सत्यमेव जयते

Department of Industrial Policy and Promotion
Ministry of Commerce & Industry
Government of India

EUROPEAN UNION

THE MADRID PROTOCOL:
A ROUTE TO GLOBAL BRANDING

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INTELLECTUAL PROPERTY INDIA
PATENTS | DESIGNS | TRADE MARKS
GEOGRAPHICAL INDICATIONS

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FOREWORD BY THE MINISTER

India has always been conscious of its obligations in the international arena, and has acceded to a number of international conventions to further the cause of IPRs globally. The accession to the Madrid Protocol for international registration of marks in 2013 has been a significant step by India towards global protection of marks.

Recognising the importance of the Madrid System in today's international IP Regime, EUIPO and the office of CGPDTM have prepared this informative booklet on Madrid Protocol, which will serve as a comprehensive reference guide for the Small and Medium Enterprises (SMEs) and other stakeholders on global branding and international trademark protection under the Madrid System. The Department of Industrial Policy and Promotion (DIPP), Ministry of Commerce and Industry, has also worked relentlessly in creating awareness amongst various stakeholders, including the Micro, Small & Medium Enterprises (MSMEs) Sector, on the importance of Intellectual Property Rights (IPR) and integrating it in business to make them globally competitive. This is in line with the objectives of the Indian National IPR Policy, 2016 to stimulate generation of IPRs and increase awareness of international mechanism and treaties, and thereby encourage creation and protection of IPRs by Indian individuals and entities in global markets.

The dedicated efforts of EUIPO and CGPDTM in formulating this detailed booklet will foster sustained growth of IPRs amongst enterprises, especially SMEs, on the global stage. I take this opportunity to commend all concerned with this effort, and reiterate the government of India's commitment to a balanced and robust IP regime.

Suresh Prabhu
Minister of Commerce and Industry, Government of India

FOREWORD BY THE AMBASSADOR

Intellectual Property Rights (IPR) are gaining greater attention and recognition worldwide as many countries attempt to transition into knowledge-driven economies. Europe is known as a key leader in this field contributing to a fair and balanced IPR ecosystem that promotes innovation and creativity and creates more and better jobs in the medium-/long-term.

The EU-India Intellectual Property Cooperation makes use of the best available European expertise. It aims to enhance the capacity of the Indian productive sector to create, protect and manage its own brands by using IPR as a tool for development. India has been taking giant strides in the path of economic prosperity and sustainable development through a number of initiatives such as "Make in India". It is my belief that such initiatives will provide many opportunities to Indian and global business enterprises to collaborate and innovate thus furthering the cause of economic and social development. Indian businesses should therefore continue to expand in the global markets.

The Madrid system of International Registration for Marks provides a convenient and one-stop solution to enterprises for registering their trade-marks and protecting their brands in multiple countries.

It is my pleasure to share this booklet on "The Madrid Protocol: A route to Global Branding" funded by the EU. This enriching resource material has been developed by the European Union Intellectual Property Office (EUIPO) and the Department of Industrial Policy and Promotion (DIPP) within a close cooperation between the EU and the Government of India – Ministry of Commerce. I believe this document will serve as a user-friendly practical guide and prove to be extremely beneficial for Indian businesses. In particular, I hope it will help small and medium-sized enterprises expand their global footprint. Eventually, it will contribute to India's further integration into the global trading system, creating new job opportunities, and increasing economic prosperity and advancing on sustainable development.

Tomasz Kozlowski
Ambassador of the European Union to India

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1. YOUR BRAND: YOUR STRONGEST ASSET

Your brand is the image that differentiates you from your competitors. It identifies your product, your service, your company. It may be represented by a sign, a symbol, a design, a word, a colour, or a combination thereof. It conveys a sense of quality, credibility, customer satisfaction. It plays a crucial role in your marketing strategy and is at the core of your business competitiveness. It generates customer loyalty and has a value. It may become your strongest asset.

1.1. BRANDING STRATEGIES AND BUSINESS SUCCESS

Branding aims at building a distinctive and attractive presence in the market that helps gain and retain loyal customers. Effective branding involves creating an image in the consumers' minds about the quality of a product or a service, mainly through advertising campaigns centred on the brand. It also requires ensuring the legal protection of the brand against competitors in the relevant markets. Branding strategies are at the core of sustained market competitiveness and business success.

1.2. BRAND CREATION, MANAGEMENT AND COMMERCIALIZATION

Creating a brand implies choosing the signs that will distinguish your products or services from those of your competitors and getting them legally protected. The legal expression of your brand is a trade mark. A trade mark confers on you the exclusive right to prevent third parties from using the signs that distinguish your brand in the course of trade for identical or similar goods or services. You can register your trademark in India by filing an application at the Trade Marks Registry (TMR) within the Office of the Controller General for Patents, Designs and Trademarks (CGPDTM). The registration of your trade mark in India will have a duration of 10 years and is renewable indefinitely for similar periods. Managing your brand implies regularly renewing your trademarks and enforcing your rights against infringers and counterfeiters. The assignment and licensing of trade mark rights may play a significant role in brand commercialization through partnership, merger and franchising initiatives.

1.3. PROTECTING YOUR BRAND IN EXPORT MARKETS

Protecting your brand outside India implies acquiring trade mark rights in each of the export markets where you wish to commercialize your products or services. Trade mark rights are territorial in nature and are only valid within the territory of a country (national trade mark) or a group of countries having established a regional trade mark system (e.g., the European Union). In principle, to acquire trade mark rights abroad you need to file separate trade mark applications at the trade mark offices of the countries where you wish to have your brand protected. Once you get your rights in those countries you will need to follow separate procedures at those same offices to manage your rights (renew, licence, or assign them). However, being a national of India or a person domiciled in India you may take advantage of an alternative, more attractive, cost-effective and user-friendly route to acquire and manage your trade mark rights abroad by making use of the Madrid Protocol, an international treaty that India joined in 2013.

2.2.2. Centralized Management of your Trade Marks

Once your international registration has been obtained and your mark is protected in the designated members of the Madrid Union, you will be able to manage your rights very easily by following online procedures at a single point (WIPO) to renew your trade mark rights every ten years, extend protection to new markets at any time, and request the central recording of various types of modifications to your registration (assignment of rights, change of name or address, limitations, renunciations).

