EFFECTIVE IMPLEMENTATION OF THE MADRID PROTOCOL WITH A SPECIAL EMPHASIS TO THE ORGANIZATIONAL SET UP IN INDIA.

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ABSTRACT

The study is based on the importance of the Madrid Protocol in the present economic scenario of India. The Indian economy is one of the fastest growing economies and has all the potential to become the world leader in this century. The Intellectual Property is an important tool for the economic well being of a country and it is highly important to give a proper environment to protect its rights.

The Trademarks are an important branch of Intellectual property and its protection is highly necessary. In this 21st Century the business will grow beyond the borders of a country due to the better transportation, communication and advancement of the technology. The protection of Trade marks in different countries is highly important to grow business of an enterprise. The Madrid Protocol is one of the effective tools to register the trade marks internationally and it is essential that India to accede the system. Many of the developed and developing countries have already been acceded the system and India cannot keep itself away from accessing to Madrid Protocol.

However, before accessing the Madrid Protocol, it should be ensured that the Trade marks law in India is in harmony with the international trends and treaties. Certain amendments of the present Trade Mark laws are essential to accommodate the Madrid Protocol and the Government of India has initiated the action by way of drafting the Trade Marks (Amendment) Bill in the year 2007 and the Bill to be presented before the Parliament for final approval.

The proposed amendment may be sufficient in general, for technical implementation of the Madrid Protocol in India. However, practical implementation will be difficult due to the existence of number of loopholes in the laws and the Trade mark registry’s infrastructural issues.

In this study the author is trying to find out the drawbacks of the present Trade mark laws and the organizational set up in India and a practical solution to strengthen the Trade mark laws and organizational structure in India in harmonization with the international trends.
CHAPTER 1

1. INTRODUCTION

1.1. BACK GROUND OF RESEARCH THEME

The oldest forms of intellectual property rights may be trademarks and service marks, dates back to ancient times. There is lots of confusion about the first trade mark in the history. The paintings of the Lascaux Caves in France were made around 5000 years B.C. contain some marks, which scholars say indicate ownership.

The ancient potteries of CHINA, EGYPT, ROME, MESOPOTAMIA and GREEKS have some marks indicating the ownership. Another earlier form of identification mark has been the branding of livestock. The Bass and company, the British brewery claims their

Red Triangle is the world’s first trade mark. They are claiming use since 1600. The Red Triangle Logo was the first trade mark to be registered under the Trade Mark Registration Act, 1875, as Trade Mark no. The 1875 Act came into force on 1st January, 1876 and that New Year’s eve, an employee of the Bass company wait overnight outside of the Registrar’s office, in order to be the first in the queue to register a trademark in the next morning.

1 www.bassale.com The Red Triangle and word BASS is the property of Brand brew S.A.
In U.S.A., Federal Trade Mark Legislation was passed in the Year 1870 and the Eagle logo owned by Averill paints become the first Trade mark in U.S.A. There are lot of other contenders for the world’s oldest Trade Mark. The Right of Trade Mark is perpetual, if it is renewed time to time, contrary to other IPR like Patents, Designs, Copy rights etc.

The purpose of the Trade Mark or service mark is to distinguish the goods or service of one person from the other. It may be a word, letters, shape, signature, packaging, label, combination of colors and anything graphically represented can be a trade mark or service mark. The Trade Mark gives an indication to the public that the said product belongs to a particular source and it has certain qualities. The selection of goods may be on the basis of price, quality or anything the consumer attracted to that product.

The Trade Marks have a significant role to improve the economy of a company and the goodwill of the company mainly associated with the Trade Marks. Trade Mark protections are highly important in a Market economy. Earlier times there were no organized laws for the protection of Trade Marks in most countries and the Trade Marks were protected that time under the common laws of that country. Prior to the eighteenth century the market of a product normally restricted too locally and the industrial revolution of the eighteenth and nineteenth centuries established the importance of Industrial property system.

The rapid increase of the technology, science, production, transportation and communication made the products of one country made available beyond the borders of that country. The trade and commerce crossed the borders and the protection of Trademarks became vital to the producers to avoid the counterfeit of products and it created the necessity of protecting the industrial property globally. Foreign producers were reluctant to exhibit their products during the International exhibitions held in the years 1855 and 1867 in Paris because of inadequate protection of their industrial property in other countries, but in 1873, the Austrian Government has passed a law to grant temporary protection to Foreign producers for their Trade Mark, Designs and Patents to enable them to participate in the International exhibitions, probably, this may be the first initiative for International Registrations.

The Paris convention for the protection of the Industrial property was one of the first intellectual property treaties signed in Paris, France on 20th March 1883. The convention was initially signed by 11 countries. The Treaty revised at Brussels, Belgium on 14th December 1900, at Washington U.S.A on 2nd June 1911, at The Hague, The Netherlands on 6th November

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2 Madrid Agreement Centenary published by WIPO, 1991 page No 16
3 Madrid Agreement Centenary published by WIPO, 1991 page No 19
1925, at London, United Kingdom on 2nd June 1934, at Lisbon, Portugal on 31st October 1958 and at Stockholm, Sweden, on 14th July 1967 and was amended on 28th September 1979. At present it has 173 contracting member countries. The Paris convention is administered by WIPO.

The background of my research theme is the changes of the market over a period of time and the impact of such changes on the owners of the trademark or producers. In this 21st century, the entire world is considered as a global village and the market is no more local. The internet is one of the main media to do the business and no company can be purely on national and such circumstances the owners of the Trade Marks should protect their valuable rights in other countries to do business in a better and effective way. There were no effective tool to register the trade mark globally before the implementation of Madrid system and such circumstances the importance of the Madrid protocol cannot be overlooked. The primary aim of the Trade mark Registry to promote the use of Trade Mark among the owners and give better protection to their mark by way of registering their mark and to avoid the counterfeiters.

The protocol relating to the Madrid Agreement concerning the International Registration of Marks known as Madrid Protocol is one of the best system available today to register the mark in different countries through a single application with reduced costs. As on December, 2008, there are 78 members are acceded the Madrid Protocol 4 and more countries are trying to accede the system.

India is one of the fastest growing economy in the world is studying the different aspects of the Madrid Protocol to accede the system to help the Multinational companies as well as to the domestic companies and Small Medium Enterprises by protecting their Marks in different countries at a reduced cost of price. In this paper, I give my best effort to express my opinion about the implementation of the Madrid Protocol effectively in India with a comparative study of JPO.

1.2 OBJECTIVES.

Indian Economy has been growing rapidly for the last few years and it is one of the fastest growing Economies in the world. Many Indian companies started to invest money in other countries and they are expanding their business all over the world. The multinational companies of foreign origin also realized that the India is a potential market to invest and expand their business because of its high purchasing power and the availability of natural and human resources. During such expansion it is important to have a proper protection of their valuable

4 [www.WIPO.int/Madrid/list](http://www.WIPO.int/Madrid/list) of members
intellectual property rights. At present in India there is no proper mechanism to register the Trade Mark internationally through a single application; hence, accession to the Madrid Protocol will be highly beneficial to Indian as well as to the foreign companies.

My focus in this Research is mainly to implement the Madrid Protocol effectively in India with the modifications required to amend the present Trade Marks Act and Rules prevailed in the Country. I am also using this opportunity to learn how effectively the Japan acceded the Madrid system.

1.3 METHODOLOGY.

A detailed information about the Madrid system, present trade mark laws in India and proposed trade marks (Amendment) bill 2007 to be collected and have to be reviewed thoroughly. The information about the organizational set up in India is also to be collected.

After obtaining the necessary information and knowledge, Questionnaires are to be distributed to the JPO and Japan patent attorneys and a detailed analysis is to be done. It is also necessary to collect the statistical data of applications, registrations, employees and their functions regarding India and Japan.

Finally, it is the time to analyze and conclude the obtained knowledge and information and recommend some practical proposals to implement the Madrid Protocol effectively in India.

CHAPTER 2

2.1. MADRID SYSTEM- AN OVER LOOK

The system of International registration of marks is governed by two treaties. The Madrid Agreement Concerning the International Registrations of Marks, dated from 1891, and the Protocol Related to the Madrid Agreement, which was adopted in 1989, entered into force on December 1, 1995 and came into operation on 1st April, 1996. Common regulations under the Agreement and Protocol also came into force on that date, the Agreement and Protocol jointly known as Madrid System. The system is administered by the International Bureau of WIPO,
which maintains the International Register and publishes the WIPO, Gazette of International Marks.\textsuperscript{6}

The difference between the National Route and the Madrid Route are in the National Route, the applicant has to file different applications in different countries, whereas in the Madrid Route the applicant has to file a single application in the Office of Origin for multiple jurisdictions.

