

## **B. Kaushik & Associates.**

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### **Q.151 Who can make application for International registration of trademark from India as an office of origin?**

**Ans.** A person (including a legal entity):

- who is a citizen of India, or domiciled in India, or
- who has a real and effective industrial or commercial establishment in India, and
- who has got a registration of a trademark or whose application for registration of trademark is pending in Indian office ,  
may make application for international registration of his trademark.

You can file international application of Trademark either offline (physical submissions) or through online mode from the site given herewith [www.ipindia@nic.in](mailto:www.ipindia@nic.in).

### **Q.152 How do I file an application for an International Trademark Registration?**

**Ans.** You must already have – or have applied for – a national trademark registration (known as your “basic mark”) through your home IP Office (“Office of origin”) before you can file an application for an international trademark registration.

**Form MM-2E** is used to file application for international registration of trademark under the Madrid System.

Application must be filed through the gateway for online filing of International applications made available at the official website [www.ipindia@nic.in](http://www.ipindia@nic.in),

### **Q.153 What is Madrid System?**

**Ans.** The Madrid System is a convenient and cost-effective solution for registering and managing trademarks worldwide. File a single international trademark application and pay one set of fees to apply for protection in up to 130 countries. Modify, renew or expand your global trademark portfolio through one centralized system.

### **Q.154 Why did Madrid protocol came into force?**

**Ans.** Having regard to the practical difficulty in filing applications for registration of trademark in each country, with different laws, languages and fee payment in different currencies, an international agreement gave birth to the Madrid Protocol administered by a specialised agency of the United Nations, called the World Intellectual Property Organisation (WIPO). This protocol facilitates international registration of trademark and provides a means for securing protection to such marks in one or more member countries under the Madrid System.

### **Q.155 Who can use the Madrid System?**

**Ans.** You can use the Madrid System if you are a national of or have a domicile or business in any of the 130 countries covered by the Madrid System's [https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid\\_marks.pdf](https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid_marks.pdf)

### **Q.156 Who are the members of Madrid Union?**

**Ans.** The Madrid Union is made up of Contracting Parties to the Madrid Protocol.

The office of the Contracting Party in which you apply for or register your basic mark is referred to as the "**Office of Origin**". In your international application, you can select Contracting Parties in which you would like to protect your mark, or you can expand the geographical scope of your international registration under the Madrid System at a later time.



### **Q.157 Is trademark registration limited to particular territory where it gets registered?**

**Ans.** Yes, Trademark registration is subjected to territory where it gets registered. When a trademark is registered in India, the registration provides protection only within India. A trademark owner needs to obtain international trademark protection for its protection outside India. When trademark owners have national registration/application is filed for such registration of Trademark, they can apply the mark outside India and ensure that third parties do not apply for the same trademark in the global market.

### **Q.158 When did International trademark registration introduced?**

**Ans.** The Trademarks Act, 1999 was amended to comply with the Madrid system after India became a member of the Madrid Protocol. On 21 September 2010, the Trademarks (Amendment) Act, 2010 was passed, and the international trademark registration under the Madrid Protocol was introduced in India.

### **Q.159 Why there is a need to obtain protection of trademark internationally?**

**Ans.** With the expansion of International trade and commerce, the need to obtain protection of trademark becomes very important for commercial enterprises to register not only in one's own home country but also in other countries.

### **Q.160 What is the meaning of the term “basic application” for registration of Trademark ?**

**Ans.** Basic application means an application filed under section 18 of Trademark Act, 1999 for the registration of Trademark in one's own country which is used as a basic necessity for applying for an international trademark registration.

### **Q.161 What is the meaning of the term “basic registration” under Trademark act, 1999?**

**Ans.** Basic registration means the registration granted under section 23 of Trademark Act, 1999 in one's own country which will be used as a basic necessity for getting international registration of trademark.

