



**INTELLECTUAL
PROPERTY INDIA**

Patents | Designs | Trademarks
Geographical Indications



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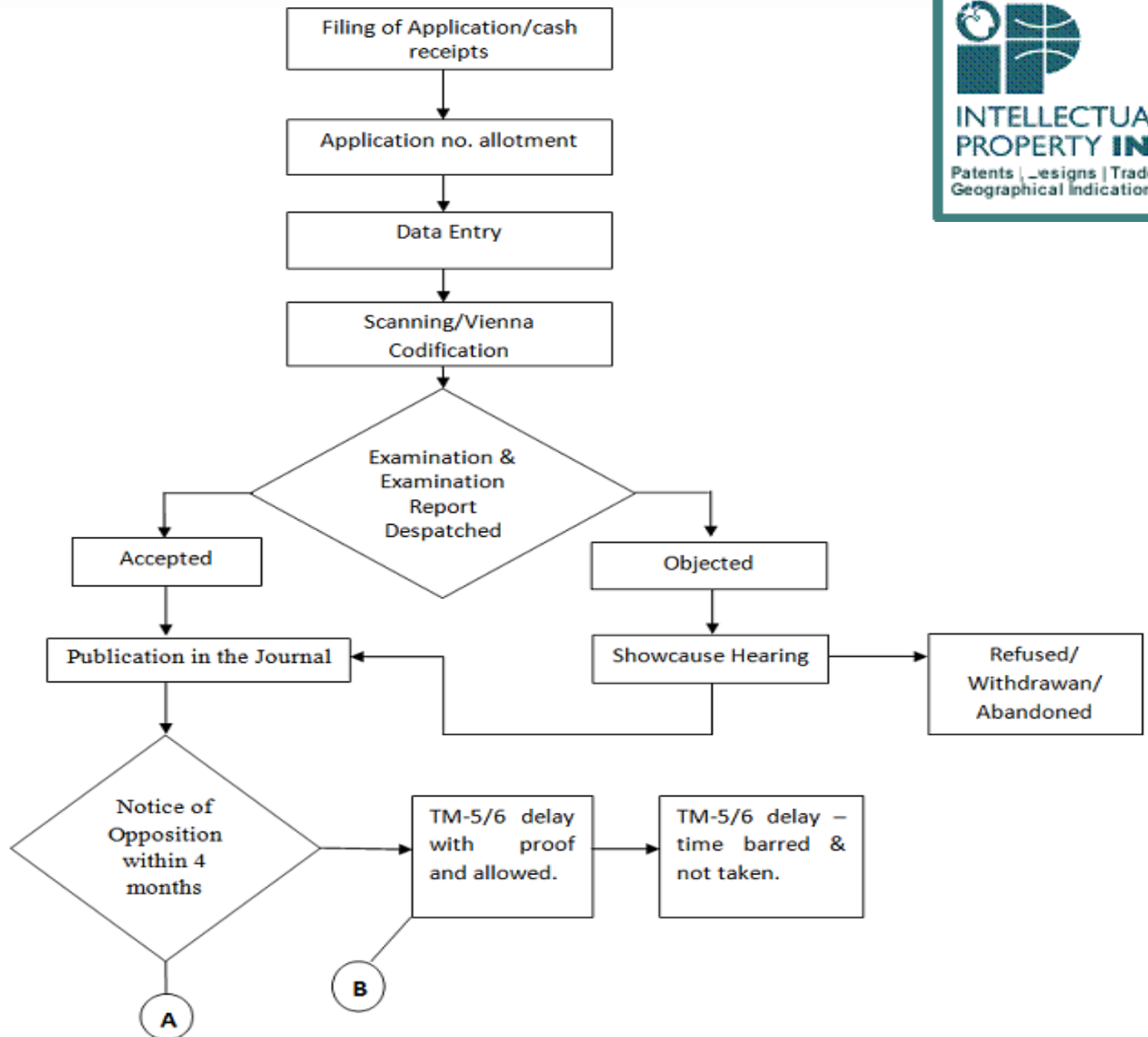