Any State which is a party to the Paris Convention for the protection of Industrial property may become a party to the Agreement or the Protocol or both. In addition, an intergovernmental organization may become a party to the Protocol, but not the Agreement subject to fulfilling the following conditions

1. At least one of the Member States of the organization is a party to the Paris Convention.

2. The organization maintains a regional office for the purposes of registering marks with effect in the territory of the organization.

The states parties to the Agreement and/or the protocol are collectively referred as contracting parties. As of December 2008, there are 84 Contracting States, out of which 06 Members are in Madrid Agreement only, 28 contracting parties are only for Madrid Protocol and 50 are in Protocol and Agreement.\textsuperscript{7} According to a press release of WIPO dated 10\textsuperscript{th} March, 2009 the Madrid system representing 5.3\% rate of growth and at present it have more than million applications. The WIPO has received an overall application of 42,075 under the 84 member of the Madrid system during the year 2008.

The Contracting parties together they constitute Madrid Union and every member of the Madrid Union is a member of its Assembly and their major responsibilities are the adoption of the program and budget of the Union and the adoption and modifications of the regulations and fixing of the fees etc.

An application for international registration may be filed only by a natural person or a legal entity which has a real and effective industrial or commercial establishment in, or is domiciled in, or is a national of, a country which is party to the Madrid Agreement or the Madrid

\textsuperscript{6} Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A. 2

\textsuperscript{7} WWW.WIPO.int/madrid/list of members
Protocol, or who has such establishment in, or is domiciled in, the territory of an intergovernmental organization which is a party to the Protocol, or is a national of a Member state of such an organization. Thus the Madrid system of international registration cannot be used by a person or legal entity which does not have the necessary connection, through establishment, domicile, or nationality, with a member of the Madrid union and it cannot be used to protect a mark outside the Madrid Union.8

2.2 THE OBJECTIVE OF THE MADRID SYSTEM

The main objectives of the system is to facilitate an easier way to register the trademarks and service marks among the contracting parties with lesser efforts and made subsequent management of the trade mark and service mark portfolio easier among the designated contracting states.

2.3. THE DIFFERENCE BETWEEN THE MADRID AGREEMENTS AND THE MADRID PROTOCOL

Even though the Madrid Agreement adopted in the year 1891, many countries avoided the Agreement due to the incompatibility to their national laws and therefore, WIPO initiated to prepare a protocol to persuade other countries to join the system by avoiding the difficulties of the Agreement and accordingly the draft was made by the year 1989 and finally in the year 1996 the Madrid Protocol came into force. However, many existing members of the Madrid Agreement feels that the changes are not required, since, it is working well for them for more than 100 years. The Madrid Agreement and the Madrid Protocol are independent, parallel treaties, with separate but overlapping memberships.

Thus, there are three groups of members of the Madrid Union.

I. States party only to the Madrid Agreement.
II. States party to both the Madrid Agreement and Protocol.
III. States and Organizations party only to the Protocol.

The Article 9sexies (1) of the Protocol, known as the safeguard clause, clarifies the doubt about which treaty applicable to the states party to both the Agreement and the Protocol. Which provides that where, with regard to a given international application or registration, the office of origin is the office of a state party to both the Agreement and the Protocol, that international application or registration will, with respect to any other state also party to both Agreement and

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8 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No.A.3.
the Protocol, be governed exclusively by the Agreement.  

9 But this clause has been repealed from 1st September, 2008 and now, the Protocol regulates the relations in the mutual relations of Contracting Parties bound by both treaties. 

10 The Madrid Protocol provides that an application for International registration may be based on an application or registration of the country of origin, whereas under the Madrid Agreement the application should be based on the registration of the country of origin.

11 Under the Madrid Protocol, each Contracting party in which the applicant seeks protection may elect a period of 12 to 18 months and even longer period in the case of opposition, whereas under the Madrid Agreement it is 12 months. The purpose of such extension is to attract the countries that had more extensive examination system like U.K, U.S.A, Singapore, Japan etc.

12 The Madrid Protocol provides, an International registration which is cancelled at the request of the office of origin, under the Central attack, i.e. because the basic application has been refused or the basic registration has been invalidated within five years from the date of the international registration, may be transformed into national applications in the respective Contracting Parties in which the international registration had effect, each benefiting from the date of the international registration and where applicable even its priority date. This possibility does not exist under the Madrid Agreement.

13 Under the Madrid Protocol the official languages can be used as French, English and Spanish whereas in the Madrid Agreement, its, only French.

14 Under the Madrid Protocol, the office of each Contracting Party may receive higher fees than under the Madrid Agreement because the Protocol allows the members to charge individual fees. There are four components to the fees charged by WIPO under the Madrid system:

(i) A basic fee for the international registration itself.

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9 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A.6
11 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A.5
12 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A.5
14 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A.5
15 Guide to the international registration of marks under the Madrid Agreement published by WIPO page No A.5
(ii) A complimentary fee for each contracting party state designated that has no individual fee

(iii) An individual fee for those Protocol Contracting Party states that require it. (but the individual fee cannot be higher than what the Contracting Party state charges to file a national application)

(IV). finally, a supplementary fee for all classes beyond the first three classes.

The basic fee is payable to WIPO for each Madrid application filed is CHF 653 for black and white mark and CHF 903 for a color mark covering one to three classes under the International Classification of Goods and Services. Where the goods/services fall into more than three classes, a supplementary fee CHF73 is payable per additional class beyond three (but if individual fees are payable for all the selected designations, no supplementary fees need be paid). In addition to this a complimentary fees or Individual Fees will be payable for each designated country. The amount of complementary fees payable is at CHF 73 but where a particular contracting party has made declaration under article 8 (7)(a) of the Madrid Protocol that it wishes to receive an individual fees instead, the appropriate individual fees as notified by the office of that country will be payable. The Complementary and supplementary fee has hiked to 100 CHF from 1stSeptember, 2008.16

Under the Madrid Protocol, the term of registration of a mark is 10 years,17 whereas, in the Agreement it is 20 years.

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17 Article 6 (1) of the Madrid Protocol
DIFFERENCE BETWEEN AGREEMENT AND PROTOCOL

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2.4. ADVANTAGES OF THE MADRID PROTOCOL.

(i) LESS EXPENSIVE.

The filing fees under the Madrid Protocol are estimated to be significantly less than that for filing separate applications with national Trade mark office. After registering the mark, or filing an application for registration, with the office of origin, the applicant has only to file one application and pay fees to one office and in one language, instead of filing separately in the trade mark offices and the similar advantages are existing when the registration has to be renewed, assigned, or change of name etc. The legal counsel fee also is less because it requires legal counsel in only one country and also the Madrid system allows the Trade Mark owners to apply for Trade Mark without the help of a counsel to conduct their own search and file the application directly.

(ii) THE MANAGEMENT OF THE TRADE MARK PORTFOLIO
MADE EASIER

The subsequent management of the Trade Mark portfolio is made much easier, since an International Registration is equivalent to a bundle of national registration. There is only one registration, hence, one registration to renew and changes such as a change in ownership or in the name or address of the holder, or a limitation of the list of goods and services, can be recorded in the International Register through a single simple procedural step. The system is also designed in such way that if it is desired to transfer the registration for only some of the designed Contracting Parties, or for only some of the goods or services, or to limit the list of goods and services with respect to only some of the designated Contracting Parties.

(iii)  FASTER REGISTRATION.

Another advantage of the Madrid Protocol is that gives the registration in much faster comparing to some countries, due to the lengthy examination process or backlog of applications. The Contracting Parties to choose a time between 12 months to 18 months to decide the application, unless there is opposition. The applicant does not have to wait for the Office of each Contracting Party in which protection is sought to take a positive steps decision to register the mark, and if no refusal is notified by an Office within the applicable time limit, the mark is protected in the Contracting Party concerned and in some cases, the applicant does not even have to wait the expiry of this time limit in order to know that the mark is protected in a Contracting Party, since he may, before the expiry of the time limit, receive a statement of Grant of protection from the office of that Contracting Party.

