

related to cyberpiracy protections for individuals, was transferred to section 8131 of this title.

#### SUBCHAPTER IV—THE MADRID PROTOCOL

### § 1141. Definitions

In this subchapter:

#### (1) Basic application

The term “basic application” means the application for the registration of a mark that has been filed with an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

#### (2) Basic registration

The term “basic registration” means the registration of a mark that has been granted by an Office of a Contracting Party and that constitutes the basis for an application for the international registration of that mark.

#### (3) Contracting Party

The term “Contracting Party” means any country or inter-governmental organization that is a party to the Madrid Protocol.

#### (4) Date of recordal

The term “date of recordal” means the date on which a request for extension of protection, filed after an international registration is granted, is recorded on the International Register.

#### (5) Declaration of bona fide intention to use the mark in commerce

The term “declaration of bona fide intention to use the mark in commerce” means a declaration that is signed by the applicant for, or holder of, an international registration who is seeking extension of protection of a mark to the United States and that contains a statement that—

(A) the applicant or holder has a bona fide intention to use the mark in commerce;

(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

#### (6) Extension of protection

The term “extension of protection” means the protection resulting from an international registration that extends to the United States at the request of the holder of the international registration, in accordance with the Madrid Protocol.

#### (7) Holder of an international registration

A “holder” of an international registration is the natural or juristic person in whose name

the international registration is recorded on the International Register.

#### (8) International application

The term “international application” means an application for international registration that is filed under the Madrid Protocol.

#### (9) International Bureau

The term “International Bureau” means the International Bureau of the World Intellectual Property Organization.

#### (10) International Register

The term “International Register” means the official collection of data concerning international registrations maintained by the International Bureau that the Madrid Protocol or its implementing regulations require or permit to be recorded.

#### (11) International registration

The term “international registration” means the registration of a mark granted under the Madrid Protocol.

#### (12) International registration date

The term “international registration date” means the date assigned to the international registration by the International Bureau.

#### (13) Madrid Protocol

The term “Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid, Spain, on June 27, 1989.

#### (14) Notification of refusal

The term “notification of refusal” means the notice sent by the United States Patent and Trademark Office to the International Bureau declaring that an extension of protection cannot be granted.

#### (15) Office of a Contracting Party

The term “Office of a Contracting Party” means—

(A) the office, or governmental entity, of a Contracting Party that is responsible for the registration of marks; or

(B) the common office, or governmental entity, of more than 1 Contracting Party that is responsible for the registration of marks and is so recognized by the International Bureau.

#### (16) Office of origin

The term “office of origin” means the Office of a Contracting Party with which a basic application was filed or by which a basic registration was granted.

#### (17) Opposition period

The term “opposition period” means the time allowed for filing an opposition in the United States Patent and Trademark Office, including any extension of time granted under section 1063 of this title.

(July 5, 1946, ch. 540, title XII, § 60, as added Pub. L. 107-273, div. C, title III, § 13402, Nov. 2, 2002, 116 Stat. 1913.)

#### EFFECTIVE DATE

Pub. L. 107-273, div. C, title III, § 13403, Nov. 2, 2002, 116 Stat. 1920, provided that: “This subtitle [subtitle D

(§§13401–13403) of title III of div. C of Pub. L. 107–273, enacting this subchapter and provisions set out as a note under section 1051 of this title] and the amendments made by this subtitle shall take effect on the later of—

“(1) the date on which the Madrid Protocol (as defined in section 60 of the Trademark Act of 1946 [this section]) enters into force with respect to the United States [Nov. 2, 2003]; or

“(2) the date occurring 1 year after the date of enactment of this Act [Nov. 2, 2002].”

**§ 1141a. International applications based on United States applications or registrations**

**(a) In general**

The owner of a basic application pending before the United States Patent and Trademark Office, or the owner of a basic registration granted by the United States Patent and Trademark Office may file an international application by submitting to the United States Patent and Trademark Office a written application in such form, together with such fees, as may be prescribed by the Director.

**(b) Qualified owners**

A qualified owner, under subsection (a) of this section, shall—

(1) be a national of the United States;

(2) be domiciled in the United States; or

(3) have a real and effective industrial or commercial establishment in the United States.

(July 5, 1946, ch. 540, title XII, §61, as added Pub. L. 107–273, div. C, title III, §13402, Nov. 2, 2002, 116 Stat. 1915.)

**§ 1141b. Certification of the international application**

**(a) Certification procedure**

Upon the filing of an application for international registration and payment of the prescribed fees, 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.

**(b) Transmittal**

Upon examination and certification of the international application, the Director shall transmit the international application to the International Bureau.

(July 5, 1946, ch. 540, title XII, §62, as added Pub. L. 107–273, div. C, title III, §13402, Nov. 2, 2002, 116 Stat. 1915.)

**§ 1141c. Restriction, abandonment, cancellation, or expiration of a basic application or basic registration**

With respect to an international application transmitted to the International Bureau under section 1141b of this title, the Director shall notify the International Bureau whenever the basic application or basic registration which is the basis for the international application has been restricted, abandoned, or canceled, or has expired, with respect to some or all of the goods and services listed in the international registration—

(1) within 5 years after the international registration date; or

(2) more than 5 years after the international registration date if the restriction, abandonment, or cancellation of the basic application or basic registration resulted from an action that began before the end of that 5-year period.

(July 5, 1946, ch. 540, title XII, §63, as added Pub. L. 107–273, div. C, title III, §13402, Nov. 2, 2002, 116 Stat. 1915.)

**§ 1141d. Request for extension of protection subsequent to international registration**

The holder of an international registration that is based upon a basic application filed with the United States Patent and Trademark Office or a basic registration granted by the Patent and Trademark Office may request an extension of protection of its international registration by filing such a request—

(1) directly with the International Bureau; or

(2) with the United States Patent and Trademark Office for transmittal to the International Bureau, if the request is in such form, and contains such transmittal fee, as may be prescribed by the Director.

(July 5, 1946, ch. 540, title XII, §64, as added Pub. L. 107–273, div. C, title III, §13402, Nov. 2, 2002, 116 Stat. 1916.)

**§ 1141e. Extension of protection of an international registration to the United States under the Madrid Protocol**

**(a) In general**

Subject to the provisions of section 1141h of this title, the holder of an international registration shall be entitled to the benefits of extension of protection of that international registration to the United States to the extent necessary to give effect to any provision of the Madrid Protocol.

**(b) If the United States is office of origin**

Where the United States Patent and Trademark Office is the office of origin for a trademark application or registration, any international registration based on such application or registration cannot be used to obtain the benefits of the Madrid Protocol in the United States.

(July 5, 1946, ch. 540, title XII, §65, as added Pub. L. 107–273, div. C, title III, §13402, Nov. 2, 2002, 116 Stat. 1916.)

**§ 1141f. Effect of filing a request for extension of protection of an international registration to the United States**

**(a) Requirement for request for extension of protection**

A request for extension of protection of an international registration to the United States that the International Bureau transmits to the United States Patent and Trademark Office shall be deemed to be properly filed in the United States if such request, when received by the International Bureau, has attached to it a