

## **MADRID PROTOCOL FOR INTERNATIONAL TRADEMARK REGISTRATION: CONCEPT AND CHALLENGES**

*Legal Upanishad Journal (LUJournal.com)*

*Vol 1 Issue 2 | September 2023 | pp- 183-188*

Ankush Singh, Law Student, Bharati Vidyapeeth New Law College, Pune

### **ABSTRACT**

*If you have a trademark in India and want to protect it in other countries, the Madrid system is a smart choice. This system lets you submit one application to cover multiple countries. The World Intellectual Property Organization, or WIPO for short, manages this system of international trademark registration. India is a signatory of the Madrid system, along with more than 128 other countries. When you apply through the Madrid Protocol, each country checks your application based on its own trademark laws. Plus, if you need to update or renew your international registrations, you can do it with a single request. That's a lot simpler than filing separate applications for each country, which can save you both time and money.*

*Trademark protection is an essential component of any successful worldwide business strategy. The majority of worldwide trademarks have one thing in common: they are all registered through the Madrid system. The system is a low-cost and successful method of registering and defending trademarks in numerous countries across the world. The Madrid system provides a safe route for international trademark protection for organisations looking to grow into global markets. The Madrid system's international register is an official record of the owner's right to a specific mark. In an increasingly global and digital world, businesses require an easy approach to getting and managing international trademark protection. The purpose of this research is to investigate the Madrid Protocol and the procedure for registering a trademark globally under the Protocol. The author has also analysed the landmark case of Coca-Cola vs. Bisleri International.*

**Keywords:** *Designated country, International registration, Madrid Protocol, Trademark and WIPO.*

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## 1. INTRODUCTION

If you are an Indian corporation, society, trust, firm, sole proprietor, or other type of business owner, you can benefit from the Madrid Protocol to protect your brand in numerous nations around the world by following a straightforward and affordable process for submitting your trade mark applications and managing your trade mark registrations abroad. The World Intellectual Property Organisation (WIPO), a specialised UN body with its main office in Geneva, Switzerland, is in charge of overseeing the Madrid Protocol. The Protocol offers a user-friendly, efficient, and affordable set of procedures for the central filing of trade mark applications and the central management of trade mark registrations with effects in various countries, enabling you to obtain and maintain protection for your brand all over the world.

## 2. MADRID PROTOCOL: WHAT IS IT AND WHAT ARE ITS DRAWBACKS?

### 2.1 Two ways to register your trademark internationally

When it comes to registering your trademark worldwide, there are two main ways to do it. One way is by using the Madrid Protocol, and the other way is by getting a local attorney in each country where you want trademark rights and having them submit the application for you. Therefore, the biggest lie that needs to be debunked is that there's no single method that can cover all countries globally with just one registration. The reason is that every country is sovereign and has its own rules for trademark registration. So, you have to go through the process separately for each country you want protection in.

### 2.2. The Madrid protocol

The Madrid Protocol is a system that was created amongst a lot of different countries that said that they understand it is burdensome to go and have to hire a local attorney to file a trademark application in each individual country, so they will allow a standard application to be filled out by someone and submitted without an attorney in the local country to any country that is a member of this treaty<sup>1</sup>. What you can do is file one application with an international organisation called the World Intellectual Property Organisation. You can check the box for each individual country for which you would like rights. Then that application

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<sup>1</sup> Madrid Protocol - The Basics, MEWBURN ELLIS (Aug 14, 2023, 5:30 PM), <https://www.mewburn.com/law-practice-library/madrid-protocol-the-basics#:~:text=The%20Madrid%20Protocol%20is%20an,and%20these%20are%20listed%20below>

gets submitted to all those different countries for their individual reviews, and as those individual countries do their reviews, they will decide as to whether your trademark is granted or refused. If there is ever a refusal of the trademark in a particular country, then you have to hire a local attorney to deal with the refusal. About eighty percent of the trademarks filed through the Madrid Protocol will just get accepted, and then there is about twenty percent that will not. One definitely has a lot of cost savings by filing through the Madrid Protocol because one does not have to hire as many local attorneys; however, it's still not a silver bullet solution to just getting the trademark everywhere you want.<sup>2</sup>