### **Q.162 What are the pre requisites for applicant making an application to register the trademark internationally?**

**Ans.** Following are the requirements to be fulfilled before making application for international trademark registration:

- The applicant should be domiciled in India, be an Indian national or has an effective and real business or commercial establishment in India.
- The applicant must have a trademark registered with the Indian Trademarks Registry or must have applied for a national trademark application in India. The national trademark application/registration acts as the basis of the international application.
- The applicant should apply for an international application for the same trademark for which the national trademark registration is obtained or mentioned in the national trademark application.
- The list of goods and services in the international application should be the same as on the national trademark registration or application.
- The applicant must choose one or more Madrid Protocol member countries where they want protection in the international application.

### **Q.163 In which form, application for international registration of trademark filed?**

**Ans.** Any person can make application for registration of trademark internationally only if he had applied for registration or is registered owner of the trademark in their own country. After

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that, applicant or the registered owner may make an international application in the form prescribed by the common regulations for international registration of that trademark.

**Form MM-2E** is used to file application for international registration of trademark under the Madrid System. The applicant must specify all the countries in which they seek registration which are known as designated contracting parties.

#### **Q.164 What is the meaning of the term “Contracting Party”**

**Ans.** The term “Contracting Party” denotes any country as well as any inter-governmental organization (the European Union, for instance) which is party to the Madrid Protocol.

#### **Q. 165 What is the meaning of the term “Office of Origin”?**

**Ans.** The Office of Origin is the office of the Contracting Party through which the applicant derives entitlement to file the international application. It is the Office in which the basic application will have been filed or the basic registration will have been recorded.

#### **Q.166 Is International application for registration of trademark be checked by the registrar of the origin country?**

**Ans.** Yes application made by the applicant for international registration be first checked by the Trademark registry. If the international application does not meet the requirements, the registrar shall not forward it to the International Bureau. A notice to comply with the requirements shall be sent to the applicant by the registry of trademark. Application will be forwarded to WIPO only after such compliances have been made within the period specified in the notice.

#### **Q.167 How the application for international registration of trademark proceeds further after submitting FORM MM-2E?**

**Ans.** The Registrar of Trademarks (office of origin) will process and verify the application. After verification, the Registrar will forward the international application within the time period of two months from the date of receipt of the said application to the International bureau for registration, which scrutinizes International application received from the office of origin.

[International Bureau means office of World Intellectual Property Organisation (WIPO)].

The applicant must file the international trademark application electronically through the official IP India website and pay the handling fee. The site link is given herewith for your reference.

<https://ipindiaonline.gov.in/trademarkefiling/user/frmLoginNew.aspx>

#### **Q.168 How the irregularities in the application for international registration of trademark be communicated to applicant?**

**Ans.** While scrutinizing the application by the International Bureau, if they discovered any irregularities in the application, the comments made by them will be communicated to the office of origin and the applicant’s authorised representative, who must rectify the irregularities within the prescribed period.

#### **Q.169. How the international certificate of registration of trademark be granted?**

**Ans.** After completion of all the formalities, the trademark is registered in the International register. The trademark will be published in the WIPO Gazette of International Marks, and Certificate of registration will be issued.

The International bureau will subsequently notifies the designated contracting party about the International registration.

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### **Q.170 Is multiple application for registration of trademark to be filed for multiple jurisdiction?**

**Ans.** No, there is no need to file multiple application for registration of trademark, The Madrid System allows for registration in multiple jurisdiction without the need for multiple individual applications.

Applicant needs to only specify the countries where they seek registration.

### **Q.171 How much time will it take to register an international application of trademark ?**

**Ans.** Once the application is filed, the international bureau of WIPO reviews it to ensure that it complies with the Madrid System's requirements. If the application is approved, the international bureau forwards it to the national trademark office for examination and registration.

The national offices have upto 18 months to decide whether to approve or reject trademark registration. If the trademark is approved, it is registered in each country where protection is sought.

### **Q.172 From where to do "Trademark search" before applying for international trademark registration?**

**Ans.** The applicant must do a Trademark search before applying for international trademark registration. The applicant can conduct a trademark search on the WIPO's Global Brand Database to determine if any similar or identical registered trademark exists. Website link is given herewith for your reference. <https://www.wipo.int/reference/en/branddb/>

The applicant must ensure that no similar or identical registered trademark exists in any of the Madrid Protocol countries where he/she is planning to apply for trademark registration. If a similar or identical trademark exists, the application will be rejected.

