INTRODUCTION

The Republic of India is one of the most dynamic emerging markets in the world today. One of the “big four” BRIC countries (Brazil, Russia, India, China), India is well on its way to becoming a major global economic player.

India is also a fast-growing trademark environment, as brand owners from around the world are drawn to the opportunities in this rapidly expanding marketplace. New developments, including India’s pending adoption of the Madrid Protocol, make this a particularly important moment in its emergence as a global marketplace. However, as with other emerging markets, having a thorough understanding of India’s developing trademark landscape is crucial to avoid pitfalls and effectively manage brand risk.

In this special report, we explore India’s intellectual property trends and regulatory realities to provide a deeper understanding of this evolving “trademarket.” We also interviewed an IP practitioner with knowledge of India’s evolving intellectual property legal landscape, revealing insights to help brand owners navigate the challenges and achieve their business goals in this promising market of commercial opportunities.

CONTENTS

Introduction ................................................................................................................................................ 2
India: Emerging Economic Giant ................................................................................................................ 3
Trademark Law in India .............................................................................................................................. 4
India: A Research Perspective ................................................................................................................... 6
Trademark Statistics & Top Filers ............................................................................................................... 7
Pharmaceutical Trademarks ......................................................................................................................10
The Importance of Trade Dress ..................................................................................................................12
Counterfeiting and Piracy ..........................................................................................................................13
Adoption of International IP Standards ....................................................................................................14
India and the Madrid Protocol ...................................................................................................................15
How Thomson CompuMark Can Help .......................................................................................................16
INdIA: COMING OF AGE

The 21st century is proving to be a very significant chapter in India’s development as a fast growing player in the global marketplace. Some of the key factors impacting its rapid economic emergence include the following:

DRAMATiC GROWTh
Economically, India introduced market reforms in 1991 that helped launch the country on a trajectory of rapid growth. It is one of the fastest growing economies in the world, with growth averaging about 7.5% annually in recent years. Thanks to this growth, today India is the eleventh largest economy in terms of Gross Domestic Product (GDP) and the world’s fourth largest economy, based on purchasing power parity. The service sector accounts for 54% of GDP, while agriculture accounts for 28% and the industrial sector accounts for 18%. India is a member of the World Trade Organization (WTO) and is in the process of eliminating import restrictions, expanding opportunities for foreign producers.

LEGAL SYSTEM
India has a unitary judicial system with the Supreme Court of India exercising judicial precedent nationally; a series of 21 High Courts that serve as the principal civil and appeals courts for India’s 28 states; and a series of subordinate district courts, including criminal courts, civil courts, and family courts. While each state drafts its own laws, including those governing labor and taxation, laws passed by the federal government supersede state laws.

Indian law is strongly influenced by British and American legal principles. Indeed, many acts and ordinances first introduced by the British Raj during the colonial period remain in effect today. Indian laws adhere to United Nations guidelines for human rights and environmental law. India also conforms to certain international trade laws, including laws enforcing intellectual property rights.

EMBRACING ARBITRATIoN

Adoption of the New Law is intended to help harmonize Indian arbitration law with the Model Law and establish an internationally recognized legal framework for arbitration of disputes. The intention was to consolidate laws on domestic and international arbitration and conciliation, enable enforcement of foreign awards, and encourage arbitration as an alternate dispute resolution process to avoid prolonged judicial processes.

TRADEMARKS IN INdIA
India has a “first-to-file” system of trademark protection that requires no evidence of prior use of the mark. Trademark registration gives exclusive proprietary rights to the mark’s owner.

However, since India has a common law legal system, unregistered trademarks may be entitled to protection, as well. Nevertheless, trademark registration is a critical priority for any brand considering entering the Indian market.

