

Protecting Your Trademark in India: Understanding Examination and Refusal Procedures

Madrid System Webinar

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Our Speakers

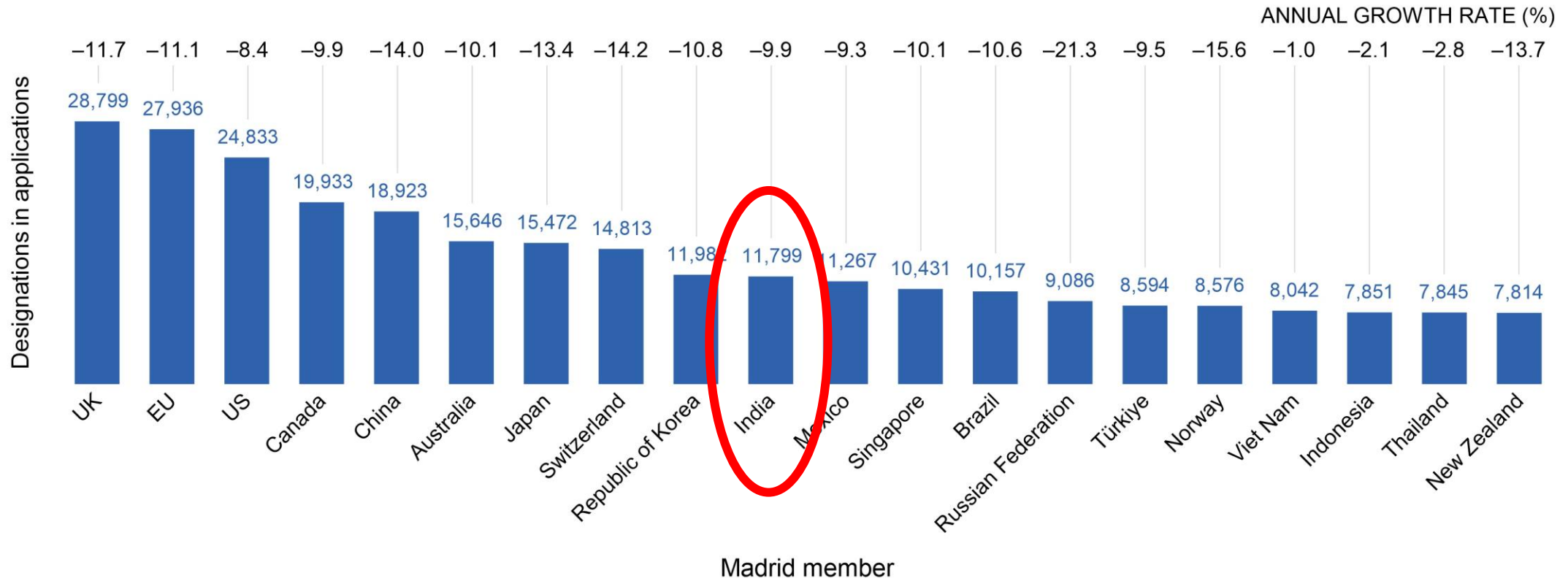


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Top 20 Designations – 2023



WIPO Statistics Database, March 2024.

Outline of the presentation

Brief introduction about Indian IP office dealing with functions relating to the Madrid System

Major declarations by Indian IP office at the time of accession to the Madrid Protocol

Procedures with Indian IP office as the Office of the designated contracting party

Formality requirements of Indian IP office regarding designation of the international registration to India

Possible grounds for refusal and tips to overcome them

Other things to be kept in mind while designating/subsequently designating the international registration to India

Brief Introduction about the Indian IP office dealing with matters relating to the international registration of marks under the Madrid System

The Trade Marks Registry (TMR) under the office of the Controller General of Patents, Designs and Trademarks (CGPDTM) in **Ministry of Commerce and Industry, Government of India** deals with all the trademark matters including those relating to the international registration of marks under the Madrid System.

All the functions of the TMR are done electronically through the Trade Mark System (TMS) and the Madrid Protocol System (MPS)

All communications with the International Bureau of WIPO regarding international applications and international registrations are done electronically through FTP Server.

All communications with applicants/agents/trademark stakeholders are done only electronically through the relevant portal as well as through email.

Brief Introduction about the Indian IP office dealing with matters relating to the international registration of marks under the Madrid System, contd....