### **Q.173 Can member countries refuse the application to register the trademark in their nation?**

**Ans.** The WIPO will issue a notification regarding the international trademark application to each Madrid Protocol member country where the applicant chooses to obtain registration. The member countries will examine the international registration application as per the trademark regulations and rules applicable to them.

The member countries will submit the examination report and notify the acceptance or refusal of the application to the WIPO within 12 to 18 months of receipt of trademark registration application.

### **Q.174 What is handling fee?**

**Ans.** A handling fee shall be payable to the registrar for certification and transmittal of international application to the International Bureau and fees shall be paid in Indian rupee electronically along with the application.

### **Q.175 What is the duration of International trademark registration?**

**Ans.** The international registration of trademark at the International Bureau shall be valid for a period of ten years and may be renewable for further ten years upon payment of the required fees to the WIPO.

### **Q.176 Is international registration of trademark depend on the registration of basic mark?**

**Ans.** An international registration remains dependent on the mark registered or applied for in the Office of origin, for a period of five years from the date of its registration.

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If the basic registration cease to have effect or the basic application is refused or withdrawn or treated as abandoned within the five-year period, the international registration will no longer be protected.

#### **Q.177 Where can the list of Contracting Parties to the Madrid Protocol, be found?**

Ans. The list of members can be found at –

[https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid\\_marks.pdf](https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid_marks.pdf)

The list of members is also available on Form MM 2E, the application for international registration of mark.

#### **Q.178 Define the procedure for international registration under the Madrid Protocol?**

Ans. The following is the procedure to file an application for international registration of trademark:

- Application must be filed only through the gateway for on line filing of International applications made available at the official website [www.ipindia@nic.in](http://www.ipindia@nic.in),
- The Trade Marks Registry (TMR) verifies the eligibility of the applicant and contents of the International Application vis-à-vis basic registration/application;
- When the International Application is not proper, the TMR sends a deficiency letter to the email of the applicant. The applicant shall prepare a reply to the deficiency letter and upload it along with supporting documents, if any, through the gateway;
- When the International Application is proper the TMR certifies and transmits such applications to the International Bureau of WIPO;
- The fee for international application and the individual fee/Complementary fee for designated countries wherever applicable is to be paid directly to the International Bureau of the WIPO, in Swiss Francs;
- The IB of WIPO examines such applications for formalities;
- In case of any irregularity (regarding the classification of goods or services, for instance) is found, the IB communicates such irregularities to the TMR as well as to the applicant;
- If the International Application is found to be proper by the IB of the WIPO. It is registered with the IB, published in the WIPO gazette and transmitted to the offices of the designated Contracting Parties.

#### **Q.179 When did India get accession to the Madrid Protocol?**

Ans. On April 8th of 2013, the Hon'ble Minister of Commerce & Industry, the Government of India, deposited the instrument of accession to the Madrid Protocol, with the Director General of the WIPO and accordingly, the provisions of international registration under the Madrid Protocol came into effect in India since July 8th of 2013.

#### **Q.180 What is provisional refusal ?**

Ans. Provisional refusal means a declaration by the Office of origin, outlining the grounds on the basis of which protection cannot be granted to the international application made by the applicant.

Some common grounds for provisional refusal in India include conflicts with existing trademark registrations or applications, descriptive or non-distinctive trademarks, and marks that are against public policy or morality.

When the Indian trademark office issues a provisional refusal, it provides a detailed explanation of the grounds for refusal and a deadline for the applicant to respond.

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### **Q. 181 What is the time limit for reply to the provisional refusal of application?**

**Ans.** A reply to provisional refusal is to be filed within 30 days from the date of receipt of provisional refusal. An extension of one month can be sought for replying to the provisional refusal. The reply must be filed by the authorised representative competent to practice before Indian TM Registry or by Applicant if it is having an office/address for service in India.

