

Madrid Protocol Trademark Filing Guide (India)

Guide to protecting Indian trademarks internationally through the Madrid System

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2.	Review annually or whenever relevant laws, regulations, or business circumstances change.
3.	Keep a signed copy on file and ensure the IP Manager has the current version.
4.	Template only — not legal advice. Consult a qualified IP advocate for your specific situation.

1. THE MADRID SYSTEM FOR INTERNATIONAL TRADEMARKS

1.1 What is the Madrid System? The Madrid System is an international trademark registration system administered by WIPO that allows an Indian trademark owner to seek registration in up to 130+ member countries through a single application filed with the Indian Trademark Office (as the 'Office of Origin'). Key advantages: (a) one application, one language (English or French or Spanish), one set of fees; (b) centrally managed portfolio — renewals, changes of address, and assignments recorded centrally at WIPO; and (c) standard 18-month examination period in each designated country. The system is governed by the Madrid Protocol.

1.2 Eligibility Requirements. To file an international application through India (CGPDTM as Office of Origin), the applicant must: (a) have a pending or registered trademark in India for the same or similar mark; (b) be an Indian national, domiciled in India, or have a real and effective industrial or commercial establishment in India; and (c) apply for protection in the same goods/services as the Indian base mark (can be a subset but not broader).

2. THE FILING PROCESS

2.1 Step-by-Step Filing. Step 1: Ensure a pending or registered Indian trademark exists as the 'basic mark'. Step 2: Prepare the international application (Form MM2) through the CGPDTM or WIPO's TMview/Madrid Monitor. Step 3: CGPDTM certifies and forwards to WIPO within 2 months. Step 4: WIPO conducts formality examination and issues the international registration. Step 5: WIPO notifies the trademark offices of each designated country. Step 6: Each country's trademark office has 18 months (or 12 months if they have not extended) to refuse protection. Step 7: If no refusal, the mark is protected in that country.

2.2 Fees for Indian Applicants. International application fees are paid to WIPO in Swiss Francs (CHF) and include: basic fee (CHF 653 for B&W; mark, CHF 903 for colour); individual fees for each designated country (vary — Switzerland CHF 395, USA USD 325 per class, EU EUR 147 per class approximately); and a transmittal fee payable to CGPDTM (Rs. 2,000 approx for startup with DPIIT discount). Budget CHF 1,500–5,000 for protection in 5–8 countries depending on fee structures.

2.3 Pros and Cons vs National Filings. Madrid advantages: lower upfront costs for multiple countries; centralised portfolio management; single renewal (every 10 years, CHF 653 base fee plus per-country fees). Madrid disadvantages: 'central attack' risk — if the Indian base mark is cancelled within 5 years of international registration, all dependent international registrations also fall (though can be converted to national applications); examination in each country is still done by local examiners under local law; lack of representation in local proceedings may be a disadvantage when responding to office actions.

3. POST-REGISTRATION MANAGEMENT

3.1 Renewal and Maintenance. Madrid international registrations are valid for 10 years and renewable for further 10-year periods. Renewal is centrally managed through WIPO — one renewal covers all designated countries in the registration. File renewal at least 6 months before expiry. Note that individual countries may have earlier renewal deadlines under their national law — monitor country-specific requirements for long-term portfolio management.

3.2 Subsequent Designations. After initial registration, additional countries can be designated later (called 'subsequent designations') through a simple procedure filed with WIPO. This allows the Company to expand protection to new countries as business expands without re-filing the entire application.

3.3 Responding to Office Actions. When a designated country's trademark office raises an objection or provisional refusal, the Company must engage a local trademark attorney in that country to respond. WIPO notifies the Company of the provisional refusal, but the response must comply with local procedures. Budget for local attorney fees in each country where office actions may arise.