2.3. ADVANTAGES: REDUCED COSTS, EFFECTIVE BRAND MANAGEMENT AND COMMERCIALIZATION

Centralized filing of your trade mark under the Madrid Protocol offers many advantages: you do not need to file separate applications in many countries, drafted in different languages, pay fees in different currencies, hire the services of local representatives and follow different procedures in each of those countries. Instead, you can file a single international application online on the IP India website, in a single language (English), you pay fees in a single currency (Swiss francs), and your application has effects in all the Madrid Union members of your interest. The procedure is very simple, user-friendly, expeditious and cost effective. Moreover, you make savings in translation costs and various types of fees (local representatives, currency exchanges). The strict time limits imposed on Madrid Union members to decide on the recognition of local rights based on your international registration, contribute to speed up protection procedures considerably.

The benefits of central management are even more important than those of central filing: once your international registration has been obtained, you will take care of only one renewal date and procedure, all in one place (WIPO), instead of many different dates and procedures at separate TM offices; you will always be able to extend protection of your mark to new markets very easily (through subsequent designations); and you will be able to have modifications to your trade mark registration (such as assignment of rights, change of name or address of holder or representative, limitations, renunciations) recorded in one single place (the International Register maintained by WIPO) at a very low cost.

Cost savings that result from using the Madrid system are particularly significant for small and medium-sized companies (SMEs). 80% of users of the Madrid system have been categorized as SMEs, having a small portfolio of only one or two international registrations.

But the advantages of the Madrid Protocol not only consist of reduced costs and speedier procedures resulting from central filing and central management of international registrations. The Protocol also offers you early brand presence abroad, as it is a means to acquire rapid international reputation and generate goodwill for your trademarks.

Moreover, from a strategic development viewpoint, the Madrid Protocol offers additional economic benefits to companies that use the system. A recent report by the Indian Institute of Management

Bangalore (IIMB)[1] highlights the fact that the Madrid system is not only relevant for companies planning to export their products or services. More generally, the early brand presence abroad gained by companies using the Madrid system generates increased franchising opportunities, opens possibilities of partnering with international entrepreneurs for optimizing life-cycle development, and facilitates integration to global supply chains.

3. CHOOSING YOUR TRADE MARK – BEST PRACTICES

Creating a brand implies choosing the sign (trade mark) that will distinguish your products or services form those of your competitors.

In principle, any sign capable of distinguishing your goods or services from those of other undertakings in the market can constitute a trade mark. Thus, your trade mark may be constituted by a sign, a symbol, a design, a word, a colour, or a combination thereof. However, when choosing your trade mark, there are certain requirements or limitations that you need to consider:

- Your mark must be distinctive, meaning that it should consist of a sign that serves to identify your products or services and distinguish them from those of other undertakings.

- Your mark should not be descriptive of the specific goods or services that you wish to commercialize. Generic terms used to identify those goods or services, or terms that describe their characteristics, would not be accepted.

- Your mark should be capable of being represented. Most trade mark offices require graphical representation, even though some also accept other means of representation for special types of marks (e.g., MP3 audio recordings for sound marks). The Madrid system requires that your mark be graphically represented.

- Your mark should not be functional, which means that the sign that constitutes your trade mark should not consist exclusively of a characteristic that results from the nature of the goods themselves or that is necessary to obtain a technical result. This is especially relevant in the case of three-dimensional marks.

- Your mark should not be deceptive. A sign conveying a false origin or false characteristics of a product would be refused for protection on grounds of being deceptive.

1 - *Madrid System Market Research in India – Marketing Campaign in India for International Registration of Trade Marks*, Damodaran A. & Sundaram M., Indian Institute of Management (IIM), Bangalore, 31st Mar. 2016, Available at: http://www.ipindia.nic.in/writereaddata/Portal/Images/pdf/madrid_protocol_report.pdf.

- Most countries would refuse protection as a trade mark for signs that are contrary to public order or morality.

- State flags, State emblems and names and emblems of intergovernmental organizations are excluded from protection as trade marks in most countries around the world.

Finally, most importantly, you must make sure that the sign you wish to use as your trade mark is still available in the market and is not the same as or similar to a well-known mark or a trade mark already registered by someone else for the same goods or services. Therefore, it is very important that you make an exhaustive search for the availability of your trade mark in those markets where you would like to get it protected.

3.1. SEARCHING FOR A TRADE MARK IN INDIA

Before filing a trade mark application in India, you should make sure that the sign that you are planning to use as a trade mark is not excluded from protection by the Indian trade mark law (http://www.ipindia.gov.in/acts-rules-tm.htm). In addition, you should consult certain online sections of the IP India web site that will help you check that your trade mark is not excluded from protection because of being a well-known mark already protected in India by someone else (https://ipindiaonline.gov.in/tmrpublicsearch/wellknownmarks.aspx), or consisting of the international non-proprietary name for a pharmaceutical substance (http://www.ipindia.gov.in/international-non-proprietary-names-inn.htm); or another term prohibited for protection (https://ipindiaonline.gov.in/tmrpublicsearch/prohibitedmarks.aspx).

You should also check whether the sign that you are planning to use as a trade mark in India has not been already applied for or registered as a trade mark for the same goods or services by someone else. You can do so by consulting the IP India Public Search for Trade Marks interface at https://ipindiaonline.gov.in/tmrpublicsearch/frmmain.aspx#. This interface allows you to make three types of searches: wordmark searches (by word, class and good/service description), design mark searches (by Vienna code and class), and phonetic searches (by wordmark and class, producing as a result wordmarks sounding similar). For more details on the use of this Trademark Public Search Application you may consult the guidelines available at: https://ipindiaonline.gov.in/tmrpublicsearch/Guidelines_to_use_Trade_Mark_Public_Search.pdf

3.2. SEARCHING FOR A TRADE MARK ABROAD: ONLINE DATABASES (TMVIEW, GLOBAL BRAND DATABASE)

Before filing an international application to protect your mark abroad, you should check whether the sign that you are planning to use as your trade mark does not belong to someone else in the export markets of interest to you. This implies making a search for identical or similar trademarks already protected in those markets for the same goods or services. Several trade mark Offices

of Madrid Union members offer you the possibility to search their trade mark databases on line. However, the best way to start making your searches for similar trademarks is to consult TMview.