### **Q.182 How to Respond to a Provisional Refusal in India?**

**Ans.** If you receive a provisional refusal for your trademark application in India, you have the right to respond to the refusal. Here are the steps you should follow to respond to a provisional refusal in India:

- Review the grounds for refusal: Carefully review the provisional refusal notice to understand the reasons for the refusal. This will help you to prepare a well-crafted response.
- Analyse the refusal: Based on the grounds for refusal, analyse your trademark application and assess whether there are any issues that need to be addressed. You may need to provide additional evidence, arguments or amendments to your application to overcome the grounds for refusal.
- Prepare a response: Based on your analysis, prepare a detailed response that addresses the specific issues raised in the provisional refusal. Your response should be in writing and include all the necessary evidence and arguments to support your trademark application.
- Submit your response: Submit your response to the Indian Trademark Office within the deadline specified in the provisional refusal notice. Failure to respond within the deadline will result in the abandonment of your trademark application.
- Attend a hearing, if required: In some cases, the Indian Trademark Office may require a hearing to be held to discuss the issues raised in the provisional refusal. If a hearing is required, attend the hearing and present your case.

### **Q. 183 How to calculate the fee for filing international application of trademark?**

**Ans.** The basic fee for filing international application for registration of trademark, which is consists of either 653 Swiss francs for a mark in black and white, or 903 Swiss francs for a mark in colour. This fee is for payment to the International Bureau.

It is recommended that the applicant use the electronic Fee Calculator, which is available on the Madrid system website at the following address:

<http://www.wipo.int/madrid/en/fees/calculator.jsp>

### **Q.184 What is the time period for making renewal application for international registration of trademark?**

**Ans..** You can renew your international trademark registration at the earliest six months before the ten-year term of protection expires, or within the six-month grace period following its expiry. Important! Surcharges apply if you renew during the grace period.

### **Q.185 How the fee is payable for making international application of trademark from India?**

**Ans.** The applicant may directly pay the fees to the International Bureau in Swiss France or through the trademark registry.

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If he opt to pay the fee directly to the International Bureau then in such scenario, the applicant had to firstly notify the Director General for the same.

#### **Q.186. What should be the language of International Application?**

Ans. The international application may be in English, French or Spanish, according to what is prescribed by the Office of origin.

The Office of origin is entitled to restrict the choice of the applicant to just one language, or to two languages, or indeed, the Office may permit the applicant to choose between any of the three languages.

Thus, the applicant should ascertain from the Office of origin which language or languages must or may be utilize, in advance of the filing of the application through that Office.

#### **Q.187 Can I make an additional address for correspondence?**

Ans. Yes, you can mention an additional address for correspondence. Where the applicant requires that that communications be sent to an address other than that as mentioned in the application form, field of “Address for correspondence” is filled.

#### **Q.188 Can two or more applicants jointly file an International application of trademark?**

Ans. Yes, two or more applicants may jointly file a single international application, provided that the basic application or the basic registration is jointly owned by them.

Where there is more than one applicant, the name and address of each applicant should be given, if necessary using a continuation sheet.

#### **Q.189. What are the documents required for making an international application of trademark?**

Ans. The following documents are required for making an international application of trademark:

- Identity proof;
- Address proof;
- Business Registration( CIN, Partnership, MSME);
- International Application Form MM-2E;
- Copy of Trademark- Word or Logo;
- Trademark Registration Certificate/Application Master Page proof (if application is pending) in Domestic country.

#### **Q.190 What are the things one should kept in their mind before applying for registration of trademark internationally?**

Ans. You need to keep the following things in mind when applying for International Trademark Registration-

- Ensure that the trademark is not yet registered in the countries you are seeking registration.
- Make an International trademark search on WIPO's broad database to check all registered trademarks. Search can be done from the link attach herewith <https://branddb.wipo.int/>
- The search can be performed using the text, image or class of goods or services.
- You must get the trademark in your home country before applying for international trademark registration.
- Your country must be a part of the Madrid System
- You can choose multiple countries when applying for international trademark registration, so decide beforehand which country you are going to apply and accordingly the fee will be applicable.

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### Q. 191 How can I check my International Trademark application status?

Ans. By following the below given steps you can Check Trademark Status –

Step 1: Access IP INDIA Website. <https://ipindiaservices.gov.in/eregister/eregister.aspx>

Step 2: Select International Registration Number.

Step 3: Provide Trademark Application Number.