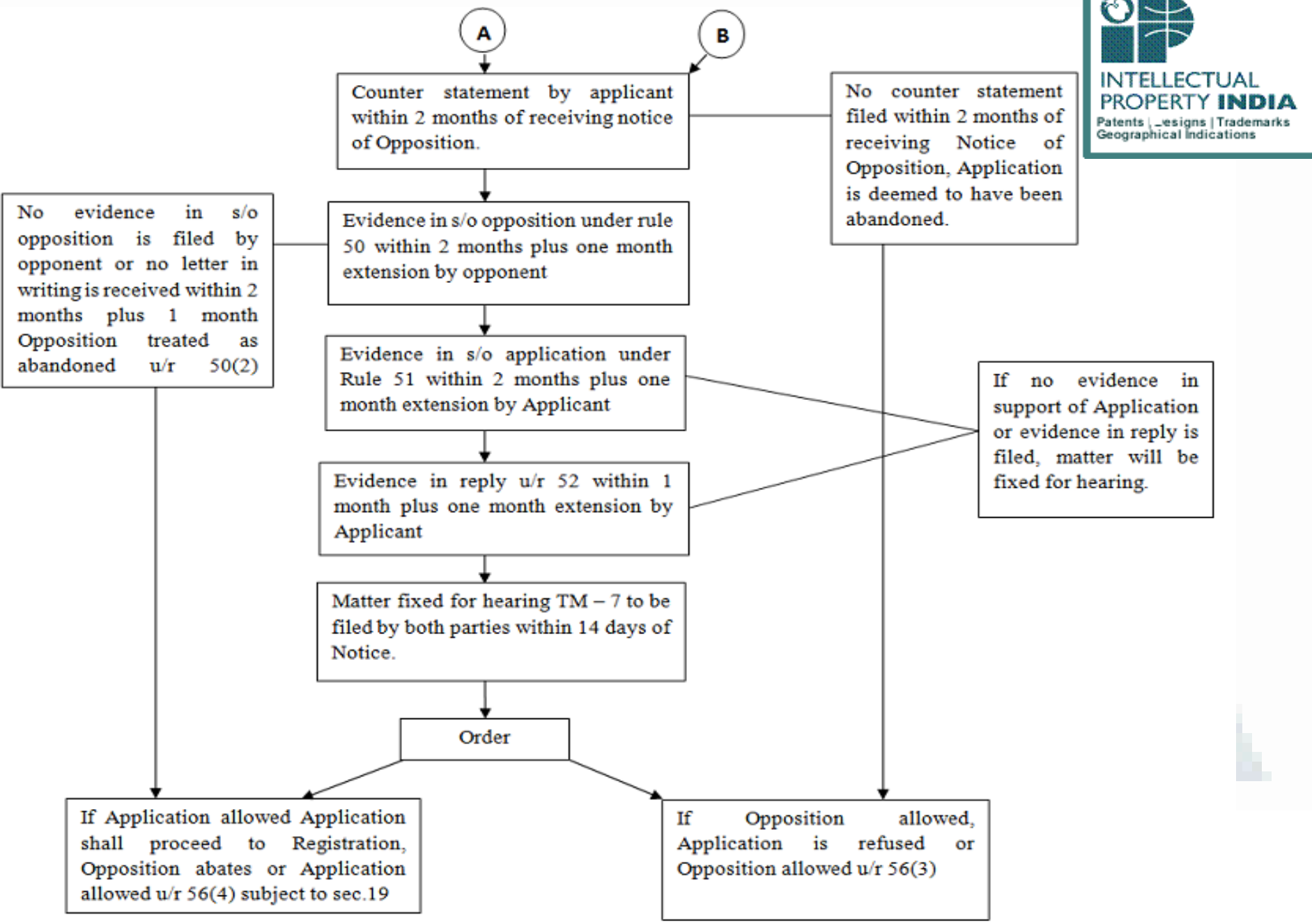
**INTELLECTUAL
PROPERTY INDIA**

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**POLICY CONSIDERATIONS WHEN
ASSESSING ACCESSION TO THE
MADRID PROTOCOL AND THE MAIN
POLICY AND LEGAL CHALLENGES
FACING THE MADRID PROTOCOL.**

**OFFICE OF THE CONTROLLER GENERAL
OF PATENTS, DESIGN AND TRADEMARKS.**





Trend of applications filed from 2007-08 to 2013-2014

Year	Indian Applicants	Foreign Applicants	Total
2007-08	1,17,014	6,500	1,23,514
2008-09	1,19,371	10,801	1,30,172
2009-10	1,34,403	7,540	1,41,943
2010-11	1,67,701	11,616	1,79,317
2011-12	1,69,602	13,986	1,83,588
2012-13	1,79,435	14,780	1,94,216
2013-14	1,84,140	15,865	2,00,005

