

# Madrid Protocol-Based Registrations: Maintenance and Renewal

A Lexis Practice Advisor® Practice Note by Peter S. Sloane and Michelle J. Levin, Leason Ellis LLP



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This practice note provides a brief overview of maintenance and **renewal** requirements for International Registrations obtained pursuant to the Madrid Protocol. It focuses on the requirements for extensions of protection into the United States.

Similar to national U.S. trademark registrations, U.S. extensions of protection must be both maintained and renewed. Pursuant to U.S. trademark law, they are maintained by filing a Declaration of Use or Excusable Non-use (known as a Section 71 Declaration) at specific intervals in the U.S. Patent and Trademark Office (USPTO). However, the International Registration, along with all of the individual country extensions, must be renewed centrally with the World Intellectual Property Organization (WIPO).

Note that not all countries that participate in the Madrid system require maintenance filings in between **renewal** periods. Thus, it may be helpful to confer with foreign counsel in relevant jurisdictions to determine any relevant

requirements. For country-specific guidance, see [Trademarks in International Jurisdictions](#). For a more detailed discussion on the Madrid system (including the Madrid Protocol), see [Madrid International Trademark System](#).

Note that effective August 3, 2019, all foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented by an attorney licensed to practice law in the United States in all trademark matters. This includes the submission of Section 71 Declarations. Additionally, effective December 21, 2019, all trademark submissions (including Section 71 Declarations) must be filed electronically, with limited exceptions. See Changes to the Trademark Rules of Practice to Mandate Electronic Filing, 84 FR 52363 (Oct. 2, 2019).

## Maintenance Filings

The maintenance of International Registrations obtained pursuant to the Madrid Protocol is governed by Section 71 of the Trademark Act (compared to Section 8, which governs registrations based on use or a foreign registration).

Extensions of protection into the United States are subject to the same proof of use (or excusable non-use) requirements that are required for national registrations. For a more detailed discussion on the proof of use requirements, see [Trademark Registrations: Maintenance and Renewal – Section 8 Declaration of Use](#).

A U.S. extension of protection will be canceled if a Section 71 Declaration of Use is not timely filed. The requirements and timing of a Section 71 Declaration correspond to the Section 8 Declaration. Therefore, a Section 71 Declaration must be filed at the intervals below:

- Between the fifth and sixth year following the date the USPTO grants the extension of protection
- Between the ninth and tenth year following the date the USPTO grants the extension of protection
- Each successive 10-year period following the date the USPTO grants the extension of protection

The time for filing the required Section 71 Declaration is measured from the date the U.S. extension is issued. (The issuance date of the U.S. extension generally does not correlate to the issuance date of the International Registration—it is often at least a year after the International Registration date.) For an additional fee, registrants may file the necessary Section 71 Declaration within the six-month grace period following the deadline.

An electronic form for filing a Section 71 Declaration is available on the [Trademark Electronic Application System \(TEAS\)](#), the USPTO's electronic filing system. The form is nearly identical to a Section 8 Declaration and the requirements are mostly the same. It is also possible to file a claim for excusable non-use in a Section 71 Declaration.

Notable differences between Section 71 and Section 8 Declarations include the inability to change the owner information or amend the mark in a Section 71 Declaration. Any changes in the owner information or the owner address must be filed directly with WIPO. Further, it is not possible to amend the mark in an International Registration through WIPO.

The owner of a registered extension of protection may file a combined Section 71 and 15 Declaration (Section 15 Declarations are used for claims of incontestability). A combined Section 71 and 15 Declaration is available through TEAS. For a more detailed discussion on the requirements for asserting a claim of incontestability, see [Trademark Registrations: Maintenance and Renewal – Claim of Incontestability](#).

Note that the USPTO will conduct random audits of up to 10 percent of the combined total of Section 8 and 71 Declarations filed each year in which the mark is registered for more than one good or service per class. If you are selected for an audit, the USPTO will issue an Office Action requiring additional proof of use for specified goods/services (generally, for two additional goods/services per class). You must respond within six months and either:

- Submit the required proof of use (e.g., information, exhibits, affidavits or declarations, specimens of use)
- Delete those goods/services for which the mark is not being used

Failure to respond will result in cancellation of the entire registration (unless time remains in the grace period, in which case you may file a complete new Section 71 Declaration). The USPTO may also issue subsequent Office Actions requiring proof of use on some, or all, remaining goods/services. See 37 C.F.R. § 7.37(h); 82 Fed. Reg. 6259.

## Renewal Applications

**Renewals** of International Registrations, including extensions of protection, are filed through WIPO using a centralized system. Registrants are not required to renew their extensions of protection in each country listed in the International Registration. Rather, one **renewal** application filed with WIPO is sufficient. **Renewals** may be filed on paper, using the MM11 form supplied by WIPO, or through its electronic filing system, E-Renewal ([https://webaccess.wipo.int/trademarks/ren/erenewal\\_en.jsp](https://webaccess.wipo.int/trademarks/ren/erenewal_en.jsp)).

International Registrations are valid for 10 years and, as such, must be renewed every 10 years. The time period for renewing an International Registration, including the extension of protection into the United States, is measured from the issuance date of the Registration. This is different than the maintenance filings discussed above, which are measured from the date of the U.S. grant of protection.

For instance, if an International Registration is issued on April 1, 2012, the Registration must be renewed by April 1, 2022. The **renewal** requirements and the Section 71 maintenance requirements are separate and run parallel to each other.

Failure to renew an International Registration with WIPO results in the cancellation of the entire International Registration, including the U.S. extension of protection (as well as the protection granted by other countries).

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A partner at Leason Ellis LLP, Peter Sloane counsels clients, prosecutes trademark and copyright applications, and litigates intellectual property disputes. His clients span from major well-known companies to privately owned businesses to individuals. They operate in fields as diverse as consumer electronics, luxury goods, entertainment, pharmaceuticals and industrial products.

Peter counsels clients on all aspects of trademark adoption and protection including licensing. From advising clients on issues of inherent registrability to computer database and full searching, he is adept at taking the steps necessary to ensure that a mark is properly vetted prior to adoption. Peter is also familiar with the issues that arise in foreign trademark searching when a client has plans to use its mark abroad. Over the years, he has handled a number of global trademark portfolios.

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Michelle (Dorman) Levin practices in all aspects of domestic and foreign trademark prosecution. Her experience extends to a wide range of industries including luxury goods, publishing, electronics and food and beverages.

Michelle has conducted all phases of trademark prosecution and maintenance before the U.S. Patent and Trademark Office, including preparing and filing responses to Office Actions in all types of substantive refusals. Michelle has also conducted trademark searches and drafted opinions regarding the availability and registrability of trademarks, counseled clients regarding registration requirements in the U.S., negotiated license agreements, and conducted intellectual property due diligences. Outside the U.S., she has worked on trademark matters in over 100 countries, prosecuting foreign trademark applications, including international applications filed through WIPO, and maintaining international trademark portfolios.

Michelle has also assisted in copyright, trademark, and patent litigations, including extensive legal research, and prepared and filed documents for trademark opposition proceedings before the Trademark Trial and Appeal Board. She has also registered and maintained domain name registrations, handled UDRP proceedings, and prepared and filed copyright applications.

While in law school, Michelle interned at Burberry Limited, where she conducted internet trademark enforcement and drafted trademark settlement agreements, cease-and-desist letters, and correspondence to infringing parties. She also interned at Classic Media, Inc., where she drafted licensing, merchandising, promotional, agency, and work for hire agreements.

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