Step 4: View Trademark Application Information on clicking on application number reflecting as hyperlink.

### Q.192 How can we know whether a similar mark have already been registered in same type of goods in internationally?

Ans. Before submitting your international application, double-check to ensure that your mark will not infringe on any existing trademark anywhere in the world. Of course, you can file without conducting the background check, doing so puts you at risk of being sued for trademark infringement.

The most reliable source of this kind of information is the global brand database of WIPO itself. You can conduct any trademark search by text or pictures and view the displayed results <https://branddb.wipo.int/>

### Q.193 What is the international classification of products and services?

Ans. International Classification of Goods and Services also known as the Nice Classification It is updated every five years. Class 1 to 34 include goods and Class 35 to 45 embrace Services. Link is given herewith from where you can reach the Nice Classification.

<https://nclpub.wipo.int/enfr/>

### Q.194 In which form application for renewal of international trademark is filed?

Ans. **Form MM-11** is filed for filing the application of renewal of international trademark.

You can renew your international trademark registration at the earliest six months before the ten-year term of protection expires, or within the six-month grace period following its expiry. Important! Surcharges apply if you renew during the grace period.

### Q.195 What is assignment?

Ans. Trademark proprietors can transfer trademarks similarly to how they can transfer physical properties. One of the ways to transfer a trademark is through an assignment.

Assignment means transferring rights, interests, titles and benefits from one person to another.

**Assignment of a trademark means to transfer the owner's right in a trademark to another person.**

Here Assignment means absolute transfer.

### Q. 196 What is Licence in Trademark?

Ans. A trademark license is a legal agreement that grants permission from the owner of a trademark (the licensor) to another party (the licensee) to use the trademark in connection with specified goods or services, according to terms and conditions outlined in the agreement. This permission allows the licensee to utilize the trademark for commercial purposes while maintaining the ownership rights with the licensor. The terms of the license typically include provisions regarding the scope of the permitted use, quality control standards, duration of the license, royalties or fees, and any limitations or restrictions on the use of the trademark.

### Q.197 What is the assignment clause of a trademark?

Ans. A trademark assignment is the transfer of an owner's property rights in a given mark or marks. Such transfers may occur on their own or as parts of larger asset sales or purchases.

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Trademark assignment agreements provide both the records of ownership & transfer and protect the rights of all parties.

#### **Q.198 How do you assign ownership of a trademark?**

Ans. As with other forms of intellectual property, a trade mark belongs to the registered owner. To assign ownership to another party, there needs to be an agreement between the current owner (the 'assignor') and the proposed owner (the 'assignee'). This agreement will need to be signed by an authorised person and to be registered with registrar.

#### **Q199. Who is authorised person in trademark assignment?**

Ans. In the context of trademark assignment, an authorized person is someone who has the legal authority to act on behalf of the owner of the trademark. This authorization may be explicitly granted in writing, such as through a power of attorney or a formal resolution. An authorized person could include an attorney, an executive within the company, or another representative who is empowered to execute and manage the trademark assignment on behalf of the owner. It's crucial to ensure that the person conducting the assignment has the proper authorization to do so.

#### **Q.200 Who is Assignor and Assignee in Trademark?**

Ans. The transferring party is called the assignor, and the receiving party is called the assignee.

#### **Q.201 What are the benefits of Trademark Assignment?**

Ans. Some of the benefits of Trademark Assignment are:

- The trademark assignment enables the owner of the trademark to encashed the value of his brand.
- With the help of a trademark assignment, the assignee can obtain the rights of an already established brand.
- The assignment of the trademark supports both the assignor and the assignee to expand their respective business.
- In case of any dispute, the trademark assignment agreement would enable the assignor or the assignee to establish the legal right.
- Appropriate stamp duty be paid on consideration as per respective state according to Schedule I of Stamp Act.

#### **Q.202 What are the documents required for Assignment of Trademark?**

Ans. The following documents must be submitted to the registrar of trademark along with **Form TM-P** (Assignment of Trademark)

- Trademark assignment agreement.
- Trademark certificate.
- NOC from the assignor.
- Identification documents of the assignor and assignee.
- Appropriate