Indian office has a dedicated website www.ipindia.gov.in which provides various useful links like e-filing, public search etc. and various useful information like status of each application/designation, Trademark Journal, Text of Act and Rules, etc.

India acceded to the Madrid Protocol on April 8, 2013; and provisions of the Madrid Protocol came into force in India since July 8, 2013.

Major declarations made by the Indian office at the time of accession to the Madrid Protocol

under Article 5(2)(b) of the Madrid Protocol (1989), the **time limit to notify a refusal of protection** referred to in Article 5(2)(a) is **18 months** and under Article 5(2)(c) of the said Protocol, when a **refusal of protection may result from an opposition** to the granting of protection, such refusal may be notified to the International Bureau **after the expiry of the 18-month time limit;**

in accordance with Article 8(7)(a) of the Madrid Protocol (1989), **the Republic of India, in connection with each international registration** in which it is mentioned under Article 3ter of the said Protocol, and **in connection with the renewal of any such international registration, wants to receive, instead of a share in the revenue produced by the supplementary and complementary fees, an individual fee;** and

in accordance with Article 14(5) of the Madrid Protocol (1989), the protection resulting from any international registration effected under this Protocol before the date of entry into force of this Protocol with respect to the Republic of India cannot be extended to it, **So India can not be subsequently designated for protection of international registrations affected before July 8, 2013.**

Procedures with Indian office , as an office of the Designated Contracting Party

Import of notification of the International Registration to the TMR database

Generation of equivalent national application No (for the designated IR) in the form of IRDIxxxxxxxx

Examination of IRDI as per provisions of the Trade Marks Act 1999 & the Trade Marks Rules 2017

In case of any objection, communication of a provisional refusal by the TMR to IB of WIPO.

Procedures with Indian office , as an office of the Designated Contracting Party, contd..

Submission of response/reply to the provisional refusal on behalf of the applicant through an Indian Agent (Representative).

[Any legal practitioner (Advocate or a Company Secretary), or a Registered Trademarks Agent can be representative of the applicant and can act as the applicant's agent.]

Consideration of the applicant's reply , in case of unsatisfactory reply scheduling the case for hearing

In case of no objections at examination stage/ waiver of objections after applicant's response or hearing, publication the IRDI in the Indian Trademarks Journal like a domestic application

Procedures with Indian office , as an office of the Designated Contracting Party, contd..

Any person may file **notice of opposition** to so published IRDI, **within the period of 4 months** from its publication in the Trademarks journal

On receipt of any opposition to the IRDI, communication of a provisional refusal based on the opposition to the IB

Submission of Counter Statement by the applicant, through an Indian Representative

Procedures with Indian office , as an office of the Designated Contracting Party, contd..

- Opposition proceedings-

- Service of copy of Counter Statement to the Opponent's agent
- Opponent files evidence in support of opposition within 2 months with a copy to the applicant's agent
- Applicant files evidence in support of application within 2 months with a copy to the Opponent's agent
- Opponent files evidence in reply within 1 months with a copy to the applicant's agent
- Scheduling the case for final hearing
- Disposal of opposition by the designated Hearing Officer

- In case

- no Provisional refusal sent after examination, or the Provisional Refusal, if sent is withdrawn and
- After publication in the Indian TMJ, no opposition received or /opposition, if received is disposed in favor of the applicant,

the TMR notifies the Grant of Protection of the international registration, to the WIPO.

- same protection of such IR as a national application registered with Indian office

Formality requirements of Indian IP office regarding designation of the international registration to India

Intention to use the mark

In case of Collective mark-draft regulations and statement of case as per Section 63 of the Trade Marks Act 1999 and Rule 131 of the Trade Marks Rules 2017

In case of Certification mark-draft regulations and statement of case as per Section 71 of the Trade Marks Act 1999 and Rule 137 of the Trade Marks Rules 2017

In case of three-dimensional mark- Three different views of the object

In case of shape or packaging as the mark- Five different views of the shape or packaging

In case of combination of colours as a distinctive feature of the mark, a statement to this effect

Formality requirements of Indian IP office regarding designation of the international registration to India, contd...

In case of a sound mark -reproduction of the sound in the MP3 format not exceeding thirty seconds' length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations.

