fast-food restaurants.

Basic application: United States of America, 18.09.2000, 76131156.

Basic registration: United States of America, 18.09.2001, 2490665.

Designations under the Madrid Protocol: Australia, European Community, Japan, Singapore.

Declaration of intention to use the mark: Singapore.

Date of notification: 17.02.2005

Language of the international application: English

WORLD INTELLECTUAL
PROPERTY ORGANIZATION

34, chemin des Colombettes, P.O. Box 18, CH-1211 Geneva 20 (Switzerland)
WIPO postal cheque account: No. 12-5000-8 Geneva
Int'l Bank Account Number (IBAN): Credit Swiss Bank, Geneva
CH35 0425 1048 7080 8100 0 / Swift Code: CRESCHZZ12A
Tel: (41-22) 338 9111 Fax: (41-22) 733 5428
E-mail: infreg.mail@wipo.int Internet: <http://www.wipo.int>



RECEIVED

SEP 8 2005

Madrid Agreement
and
Madrid Protocol

By registered mail

Seth M. Reiss
c/o Godbey Griffiths Reiss
1001 Bishop St., Suite 2300
Pauahi Tower
Honolulu Hawaii 96813
United States of America

Our reference: 860/311335001

Geneva, 02/09/2005

Re: Statement of Grant of Protection
International registration No. 827674 (BODY MINT)

Madam,
Sir,

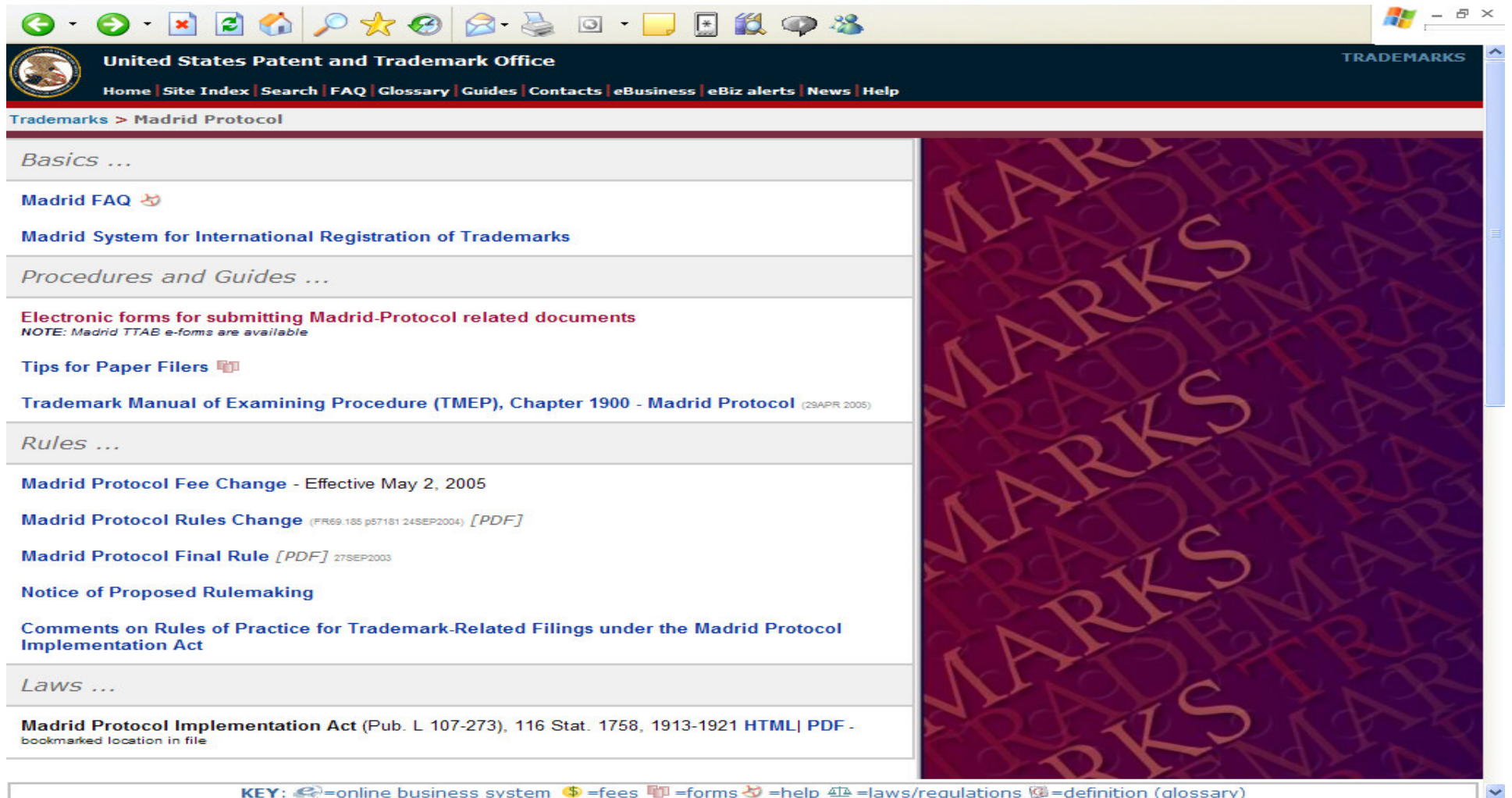
Please find enclosed a statement of grant of protection for the above-mentioned international registration, issued by the Office of Turkey, in accordance with Rule 17(6)(a)(i) of the Common Regulations under the Madrid Agreement and the Protocol Relating to that Agreement.

