

Madrid Protocol: A Giant Step in the field of International Trademark Registration

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ABSTRACT

In this study an attempt will be made to inspect about the idea of Madrid Protocol. The examination starts with a short clarification of the Madrid System alongside a relative study between Madrid Agreement and Protocol. The project is divided into three sections. The first being the history and origin of the protocol, the aim and development behind its foundation. The next part lays down the requirements and procedure of the international registration of trademark as to launch new brand/ product in a worldwide market, it is important to verify our freedom to operate internationally and protect it from infringement. Thirdly we discuss about two important scenarios where trademark registration can be challenged. Although the Madrid Protocol provides a efficient way for trademark holders to ensure protection for their marks in multiple countries, yet loopholes are available. We will also examine the drawbacks of this convention; bring light on what must be done to meet the changing needs.

Key Words: International Registration, Madrid System, Loopholes.

INTRODUCTION TO MADRID PROTOCOL:

The Madrid Protocol (formally the Madrid system for the worldwide recognition of trademark) is the essential global framework for encouraging the enrollment of trademarks in numerous purviews around the globe. Its legitimate premise is the multilateral treaty Madrid Agreement Concerning the International Registration of Trade Marks of 1891, and additionally the Protocol Relating to the Madrid Agreement (1989). The framework gives a segment to getting trademark protection in various countries as far and wide as could

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reasonably be expected which is more effective than searching for security autonomously in each individual country or jurisdiction.

The Madrid Protocol is a universal settlement, which was embraced in 1989 with a specific end goal to uproot the challenges that were discouraging a few nations from consenting to the Madrid Agreement, the 1891 bargain that set up the framework for the global enlistment of trademarks. By complexity, the Madrid Protocol is a relative newcomer.. It started operation on April 1, 1996, and is, just like the Madrid Agreement, a universal trademark documenting framework among Contracting Parties that outcomes in the issuance of global enrollments. The Protocol, which has been in power following April 1, 1996, has turned into an advantageous and efficient method for securing trademark enlistment in part nations in Asia, European nations, Africa countries , the Western Hemisphere, the Middle East and the Pacific Circle.³

It gives a financially savvy and proficient path for trademark holders - people and organizations - to guarantee insurance for their imprints in different nations through the documenting of one application with a single office, in one dialect, with one set of expenses, in one currency. No local agent is involved in the registration process. Thus adoption of the Madrid Protocol is referred as a very vital step taken in the protecting trademarks globally.

HISTORY AND ORIGIN OF THE MADRID PROTOCOL:

The Madrid Protocol owes its presence to the production of the Community Trademark framework and to the powerlessness of the 1891 Madrid Agreement to pull in the participation of new nations. The Madrid Agreement was initially expected to accommodate a universal registration framework, yet did not accomplish this for two critical reasons:

- The absence of global acknowledgment. Some non-part nations, including the United States, United Kingdom, Parts of America and even Asian nations, for example, Japan, were not followers, which undermined acknowledgment of the framework as a genuinely "global" administration. Together, a many of these countries speak to the biggest quantities of trademark filings and enrollments on the planet, and

³ *The Madrid Protocol: Impact of U.S. Adherence on Trademark Laws and Practice*, International Trademark Association, April 2003, <http://www.inta.org/Advocacy/Documents/INTAMadridProtocolUSImpact.pdf> (last updated on 3rd February 2015)

→ The simple sending by the International Bureau of a uniform application to part nations, instead of the enlistment of the relevant trademark in the national trademark registers, ceases a genuine registration framework

Participation of the Madrid Agreement was customarily restricted to some European countries and North African nations, Asian parts, notably China. Be that as it may be nations which were regularly looked for as nations of destination of trademarks ensured somewhere else, and also nations having a substantial residential exchange imprint base and hence inspired by sending out imprints, had stayed beyond the legislation of the Madrid Union⁴. This was genuine not just of such European nations as the United Kingdom, the Scandinavian nations and Greece, additionally of the United States and parts of Canada, Latin America (excluding Cuba), and the Asian countries, for example, India, Japan, Korea and so many more., and also Australia.