Translation (of the mark if it is in a language other than English or Hindi) **and Transliteration** (of the mark if it is written in a script other than Roman or Devnagari)

In case of mark containing name or representation of a living person or who expired within 20 years prior to the date of the application- written consent of that person or that of his legal heirs

Claim of **different dates of priority** for some goods and services covered under the same international registration **not admissible**

Possible grounds for refusal and tips to overcome them

The mark is not distinctive, or descriptive of goods or services [Objection under Section 9(1) of the Trade Marks Act 1999]-

(like common names/surnames of persons, names of popular places, numbers/letters upto 2 digits, insignificant/common geometrical designs, etc.)

- The applicant can establish that the mark has acquired a distinctive character by virtue of prior use in India or because of foreign registrations and use of the mark abroad , if it is so.

- The applicant can limit the list of goods or services by deleting those items to which the mark is descriptive.

Possible grounds for refusal and tips to overcome them

The mark is deceptive, obscene, scandalous, or it hurts religious sentiments, or is prohibited for registration [Objection under Section 9(2) of the Trade Marks Act 1999]-

○The applicant has to establish that it does not come in such categories, he may rely on registration of the mark in India or in other jurisdictions.

The mark being shape (of goods)- which results from the nature of goods themselves, which is necessary to obtain technical result, or which adds value to goods [Objection under Section 9(3) of the Trade Marks Act 1999]-

○The applicant may establish that it does not come in such categories, he may rely on registration of the mark in India or in other jurisdictions

Possible grounds for refusal and tips to overcome them, contd..

The mark is identical with/similar to earlier mark(s) on record in the name of different persons [objection under Section 11 of the Trade Marks Act 1999]-

It can be submitted that the said earlier mark(s) are dissimilar with the applicant's mark; and/or the goods or services covered under said earlier marks are different than the applicant's goods or services.

If possible, No Objection letter from the proprietor of the said cited mark(s) may be procured.

If the applicant has also been using the mark in India, benefit of honest and concurrent use can be claimed under Section 12 of the Trade Marks Act 1999

Other things to be kept in mind while designating/ subsequently designating the international registration to India, contd..

Indian office does not honour the licensing/permitted use of a trademark unless the same has been executed and registered in India

As on date, the Indian office doesn't accept division of the international registration designated to it, or merger of divided international registrations.

As on date, the Indian office doesn't accept the request for transformation of a cancelled international registration. In such case the applicant is advised to file national application.

As on date, the Indian office doesn't accept the request for withdrawal of the international registration or for any change in the contents of the international registration.

Other things to be kept in mind while designating/ subsequently designating the international registration to India

Indian IP office is reluctant to accept smell mark, position mark, or any other mark which cannot be duly represented graphically.

Indian IP office does not accept guarantee mark.

Indian IP office does not accept any mark containing letter R or letter C in circle or words 'Regd./' 'Registered' unless the applicant has already obtained registration of the trademark or copyright of that design

Indian IP office does not accept any mark which is mentioned in Schedule to The Emblems And Names (Prevention Of Improper Use) Act, 1950

Other things to be kept in mind while designating/ subsequently designating the international registration to India, contd..

Indian IP office **doesn't entertain any paper correspondence or telephonic conversation** regarding the international registration designated to India

Indian IP office **requires all correspondence to be made only in English.**

Indian IP office **requires an Indian representative/agent** (Legal practitioner or registered trademark agent) **to represent the applicant, in case of a provisional refusal.** The applicant **needs to execute a Power of Attorney** in favour of the said representative.

Indian office **invariably requires a valid email for correspondence** and all correspondence to the parties concerned are done at the said email.

Some statistics for the last 4 years

Year From 1st April to 31st March	No of designations of International registrations received from the WIPO	No of cases wherein grant of protection sent to the WIPO
2019-2020	14001	14699
2020-2021	12913	9943
2021-2022	15109	6971
2022-2023	14366	7137

**[Source Annual Report of the CGPDTM for the year
2022-2023]**

From 1st April 2022 to 31st March 2023

The Indian office received notifications of 14366 international registrations.

In respect of 8274 international registrations Provisional Refusals based on Examination were sent to the WIPO

In respect of 857 international registrations Provisional Refusals based on third party Opposition were sent to the WIPO

Grant of Protection were sent to the WIPO in respect of 7137 international registrations

In 4055 out of 7137 international registrations, Grant of Protections were issued, without requiring the applicant to approach Indian Office.

Questions?