Trademark law in India is based on the Trade Marks Act of 1999 and the associated Trade Marks Rules, which were implemented in 2002. Together, these pieces of legislation define:

**A TRADEMARK**
A trademark is defined as a device, brand, heading, label, ticket, name (including abbreviations), signature, word, letter, numerals, shape of goods, packaging or combination of colors and any combination thereof. To meet the definition, trademarks must be distinctive, distinguishing the product or service from others in the market, and must not be deceptive.

**TRADEMARK REGISTRABILITY**
The law provides for registration of trademarks and service marks being used or intended to be used on goods, services, certification, and collective marks. Subsequent case law [N. R. Dongre v. Whirlpool Corporation 1996 (16) PTC 583; Milmet Oftho Industries & Ors. v. Allergan, Inc. (2006 (32) PTC 495)] has broadened the definition of the word “use” to include trademark appearing on the Internet and in international publications, in addition to the physical presence of the goods in India.

Trademarks will not be registered if they are “devoid of any distinctive character” or if they serve “to designate the kind, quality, quantity, intended purpose, values, geographical origin, time of production/rendering of the service, other characteristics of the goods or service” or if they consist of elements “which have become customary,” unless they have acquired a distinctive character as a result of their use or were already well-known as a trademark.

In addition trademarks are NOT registrable if they:

- consist exclusively of the shape of goods, which results from the nature of goods themselves or which is necessary to obtain a technical result or if the shape gives substantial value to the goods.

**REGISTRATION PROCEDURE**
Because India has a “first to file” system of protection, it is important that trademark owners apply for registration as early as possible.

Application for registration is made by the mark’s owner/proprietor (or agent with power of attorney) to the Registrar of Trademarks.

- The trademark owner must have the intention to use the mark himself or through a registered user or by a person other than himself and a registered user.
- Multi-class applications can be filed.
- Applicants who are not Indian nationals or living in India must provide the Registry with an address for service in India or they must appoint a local registered agent or representative.
- Applicants can claim priority, provided the application is filed in India within six months of the priority date; multiple and partial priorities are allowed.

Specific application requirements include the following:

- Name, address, state of incorporation, class(es) of goods/services.
- Authorization of agent (no legalization or notarization required).
- 15 prints (in case of marks in color); three different views for three-dimensional marks.
- Date of first use in India or whether the mark is intended to be used.
- Trade description of the applicants.
- In case priority is being claimed, a certified copy of the priority document along with its certified English translation.
EXAMINATION
Applications are examined to ensure compliance with the law and to ensure they do not conflict with marks that are already registered or pending. Application may be amended provided the amendment does not constitute a major alteration. Registration may be refused for any of the registrability guidelines listed above or if it is found to be identical or deceptively similar to other marks for the same or similar goods/services or for dissimilar goods/services if the earlier trademark is considered a well-known trademark. In some cases, a letter of consent from the owner of the previously registered or pending mark may help secure acceptance of the new mark. In the case of identical or similar marks, registration may be permitted with proof that the mark was being used concurrently and in good faith.

A registrant can re-file an application for a different specification of goods or in the event registration has lapsed due to non-payment of renewal fee. Applications may request a hearing for applications which the Registrar proposes to refuse; appeal of any order issued at a hearing can be made to the Intellectual Property Appellate Board.

OPPOSING AN APPLICATION
Accepted applications are advertised in the Trade Marks Journal and opposition may be filed within three months from the date of publication in the Trade Marks Journal; a one-month extension for filing opposition can be obtained within the three-month period.

REGISTRATION DURATION
Registration is good for 10 years, renewable every 10 years. A mark may be renewed within six months after expiration on payment of renewal fees and surcharge. Restoration may be possible for up to one year, though conditions or limitations may apply. A trademark removed from the Register for non-payment of renewal fees can be cited against an application for registration for up to one year.

NON-USE OF TRADEMARK
A trademark that has not been used for five years or more from the date of registration can be cancelled for non-use.

