

**Government of India  
Department of Industrial  
Policy and Promotion  
Ministry Of Commerce and  
Industry**



**Office of the Controller  
General of Patents, Designs &  
Trademarks**

# **International Registration of Trademarks under the Madrid Protocol**

# Madrid System

- The Madrid system provides one single procedure for the registration of trademarks in several territories.
- It is governed by two treaties, *'the Madrid Agreement concerning the international registration of marks'* (briefly known as Madrid Agreement) and the *'Protocol relating to the Madrid Agreement'* (briefly known as Madrid Protocol).
- These treaties are administered by the International Bureau (IB) of the World Intellectual Property Organisation (WIPO) in Geneva, Switzerland.

# Advantages of the Madrid system

- One international application based on a basic application/registration
- One language (English, French or Spanish)
- One set of fees in one currency (CHF)
- One registration number and one renewal date
- The registration can be further extended geographically
- All subsequent changes to the international registration may be recorded with the IB and have effect through one single procedure
- Offices do not need to examine for formal requirements

## **‘Basic registration’ and ‘Basic application’**

- Under the Madrid Protocol, an international application may be based on either a **mark that has already been registered** (“basic registration”), or a **mark that has been applied for but not yet registered** (“basic application”)
- The international application can be filed only in respect of goods and/or services covered by the basic application or registration.

## **Contracting Party**

- The term “Contracting Party” denotes any country as well as any inter-governmental organization (the European Union, for instance) which is party to the Madrid Protocol.

## Where can the list of Contracting Parties to the Madrid Protocol, be found?

- The list of members can be found at -

[http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid\\_marks.pdf](http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/madrid_marks.pdf)

- The list of members is also available on form MM2, the application for international registration of mark.