Public Education Resources

Resources

IP for Business:

- WIPO IP Diagnostics Tool <https://www.wipo.int/en/web/wipo-ip-diagnostics>
- Guides: Intellectual Property for Business <https://www.wipo.int/publications/en/series/index.jsp?id=181>
- A step-by-step IP Strategy Checklist for SMEs <https://www.wipo.int/sme/en/checklist.html>

Madrid System:

- eMadrid <https://www.wipo.int/web/emadrid/>

Public Webinars – 8 Languages

Webinars del Sistema de Madrid

Actualizaciones legales del Sistema de Madrid de 2023: Todo lo que necesita saber

1:03:21
WIPO MADRID

9 MONTHS AGO

Actualizaciones legales del Siste...

Webinars du système de Madrid

Protéger sa marque à l'étranger : Guide sur le système de Madrid de l'OMPI et outils de propriété intellectuelle pour les PME

1:08:24
WIPO MADRID

5 MONTHS AGO

Protéger sa marque à l'étranger ...

马德里体系网络研讨会

中国商标局的马德里申请程序 (2023)

1:09:00
WIPO MADRID

EDUCATION 4 MONTHS AGO

The Madrid Filing Procedure in China Trademark Office

Вебинары по Мадридской системе

Официальные формы: Управление международной регистрацией

59:39
WIPO MADRID

EDUCATION 2 YEARS AGO

Official Forms: Managing an international registration

マドリッド制度に関するWebセミナー

商標の国際登録制度『マドリッド制度』の概要(初級) - 制度を学びたいスタートアップ、中小企業の方にも!

2023年10月26日

1:13:44
WIPO MADRID

EDUCATION 15 DAYS AGO

商標の国際登録制度『マドリッド制度』の概要(初級) - 制度

التحديثات القانونية بشأن نظام مدريد

تحديثات قانونية لعام 2023 وملاحظات الفريق العامل

44:48
WIPO MADRID

8 MONTHS AGO

لعام 2023 آراء ومقترحات الفريق العامل ...

Madrid System Webinars

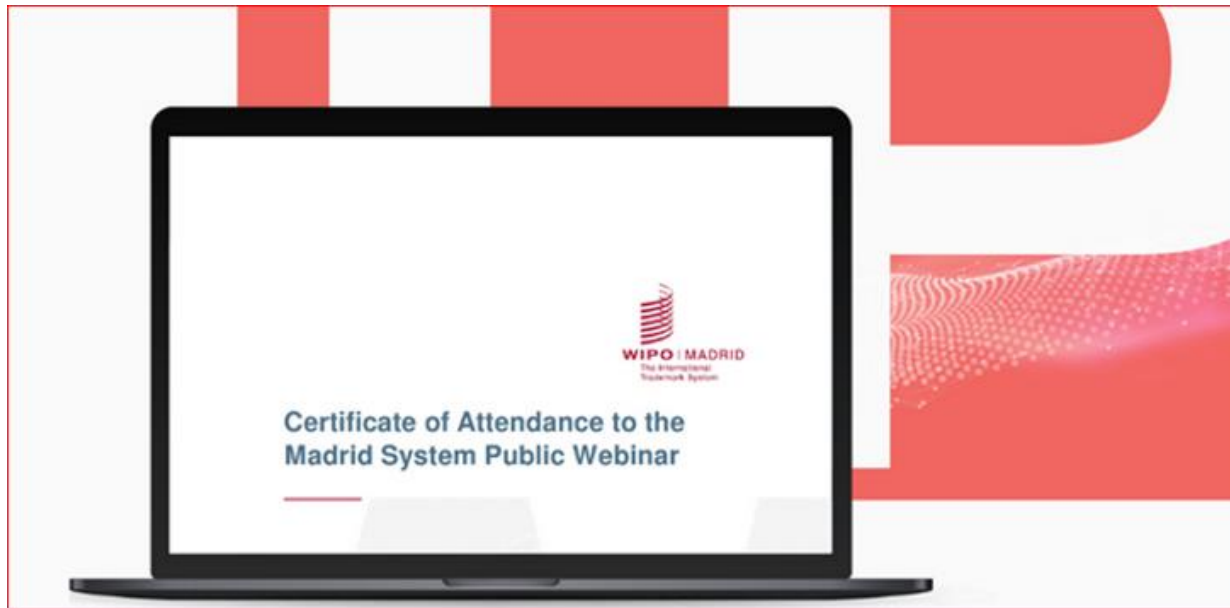
Understanding Procedures at the IP Office of the United Kingdom (UKIPO)

1:06:25
WIPO MADRID

EDUCATION 1 MONTH AGO

Understanding Procedures at th...

