

Bright Ideas

A publication of the Intellectual Property Law Section of the New York State Bar Association

Message from the Chair

Sir Isaac Newton (a source worthy of citation by any intellectual property law practitioner) famously wrote: "If I have seen a little further it is by standing on the shoulders of Giants." It should be noted with some irony that in using this phrase Newton was actually cribbing an expression already at the time hundreds of years old. Indeed, the first written reference to this now-famous metaphor dates back at least to the twelfth century, attributed to Bernard of Chartres, who allegedly was fond of saying "we are like dwarfs on the shoulders of giants, so that we can see more than they, and things at a greater distance, not by virtue of any sharpness of our sight on our part, or any physical distinction, but because we are carried high and raised up by their giant size."



Paul M. Fakler

As the incoming Chair of the Intellectual Property Law Section, the metaphor of a dwarf standing on the shoulders of giants seems particularly fitting to describe my position. I have been entrusted with the temporary stewardship of a Section that is no longer new, no longer small, no longer up-and-coming. Our Section is one of the largest, most productive, and most fun (I dare say) of any of the Sections of the New York State Bar Association. This did not happen accidentally. The greatness of the Section we know today was forged of the hard work and commitment of several Past-Chairs (and many Executive Committee members supporting them) who, over time, turned the Section into what it is.

One of the most remarkable things about these giants is how many of them continue to be active in the Section. In my opinion, this is one of our Section's greatest strengths, and it speaks not only to the commitment of these Past-Chairs but also to how much enjoyment

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Legalization of Documents in International Trademark Practice: A Primer

By Peter S. Sloane and Sergey Lysenko

No trademark professional who deals with foreign matters can escape the need to legalize certain documents from time to time. Legalization is the process of certifying or authenticating a document so that it will be recognized by a foreign country's legal system. Although the theoretical purpose of legalization is to authenticate the validity of signatures, one may reasonably suspect that the true motivation in requiring this arguably archaic practice is to raise governmental revenues by fee taxes. Still, legalization is a reality with which trademark lawyers must deal and, while not exactly rocket science, it is important to become familiar with the different ways to properly legalize documents in order to minimize unnecessary time and expense.

In the trademark field, the most common document requiring legalization is the Power of Attorney. Other documents requiring legalization include priority documents and sworn declarations or affidavits. Legalization of such documents is required by many countries around the world. A list of countries that require legalization may be found on Wikipedia at [http://en.wikipedia.org/wiki/Legalization_\(international_law\)](http://en.wikipedia.org/wiki/Legalization_(international_law)). Notable countries requiring legalization include Brazil, Canada, Chile, China, Denmark, Singapore, and Thailand as well as Arab countries such as Iraq, Saudi Arabia, and the United Arab Emirates. These countries require following what is often referred to as the "Chain Authentication Method."

Notarization is usually the first step in the Chain Authentication Method. However, documents issued by the Secretary of State of any of the fifty states or by a federal agency need not be notarized. They are in a sense self-authenticating. For example, a certified copy of a trademark application certified by the United States Patent and Trademark Office does not require notarization.

Other non-official documents should be notarized by a licensed notary public. The notary should sign the notarial certification and affix his or her official seal. For example, a Power of Attorney authorizing a foreign law firm to act on behalf of a client should be notarized. If the Power does not incorporate a notarial certificate, it should be attached to the document as a separate page. Although the certificate should generally verify the identity of the person signing the underlying document, the District of Columbia and some states such as Arizona have specific required language. Familiarization with the notarization requirements in the various states is highly recommended.

Once the trademark-related document is executed and notarized, it is then necessary to certify the notary's signature. Some states, such as Connecticut, allow for certification by the Secretary of State. New York, however, requires certification by the clerk's office in the county where the notary is qualified. There are sixty-two counties in New York. Most counties have their own clerk's office. Specific rules and fee information can usually be found on their respective websites. In New York, once the county clerk certifies the signature of the notary, it is then necessary to send the document to the Secretary of State with a request for authentication. An "authentication" certifies the signature and the position of the official who has executed, issued, or certified a copy of a document.

There are two ways to authenticate documents in New York. The document may be mailed to the Department of State in Albany, or it can be brought in person to the Albany office or to the Department of State's New York City office. Documents submitted by mail are usually completed within two to four business days, while documents submitted in person are usually completed the same day. Each document submitted for authentication must be accompanied by a \$10 fee. See www.dos.state.ny.us/corps/apostille.html for more information.

