



Cover Page



SINGLE WINDOW FOR THE PROTECTION OF INTERNATIONAL TRADEMARK REGISTRATION

Hemant Khosla

Research Scholar, Department of Legal Studies
Ch. Charan Singh University
Meerut, Uttar Pradesh, India

ABSTRACT

Effective April 8, 2013, Indian business has a streamlined and potentially less expensive means at their disposal to protect trademarks in overseas market. Through India adherence to the international treaty known as the “Madrid Protocol. International Trademarks is a remarkable step which is welcomed by India with open headedly because it has a valuable mechanism allowing all the trademark holders to benefit from acquiring the monopolistic rights in the form of Trademarks registration with the minimum cost friction, one language (English, French or Spanish), one set of fees in one currency, one registration number and moreover the registration can be further extended to all the member countries. Madrid Protocol widened the sphere for the trademark holders while providing a valuable opportunity for those who otherwise might not choose to file international trademarks application for registration. Now with the help of Single Window for International application based on a basic application/registration holder of trademark can spread their wings and compete globally while enjoying their monopolistic rights worldwide with the ease.

Keywords: Streamline, Adherence, Monopolistic.

INTRODUCTION

On April 8th of 2013, the Government of India, deposited the instrument of accession to the Madrid Protocol¹, with the Director General of the WIPO and accordingly, the long awaited and much-heralded the provisions of international registration under the Madrid Protocol² came into effect since July 8th of 2013 because of this an Individual/Body corporate/any legal entity may obtain international trademarks registration in any of the member countries through single trademark applications in one language (i.e., English, French or Spanish) and in one set of fees in one currency. Madrid Protocol provides most effective way to get international trademarks protection with minimum cost imparted.

The Indian Government amended her Trademarks Act³ for strictly adherence the guidelines provided by Madrid Protocol which provides inherent cost-efficiency and a valuable opportunity to the trademark owners who otherwise might not choose to file international trademark applications because of this the scope of trademarks registration is broader and chances to get international trademark registrations is almost very certain with minimum cost in minimum fix period of time. For India, it becomes the milestone to get protection worldwide through single window clearance with the single step of filing.

Registration Process: National V/s Madrid Protocol

In India, there are two mode of filing Trademark Applications offline and online through digitally but if the trademark owners want to file international applications than they have to file different trademark applications in each of the countries and have to engage an advocate/agent for that country too and even different fees have to be paid in different currency according to the country in which they have planned to get trademark registration⁴. All trademark registration, renewal and any changes to that registration had to be filed separately on a country-by-country basis. The process is very lengthy, time consuming and involved a lot of proper work and recordkeeping. It also incurred heavy burden on the trademark owners because the agents/advocates charges heavy professional fees to deal with.

But because of Madrid Protocol Indian trademark owners are now permitted to file their trademark applications in different member countries of the Madrid Protocol on a single home country application or home country registration⁵. Through single window,

¹ www.ipindia.nic.in

² Protocol Relating to Madrid Agreement Concerning International Registration of Marks, June27, 1989, S.Treaty Doc.No. 106-41, Hein’s No. KAV 6242 (hereinafter Madrid Protocol).

³ The Trademarks (Amendment) Act, 2010 specially Chapter IVA (Special Provision Relating to Protection of Trademarks through International Registration under Madrid Protocol) and Section 36 amended.

⁴ International Trademark Prosecution Streamlined: The Madrid Protocol Comes into Force in the United States by Jeffrey M.Samuels and Linda B.Samuels, University of Georgia Law.

⁵ International Register: World Intellectual Property Organisation IP Services, Madrid Express Database, http://www.wipo.int/madrid/en/services/madrid_express.htm



Cover Page



if an applicant of the Indian trademark gets his registration of the marks files a request in the Indian Patent and Trademarks Office for the extensions of protection to any or all of the other protocol member countries.

With help of this, the Trademark owners can secure registrations in all of the member countries⁶. WIPO is the administrator of the Intellectual Property Rights worldwide and also the Madrid Protocol which is now extended into the India and all international applications and registrations with WIPO can also be excess directly through India.

If the Trademark owners wants to file international trademark applications under the Madrid Protocol than has to follow the following guidelines provided by the Protocol⁷ i.e.

- 1) Trademark owners must be the citizen of the member country;
- 2) Trademark owners must have real and effective business or industrial establishment in the member country.
- 3) If a trademark owner who is not the national/citizen of the member country but he/she has a business/industry in the member country of the Protocol will not be permitted to participate in the Madrid System.

After an International trademarks application is filed through single window for the protection of International trademarks registration under the Madrid Protocol, the Indian Patent and Trademarks Office will examine the application from Mumbai Head Office because Examination of Trademark applications is centralized and it is done by the trained trademarks examiner from the data maintained by the Indian Patent and Trademarks office thoroughly and then it goes to the controlling officer who review the application again and to ensure the information matches the home country registration or application, certifies it , and electronically forwarded it to World Intellectual Property Organisation (WIPO), who administers the Madrid system which conducts its own examination and if there are any deficiencies in the application, the applicant will be notified of these and given an opportunity to correct them. If the Application complies with WIPO’s requirements, details of the mark are recorded on the International Register.

WIPO then transmit details of the International Application to the national Trade Mark Office of each designated country. At that point, each office will examine the application according to its national trade mark law. This is known as “National Examination”⁸. If no objection is raised, each office will issue a statement of grant of protection in the country concerned.

If any objection is raised in respect of a particular country, these will be communicated to the applicant through Indian Patent & Trademarks Office. The objections will need to be overcome before protection for the mark will be granted in that country. In this way we can say that the Madrid Protocol provides Indian trademark owners a simplified and streamlined procedure for obtaining protection and get registration in other countries through single window unlike have to face many decades’ pendency to get registration in home country like India. Those who utilize this single window for the protection of their mark will no longer have to file separate application in each country where protection is needed, even the trademark owner should be able to avoid the costs associated with retaining trademark counsel in that country. The Madrid Protocol provides a mean for assignment⁹ and renewal¹⁰ of an international registration, which has a term of 10 years through the filing of a single document and the payment of a single fee to WIPO.

CONCLUSION

The Madrid Protocol offers Indian trademark owner an additional mechanism for obtaining protection worldwide and even a small trader can open their wings across the globe. The effect of the India joining the Madrid Protocol is most significant in cost savings and with the accession of the India to the Madrid Protocol in 2013 the reality of an international system of trademarks registration came one step closer to fruition. This system is simple, affordable and efficient way of obtaining and maintaining trademarks. This article was intended to provide knowledge on the Madrid System of International Trademarks registration.

⁶ www.wipo.int/Madrid/en/members/ (last visited May 5,2017) (at present 98 Contracting Parties)

⁷ Guide to the International Registration of Marks under Madrid Protocol (www.wipo.int/madrid/en/guide/and Guideline for functioning under the Madrid Protocol (www.ipinida).

⁸ The Madrid Protocol: IMPACT OF U.S. Adherence on Trademark Law and Practice, Issue Brief of INTA (International Trademark Association, New York.

⁹ Article 4bis: Substitution of International Registration for Earlier National Registration (Guide on Madrid Agreement Concerning the International Registration of Marks.

¹⁰ Article 7: Renewal of International Registration.