

# Obtaining Trademark Rights & Registrations Internationally

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# Introduction

- Practicing since 2007
- Background: Medicine, Music, Software, International
- Clientele Industries: Fintech, AI & Software, Music, Food & Beverage, Consumer Products
- Recently joined Lippes Mathias LLP

# Learning Objectives

1. Strategize about when and where to pursue trademark rights abroad depending on client activities and plans over time
2. Identify how differences in trademark laws from those of the United States may impact the selection of marks to be registered, the scope of goods and services to be covered, and the enforceability of rights obtained
3. Decide between the two mechanisms for obtaining registrations abroad with an understanding of the differences in method, risks, and costs for each
4. Recognize cost-effective ways to search for marks in non-U.S. jurisdictions
5. Review how differences in trademark laws and practices may impact the issues faced and the actions available to address them

# Key Aspects of U.S. Trademark System

- First to use: Use Requirement/Evidence/Filing Basis
  - Outside of the United States, trademark rights are generally obtained as a result of registration (as opposed to use)
- Absolute & Relative Grounds of Refusal
- Distinctiveness can be earned later
- Supplemental Register
- Signature Requirement/Formalities
- Scope: Color vs. Black & White
- Likelihood of Confusion analysis independent of Classification
- Specificity
  - “Clothing, namely, shirts” in Class 25
  - “Legal services” in Class 45
- New Platforms, Requirements, Costs – Took Effect January 18, 2025

# Where to register the mark?

- Will the manufacturer sell/distribute the same product to others? Will it bear the same mark?
- Will others copy the product in the country of manufacture?
- Will others seek to register the mark?
- Where will you distribute the product or offer the services?
- Where will you have distributors, licenses, joint development partners?
- Where will you open offices/stores?
- From where are your employees working?
- Stealth Filings

# Madrid System

- 114 members / 130 countries
- Basic application/registration in home country sent to WIPO with designations of desired foreign rights
- Cheaper up front
- Riskier
  
- U.S. based Madrid Registrations
  - Often unnecessarily limited by the requisite specificity
  - Risk of Central Attack
  - Generally cheaper, but not advisable for house mark or questionable distinctiveness
  
- Madrid Registration Extended to U.S.
  - No Supplemental Register
  - Descriptions of Goods/Services
  - Translations
  - No moving between classes
  - Colors

# European Union

- 27 Countries at once
  - Key Excluded Countries: Norway, United Kingdom, Switzerland
  - Some individual countries within the E.U. can be faster.
- First to file with no use requirement
  - Use only required after 5 years/Generally only comes up in oppositions/cancellations
- Specificity (more so than previously)
- Color vs Black & White
- No Relative Grounds of Refusal, but Notifications to Owners = Extensive Opposition Practice
- Distinctiveness at time of filing & across the entire region
- Much faster than U.S. process

# Canada

- No more Filing Bases
- Use requirement
- Classification
- Distinctiveness
  - Inherent
  - Acquired (as of filing date, in all provinces)
- Consents often disregarded
- French language requirements



# Puerto Rico

- Backlogged
- Covered by U.S. federal system?
  - Do not always follow the U.S. federal system
- Varied Responsiveness of counsel

# China

- Not really the “wild east” that many perceive it to be
  - First to File
  - Subclassification
  - Translated/Transliterated Marks
  - Varied Costs & Responsiveness
  - Limited access to documents
  - Limited rationales for decisions
  - Suspension rare (changing)
  - Some formalities: Beijing IP Court

# India

- Slow process
- Varied costs & responsiveness
- Solicitations

# MENA region

- Traditionally most expensive
- Formalities
- Sub-POAs

# Brazil

- Class Headings Ok, but trend toward specificity
- Publication before examination
- Slow process
- Recently joined Madrid
- Varied Cost & Responsiveness
- Limited Access to Documents
- Limited Rationale for Decisions

# Andean Community

- Peru, Bolivia, Colombia, and Ecuador
- Not Centralized Registration
- Regional right to oppose
- Regional right to defend against non-use
- Applies to Madrid Registrations in Colombia?

# African regional trademarks

- **OAPI**
  - 17 French-speaking countries in Western in Africa
  - Single regional filing;
  - No national trademarks available
- **ARIPO**
  - Regional system similar to Madrid Protocol
    - Doubts

# Customs

- Registering the trademark registration with U.S. customs can prevent importation of counterfeit and infringing goods
- In some countries, like China, registration with customs can prevent exportation of such goods



# Other considerations

Options for Searching

Options for Filing

Developing a Filing Strategy

Iterative approach and alignment on budget and planned activities

# Thank you

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