INFRINGEMENT
Trademark owners alleging infringement of their registered mark by another mark can file suit, requesting an injunction, financial damages, and an order for delivery-up of the infringing labels and marks for destruction. Unregistered trademarks well known in India or internationally may be protected against misuse in a passing off action.
When it comes to researching potential trademarks, India bears many similarities to western markets, along with some interesting differences.

One advantage when researching trademarks in India is the fact that, next to the official language Hindi, English is recognized as a subsidiary official language. So while trademark records often include information in Hindi, they will always include an English version, as well. Indeed, you will find Hindi and English side-by-side on most product packaging in India. The inclusion of English in trademark records is a big advantage when searching marks in India as compared to countries like China, where all records require transliteration to facilitate a search.

LINGUISTIC DIFFERENCES
There are, however, some differences in the trademark records in India. For example, some typical Indian goods, such as incense, will include names for the goods in Hindi only (listed on the record in Latin characters). In some cases, these cannot be translated into English. For example, the words “Agarbathies” and “Dhoop” refer to specific types of incense typical in India, but for which there is no word in English. This demands specialized knowledge when searching and it is one reason why working with a trademark research partner with experience in the Indian market is so important.

SEARCHING MULTIPLE CLASSES
Until 2003, India had a per-class registration system. So registering a single mark in three classes required applicants to file three separate applications. The system has been changed, allowing applicants to register in multiple classes with a single application. However, because the per-class system was in place for so long, the vast majority of trademark registrations are recorded in this way. This requires searching a mark in each relevant class to ensure you do not miss pertinent marks.

For this reason, when performing online screening searches of trademarks for use in India, using a database that allows you to search multiple classes simultaneously can save significant time and effort. With India joining the Madrid Protocol, it is equally important to use a database that allows you to search the international trademarks claiming protection in India, all in the same search.

MINIMIZING BRAND RISK
As in any other register, performing a screening search in India is an invaluable first step in determining whether a mark is available. However, it is crucially important to perform a full availability search when clearing a mark. For companies considering doing business in India, performing a comprehensive full search should be viewed as a strategic investment for managing their brand risk in this extremely dynamic and rapidly growing marketplace.

For cleared trademarks, ongoing trademark watching is also important. As in other rapidly emerging markets, counterfeiting represents a common problem in India. We often see “imitations” of well-known trademarks. In some cases, these “imitators” will find out in which countries a well-known trademark has not been registered and file for registration themselves and sell that registration. Proactive watching can help identify these potential infringements, so trademark owners can respond quickly to protect their brands.

Indian trademark records always include English text, often alongside a version in Hindi. Note that in some cases, the Goods classification is in English (“Incense Sticks”) while in others, the Goods are described in Hindi (“Agarbathies” and “Dhoop”). These examples also highlight the importance of distinctive, colorful trade dress in India, where a large portion of the population cannot read.

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**TRADEMARKS IN INDIA**

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TRADMARKS IN INDIA
TRADEMARK STATISTICS

Reflecting the country’s rapid rise as a commercial economic player, India has experienced dramatic growth in applications for trademark registration in just the past few years.

In 2004-05, a total of 78,996 applications were filed; by 2008-2009, that number had risen to 130,172. The greatest increase came in 2007-08, when applications rose by more than 20,000 over the previous year—a nearly 20% increase in one year alone.

REGISTRATIONS ON THE RISE

Also notable is that the trend of trademarks accepted and registered has also been on the rise—from less than 57% of applications (45,015) in 2004-05 to nearly 79% of applications in 2008-09.

Source: These statistics are based on the figures published on the India Controller General of Patents, Designs and Trademark website.
In addition, trademark applications and registrations are growing in relation to other types of intellectual property registration, including patents, designs, and geographical indications of goods (see charts below).

**Types of Marks Filed**

It is also interesting to note that for the most recent years tracked, applications for word marks have fallen, while those for device marks have risen. In 2007-08, there were 71,202 applications for word marks and 51,082 applications for device marks. The very next year, there were only 52,256 word marks (39% of the total) and 79,059 device marks (61% of the total)—a complete reversal. Some factors that could impact this are the already high number of word marks and the high illiteracy levels within the population. Whether or not this represents a continuing trend, requires further exploration.

