



ROVING SEMINAR

Public Awareness Building on the Madrid System for the International Registration of Marks

Organized by
The World Intellectual Property Organization (WIPO)
And
The Office of the Controller-General of Patents, Designs and Trademarks
In cooperation with
The Federation of Indian Chambers of Commerce & Industry (FICCI)

Conference Report

Ahmedabad, November 26, 2014

Supported by
National Institute of Design, Ahmedabad



राष्ट्रीय डिजाइन संस्थान
NATIONAL INSTITUTE OF DESIGN

About FICCI



FEDERATION OF INDIAN CHAMBERS OF COMMERCE AND INDUSTRY (FICCI) since 1927 has been the rallying point for free enterprises in India. It has empowered Indian Businesses in the changing times, to shore up their competitiveness and enhance their global reach. With a nationwide membership of 500 chambers of business association, FICCI stands for quality, competitiveness, and transparency, accountability and business –government-civil society partnership to spread ethics based business practices and to enhance the quality of life of common people.

FICCI has a reach in all 29 states and 7 Union Territories; through its Secretariat at New Delhi & 12 State Offices. FICCI has 1,800 direct members from the corporate sector, both private and public, including SMEs and MNCs and 2,50,000 lakh (approx.) indirect members through various regional chambers of commerce, ranging from 44 industrial verticals including public & private industries, associations, individuals, SME's etc.

FICCI strongly believes that it is important to provide entrepreneurs conducive environment which can foster innovation. FICCI IPR DIVISION is dedicated to the task of holistic development, protection, incentivization and promotion of Intellectual Property in India.

The *Intellectual Property Education Centre (IPEC)* is one of its kind online educational website second only to the WIPO educational initiative. Since its inception FICCI IPEC has successfully provided the certificate course to over 5,000 students, industry professionals, ex-government employees, etc. The courses include general course on IPR; specialized courses on Competition Law, Pharmaceutical R&D and US Patent. The plan for 2015 includes revamping the IPEC website alongwith updating the existing course material and also adding courses on IP enforcement, IP landscaping, IP Commercialization, R&D and Tech Transfer.

FICCI also established the *Intellectual Property Facilitation Centre (IPFC)* in New Delhi and Guwahati under the mandate of the Ministry of Micro, Small & Medium Enterprises (MSME). Headed by a team of experts from Legal & MSME; the IPFC helps MSME, Entrepreneurs, Individual Inventors etc. to identify, develop, protect, register, commercialise and use IP to business advantage. IPFC in 2015 endeavours to develop a holistic web system to provide the services IP consultancy, IP related knowledge, Commercialization Consultancy, Tech Transfer, linking international and national search databases; providing technical training in searching these databases; for payment of fee or for free to MSME; individuals innovators, etc. all over the Country and abroad.

FICCI IPR Division is dedicated to tackling IP related problem at the grass root level. The Division is engaged in conducting roving seminars for general IP Awareness & International Filling; Police & Customs Training for identifying IP related Offences and tackling them effectively; Judiciary Roundtables for making the Judiciary sensitive to the industry perspective of the losses and the impact of IP infringement.

In addition the Division is also involved in developing education curriculum to be included in the school syllabi at primary, secondary & higher secondary level. The division is actively involved in making policy suggestions to the IPR Think Tank.

CONTACTS

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ABOUT THE SPEAKERS

Mr. Bernard Volken, Attorney-at-Law, Fuhrer Marbach and Partner, Bern, Switzerland; is specialized in the field of intellectual property since 20 years. He focuses on developing a full range of IP strategies (prosecution, litigation, customs seizures, contracts/licensing). Before joining Fuhrer Marbach & Partners he worked for several years at the Swiss Trademark Office (IPI) as head of the Trademark Opposition Section. During this time he was involved in the total revision of the new Swiss Design Protection Act.

Mr. Volken is lecturer at the “Hochschule für Technik Zurich” in the field of a Master of Advanced Studies in Intellectual Property. He regularly speaks at IP seminars and frequently publishes articles on IP issues. Mr. Volken serves as an examination expert for Swiss Patent Attorneys and he is a contributing editor of the Swiss Journal of Intellectual Property Rights.

Mr. Volken was the winner of the ILO (InternationalLawOffice.com) Client Choice Award 2011 and 2014 for Switzerland in the category "Trademark Law". He is regularly listed in the WTR (The Word's Leading Trademark Professionals) and has been recommended in Chambers Europe and “Who's who legal”.

Ms. Junying Tao, Senior Counsellor, Information and Promotion Division, Madrid Registry, Brands and Designs Sector, based in Geneva, Switzerland. Since 1991, she served at different posts in the international trademark and designs administration, legal, and promotion and information areas and participated in particular in the implementation of the Madrid Protocol in 1996, in the conclusion of The Geneva Act of the Hague Agreement.

