Practitioner's perspective

Going the Madrid way

Ashwin Julka and Bisman Kaur at Remfry & Sagar examine the procedural intricacies of the Madrid Protocol and what it means for India

On 8 April India acceded to the Madrid Protocol, introducing a procedure to register trademarks involving one office, one application and one currency with potential coverage across 90 territories.

Deconstructing the protocol

To start things off, Indian applicants (individuals or businesses that are nationals of, domiciled in, or have a commercial establishment in the country) must have a home trademark application or registration – the basic application/registration. Thereafter, an international application designating countries of interest may be filed at the Indian Trademark Office. This will be sent to the World Intellectual Property Organization (WIPO) after ensuring there are no discrepancies with the basic application.

Once WIPO is satisfied that Madrid filing requirements are met – it usually checks for classification of goods and services, requisite fee, etc., – it will register and publish the trademark in the WIPO Gazette of International Marks. Intimation of the Madrid registration will then be sent to the national offices of the designated countries.

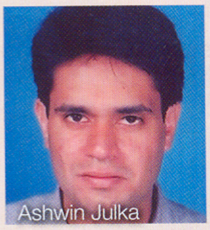
National offices treat requests for extension of the international registration (IR) to their territory as applications filed under domestic law. At this stage, applicants may have to submit additional information, likely with the help of a local attorney. If a national office refuses extension, it must convey this to WIPO within strict timelines (either 12 or 18 months and subject to certain conditions, longer where refusal may result from an opposition), failing which the IR holder is automatically granted protection for its mark in that country. Refusal in one territory has no bearing on applications in others. If the IR is mired in time consuming objections in one country, that jurisdiction can be hived off.

The protocol allows priority claims and such a claim may even be based on an Indian application filed prior to the implementation date of the protocol in India. Further, an IR is due for renewal every 10 years on the anniversary of the application date. Renewal can be done through a single filing with WIPO with the option of dropping designations.

For those who already hold an IR, the protocol allows additional jurisdictions to be designated at any time and owners may choose to extend their IR to India starting 8 July (when the protocol takes effect in India).

Points of vulnerability

Of prime concern is "central attack". If during the first five years of filing the IR the basic registration is refused, withdrawn, cancelled or restricted, the IR is similarly limited or cancelled across all designated jurisdictions. Even if a cancellation initiated within the first five years bears fruition later, the IR is still liable to cancellation. This concept may seem especially disadvantageous when a basic registration is cancelled due to stringent local laws such as non-use requirements, which are more relaxed in other jurisdictions. Damage caused by a successful central attack may be somewhat mitigated by filing national applications in the designated countries – if done within three months of the IR cancellation, the new applications receive the same filing date as the failed IR.



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Owners must also tread cautiously when amending marks. Indian law permits minor changes to a mark as long as its identity is not affected substantially. The lack of a corresponding provision under the protocol means that altering the form of a mark in a basic registration in the first five years may lead to a loss of rights. Also disallowed are amendments during prosecution of national extensions.

Moreover, though an IR is easily assigned through a single application and fee, it may be assigned only to a party that itself is qualified to file a Madrid application.

In terms of implementation, readiness of the Indian trademark office has been in some doubt. Several efforts have been made to improve functioning from digitization of paper records and e-filing to regular training of registry officials and special drives to dispose of pending files. Yet trained staff is short and backlogs remain. The three-month window between accession and implementation seems insufficient to ensure 100% efficiency. However, implementing the protocol despite some challenges may be the best way to iron out problems completely.

What the future holds

Is a large spike in Madrid applications expected? Applicants in India may take time to get to grips with a new system. Foreign parties for whom India is a market may already have filed applications directly. However, the protocol offers cost benefits as agents are not always required at the stage of filing, renewal, etc. Thus, trademark owners will increasingly look to the protocol for protection.

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