

LAW GRAFFITI

इ श्वर कंसलटन्ट्स

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Chennai ♦ Shanghai



NEWSLETTER ON INTERNATIONAL REGISTRATION OF TRADEMARKS UNDER THE MADRID SYSTEM

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INTRODUCTION

You would have by now heard that India has acceded to the Madrid Protocol for the International Registration of Trademarks, and that the same is coming into force on the July 8, 2013.



In this edition of La[W] Graffiti, we have captured the procedure to register your Trademarks under the Madrid System in a nutshell.

SINGLE APPLICATION FOR REGISTRATION OF YOUR TRADEMARKS IN OVER 90 COUNTRIES

Indian Trademark and Brand owners can from the July 8, 2013 start filing one single trademark application in one language and by paying one single set of fees in one currency, instead of filing separate applications in the different Intellectual Property Offices of the various countries.

The “**Madrid System**” is governed by two international treaties:

- Madrid Agreement and
- Madrid Protocol.

These treaties are administered by The International Bureau (“**IB**”) of the World Intellectual Property Organisation (WIPO) in Geneva, Switzerland.

What is an “Office of origin”?

The Office of Origin is the trademark office of the country, which is a party to the Madrid System and in which the applicant for international registration has the necessary connection (through

establishment, domicile or nationality) that entitles the applicant to file an international application under the Madrid System.

E.g:- If you have an establishment or domicile or nationality in India and if you have applied for or already have a registered trademark in India, then the Indian Trademark Office shall be the **Office of Origin**.

In the words of the Commerce Minister of India Mr. Anand Sharma: *“The Madrid System will provide an opportunity for Indian companies, which are increasing their global footprint, to register trademarks in member countries of the Protocol through a single application, while also allowing foreign companies a similar dispensation”*.

What are the benefits of the Madrid System?

You can enjoy the following benefits if you file your Trademark Application through the Madrid System:

- Filing of single Application in one language together with a single set of fees to protect your trademarks in over 90 countries. Negates the need for filing application in multiple countries.
- You can choose the Countries where your Trade Mark is required to be registered.
- After the trademark has been registered through the Madrid system in certain select countries, you can also further extend the geographical scope to additional Countries (which are also party to the Madrid System) in a quick, simple and cost-effective manner.
- Date of expiry is common for all the territories and renewal of trademark becomes trouble-free as you would be filing only one Application for renewing the marks in various territories.
- Cost-Effective when it comes to renewals, assignments and making changes in contact information.
- Time saving, as there would be less delay encountered, due to the use of a single administration.

What are the pre-requisites for filing International Application under the Madrid System?

Following are the pre-requisites for filing International Application through Madrid System:

- You are an individual based in India, or a business entity registered in India, or where you have an entity outside India which holds all your Trademarks – then such entity is in one of the Countries that is a signatory to the Madrid System (**Refer Annexure A**).
- If you have applied for, or registered, a trademark (Basic Mark) in India.
- The Class and description of goods and Services of the International Application should be similar to that of the Class and description of goods and services given in the Basic Mark filed in India.

Is the procedure for registering through the Madrid System fraught with complexities?

The procedure under the Madrid System is uncomplicated and very simple.

Procedure in a Nutshell-

Once an application is filed with the Office of Origin under the Madrid System, the Office of Origin forwards the application to the International Bureau and the International Bureau checks if the international application complies with formal requirements. If it does, the International Bureau records the mark in the International Register. It informs the Office of Origin and also sends a certificate of the international registration to the holder of the mark or to his recorded representative. It also notifies the Trademark office in the designated Countries where you want your mark to be registered. The trademark offices in that Country would then examine the mark under its relevant trademark law and decide on the application.

The status of your international application can also be checked by using the WIPO database. This database is updated daily and is available free-of-charge.

Date of Expiry is common for all the Trademark registered in all the Territories:-

There is a common date of expiry for the Trademarks registered in various territories irrespective of the dates on which the mark has been accepted by each Country where you require your mark to be registered. Six months before the expiry date, the International Bureau sends an unofficial notice to remind the holder and his representative, if any, of the exact date of expiry.

Hence, the renewal of Trademark can also be made by filing single renewal Application and by paying a single set of fees.

Independence of Basic Mark after 5 years:-

An international registration is initially dependent on the Basic Mark for a period of five years following the recordal date of the international registration. After this five-year period, the international registration becomes independent of the Basic Mark (registered in Office of Origin). It is therefore not necessary, after this five-year period, to renew the Basic Mark in order to continue validity of the international registration.

ANNEXURE A**MEMBERS OF MADRID UNION:-**

Following are the list of member states/ countries of Madrid Union. As the treaty will enter into force with respect to India on July 8, 2013, India will become a member of Madrid Union only since July 8, 2013.

Albania	European Union
Algeria	Finland
Antigua and Barbuda	France
Armenia	Georgia
Australia	Germany
Austria	Ghana
Azerbaijan	Greece
Bahrain	Hungary
Belarus	Iceland
Belgium	Iran (Islamic Republic of)
Bhutan	Ireland
Bosnia and Herzegovina	Israel
Botswana	Italy
Bulgaria	Japan
China	Kazakhstan
Colombia	Kenya
Croatia	Kyrgyzstan
Cuba	Latvia
Cyprus	Lesotho
Czech Republic	Liberia
Democratic People's Republic of Korea	Liechtenstein
Denmark	Lithuania

Egypt	Luxembourg
Estonia	Madagascar
Mexico	Monaco
Mongolia	Singapore
Montenegro	Slovakia
Morocco	Slovenia
Mozambique	Spain
Namibia	Sudan
Netherlands	Swaziland
New Zealand	Sweden
Norway	Switzerland
Oman	Syrian Arab Republic
Philippines	Tajikistan
Poland	The former Yugoslav
Portugal	Republic of Macedonia
Republic of Korea	Turkey
Republic of Moldova	Turkmenistan
Romania	Ukraine
Russian Federation	United Kingdom
San Marino	United States of America
Sao Tome and Principe	Uzbekistan
Serbia	Vietnam
Sierra Leone	Zambia

Note: The European Union is a party to the Madrid System.