(iv)  SUBSEQUENT DESIGNATION

The International registration can also be extended to a Contracting Party not covered by the International application by filing a subsequent designation. This is an added advantage to the owner of a Trade mark to choose area according to the expansion of his business. Further, to this a designation can be made to a Contracting Party which was not a party to the Agreement or Protocol at the time of the International application.

An international registration is deemed to replace a national or regional registration for the same mark and the same goods and services recorded in the name of the same person in a designated Contracting Party. The Article 4bis of the Madrid Protocol deals the Replacement of a National or Regional Registration by an International Registration. The effect of replacement is that, if the national or regional registration is not renewed, the holder of the international
registration may continue to benefit from the earlier rights acquired by reason of that national or regional registration. The owner of the international registration may request the office of the Contracting Party in which the national or regional registration is recorded to take note in its register of the international registration.

(v) NO FORMALITY CHECK REQUIRED BY THE NATIONAL OFFICE.

WIPO checks that all basic filing requirements have been met, that the goods are properly mentioned, fees paid etc. and it’s an added advantage to the National office not to do any formality verification, or classify the goods or services or publish the marks. The WIPO will inform the office of origin and the applicant, if any issues arise, and the same must be addressed within a three months period to avoid any abandonment. However, local counsel may require if any opposition or refusal of the application by the respective designated country or office of origin. Moreover, the national offices are compensated for the work that they perform. The individual fees collected by the IB are transferred to the contracting parties in respect of which they have been paid, while the complimentary and supplementary fees are distributed annually among the Contracting Parties not receiving individual fees, in proportion of the number of designations made of each of them. If the International Registration service closes its biennial accounts with a profit, the proceeds are divided among the Contracting Parties.

2.5 DISADVANTAGES OF THE MADRID PROTOCOL.

(i) CONSEQUENCE OF THE CENTRAL ATTACK.

One of the greatest disadvantages of the Madrid Protocol is the provision of the Central Attack.18

For a period of five years from the date of its registration, an international registration remains dependent on the mark registered or applied for in the office of origin. The basic registration ceases to have effect, whether through cancellation following a decision of the office of origin or a court, through voluntary cancellation or through non-renewal, within this five year period, the International registration will no longer be protected. Similarly, where the International registration was based on an application in the office of origin, it will be cancelled if, that application is refused or withdrawn within the five year period. Thus, the first five years are crucial for international registrations, whatever happens to the basic application or registration in the office of origin also affect the rest of designations under the international registration. If the basic application successfully challenged in an opposition or rectification, all

18 Article 6(3) of the Madrid Protocol
rights accrued in the designated countries also fail. If the goods or services are deleted from the basic application or registration, whether voluntarily through examination or opposition proceedings, the same goods or services should be deleted from the International registration, this is really unfair to the registrant as the grounds for cancellation or rectification may vary from country to country.

In India section 47 of the Trade Marks Act, 1999, deals with the removal of registered mark from the register and imposition of limitations on ground of non-use.

Section 47. (1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the registrar or the appellate Board by any person aggrieved on the ground either----

(a) that the trade mark was registered without any bona fide intentions on the part of the applicant for registration that it should be used in relation to those goods or service by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be and that there has, in fact been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application or

(b) that up to a date three months before the date of the applications a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that, there has been, before the relevant date or during the relevant period, as the case may be bona fide use of the trade mark by any proprietor thereof for the time being in relation to

(i) Goods or services of the same description: or

(ii) Goods or services associated with those goods or services of that description

Being goods or services, as the case may be in respect of which the trade
Mark is registered.

(2) Where in relation to any goods or services in respect of which a trade Mark is registered

(a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India) or in relation to goods to be exported to a particular market outside India: or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India and

(b) a person has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark.

on application by that person in the prescribed manner to the Appellate Board or to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub section (1) or for the purpose of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates.\(^\text{19}\)

Hence, in India even if there is no use for a continuous period of 5 years as envisaged in Section 47 (1) (b), the trade mark cannot be cancelled. This may not be the condition in other countries. So there is no uniformity about the cancellation of a mark among the Contracting Party.

The article 9quinquies of the Madrid Protocol provides the transformation of an International Registration into National or Regional Application, in the event that the International Registration is cancelled at the request of the Office of origin. The transformed national applications must be filed within three months from the date on which the international registration was

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\(^{19}\) Trademarks Act, 1999
cancelled and the goods and services listed in the application must have been covered by the list of goods or services contained in the original International registration. In such circumstances, the applicant have to bear more expenses by paying national fees in each designated countries and one of the advantage of the Madrid Protocol become a disadvantage. The provisions of central attack more vulnerable to the applicants from countries that recognize prior use or common law rights like India.

(ii)  **THE INTERNATIONAL REGISTRATION CANNOT EXCEED THE GOODS OR SERVICE MENTIONED IN THE BASIC APPLICATION.**

The basis of International registration is the application of the office of origin and any cancellation or deletion of goods or services from the office of origin will also to be deleted from the International registration. Some countries like U.S.A are not permitting broad specification of goods or services in their country; hence the applicants from these countries cannot specify a broad specification of goods as normally do by many other countries.

(iii)  **THE ASSIGNMENT CAN BE EFFECTED TO AN ENTITY BELONGING TO A CONTRACTING PARTY TO THE MADRID PROTOCOL**

The change in ownership can be recorded only if the transferee is a person who is entitled to file international applications, hence, a transfer of ownership to an entity, which is not a party to the protocol is not possible.

(iv)  **LIMITED MEMBERS.**

Another disadvantage of the Madrid Protocol is its limited membership; especially many emerging economies of Asia are not yet members of the system.

(v)  **NO AMENDMENT OF MARK.**

The amendment of mark is not permitted in the Madrid system. The applicant has to file the same mark where he filed in the Office of Origin; even the slight amendment of the mark will not be entertained by the IB.
2.6. THE PROCESS OF THE MADRID APPLICATION.

An application for the international registration under the Madrid Protocol should be filed through the office of origin and the office of origin is defined in Article 2(2) of the Protocol. According to the protocol the applicant may freely choose his office of origin on the basis of establishment, domicile, or nationality, it being understood that there can be only one office of origin. In the case of the Office of a country, an international application may be filed by anyone who is a national of that country or is domiciled or has a real and effective industrial or commercial establishment in that country. In the case of the office of a Contracting Organization, an International application may be filed by anyone who is a national of a member state of that organization or who is domiciled or has a real and effective industrial or commercial establishment in the territory of that organization.\(^\text{20}\)

\(^{20}\) Guide to the International registration of Marks Published by WIPO page No A. 3.
The International application must be presented to the IB through the Office of Origin and if applied directly to the IB by the applicant will not be considered and will be returned to the sender and any fees paid will be reimbursed.

The International application should be presented to the IB on the official form and the language should be either English or French or Spanish in the case of the Madrid Protocol and should be only French which is governed exclusively by the Madrid Agreement. The International application must contain a reproduction of the mark, which must be identical with that in the basic registration or basic application.\(^1\) The list of the goods and services for which protection is sought, classified in accordance with the International Classification of Goods and Services- Nice Classification.

An International application must designate the contracting parties in which the mark is to be registered. Where the contracting party whose office is the office of origin is a party to the Agreement but not the Protocol, only other states which are also party to the Agreement may be designated. Where the contracting party whose office is the office of origin is a party to the Protocol but not the Agreement, only other Contracting parties which are also party to the Protocol may be designated. Where the Contracting party whose office is the office of origin is a party to both the Agreement and the Protocol, any other Contracting party may be designated.\(^2\)

The Contracting party whose office is the office of origin cannot be designated in an international application nor can it be designated subsequently.

The fees for International Application and Registration are specified in Article 8 of the Madrid Protocol and it subject to the following fees.

(i) A basic fee.

(ii) A complimentary fee in respect of each designated Contracting party for which no individual fee is payable.

(iii) An Individual fee in respect of any Contracting party which is designated under the Protocol and has declared that it wishes to receive such a fee, however, the amount of the individual fee is determined by each Contracting Party may not be higher than the amount that would be payable for the registration of a mark in the office of that Contracting Party.

\(^{21}\) Guide to the International registration of Marks Published by WIPO page No B.II.2

\(^{22}\) Guide to the International registration of Marks Published by WIPO page No B.II.17.
(iv) A supplementary fee in respect of each class of goods and services beyond the third. However, no supplementary fee is payable where, all the designations are ones in respect of which an individual fee has to be paid.