While initially the WIPO endeavors were centered around creating a correlation with the CTM regulation, in the recent piece of the 1980s the emphasis was on both of the deficiencies of the old Madrid system, the thought around then being to make two conventions to the Madrid Agreement, one for the connection with the CTM framework, the other for the augmentation of the participation.

The Madrid Protocol was received on 27 June 1989 and went into power on 1 December 1995 keeping in mind the end goal to manage the weaknesses of that of the Madrid Agreement. The Protocol got to be agent four months after the fact, on 1 April 1996, that day that the CTM framework came into use.⁵

Basic difference and points of comparison between Madrid Agreement and Madrid Protocol are the following:

Basis of Difference:	Madrid Agreement	Madrid Protocol
Basic of International	For registering a trademark	Under the Protocol, the applicant

⁵ Ladas & Parry, *Madrid Protocol- General Discussion*, <http://ladas.com/madrid-protocol-general-discussion/> (Last updated on 5th February 2015)

Registration	internationally under that of the Madrid Agreement, one is required to first obtain registration in his home country.	may base its application for international registration on an application filed with the home country's trademark office or a registration granted by that office.
Filing Language	Under the Agreement the working language is French. All applications shall be filed in French only.	In case of the Protocol, applications can be filed in English, French or Spanish.
Remedy to Central Attack	<p>Under the Madrid Agreement "central attack" may occur during the first five years of an international registration as follows: Where the basic application or basic registration has its scope of protection limited or eliminated during that time, under the Agreement the international extension registration were similarly limited or eliminated and there was no recourse for the owner of the international registration.</p> <p>The Madrid Agreement's "central attack" provisions are considered unfair by many trademark owners because many of the grounds available to reject oppose or move to cancel a domestic registration are not recognized in other countries.</p>	<p>However, under the Protocol. when an international registration is cancelled during its first five years due to failure of the basic application or basic registration, the international registration may be transformed into national (or regional) applications in each of the Contracting Parties in which the international registration had effect maintaining the priority date of the international registration. This possibility does not exist under the Madrid Agreement</p>
Time limit for refusal period	The time period for a contracting country to refuse the protection is 12 months under the Agreement. This is considered unfair as the expenses and process of registration	This time span for refusal was increased to 18 months in that of the Madrid Protocol.

	is very lengthy.	
Validity	Protection under the Agreement lasts for 20 years before being renewed.	Protection under the Protocol lasts for 10 years before being renewed.

MADRID PROTOCOL: REGISTRATION REQUIREMENTS AND PROCEDURES:

Administration and countries covered under this protocol: The Madrid Protocol is directed by the International Bureau of the World Intellectual Property Organization (WIPO) situated in Geneva, Switzerland. The International Bureau regulates the Madrid System and directs the transmittal of solicitations for security to all parties to the protocol. Till February 2013, 88 nations have become a member to the Madrid Protocol. These nations are called "Contracting Parties."

Who may apply for an International Trademark Registration? A Madrid application can be recorded by a natural individual, or legal entity, having genuine and successful modern or business foundation status, or being a domicile/resident of a Madrid Union Member Country. The Madrid Protocol permits candidates to pick the careful nations in which they look for assurance.

Where can an international trademark registration be filed? An International Registration application is recorded at the Bureau through the workplace of source of the essential national application or enlistment. It can't be documented straightforwardly at the Bureau. The Office of Origin in the nation of beginning looks at whether the worldwide application compares to a compulsory fundamental application or essential enlistment and conforms to home state necessities at first. The application ought to be gotten by the International Bureau from the Office of Origin Article 3 (4) of the Protocol inside of two months of that starting date of receipt of the application by the Office of Origin.⁶

⁶ Jerome Gilson & Anne Gilson, *Madrid Protocol: A Slumbering Giant awakens at last*, Lexis Nexis, <http://www.lexisnexis.com/practiceareas/ip/pdfs/MadridProtocolPamphlet.pdf> (last updated on 6th February 2015)

A “Basic application” defined under Section 36 B (b) of the Trade Marks (Amendment) Act, 2010 is an application for registration of a trademark filed under Section 18 of the Act, and which is considered as a ground for applying for an international registration.