**Domestic vs. Foreign Applicants**

To date, the vast majority of applicants for trademark registration have been domestic filers. While the number of Indian applications has grown steadily—from 63,906 in 2004-05 to 119,371 in 2008-09—the number of foreign applicants has not seen the same growth. Indeed, while the number of foreign applicants reached 15,209 in 2006-07, the number fell to just 6,500 the following year. In 2008-09, there were 10,801 foreign applicants.

In recent years, the top foreign filers are from the following countries, in order of frequency:

- United States
- Germany
- UK
- Japan
- France

It is expected that, with the full adoption of the Madrid Protocol, the trend will be toward greater numbers of foreign trademark registration applications.
LEADING CLASS: PHARMACEUTICALS

For the latest year tracked (2008-09) the greatest number of trademark applications (11,313) were for Class 5 (Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.). This accounts for 11.06% of all applications that year.

The second most common class was Class 9, accounting for 6.03% of all applications. Class 9 includes: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.

In addition, 17.61% of applications were registered in multiple classes in 2008-09.
Currently, India is home to the world’s third largest pharmaceutical industry by production volume, leading the country’s manufacturing sector (though it is fourteenth in terms of value, an indication of the predominance of low-cost generic drugs).

India’s first pharmaceutical company, Bengal Chemicals and Pharmaceutical Works, founded in 1930, still exists as one of five government-owned drug manufacturers. The Patents Act of 1970 reduced the patent protection granted to food and drug products, driving many multinational companies from the market, paving the way for a robust domestic pharmaceutical industry. Since then, Indian pharmaceutical companies have shown expertise in engineering manufacturing processes to produce drugs at a lower cost. In recent years, Bio-Pharma has grown dramatically, accounting for 60 of pharmaceutical industry growth. In 2009-10, India’s biotechnology sector grew by 17%.

In 2002, a total of $9 billion worth of pharmaceutical products from registered drug companies was sold worldwide. While 85% of formulations were sold in India, 60% of the bulk drugs produced were exported, primarily to the U.S. and Russia. While there were more than 20,000 registered drug companies in India, two-thirds of the market is controlled by about 250 companies. Multinational companies account for only 35% of the market.

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Viewing the Indian pharmaceutical industry from a global perspective, it accounts for 10% of pharmaceutical products from registered drug companies sold worldwide. While 85% of formulations were sold in India, 60% of the bulk drugs produced were exported, primarily to the U.S. and Russia. While there were more than 20,000 registered drug companies in India, two-thirds of the market is controlled by about 250 companies. Multinational companies account for only 35% of the market.

In recent years, the Indian courts have reinforced trademark protection for pharmaceutical products, including well-known, international pharmaceutical trademarks.

In the case of Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd (2001 PTC 300 (SC)), the Supreme Court set a stricter standard for comparing competing pharmaceutical trademarks than for ordinary marks, recognizing the public safety implications and the potential for confusion among consumers in India due to lack of education, multiple languages, and other factors.

### Top 10 Pharma Companies in India

<table>
<thead>
<tr>
<th>RANK</th>
<th>COMPANY</th>
<th>2008 Revenue (USD Millions)</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Cipla</td>
<td>411</td>
</tr>
<tr>
<td>2</td>
<td>Ranbaxy</td>
<td>384</td>
</tr>
<tr>
<td>3</td>
<td>GSK (India)</td>
<td>340</td>
</tr>
<tr>
<td>4</td>
<td>Piramal Healthcare</td>
<td>300</td>
</tr>
<tr>
<td>5</td>
<td>Zydus Cadila</td>
<td>282</td>
</tr>
<tr>
<td>6</td>
<td>Sun Pharma</td>
<td>275</td>
</tr>
<tr>
<td>7</td>
<td>Lupin Laboratories</td>
<td>214</td>
</tr>
<tr>
<td>8</td>
<td>Alkem</td>
<td>213</td>
</tr>
<tr>
<td>9</td>
<td>Sanofi-Aventis (India)</td>
<td>189</td>
</tr>
<tr>
<td>10</td>
<td>Mankind Pharma</td>
<td>188</td>
</tr>
</tbody>
</table>

Source: compiled from annual reports.