AZERA

Priority claimed from 20/08/2013; Application No. : 4020130055832 ;Republic of Korea

2704093 01/11/2013

[International Registration No. : 1189354]

HYUNDAI MOTOR COMPANY

231, YANGJAE-DONG, SEOCHO-GU SEOUL REPUBLIC OF KOREA

Proposed to be Used

IR DIVISION

MODEL CARS; TOYS; SCALE MODEL VEHICLES; TOY VEHICLES; BOARD GAMES; TENNIS BALLS.

INCIPIO

Priority claimed from 25/06/2013; Application No. : 85969267 ;United States of America

2704183 15/10/2013

[International Registration No. : 1182298]

INCIPIO TECHNOLOGIES, INC.

6001 OAK CANYON IRVINE CA 92618 UNITED STATES OF AMERICA

Proposed to be Used

To be associated with:

2579317

IR DIVISION

AUDIO HEADPHONES; AUDIO EARPHONES; AUDIO CONNECTION CABLES; VIDEO CONNECTION CABLES; BATTERY CHARGERS; COMPUTER CARRYING CASES.

Priority claimed from 26/04/2013; Application No. : 30 2013 029 466.1/07 ;Germany
2704228 23/10/2013

[International Registration No. : 1189855]

KIESLING MASCHINENTECHNIK GMBH
MAINSTRASSE 20 63128 DIETZENBACH GERMANY

Proposed to be Used

IR DIVISION

Cl.7;SEPARATORS [MACHINES]; METAL DRAWING MACHINES; " BENDING MACHINES; PRINTING MACHINES FOR USE ON SHEET METAL; DRILL CHUCKS [PARTS OF MACHINES]; DRILLING HEADS [PARTS OF MACHINES]; DRILLING BITS [PARTS OF MACHINES]; DRILLING MACHINES; LATHES; COMPRESSED AIR MACHINES; COMPRESSED AIR ENGINES; PRINTING MACHINES; PRINTING ROLLERS FOR MACHINES; PRESSURE VALVES; BRUSHES, ELECTRICALLY OPERATED; SPEED GOVERNORS FOR MACHINES, ENGINES AND MOTORS; FILTERS [PARTS OF MACHINES OR MOTORS]; MILLING MACHINES; GEAR BOXES OTHER THAN FOR LAND VEHICLES; ENGRAVING MACHINES; ELEVATING APPARATUS; STITCHING MACHINES; SIZING MACHINES; NOTCHERS [MACHINE TOOLS]; PISTON SEGMENTS; BALL BEARINGS; BEARINGS [PARTS OF MACHINES]; AIR FILTERS FOR ENGINES; MACHINES FOR PROCESSING OF PLASTICS, METAL AND WOOD; METAL PROCESSING MACHINES; RIVETING MACHINES; CONTROLS (PNEUMATIC) FOR MACHINES, MOTORS AND ENGINES; DIE-STAMPING MACHINES; PUMPS [BEING PARTS OF MACHINES OR ENGINES]; MACHINE WHEELWORK; TRUING MACHINES; SHARPENING WHEELS [PARTS OF MACHINES]; SAW BLADES [PARTS OF MACHINES]; VALVES [PARTS OF MACHINES]; CUTTERS [MACHINES]; CHUCKS [PARTS OF MACHINES]; JIGS [MACHINES]; CLEANER BAGS CONTROL MECHANISMS FOR MACHINES, ENGINES OR MOTORS; CONTROL CABLES FOR MACHINES, ENGINES OR MOTORS; SWAGING MACHINES; TRANSMISSIONS FOR MACHINES; TOOLS [PARTS OF MACHINES]; FANS FOR MOTORS AND ENGINES; HOLDING DEVICES FOR MACHINE TOOLS; MACHINE TOOLS; CYLINDERS FOR MOTORS AND ENGINES; PISTONS FOR CYLINDERS; MACHINES FOR PROCESSING OF ALUMINUM.