MANAGING OFFICE ACTIONS AND REFUSALS IN MADRID DESIGNATIONS

4.1 Types of Refusals in Madrid System. When a designated country's trademark office refuses protection, the refusal can be: (a) Absolute grounds — the mark is descriptive, lacks distinctiveness, is contrary to public policy, or is a generic term in that country; or (b) Relative grounds — the mark is identical or confusingly similar to an existing registered mark in that country. The WIPO notifies the applicant of the provisional refusal, and the applicant must engage a local trademark attorney in that country to respond within the designated time limit.

4.2 Responding to US Office Actions. The USA is a frequent source of office actions in Madrid designations due to: strict requirements for identifying goods and services (the Acceptable Identification of Goods and Services Manual must be followed); the 'likelihood of confusion' standard that is broadly applied; and the requirement for a Statement of Use or Intent to Use declaration. US office actions must be responded to by a US-licensed trademark attorney. Budget USD 1,500–3,000 for a standard US office action response.

4.3 The Central Attack Risk — Managing and Mitigating. The central attack risk is the biggest strategic vulnerability of the Madrid system: if the Indian base mark (the 'basic mark') is cancelled, opposed successfully, or lapses within 5 years of the international registration date, all international registrations based on it automatically cease. Mitigation strategies: (a) Monitor the Indian base mark carefully — ensure renewals are paid and defend against any oppositions aggressively; (b) After 5 years from the international registration date, the international registrations become independent of the basic mark and the central attack risk disappears; (c) If central attack materialises, immediately file 'transformation requests' to convert the international designation to direct national applications in each country — this preserves the priority date and avoids losing protection.

4.4 Key Differences Between Madrid and National Filings. Choosing between Madrid and direct national filing: Madrid is cost-effective for protecting in 5+ countries simultaneously; direct national filings give more flexibility to tailor each application to local requirements; Madrid does not eliminate the need for local counsel to respond to office actions; and direct national filings have independent validity — no central attack risk. For a startup planning to enter 3–4 specific countries, direct national filings via Paris Convention may be more efficient; for 6+ countries simultaneously, Madrid provides significant cost and administrative benefits.

COUNTRY-SPECIFIC CONSIDERATIONS FOR KEY MARKETS

5.1 USA (USPTO). The USA requires a declaration of use (or intent to use) for trademark registration. For Madrid designations, the USPTO typically issues an office action requiring the applicant to specify goods/services using language from the USPTO Acceptable Identification of Goods and Services Manual. USA registrations must be maintained with a Statement of Use (Section 8 declaration) between year 5 and 6, and at each renewal. USA trademark owners can also register with US Customs to block infringing imports. Given the size of the US market, USA designation in Madrid is typically high priority.

5.2 European Union (EUIPO). A EU Trademark (EUTM) registered at the EUIPO covers all 27 EU member states with a single registration. Madrid designation at the EUIPO provides EU-wide protection. Key advantage: one designation covers the entire EU. Key risk: if the EUTM is opposed or cancelled in any EU member state on relative grounds (prior national mark), the entire EUTM designation may be refused. Monitor for conflicting marks in major EU markets (Germany, France, Spain, Italy) before designating the EU.

5.3 China (CNIPA). China is a first-to-file jurisdiction — any party can file a trademark before the actual brand owner. This makes early filing in China critical for Indian startups planning China market entry. China also has specific issues with trademark squatting by local entities who register foreign brands in bad faith. File in China as early as possible, even before market entry. Chinese language transliteration of the English brand should also be filed as a separate trademark. Madrid designation in China is possible but local filing through a Chinese attorney may provide more control.

5.4 UAE and Gulf Cooperation Council. The UAE is an important market for many Indian startups and service providers. UAE trademark registrations require local agent representation and use of Arabic transliteration alongside the English mark. The GCC Trademark Office provides multi-country protection in GCC member states (UAE, Saudi Arabia, Kuwait, Bahrain, Qatar, Oman) with a single application — though national filings in individual GCC countries may also be required for full protection.