You will also find enclosed a copy of Information Notice No. 23/2000, which concerns such statements.

International Bureau of the World Intellectual
Property Organization (WIPO)

USPTO Practice Under the Madrid

<http://www.uspto.gov/web/trademarks/madrid/madridindex.htm>



The screenshot shows a web browser window displaying the USPTO Madrid Protocol website. The browser's address bar shows the URL <http://www.uspto.gov/web/trademarks/madrid/madridindex.htm>. The website header features the USPTO logo and the text "United States Patent and Trademark Office" with a "TRADEMARKS" link. A navigation bar includes links for Home, Site Index, Search, FAQ, Glossary, Guides, Contacts, eBusiness, eBiz alerts, News, and Help. The main content area is titled "Trademarks > Madrid Protocol" and is organized into sections: "Basics ..." (containing "Madrid FAQ" and "Madrid System for International Registration of Trademarks"), "Procedures and Guides ..." (containing "Electronic forms for submitting Madrid-Protocol related documents" with a note about TTAB e-forms, "Tips for Paper Filers", and "Trademark Manual of Examining Procedure (TMPE), Chapter 1900 - Madrid Protocol (29APR 2005)"), "Rules ..." (containing "Madrid Protocol Fee Change - Effective May 2, 2005", "Madrid Protocol Rules Change (FR69.186 p57181 24SEP2004) [PDF]", "Madrid Protocol Final Rule [PDF] 27SEP2003", "Notice of Proposed Rulemaking", and "Comments on Rules of Practice for Trademark-Related Filings under the Madrid Protocol Implementation Act"), and "Laws ..." (containing "Madrid Protocol Implementation Act (Pub. L 107-273), 116 Stat. 1758, 1913-1921 HTML| PDF - bookmarked location in file"). A large, stylized graphic of the words "TRADEMARKS" in a repeating pattern is visible on the right side of the page. The footer contains a key for icons: online business system, fees, forms, help, laws/regulations, and definition (glossary).

United States Patent and Trademark Office

TRADEMARKS

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Madrid Protocol

Basics ...

[Madrid FAQ](#)

[Madrid System for International Registration of Trademarks](#)

Procedures and Guides ...

Electronic forms for submitting Madrid-Protocol related documents
NOTE: Madrid TTAB e-forms are available

[Tips for Paper Filers](#)

[Trademark Manual of Examining Procedure \(TMPE\), Chapter 1900 - Madrid Protocol](#) (29APR 2005)

Rules ...

[Madrid Protocol Fee Change](#) - Effective May 2, 2005

[Madrid Protocol Rules Change](#) (FR69.186 p57181 24SEP2004) [PDF]

[Madrid Protocol Final Rule](#) [PDF] 27SEP2003

[Notice of Proposed Rulemaking](#)

[Comments on Rules of Practice for Trademark-Related Filings under the Madrid Protocol Implementation Act](#)

Laws ...

[Madrid Protocol Implementation Act](#) (Pub. L 107-273), 116 Stat. 1758, 1913-1921 [HTML](#) | [PDF](#) - bookmarked location in file

KEY: =online business system =fees =forms =help =laws/regulations =definition (glossary)

USPTO Madrid Practice Electronic Filing via TEAS

<http://www.uspto.gov/teas/index.html>

TEAS file online

the Trademark Electronic Application System. TEAS allows you to fill out a form, check it for completeness, and then submit the form directly to the USPTO over the internet, making an official filing on-line.

NOTE: New Filers are encouraged to review [Where Do I Start](#) information before beginning the application process.

Up-Coming Enhancements

- [Expanded Image File Types](#). *Updated 01/05/2005*

Important Notices

- [Paper Filings](#). *Updated 11/02/2004*
- [Form Session Time Limit](#).
- [Ensuring Receipt of All Information](#).
- [Keeping Data When "Backing Up" in Forms](#).
- [Eastern Time Controls Filing Date](#).
- [Three Payment Options Available](#).
- [Image Files for TEAS Must Be in JPG Format](#).
- [Avoiding Formatting Problems](#).
- [Filing Fee and Refund Policy](#). *Updated 07/18/2005*
- [Sound Marks and electronic filing](#). *New 05/20/2005*
- [Ensuring delivery of emails sent from the USPTO](#).

Forms

Click here for [TEAS TECHNICAL INFORMATION](#), [TEAS TUTORIAL](#) (step-by-step instructions for filing your application directly over the Internet), and [ELECTRONIC FILING TIPS](#) *New*

Click below to access the correct form:

Trademarks

- [Apply for a NEW mark](#)
- [File a PRE-registration Form](#)
 - File Preliminary Amendment
 - File Extension of time or Allegation of Use/Statement of Use
 - File form after receiving your Notice of Allowance (NOA)
 - File Request to Delete Section 1(b) basis, Intent to Use *New*
- [File a POST-registration form or Renew an Existing Registered Mark](#)
- [Response to Office Action Form](#)
- [Change of Address Forms](#) *New*
- [Express Abandonment Form](#) *New*
- [Petition Forms](#) *New*
For Petition Information Sheet for a paper filing, please click [here](#).
- [Withdrawal of Attorney & Revocation/Appointment of Attorney/Domestic Representative Forms](#) *New*

Madrid Protocol Forms

New 11/01/2004

[Assignments*](#)

Electronic Filing via TEAS Madrid Outbound Forms

<http://teasi.uspto.gov/>



■ **Application for International Registration**

Use this form to submit an international application for registration. If the international application meets the requirements of [37 C.F.R. §7.11\(a\)](#), the USPTO will certify and forward the international application to the International Bureau of the World Intellectual Property Organization (IB). An international application submitted through the USPTO must be based on either (1) an application(s) that is currently pending in the USPTO; or (2) a registration(s) that the USPTO already issued. The international application may be based on more than one basic application or registration only if the mark and the owner are the same for all of the basic applications and/or registrations.