Cl.35;PROCUREMENT SERVICES FOR OTHERS [PURCHASING GOODS AND SERVICES FOR OTHER BUSINESSES]; ONLINE RETAIL SERVICES IN THE FIELD OF MACHINES, TOOLS AND METAL GOODS, ELECTRIC AND ELECTRONIC GOODS; ONLINE WHOLESALE SERVICES IN THE FIELD OF MACHINES, TOOLS AND METAL GOODS, ELECTRIC AND ELECTRONIC GOODS; RETAIL SERVICES IN THE FIELD OF MACHINES, TOOLS AND METAL GOODS, ELECTRIC AND ELECTRONIC GOODS; WHOLESALE SERVICES IN THE FIELD OF MACHINES, TOOLS AND METAL GOODS, ELECTRIC AND ELECTRONIC GOODS; ONLINE OR MAIL ORDER TRADING SERVICES IN THE FIELD OF MACHINES, TOOLS AND METAL GOODS, ELECTRIC AND ELECTRONIC GOODS.

Cl.42;DESIGN AND DEVELOPMENT OF COMPUTER HARDWARE AND SOFTWARE; UPDATING OF COMPUTER SOFTWARE; COMPUTER SYSTEM ANALYSIS; SERVICES OF A TECHNICAL MEASURING AND TESTING LABORATORY; MECHANICAL ANALYSIS; TECHNICAL RESEARCH; SCIENTIFIC RESEARCH; SURVEYING; TECHNICAL RESEARCH; MECHANICAL RESEARCH; INSTALLATION AND MAINTENANCE OF SOFTWARE; SIZING AND FUNCTIONAL TESTING OF MEASUREMENT DEVICES; CONSTRUCTION DRAFTING; MATERIAL TESTING IN THE FIELD OF MECHANICAL ENGINEERING; QUALITY CONTROL IN THE FIELD OF MECHANICAL ENGINEERING; TECHNICAL CONSULTING IN THE FIELD OF MECHANICAL ENGINEERING; TECHNICAL PROJECT STUDIES IN THE FIELD OF MECHANICAL ENGINEERING; MATERIAL TESTING; TECHNICAL PLANNING OF AUTOMATION.

Need for India's accession to the Madrid System

Today, the whole world has become a global village.

Indian entrepreneurs are making their presence in international market.

Value and reputation of Indian trademarks in the international market is increasing day by day.

Indian business men have to register their trademarks in different territories in order to protect them.

In that situation, one needs to make applications before each jurisdiction in different languages, with different fees and by following different regional regulations. One needs to engage a local attorney for every application.

TO RESOLVE & ONLY ANSWER IS MADRID PROTOCOL.

- ▶ The Government of India in the year 2007, took a decision to accede to the Madrid Protocol of the Madrid system of international registration of trademarks.
- ▶ India joined the Madrid Protocol, since it is more beneficial to the public. Most of the countries which were members of the Madrid Agreement also joined the Madrid Protocol.
- ▶ The Government of India acceded to the Madrid Protocol as 90th member of the Madrid System.
- ▶ In fact the Madrid System is a system for providing international protection of the mark under domestic application or registration, by international registration of the mark with the international Bureau of the WIPO.

THE MAIN ADVANTAGE OF THE INDIA'S ACCESSION

- ▶ It allows an Indian applicant who has got the registration of a trademark in India or who has made an application, to obtain trademark registration and protection in any or all member states by making one application in India in English with one set of fees in Swiss Francs.
- ▶ Likewise a person from another member state may get protection of his trademark in India by making such application in the office of his home country and by designating India therein.
- ▶ In such international registrations under the Madrid Protocol there is one registration number and one renewal date irrespective of the number of jurisdictions designated.
- ▶ All subsequent changes to the international registration may be recorded with the IB and have effect through one single procedure.

Steps taken for implementation of the provisions of Madrid Protocol in India

- ▶ The Trade Marks Act, 1999 and Trade Marks Rules, 2002 govern the law relating to trade marks in India. A major amendment in the Trade Marks Act, 1999 by way of the Trade Marks (Amendment) Act, 2010 was brought to enable accession to the Madrid Protocol.
- ▶ The Trade Marks Rules, 2002 were amended in the year 2013 through the Trademarks (Amendment) Rules 2013 mainly for the purpose of implementation of provisions of the Madrid Protocol in India. Accordingly the provisions of the Madrid Protocol came into force in India since 8th July, 2013.
- ▶ It was also decided that all functions relating to Madrid Protocol in India should be done only through electronic system. A 'Trade Marks International Applications System' has been developed and put into operation.
- ▶ Under this system, the applications for international registration of trademarks can be filed and payment of fees relating thereto can be made online through the comprehensive e-filing service of trademarks gateway.