TMview (https://www.tmdn.org/tmview/welcome) is an online trade mark information platform, built by 51 Trade Mark Offices from around the world (including India's TM Registry), aimed at making trade mark data widely available and easily accessible to the public, free of charge. TMview offers the possibility to explore the overall trade mark landscape in many countries (including some 10 in Asia, 36 in Europe, 20 in Africa and 4 in the Americas) in a user-friendly way. TMview gives access to information on more than 40 million trade mark applications and registrations having effects in those countries, plus international registrations under the Madrid system, including data regarding trade mark name, applicant's name, trade mark type, graphic representation, legal status, list of goods and services, class codes, etc. TMview allows you to carry out trademark searches 24 hours a day, 7 days a week. The accuracy of the data shown in TMview is the sole responsibility of the participating trademark offices providing it. Since the introduction of TMview in April 2010 the tool has served more than 29 million searches from 155 different countries.

To explore the trade mark landscape abroad you can also consult the Global Brand Database (http://www.wipo.int/reference/en/branddb/), an online gateway managed by WIPO which contains more than 28 million records from 35 national and international collections, including data on trade marks, appellations of origin and armorial bearings, flags and other state emblems protected in various countries around the world, as well as the names, abbreviations and emblems of intergovernmental organizations.

4. FILING YOUR INTERNATIONAL TRADE MARK APPLICATION – BEST PRACTICES

Once you have selected your trade mark for protection abroad, you are almost ready to file your international application. But first you must make sure that you fulfil the necessary requirements. The Trade Marks Registry under the office of the Controller General of Patents designs and Trade Marks (CGPDTM) deals with international applications originating from India.

4.1. REQUIREMENTS: ENTITLEMENT, BASIC MARK IN INDIA

You may file an international trade mark application under the Madrid system if: (i) you are a national of India, or you are a natural person or legal entity domiciled in India, or you have a real and effective industrial or commercial establishment in India, and (ii) you have a "basic mark" in India, which means that your mark has already been registered or applied for protection in India at the India Trade Marks Registry.

4.2. ONLINE E-FILING AT THE IP INDIA WEBSITE (OFFICE OF THE CGPDTM)

If you wish to file an international application under the Madrid Protocol, you have to do it electronically at the IP India website by filling in a special form[MM2(E)] available at IAOI (International application originating from India link at comprehensive e-filing services gateway made available at the following address: https://ipindiaonline.gov.in/trademarkefiling/user/frmLoginNew.aspx

If you are not yet registered with IP India for electronic filing, you need first to register by taking the following steps: (i) procure a class III/II digital signature from any of the Indian Certifying Authorities and install the same on your computer; (ii) download and install the Signing Component as per the instructions given in the CGPDTM Digital Signature Manual. If you need assistance, you can write to the TM Registry helpdesk at: tmr-helpdesk@nic.in. You also need to make online payment of Rs 5000/ for each international application (MM2).

4.3. CONTENT OF YOUR INTERNATIONAL APPLICATION: MANDATORY, OPTIONAL

The international application form (MM2) must contain:

(i) your name and address;
(ii) the reproduction of your mark, which must be identical to your basic mark in India;
(iii) a list of the goods and services for which protection is sought, which must be fully covered by those indicated in your basic mark; and
(iv) a list of members of the Madrid Union in which protection for the mark is sought (designated Contracting Parties).

These requirements are mandatory and have an impact on the date of the international application. The international application must also contain:

(i) an indication of your entitlement to file (establishment or domicile in India or Indian nationality);
(ii) trade mark priority claim, if applicable;
(iii) name and address of representative, if appointed;
(iv) number and date of your basic mark at the India Trade Marks Registry;
(v) indications of the mark (kind of mark, colour claim if applicable);
(vi) description of the mark, if required;
(vii) transliteration of the mark, if applicable;
(viii) amount of the fees being paid and method of payment.

Some additional content may be required with respect to certain members of the Madrid Union (e.g., a declaration of the intention to use the mark) if they are designated in the application (see below).

4.5. DESIGNATING THE TERRITORIES WHERE TO GET PROTECTION

In your international application, you must designate all the Madrid Union members (Madrid Protocol Contracting Parties) where you wish your trade mark to be protected. By simply checking the box next to each member's name in the application form (MM2) you can designate any Madrid Union member except India. Your trade mark in India (basic mark) will continue to be protected under the Indian law as registered by the India Trade Marks Registry.

At present, you can designate up to 100 Contracting Parties to the Madrid Protocol, including 116 States and two intergovernmental organizations, namely the European Union and the African Intellectual Property Organization (OAPI). By designating the European Union, you may get protection for your trade mark in its 28 Member States. By designating OAPI, you may get protection for your trade mark in its 17 Member States.

Certain Contracting Parties have special requirements that you need to consider when designating them in your international application. If you designate the European Union, you must indicate in the application form (MM2) a second working language for procedures before EUIPO, and you must attach an additional form (MM17) if you further wish to claim European Union seniority (for more details, please see the section on getting protection in the European Union, below).

If you designate the United States of America (US), you need to attach to your international application form (MM2) an additional form (MM18) containing a declaration of your intention to use the mark in the US. Moreover, if you are a natural person you should indicate your nationality in the international application form (MM2), and if you are a legal entity you should indicate your legal nature and the law under which you have been established as a legal entity.
Finally, if you designate Brunei Darussalam, Ireland, Lesotho, Mozambique, New Zealand, Singapore or the United Kingdom, you need to attach a declaration of your intention to use the mark in those countries.

4.6. ESTIMATING COSTS AND PAYING FEES: MADRID FEE CALCULATOR, PAYMENT METHODS

Your international application must be accompanied by the payment to WIPO of a set of fees (in Swiss francs) which include:

(i) a basic fee of 653 Swiss francs, if no reproduction of your mark is in colour, or 903 Swiss francs, if any reproduction of your mark is in colour;
(ii) an individual fee for each designated Contracting Party having fixed individual fees (see below);
(iii) a complementary fee of 100 Swiss francs for each designated Contracting Party not having fixed individual fees; and,
(iv) a supplementary fee of 100 Swiss francs for each class of goods and services beyond three classes, except if you only designate Contracting Parties having fixed individual fees.

