

PROTECTION OF TRADEMARKS: TREATIES AND REGISTRATION

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1.0 Introduction

Trademarks may be one or more combinations of words, letters, and numerals. They may also consist of drawings, symbols, three dimensional signs, audible signs, colors, or scents. The types of trademarks protected vary from country to country.

Trademark owners doing business internationally should adequately exploit their trademark rights to maintain or increase the reputation and value of their mark and seek to protect those rights in jurisdictions where commercial use of the mark is being or will be made. They must also develop an awareness of the significance of their mark outside any country's boundaries, given the increasing presence of brands in the global market, in order to protect the markets for their goods and services as they introduce their brands to new markets. Consequently, trademark owners need to adopt an international trademark strategy to control, preserve, and protect their rights worldwide.

2.0 Treaties Relating to Protection of Trademarks

2.1 Madrid System/Madrid Protocol

The Madrid system (officially the Madrid system for the international registration of marks) is the primary international system for facilitating the registration of trademarks in multiple jurisdictions around the world. Its legal basis is the multilateral treaty *Madrid Agreement Concerning the International Registration of Marks* of 1891, as well as the *Protocol Relating to the Madrid Agreement* (1989).

Two significant recent developments in international trademark law were the accession of the United States and the European Union to the Madrid Protocol on November 2, 2003, and October 1, 2004, respectively. With the addition of these jurisdictions to the protocol, most major trading jurisdictions have joined the Madrid system.

On 31 July 2015, Algeria deposited its instrument of accession and will accede to the Madrid Protocol on 31 October 2015. As Algeria was the last member of the Madrid system to adhere to the protocol, the protocol is now effective across the entire Madrid system.

The protocol relating to the Madrid Agreement aims to make the Madrid system more flexible and compatible with the domestic legislation of certain countries or intergovernmental organizations that had not been able to accede to the agreement. States and organizations party to the Madrid system are collectively referred to as contracting parties. Thus, this system makes it possible to protect a mark in a large number of countries by obtaining an international registration that has effect in each of the designated contracting parties.

Both the protocol and the agreement are governed by the WIPO. The aim of the Madrid system is to streamline the process of obtaining global trademark protection. The Madrid agreement and the Madrid protocol are independent yet parallel treaties with separate but overlapping memberships.

Registration of a mark under the agreement provides for legal equivalent of registration in member countries designated by the mark owner. India being a signatory of the Madrid Protocol, an applicant while making an application to National office may select from the list of member countries where he seeks protection of mark. The National office in the country of origin examines whether the international application corresponds to the basic application and complies with home state requirements. The national office being satisfied, it forwards the application to WIPO. On fulfilling the formalities like examination, advertisement for approval and opposition the mark is registered in the selected member countries. Registration term under the protocol is for 10 years which can be renewed for further 10 years. There is a provision for a “central attack” under the Madrid protocol under which if any application to the WIPO under the protocol is rejected in the country of origin itself at the discretion of the National Office or an opposition, the application is then treated as rejected by all member states designated in the application, in which the applicant seeks protection.

2.1.1 Advantages of Madrid Protocol

1. Lower costs compared to individual foreign filings
2. Managing renewals, change in address, change in ownership is easier and more cost-effective
3. Additional countries may be designated at a later stage
4. One application in one language;
5. Payment of one set of fees;
6. Seek protection of the mark in 90+ countries;

7. Seek protection of the mark in new countries that become members of the Madrid system subsequently;
8. Automatic registration in designated countries if the trademark office does not raise an objection in 12 or 18 months;
9. Any change of applicant/ownership information, limiting goods and services, renewal of the registration, assignment/license of rights in one or more jurisdictions can be made by just filing a single application.