There is a concession to the International applications filed by applicants whose country of origin is a least developed country, in accordance with the list established by the United Nations; the basic fee is reduced to 10% of the prescribed amount.23

The office of origin must certify that the mark is the same as that in the basic registration or basic application, that any indications such as description of the mark or a claim to color as a distinctive feature of the mark are the same as those contained in the basic registration or basic application, and that the goods and services indicated in the international application are covered by the list of goods and services in the basic registration or basic application. It must also certify the date on which it received the request to present the international application and this date will be the date of the international registration.24

The IB checks that the international application complies with the requirements of the Agreement or Protocol, goods and services, fees etc. and if they found any irregularities, will be communicated to the Office of origin and the applicants25 and these must be complied within three months, otherwise the application will be abandoned. Once the applicant comply all the requirements, the mark is recorded in the International Register and published in the Gazette. The IB then notifies each Contracting Party in which protection has been sought.

**EXAMINATION BY THE DESIGNATED CONTRACTING PARTIES**

It is obligatory on the part of designated Contracting Parties examine the International registration in exactly the same way as an application filed directly. Each designated Contracting Party has the right to refuse the protection of the International registration in its territory and such refusal may only be based on the grounds which would apply, under Article 6quinquies(B) of the Paris Convention for the protection of Industrial Property, in the case of a mark deposited direct with the Office which notifies the refusal. If the application is objected at the time of

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23 [www.wipo./madrid/fees](http://www.wipo./madrid/fees)

24 Guide to the International registration of Marks Published by WIPO page No B.III.5

25 Guide to the International registration of Marks Published by WIPO page No B.III.15
examination, or if an opposition filed, the designated Contracting party has the right to declare
that protection cannot be granted in their territory.

The refusal must be notified to the IB within a prescribed time limit, and this time limit is
varying from 12 months to 18 months.26 A Contracting Party that has made this declaration may
further declare that a provisional refusal based on an opposition may be notified even after the
expiry of this 18 month period. It is not necessary that a final decision on the refusal be taken
within the applicable time limit and it is sufficient that all grounds for refusal are notified within
the time limit. When an Office informs the IB, in connection with a given international
registration, of the possibility that opposition may be filed after the expiry of the 18 months
period, it must, where the dates on which the opposition period begins and ends are known,
indicate them in the communication. If such dates are, at that time, not yet known, they must be
communicated to the IB once they become known. The IB will record this information in the
international register, transmit it to the holder of the international registration and publish it in
the Gazette.27

An Office which has sent to the IB a notification of provisional refusal should send a
statement, once all procedures before the said Office relating to the protection of the mark have
been completed, indicating that the provisional refusal is confirmed or is totally or partially
withdrawn and the said statement recorded in the international register and published in the
Gazette. {Rule 17(5)} .

An Office which has not communicated a notification of provisional refusal may, before
the expiry of the applicable time limit for provisional refusal, issue a statement of grant of
protection to the IB. Such statement is recorded in the International Register and published in the
Gazette and a copy is transmitted to the holder.

The holder of an International registration can extent his registration to other countries by
filing subsequent designations if he fulfills the conditions stipulated in Article 1(2) and 2 of the
Agreement or Article 2 of the Protocol and thereby the holder is benefited to get an extension of
protection of the mark to a Contracting Party which was not a party to the Agreement or Protocol
at the time of the international application.28

26 Guide to the International registration of Marks Published by WIPO page No B.III.22
27 Guide to the International registration of Marks Published by WIPO
28 Guide to the International registration of Marks Published by WIPO page No B.III.26
The holder of an international registration may change his name, address, ownership or change his representative. However, in the case of a change of ownership of the international registration, the Contracting Party or Parties in respect of which the transferee fulfils the conditions, under Articles 1(2) and 2 of the Agreement or under Article 2 of the Protocol, to be the holder of an international registration. A person cannot be recorded as the holder of an international registration in respect of a given Contracting Party if he would not be entitled to designate that Contracting Party in an international application.

In nutshell, the basic principles of the International Registration is that is based on the basic application or basic registration in a contracting party of the Madrid System and there should be a connection between the owner named in the basic mark and that contracting party and it should filed through an Office of Origin and it must designate one or more other Contracting Parties with common treaty, it must be noted that a self designation is not possible. The Madrid System is also set time limits for refusal of the application varying from 12 to 18 months and the International Registration is depending on the Basic Mark for 5 years from the date of International Application. The subsequent designations and transformation of national application is possible and the International Registration is centrally managed by WIPO. There are 3 types of Applications (1) Exclusively governed by the Agreement and all designations in this case will be governed by Agreement Rule 1(viii) and MM1 form will be used (2) Exclusively governed by the Protocol and all designations in this case will be governed by the Protocol Rule 1(ix) and MM2 form will be used (3) The applications governed by both Agreement and Protocol and in this case some are governed by Agreement and some are governed by Protocol Rule 1(x) and MM3 forms will be used.

FLOW CHART OF THE MADRID

PROTOCOL APPLICATION

29 Guide to the International registration of Marks Published by WIPO page No B.III.34
CHAPTER 3

REQUIRED PREPARATION TO START THE MADRID PROTOCOL

India must be prepared thoroughly before the accession of the Madrid Protocol and certain amendments of the present Trade mark law are inevitable to accommodate the Madrid Protocol. Changes in the organizational set up of India are also very necessary since the Madrid Protocol imposes strict time limits on the Contracting Parties to dispose of applications for registration of trade marks.

In this chapter, I am focusing in the amendments of the present Trade mark law and the changes required in the organizational set up in India.
The Japan Patent Office has started the preparation for the accession of the Madrid Protocol at the end of the fiscal year 1997. A study was begun on the issues of legislation, business and systems by a subcommittee of Industrial Property Council. They started with three project teams such as 1) Legislation and Fees Team 2) Business operations and systems team 3) Substantial Examination Team. At the beginning of 1998 Researches on Madrid Protocol application procedures are conducted in Germany, U.K and WIPO and the Reports were submitted by the Committee. A discussion regarding the system design has started at the beginning of the year 1999 and they established the International Trademark Application Office by April, 1999. The Trademark Act has also revised in due course. The promotional activity for users has started and they established the Substantial Examination Office by March 2000.


3.1 AMENDMENT OF CURRENT TRADE MARKS LAWS IN INDIA.

The Government of India has already drafted a Bill regarding the amendment of the Trade marks Act, 1999 in the year 2007 as BILL No.65 of 2007.

A new chapter IVA containing Special provisions relating to protection of international registration of Trademarks under the Madrid Protocol is incorporated. The said Bill also proposed to amend the certain other flaws of the Trade marks Act, 1999, more importantly to reduce the time period of filing a notice of opposition of published applications from four months to three months for speedy disposal of proceedings. The chapter X of the Trade marks Act, 1999 dealing with special provisions for textile goods, also proposed to omit since it has become redundant.

The Bill has also proposed to simplify the provisions regarding the transfer of ownership of trademarks by assignment or transmission in accordance with the present international laws and modern business needs, by omitting the sections 40, 41 and 42 and by modifying the section 45 of the Trade marks Act, 1999.

PROVISIONS OF THE TRADE MARKS (AMENDMENT) BILL 2007 TO FACILITATE THE MADRID PROTOCOL AS FOLLOW.

(i) Sub-Section (1) of Section 23 of the Trade marks Act, 1999 modified in the following manner.
Subject to the provisions of sections 19, when an application for registration of a trade mark has been accepted and either-

(a) The application has not been opposed and the time for notice of opposition has expired: or

(b) the application has been opposed and the opposition has been decided in favor of the applicant,

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark within eighteen months of the filing of the application and the trade mark when registered shall be registered as of the date of the making of the said application and the date shall, subject to the provisions of sections 154, be deemed to be the date of registration.

Thus by inserting the words within eighteen months of the filing of the application, it is obligatory on the part of the Registrar to comply the time limit prescribed by the Madrid Protocol.

The new chapter IVA dealing with the special provisions relating to protection of Trade Marks through International Registration under the Madrid protocol and the following sections added to this chapter.