Before joining WIPO in 1991, she worked in the Trademark Office of the State Administration of Industry and Commerce of China. As Deputy Director of International Registration Division during 1988 to 1991, she accomplished the preparation of the accession of China to the Madrid Agreement and setting up the internal registration procedure under the Madrid system. As a delegate, she participated in the diplomatic conference for the conclusion of the Protocol relating to the Madrid Agreement concerning the international registration of marks in 1989.

SUMMARY OF PROCEEDINGS

MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

Venue:- National Institute of Design, Ahmedabad

Dated:- 26th November 2014

*Attendees:- 80 Members from Industry, Academia, MSME and individual
entrepreneurs*

Introduction

The Madrid Protocol, which was established under the Madrid Agreement in 1989, has been adopted by more and more countries as it is seen as a measure to assist trademarks owners in reducing the time, expenses and even paper work involved in maintaining a large trade mark portfolio in multiple countries for multiple categories of goods. Recently India became a party to it with the parliament ratifying the same on 08th Feb, 2007. The new amendments proposed in relation to the Trade Marks Act 1999, are aimed at primarily addressing the law in India and making it comply with the requirements of the Madrid Protocol. At present there are 92 member countries who are a party to the Madrid Protocol.

MADRID SYSTEM

The system of International registration of marks is governed by two treaties:-

(a). The Madrid Agreement, concluded in 1891 and revised at Brussels (1900), Washington(1911), The Hague(1925), London (1934), Nice (1957) and Stockholm (1967).

(b). The protocol relating to that agreement, which was concluded in 1989, with the aim of rendering the Madrid System more flexible and more compatible with the domestic legislation of certain countries which had not been able to accede to the Agreement.

WHICH PREVAILS : THE MADRID AGREEMENT OR THE MADRID PROTOCOL?

The Madrid Protocol prevails over the Madrid Agreement where Contracting parties are bound by both the Madrid Protocol and the Madrid Agreement. The Madrid Agreement will only remain applicable and continue to apply in full for member countries bound solely by the Agreement.

WHO MAY USE THE SYSTEM?

An application for International registration (international application) may be filed only by natural person or legal entity having a connection, through an establishment, domicile or nationality, with a Contracting party to the Agreement or the Protocol.

A mark may be the subject of an International application only if has already been registered with the Trademark office of the contracting party with which the applicant has the necessary connections. However, where all the designations are effected under the Protocol, the internal applications may be based on a mere application for registration filed with the office of origin.

INTERNATIONAL REGISTRATION

Once the International Bureau receives the International application, it carries out an examination for compliance with the requirements of the Agreement, the protocol, and their Common Regulations. This examination is restricted to formalities, including the classification and comprehensibility of the list of goods and or services, any matter of substance, such as whether the mark qualifies for protection or whether it is in conflict with an earlier mark, is left to each designated Contracting party to determine. If there are no irregularities, the International Bureau records the mark in the International Register, publishes the international registration in the WIP gazette of International Marks, and notifies it to each designated Contracting party.

REFUSAL OF PROTECTION

These contracting parties may examine the international registration for compliance with their domestic legislation and, if some substantive provisions are not complied with, they have the right to refuse protection in their territory. Any such refusal, including the indication of the grounds on which it is based, must be communicated to the International Bureau, normally within 12 months from the date of the notification. However, a contracting party to the protocol may declare that a refusal based on an opposition may be communicated to the International Bureau even after this time limit of 18 months.

WHAT IS THE PROCEDURE FOR AN APPLICATION UNDER THE MADRID PROTOCOL?

a). Upon India being a signatory to the Madrid Protocol, applicant while making an application to National Office may select from the list of member countries where he seeks protection of mark.

- b). The National Office in the country of origin examines whether the International application corresponds to the basic application and complies with home state requirements.
- c). On the National Office being satisfied, it forwards the application to WIPO. WIPO examines the application and the International Bureau places the mark in the International Register of Trade marks.
- d). The international Bureau advertises the mark and passes on the details of the application to the designated countries listed in the application for their consideration, consequent approval and granting of registration.
- e). Member states designated in the application have twelve months to notify WIPO of any objections, but under special provision United Kingdom has eighteen months.

WHAT IS THE LIFE OF A MARK UNDER THE MADRID PROTOCOL?

Registration under the Protocol lasts for 10 years, but can be renewed subsequently for periods of 10 years. Any regional registration can be made an international registration, upon satisfying the conditions and requirements under the Madrid Protocol.

IMPLICATION OF MADRID PROTOCOL IN INDIA

With a view to implementing the Madrid Protocol, an amendment, has been proposed in the Trade Marks Act, 1999 which introduces several changes, very welcome. It is believed that upon the implementation of the protocol and the amendment of the Act, the procedure for filing of trademarks may become quicker with lower costs, even for Indian clients applying in India. Amongst the changes proposed in the Act is the change to Section 23, wherein, the requirement to register a trademark application within 18 months has been proposed to be inserted. This requirement is in keeping with the Madrid Protocol which requires national trade mark offices to decide an application within twelve to eighteen months. A new Chapter IVA has also been introduced into the Act which deals with the International applications and statutory provisions particular to the protocol.