NOTE: All fees associated with the international application, i.e., the U.S. certification fee and the international application fees, must be paid at the time of submission. The U.S. certification fee is \$100.00, per class, if the international application is based on one single basic application or registration; or \$150.00 per class, if the international application is based on more than one basic application or registration. A schedule of international fees and fee calculator are available online at <http://www.wipo.int/madrid/en/>. The international application fees may be paid through the USPTO in U.S. dollars or directly to the IB in Swiss francs.

■ **Subsequent Designation**

A subsequent designation is a request by the holder of an international registration for an extension of protection of the registration to additional countries that are party to the Madrid Protocol (Contracting Parties). The holder of an international registration may use this form to submit a subsequent designation through the USPTO for forwarding to the International Bureau of the World Intellectual Property Organization (IB), provided that: (1) the holder is a U.S. national, either domiciled in the United States, or having a real and effective industrial or commercial establishment therein; and (2) the international registration is based on a U.S. basic application or registration.

NOTE: All fees associated with the subsequent designation, i.e., the U.S. transmittal fee and the international fees for filing a subsequent designation, must be paid at the time of submission. The U.S. transmittal fee is \$100.00. A schedule of international fees and a fee calculator are available online at <http://www.wipo.int/madrid/en/>. The international fees may be paid through the USPTO in U.S. dollars or directly to the IB in Swiss francs.

■ **Response to a Notice of Irregularity**

Use this form only if (1) you are submitting a response to a notice of irregularity in an international application issued by the International Bureau of the World Intellectual Property Organization (IB); and (2) the IB response deadline has not expired. You may not use this form to respond to any IB irregularities notice concerning another Madrid-related filing.

■ **Transformation into a National Application - Under Development**

The holder of an international registration may use this form to request transformation of its extension of protection to the United States into an application for registration under Section 1 and/or Section 44 of the Trademark Act, if the international registration was cancelled (in whole or in part) by the International Bureau of the World Intellectual Property Organization under Article 6(4) of the Madrid Protocol, due to the cancellation of the basic application or registration. The request for transformation must be filed within three months of the date of cancellation of the

Electronic Filing via TEAS Madrid Outbound Forms

United States Patent and Trademark Office
Application for International Registration

SELECTION OF FORM TYPE FOR APPLICATION FOR INTERNATIONAL REGISTRATION

What type of form do you wish to use?

☐ **PRE-POPULATED FORM**
(Use for **one** U.S. serial/registration number; *narrowing* of goods/services and/or substitute color drawing are permissible data change within this form.
Enter the **one** U.S. serial number or registration number as the basis of this International Application.

Enter the number with NO punctuation or other symbols included.

☐ **FREE-TEXT FORM**
(Use for multiple U.S. serial/registration numbers and/or for cases that do not yet appear in [TARR](#) and/or if changing data **other** than only *narrowing* goods/services and/or substituting color drawing.
Enter the U.S. serial number(s) or registration number(s) as the basis of this International Application. Separate multiple numbers with a comma.

Enter the number with NO punctuation or other symbols included.

i

The pre-populated form will automatically display the exact information that is already in the USPTO database for one specific U.S. serial number or registration number. If you do not change any data fields, then the pre-populated form will directly submit information that must be certified to WIPO's International Bureau (IB), without independent review of this data at the USPTO. Alternatively, this form may be used where certain data fields can be changed (e.g., either narrowing the scope of the identification of goods and/or recitation of services in the U.S. application or registration, and/or substituting a color drawing of the mark, where the original mark is shown in the USPTO database as a black-and-white image); however, if any data field is changed, an independent review of this data at the USPTO must occur prior to submission as certified to the IB.

The free-text form must be used if 1) the application for International Registration is being based on more than one U.S. serial number or registration number; 2) data is being changed in any way other than only narrowing the scope of the identification of goods and/or recitation of services in the U.S. application or registration and/or substituting a color drawing of the mark, where the original mark is shown in the USPTO database as a black-and-white image; or 3) the U.S. application being used as the basis is not yet loaded into the Office's database at

[[Help Desk](#) - [Bug Report](#) - [Feedback](#)]
[[TEAS Home](#) | [Trademark Home](#) | [USPTO](#)]

start 3 Microso... 2 Windo... Microsoft P... http://teasi... Application ... Microsoft P... 9:38 AM