Certificates of Attendance



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Tag WIPO **#MadridSystem**

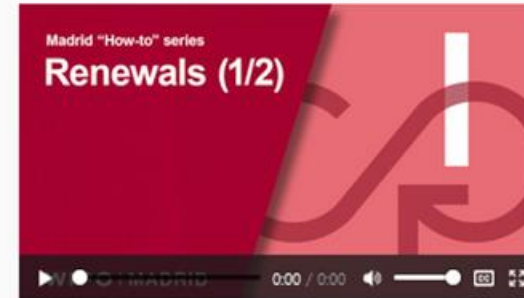
Video Explainers and Tutorials

Madrid 'How-to' videos



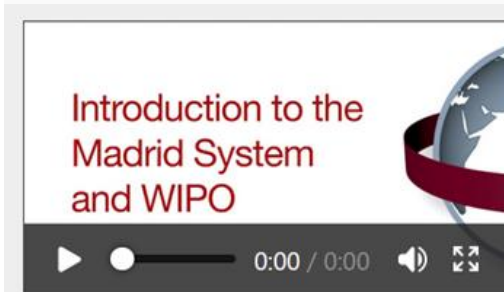
How to extend the protection of an international registration via the subsequent designation

In this tutorial, you will learn how to expand the geographical coverage of your existing international registration by adding additional countries or regions through a subsequent designation. [About subsequent designations.](#)



How to renew international registrations (part 1)

This tutorial will go over the renewal process, modifications to international registrations before and after the renewal and the costs associated to the renewal. [About renewals.](#)



Video: An introduction to the International Trademark System.



Video: Benefits and advantages of the Madrid System.

Distance Learning Course




- Certified and tutored online course
- 6 modules – 16 hours
- Free
- 800 - 1000 participants per session
- With the WIPO Academy
- [DL-303 Specialized Course on the Madrid System for the International Registration of Marks](#)