STATUS

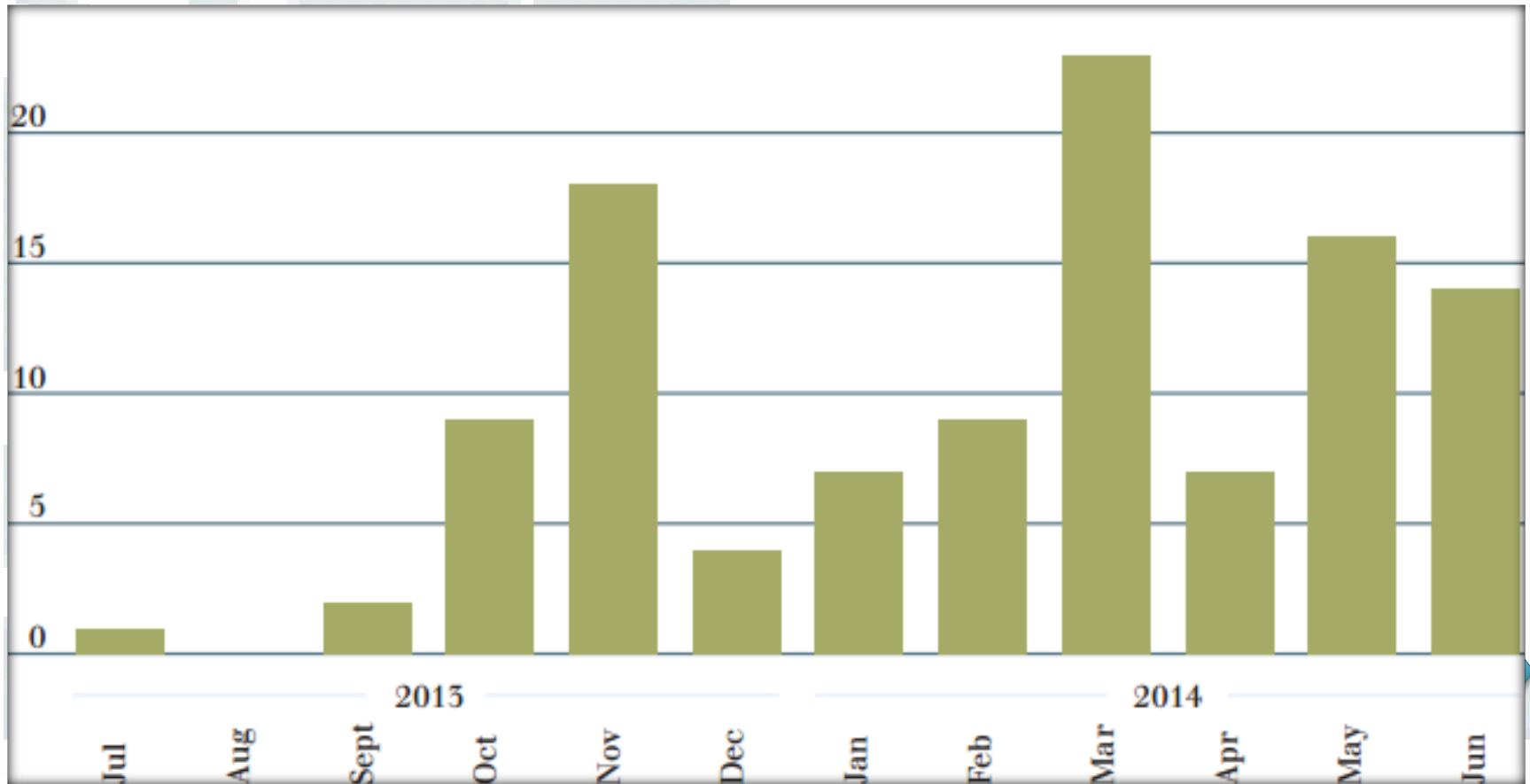
- ▶ The status of trademarks filed and registered can also be viewed at the Registry's website www.ipindia.nic.in. The facility for trademark search enables the public to conduct free trademark search.
- ▶ The digitization of trademark records has made the system transparent.
- ▶ The filing and prosecution of trademarks is less time consuming and provides for speedy disposal of trademark applications.
- ▶ The Registry has launched a dynamic trade mark utility enabling the public to see in real time the stock and flow of trade mark applications.