Sr no.	Madrid Agreement	Madrid Protocol
1. Basic of an International Registration	Application can only be filed after the national registration is complete	Application can be filed even if the national application is pending
2. Time Limit for Refusal Period	Trademark office has to inform the international bureau within 12 months if objection is raised	Each Trademark office can opt for 18 months period or even in longer in case of refusals based on opposition
3. Term of Protection	Term of registration is 20 years and then subject to renewal	Term of registration is 10 years and then subject to renewal
4. Conversion to National Application	International application cannot be converted to national application if any national application on which the international registration is based is refused withdrawn or cancelled	Application can be converted if into national application if it retains the date or priority date of the international registration
5. Membership of EU	EU is not a party to the agreement	EU is a party to the Protocol

2.2 Nice Agreement Concerning The International Classification Of Goods And Services For The Purposes Of The Registration Of Marks (1957)

An international system for classification of goods and services for registration and protection of trademark and service marks is established by the Nice Agreement concerning the International Classification of Goods and Services. This agreement is an outcome of the diplomatic conference held at Nice, France in 1957. It provides for 45 classes out of which 34 classes are for goods and 11 classes are for services. This classification is updated every five years. This agreement is open to the states that are party to the Paris convention. There are at present 83 countries that are party to the agreement. Apart from this, there are trademark offices of at least 147 States, as well as the International Bureau of WIPO, the African Intellectual Property Organization (OAPI), the African Regional Intellectual Property Organization (ARIPO), the Benelux Organisation for Intellectual Property (BOIP) and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of the European Communities, actually use the Classification that uses Nice classification without being party to it. The trademark offices of the contracting States must indicate, in the official documents and publications in connection with each registration, the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong. The Agreement, concluded in 1957, was revised at Stockholm in 1967 and at Geneva in 1977, and it was amended in 1979. India follows the International Classification of Goods and Services (Nice Classification) under the NICE Agreement administered by WIPO. The Nice Classification is embodied in the Fourth Schedule of the Trade Mark Rules, 2002 which lays down the broad classification of goods or services for which marks can be registered in India. Keeping itself abreast with the latest editions of the Nice Classification, India has introduced associated changes to its trademarks law from time to time. The latest amendment to the Fourth Schedule of the Trade Mark Rules was made in May, 2010, which introduced 3 additional classes of services.

3.0 Trademark Registration in India

1. Trademark Search

This is conducted by a professional from the trademark database. This search will reveal all information about an identical trademark that has already been filed with the Trademark authorities. A trademark search report is formulated on the basis of this.

2. Trademark Filing

After the formulation of the search report, application for registration will be made. The application shall be in the manner as prescribed by the govt and has to be filed alongwith requisite Govt fees. This application can be filed online. An application shall contain the following mandatory details:

- Logo/mark/tagline or the mark
- Name & Address of owner (individual/company/firm)
- Classification of Trademark class
- Date since which the logo/mark/tagline is used
- Description of goods/services

Once the application is filed, the registry will issue an official receipt with the filing date and number allotted to the application. Although the official process of trademark registration in India ranges from 18-24 months, priority of application is allotted as per this acknowledgement number. Further, the applicant can start using the TM symbol on receiving this application number.

3.Vienna Code Classification

The Vienna Codification was established by the Vienna Agreement (1973). It is an international classification of figurative elements of marks. Vienna code classification is the next stage after filing of the application. In this stage, Registrar will apply the Vienna classification to the trademark based on the figurative elements of the mark. You can understand that your application is in this stage when the status of your application shows “Sent for Vienna Codification”.

4.Examination

This is the next stage after Vienna Codification. Upon completion of Vienna Codification, the application will reach the desk of a designated Trademark Officer (TO). The TO has the right to either accept the application and send it over to the next stage or raise objections. The TO reviews the application and issues an examination report for this purpose.

If the application is objected to by the TO, the applicant may appear before him and present his plea. If the TO is satisfied by the representation, he will approve the application and send over to the next stage. If he is not satisfied, he will not pass the application. The applicant further has a right to appeal against this objection with the Intellectual Property Appellate Board.

