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Pitfalls of the Madrid Protocol – Just Ask Fiat

Italian car maker Fiat sought to extend the protection in the U trademark **FIAT 500** for "retail store and on-line retail store se and others." Fiat's U.S. application was based on its internati Madrid Protocol allows a single international application to be member countries as opposed to a separate application in eac

The issue before the Trademark Trial and Appeal Board (TTAB *Communications S.p.A*, Serial No. 79/099154 (TTAB Jan. 31, 20 identification of services in Fiat's application from "advertising administration; office functions" to retail store services consti violation of Trademark Rule 2.71(a). Rule 2.71 permits an app but not broaden, the identification of goods and/or services."

Fiat's identification of services in its international registration under the Madrid Protocol – *i.e.*, "advertising services; bus functions" – mirrored the heading of International Class 35. In other words, in its original application, Fiat used the class services. Although International Class 35 encompasses retail and on-line sales, the TTAB rejected the registration. The T construction of a registration that is sometimes used in foreign jurisdictions.

Instead, the TTAB applied the "ordinary meaning" test from section 1402.07(a) of the Trademark Manual of Examining Pr that "[t]he USPTO will not permit the applicant to amend to include any item that falls in the class, unless the item falls w heading, ..." Section 1402.07(a) specifically references TMEP § 1402.01(b), noting that "class headings are generally ur States applications, even if the class heading is used as the identification in the foreign registration."

Fiat argued that the amended services should be considered within the scope of protection of the original application be stores and store services." Fiat relied on the following language from TMEP § 1402.02 regarding the filing date requirem goods/services: "[t]he USPTO will not deny a filing date if the applicant uses the language of an international class headir services in a certain class." *See* TMEP § 1402.02. Based on that language, Fiat argued that the USPTO considers a class h particular class. According to Fiat, it was not broadening the scope of the original services in violation of Rule 2.71 becau "business management" services - words taken verbatim from the heading of International Class 35.

The TTAB disagreed, holding that the proposed amendment improperly broadened the identification of services in violati 1402.01 which requires that "common names" and "generally understood" terminology be used instead of a class headir applying the "ordinary meaning" test from TMEP § 1402.07(a), the TTAB found that the term "business management" is encompass retail store services. It simply found unpersuasive Fiat's argument that "business management" is an umbrel because the latter involves the management of a business.

The TTAB summed up its decision as follows:

> . . . while class headings are allowed in international registrations, and the USPTO will accord a filing date to a
> to an international registration that uses a class heading as an identification of goods or services, use of the w
> in an application filed with the USPTO is not deemed to include all the goods and services in the established s

In short, the TTAB rejected the so-called "class heading covers all" policy adopted by certain countries party to the Madri
the protection of its **FIAT 500** mark in the United States to retail store services. The lesson learned here is that when usir
extension of protection in the United States, make sure you are familiar with the rules and regulations of the USPTO, incl
policy.

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