

International Registration of Trademarks as per Madrid Protocol

Accession of India to Madrid Protocol

India on 8th July 2013 shall formally ascend to Madrid Protocol relating to the Madrid Agreement Concerning the International Registration of Marks. This shall mark a new chapter in the history of the Intellectual Property Rights protection regime with a single application opening the doors of Trade mark protection in 89 designated countries around the world. India shall join in as 90th member and shall be 14th member of G-20 economies to have acceded to the Protocol. This step shall ensure and give robust march of Indian businesses to countries around the world. The Madrid system shall be benefiting businesses across lines and especially Indian business that have been aiming to enter the global markets and seeking expansion in these global markets respectively. This system shall be benefiting big, small and medium Indian business alike. The system shall also vice-versa prove to be a boon to the foreign business that have been eying the Indian markets but have been caught up in red-tape web and with held the filing of the applications for trade mark registration.

The International system of Registration of Marks or Madrid System

The Madrid Protocol of 1989 is a sequel to the Paris Convention for the protection of Industrial Property and aims to provide a trade mark owner a speedy, cost-effective and streamline process of registration of his mark internationally in designated countries (other 89 countries party to the Madrid Protocol) by the filing of single application with his own national or regional trade mark office. The international application must designate contracting party (countries party to Madrid Protocol) where the protection for trade mark is sought. This application is thereafter forwarded by the intermediary regional trade mark office to International bureau of World Intellectual Property Organization (WIPO) which shall examine the application for compliance to the Protocol and shall classify the application. The International Bureau shall record the mark in the International Register in the absence of any irregularity and publish the international registration in the WIPO Gazette of International trade marks and notify the same to each designated country.

The designated contracting party shall thereafter examine the mark for compliance to its domestic legislation and may also refuse to grant protection in their territory in case of conflict with any of the provisions of its domestic legislation. India has declared 18 months as time-limit to notify provisional refusal of protection to the international bureau and declared further that provisional refusal resulting from opposition proceedings in India may be notified after the expiry of 18 months time-limit. This refusal shall be communicated to the trade mark holder and recorded in the International Register and thereafter published in the gazette. The proceedings subsequent to the refusal are carried out directly between the designated contracting party and the trademark holder and the decision of the said matter is communicated to International bureau and published by it in Gazette.

The working of Madrid System in India

The system works in a similar fashion in India. The applicant in order to file international application is required to base its application on Indian application of registration of mark or 'base application' as it is called. The applicant may also base its international application on the Indian registration of trademark. This application is either in English or French or Spanish language and designates countries where the applicant wishes to seek protection of trademark. This application along with the applicable fee in Swiss franc is filed with the Indian trademark office. The Indian trademark office shall then certify the information contained in the international application on the basis of base application or Indian trademark registration. Thereafter, the Indian office shall forward this application to the International bureau of WIPO. The international bureau shall review the international application to see whether it complies with the filing requirements of Madrid Protocol and in absence of any irregularity and in the presence of the requirements being met shall register the same and publish in the WIPO Gazette of International Marks. The International bureau shall thereafter send certificate to the applicant informing about registration.

The International bureau will then notify each designated contracting party mentioned in the international application of the request of extension of protection to trademark in their country. The designated contracting party shall examine the international registration in accordance to its domestic laws and in case of no violation, the designated country shall grant protection and notify the same within 12 months or 18 months as declared by it in its instrument of accession to Protocol. India has declared that it shall declare the same within 18 months. In case, the designated country does not inform the International bureau about the provisional refusal then it shall be deemed that the designated country has granted protection to the mark. Any opposition to said international registration shall be decided in the Indian jurisdiction between the applicant and Indian trademark office by the applicant contesting the proceedings in India. India as mentioned above shall notify the provisional refusal to international registration in case of opposition after the expiry of 18 month's time limit.

Central Attack

Under the Indian law, any refusal or withdrawal or cancellation of base application or Indian registration within first 5 years from the date of international registration shall lead to refusal or withdrawal or cancellation of that international registration of mark to the same extent in all designated countries. This is known as 'central attack' whereby attacking the base application shall lead to cancellation of international registration of mark. In case of successful central attack, the applicant may seek registration of the mark on basis of independent application in each jurisdiction in designated country. The designated country on the basis of international registration shall accord registration from the date of international registration filing.

Benefits of the Madrid system

The international mark that is registered by said process is bestowed with the same protection as if it is registered in the trade mark office of the designated home country. This system assists in protection of Trademark portfolios internationally by filing of single application and thereby assist in expansion and promotion of brand and brand value of businesses.

India Road to Madrid Protocol

The Trade marks (Amendments) Act, 2010 and the Trade Marks Rules, 2013 shall set in motion India accession to Madrid Protocol. The Trade Marks Rules, 2013 have been already notified and India shall start accepting international applications for registration of marks from 8th July 2013 onwards.

India in its instrument of accession to Madrid Protocol has declared under **Article 14 (5)** of the Madrid Protocol that any protection resulting from any international registration effected under Madrid Protocol before date of entry in force of the Protocol, with respect to India, **cannot be extended to India**. India has also declared in the instrument that it shall receive an **'individual fee'** where it is designated in the international application instead of the receipt of a share in the revenue produced by the supplementary and complementary fees and shall accordingly declare the same by an information notice. India has also declared that **under Rule 20bis (6) (b) of the Common Regulation under the Madrid Agreement Concerning International Registration of Marks and Protocol relating to that Agreement** that recording of any license in regard to the use of international mark in the international register shall have **no effect in India** and **any license relating** to the international registration of mark which has been granted with respect to India shall **in order to have effect in India should be recorded in National Register of Trade mark office in India in accordance to local law**.

But, India at this juncture is also faced with the herculean task of bringing this project to a success. The Indian Trade Mark office is already burdened with domestic trademark applications in the absence of sufficient human resource power and therefore, an important question remains to be answered is that whether the Indian trademark office shall be able to withstand the pressures of international trademark registration system. The Indian government has been taking steps to develop the Indian Trademark office so as to enable it to efficiently handle the speedy and effective international system of registration of marks. India already has its trade mark office on the internet where the application status, examination reports and oppositions to marks being available at just of a click of a button and the government is also taking steps to ensure easy acceptance of trade mark applications.

Conclusion:

The acceptance of Madrid Protocol by India is truly a revolutionary move by India leading to the inclusion of India to the International trademark system and also simultaneously offering the business and trademark, owners an easy and cost effective mechanism of acquiring trademark protection in multiple jurisdictions by single application. This system has also brought the world closer to what can be truly called as 'global village'.

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www.lawsenate.com

Office Numbers: +91-11-26102873, +91-11-26104773
Email Id: contact@lawsenate.com, info@lawsenate.com
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