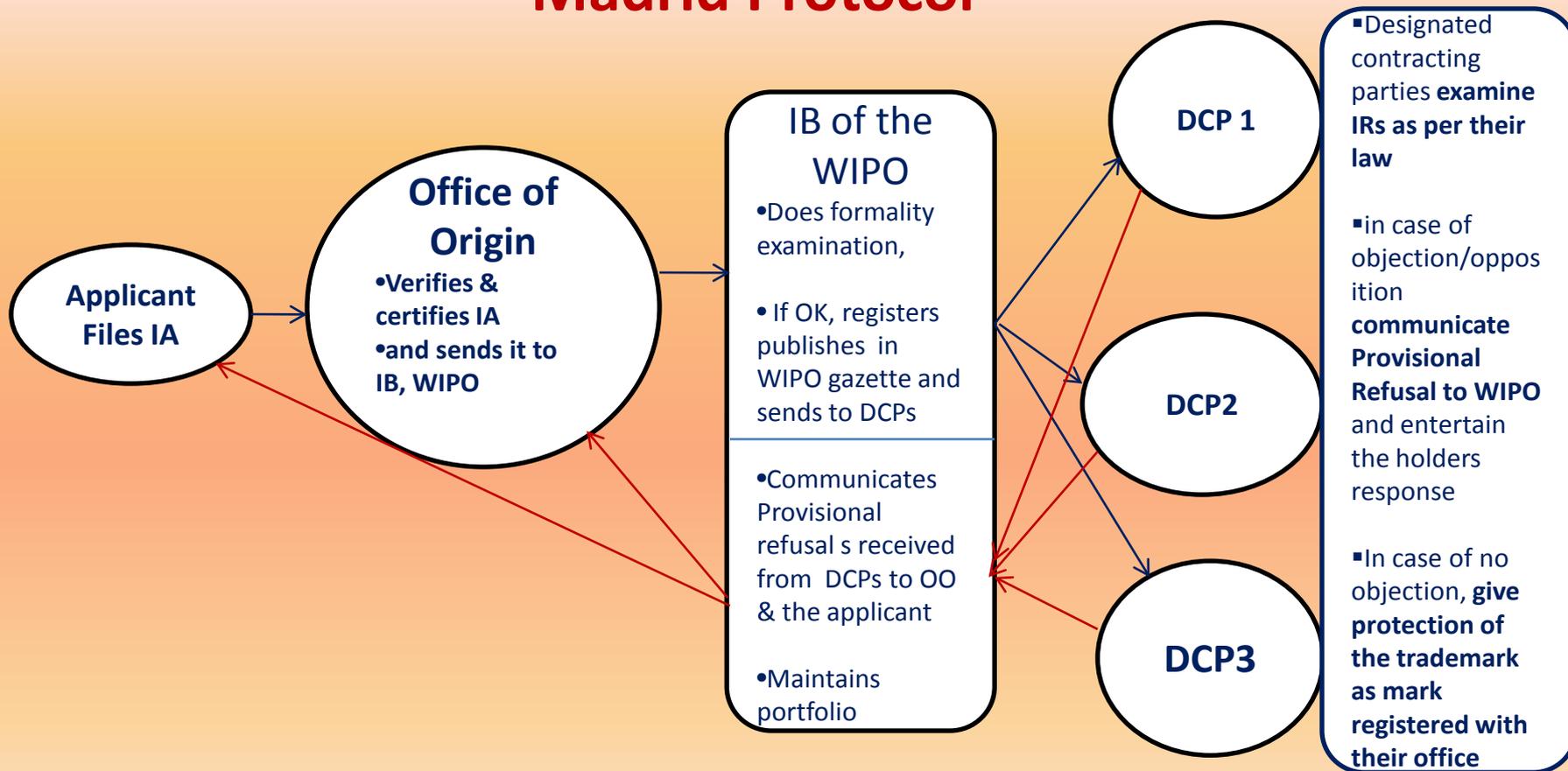
# Office of Origin

- The Office of origin is the trademark office of the Contracting Party with which the applicant for international registration has the necessary connection (through establishment, domicile or nationality) to be entitled to file an international application.
- The international application is received at the Office of Origin and it is forwarded to the WIPO, through it.

## **Designation and subsequent designation**

- A “designation” means an **indication** in the international trademark application form, **of one or more Contracting Parties where the protection of the mark is intended** .
- A “subsequent designation” means an extension of the geographical scope of protection after the mark has already been registered.
- A subsequent designation is made by completing the appropriate form, indicating therein the additional Contracting Parties for which protection is sought.

# Procedure for international registration under the Madrid Protocol



## **Dependence on the Basic Mark**

- An international registration **remains dependent** on the mark registered or applied for in the Office of origin, **for a period of five years from the date of its registration.**
- **If, and to the extent that, the basic registration ceases to have effect or the basic application is refused or withdrawn or treated as abandoned within the five-year period, the international registration will no longer be protected.**

## **Transformation**

**Where the international registration is cancelled because of extinction of basic application or registration and**

**the person who was the holder of the international registration files an application for the registration of the same mark with the Office of any of the Contracting Parties in the territory of which the international registration had effect,**

**that application shall be treated as if it had been filed on the date of the international registration**

**Provided that such application is filed within three months from the date on which the international registration was cancelled, and such application complies with all the requirements of the applicable law, including the requirements concerning fees.**

## **Replacement of a National Registration by an International Registration**

An international registration is deemed to replace a national registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party.

## **India's accession to the Madrid Protocol**

- **On April 8<sup>th</sup> of 2013, the Hon'ble Minister of Commerce & Industry, the Government of India, deposited the instrument of accession to the Madrid Protocol, with the Director General of the WIPO.**

**and accordingly, the provisions of international registration under the Madrid Protocol came into effect in India since July 8<sup>th</sup> of 2013**

## India as an Office of Origin

- **A person (including a legal entity)**
  - **who is a citizen of India, or domiciled in India, or**
  - **who has a real and effective industrial or commercial establishment in India, and**
  - **who has got a registration of a trademark or whose application for registration of trademark is pending in Indian office ,**  
**may make application for international registration of his trademark**
- **Application must be filed only through the gateway for on line filing of International applications made available at the official website [www.ipindia@nic.in](mailto:www.ipindia@nic.in), with handling fee of INR 2000/**
- **The Trade Marks Registry (TMR) verifies as to eligibility of the applicant and contents of the International Application vis-à-vis basic registration/application**
- **When the International Application is not proper, the TMR sends a deficiency letter at the email of the applicant. The applicant shall prepare a reply to the deficiency letter and upload it, with supporting documents, if any, through the gateway.**