What can be registered? The system enables the registration of trademarks in many jurisdictions worldwide that are part of Madrid Union’s 85 member nations by submitting a single application in the Applicant’s home country trademark office, or regional trademark office.

Language to be used: An international application may be filed in either English, French or Spanish.

Examination procedure by the office of the contracting party: Once an International Registration has issued, the Bureau will advise the trademark office of every contracting nations of the solicitation for an expansion of assurance to that nation/jurisdiction. It will then be analyzed by applicable national law. The national trademark office will concede security of the marks in that nation/jurisdiction if the application meets the nearby enlistment or registration necessities.

The Protocol does not change regional laws on the securing of trademark rights, application customs and utilization prerequisites. Examination of national assignments by national trademark workplaces stays subject to local practice and procedure.⁷ The trademark office of every contracting gathering is qualified for reject security in entire or partially. When a refusal notification has issued from the national trademark office, by and large the candidate is told either by the Bureau or through the candidate's operators, who has gotten the notification from the Bureau⁸.

Refusal of Protection based on Oppositions: Article 5 (2) (c) of the Madrid Protocol expresses that such refusal by the National Office of assigned nation in light of resistances can be made post the expiry of the 18 month time limit from warning receipt. A temporary refusal if proclaimed by a part state is recorded in the International Register by the

⁸ *id*

International Bureau, and further distributed in the International Gazette, alongside the transmission of a duplicate to the holder of the worldwide registration.

Term of Registration: After following the above procedures, a statement is sent to the International Bureau indicating that the refusal is confirmed, or totally withdrawn, or partially withdrawn. This statement is also recorded in the International Register and published in the Gazette. If no objection is received by the International Bureau from the designated Member States, within the prescribed time limit i.e. normally twelve months (extended to 18 months under the Protocol for India), or a grant of protection is issued by the Member State Office. The duration of protection granted by an international registration is 10 years, before which a renewal application must be filed to extend protection. A renewal grace period of 6 months may be granted under Section 36G (2) of the Act.

CHALLENGING INTERNATIONAL REGISTRATION:

The rights allowed by an International Registration can be smothered if: (a) its home application does not develop to registration or (b) its home enlistment is wiped out amid its initial five years (this idea is ordinarily alluded to as "central attack"), which is a particular burden.⁹

In spite of the fact that it would at present be conceivable to change the International Registration to national applications in the assigned contracting gatherings if the home application/enrollment is effectively tested, the aggregate expense would really be higher than if the national course had been utilized at the start. What's more, the changed national application may must be reconsidered once more by the national office, despite the fact that practice on this point may fluctuate.

The issue of "Central Attack" : As per the Article 6 of the Madrid framework a worldwide enrollment stays essentially for 20 years under the Madrid Agreement and for 10 years under the Madrid Protocol, at which times it must be restored to stay in effect. However, for a time of five years from the date of the worldwide registration , the IR's legitimacy stays subordinate upon the fundamental application or enrollment in the candidate's nation of root. This is ordinarily alluded to as the "reliance period". On the off chance that the IR's fundamental application or enrollment stop to have impact, in entire or to a limited extent, whether because of a complaint by the Examiner in the nation of beginning, or because of a

⁹ *id*

fruitful restriction or undoing activity, or because of intentional withdrawal or deserting by the trademark proprietor, then the worldwide enlistment, including the majority of its specialist expansions of assurance to the nations determined, will never again be substantial. Regardless of the possibility that the negation of the essential application or enrollment in the nation of starting point happens after the close of the five-year reliance period, the global enlistment and its specialist augmentations of insurance will in any case be refuted if the "activity" that brought about an official choice of dismissal, repudiation, crossing out or refutation initiated preceding the termination of the five-year reliance period. This is what is referred to under the Madrid framework as the "central attack" procurement.¹⁰

Replacement of already existing trademark: The Madrid Protocol procurement expresses that an officially existing trademark inside of any local domain to which Madrid framework wins, then the Madrid Registration will supplant the national enlistment. This procurement is equipped for making perplexity and hurting the enthusiasm of that of the previous right holder and they are cared for by that of the focal organization.

