

Foreign Trademark Filings including Community Trade Marks

Thank you for your recent inquiry regarding foreign trademark protection. As you may be aware, the rights afforded an owner of a U.S. trademark are territorial in nature. That is, they are valid only in the United States and do not extend to foreign countries. Therefore, in order to secure intellectual property protection outside the United States, generally, you must register a trademark on a country-by-country basis. On average, filing an application runs about US\$1000-\$1500 per country. In addition to the initial filing, there are also costs for clearing a mark by conducting a preliminary search (about US\$300 per country) and costs for prosecution of the application in the foreign trademark office (\$variable). Once examination is complete, if the application is allowed, registration fees are also required (about US\$800 - US\$1500 per country). Quotes for specific countries are available upon request.

However, if you are interested in more than three or four countries in the European Union, it may be more cost effective to apply for a Community Trade Mark ("CTM"). The CTM offers the opportunity to protect a trademark in all the countries of the European Union (EU) through filing a single application. The countries currently covered by a CTM registration are Austria, Benelux (Belgium, the Netherlands and Luxembourg), Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, the Slovak Republic, Slovenia, Spain, Sweden and the United Kingdom.

The most attractive feature of CTM registration is that it offers trademark protection in all countries of the EU at a cost that is much lower than that of filing separate applications in each Member State, generally about US\$3500 to file and another US\$2500 to register. Furthermore, use of the trademark is not required to secure registration or renewal. Also, use in a single Member State is sufficient to maintain the validity of the CTM registration throughout the EU, and avoid it being vulnerable to cancellation through nonuse over a five-year period. Last, a CTM application that is refused registration may be converted into national applications maintaining the priority of the original CTM application. A disadvantage of the CTM registration is that an earlier registration in one Member State alone may defeat a CTM application in its entirety.

Please also keep in mind that the above foreign application estimates do not include costs and fees for priority claiming, certified copies, printing surcharges, oppositions, appeals, substantive rejections, consular legalization or incidental charges such as courier charges. Exchange rates also may greatly affect most estimates. Please note that all fees involved in filing foreign trademarks must be paid prior to filing. During prosecution of the applications, sufficient funds must also be maintained in trust to cover agents' fees for prosecution and registration as they come due.

We hope the above information is helpful for your decision regarding foreign trademark protection. Please let us know how you wish to proceed.