

## **Madrid Protocol pertaining to Trademark Law**

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### THE MADRID SYSTEM OF INTERNATIONAL REGISTRATION OF TRADEMARKS - AN INSIGHT INTO THE INDIAN PERSPECTIVE

#### Brief Background of the Madrid System

The Madrid system for the international registration of marks, also conveniently known as the 'Madrid system', is the primary international system for facilitating registration of trademarks in multiple jurisdictions around the world.

The Madrid system provides a centrally administered system of obtaining a bundle of single jurisdiction trademark registrations based on an 'international registration', and therefore provides a mechanism for obtaining trademark protection in many countries around the world .

Although it is not possible to obtain an 'international trademark', whereby a single trademark registration will automatically apply around the world, the Madrid system permits the filing, registration and maintenance of trade mark rights in more than one jurisdiction on a global basis. The Madrid system is administered by the International Bureau of the World Intellectual Property Organisation in Geneva, Switzerland. The Madrid system comprises two treaties; the Madrid Agreement Concerning the International Registration of Marks, which was concluded in 1891 and entered into force in 1892, and the Protocol Relating to the Madrid Agreement, which came into operation on 1 April 1996. The Madrid Agreement and Madrid Protocol were adopted at diplomatic conferences held in Madrid, Spain.

#### Members

As of 15 July 2005, there are 77 members comprising the Madrid Union of jurisdictions which have become party to the Agreement or the Protocol or both. The primary reason why the Protocol - which in 2004 has been in operation for less than 10 years and has 66 members - is more popular than the Agreement - which has been in operation for more than 110 years and has 55 members - is that the Protocol introduced a number of changes to the Madrid system which significantly enhanced its usefulness to trademark owners.

For instance, according to the Protocol it is possible to obtain an international registration based on a pending trade mark application, so that a trade mark owner can simultaneously apply for international registration after filing an application in a member jurisdiction. On the other hand, the Agreement requires that the trade mark owner already holds an existing registration in a member jurisdiction. Moreover, the Agreement does

not provide the option to 'convert' international registrations which have been 'centrally attacked'

#### Recent developments in the World vis a vis Madrid System

Two significant recent developments in international trade mark law were the accession of the United States and the European Union to the Madrid Protocol on 2 November 2003 and 1 October 2004, respectively. With the addition of these jurisdictions to the Protocol most major trading jurisdictions have joined the Madrid system. India is in process of making amendments to its tradelaw regime to streamline its trademark law and to make it consistent with evolving international trademark law regime and is also contemplating accession to the Madrid System.

#### Indian Perspective on accession to Madrid System

India is also considering and is infact inclined towards granting accession to the Madrid system. India is beginning to realize the various advantages of acceding to the Madrid System, in particular that, the applicant for an International registration is required to file only one application, pay one fee in local currency, and is not required at least initially, to submit foreign powers of attorney. Renewals, assignment recordals, changes of name and/or address of an International registration may be effected by filing one document with the International Bureau. Moreover, The payment of a single filing fee and preparation of a single application should result in savings in legal service fees. India's accession to the treaty will substantially reduce the cost, effort and time in getting protection for brand names as well in modifying or renewing them by a single application in all Madrid union countries. However, keeping in mind the Indian scenario, there are few major concerns and apprehensions that emerge and need to addressed and taken care of before India accedes to the Madrid System.

Few of the major concerns that arise in this respect are summarized as follows:

" It is apprehended that the Protocol applications would produce additional backlog at many already overburdened Trademark Offices where it currently takes over one to two years to examine and process applications.

" The Trademark Offices in India may also require additional staffing, and IT infrastructure and IT trained personnel which will increase the costs of filing domestic applications .

" While corporates will benefit from the deal, the government and local trademark attorneys may lose out as it would reduce local filings considerably.

" The trademark law and practice in jurisdictions like India ,Brazil, Canada, Japan and Hong Kong may disadvantage those basing their International registration on a home or basic application particularly as these jurisdictions have lengthy opposition procedures

and a successful opposition to the home or basic application would then necessitate the filing of national applications resulting in additional costs.

" The increased numbers of initial applications may prompt the designated country trademark examiners to issue a provisional refusal for every reason available, if only to avoid automatic registration

" Trademark Offices will need to develop a system for distinguishing International registrations from national registrations. This will result in added record keeping, requiring more personnel and work hours and computerized data bases which do not yet exist in India, Pakistan, Sri Lanka and several other jurisdictions.

" With more marks registered, there could be a decreasing availability of marks for small entities solely for domestic use.

" An International application and any future communication pertaining thereto may be in English or in French. The result of the bi-lingual system necessitates the employment of additional multi-lingual staff at the national trademark offices.

India inclined to accede to Madrid Protocol.

At this point it is pertinent to point out that since the Madrid system offers scope for putting in an application for international registration in the trade mark office of any country where the applicant has a substantial commercial interest or is domiciled, and not necessarily in the trade mark office of his own country, failure to join the system is in fact encouraging Indian businesses to use the trade mark offices of other countries that are members of the system. To counter this trend, India is seriously considering its accession to the Madrid Union and strengthen its own trade mark registry and professional skills before such accession. The recent accession of the United States and China has also added a new dimension to the Madrid System.

India realizes the multifarious advantages the Madrid System offers and is at present contemplating accession to the Madrid System .India is planning workable strategies to find solutions to tackle all apprehensions it speculates in this regard! It is already in the process of updating its official website and making possible the trademark search to be conducted online. Further, it is making efforts to make available online trademark journals and the records of the already Registered trademarks and the facility of checking online the status of pending applications .Moreover, the Indian Trademark Registry offices are in the process of inducting more IT trained personnel and having complete computerization of records besides making substantial additions to their main infrastructural facilities.

#### Conclusion

The Indian View point vis avis Accession to Madrid System may be thus summarized in few words as follows:

Although the Madrid Protocol is not the utopian solution ,it definitely is the best system presently available to procure international registration of trademarks as it, to a certain extent, simplifies trademark filings, and connected procedural formalities and may reduce

costs. The Protocol, therefore, appears to be worth acceding to! However, before India decides to do so, certain major changes in the prevailing Indian Trademark Registration Regime are warranted, which India is already in the process of adopting. Thus, there exists a strong likelihood that India will soon accede to the Madrid System of International Registration of Trademarks!

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