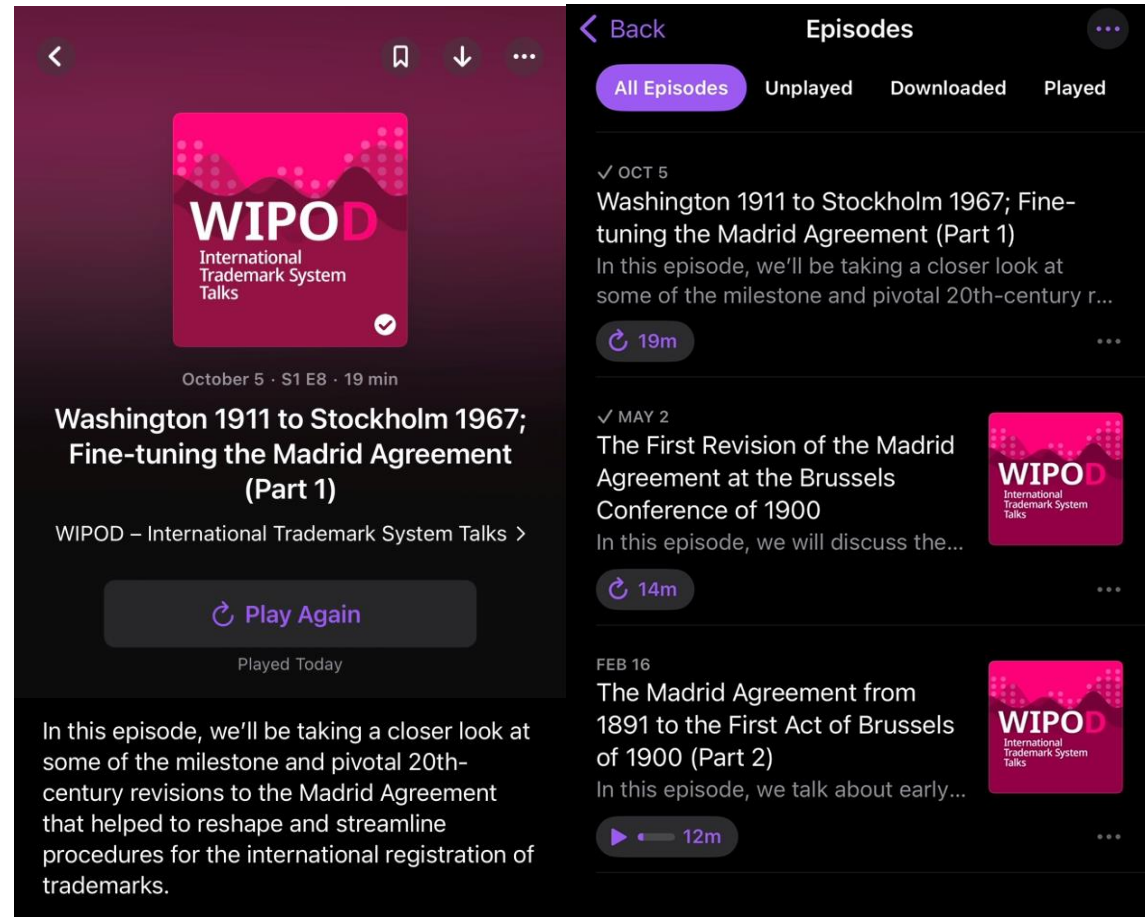


Madrid System Podcast

WIPOD – International Trademark System Talks

10 episodes

- Spotify 
- Apple Podcasts 
- YouTube Podcasts 



WIPO, 2024

Testimonials and Case Studies

Madrid System Success Story: M'Simbi – Spreading Self-Love Globally, One Doll at a Time

July 25, 2023

We have just released a new success story highlighting how the [Madrid System](#) supports innovative entrepreneurs who want their brand to make a difference even beyond their national borders.

What do you do when society tricks you into believing you do not fit in? You carve your own path and you make your voice heard! This is exactly what Maingaila Moono – former biostatistician and now full-time entrepreneur from Zambia – did when she realized that her daughter did not feel like she complied with traditional beauty standards.



In 2022, the [Zambian Association of Manufacturers](#) assigned Maingaila the Game Changers Award, as an acknowledgement of her innovative ideas, her sense of leadership and her positive impact on the manufacturing industry. (Photo: MacLean's Photography)

Her little girl motivated Maingaila to find a way to manufacture Black dolls, and to set up her own business - M'Simbi- whose mission is to teach young girls to be proud of their cultural identity and aware of their own unique beauty.

M'Simbi products now range from dolls to backpacks, and from clothes to hair accessories, and are exported to the United Kingdom and the United States of America.

International trademark protection in those countries through the [Madrid System](#) is what truly allowed M'Simbi to take off, opening up doors to major international e-commerce platforms.

"I would definitely encourage local entrepreneurs to apply for trademark protection both locally and internationally. When [PACRA \(Patents and Companies Registration Agency in Zambia\)](#) told us that you can register your trademark in many countries at once with the [Madrid System](#), it really intrigued us."

— Maingaila Moono

[Access the full success story](#)

Madrid System Success Story: HABIBA Jewellery – Timeless Tunisian Jewelry Takes the International Stage by Storm

September 26, 2023

Entrepreneur Sonia Feki's brand "[HABIBA Jewellery](#)" – created as a tribute to her mother – was quick to win the hearts of women across Tunisia. Despite the challenges of the COVID-19 pandemic, the brands' success grew, spontaneously catching the attention of Egyptian media outlets, in turn raising awareness in the Gulf countries. From there, demand grew in other African countries.

Find out all about Sonia's journey to success, and how the [Madrid System](#) is helping her not just to expand her horizons but also to face the future with confidence.



Sonia's secret to success?

"When I founded [HABIBA Jewellery](#), I projected myself 15 years into the future. Protecting my trademark – first nationally and then internationally – was one of my top priorities."

— Sonia Feki, [HABIBA Jewellery](#)

[Access the full success story](#)

Madrid System User Group

Help us shape the future of our Madrid System online services under [eMadrid!](#)

[Sign up to our Madrid System User Group](#)



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Keep Updated on the Madrid System

Good news! We are now on LinkedIn!

We'll be sharing tips, facts, stories, learning opportunities and much more on WIPO's [Madrid System](#), [Hague System](#) and [Lisbon System](#), as well as trademarks, designs, and geographical indications!

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Thank you for your participation

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