India's Accession to Madrid Protocol:

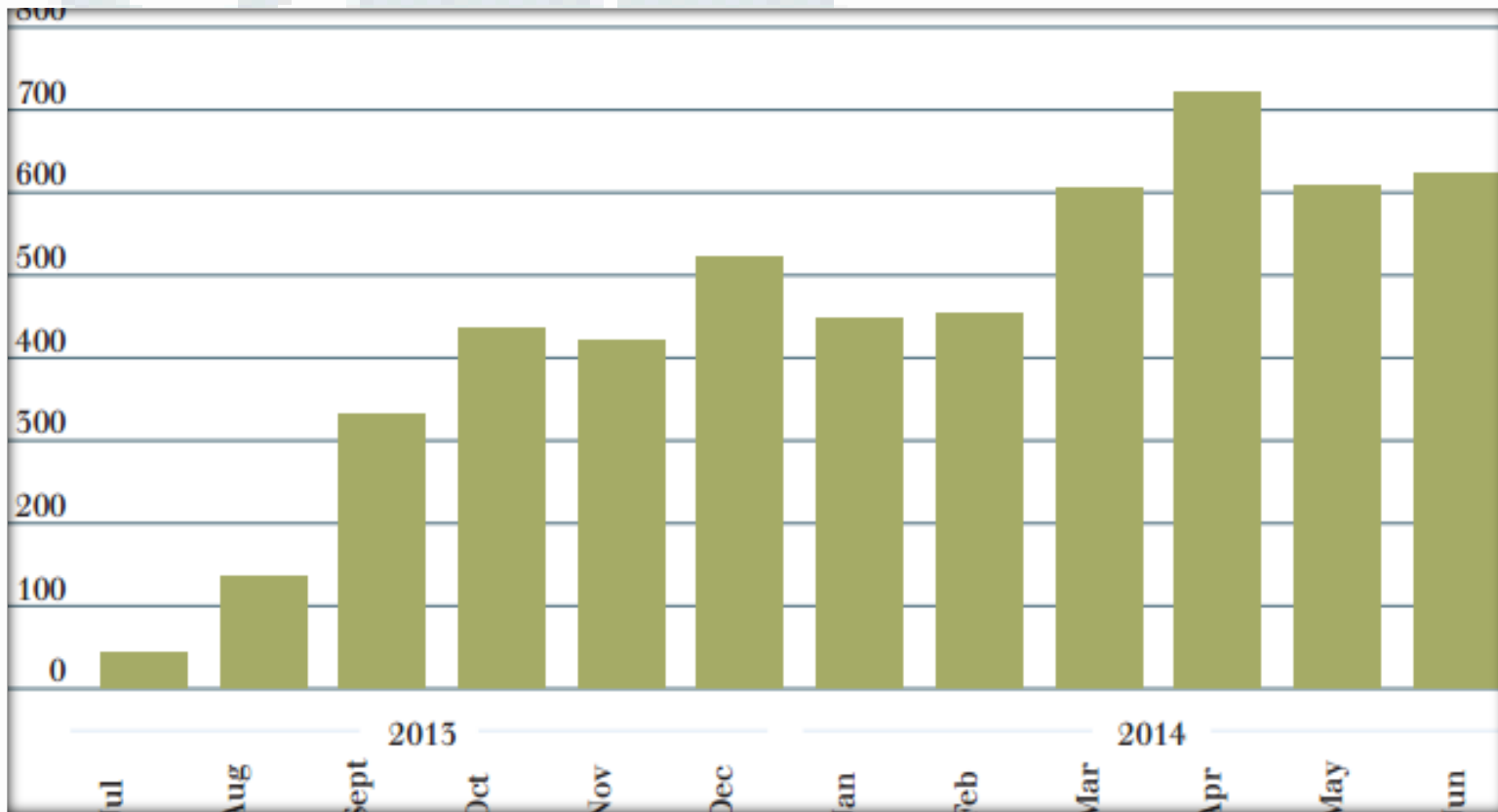
- ▶ On 8th April 2013, the Government of India joined the Madrid system for international registration of trademarks, by depositing the instrument of accession to the Madrid Protocol with the Director General of the World Intellectual Property Organization.
- ▶ India deposited its instrument of accession to the Madrid Protocol for International Registration of Marks at WIPO in April, 2013.
- ▶ The System enables Indian trademark owners to secure international trademark registration in signatory countries by way of filing a single application.
- ▶ According to WIPO reports, pursuant to accession, 110 international applications have originated from India and in 5,458 international applications have been filed designating India as a signatory country till 2013-14.