36A. the provisions of this Chapter shall apply to international applications and International registrations under the Madrid Protocol

36B. in this Chapter, unless the context otherwise requires,—

(a) “application”, in relation to a Contracting State or a Contracting Organization, means an application made by a person who is a citizen of or is domiciled in or has a real and effective industrial or commercial establishment in that Contracting State or a State which is a member of that Contracting Organization, as the case may be;

(b) “basic application” means an application for the registration of a trade mark filed under section 18 and which is used as a basis for applying for an International registration;

(c) “basic registration” means the registration of a trade mark under section 23 and which is used as a basis for applying for an international registration;
(d) “Common Regulations” mean the Regulations concerning the implementation of the Madrid Protocol;

(e) “Contracting Organization” means a Contracting Party that is an intergovernmental organization;

(f) “Contracting Party” means a Contracting State or Contracting Organization party to the Madrid Protocol;

(g) “Contracting State” means a country party to the Madrid Protocol;

(h) “International application” means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;

(i) “International Bureau” means the International Bureau of the World Intellectual Property Organization;

(j) “International registration” means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;

(k) “Madrid Agreement” means the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 14th day of April 1891, as subsequently revised and amended;

(l) “Madrid Protocol” means the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time.

36C. Notwithstanding anything contained in sub-section (3) of section 5, an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.

36D. (1) Where an application for the registration of a trade mark has been made under section 18 or a trade mark has been registered under section 23, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.
(2) A person holding an international registration may make an international Application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall Designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application correspond to the particulars appearing, at the time of the certification, in the application under section 18 or the registration under section 23, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall as soon as may be, forward the international application to the International Bureau for registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under section 18 or the registration under section 23, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall be of no effect:

Provided that where an appeal is made against the decision of registration, an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(6) The Registrar shall, during the period of five years beginning with the date of international registration, transmit to the International Bureau every information referred to in sub-section (5).

(7) The Registrar shall notify the International Bureau the cancellation to be Effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case may be.
36E. (1) The Registrar shall, after receipt of an advice from the International

Bureau about any international registration where India has been designated, keep a record of the particulars of that international registration in the prescribed manner.

(2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in India should not be granted or such protection should be granted subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires, refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the advice referred to in sub-section (1) was received.

(3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), he shall without any delay cause such international registration to be advertised in the prescribed manner.

(4) The provisions of sections 9 to 21 (both inclusive), 63 and 74 shall apply

Mutatis mutandis in relation to an international registration as if such international registration was an application for registration of a trade mark under section 18.

(5) When the protection of an international registration has not been opposed

and the time for notice of opposition has expired, the Registrar shall within a period of eighteen months of the receipt of advice under sub-section (1) notify the International Bureau its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.

(6) Where a registered proprietor of a trade mark makes an international

registration of that trade mark and designates India, the international registration from the date of the registration shall be deemed to replace the registration held in India without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the Register referred to in sub-section (1) of section 6.
(7) A holder of international registration of a trade mark who designates India and who has not been extended protection in India shall have the same remedy which is available to any person making an application for the registration of a trade mark under section 18 and which has not resulted in registration under section 23.

(8) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than India has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration in India shall cease to have effect.

36F.  
(1) From the date of the international registration of a trade mark where India has been designated or the date of the record in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark to India, the protection of the trade mark in India shall be the same as if the trade mark had been registered in India.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark.

36G.  
the international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period. 30

3.2 CHANGE OF PRACTICAL WORK FLOW UNDER THE MADRID PROTOCOL.

The filing of Trade mark applications in India are increasing year by year and it’s almost doubled in the last 10 years. However, the number of staffs are not increased proportionate to the filing of the applications and due to the lack of employees, the pendency of various activities in the office are increasing.

The Indian economy is consistently performing better in the last decade and recording 7 - 9% of growth and it is highly important to provide a better service in the field of intellectual

30 Trade marks (Amendment) Bill, 2007.
property to attract more foreign direct investment in the country. Many economists suggested that the IPR protection attract more FDI, if such countries have a large market and have a capacity to imitate the products. India can easily meet these two conditions and therefore the IPR protection is very important.

In the year 2002-03, there were 94,120 trade mark applications filed in India and which has increased to 103,419, in the year 2006-07, nearly 10% increase. Where as in Japan the total number of applications filed in the year 2003 are 123,325 and in the year 2007 are 143,221, increasing by approximately 16%.

As per the USPTO data, the total number of Trademarks applications filed is 267,218 and 394,368 increasing 47.58% for the same period.

It indicates that the filing of Trade mark applications is more in U.S.A and Japan comparing to India. The GDP of U.S.A is $14.264 trillion and the per capita $46, 859 and the GDP of Japan is $4.354.trillion and the per capita is $34,100. Whereas, India s GDP is $3.288 trillion and the per capita is $2,762.

The aforesaid data shows that, there is a relation between the GDP and the filing of Trade mark applications. The USA has GDP of 4 times more than India and the Japan have GDP of 1.3 times more than India. The filing of Trade mark applications in the USA is 3.82 times more than India and the Japan is more than 1.38 times. As and when the Economy grew, the purchasing power of the public will increase and more products will come to the market. At present level of growth of Indian Economy, it is obvious that the Trade mark applications will double in the next decade.

As per the Statistical Data provided in the Annual Report, 2008 of JPO, there are 150 Trade mark Examiners and 386 Appeal Examiners and in the USPTO the total number of Trade

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33 USPTO, Performance and Accountability Report, 2008
34 Countries by GDP (PPP), list published by the International Monetary Fund, 2008
35 List of Countries by GDP (PPP) per capita by International Monetary Fund, 2008
36 Countries by GDP (PPP), list published by the International Monetary Fund, 2008
37 List of Countries by GDP (PPP) per capita by International Monetary Fund, 2008
38 Countries by GDP (PPP), list published by the International Monetary Fund, 2008
39 List of Countries by GDP (PPP) per capita by International Monetary Fund, 2008
mark examining attorneys are 398.\textsuperscript{40} Where as in India, the total number of sanctioned Examiners including Senior Examiners is 31 and out of which only 25 are the working strength.\textsuperscript{41}

The following Data shows the ratio of Number of Trade Mark Applications and the Number of Examiners in the U.S.A, JAPAN and INDIA in the year 2007.

<table>
<thead>
<tr>
<th></th>
<th>TOTAL No. OF TM APPLICATIONS</th>
<th>TOTAL No. OF EXAMINERS</th>
<th>WORKING STRENGTH</th>
<th>AVERAGE OF APPLICATIONS/EXAMINER IN AN YEAR</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>USPTO 394368</td>
<td>398</td>
<td>398</td>
<td>990.87</td>
</tr>
<tr>
<td>2</td>
<td>JPO 143221</td>
<td>150</td>
<td>150</td>
<td>954.80</td>
</tr>
<tr>
<td>3</td>
<td>INDIA 103419</td>
<td>31</td>
<td>25</td>
<td>4136.76</td>
</tr>
</tbody>
</table>

It is clear from the above table that in the US and Japan have similar allocation of work i.e. below 1000 Applications per Year for an Examiner, where as in India it is more than 4000 applications per Year. It is pertinent to the fact that the Indian Examiners are having more than 4 times of work load than that of USPTO and JAPAN Examiners and obviously the quality of Indian Examination will not be up to the standards of those countries. It is high time for India to recruit more Examiners according to the standard of USPTO and JPO to strengthen our IPO and the working strength of Examiners to be increased as 100.

The total number of Trademarks published in the trade mark journal in the year 2006-07 is 104,260 and out of which 18058\textsuperscript{42} opposition filed i.e. nearly 18% of the application advertised were opposed. In addition to this 407 applications for Rectifications also filed. The Trade mark Registry has finally disposed 2327 opposition in that year, which means the office has disposed only 12.60% of the opposition filed. As per the data available in the Annual Reports, more than 90% of the oppositions filed during the period 2001 to 2007 are still pending for disposal.

\textsuperscript{40} USPTO Performance and Accountability Report Fiscal Year 2008
\textsuperscript{41} Annual Report of the Office of the Controller General of Patents, Designs, Trademarks and G.I, 06
\textsuperscript{42} Annual Report of the Office of the Controller General of Patents, Designs, Trademarks and G.I, 06
In India the contested matters in respect of Trademarks normally are posted before the Assistant Registrar, Deputy Registrar and Joint Registrar. At present in India there are only 2 Joint Registrar, 3 Deputy Registrar and 4 Assistant Registrar and they disposed it together 2327 opposition in the Year 2006-07, an average of 258 opposition per person in a year. The efforts of the above officers are appreciable, considering the complexity of opposition matters. Besides, the contested matters the aforesaid officers are also assist the Registrar in all procedural, administrative and supervisory functions connected with the various proceedings under the Act and the Rules. During the period 2001 to 2007, in India 75286 oppositions and 1035 Rectifications filed and out of which 68782 matters are pending for disposal and the present rate of disposal India require another 20 years to clear this backlog. While considering the accumulation of contested matters in the coming years, the data will be out of proportion and the Authorities should consider this matter very seriously and more appointments of hearing officers is to be done at the earliest.