So far, more than 50 Contracting Parties to the Madrid Protocol have fixed individual fees. You can check the list of those Contracting Parties and the amounts to be paid for each of them at the following address: http://www.wipo.int/madrid/en/fees/ind_taxes.html

To facilitate your calculation of the fees to be paid for your international application, WIPO offers a very practical online tool known as Fee Calculator, that you can access at the following address: http://www.wipo.int/madrid/en/fees/calculator.jsp

Regarding payment methods, you may pay your fees to WIPO either by: (i) credit card; (ii) WIPO

If there are other irregularities (e.g., your address is incomplete, the reproduction of the mark is not sufficiently clear, no fees have been paid or their amount is insufficient), these will be notified directly to be the applicant and should be remedied by the applicant within three months failing which the application may be considered abandoned.

Finally, if you have designated the US and you have failed to attach the MM18 form containing a declaration of your intention to use the mark in the US, WIPO will invite you, through the India TM Registry, to attach that form within a two-month period from the date of receipt of the international application by the India TM Registry. If this is not done within that period, your designation of the US will be considered as withdrawn

5. THE INTERNATIONAL TRADE MARK REGISTRATION

If your international application conforms to the applicable requirements, WIPO will register your mark in the International Register, will publish the international registration in the WIPO Gazette of International Marks, and will notify it to the Offices of the designated Contracting Parties (DCPs). It will also inform the India TM Registry and send you an international registration certificate.

5.1. DATE AND EFFECTS

5.1.1. Date of the international registration

As a rule, your international registration will bear the date on which your international application was received by the India TM Registry, unless your application has reached WIPO more than two months after that date (in which case your international registration will bear the date in which it was actually received by WIPO).

The date of your international registration may be affected if any of the following elements is missing: your name and address, the designation of the Contracting Parties where protection is sought, a reproduction of the mark, the indication of the goods or services for which protection of the mark is sought. The India TM Registry will be notified of such irregularity which should be remedied within a maximum period of three months. The date of your international registration will depend on the date on which the last missing element has been received by WIPO.

5.1.2. Effects of the international registration

From the date of your international registration, your mark will enjoy the same protection in each of the designated Contracting Parties (DCPs) as if your mark had been filed or applied for directly in that DCP.

A designated Contracting Party (DCP) may refuse protection for your mark on grounds that would apply under national law to marks filed directly with the Office of that DCP (e.g., because the mark

already belongs to another person in that DCP). Such a refusal will be subject to review or appeal depending upon the laws and practice of the DCP concerned.

Where a DCP does not refuse protection for your mark within a prescribed time limit (12 months, or 18 months, or longer than 18 months in case of opposition, depending on the choice made by each DCP), or if such a refusal has been subsequently withdrawn, the protection of your mark in that DCP will be the same as if your mark had been registered by the Office of that DCP as from the date of your international registration.

In all the DCPs not having refused protection your mark will be valid for a period of 10 years as from the date of its international registration, with the possibility of indefinite renewal for further periods of 10 years.

5.2. MANAGING YOUR REGISTRATION – BEST PRACTICES

While the Madrid system offers you many advantages to get your trade mark protected in various markets, the system offers you even more valuable advantages regarding the management of your mark after registration. Extending protection of your mark to new territories, renewing the protection of your mark for additional periods of ten years, or having changes to your registration recorded in the International Register with effects extending to those Madrid Union members of interest to you, can be done through very simple, user-friendly and cost-effective procedures.

5.2.1. Extending protection to new territories (subsequent designations)

If you are the holder of an international registration that extends its effects to only some of the members of the Madrid Union (Contracting Parties), you may, at any time, seek to extend the protection of your mark to other members of the Union that were not designated in your original international application. You simply need to present a subsequent designation to WIPO.

The subsequent designation must be presented in an official form (MM4) and may be transmitted to WIPO by mail, by facsimile or by electronic means (https://www3.wipo.int/osd/)

You must indicate the number of your international registration, your name and address (as recorded in the International Register), the Contracting Party or Parties to which an extension of the protection is sought, and the goods and services for which the subsequent designation is made (which may be all or only some of those covered by the international registration). With respect to some Contracting Parties, you may need to include some additional information (e.g., a declaration of intention to use the mark if you designate the United States).

The fees payable in respect of a subsequent designation include a basic fee (300 CHF), an individual fee for each DCP having fixed individual fees, and a complementary fee (100 CHF) for each DCP not having fixed individual fees. The Fee Calculator (http://www.wipo.int/madrid/en/fees/calculator.jsp) may be used to calculate the fees payable.

The subsequent designation will bear the date in which it was received by WIPO.

If the designated Contracting Party (DCP) does not refuse protection for your mark within the prescribed time limit (12 months, or 18 months, or longer than 18 months in case of opposition, depending on the choice made by each DCP), or if such a refusal has been subsequently withdrawn, the protection of your mark in that DCP will be the same as if your mark had been registered by the Office of that DCP as from the date of its subsequent designation.

In all the DCPs not having refused protection your mark will be valid for the remaining duration of your international registration, with the possibility of indefinite renewal for further periods of 10 years.

5.2.2. Central recording of modifications to your international registration (IR)

During the life of your IR you may, at any time, request WIPO to record in the International Register a change in your name or address or in the name or address of your representative, a restriction in the protection of your IR (limitation, renunciation, cancellation), a change in ownership of your mark or a licence, having effects in all or some of the DCPs. The central recording of such modifications in the International Register relieves you from the need to request such action from the Office of each DCP thus resulting in very significant savings.

To request the recording of a change of name or address of the holder of the international registration (without change in ownership,) you can use form MM9 made available at the WIPO website The fee payable to WIPO will amount to only 150 CHF (http://www.wipo.int/madrid/en/forms/). If you, being holder of the international registration, happen to sell your mark, either in respect of all or some of the DCPs, or of all or only some of the goods and services for which it is protected, you can request the recording of such a transfer by using form MM5 and paying a fee (177 CHF). The change in ownership may be recorded only if the new owner (the transferee) is a person entitled to use the Madrid system (either through nationality, or establishment or domicile in a Contracting Party).

Your request may refer to several international registrations. If the only change to be recorded concerns your address for correspondence, email address, phone number or facsimile number, no fee is payable. A change of name or address recorded in the International Register will have immediate effects with respect to all DCPs in the IR at no additional cost.

To request the recording of a change of name or address of your representative, you can use form MM10. The recording of such a change is free of charge.

To request a limitation of the list of goods and services, which may affect some or all of the DCPs, you will use form MM6. This request is subject to the payment of a fee (177 CHF) to WIPO. No additional fee will be charged by the DCPs concerned.

