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Features

The Madrid Protocol in BRICS Countries: A Comparative Analysis

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The BRICS countries (Brazil, Russia, India, China and South Africa) held an annual summit in Brazil in July 2014 leading to some significant developments, including the establishment of the BRICS' New Development Bank. Attention has been drawn to the potential of these developing economies due to many factors, including their combined population, GDP and exemplary growth rate (as shown in Figure 1). Economist and Former Chairman of Goldman Sachs, Jim O'Neill, in his book, *The Growth Map: Economic Opportunity in the BRICs and Beyond*, mentions that "Brazil, Russia, India and China are emerging countries whose size gives them the potential to overtake today's largest economies, the G7, by 2050."



BRICS combined GDP grew more than 300 percent in the last decade.

Figure 1. Source: 6th BRICS Summit, Brazil (July 2014). Statistics available at www.brics6.itamaraty.gov.br/.

BRICS' focus on IP grew at its Annual Summit in Durban, South Africa, in 2012, where the group's trade ministers endorsed a BRICS Trade and Investment Cooperation Agreement, which specifically included a provision for cooperation in IP. To move forward the cooperation among the BRICS IP offices, a roadmap dubbed the Intellectual Property Offices Cooperation Roadmap was agreed upon in Magaliesburg, South Africa, on May 16, 2013, and was signed alongside the World Intellectual Property Organization's (WIPO's) annual General Assemblies in Geneva, in September 2013. This roadmap has the following goals:

- Promotion of public awareness of IP in BRICS countries
- Examiner exchange programs
- Information services to be enhanced by an

exchange of patent information, and best practices provided by each office

- Training of Intellectual Property Office Staff
- National IP Strategy and IP Strategy for enterprises
- A review of filing procedures within the group, improvements in office practices, and increased innovation and commercialisation among the countries
- Collaboration in international forums

Worldwide, more and more trademark holders and businesses are filing trademark applications via the Madrid Protocol. According to a WIPO press release dated March 13, 2014, in 2013 there was a 6.4 percent increase in filings under the Madrid System, with a total of 46,829 Madrid applications filed. Recognizing the growing importance of International Registrations of Marks under the Madrid System, BRICS countries are consistently amending their laws and procedures in accordance with the international conventions. With the accession of India to the Madrid Protocol on April 8, 2013, Brazil and South Africa are the only BRICS countries yet to become members of the Madrid Protocol.

This article discusses the implementation and adoption of International Registrations of Marks under the Madrid Protocol in Russia, China and India, as well as the status of accession to the Madrid Protocol in Brazil and South Africa.

Comparison of the Trademark Laws of BRICS Countries

There are certain basic differences in the trademark laws of the various BRICS countries, including the filing basis and the duration of the non-use period warranting removal of a trademark, as shown in the table on page 13.

Filing Under the Madrid Protocol: Comparative Analysis Among India, Russia and China

According to WIPO's *Madrid Yearly Review*, in 2013, China was the most frequently designated Madrid member, followed by Russia. China was the only Madrid member to exceed 20,000 total designations, while Russia received a total of 18,239 designations, consequently recording one of the highest growth rates (9.6 percent).

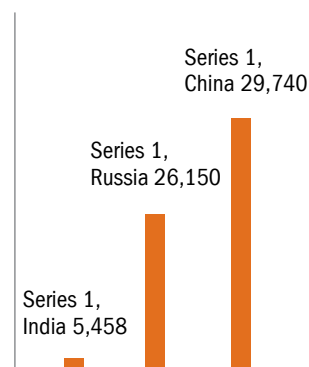
Similarly, it is expected that India, as one of the world's growing economies, will file more international applications in the coming years and will be selected often as a designated country by trademark holders worldwide.

International Applications Originating from India, Russia and China (July 2013–October 2014)



Source: Statistics under Madrid System (WIPO)

International Applications Designating India, Russia and China (2013–2014)



Source: Statistics under Madrid System (WIPO)

India

India's accession to the Madrid Protocol on April 8, 2013 was preceded by necessary amendments in the domestic IP regime. The Trademarks (Amendment) Act, 2010, as well as various administrative changes, including the following norms and standards, were introduced to adapt to the changing regime:

- Trademarks (Amendment) Act, 2010 included a new chapter (Chapter IV A) incorporating special provisions relating to the protection of trademarks through international registration under the Madrid Protocol. Sections 36A to 36G of the Trademarks Act contain the provisions with respect to International Registration of Marks under

See "Madrid Protocol" on page 14

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Country	Brazil	Russia	India	China	South Africa
Trademark Office	National Institute of Industrial Property	Federal Service for Intellectual Property (ROSPATENT)	Office of the Controller-General of Patents, Designs and Trademarks	State Administration for Industry and Commerce of the People's Republic of China (SAIC)	Department of Trade and Industry, Companies and Intellectual Property Commission (CIPC)
Statute Followed	Industrial Property Law No. 9279/96	Trademark Law No. 3520-1 of September 23, 1992	Trademarks Act, 1999 and Trademarks Rules, 2002	Trademark Law of the People's Republic of China	Trademark Act of 1993
Filing Basis	First-to-File	First-to-File	First-to-Use	First-to-File	First-to-Use
Removal of Trademark on Basis of Non-use	5 years	3 years	5 years 3 months	3 years	5 years
International Treaties in Force (Year Treaty Came into Force)	<ul style="list-style-type: none"> • Nairobi Treaty (1984) • Paris Convention (1884) 	<ul style="list-style-type: none"> • Madrid Agreement (1976) • Madrid Protocol (1997) • Nairobi Treaty (1986) • Nice Agreement (1971) • Paris Convention (1965) • Singapore Treaty on the Law of Trademarks (2009) • Trademark Law Treaty (1998) 	<ul style="list-style-type: none"> • Madrid Protocol (2013) • Nairobi Treaty (1983) • Paris Convention (1998) 	<ul style="list-style-type: none"> • Madrid Agreement (1989) • Madrid Protocol (1995) • Nice Agreement (1994) • Paris Convention (1985) 	Paris Convention (1947)
Basic Fee; Office of Origin	N/A	CHF 653	CHF 653	CHF 653	N/A
Country of Designation	Individual/Complementary Fee				
India	N/A	CHF 100	-	CHF 249	N/A
Russia	N/A	-	CHF 51	CHF 100	N/A
China	N/A	CHF 100	CHF 51	-	N/A