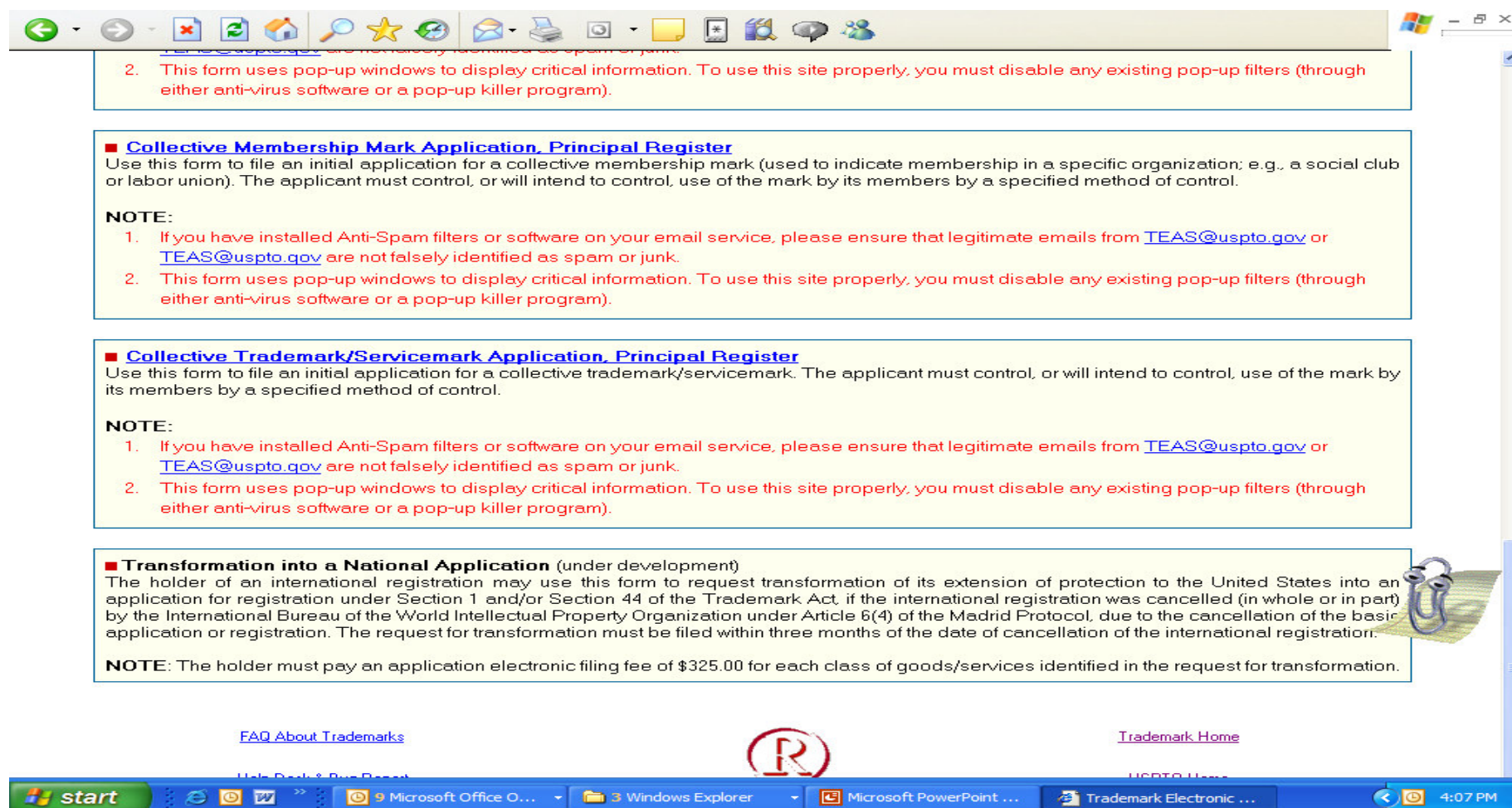
Madrid USPTO Inbound Practice

- No TEAS for inbound because an application under Section 66(a) is initiated by the IB, not applicant
- A lot of refusals based on broad identification of goods and services
 - Determined as a matter of U.S. law
 - U.S. requires much narrower identification than most countries
 - Need to retain U.S. trademark practitioner

Madrid USPTO Practice

TEAS Inbound Form for Transformation

<http://teasi.uspto.gov/> “Under Construction”



2. This form uses pop-up windows to display critical information. To use this site properly, you must disable any existing pop-up filters (through either anti-virus software or a pop-up killer program).

■ **Collective Membership Mark Application, Principal Register**
Use this form to file an initial application for a collective membership mark (used to indicate membership in a specific organization; e.g., a social club or labor union). The applicant must control, or will intend to control, use of the mark by its members by a specified method of control.

NOTE:

1. If you have installed Anti-Spam filters or software on your email service, please ensure that legitimate emails from TEAS@uspto.gov or TEAS@uspto.gov are not falsely identified as spam or junk.
2. This form uses pop-up windows to display critical information. To use this site properly, you must disable any existing pop-up filters (through either anti-virus software or a pop-up killer program).


■ **Collective Trademark/Service Mark Application, Principal Register**
Use this form to file an initial application for a collective trademark/service mark. The applicant must control, or will intend to control, use of the mark by its members by a specified method of control.

NOTE:

1. If you have installed Anti-Spam filters or software on your email service, please ensure that legitimate emails from TEAS@uspto.gov or TEAS@uspto.gov are not falsely identified as spam or junk.
2. This form uses pop-up windows to display critical information. To use this site properly, you must disable any existing pop-up filters (through either anti-virus software or a pop-up killer program).

■ **Transformation into a National Application (under development)**
The holder of an international registration may use this form to request transformation of its extension of protection to the United States into an application for registration under Section 1 and/or Section 44 of the Trademark Act, if the international registration was cancelled (in whole or in part) by the International Bureau of the World Intellectual Property Organization under Article 6(4) of the Madrid Protocol, due to the cancellation of the basic application or registration. The request for transformation must be filed within three months of the date of cancellation of the international registration.

