



# India Joins Madrid

As India accedes to the Madrid Protocol, Indian IP practitioners are preparing for an expected growth in international applications. **Lucy Rana** explains.

On April 8, 2013, India's Minister of Commerce and Industry, Anand Sharma deposited India's instrument of accession to the Madrid Protocol for the International Registration of Marks to WIPO Director General Francis Gurry, which marked the accomplishment of an endeavour initiated six years ago to join the league of International Registration of Marks.

The Treaty is set to come into force on July 8, 2013, by which India will become the 90th member to join the international trademark system.

The Madrid System for International Registration of Marks originated in 1891 with the Madrid Agreement and was further expanded in 1989 with the inclusion of the Madrid Protocol. The system enables the trademark owners in the signatories' countries to secure international trademark registration by way of filing single application.

## Advantages of International Registration of Marks

The Madrid system provides that after a trademark has been registered by the International Bureau, it will take on the status of a national application, which means that any contracting party can accept or refuse the protection of the mark in its territory, in accordance with the provisions of its national laws. Trademark registration is territorial. As such, a refusal will only relate to the contracting party issuing it and will not affect other designated contracting parties. In addition, a refusal is not a final decision and is subject to appeal before the competent authorities.

One of the most striking features of the International Registration of Marks is the "one factor," which implies one application, in one language, with one set of fees (including basic fee, complimentary fee in respect of each designated contracting party and a supplementary fee for each class of goods beyond the third) in one currency, one expiry date and one registration to renew. Moreover, changes in the mark such as change in ownership or in the name or address of the holder or limitation in the list of goods and services can be recorded through a single simple procedural step with respect to all the designated contracting parties. This "one factor" involved in the filing of an international application is purported to enable many Indian companies in establishing their footprint globally.

Apart from giving a source of international branding to Indian industries, the international registration of marks system is also expected to give an opportunity to entities around the world to protect their marks in India.

## The Road Ahead

India has taken significant steps towards the alignment of its intellectual property regime with the global norms through the Trademark (Amendment) Bill, 2009 which has led to the inclusion of a new chapter (Chapter IV A) in the Trademarks Act, which exclusively deals with procedural and statutory requirements for international registration of marks. Sections 36A to 36G of the Trademarks Act entail the provisions with respect to international registration of marks under the Madrid System. Under

this provision, on receipt of notification from International Bureau with respect to a particular mark, the Registry will examine the mark under the provisions laid down under Sections 9, 21, 63 and

application. One of the recent developments in this regard being the drive initiated by the Registry for disposal of post-registration changes filed in trademark applications.



**One of the most intriguing concerns is if the Indian Trademark Registry is prepared to square up to the challenges it would face administratively while adhering to the Madrid System.**



**Growth in International Registrations Under the Madrid System**

In 2012, 44,018 applications were filed for international registration of trademarks under the Madrid System, marking a growth of 4.1% over the year 2011, according to statistics released by WIPO at a March 2013 press conference. The following graph depicts the growth rate of international

applications filed between the periods 2007- 2011, as well as the growth by office of origin:

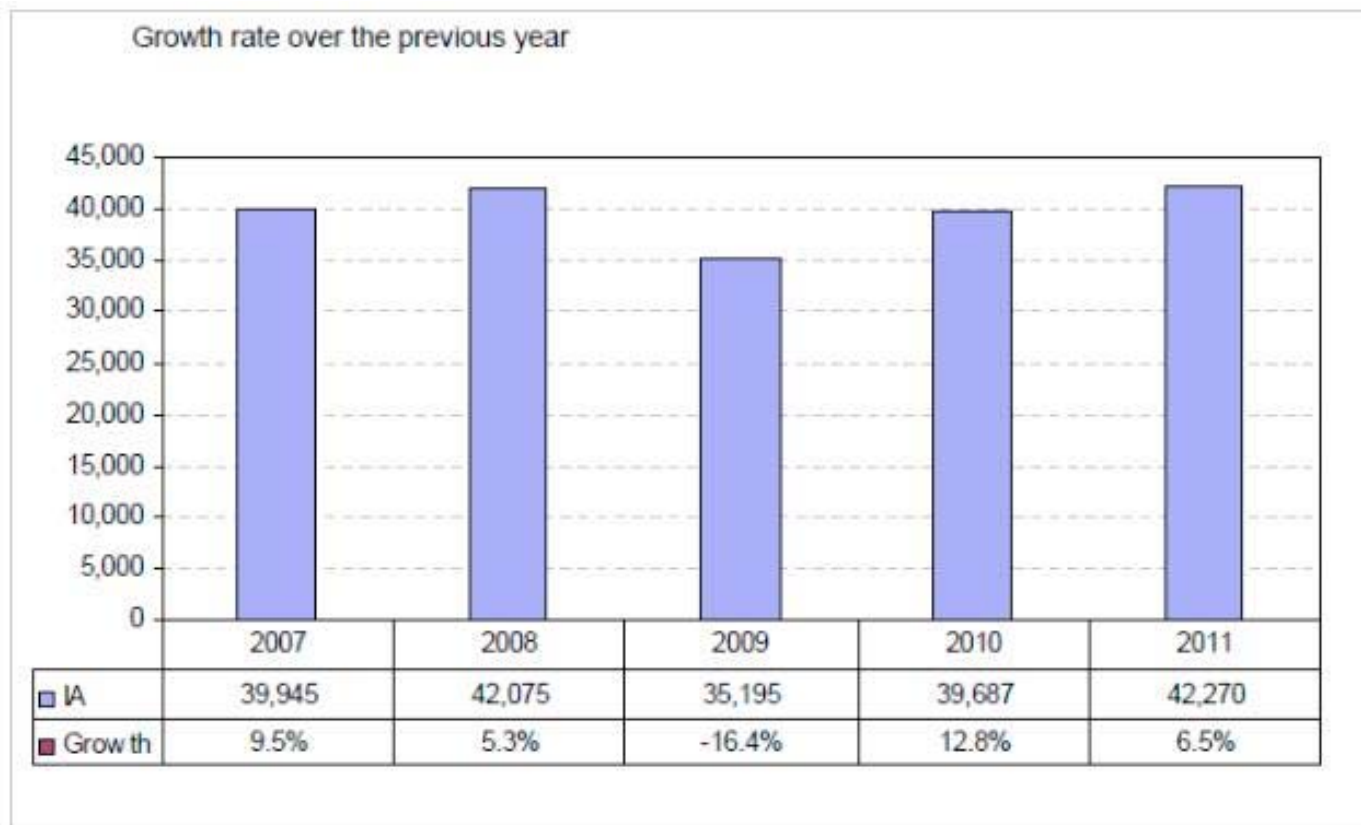
**Expected Impact of International Registration of Marks on the Domestic Market**

With the handing over of India's instrument of accession to WIPO, India is set to embrace the international registration of marks under the Madrid system and harmonize the Indian intellectual property law with the international trends. International registration of marks is set to provide an insight to Indian companies towards international branding. India, as one of the most-desired consumer markets globally, is likely to be more often designated by foreign applicants via the Madrid Protocol.

74 of the Act and thereafter accordingly issue necessary directives (advertise or refuse) the application and apprise the International Bureau with respect to the same within 18 months from the date on which it received the notification.

One of the most intriguing concerns is if the Indian Trademark Registry is prepared to square up to the challenges it would face administratively while adhering to the Madrid System. of Trademark Registration. In the last few years the Registry has been trying to introduce and implement several administrative norms for the upgrade of its infrastructure, with one of the major reforms being digitization of the trademark office and trademark filings, which to a great extent has accelerated the process of registration of marks, as well as cleared the backlogs with respect to amendments/corrections made in the trademark

**Applications of international registrations (TOP 10)**



Though it is widely speculated that Madrid system will result in a decrease of national Indian trademark applications, in all likelihood it is quite probable that the designations of India via the Madrid Protocol by foreign applicants will increase. The Indian IP community will also be enhanced by the Madrid Protocol, and Indian businesses will indeed benefit by the opportunities it offers. There will, however, be initial glitches and usual teething troubles that any new project has to undergo; for instance instead of just mentioning the class headings, applicants will now be required to mention specific designated goods, or else the mark may be refused in certain designated countries such as the United States. Nevertheless, the accession was long overdue, and apart from benefitting the brand owners, Indian companies and SMEs, it will invariably lead to augmentation of the Registry's infrastructure, streamlining of work and adoption of globally accepted best policies and practices.

The accession will almost certainly add to the existing impulses that have already placed considerable demands on the trademark registry, which will now also be under pressure to meet international obligations. The Indian Registry, however, has been continuously making efforts to mould itself so that it can rightly adapt itself and conform to the guidelines. To a greater extent the Registry has also been successful in matching itself with the standards of international registration.



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