INTA's Practitioner's Guide to the Madrid Agreement and Madrid Protocol

This searchable database offers practical information on member countries' practices and procedure in obtaining, maintaining and enforcing registrations through the Madrid System.

Visit www.inta.org/MadridProtocol

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the Madrid System. Under these provisions (Sections 9, 21, 63 and 74 of the Act), on receipt of notification from the International Bureau with respect to a particular mark, the Registry will examine the mark, advertise or refuse the application and apprise the International Bureau with respect to the same **within 18 months** of the date on which it received the notification.

- To comply with these time limits, a number of infrastructure upgrades have been introduced, one of the major reforms being digitization of the trademark department of the Office of the Controller-General of Patents, Designs and Trademarks and trademark filings. To a great extent, the implementation of these reforms has accelerated the process of registering marks and clearing the backlogs in examining trademark applications.

Moving Towards Madrid

Brazil

Brazil has not yet acceded to the Madrid Protocol. On April 9, 2013, CAMEX (the Brazilian Chamber of Foreign Trade of the Federal Government), in its consideration on accession to the Madrid Protocol, approved Brazil's accession; however, the treaty has not yet been submitted to Congress.

On May 16, 2013, the National Institute of Industrial Property (INPI) issued Resolution

No. 89/2013, which took effect on May 21, 2014, after being published in the Official Gazette (No. 2211). The Resolution introduced important changes to the procedure for filing trademark applications, including mandating a deadline for the implementation of a multi-class system. It also introduced certain provisions relating to the classification of goods and services and the classification of figurative elements. Following are some of these important changes:

- Article 14 of the Resolution provides that within 90 days from the effective date (i.e., May 21, 2014) of the Resolution, the INPI must begin to allow electronic filing of all trademark applications.
- Article 13, which is aimed at achieving greater consistency, transparency and speed in trademark examinations, establishes a 180-day deadline for the INPI to publish a table defining which markets are related to each other. Examiners can use this table to examine oppositions, appeals and administrative nullity proceedings.
- Article 12, establishes a 180-day deadline for the INPI to "implement mechanisms which permit and regulate" the filing of multiclass applications.

The administrative changes necessary to comply with the Madrid Protocol have already been initiated, i.e., to reduce the time it takes to examine applications in order to comply with the Madrid

System's rules (which provide for a maximum period of 18 months for examination).

South Africa

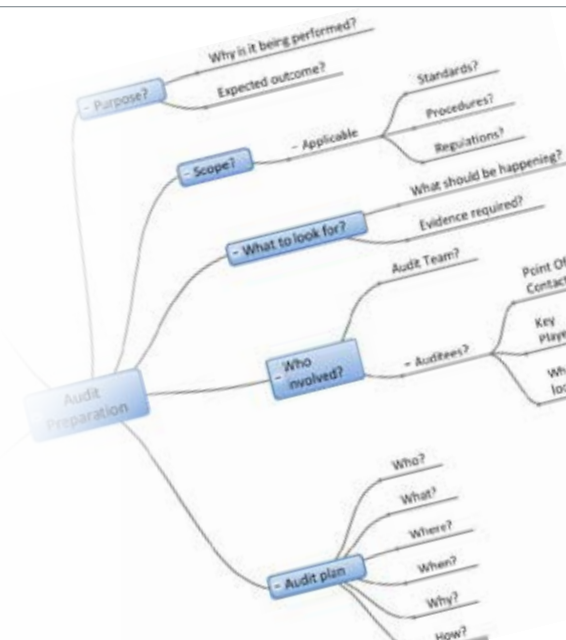
South Africa continues its consideration of joining the Protocol. In recent years, the laws of South Africa have been amended to accommodate the changes. Previously, it was thought that South Africa could not join the International Registration System because its Department of Trade and Industry was not able to meet the turnaround times prescribed by the international system (i.e., the 18-month deadline for examining applications). That is no longer the case, as trademark applications are now typically examined within nine months of filing.

Conclusion

The International Registration of Marks under the Madrid System is an appealing one-stop solution for member countries to register trademarks and to establish their global footprints. The Madrid Protocol has been generally well accepted and appreciated in the BRICS by the countries that have adopted it. The indications are that the number of outbound registrations from existing BRICS members of the Madrid System (Russia, India and China) are set to grow and may be joined by Brazil and South Africa in the distant future. ■

When You Need to Know

Whether undertaken as an assessment of trademark rights or an evaluation of the adequacy of internal management systems, a trademark audit has to be thorough to offer an accurate picture of a company's brand name activity. For tips on navigating the myriad details associated with the exercise, see "Trademark Audits" in INTA's exclusive **Practitioners' Checklists** series.



Visit www.inta.org/practitionerschecklists