**THE FOLLOWING TABLE INDICATES THE TREND OF OPPOSITION IN INDIA**

<table>
<thead>
<tr>
<th>YEAR</th>
<th>APPLICATION FILED</th>
<th>ADVERTISED</th>
<th>OPPOSED</th>
<th>RECTIFICATION</th>
<th>DISPOSED</th>
<th>PENDENCY IN RESPECT OF OPP/RECT</th>
</tr>
</thead>
<tbody>
<tr>
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<td>98250</td>
<td>2090</td>
<td>127</td>
<td>491</td>
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<tr>
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<td>52110</td>
<td>2065</td>
<td>79</td>
<td>491</td>
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<tr>
<td>2003-04</td>
<td>92251</td>
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<td>85</td>
<td>1289</td>
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<td>1671</td>
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<td>104260</td>
<td>18058</td>
<td>407</td>
<td>2327</td>
<td>16138</td>
</tr>
<tr>
<td>TOTAL</td>
<td>544721</td>
<td>770362</td>
<td>75286</td>
<td>1035</td>
<td>7539</td>
<td>68782</td>
</tr>
</tbody>
</table>

The data compiled by the Author from the Annual reports Published in the website www.ipindia.nic.in
As per the Annual Reports published by the Office of the CGPDTM in the year 2006-07, India have received 15,209 foreign applications for Registrations and approximately 13% of the Trade mark applications in India are foreign origin in the last 6 years and India can expect between 10,000 to 12,000 applications in an year through Madrid Protocol, as and when India acceded the Madrid System, because, most of the foreign applications filed in India originated from U.S.A, European Countries, China, Japan etc. are already members of the Madrid Protocol.

THE TREND OF FOREIGN APPLICATIONS IN INDIA THROUGH
THE YEAR 2000-01 TO 2006-07.

<table>
<thead>
<tr>
<th>YEAR</th>
<th>FOREIGN APPLICATIONS</th>
<th>TOTAL APPLICATIONS</th>
</tr>
</thead>
<tbody>
<tr>
<td>2000-01</td>
<td>17013</td>
<td>84275</td>
</tr>
<tr>
<td>2001-02</td>
<td>10490</td>
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<tr>
<td>2006-07</td>
<td>15209</td>
<td>103419</td>
</tr>
</tbody>
</table>

The data compiled by the Author from the Annual reports Published in the website www.ipindia.nic.in

3.3 ESTIMATION OF WORK LOAD FOR THE NEXT 10 YEARS.
India has witnessed amazing growth in Trade mark applications during 1996-97 to 2006-2007. The number of applications increased from 43234 in the year 1996-07 to 103419 in the year 2006-07, an increase of 239.21% over a period of 10 years. The Indian Economy has posted an average growth rate of more than 7% in the decade since 1997. India achieved 8.5% GDP growth in 2006, 9.0% in 2007 and 7.3% in 2008. Services are the major source of economic growth, accounting for more than half of India’s output with less than one third of its labor force.\(^{43}\) According to the World Trade Statistics of the WTO in 2006, India’s total merchandise trade (counting exports and imports) was valued at $294 billion in 2006 and India’s Services

\(^{43}\) CIA- World Fact Book
trade inclusive of export and import was $143 billion. India’s global economic engagement in 2006 covering both merchandise and services trade was of the order of $437 billion, up by a record 72% from a level of $253 billion in 2004. According to WTO India currently accounts for 1.5% of World trade as of 2007.  

According to many economists India may likely to sustain 8-10% growth in the coming Decade. All the above figures pointing out to a better Economy, better GDP and better per capita in the next decade.

Indian Trademarks applications have increased 2.4 times in the last decade and with the present way of growth, it may touch 200,000 applications in a year within a short period of time and with the present number of staffs it’s not at all practical to deal with such huge volume of applications. India has to adopt a strategic plan to increase the number of staffs according to the world standard and according to the number of applications.

### 3.4 NEW ORGANIZATION FOR THE MADRID PROTOCOL, FUNCTION AND STAFFING

A separate division to be established as and when India accede the Madrid Protocol, purely to deal with the international application routed through the IB and can be named as International Affairs Division (IAD) or Madrid Protocol Division (MPD). The purpose of this department to deal the international applications, strictly adhere to the time limit given by the Madrid System.

The Japan Patent Office has set up a separate department to deal with the Madrid Protocol Applications having 20 Examiners, 10 Trial examiners and 10 clerical staffs. This department has 2 divisions.


This division is responsible for receipt and formality examination of applications for international registration from Japanese applicants under the Madrid Protocol (Madrid Protocol applications) and other related operations, and receipt and formality examination of documents needed for procedures in Japan when Japan is designated for Madrid Protocol applications.

b) International Trademark Application Examination Office.

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44 Economy of India- Wikipedia
This division is responsible for substantive examination of applications for international trademark registration for which Japan is designated, based on notification of designation from WIPO’s International Bureau.

**Organigram of the International Trade Mark Application Office of the Japan Patent Office**

Source - Research report submitted by CHAUDHARY ASFAND ALI, Asst.Director, IPO, Pakistan to WIPO, 2008
Responsibilities of Officers mentioned in the Organ gram

of the International Trade Mark Application Office of JPO

<table>
<thead>
<tr>
<th>Designation</th>
<th>Work Responsibility</th>
</tr>
</thead>
<tbody>
<tr>
<td>④ Deputy Director</td>
<td>Planning and formulation of the administrative work systems for applications for international registration, etc. (of the office of origin and the designated offices)</td>
</tr>
</tbody>
</table>
| ⑥ Assistant Director | - Preparation, management, and distribution of required data for progress management in the administrative work for international applications for registration, etc. (by the office of origin and the designated offices).  
- Liaison and coordination for the progress management in the administrative work (by the office of origin and the designated offices).  
- Statistics related to applications for international registration, etc. (of the office of origin and the designated offices).  
- Dispatch of documents related to applications for international registration, etc. (of the office of origin and the designated offices). |
| ③ Associate Managing Specialist for Electronic Data Management | Administrative work related to the operation concerning the liaison and coordination concerning the paperless system. |
| ① Associate Managing Specialist for Formality Examination. (Person in charge in the office of origin) | - Acceptance of application related to applications for international registration, etc. (the office of origin).  
- The formality examination of filing documents concerning applications for international registration, etc. (the office of origin).  
- The processing of intermediate documents concerning applications for international registration, etc. (the office of origin).  
- The correction and management of data concerning applications for international registration, etc. (the office of origin). |
| ② Specialist for Formality Examination. (Person in charge in the office of origin) | |
| ① Associate Managing Specialist for Formality Examination. (Person in charge in the office of origin) | - Acceptance of application documents concerning applications for international registration, etc. (designated offices).  
- Distribution and processing of intermediate documents concerning applications for international registration, etc. |
<table>
<thead>
<tr>
<th><strong>Specialist for Formality Examination.</strong> <em>(Person in charge in the designated office)</em></th>
</tr>
</thead>
<tbody>
<tr>
<td>Withdrawal and abandonment of applications for international registration, etc. (designated office).</td>
</tr>
<tr>
<td>The preparation, arrangement, dispatch, recovery and safekeeping of file wrapper relative to applications for international registration, etc. (designated office).</td>
</tr>
<tr>
<td>The correction and management of data concerning applications for international registration, etc. (designated office).</td>
</tr>
</tbody>
</table>

In India also similar type of Department to be set up to deal with the Madrid Protocol Application.

### 3.5 PROMOTION OF THE MADRID PROTOCOL APPLICATION.

Before the accession of the Madrid Protocol, the promotion activities to be carried out in the national level, by distributing pamphlets through the branches of the Intellectual Property Office and a brief description about the Madrid system in the web-site and also to conduct seminars in the various parts of India among the attorneys and business industries. The training to the staff of the Trade marks Registry is also highly necessary. In Singapore before the accession of the Madrid Protocol there were two sets of training.