### IP Law and Pharmaceuticals

In recent years, the Indian courts have reinforced trademark protection for pharmaceutical products, including well-known, international pharmaceutical trademarks.

The Drugs and Cosmetics Act of 1940 prohibits the sales or distribution of “spurious drugs,” defined as “a drug manufactured under a name which belongs to another drug or is an imitation of, or a substitute for, another drug; which resembles another drug in a manner likely to deceive; or which bears upon it or upon its label or container the name of another drug unless it is plainly and conspicuously marked so as to reveal its true character and its lack of identity with such other drug”. India’s Supreme Court has interpreted this to include trademark disputes, effectively strengthening trademark protection for pharmaceutical products.

In the case of Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd (2001 PTC 300 (SC)), the Supreme Court set a stricter standard for comparing competing pharmaceutical trademarks than for ordinary marks, recognizing the public safety implications and the potential for confusion among consumers in India due to lack of education, multiple languages, and other factors.
In other cases, Indian courts have determined that certain names—such as the name of active ingredients, salts, organs, or ailments—are generic and may not be used exclusively as a trademark. For this reason, manufacturers have tended to use a portion of the active ingredient’s name as a prefix or suffix in a trademark.

**APPROPRIATION OF FOREIGN MARKS**

It is not uncommon for Indian pharmaceutical companies to appropriate the trademarks of international pharmaceutical trademarks that have not yet been used in India. However, recognizing the global nature of the pharmaceutical industry, the Indian Supreme Court has held that if a pharmaceutical trademark is associated with one party worldwide, allowing an identical mark to be sold in India by another party could be disastrous. Subsequent lower court decisions have held that owners of trademarks with an established international reputation can sue to protect that reputation in India even if they have no business activity there.

The challenge for international plaintiffs is that they will have the burden of proving that their trademarks enjoy “trans-border reputation” in India.
THE IMPORTANCE OF TRADE DRESS

A product’s trade dress—its distinctive appearance, color, design, shape, packaging, and even its aroma—is a crucial component of its brand equity. This is especially the case in India, where a large portion of the population is poorly educated and may not be literate. For this reason, the concept and importance of trade dress is well recognized and protected under Indian IP law.

India’s Trademarks Act of 1999 specifically included elements of trade dress, for both products and packaging, within its definition of trademark. Courts in India have consistently reinforced trade dress protection.

One of the most cited cases is Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd. in the Delhi High Court. The plaintiff disputed the use by the other company of a distinctive red and white pattern in a precise proportion, together with the style of lettering on dentifrice packaging. Colgate argued it has used the red and white pattern since 1951, where the defendant started using its design in 1996. The court ruled for the plaintiff, indicating that the infringement on Colgate’s well-established and distinctive color scheme could cause both confusion in the marketplace and dilution of Colgate’s brand.

In another case, Kangaro Industries Limited v. Evershine STY, the Delhi High Court issued an injunction to stop the defendant’s use of a distinctive design and color combination featuring the image of a frog. Kangaro, a well-known office equipment and stationery brand, was found to have prior rights to this distinctive trade dress.

Other similar cases have upheld the trade dress rights of other well-known brands, including Cadbury Gems and its distinctive “pillow” packaging.
COUNTERFEITING AND PIRACY

As in other newly liberalized and rapidly expanding markets, like China, counterfeiting and piracy of branded goods is an issue in India. The types of counterfeit goods run the gamut from software, electronics and clothing to pharmaceuticals and cosmetics. While counterfeits clearly do harm to brand equity, some may also pose a risk to consumers, such as counterfeit pharmaceuticals.

