



ACCESSION TO THE MADRID PROTOCOL – WHAT IT MEANS TO INDIAN BUSINESS?

The Union Cabinet has announced its approval to the much awaited accession to the Madrid Protocol on International Registration of Marks. Consequently, a Bill will be introduced in Parliament to amend the Indian Trade Marks Law (Trade Marks Act, 1999) to incorporate provisions relating to international registration through the Madrid Protocol. The Madrid Protocol, administered by the International Bureau of World Intellectual Property Organisation (WIPO), Geneva, facilitates the filing, registration and maintenance of trademark rights in more than one country on a global level.

A trademark is the face of a company and therefore trademark protection assumes great significance when a company has built a good image and reputation. Trademark registration being territorial in nature and with Indian multi-nationals gaining prominence in the international arena, it is imperative that they protect their trademarks internationally through registration. Not only for companies already having presence in foreign countries, also for companies / enterprises contemplating international expansion, it becomes important to protect their trademarks in those countries.

At present, there is no system for obtaining international registration in all countries in the world. The best available international system as of today is the Madrid System for international registration where registration can be obtained in the 71 member countries of the Madrid Protocol. However, until now Indian applicants did not have the option to use the International Registration system.

According to the current trademark practice in the country, trademark owners who want protection for their marks abroad have to file applications in each country and prosecute them separately, which turns out to be time-consuming and exorbitant. The Madrid Protocol facilitates trademark registration in multiple countries by allowing filing of a single application and designating any or all of the member countries where protection is required. The primary advantage of the International Trademark System is that single application can be filed in one jurisdiction, in one language, with one set of fees, in one currency (Swiss francs). Filing applications, changing particulars, renewing registrations can all be done through a single administrative process. This to a large extent would simplify trademark filings and reduce costs.

How the system works

To file an international application, an applicant must have an Indian application, called a "basic application" or an Indian registration, called a "basic registration". The international application has to be filed through the Indian Trademark Office. The Indian Trademark Office (Office of origin) must certify that information in the international application based on the Indian basic application is the same. The Office of origin would then forward the international application to the International Bureau of WIPO.

The International Bureau will review the international application to determine whether it meets the Madrid Protocol filing requirements. If the requirements are met and the fees paid, the International Bureau will then register the mark, publish it in the WIPO Gazette of International Marks (WIPO Gazette), send a certificate to the international applicant.

The International Bureau will then notify each Contracting Party designated in the international registration of the request for an extension of protection to that country. Each designated Contracting Party according to its domestic laws will examine the request for an extension of protection. If the application meets the criteria for registration of that country, then the Contracting Party will grant protection of the mark in its country.

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There are stringent time limits for refusing to grant an extension of protection (a maximum of 18 months). If a member country does not notify the International Bureau of any refusal of an extension of protection within the prescribed time limit set forth in the Madrid Protocol, the holder of the international registration is automatically granted protection for its mark in that country.

Another useful aspect of the Madrid System is that this protection may be extended to additional jurisdictions at any time, so as to cover countries that subsequently join the Madrid System, or to such other territories the trademark owner may choose. Also, after the mark in an international application is registered, the owner of the international registration can request an extension of protection in additional countries by designating additional contracting parties.

One also needs to be aware of the downside of filing an international application through the Madrid System which is called the "Central Attack". For the first five years, the international registration will be totally dependent on the Indian basic application or registration. This means that, during the first five years of the life of the international registration, if the Indian application or registration is refused, withdrawn, cancelled or restricted, in whole or in part, then the international registration will lead to the refusal, withdrawal or cancellation of the international registration to the same extent which will be carried out by the International Bureau. A refusal or cancellation of a basic application or registration after the end of the 5-year period will also result in the cancellation of the international registration, if the action that caused the refusal or cancellation began within that 5-year period. However, after the 5-year period has ended, the international registration becomes independent of the basic application or registration. However, the effects of a successful "central attack" can be alleviated by converting the international registration into a series of individual applications in each jurisdictions designated by the international registration. Although conversion is an expensive option of last resort, one consolation is that the resulting applications will receive the registration date of the international registration as their filing date.

The accession would make possible speedy registration of Indian trademarks in different countries worldwide. Existing trademark holders whose trademarks are pending registration in India can also use the Madrid Protocol to extend the protection to other member countries.

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