

NEWSSTAND

Client Advisory - India to Implement Madrid Protocol

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On 18 December 2009, the Lok Sabha (Lower House of the Indian Parliament) passed The Trade Marks (Amendment) Bill, 2009, which will implement the Madrid Protocol into Indian Trade Mark Law. It also amends the Indian Trade Mark Act to align it with the Protocol.

As a result, it is imminent that India will accede to the Madrid Protocol as soon as the Bill is ratified by the Rajya Sabha (Upper House of the Indian Parliament) and brought into force.

Implications for brand owner

Once India's accession is confirmed, multinational brand owners will be able to designate India when filing international trade mark applications under the Madrid Protocol. This will reduce the cost and resources involved in securing trade mark protection for international brands in India. More importantly, it will hopefully speed up the examination and grant in India. Furthermore, it could make administration and renewals easier.

Owners of CTM applications will be able to extend protection to India as well because of the link between Madrid Protocol and CTM.

Indian companies will also be able to file trade marks internationally at significantly lower cost, which will undoubtedly spur the rapid expansion of Indian brands internationally.

The Bill also provides that all unopposed trade mark applications shall be registered within 18 months of the application date, which will put added pressure on the Indian Registry to deal with applications more quickly and efficiently.

Pitfalls

However, the current Indian legal framework does not provide the full benefit of the Madrid Protocol to foreign applicants.

Firstly, under the Indian Advocates Act, any advice from a foreign attorney in relation to business in India is regarded as void. Consequently, any prosecution of a trade mark application under the Madrid Protocol in India will still need to be carried out through local representatives.

Secondly, the current version of the Indian Trademark Rules, 2002 provides that all parties who apply for trade mark protection in India must have an address for service in India. This again means that local representatives will need to be retained for the purposes of designating India under the Madrid Protocol.

Conclusion

Multinational brand owners will soon be able to use the Madrid Protocol to apply for trade mark protection in India. The benefit will be enhanced if the existing hurdles are addressed. It is anticipated that these issues will be addressed to facilitate the implementation.

If India does not amend the rules relating to foreign representation this may dampen the impact or effects of the Protocol. In which case, the only beneficiaries will be Indian law firms and India could become an attractive forum for outsourcing trade mark prosecution work.

This advisory is for guidance only and is not intended to be a substitute for specific legal advice. If you would like further information, please contact the Edwards Angell Palmer & Dodge LLP attorney responsible for your matters or the attorney listed below:

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