- **When the International Application is proper the TMR certifies and transmits such applications to the International Bureau of WIPO.**
- **The fee for international application and the individual fee/Complementary fee for designated countries wherever applicable is to be paid directly to the International Bureau of the WIPO, in Swiss Francs**
- **The IB of WIPO examines such applications for formalities.**
- **In case any irregularity (regarding classification of goods or services, for instance) is found, the IB communicates such irregularities to the TMR as well as to the applicant.** The TMR also sends the irregularities to the applicant by email. The applicant has to rectify irregularities and prepare a reply to the irregularity letter, and upload it, with supporting document, if any, through the gateway. The TMR sends response to irregularities to the International Bureau of WIPO
- **If the International Application is found to be proper by the IB of the WIPO. It is registered with the IB, published in the WIPO gazette and transmitted to the offices of the designated Contracting Parties.**

## **Communication as to ceasing of effect**

Where the basic application or basic registration mentioned in the international application ceases to exist within the period of five years from the date of international registration, the TMR shall notify this fact to International Bureau of WIPO.

Where these facts and decisions affect only some of the goods and services covered by the international registration, the communication shall indicate which goods and services are affected or which goods and services are not affected.

The International Bureau records such notifications in the International Register, and transmits copies of the notification to the holder and to the Offices of the designated Contracting Parties. Where the notification requests cancellation of the international registration, it is so cancelled, to the extent applicable; the International Bureau notifies accordingly the holder and the Offices of the designated Contracting Parties

# India as an office of a Designated country

- In case of an international applications designating India, is published as registered by WIPO and the same is notified to India, **the particulars of international applications are recorded in TMR data base, by giving a national number to it as IRDI xxxxxx** equating the date of international registration of IRDI with the date of application for a national application
- **The IRDI shall be examined as a national application** as per provisions of the Trade Marks Act & Rules.
- **In case of any objection, a provisional refusal shall be communicated to WIPO.** The WIPO communicates the provisional refusal to the applicant of the international application (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 **only through an Indian agent.** The post examination process will be similar to that as in case of national application objected at examination stage.
- **In case of no objections, it will be published in the Trade Marks Journal**

- **Any person may file notice of opposition to so published IRDI, as any other published national application.** The Notice of Opposition should be filed on-line through the gateway available at the website
- **On receiving any opposition to the IRDI, the TMR will communicate to the WIPO, a provisional refusal based on the opposition.** The 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 , only through an Indian agent.** The opposition proceeding shall then be conducted as per usual process.
- **In case no opposition is received within the prescribed period and there has been no grounds for refusal, the TMR will notify the Grant of Protection of the international registration, to the WIPO.**

## **Renewals and changes & corrections in the international registrations**

- The international registrations of marks under the Madrid System is done and maintained by the International Bureau of WIPO, accordingly the renewals of international registrations and amendments or corrections in the international registrations are done by the WIPO
- The registration of a mark at the International Bureau is for a period of 10 years. It is then renewable for a further 10 years upon payment of the required fees to the WIPO.
- A request to record a change in name or address of the holder of international registration is presented to the International Bureau of WIPO. The International Bureau records the change of name or address in the International Register and notifies accordingly the Offices of the designated Contracting Parties. At the same time, it informs the holder and, where the request was presented by an Office, that Office

## **Guidelines for functioning under the Madrid Protocol**

- A document titled as 'Guidelines for functioning under the Madrid Protocol' is put up on the home page of official website of the CGPDTM-  
[www.ipindia.nic.in](http://www.ipindia.nic.in)

## Attending to queries and problems

- Queries and problems relating to the functioning of the Madrid Protocol in India may be sent to the **International Registration wing** of the **TMR** at [madrid.tmr@nic.in](mailto:madrid.tmr@nic.in)
- A telephone call for Queries or problems relating to the functioning of the Madrid Protocol may also be made at-  
+91 22 24134555  
+91 11 25300290