5.Journal Publication

This is the next stage after the application is passed by the TO, wherein the proposed trademark is published in the Trademark Journal. The Trademark journal is published every week. Once

the mark is published in the Journal, public has an opportunity to object to it if they have substantial grounds. The third party has to file the trademark opposition within 3 months (extendable by 1 month) from the date of publication of the trademark. Registration of a mark can be opposed by any person on any of the grounds enumerated under Sections 9, 11 and 18 of the Act. The opposer can file, as a ground of opposition that the mark applied for registration is:

- i. Not distinctive
- ii. Not capable of distinguishing
- iii. Descriptive
- iv. Has a direct reference to the character and quality of the goods.
- v. Is a geographical term which in its ordinary significance has come to be known for a particular kind of quality of goods.
- vi. It comprises or contains scandalous or obscene matter or its use is prohibited under the Emblems and Names (Prevention and Improper Use) Act, 1950.
- vii. Its identity with the earlier trade mark and/ or similarity of the goods covered by the earlier mark.
- viii. The use thereof is likely to cause confusion and / or deception and is liable to be prevented under the laws of passing off or by virtue of law of copyright.
- ix. A person applying for registration is not the proprietor of the mark and the application has been filed in back date.

If the mark is objected to, a hearing is held by the Trademark Hearing Officer. In this hearing both the parties are given a fair representation to present their cases. Upon hearing both parties and based on evidences, the hearing officer will give his judgement.

The decision of the Registrar made in the opposition proceedings can be challenged by the aggrieved person by filing an appeal before the Intellectual Property Appellate Board, which has been constituted for the first time under the provisions of The Trade Marks Act, 1999. Prior to the coming into force of the Trade Marks Act, 1999, the jurisdiction to entertain such appeals vested with the High Courts having jurisdiction over the respective offices of the Trade Mark Registry in Delhi, Chennai, Mumbai, Kolkata and Ahmedabad. The provision of second appeal against the order of Registrar that was available under The Trade & Merchandise Marks Act, 1958 has been repealed under the new Act of 1999.

6. Trademark Registration

If there are no oppositions within 4 months from the date of advertisement in the Trade Marks Journal, then the trademark registration certificate will be issued. The registration when granted is valid for a period of ten years from the date of registration (i.e. the date of application). It is imperative for a proprietor to seek renewal of registration before the expiry of the validity, failing which the mark becomes liable to be removed from the Register on account of non-renewal. The request for renewal of a trademark can be filed six months prior to the expiry of the validity of registration. The law also permits renewal and restoration of lapsed trademark provided such a request is made within the maximum period of one year after the expiry of the validity. If the registered proprietor of the trademark is not vigilant in renewing the registration either prior to the expiry or within one year after the expiry of validity, the mark shall stand removed from the register of trademark and would not qualify to be renewed. In such a scenario, the proprietor will have no other option but to file a fresh application for registration and to go through the same procedural requirements as if the said application was a fresh application for registration. Section 26 of the Act, however, protects the right of the registered proprietor for a period of one year after the date of removal against third party's claim to registration.

4.0 Process of Filing International Trademark

India has joined the Madrid protocol with effect from 8th July 2013. The Madrid system for the international registration of trademarks provides one single and cost-effective procedure for the registration of a mark in several territories.

At present, there are 91 countries which are members of the Madrid protocol.

In order to file an international application under the Madrid protocol, there should be a corresponding trademark application filed in India.

In a single international application under the Madrid protocol, several countries may be designated which are members of this system. The fees will depend based on the number of classes and countries designated.

In addition, a handling fee of Rs. 2,000/- is payable to the Indian Trade Mark Registry.

Upon filing the application, the mark is examined by each designated member country where registration is sought and then proceeds to registration.

An international registration under Madrid protocol is however dependent on the corresponding Indian application for a period of five years from the date of international application.

If you wish to obtain registration in a country which is not a member of the Madrid protocol, separate national trademark application has to be filed directly in the respective country.