If you wish to record a renunciation of the protection in respect of some of, but not all, the DCPs for all the goods and services you will use form MM7. If your request concerns the cancellation of the IR in respect of all the DCPs for some or all of the goods and services you will use form MM8. These requests (renunciation or cancellation) are free of charge.

If you licence your mark, you may request the recording of your license by indicating the name and address of the licensee, the DCPs with respect to which the license is granted, and the goods and services for which the license is granted. The request must be submitted in form MM13. The recording is subject to the payment of a fee amounting to 177 CHF.

5.2.3. Renewing your international registration (IR)

To ensure that after a period of ten years from registration your mark continues to be protected for an additional period of 10 years in those territories where you so wish, you simply need to renew your IR by paying the necessary fees to WIPO. The fees due for renewal include: a basic fee (653 CHF), an individual fee for each DCP having adopted an individual fee system (amount fixed by the DCP), a complementary fee (100 CHF) for each DCP that has not adopted an individual fee system, and a supplementary fee (100 CHF) for each class of goods and services more than three, except if you only renew protection with respect to DCPs having fixed individual fees.

A system for the electronic renewal of international registrations is available on the WIPO website and can be accessed under Forms (Form MM11 at http://www.wipo.int/madrid/en/forms/) or under Online Services (https://webaccess.wipo.int/trademarks_ren/?lang=EN).

You can calculate the exact amount you should pay for the renewal of your IR by using the Fee Calculator made available by WIPO (http://www.wipo.int/madrid/en/fees/calculator.jsp).

The renewal fees should be paid to WIPO at the latest on the date of expiry of the international registration. The payment can still be made up to six months after that date (grace period) provided that a surcharge is paid at the same time. WIPO records the renewal with the date on which it was due, even if the fees required were paid within the grace period.

The effective date of renewal of your IR is the same for all DCPs where it will take effect. This is a clear advantage of the Madrid route as compared to the national route where you have separate marks at separate TM offices having to be renewed at different dates.

5.3. DEPENDENCY AND TRANSFORMATION; INDEPENDENCE

It is important to consider that, for a period of five years (dependency-period), the fate of your IR will remain dependent on the fate of your basic mark (application or registration) in India. If for whatever reason your basic mark in India ceases to have effect in whole or in part (rejection or withdrawal of your basic application, or cancellation, renunciation, revocation, invalidation, or lapse of your basic registration) within that period (five years from the date of your IR), your IR will be cancelled in whole or in part (for some goods or services) accordingly.

To soften the consequences of this dependency feature, the Madrid Protocol provides for the possibility of "transformation" of your IR into national or regional applications in the designated Contracting Parties (DCPs). Within three months of the cancellation of your IR, you may apply for the registration of that same mark in those DCPs and those applications will be treated as if they had been filed on the date of the original IR (therefore maintaining the earlier rights that you enjoyed).

At the end of the five-year dependency period, your IR becomes completely independent of your basic mark and cannot be cancelled any longer if the latter happens to cease to have effect.

5.4. ONLINE TOOLS TO MONITOR AND MANAGE INTERNATIONAL REGISTRATIONS

WIPO offers several online tools and services that make it easier for you to track and manage your international registration, as well as to keep an eye on competitors. Below is a brief description of some of these tools and services.

5.4.1. Madrid Monitor

Madrid Monitor (http://www.wipo.int/branddb/wo/en/) is an e-service launched by WIPO in 2017, which allows you to track the status of your international application or registration, access detailed information on all marks registered through the Madrid system, and keep an eye on competitors' marks. Madrid Monitor combines the features of four earlier WIPO tools (ROMARIN, WIPO Gazette, Madrid E-alert and Madrid Realtime Status) that used to operate separately. Direct access to those older tools is now stopped by the WIPO.

ROMARIN, the international trademarks database (http://www.wipo.int/madrid/en/romarin/), allows you to search detailed information on all international marks registered under the Madrid system. The database is updated daily and contains all Madrid system marks currently in force, those which have expired within the last six months, and those still under examination.

The WIPO Gazette of International Marks (http://www.wipo.int/madrid/gazette/) is the official publication of the Madrid system. Published weekly, it contains the latest data regarding international registrations, renewals, subsequent designations and modifications affecting existing registrations.

Madrid Electronic Alert (MEA) is a free "watch service" designed to inform anyone interested in monitoring the status of an international registration (IR). To subscribe to MEA, you need to have a WIPO User account (https://www3.wipo.int/wipoaccounts/en/usercenter/public/register.jsf). MEA allows you to create a list of IR numbers and receive an e-mail alert each time an inscription concerning one of them is recorded in the International Register. These messages provide a hyperlink to ROMARIN, where you can find further details on the changes.

Madrid Real-time Status (MRS) is a stand-alone tool that provides the status in real time of trademark documents being processed by WIPO. You launch a query through MRS concerning a specific international registration (IR) and you receive a list of all related events recorded or in the

process of being recorded in the International Register regarding that IR. This allows you to see what is happening to your request at any point in time. MRS is also available in a mobile version.

5.4.2. Madrid Portfolio Manager (MPM)

Madrid Portfolio Manager (MPM) is an online service that allows holders of IRs to access their international trademark portfolios. This is especially helpful when submitting new requests for recordal in the International Register. To access MPM, you need a WIPO User account (https://www3.wipo.int/wipoaccounts/en/usercenter/public/register.jsf) linked to an e-mail address. You can establish your own portfolio by collecting all the international registrations linked to the same e-mail address.

6. PROTECTING YOUR TRADE MARK IN THE EUROPEAN UNION

In the European Union (EU), there is a four-tier system for registering trademarks. What you choose depends on the needs of your business.

If you just want protection in one EU Member State where you want to trade, you can file a trade mark application directly at the relevant national IP office. This is the national route available in 25 EU Member States (Austria, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Malta, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and United Kingdom).

If you want protection in Belgium, Luxembourg and/or the Netherlands, you can file a trade mark application at the Benelux Office of Intellectual Property (BOIP),

This section analyses the benefits of obtaining a trade mark right valid in all the 28 EU Member States either by following the European route (direct filing at the EUIPO) or the international route (Madrid filing designating the EU).

6.1. DIRECT FILING AT THE EUIPO (THE EUROPEAN ROUTE)

Applying for a European Union trade mark (EUTM) directly at the EUIPO, instead of filing separate trade mark applications and getting separate rights under each of the national + Benelux systems existing in the European Union (EU), is an attractive route if you wish to get a single trade mark right that is valid in all the 28 EU member States.