NOTE: The holder must pay an application electronic filing fee of \$325.00 for each class of goods/services identified in the request for transformation.

[FAQ About Trademarks](#)  [Trademark Home](#) [USPTO Home](#)

start Microsoft Office Outlook Windows Explorer Microsoft PowerPoint Trademark Electronic Filing System 4:07 PM

International Aspects of Domain Name Disputes

© Seth M. Reiss
Godbey Griffiths Reiss Chong, LLP

Historical Development of Domain Name Hijacking Remedies in the US

- No recognized legal remedy = large \$\$\$\$
- Internic informal policy: placing domain names on hold
- Traditional Lanham act cases for infringement and then dilution
- ICANN formalized cyber-arbitration policy: UDRP
- Specialized federal legislation: ACPA

Domain Names as Trademarks

- A domain name is protectable as a trademark under U.S. law if it used as a trademark
 - *Brookfield Communications vs. West Coast Entertainment*, 174 F.3d 1036, 1044 (9th Cir. 1999)
 - mere registration of a domain name does not constitute use in commerce for purpose of establishing trademark rights (nor for purposes of constituting infringement)
 - USPTO policy for registration of domain names as marks: Examination Guide No. 2-99, published September 29, 1999.

Litigation

- Federal, state and foreign trademark and unfair competition claims; state, federal or foreign court
 - Traditional notions of personal jurisdiction
 - Targeting from afar?
- Anti-Cybersquatting Consumer Protection Act (“ACPA”); state or federal court
 - Special *in rem* jurisdiction for domain names whose owners are beyond the jurisdiction of the court

TM Infringement and Unfair Competitions For Well Known and Lesser Known Marks

- *Intermatic Inc. v. Toeppen*,
947 F. Supp. 1227 (N.D. Ill.
1996)
 - domain name arbitrage
constitutes use in commerce
 - defendant liable for
infringement, dilution and
unfair competition

Dilution: For Famous Marks Only

- Dilution by Tarnishment
 - *Hasbro, Inc. vs. Internet Entertainment Group*, 40 USPQ2d 1479 (WD Wash. 1996) use of “candyland.com” domain name for adult website diluting Hasbro’s “Candyland” game trademark by tarnishment
- Dilution by Blurring
 - *Intermatics Inc. v. Toeppen, supra* arbitrage of plaintiff’s mark in defendant’s domain name lessened capacity of plaintiff to identify itself and distinguish its goods and services from defendant’s

Litigation Under the ACPA

- Remedies limited in *in rem* jurisdiction cases to cancellation or transfer of domain name
 - when domain name registrant is overseas
 - when registrant can't be found due to false registration information
- Enhanced damages and attorneys fees available when there is *in personam* jurisdiction over defendant

Litigation Under the ACPA

- Bad faith an essential element
 - Registration or Use, not both
 - Compare UDRP where both bad faith registration and use required
- Includes remedy for reverse domain name hijacking
 - As, for example, making baseless claims or using false evidence in UDRP proceeding

Litigation Under the ACPA

- TRO not available against domain name registrant or registrar where trademark owner failed to establish personal jurisdiction as to either John Doe registrant or Canadian based registrar in *American Girl. LLC vs. Nameview, Inc.* (E.D. Wis. August 9, 2005)
- Plaintiff's remedies limited to *in rem* proceeding under the ACPA or a UDRP proceeding.

Litigation Under the ACPA

- *In rem* jurisdiction
 - Requires lack of in personal jurisdiction over domain name registrant; or
 - Domain name registrant cannot be located after due diligence; and
 - That registry or registrar located with in the district where the litigation is brought. *FleetBoston Financial Corp. vs. FleetBostonFinancial.com*, 138 F.Supp.2d 121 (D. Mass. 2001)

Litigation Under the ACPA

- *In rem* jurisdiction unavailable if both registry (ICANN accredited TLD sponsor) and registrar (ICANN accredited TLD reseller) are located outside the U.S.
- Has been used to transfer domain name from Argentinean registrant to U.K. owner in U.S. Court. *Harrods vs. Sixty Internet Domain Names, infra.*

Examples of Bad Faith Under the ACPA

- *Sporty's Farm v. Sportman's Market*, 202 F.3d 489 (2d Cir. 2000), *cert. denied*, 530 U.S. 1262 (2000), bad faith where defendant claimed he selected the name "sporty.com" after dog "spot" and never used the domain name
- *Northern Light Technology, Inc. v. Northern Lights Club*, 236 F.3d 57 (1st Cir. 2001), *cert. denied*, 530 U.S. 911 (2001), well-established pattern of registering famous marks sufficient to establish bad faith

Litigation Under the ACPA

- *Storey v. Cello Holdings, LLC*, 347 F.3d 370 (2nd Cir. 2003)
 - *Res judicata* will not bar ACPA action notwithstanding earlier ACPA action dismissed with prejudice where offer for sale of domain name postdated dismissal of first ACPA action

Extraterritorial Application of the ACPA

- *Harrods Ltd. vs. Sixty Internet Domain Name*, 302 F.3d 214 (4th Cir. 2002)
 - use by a South American registrant of the Harrods mark of the mark in English language domain names,
e.g., <www.harrodsshopping.com>, actionable under the ACPA because aimed at shoppers looking for the U.K. Harrods