The Trademarks Act of 1999 and the Copyright Act of 1957 empower authorities to take action to prevent infringement, including counterfeit goods. Other important laws include:

- The Drugs and Cosmetics Act, which makes the sale of “misbranded” and “spurious” drugs and cosmetics a criminal offense. Responding to the dramatic growth in counterfeit drugs, the Indian government has also introduced a “whistleblower” program with rewards for those providing information on counterfeit products.
- The Prevention of Food Adulteration Act, which regulates food safety and provides harsh penalties for “misbranded” food products—including life imprisonment for cases of counterfeit products resulting in death.
- The Patents Act of 2005 protects the rights of owners of patented products, such as technology and pharmaceutical products. However, unlike the other laws cited, it provides no criminal penalties, only allowing for civil damages.
- In 2007, India adopted the Intellectual Property Rights (Imported Goods) Enforcement Rules (IPR IG), a set of regulations designed to stop the importation of infringing goods into India. These rules give Indian Customs Authorities the power to deal with counterfeit and pirated goods at the borders. IP rights holders can file IPR notices that enable Customs to inspect incoming shipments from any of India’s 35 major ports against a database of registered rights holders.

Notwithstanding this well-established IP legal framework, enforcement is a major challenge in India. The judicial system is backed up with a monumental backlog of cases, forcing some plaintiffs to wait a decade or more for their day in court. Training for Customs officials is ongoing, yet confusion remains about what border officials should be doing to prevent the flow of counterfeit and pirated products. Under IPR IG, rights owners are required to file a separate application for each trademark, patent, or copyright associated with a product, a time-consuming and inefficient process.

And this only provides oversight for products entering the Indian market, not those being exported to other markets.

In response to the realities of counterfeiting and pirating in India, many companies are leveraging new technologies to combat the trend. The use of multi-colored holograms and mass serialization (providing a serial code that consumers can submit online to check the authenticity of the goods), for example, represent steps to help assure consumers that the product they buy are genuine.

In addition, many companies are taking added measures to protect their brands in India, such as controlled delivery of products, electronic surveillance, and investigative services. With the dramatic increase in online counterfeit sales the world over, web monitoring strategies can be effective in identifying counterfeit, grey market, and pirated products, regardless of their country of origin.

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ADOPTION OF INTERNATIONAL IP STANDARDS

As part of ongoing efforts to modernize its intellectual property (IP) legal infrastructure, India has adopted or plans to adopt key international trademark classifications and registration structures.

NICE CLASSIFICATION

India has recently adopted the Nice Classification (9th Edition) for trademark goods and services. As a result, India has added classes 43 (Services for providing food and drink; temporary accommodation), 44 (Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services), and 45 (Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals). In addition, it has modified class 42 (Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software) to conform to the Nice Classification.

This change impacts new registrations for those classes, as well as registered marks and pending applications for class 42. Pending applicants for Class 42 must now seek reclassification using Form TM-16 (“Request for correction of clerical error, or for amendment”). Owners of marks registered in class 42 but which now fall into other classes or across classes must be reclassified using form TM-40 (“Application by the proprietor of a registered trade mark for the conversion of the specification”). This will not change the original date of registration.

THE MADRID PROTOCOL

Further strengthening intellectual property rights in India is the country’s recent decision to ratify the Madrid Protocol governing the international registration of trademarks. It is expected that the Indian government will complete the ratification process by the end of 2010. Once this is achieved, multinational brand owners will be able to designate India when filing international trademark applications under the Madrid Protocol, streamlining the registration process. In addition, Indian companies will be able file for international protection of their marks more easily and cost-effectively, promoting global expansion of their brands.