You can file your application on line at the EUIPO website (https://euipo.europa.eu/ohimportal/en). The EUTM gives you an exclusive right valid in all the EU member States (current and future) at a reasonable cost (850 EUR basic fee, in 2017, for the online filing of an individual EUTM application covering one class; for up-to-date information on fees, including for additional classes, and EU collective or certification marks, please see https://euipo.europa.eu/ohimportal/en/fees-payable-direct-to-euipo). You can enforce your trade mark in a market of almost 500 million consumers. A EUTM is valid for 10 years and can be renewed indefinitely every ten 10 years.

At the EUIPO website, you will find detailed explanations on how to apply for a EUTM, how to follow the registration procedure, and how to manage your EUTM once registered.

6.2. DESIGNATING THE EU VIA MADRID (THE INTERNATIONAL ROUTE) – BEST PRACTICES

Similar benefits to those offered by the European route, plus the additional benefits that are proper to the Madrid system, you can enjoy by following the international route. As from 2004, when the European Union became a Contracting Party of the Madrid Protocol, it became possible for users of the Madrid system to get a trade mark right having the same effects as a EUTM (valid in all the EU Member States) by designating the EU under the international procedure (either in an international application or as a subsequent designation).

An international registration (IR) designating the EU and accepted by the EUIPO has the same effects as a EUTM registered by the EUIPO. This section describes the best practices to be followed to obtain and manage an international registration (IR) valid in the European Union.

6.2.1. Designating the European Union: specific requirements

You can designate the European Union for protection either:

- **(i)** when filing your international application on line at the IP India website (http://ipindiaonline.gov.in/trademarkefiling/user/frmLoginNew.aspx), by checking the European Union (EM) box in the MM2 form; or
- **(ii)** once you have obtained an IR, in a subsequent designation presented to WIPO in the MM4 form, either on line (https://www3.wipo.int/osd/), via facsimile or by mail.

In addition to the general requirements for international applications and subsequent designations, when you designate the European Union you should consider the following:

(a) the language of your proceedings before the EUIPO will be the language of your international application (English). However, when designating the EU, you must also designate a second language of the EUIPO (either French, German, Italian or Spanish), the use of which you accept as a possible language for opposition, revocation or invalidity proceedings.

(b) moreover, if you wish to claim the seniority of an earlier mark registered in, or for, a Member State of the European Union, you may do so at the time of filing your international application or subsequent designation by attaching the official form MM17 (you may also claim seniority directly before the EUIPO at a later date).

The basic fee for a designation of the EU for one class of goods or services has been fixed by the EUIPO at 897 CHF (status in June 2017). For up-to-date information on the individual fees fixed by the EUIPO for designations and renewals regarding individual marks and collective or certification marks under the Madrid system, please see http://www.wipo.int/madrid/en/fees/ind_taxes.html

6.2.2. Professional representation before the EUIPO

In principle, you do not need to appoint a representative before the EUIPO. However, being located outside the European Economic Area, you will need to appoint a representative (a) if the EUIPO issues a provisional refusal of your international registration, (b) for filing seniority claims directly before the EUIPO; or (c) further to a EUIPO objection on a seniority claim. Your representative should be a person who appears in the database of representatives maintained by the EUIPO (https://euipo.europa.eu/eSearch/#advanced/representatives).

6.2.3. First republication, searches and formalities

Upon receipt of the WIPO notification of the international registration (IR) designating the EU, the EUIPO will immediately republish the IR in the EUTM Bulletin (Part M.1) (https://euipo.europa.eu/ohimportal/en/where-is-the-bulletin). Publication is limited to the bibliographic data, the reproduction of the mark, and the class numbers (not the actual list of goods and services). The IR has, from the date of that first republication, the same effect as a published EUTM application. If you so wish, within one month of the WIPO notification you may ask EUIPO to draw up a EU search report which will cite similar EUTMs and IRs designating the EU. You may also request the EUIPO to send the IR to the participating national offices of EU Member States to have national searches carried out for you (you will have to pay the corresponding fees).

The formalities examination carried out by the EUIPO on IRs is limited to (a) whether a second language has been indicated, (b) whether the application is for a collective mark, (c) whether there are any seniority claims, (d) whether the list of goods and/or services meets the requirements of clarity and precision as described in the EUIPO TM guidelines, and (d) whether the limited list for the EU designation falls within the IR's main list.

If you have failed to designate a second language of the EUIPO as a possible language of proceedings for opposition, revocation or invalidity proceedings before the EUIPO, the EUIPO examiner will issue a provisional refusal and give you two months to remedy the deficiency.

If your IR designating the EU is a collective mark or a certification mark based on such type of mark in India, it will be dealt with as an EU collective mark or an EU certification mark, whichever is applicable. In such cases, you will need to submit the regulations governing the use of the mark to EUIPO within two months.

If you have claimed seniority of an earlier mark registered in an EU Member State, the EUIPO will check that you have given the name of the EU Member State where the earlier right is registered, the registration number and the filing date of the relevant registration.

Where the IR contains vague terms in the list of goods and/or services, which lack clarity or precision, the EUIPO will issue a provisional refusal and give you two months to remedy the deficiency. To avoid including in your list terms that will not be accepted by the EUIPO, it is recommended that you search the content of the EU Harmonised Database (HDB) before filing an IR designating the EU. This can be done on line, free of charge, at the following address: http://tmclass.tmdn.org/ec2/. The HDB contains terms designating goods and services that are accepted by all TM offices in the EU. All HDB terms will be accepted by the EUIPO automatically. This will help make your registration process much smoother.

6.2.4. Examination of absolute grounds for refusal

IRs designating the EU are subject to examination of absolute grounds for refusal in the same way as direct EUTM applications.