Implementation of provisions of the Madrid Protocol by the Trade Marks Registry Office

- ▶ The Indian office has entered into a Memorandum of Understanding with the International Bureau of the World Intellectual Property Organization (WIPO).
- ▶ Under which all the data are transmitted and received from WIPO electronically through FTP Server.
- ▶ The Trade Marks Registry sends data to WIPO on every Monday and receives data on every Friday.
- ▶ All the functions relating to applications for international registration of trademarks originating from India as well as relating to international registrations wherein India has been designated are performed through the Trade Marks International Application System.
- ▶ In addition to correspondence through the system an alert is sent to the respective applicant or his authorized agent at his registered email.



International Applications originating from
INDIA (2013-2014)



International Applications designated to INDIA (2013-2014)

To comply with these time limits

- ▶ A number of infrastructure upgrades have been introduced.
- ▶ One of the major reforms being the digitization of the trademark applications.
- ▶ The Indian IP Office has digitalized almost all of its records a massive work which enables the filing and prosecution of trademark applications transparent and user friendly.
- ▶ The e-filing of trademarks, helps trademark owners or their agents and attorneys to file trademark application through a simple process.
- ▶ The users can also upload the supporting documents along with the application. Further, other subsequent TM Forms can also be filed online.
- ▶ Increased Human Resource Support.
- ▶ To a great extent, the implementation of these reforms has accelerated the process of registering marks and clearing the backlogs within the time frame.

Liquidation of Oppositions

Possible Ways.

Timely action (the Act and Rules).

- When an Opposition is filed beyond the prescribed time (four months) - disposal after giving an opportunity of being heard.
- Abandoning application under Section 21(2) of the TM Act, 1999 for non-filing of counterstatement within the prescribed time limit of 2 months.
- Abandoning opposition under Rule 50 (2) of the TM Rules, 2002 for non-filing of evidence in support of opposition within extended time limits of 3 months(2+1).

Non-Prosecution

- ▶ Abandoning of application under opposition under Rule 56(3) for non-prosecution during the hearing (after reasonable opportunities’).
- ▶ Abandoning of opposition under Rule 56(4) for non-prosecution during the hearing(after reasonable opportunities).

Withdrawal (Action in Process)

- ▶ Withdrawing of application under opposition by the applicant.
- ▶ Withdrawing of opposition by the opponent.

Compromise/Settlement

(Action in Process)

- ▶ Disposal of opposition by way of compromise/settlement by filing settlement copy, area restriction, goods deletion, with permissible modification in the mark and to settle.
- ▶ Multiple oppositions to a single application.
- ▶ If the counter statement is not filed in any one of the oppositions or the application is refused on merits.

Automatic effect

- ▶ Remaining opposition(s) would also be abated.

Clubbing of cases

- ▶ In cross-oppositions, where parties and mark are same - Disposal by common single order with consent of the litigants/ their advocates or agents.

Elimination

- ▶ When two oppositions are filed to a single application one by the applicant and another by his agent, the later one will not be considered. This applies in the case of filing opposition by two different agents for the same opponent.