Extraterritorial Application of the ACPA

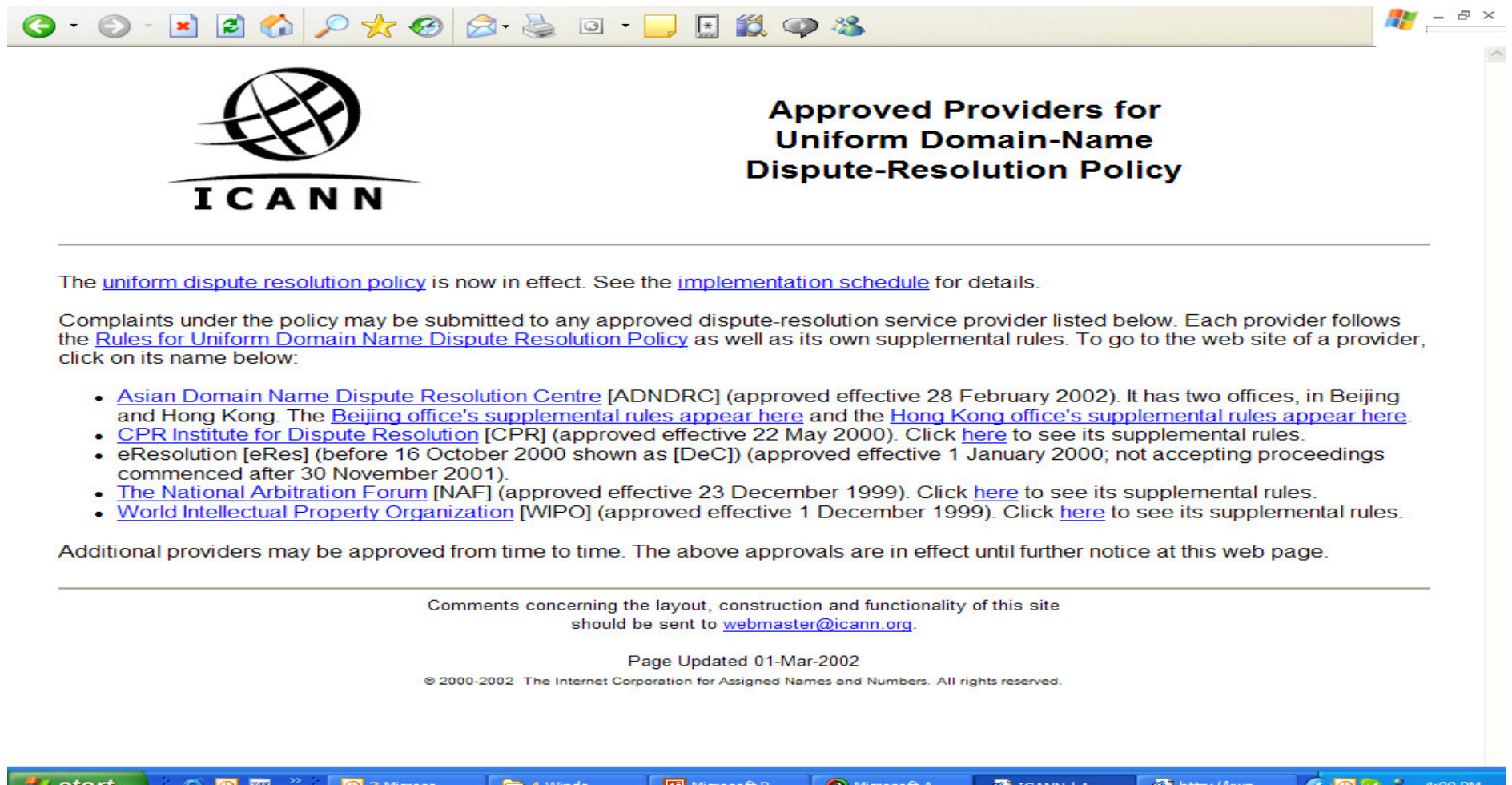
- Compare *Barcelona.com v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617 (4th Cir. 2003)
 - ACPA actions must be based upon rights arising under US law (Lanham Act); US courts do not entertain actions seeking to enforce trademark rights that exist only under foreign laws
 - UDRP decisions may be entitled to deference but not if based upon principles foreign or hostile to American law
 - Under US law, one can obtain trademark protection in a geographic designation only if that designation acquires secondary meaning
 - Held reverse domain name hijacking

Cyber-Arbitration


- Cyber-arbitration under the UDPR or CC Authorities
 - ICAAN's Uniform Dispute Resolution Policy Administred by ADR Providers
 - Disputes involving country code TLDs sometimes arbitrable under the UDRP and other times by a CC Authority appointed tribunal

ICANN Accredited UDRP Providers

<http://www.icann.org/dndr/udrp/approved-providers.htm>



The screenshot shows a web browser window with the address bar displaying the URL <http://www.icann.org/dndr/udrp/approved-providers.htm>. The browser's toolbar includes various icons for navigation and file management. The main content area features the ICANN logo on the left and the title "Approved Providers for Uniform Domain-Name Dispute-Resolution Policy" on the right. Below the title, a horizontal line separates the header from the main text. The text states that the uniform dispute resolution policy is now in effect and provides a link to the implementation schedule. It then lists five approved providers: Asian Domain Name Dispute Resolution Centre (ADNDRC), CPR Institute for Dispute Resolution (CPR), eResolution (eRes), The National Arbitration Forum (NAF), and World Intellectual Property Organization (WIPO). Each provider's name is followed by a brief description of its approval and a link to its supplemental rules. At the bottom of the page, there is a footer section containing a comment box, a page update date of 01-Mar-2002, and a copyright notice for 2000-2002.