In particular, your mark will not be eligible for protection if it consists of a sign that:

(a) does not conform to the EUTM definition (capable of distinguishing the goods or services of one undertaking from those of other undertakings, and being represented in a manner which enables to determine the clear and precise subject matter of the protection afforded);
(b) is non-distinctive;
(c) is descriptive;
(d) consists exclusively of words or indications that have become customary in the current language or in the bona fide and established practices of the trade at the relevant point in time;
(e) consists exclusively of the shape or other characteristics resulting from the nature of the goods, with an essentially technical function or substantial value;
(f) is contrary to public policy or to accepted principles of morality;
(g) is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services;
(h) is in conflict with armorial bearings, flags, emblems, and other symbols of States and IGOs protected under Article 6ter of the Paris Convention;
(i) is in conflict with other badges, emblems an escutcheons of particular public interest;
(j) is in conflict with designations of origin and geographical indications protected under national

(EU Member State) or EU legislation or international agreements to which the EU or the Member State concerned is party;

(k) is in conflict with traditional terms for wines protected by either EU legislation or international agreements to which the EU is party;

(l) is in conflict with traditional specialities guaranteed (TSGs) protected by either EU legislation or international agreements to which the EU is party;

(m) is in conflict with earlier plant variety denominations protected within the EU in respect of plant varieties of the same or closely related species.

If the EUIPO finds that your mark is not eligible for protection, it will send a provisional refusal and provide you with a two month time period to submit observations. Your reply must be addressed directly to the EUIPO, which, after re-examining the case, may decide to confirm the refusal or waive the objection.

If the EUIPO finds that your mark is eligible for protection, and provided that no other provisional refusal is pending, it will send an interim status of the mark to WIPO indicating that the ex officio examination has been completed but the IR is still open to opposition or third-party observations.

6.2.5. Opposition

Any person invoking earlier rights in conflict with your mark may file an opposition against your IR between the first month and the fourth month following the date of first publication.

If someone opposes your IR within that period, the EUIPO will send to WIPO a notification of provisional refusal (based on relative grounds) and will send you copy of the notice of opposition. It will also notify to you the time limit for commencement of the proceedings. In all communications with WIPO, the EUIPO will use the language of the IR (English in your case). In all communications sent directly to you, the EUIPO will use the language of the opposition proceedings chosen by the opponent (which will be English or the second language chosen by you when designating the EU).

The provisional refusal may be partial or total. It will contain the earlier rights invoked, the relevant list of goods and services on which the opposition is based and, in the case of a partial refusal, the list of goods and services against which the opposition is directed. The list of goods and services will be in the language of the opposition proceedings.

6.2.6 Final decision

Once all the procedures have been completed and all the decisions are final, the EUIPO must either confirm the provisional refusal(s) to WIPO or send a statement of grant of protection to WIPO specifying for which goods and services your mark is accepted.

6.2.7. Protection in the EU

If the EUIPO decides that your mark is (at least in part) protected in the EU, the EUIPO will republish your IR for a second time in the EUTM Bulletin (Part M.3). The EUIPO will not issue any registration certificate.

From the date of the second republication, the IR has the same effects as a registered EUTM and may be invoked against an infringer. The date of the second republication will also be the starting point for the five-year use period. If your mark is not put to genuine use in the European Union within that period, the effects of your IR in the EU may be declared invalid.

6.2.8. Transformation into a EUTM

If your IR is cancelled in whole or in part because your basic mark in India has ceased to have effect within the five-year dependency period and your EU designation is still effective, you may file a direct EUTM application at the EUIPO for the same mark and the same goods and services as the cancelled mark. Based on the Madrid Protocol provision on "transformation", this application will be treated by the EUIPO as if it had been filed on the date of the original designation of the EU and will enjoy the same priority, if any.

To invoke a transformation right your application should be filed within a period of three months from the date on which your IR was cancelled in whole or in part, and the goods and services of the ensuing application should be covered by the list of goods and services of the EU designation. When the application for transformation relates to an IR designating the EU which was already accepted and published by the EUIPO, the examination and opposition states are omitted. The EUTM will be published in all EU languages and a EUTM registration certificate will be issued.

6.2.9. Conversion ("opting-back")

If for whatever reason your designation of the EU is withdrawn, refused or ceases to have effect, you may convert the designation of the EU into either a national application filed directly with the Office of one or more EU member States or a subsequent designation of those member States under the Madrid system. The effect of conversion is that the trademark application or the subsequent designation resulting from conversion is allocated the same filing date as that of the designation of the EU in the international registration (IR) as recorded in the International Register (and enjoys, if applicable the same priority date and/or seniority claimed). This mechanism offered to the holder of an IR is often referred to as the "opting-back" provision.

A subsequent designation resulting from conversion must be forwarded to WIPO through the EUIPO in an official form (MM16), within the time limits set up by the EUIPO.

6.2.10. Replacement in the EU

If you had your mark already registered at the EUIPO as a EUTM and you designate the EU under the Madrid system for the same mark, you will enjoy the Madrid Protocol benefit of replacement (your IR rights in the EU will be deemed to start from the date of the earlier EUTM registration). Replacement takes place automatically; there is no need to request any record. Nevertheless, you can ask the EUIPO to take note of the replacement in its Register. After replacement has taken place, the EUTM is maintained normally in its Register as long as you renew it. If you renew it, there will be coexistence between the "replaced" EUTM and the IR designating the EU.

7. PROTECTING TRADEMARK IN INDIA THROUGH MADRID PROTOCOL

A trademark may also be protected in India through an application for international registration under the Madrid Protocol. Under this procedure, any person belonging to a country or organization of countries which is member of the Madrid Protocol and where he has a trademark registered or pending for registration (commonly known as 'Basic mark') may file the application for international registration (commonly known as 'International Application') through his office and may seek protection of his trademark in India. The application needs to be certified and transmitted by that office to the WIPO.

In case, the international application designating India is published as registered by WIPO, the same is notified to India. The Trade Marks Registry (TMR) under the office of the Controller General of Patents designs and Trade Marks (CGPDTM) deals with such international registrations and decides about protection of the mark in India in view of Indian Trademarks Act and rules made thereunder. After receiving notifications about international registrations where protection of the mark is sought in India, the Indian office (TMR) adopts the following procedure-

- The particulars of international registrations are recorded in Indian IP office (TMR) data base, and a corresponding national number [as IRDI xxxxxxxx] is assigned for each international registration.

- The Indian office entertains correspondence in respect of any international registration under Madrid Protocol only when the same is received through comprehensive e-filing services gateway available at the website: https://ipindiaonline.gov.in/trademarkefiling/online/welcomeForm.aspx

- The IRDI is examined as a national application as per provisions of the Trade Marks Act & Rules.

- In case of any objection, a provisional refusal is communicated to WIPO. The WIPO communicates the provisional refusal to the Holder of the international registration.