1) **INTERNAL TRAINING**

Training has given to the Madrid study team at WIPO, Geneva and also study visits to Swiss Federal Institute of Intellectual Property, Bern and UK Patent Trade Marks Registry, Wales. An extensive training has also given to the officers and General staff regarding the international registrations.

2) **EXTERNAL TRAINING**

An external training provided to the Trade mark agents and owners by conducting workshops on procedures of the Madrid Protocol in the year 2000 and also conducted Dialogue session for TM agents prior to implementation of the Madrid Protocol. Intellectual Property Office of Singapore also provided wide publicity such as notices to in the Trade Marks Journal, Press statements, Brochures, Announcement on IPOS website and also made a Hotline in a specific time of the day regarding the queries of Madrid System.

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CHAPTER 4
IMPLEMENTATION OF METHODOLOGY

4.1 QUESTIONNAIRE TO TRADE MARK ATTORNEYS

A questionnaire has been prepared and an interview with the Trade mark Attorney was scheduled, who is dealing the Madrid Protocol applications since the accession to the Madrid Protocol by Japan in the year 2000. According to the Attorney’s point of view there are mainly three difficulties they are facing while processing the Madrid Protocol applications.45

a) LANGUAGE

The WIPO sends the compliance reports to the Attorneys in any of the three languages chosen by the parties and this makes the attorneys the problem of learning three languages such as French, English and Spanish. Normally, the Japanese attorneys don't have many difficulties with English Language, however lot of efforts required in respect of French and Spanish and sometimes the attorneys have to send this report for translators to translate to either Japanese or English and it consumes lot of time and causes more expenditures.

b) CLASSIFICATION AND DESCRIPTION OF GOODS.

There is no uniformity among the members about the classification and acceptable descriptions of goods and services. WIPO may make different decisions regarding classes, which the JPO determined in the basic Japanese registrations. Since there are countries which accept comprehensive designations and those which only accept narrow designations and hence, the acceptability of descriptions cannot be evaluated at the filing stage and it will cause issuance of unnecessary office actions.

c) FINAL INFORMATION OF INTERNATIONAL REGISTRATIONS.

There is no uniformity among the members about the issuance of the registration certificates. There are many countries issue registration certificates and some other countries never issue registration certificates. We understand that registration of an International Registration is confirmed if we do not receive a provisional refusal within a certain period. However, the clients often ask the attorneys exactly when the registration is confirmed and the attorneys are facing the problem at that time and hence, in order to clarify the result of filing, the attorney’s view that every country issues a registration

45 Interview with Mr. Hiroshi Suzuki, Shiga International Patent Office
Further to this, the necessity of amendment of description of Goods and Services may occur at the examination stage in each country and as a result, the description may differ in each country. In order to clarify the range of registration in each country, the attorneys view that each country should publish the descriptions finally registered and a certificate should be issued.

According to the Attorney, the major disadvantage of the International Registration is the enforcement of the trade marks rights vary from country to country. The international application is filed by the applicant or attorney without having adequate knowledge of laws prevailing in the designated countries and without consulting with the local attorneys. It may be easy to get the international registration through the Madrid Protocol. However, the content of registration obtained through the Madrid Protocol is not always suitable for execution of the right in a certain country. For example, if the client registers the trademark in the USA for goods which are not in use in the USA, execution of the right may not be allowed on the grounds of a fraudulent act. Hence, for the important marks, the attorneys consult with the foreign attorneys in advance and sometimes file applications which suits better to a specific country through the Paris route.

As per the views of Attorney, some of the procedures of the Madrid Protocol require urgent attention to avoid confusion. There is no uniform communication route among the members of the Madrid Protocol. Some designated countries forward the notifications to WIPO as well as to the applicant and some countries do not, the notifications send by the designated country directly to the applicant reach faster than the notification sends by the WIPO. In such cases, it creates confusion in the minds of the applicant, since the notification sends by the WIPO have not yet received by the attorneys. Moreover, it appears that there are kinds of notifications which are forwarded only to the applicants, and if the notification is important, there is a risk that the applicants would not notice the importance of the notification. Hence, the attorneys wish that each designated country does not send notifications directly to the applicants and if possible, the route of communications should be limited to the following manner - DESIGNATED COUNTRY- WIPO-COUNTRY OF ORIGIN- ATTORNEY-APPLICANT.

Finally attorney’s point of view, a country should accede to the Madrid Protocol to promote and expand the business of its industry globally by the protection of their mark in an easy and inexpensive way and it is the best available option at present, even though the system has some drawbacks.
A questionnaire has also been prepared and sent it to some of the attorneys in India for their opinion about the accession to the Madrid Protocol by India. Most of them agreed that the accession to the Madrid Protocol by India is essential according to the present economic scenario in India. They are of the opinion that the Indian Trade Marks law to be strengthened and harmonized with the International trends and it is high time that India became party to the system. Further, according to them, the proposed Amendment of the Trade mark law may be sufficient for technical implementation of the Madrid Protocol, however, practically there still exist a number of loopholes in the law coupled with The Trade mark registry’s present infrastructural issues, and the practical implementation will be extremely difficult. The attorneys feel that the Indian Trade mark registry is over burdened with the work and it require sufficient staff. The volume of applications has increased considerably; however the recruitment of officials has not kept pace, delays the registration. The lack of training to the staff aggravates the problem further.

**4.2 QUESTIONAIRE TO JAPAN PATENT OFFICE AND STUDY ON JPO HOW EFFECTIVELY IMPLEMENTED THE MADRID PROTOCOL.**

A questionnaire has been prepared and was send to JPO about their views regarding the Madrid Protocol. The JPO has taken various steps before implementing the Madrid Protocol in the year 2000. JPO has started the preparation for accession of the Madrid Protocol in the fiscal year 1997.

**STEP-1 FEASIBILITY STUDY**

The feasibility study intended for overcoming the Legislative hurdles. The time period for refusal under Madrid Protocol is the maximum period of 18 Months, whereas, during that time in Japan the pendency was 22 months and their first priority to reduce the period for refusal. The other obstacles they faced are the language and publication. The International Register, having the languages of French and English and the National Register is in Japanese. The Gazette of WIPO published in French and English and JPO required publishing the Gazette in Japanese.

**STEP-2 USER SURVEY**

JPO conducted a user survey in the year 1998 and 94% of the companies agreed that the Japan’s accession to the Protocol will benefit their company and 95% also stated that they will consider making use of the Protocol for filing abroad.

**STEP-3 MEASURES TO EXPEDITE EXAMINATION PROCESS**
JPO has initiated action to reduce the pendency of period for refusal from 22 Months in the year 1996 to 17 months in the year 1998. They have outsourced the prior searches for figurative marks and the computerization of examination processes also started. At the time of the accession of the Protocol in the year 2000 the period for refusal reduced to 11.1 months.

STEP-4 SUPPORT MEASURES ON MADRID PROTOCOL EXAMINATIONS

JPO has set-up two divisions (1) International Trademark Application Office (2) Madrid Protocol Examination Division. They prepared the manuals for Examination of the Madrid Protocol Applications and also made a Computer system for the Protocol.

STEP-5 REVISION OF TRADEMARK ACT

JPO started the process for the implementation of the Madrid Protocol (1) For the Office of Origin (2) For the Office of Designated Office. The important provisions of the trademark Act drafted.

(i). INSTITUTIONAL STEPS.

The amendment of the relevant Japanese law to facilitate the Madrid Protocol applications and some of the important provisions as follows-

- Stipulate the statutory period for examination within 18 months.
- Incorporate the provisions concerning applications for international registration from Japan to WIPO’s International Bureau.
- Stipulate special provisions concerning applications for International trademark registration, where Japan as designated country.
- Stipulate special provisions concerning applications for trademark registration in respect of Central attack.
- Improve the provisions concerning the fee structure covering commissions for individual fees set out in the Madrid Protocol.

(ii) OPERATIONAL STEPS.

- Development of computer systems for administrating the information on applications and registrations under the Madrid Protocol.
• Setting up the International Trademark Application Office and the International Trademark Application Examination Office to which Officers who have completed training programs provided by WIPO’s International Bureau are assigned.

(iii) OTHER STEPS.