**Approved Providers for
Uniform Domain-Name
Dispute-Resolution Policy**

The [uniform dispute resolution policy](#) is now in effect. See the [implementation schedule](#) for details.

Complaints under the policy may be submitted to any approved dispute-resolution service provider listed below. Each provider follows the [Rules for Uniform Domain Name Dispute Resolution Policy](#) as well as its own supplemental rules. To go to the web site of a provider, click on its name below:

- [Asian Domain Name Dispute Resolution Centre](#) [ADNDRC] (approved effective 28 February 2002). It has two offices, in Beijing and Hong Kong. The [Beijing office's supplemental rules appear here](#) and the [Hong Kong office's supplemental rules appear here](#).
- [CPR Institute for Dispute Resolution](#) [CPR] (approved effective 22 May 2000). Click [here](#) to see its supplemental rules.
- eResolution [eRes] (before 16 October 2000 shown as [DeC]) (approved effective 1 January 2000; not accepting proceedings commenced after 30 November 2001).
- [The National Arbitration Forum](#) [NAF] (approved effective 23 December 1999). Click [here](#) to see its supplemental rules.
- [World Intellectual Property Organization](#) [WIPO] (approved effective 1 December 1999). Click [here](#) to see its supplemental rules.

Additional providers may be approved from time to time. The above approvals are in effect until further notice at this web page.

Comments concerning the layout, construction and functionality of this site should be sent to webmaster@icann.org.

Page Updated 01-Mar-2002

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UDPR Positives

- Fast and Streamlined
 - 3 months
 - strict page limits
- Inexpensive
 - ADNDRC: \$1,000 to \$2,500
 - NAF: \$1,150 or \$2,500
 - WIPO: \$1,500 or \$4,000
- Jurisdiction not a problem
- Statistics favor trademark holders

UDPR Negatives

- Non-binding
- No reply
 - Inability to challenge fabrications of registrant
- No-damages, attorneys fees or sanctions
- Limited predictability and consistency, but improving

UDPR Negatives

- Requires proof that domain name was registered and used in bad faith
 - Innocent infringement and dilution not sufficient
 - Registration of vanity names for sale or simply sitting on a registered name? Case by case.

Recent UDRP Developments:

- Caseload leveling off; but not yet decreasing
- Concept of an emerging UDRP standard
 - Database of decisions searchable by topic
 - Attempts to harmonize substantive and procedural aspects of national laws
 - Recognition of trademark rights
 - Confusingly similar/passing off
 - Due process/natural justice
 - Increased consistency and reliability
 - Provider's role in promoting consistent decisions

UDRP RESOURCES

<http://arbiter.wipo.int/domains/search/overview/index.html>

The screenshot shows a web browser window displaying the WIPO Arbitration and Mediation Center website. The page title is "WIPO Overview of WIPO Panel Views on Selected UDRP Questions". The left sidebar contains a navigation menu with links: "About the Center", "Arbitration", "Mediation", "Recommended Clauses", "Domain Names", "gTLDs", "ccTLDs", "Cases", "Decisions", "Resources", "Filing", "Panelists", "Search", "Neutrals", "Meetings and Workshops", "Publications", and "What's New". The main content area has a header "WIPO Overview of WIPO Panel Views on Selected UDRP Questions" and three paragraphs of text. The first paragraph states that decision-making authority under the UDRP lies exclusively with the appointed panels. The second paragraph discusses the Center's identification of questions and evaluation of opinions based on 7,000 UDRP cases administered through February 2005. The third paragraph explains the purpose of the overview, which is to identify consensus among UDRP decisions. Below the text, there is a section titled "QUESTIONS" with links to "UDRP Policy", "UDRP Rules", and "WIPO Supplemental Rules". The browser's address bar shows the URL "http://arbiter.wipo.int/domains/search/overview/index.html". The Windows taskbar at the bottom shows the start button and several open applications, including Microsoft Word and Internet Explorer.

WIPO Arbitration and Mediation Center

Search Contact Home

Español · Français

WIPO Overview of WIPO Panel Views on Selected UDRP Questions

Decision-making authority under the Uniform Domain Name Dispute Resolution Policy and Rules (UDRP) lies exclusively with the appointed panels. To assist awareness of their views on certain questions that commonly arise in proceedings under the UDRP, the WIPO Arbitration and Mediation Center has produced the following informal overview of panel positions on key procedural and substantial issues. Decision references supporting each line of opinion are included, with over 100 decisions from over 80 different UDRP panelists listed.

While some of the listed issues arise only infrequently, all of them are, or are perceived to be, relevant to the operation of the UDRP. On most of these issues, consensus or clear majority views have developed. Certain other questions continue to attract a diversity of views. The Center's identification of questions and evaluation of opinions is based on the 7,000 UDRP cases it has administered through February 2005. **Broad information on all views is available from the Center's online Legal Index of WIPO UDRP Panel Decisions (<http://arbiter.wipo.int/domains/search>), as well as from the full posting of all decisions (<http://arbiter.wipo.int/domains/decisions>).**

This overview is created in recognition of the need that has been expressed to identify, as much as possible, consensus among UDRP decisions, so as to maximize the consistency of the UDRP system. It should be understood that, with UDRP decisions covering a multitude of facts and arguments, genuine differences of opinion may be difficult to avoid on particular issues, all the more so where panelists and parties come from a multitude of jurisdictions. However, it is hoped that this update on the UDRP experience will be found helpful by identifying views expressed by panels and providing decisions which help to put those views in context.