ADVANTAGESS OF THE MADRID SYSTEM

There are various advantages associated with the Madrid Protocol. Some of these benefits are as follows:-

- a). The simplicity of filing :- The Madrid Protocol allows for the filing of a single application, in one office, in one language, with a single fee (which depends on the number of countries selected).

b). The simplicity of alternation:- A change of ownership details or a name or address change is easily recorded with all the members states by means of one form.

c). Faster processing:- The time period for overseas trade mark offices to issue a provisional refusal of the mark is limited to 12 or 18 months.

d). The simplicity of renewal:- There is only one renewal payment to make every ten years from the registration date.

DISADVANTAGES OF THE MADRID SYSTEM

a). Firstly, not all the countries follow standardized criteria for examining and accepting an application. Certain countries are stricter and follow stringent norms for determining the validity of an application, such as those relating to proof of use, specification of goods and services, criteria for determining deceptive similarity etc.

b). Secondly, and perhaps one of the biggest drawbacks of the system is the vulnerability of the trade mark registrations/applications in all jurisdictions to a central attack on an application is the result of the provision in the Madrid Protocol where, if the basic application is rejected or the basic registration removed/cancelled, then all the applications based on such an application would no longer be protected.

c). Thirdly, goods & services description cannot exceed scope of home registration. Another unique feature of the Madrid system relates to recordable of changes in ownership, address of owner, assignments, etc. under the system, a single application with a single fee would suffice for recoverable of these changes in all the jurisdiction. This is of course, of tremendous advantage to the trade mark owners in terms of saving costs and time. The Madrid Protocol does not change local laws on the acquisition of the trade mark rights, application formalities, and use requirements.

CONCLUSION

In essence, the Madrid Protocol is a system, akin to the Patent Co-operation Treaty (PCT) system that exists for patents, to enable trade-marks owners to file multiple trade mark applications simultaneously at considerably less expenditure. Experience has shown that allowing PCT filings in India has been major boon to the country, bringing in more and more patent applications along with the technologies that would otherwise have been unavailable. However, on the flip side is the problem that such a change may only be made in favour of a person entitled to the protection under the Madrid System, that is, a person or entity national of or domiciled in a country party to the Madrid Protocol or a real and effective business in such a country. This aspect may prove to be a major

hindrance in the adoption and implementation of the Madrid System by trade mark owners worldwide. Restricting recordal of such changes only in favour of those who are entitled to the protection under the Madrid System may be restricting the growth and future expansion of the business and not necessarily a cost effective solution.



Mr. Bernard Volken, Attorney-at-Law, Fuhrer Marbach and Partner, Bern, Switzerland; **Shri Pradyumna Vyas**, Director, National Institute of Design, **Mr. Chaitanya Prasad**, Controller General of Patents, Designs & Trade Marks, DIPP, Ministry of Commerce and Industry; **Shri N.N. Prasad**, Assistant Director General and Chief of Staff, World Intellectual Property Organisation (WIPO), **Ms. Junying Tao**, Senior Counsellor, Information and Promotion Division, Madrid Registry, Brands and Designs Sector, based in Geneva, Switzerland; **Shri Jatin Trivedi**, Head Legal Committee, FICCI Gujarat State Office and IP Office Officials during the event.



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Ahmedabad, November 26, 2014

Venue:-NID Auditorium, Ahmedabad

PROGRAM

November 26, 2014

- 10.00– 10.15 Registration
10.15 – 10.30 **Opening Ceremony**
- Welcome addresses by:
- Representative of the Office of the Controller-General of Patents, Designs and Trademarks, Mumbai
- Mr. Naresh Prasad, Executive Director and Chief of Staff, Office of the Director General, World Intellectual Property Organization (WIPO), Geneva
- 10.30 – 11.15 **Topic 1:Importance of Protecting Trademarks at Home and Abroad**
- Speaker: Representative from Indian Office
- 11.15 – 11.30 Coffee Break
11.30 – 12.15 **Topic 2: Overview of the Madrid System for the International Registration of Marks: Basic Features and Latest Developments**
- Speaker: Ms. Junying Tao, Senior Counsellor, Information and Promotion Division, Madrid Registry, Brands and Designs Sector, WIPO
- 12.15 – 14.00 Lunch Break
- 14.00 – 14.45 **Topic 3: How to Use the Madrid System to Obtain Trademark Protection Abroad?**
- Speaker: Ms. Junying Tao, WIPO
- 14.45 – 15.15 **Topic 4:How to File a Madrid International Application from India?**
- Speaker: Representative from Indian Office
- 15.15 – 15.30 Coffee Break
- 15.30 – 16.15 **Topic 5:Experiences of Using the Madrid System**
- Speaker: Mr. Bernard Volken, Attorney-at-Law, Fuhrer Marbach and Partner, Bern, Switzerland
- 16.15 – 17.00 Questions and Answers and Summing-up