From the local Secretary of State, the document should then be sent to the U.S. Department of State in Washington, D.C. This is because foreign consuls can only authenticate the seal of an office that they recognize, and the U.S. Department of State is the highest office in the United States. Any document in a foreign language must include an English translation. The authentication fee is \$8 per document. The authentication of documents currently takes about 25 business days to process from the time of receipt, although walk-in service is available.

After certification by the federal Department of State, unless the country is a member of the Hague Convention, as discussed further below, the document then must be certified by the embassy for the foreign country at issue. The Authentications Office of the U.S. Department of State will mail documents directly to the foreign embassy or consulates if provided with a transmittal letter, fee, and a pre-addressed stamped envelope.

Most foreign countries maintain their embassy in Washington, D.C. The website at www.embassy.org provides information on each of the embassies with links to web-based resources where available. Many countries also

have consulate offices located in major metropolitan cities. For example, the People's Republic of China currently maintains consulates in New York, Chicago, San Francisco, Los Angeles, and Houston. The New York consulate, located in Manhattan, authenticates documents that already have been certified by the Secretaries of the following states: Connecticut, Maine, Massachusetts, New Hampshire, New Jersey, New York, Ohio, Pennsylvania, Rhode Island, and Vermont. Detailed information about specific rules and government fees can be found on the website at www.nyconsulate.prchina.org.

Many countries have specialized requirements for legalization. For example, documents intended for use in Angola must be translated into Portuguese, and documents for use in Cuba must be translated into Spanish.

To expedite the process, one should consider using an associate in Washington who is experienced and knowledgeable concerning the specific requirements to obtain legalization of documents. According to Kathryn Jennison Shultz of Jennison & Shultz in Washington, "It pays to have someone walk into the U.S. Department of State and the embassies to save time and provide confidence that the process is completed correctly."

Legalization does not necessarily end at the U.S. border. Some countries have further legalization requirements. These are often referred to colloquially as "super-legalization." For example, according to Marwan Haddad of Saba & Co. Intellectual Property, in the United Arab Emirates it is necessary to further legalize the documents up to the Ministry of Foreign Affairs. Thankfully, in certain cases, there is a less expensive and time-consuming approach to legalization. Apostille refers to the legalization of documents under the Convention Abolishing the Requirement of Legalization for Foreign Public Document, concluded on October 5, 1961. A list of countries that are party to the Convention may be found at www.hcch.net/index_en.php?act=conventions.status&cid=41. The Convention simplifies the legalization process by abolishing the need for the diplomatic and consular authentication of public documents. Under the Convention, public documents include (a) documents issued by a court; (b) documents issued by an administrative authority; and (c) documents executed before a notary public.

When such documents have been certified by apostille, no further authentication is required for recognition by a Convention country.

The function of the apostille is to certify the authenticity of the signature on the document, the capacity in which the person signing the document acted, and the identity of any stamp or seal affixed to the document. The United States has been a party to the Convention since 1981. In the United States, apostille is issued by the local Secretary of State. The U.S. Department of State has a website page describing apostille requirements at www.state.gov/m/a/auth/c16921.htm. In New York, an apostille issued by the Secretary of State is a one-page document with a black and white laser-printed facsimile of the New York State Department of State Seal. The apostille includes the facsimile signature of the individual issuing the certificate.

Beyond the formal rules for apostilization, it is at times necessary to be familiar with the legalization requirements and common practice in particular jurisdictions. For example, even though Russia is a signatory to the Convention, the official website of the Russian embassy in the United States at www.ruscon.org/cons_other_ENG.html indicates that the Russian Federation "[m]ay not accept foreign corporate documents if they are not legalized by consular offices of Russian Federation in the countries where the documents originated." As a result, it is prudent to have a document with apostille further legalized by the Russian Embassy, which has branches in several states. The evident purpose of such a requirement is to raise official fees.

Although the process of legalization and apostilization is generally straightforward, there are caveats depending upon the particular county, state, and country. Consequently, it is helpful to seek information from the websites of the various governmental entities and even at times to seek assistance from experienced and knowledgeable local counsel in the United States and abroad.

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