Adoption of the Madrid Protocol marks a major step forward in enabling international registration of Indian trademarks. Administered by the World Intellectual Property Organization (WIPO), the Madrid Protocol offers a low-cost method of registering and renewing trademarks in other participating countries. Applicants can apply for trademark protection in some or all of the Madrid Protocol countries with a single application.

A key provision of the Madrid Protocol is that all unopposed trademark applications be registered within 18 months of the application date. Intended to accelerate the process, this provision will undoubtedly place even greater pressure on India’s Trademark Registry to improve and modernize its infrastructure.

In addition to making the process of international trademark registration simpler and more cost-effective, India’s decision to adopt the Madrid Protocol enhances the credibility of its trademark system internationally. This, in turn, may provide brand owners entering the Indian market with greater confidence in the country’s commitment to protecting their intellectual property rights.

Nevertheless, some stumbling blocks remain. The Indian Trademark Registry has been working diligently to address a significant backlog in applications and to update its infrastructure to handle the anticipated increased workload. Time will tell whether these efforts will enable the Registry to meet the 18-month registration turnaround required under the Madrid Protocol.
What is the latest status on India’s adoption of the Madrid Protocol?

The trademark amendment bill has already been passed by both houses of Parliament and it is just awaiting the signature of the President. As soon as she signs it, it will become law. That could happen any time.

Once the act to adopt the Madrid Protocol is amended, the rules must be framed before the act is brought into force through a journal notification. So it may take some time before the actual filings take place in India under the Madrid Protocol.

Is there a sense of urgency to get this accomplished by the end of 2010?

Yes there is, because both houses have already passed it. The Registrar’s office is working very hard. They have moved the entire examination process to the Mumbai Registry in order to expedite it. They have moved the examiners under the Joint Registrar, who has been given the administrative powers to speed up the backlog of trademark applications.

Is the 18-month turnaround time for trademark applications under the Madrid Protocol realistic for the Trademark Registry?

That is what they are working toward and that is what they want to do. That’s why they have had everybody working on the backlog of examinations. In order to reduce the backlog the Controller General of the Trademark Registry decentralized the organization, with examinations being performed across five offices of jurisdiction. Now, the Controller General thinks it might be better to have it all done in one location, under one person. So he has now centralized the examination process in Mumbai again. And they have been making rapid progress reducing the backlog.

The Registry is already short of staff, so they will have to recruit more staff. But it is achievable for them. In addition, they are planning to establish an online search process. Currently, you can have an official search done at the Registrar’s office, which takes a lot of time, effort and personnel. So they have decided to put it online and make it only a public search and not an official search. That will free up more resources to examine the marks and work on the prosecution procedure.

What other changes is the Registry making to expedite the examination process?

They are planning to make the process more transparent and the records more accurate. For example, they are working to remove from the records marks that were not renewed. These marks would keep coming up in searches as registered. So now, they are cleaning up the records and trying to expedite the procedure.

Why is adoption of the Madrid Protocol so important for India?

It makes India more global. All of the other major economies have joined the Madrid Protocol. I think we owe it to the Indian businesses to have one international trademark registration. It will also make it easier for companies outside India to register here, so more of them may opt for India. In many cases, the Indian arms of the international companies are doing very well and this can help accelerate that process.

What are the advantages and potential disadvantages, both for companies based in India and for foreign or multi-national companies?

Indian companies will now enjoy the advantage of a single trademark application for multiple countries at a lower cost.

The only potential disadvantage may be to trademark attorneys in India, who will now handle fewer international filings, unless they are opposed. On the other hand, I think the number of Indian filings may go up.

What are the possible long-term consequences of India’s adoption of the Madrid Protocol?

I think the consequence will be more Indian companies filing for international registration and actually going global and more foreign companies designating India as part of their international registration. Even if we were not to join the Madrid Protocol, international filings in India would be going up. But the cost advantage offered by the single application will encourage even the small and medium-sized businesses to think of India. I would expect to see more of these companies designating India because of the lower application cost.

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