5.0 Trademark Protection In The Trips Agreement

Articles 15 to 21 of TRIPs lay down the rules for protection of trademark. It is obligatory for the member state to enforce the principles regarding conditions and content of protection of trademark as laid down in articles Art. 15. It provides for simple definition of trademark stating that any sign or any combination signs, capable of distinguishing the goods or services of one undertaking from those of other undertaking, shall be capable of constituting a trademark. This definition very clearly conveys that the agreements on TRIPs provides for both trademarks attached to goods as well as service marks indicating services on the equal footing. It is very specifically provided under the TRIPs that the signs that are not inherently capable of distinguishing the relevant goods or services may be assessed on the condition of its distinctiveness acquired through use. This in turn does not prevent the member state from denying registration of a trademark on other grounds, provided that they do not derogate from the provision of the Paris convention. While appreciating the registration of a mark on its use the TRIPs agreement stipulates that actual use of a trademark shall not be a condition for filing of an application for registration. It further adds that an application shall not be refused solely on the ground that intended use has not taken place before the expiry of a date of application. Further, it is provided that it is obligatory for the member state to publish the trademark either before it is registered or immediately after registration and to provide for reasonable opportunity for application of opposition for cancellation of such trademark.

The major changes or amendment introduced can be summarized as follows:

1. The Bill prescribes a period of 18 months within which a trade mark has to be registered.
2. The Controller-General of Patents, Designs and Trade Marks is the Registrar of Trade Marks, appointed with any other officers deemed fit, by the central government. The Bill empowers the Registrar of Trade Marks to deal with international applications originating from India as well as those received from the International Bureau and maintain record of international registrations.
3. If an international registration originates from India the registered proprietor or applicant may make an international application on a prescribed form. If the person holds an international registration, he may make an international application on the prescribed form for such registration to any other contracting party.
4. Reduction of the time period of filling of notice of opposition of published applications to three months.
5. The Bill simplifies the provision related to transfer of ownership trade marks by assignment or transmission.

If a person becomes entitled to a registered trade mark by assignment or transmission, he shall apply in

the prescribed manner to the registrar to register his title. However applicant may be asked to furnish further evidence only where there is a reasonable doubt about the veracity of any statement or document.

6.0 Principles Relating to the Substance of Protection

National Treatment Principle

The principle of national treatment is applicable to all industrial property rights. The principle generally states that a member state may not subject foreigners benefiting from the Paris Convention to higher industrial property protection standards than those applicable to its own citizens. In addition, it is not necessary to justify that a trademark has been registered in the country of origin prior to registering it in another member state. For example, if a citizen or corporation of Singapore wishes to obtain an industrial property right in France, where both countries are Paris Convention member states, the Singapore national will obtain the right under the same conditions as a French citizen or corporation. The same outcome results at a multilateral level. To understand fully the practical impact of the national treatment principle, it is necessary to understand that a member state may refuse industrial property rights protection to citizens or corporations of states that are not members of the Paris Convention. A member state may also subject non-member protections to stricter conditions than those applicable to its own nationals. For instance, because Thailand has not ratified the Paris Convention, a member state of the Convention could refuse to protect industrial property rights claimed by Thai citizens or corporations. A member state could also subject protection for these non-members to a condition of reciprocity, residence, the payment of a supplementary fee, or anything else. The national treatment principle was the first elementary and efficient rule aimed at facilitating the international protection of industrial property rights. This principle, asserted in 1883, has now been introduced into TRIPS and applies between all TRIPS member states.

7.0 Conclusion

The implementation of the Madrid system in India will be accompanied by increase of staffs in Trade Mark offices, growth of IT infrastructure, trained professionals, etc, the possible consequence of such change in the structure will be increment in the cost of filling domestic applications. The local and the government trademark attorneys may lose out to this change, as there is a considerable chance of reduction of local filings. To conclude it cannot be said that the only way out for protection of trademark at international level is Madrid Protocol but it is the best available option at this present moment.