• Training has given to examiners at WIPO and also extensive Training given in Foreign Language

• Enlightenment and publicity for Japanese users by way of seminars and booklets

• Working-level briefing sessions for Intellectual property systems
  Every year, around October, gives lectures regarding the outline of the Madrid system and application procedures in four cities

• A Text book named as - Guidance on procedures for Application for International registration- describing the outline of the Madrid system, how to apply for registration with the home country’s patent office, and how to apply for registration with a designated country’s patent office

• A guide book has also prepared, named as- Application Forms for International Registration- describing how to fill out applications forms
  And other forms and their translations for reference purpose

• Booklets named as – How to use the System for International Trademark Registrations- intended for beginners explaining the outline, procedures, Fees, advantages and disadvantages, and other key points for the Madrid System

• The JPO has also created an e-learning program me, named as – Outline Of Procedures for Madrid Protocol Applications- provides learning Environment that is available for users and their agents at any time

  The JPO has also conducted an International trademark seminar in March 2006 and lectures were given by JPO’s Commissioner and WIPO’s Deputy Director General and also lectures and panel discussions by the World’s big users of the Madrid Protocol.
4.3 HYPOTHESIS 1 THE CHANGES REQUIRED IN THE PRESENT TRADE MARKS LAWS IN INDIA

The proposed Trade marks (Amendment) bill 2007 covers almost all areas to facilitate the Madrid Protocol in India, however some of the provisions need further clarifications to avoid confusion and smooth implementation.

i) CLASSIFICATION OF GOODS AND SERVICES.

At present, there are only 42 classes of Goods and Services in India, whereas most of the countries has classified their goods and services into 45 classes. India still follows the 7th Edition of NICE CLASSIFICATION which provides only 42 classes, whereas most of the countries follow the 9th Edition of NICE CLASSIFICATION. The amendment of the classification of Goods and Services from 42 classes to 45 is highly essential to accommodate Article 5 of the Madrid Protocol. The NICE CLASSIFICATION of Goods and Services amended from 42 classes to 45 in the year 2002 and even after 7 years India still follows the old classification. This amendment should be considered on priority basis and system to be modified accordingly.

ii) TRANSFORMATION OF AN INTERNATIONAL REGISTRATION INTO NATIONAL OR REGIONAL APPLICATIONS.

The Article 9quinquies of the Madrid Protocol states that-

where , in the event that the international registration is cancelled at the request of the Office of origin under Article 6(4), in respect of all or some of the goods and services listed in the said registration, 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 according to Article 3(4) or on the date of recording of the territorial extension according to Article 3ter(2) and, if the international registration enjoyed priority, shall enjoy the same priority, provided that

(i) such application is filed within three months from the date on which the international registration was cancelled,

(ii) the goods and services listed in the application are in fact covered by the list of goods and services contained in the international
Registration in respect the Contracting Party concerned, and

(iii) Such application complies with all the requirements of the applicable law, including the requirements concerning fees.

The proposed Bill does not contain any provisions regarding the transformation of an international registration into National or Regional application, hence appropriate steps to be taken by way of inserting provisions for Article 9quinquines of the Madrid Protocol.

iii) TRADE MARK APPLICATION BASED ON TERRITORIAL EXTENSION.

The proposed Bill does not contain any provisions regarding the territorial extension subsequent to an international registration and the date on which such extension become effective in India. The territorial extension has been explained in Article 3ter (2) of the Protocol. In this regard the Japanese law is very clear and provision has provided under article 68novies as follows-

A request for territorial extension with respect to Japan shall be considered to be an application for trademark registration having been filed on the date of international registration made in accordance with Article 3(4) of the Protocol (hereinafter referred to as the date of international registration). However, in the case of later designation, under Article 3ter (2) of the Protocol, the application for trademark registration shall be considered to be the application having been filed on the date (hereinafter referred to as the date of later designation) on which later designation is recorded in the register of the International Bureau defined in Article 2(1) of the Protocol (hereinafter referred to as International Register).

Hence, a new clause to be provided in the proposed Bill

(iv) PROVISIONS REGARDING THE COLOR MARK

The proposed Bill does not containing any provisions regarding the color as distinctive feature of the mark as provided in the Article 3(3) of the Madrid Protocol. In such case the applicant shall indicate in the request a statement to that effect and the description of the color or the combination of colors affixed and also shall append to the request copies in color of the trademarks relating to the application for trademark registration.

(v) FORMS TO BE REDUCED AND SIMPLIFIED.

As per the SCHEDULE II of the Trade Marks Rules, 2002, in India, there are 74 TM forms and this to be reduced and simplified for a user friendly environment. Moreover, few
additional forms to be introduced such as for transformation of international registrations and replacement of national registrations

**HYPOTHESIS 2  THE CHANGES REQUIRED IN THE PRESENT ORGANIZATION SET UP INDIA**

At present, India is not well equipped to dispose of the Madrid Protocol applications within the time limit framed by the IB. There are number of issues in respect of the infrastructure to be considered before the accession of the Madrid Protocol.

(i). **INADEQUATE STAFF.**

Lack of adequate staff is one of the major drawbacks of the Indian Trade mark Registry. In developed countries like, US and Japan, the ratio of application per examiner is less than 1000 per year, whereas as in India it is more than 4000 application. Hence, the number of examiner is to be increased according to the standard of those countries. The volume of applications has increased considerably in the last few years, whereas the recruitment of officials has not kept pace according to that proportion. Approximately 90% of the opposition filed during the period 2001-2007 are pending for disposal and the number of hearing officers is to be increased to dispose these oppositions in time. In Japan the Appeal Examiner normally handles 150 cases per year, both appeals and inter-parties trials, whereas as in India an average of 258 cases per person disposed in the year 2007. An increase in skilled work force would be a great help to achieve the target in time.

(ii) **MORE ACCURATE DATABASE.**

The present database of the trade mark registry is not the most accurate and still there is a lot of discrepancy between the paper records and electronic records and is currently making all requisite efforts for improvisation and digitization. An electronic communication should be developed between the Registry and the applicants and the data should be more transparent. The online system needs to be more robust and user friendly to promote the online filing.

(iii) **LACK OF TRAINING.**
Another major drawback of the present system is the lack of training to their staff. Proper training should be given to the employees especially regarding the new concepts of the trade marks. An in house training division should be set up and meetings should be held at least once in a month and opportunity should be given to each officer to present certain topic regarding the emerging concepts of the trade marks. The concept of work from home is also to be developed and opportunity to be given to the employees to work from their home at least one week in a month.

CHAPTER 5

CONCLUSION AND RECOMMENDATIONS

Accession to the Madrid Protocol by India is essential to harmonize with the international trends. It will help the Indian industry to get their mark registered in multiple countries without much hassles and in a more cost effective way. There is a conscious effort being made in every sector of the Indian economy to reach an acceptable level where the accessibility to India does not appear to be limited or restricted. While considering the economic growth achieved by India in the last few years and interest among the foreign investors, the accession of the Madrid Protocol is one of the best ways to promote the global trade.

RECOMMENDATIONS

1) The Number of Examiners should be increased from the present 25 to 100 and the ratio of Application/Examiner should be below 1000 in a year.

2) The Number of Hearing Officers should be increased from 10 to 90 and the ratio of Opposition/Hearing Officer should be 200 per year.

3) Prior to the accession of the Madrid Protocol India should ensure that the backlog in respect of data entry, Digitization of old records, Examinations, Post registrations functions such as Assignment, renewal, licensing etc should be cleared and also take initiative to clear the oppositions on priority basis.

4) The 9th Edition of Nice classification of Goods and Services should be incorporated instead of the present 7th Edition of Nice classification of Goods and Services and also the process of re-classification of Services to be done at the earliest.

5) The proposed Bill of the Trade Marks (Amendment) 2007 require some more modifications such as the provision for transformation of International registration into national application,
provisions for territorial extensions etc. and it should be ensured that such changes were incorporated before the final submission of the bill to the parliament.

6) An in house Training department to be setup and training should be imparted to the Trade mark officials about the emerging concepts of the Trade marks.

7) India should promote the online filing and encourage the Attorneys to file online applications and should ensure that at least 80% of the applications to be filed through online and it will lessened the burden of the Trademark registry and the chances of error in respect of data will be reduced.

8) It is also recommend that exchange of electronic communication, instead of the present paper communication, with the Attorneys to enhance accuracy and better service.

9) The powers should be decentralized and the officers should be more accountable.

10) The Online system needs to be more robust and user friendly, making computer records more visible to the general public in terms of the extent of information displayed to achieve greater transparency.
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