### **2.2.1 Drawbacks of the Madrid Protocol**

There is still going to be pushback from certain countries, and you are still going to have to hire a local attorney sometimes to deal with that. The major drawback of using the Madrid protocol is that you have to base your international application through the protocol on an application or registration in your home country. For instance, if you have business in the United States and you file your trademark in the United States, it will take eight to ten months at minimum for the trademark to go through the process here and get registered. However, at the same time, you want to file a trademark application in China, Australia, or any other country, and you file the application through the Madrid Protocol for these countries, and the application in the United States is pending<sup>3</sup>. If, for some reason, the United States denies your U.S. application and cannot get it registered, that then causes the refusal of all of the other applications filed. The Madrid Protocol is highly dependent on the first application being registered and staying registered. So, because of this connection between your U.S. application and the foreign application, a lot of times it can be advantageous to just go in and hire a local attorney in these countries to have them file the application so that it won't be hectic for you whatever happens in the U.S. process.

If a local attorney conducts a clearance search for the client, the attorney generally doesn't want that U.S. application to be the basis of all other international filings. In that case, the attorney will go and hire an attorney in Australia or China to make these filings individually. It may be a bit more expensive, but now if something happens to the U.S. trademark, you

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<sup>2</sup> The Madrid Protocol: A Route to Global Branding, INTELLECTUAL PROPERTY INDIA (Aug 16, 2023, 6:30 PM), [https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1\\_93\\_1\\_THE\\_MADRID\\_PROTOCOL.pdf](https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_93_1_THE_MADRID_PROTOCOL.pdf)

<sup>3</sup> Ibid

don't have to worry because these other jurisdictions are just going to review the trademark on its own merits and not tie it to the U.S. application. It can be a bit tricky to find a good attorney in other countries, and trusting them can be a concern. However, if you hire a reputable trademark attorney in your home country, they often have connections in various places because they work in that field. So, if you want to register a trademark in India, it's a good idea to go through a well-known attorney. Your local attorney, who you've been working with for a while, might have contacts and can help you file your application at a reasonable cost.

### **3. LANDMARK CASE OF COCA-COLA**

There was a dispute between Coca-Cola and Bisleri International over a trademark for MAZAA<sup>4</sup>. In 1993, Bisleri International Private Limited (the defendant) sold and assigned the MAZAA trademark, along with its intellectual property rights and goodwill, to Coca-Cola (the plaintiff). However, in 2008, the defendant applied to register the MAZAA trademark in Turkey and began exporting products with the MAZAA trademark there. They argued that their agreement with Coca-Cola only covered the use of MAZAA in India, not exporting. When Coca-Cola found out about this, they took the matter to court under Section 29 of the Trademark Act 1999, which deals with trademark infringement<sup>5</sup>. The court ruled in favour of Coca-Cola because Bisleri was using the MAZAA trademark, mistakenly thinking that their agreement with Coca-Cola only applied to India.

Since they signed a deed of assignment with the Coca-Cola Company, the Bisleri no longer have any legal claim to the trademark, and the court has given them an interim injunction ordering them to cease all production and use of the trademark MAZAA with immediate regard. According to the laws, Coca-Cola is the registered owner of the mark MAZAA.

### **4. CONCLUSION**

The Madrid Protocol has been a big help for people and businesses looking to register their trademarks in many countries, especially with more global trade happening nowadays. When

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<sup>4</sup> Coca Cola v. Bisleri International Pvt. Ltd. & Ors., 2009 SCC OnLine Del 3275

<sup>5</sup> Trade Marks Act, 1999, § 29, No. 47, Acts of Parliament, 1999 (India).

you register internationally, it comes with some great benefits for the trademark owner<sup>6</sup>. First, you don't have to go through the hassle of filing separate applications for each country, each with its own set of rules. Second, you don't need to deal with the offices of each country separately for things like confirmations and deadlines because there's this central place called the International Bureau that takes care of that. In simple terms, it's a quicker, more cost-effective, and broader way to protect your trademark.

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<sup>6</sup> Madrid Protocol - The Basics, MEWBURN ELLIS (Aug 14, 2023, 5:30 PM), <https://www.mewburn.com/law-practice-library/madrid-protocol-the-basics#:~:text=The%20Madrid%20Protocol%20is%20an,and%20these%20are%20listed%20below>