While predictability remains a key element of dispute resolution systems, neither this informal overview nor prior panel decisions are binding on panelists, who will make their judgments in the particular circumstances of each individual proceeding. Also, it remains the responsibility of each case party to make its own independent assessment of decisions relevant to its case. In particular, parties should note that the present overview cannot serve as a substitution for each party's obligation to argue and establish its case under the UDRP.

The idea of this overview was welcomed by the WIPO Domain Name Panelists Meeting convened in Geneva in October 2004. The contents have been informally reviewed by a number of the most experienced WIPO panelists, who have also supported the public dissemination of this overview. The Center, in consultation with its panelists, will make an effort to update this document with relevant future panel decisions.

The Center is profoundly grateful to all WIPO panelists for the internationally recognized contributions which they have made and continue to make to the functioning of the UDRP as a time and cost efficient mechanism for the resolution of Internet domain name disputes.

QUESTIONS

[UDRP Policy](#)
[UDRP Rules](#)
[WIPO Supplemental Rules](#)

WIPO UDRP RESOURCES:

Selected Issues Overview

<http://arbiter.wipo.int/domains/search/overview/index.html>

- Overview of WIPO Panel Views on Selected (including controversial) UDRP questions
 - “sucks” cases and criticism sites
 - Geographic terms
 - Personal names and generic words
 - Unregistered marks
 - Reseller rights
 - Passive holding
 - Supplemental filings and refiled cases
 - And more

The Role of Consensus (Precedent?) in UDRP Decision Making

- “Although the WIPO Decision Overview is not precedential in nature, it does reflect a studied and considered summary of consensus positions culled from the decisions of numerous panelists during the first five years of administration of the UDRP. When such a consensus has developed, it is incumbent upon panels to follow the consensus (or the majority view) to promote consistency among UDRP decisions.” Panelist David H. Bernstein in *Fresh Intellectual Properties, Inc. v. 800Network.com, Inc.* (WIPO Case No. D2005-0061, note 3)

The Role of Consensus in UDRP Decision Making

- Panels remain split on certain issues due to
 - Differences in national laws, rules and concepts
 - Panelist personal views and preferences where the Policy and UDRP precedential consensus fails to provide a clear rule

WIPO UDRP RESOURCES: Searchable Decisions Database

<http://arbiter.wipo.int/domains/search/overview/index.html>

The screenshot displays the WIPO Arbitration and Mediation Center website. The header includes the WIPO logo, navigation links for Search, Contact, and Home, and language options: 한글, 日本語, Português, Español, and Français. The main heading is "Search WIPO Cases and WIPO Panel Decisions".

Searches

- View Case Particulars: -
(includes: link to decision text for decided cases)
- [Index of WIPO UDRP Panel Decisions](#)
(offers easy access to the legal and other information contained in WIPO decisions)
- Search WIPO Cases by Domain Name:
- Full text search on WIPO Panel Decisions:

Other Resource

- [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#) **New**

Left Sidebar:

- [About the Center](#)
- [Arbitration](#)
- [Mediation](#)
- [Recommended Clauses](#)
- [Domain Names](#)
 - [gTLDs](#)
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Bottom Bar: Terms of Use

Taskbar: start, 2 Microsoft..., Time Matter..., 2 Window..., Microsoft P..., WordPerc..., Domain Na..., 12:56 PM

WIPO UDRP RESOURCES:

Decisions Index

<http://arbiter.wipo.int/cgi-bin/domains/search/legalindex?lang=eng>

The screenshot shows a web browser window displaying the WIPO Arbitration and Mediation Center website. The browser's address bar shows the URL <http://arbiter.wipo.int/cgi-bin/domains/search/legalindex?lang=eng>. The website has a header with the WIPO logo and navigation links for Search, Contact, and Home. A language selection bar is also present. The main content area is titled "Index of WIPO UDRP Panel Decisions" and includes a brief description of the index and a search tip. Below this, there are two columns of links: "Decided WIPO cases by domain name categories" and "Legal index to WIPO panel decisions". A sidebar on the left contains a list of links related to the center's activities and services. At the bottom, there is a section for "Decided WIPO cases by domain name categories" with checkboxes for various categories.

WIPO Arbitration and Mediation Center

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Index of WIPO UDRP Panel Decisions

This Index covers all WIPO UDRP decisions. New decisions are being added continuously. The Center also makes available a separate [WIPO Overview of WIPO Panel Views on Selected UDRP Questions](#).

🔍 **Search tips**
Any time you select more than one category, the search result will yield ONLY those decisions that are indexed in ALL of the categories so selected.

Decided WIPO cases by domain name categories	Legal index to WIPO panel decisions
I. Associations and Institutions	I. General
II. Geographical Identifiers	II. Substance
III. Individuals	III. Procedure
IV. Industry and Commerce	IV. National Court Proceedings Relating to UDRP
V. Non-ASCII Script Registrations	
VI. Professional Firms	
VII. Education	
VIII. Public Sector (Governments)	

Decided WIPO cases by domain name categories

- ☐ I. Associations and Institutions
 - ☐ A. Religious
 - ☐ B. Sports
 - ☐ C. Others
- ☐ II. Geographical Identifiers
- ☐ III. Individuals