- The Holder of the international registration may respond to the provisional refusal and request this office to reconsider it; but the holder can do this only through an agent having address for service in India. The reply to the provisional refusal needs to be filed only through comprehensive e-filing services gateway available at the website: https://ipindiaonline.gov.in/trademarkefiling/newtmForms/frmReportReply.aspx under Reply to Examination report head.

- The Indian office duly considers the reply and if it is satisfactory it may accept the international registration for protection in India and will publish the particulars of the international registration (under the corresponding national IRDI number) in the Trademarks Journal which is made available on the IP India website http://www.ipindia.nic.in/journal-tm.htm. In case the reply is not satisfactory, an opportunity of show cause hearing (personal hearing) is provided to the agent/representative of the holder of the international registration in India. The hearing

is scheduled in the branch of the Trade Marks Registry Office within the territorial jurisdiction of which the address of the holder's representative is situated. In case of no objections, or objections waived after considering the holder's reply or after the personal hearing, the particulars of the international registration is published in the Indian Trade Marks Journal under the corresponding national IRDI number as mentioned above.

- Any person may file notice of opposition to so published IRDI, as any other published national application. The Notice of Opposition needs to be filed only through comprehensive e-filing services gateway available at the website https://ipindiaonline.gov.in/trademarkefiling/newtmForms/frmTM-O.aspx

- On receiving any opposition to the IRDI, the TMR communicates to the WIPO, a provisional refusal based on the opposition. WIPO sends copy of the same to the holder.

- The Holder of the international registration, may contest to provisional refusal and file a Counter Statement to resist Notice of Opposition. The holder can file the Counter Statement only through an agent having address for service in India which further needs to be filed only through comprehensive e-filing services gateway https://ipindiaonline.gov.in/trademarkefiling/newtmForms/frmTM-O.aspx. The copy of the Counter Statement is then served to the opponent who is required to file evidence in support of his opposition with a copy of the same to the representative of the holder. The holder is then required to file evidence in support of application with a copy of the same to the representative of the opponent. The opposition proceeding are then conducted as per procedures mentioned under the Trade Marks Act and rules made thereunder.

- In case no opposition is received within the prescribed period and there have been no grounds for refusal, the TMR will notify the Grant of Protection of the international registration, to the WIPO. In such cases, the protection of the mark in India shall be same as if it has been registered directly with Indian office.

In addition to above, the Indian office keeps on updating details of corresponding national (IRDI) number created for an international registration wherein protection is sought in India as per notification received from the WIPO in respect of that international registration.

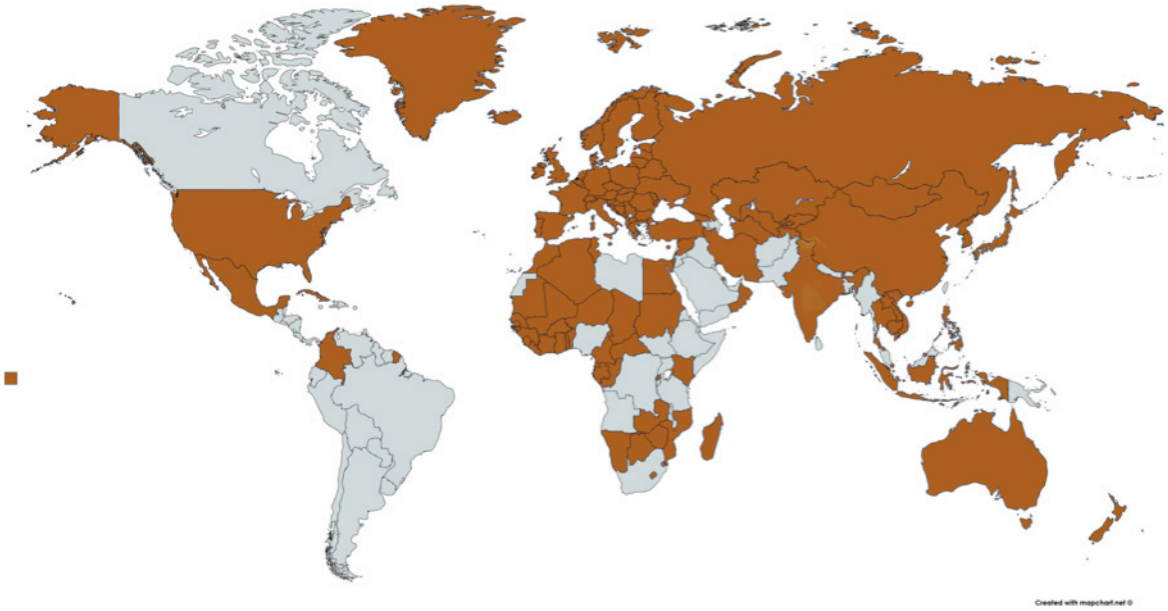
Other procedures of the Madrid Protocol as mentioned in the Common regulations are also followed by the Indian office in the same manner as followed by the EUIPO and described above. However procedures relating to **Transformation** and **Replacement** are not stabilised in India, necessary steps are being taken by Indian office to properly implement these provisions. As per declarations made by the Government of India while acceding to the Madrid Protocol, in case of the license of a trademark protected in India through international registration under Madrid Protocol, the application for recordal of license needs to be filed only with the Indian office. The license of such trademark recorded with the WIPO has no effect in India.

8. CONCLUSION

The Madrid Protocol offers you an attractive route, to protect your brand in up to 115 countries around the world, by making available cost-effective and user-friendly procedures to acquire and manage your trade mark rights abroad. As a national of India, or a person domiciled or having an enterprise in India, you are entitled to use this treaty that India joined in 2013. Using the Madrid Protocol today, is an essential component of any successful branding strategy. The Protocol offers you early brand presence at a global level and helps you rapidly acquire international reputation and generate goodwill for your trademarks abroad. The Protocol ensures the legal protection of your brand against competitors in export markets, increases franchising opportunities, opens partnership possibilities and facilitates integration to global supply chains. In general, it provides a most effective support to your branding strategies and business success.

MADRID UNION MEMBERS

100 members (including European Union and OAPI) overing 116 countries



सत्यमेव जयते

Department of Industrial Policy and Promotion
Ministry of Commerce & Industry
Government of India

EUROPEAN UNION

THE MADRID PROTOCOL:
A ROUTE TO GLOBAL BRANDING

INTELLECTUAL PROPERTY INDIA
PATENTS | DESIGNS | TRADE MARKS
GEOGRAPHICAL INDICATIONS

Creative India
Innovative India