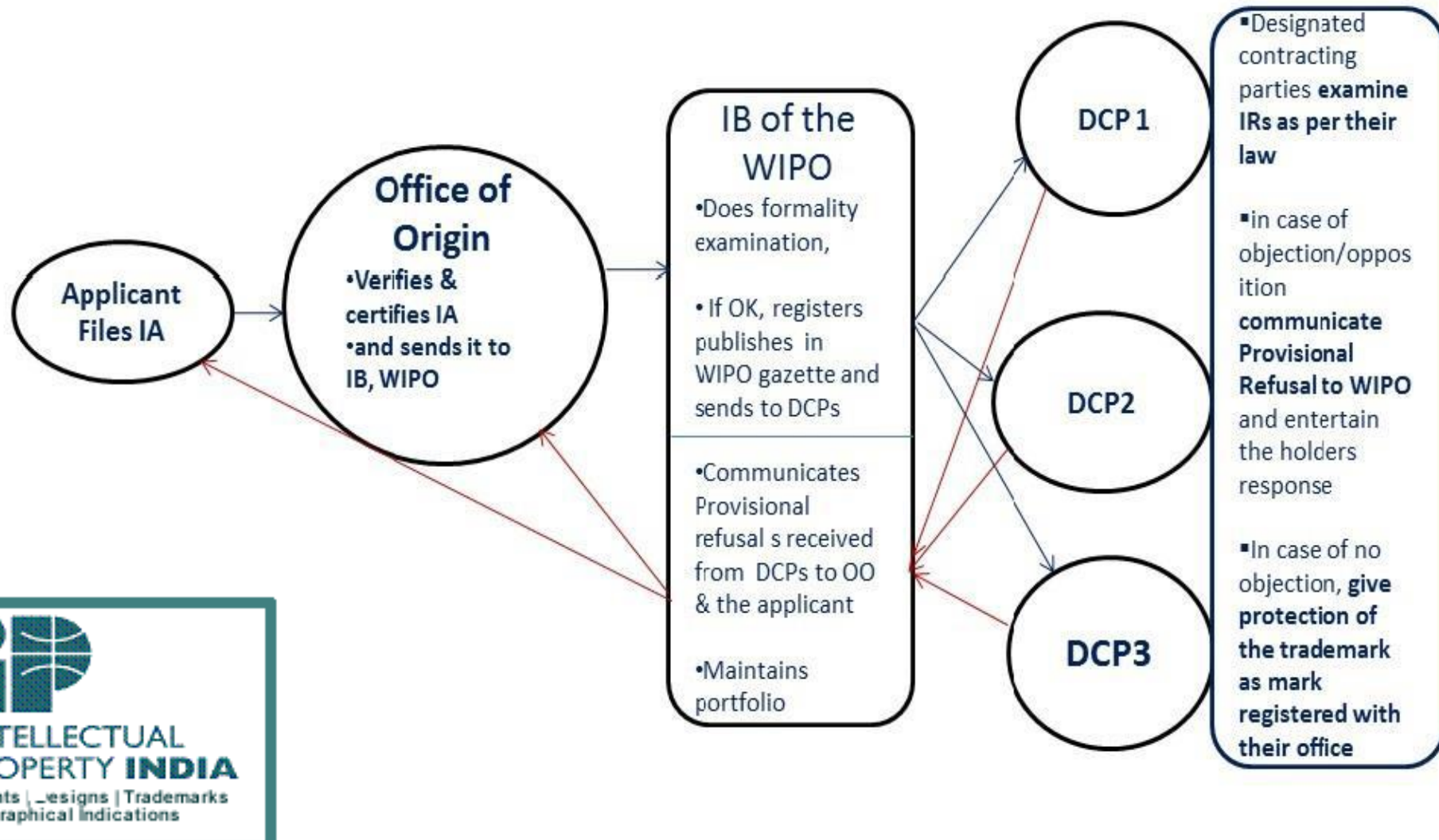
One Application One Advertisement

- ▶ When a mark is advertised more than once (very rare), advertisement, the opposition filed to the subsequent advertisement is to be treated as cancelled in a Hearing.
- ▶ When renewal is wanting, to a registered mark, in a rectification filed - due non-existence of registration - Disposal in a Hearing.

Other Situations

- ▶ Other situation identifying when opposition is filed in public interest - Disposal without discussing the other provisions of TM Act, 1999.
- ▶ When opposition is limited to Section 9 – Disposal without discussing the other provisions of TM Act, 1999.

Procedure for international registration under the Madrid Protocol



The advantages of the protocol regime are best summarized by the following statement of the International Trademark Association:

‘ONE application, in ONE place with ONE set of documents in ONE language with ONE fee in ONE currency resulting in ONE registration with ONE number and ONE renewal date covering more than ONE country’.