Narrowing Rights and Ownership Issues: Again on account of proprietorship we can see that vulnerability of the International Registration on the fundamental imprint for a long time from the date of the International Registration is autonomous of any progressions of possession. Given this, any documentation concerning a change of responsibility for fundamental mark inside of this five year period must embody suitable guarantees from the new proprietor so that the activity or inaction of the new proprietor does not hazard the International Registration.¹¹

There is no time breaking point to apply for a worldwide application once a national application/enrollment is pending or allowed. The worldwide application relies on upon a compulsory essential national application or enlistment the length of it is pending and substantial. On the off chance that either fall flat before the worldwide enlistment is allowed or inside of 5 years of the global enrollment being in all actuality, the universal application/enlistment will likewise get to be invalid. There is no particular procurement clarifying the system for managing resistances or answers between the Indian registry and the

¹⁰ *id*

¹¹ *PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS*, <http://www.tpe.gov.tr/TurkPatentEnstitusu/resources/temp/DF8F37DC-6F93-4254-B649-F52D0B23B7F0.pdf> (last accessed on 3rd February 2015)

worldwide candidate as to a universal application documented abroad and advised to India by the International Bureau for enrollment. Indian Trademark Rules additionally determine that a candidate ought to have a location for administration in India which will apply to International candidates once the Madrid Protocol is successfully actualized through the warning of the Amendment Act, 2010. Nothing in the correction demonstration determines resistance procedures in worldwide Madrid applications where India is an assigned nation. The Amendment demonstration expands the period for notification of restriction to 4 months. India will need to correct the trademark enlistment strategy rules for a smooth move into a Madrid framework technique and post alteration enrollment process.¹²

CONCLUSION:

In spite of the fact that trademark registration is not necessary, a noteworthy point of interest of enrollment is that it gives a statutory restraining infrastructure and constitutes by all appearances verification or proof according to law towards the making of a select right for the proprietor of the trademark.

The Protocol endeavors to strike a harmony between the need to regard a nation's trademark examination framework, a part of State Sovereignty, and the need to make an effective structure for universal trademark registration. It is obvious from the above breakdown that the Protocol does not influence any adjustment in the utilitarian procurements of the law inside of a nation.¹³ In the meantime, despite the fact that securing global trademark, insurance under the Madrid Protocol has numerous prizes, it is not an universal remedy. Every business element must measure the upsides and downsides of documenting their marks under the Madrid Protocol in every condition and every nation, before continuing. The Protocol gives a framework to a financially savvy technique for acquiring trademark assurance in numerous businesses around the globe, upgrading the capacity of the endeavors in India to work together abroad in specific domains. While considering the financial development accomplished by India in the most recent couple of years and enthusiasm among the outside speculators, the increase of the Madrid Protocol is one of the most ideal approaches to

¹² Gilson, *Supra*, note 6

¹³ WIPO, *The Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to that Agreement: Objectives, Main Features, Advantages*, http://www.wipo.int/edocs/pubdocs/en/marks/418/wipo_pub_418.pdf (last updated on 4th February 2015)

advance the worldwide exchange. Understanding the framework and its constraints, and the numerous accessible alternatives, on the other hand, is pivotal to building up the best system for the universal registration of marks.

The Madrid System offers various advantages to those searching for worldwide trademark security. In light of present circumstances, there are a couple of traps, and if the Madrid application is going to name a pending application rather than a recognized and enrolled trademark, it is fundamental that exhaustive trademark searches are done in advance.

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