

# National trademark applications versus Madrid trademark applications: practical considerations

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## Introduction

India, as a contracting party to the Madrid Protocol, offers two "routes" to secure statutory trademarks rights in India:

- the domestic route (a national application); and
- the Madrid route (a Madrid application).

The features, processes, fees involved and scope of protection afforded by the two routes largely overlap – at least theoretically – but they have slight differences from a practical standpoint. The practical considerations are all largely contextual – when it comes to choosing one route over the other, the facts of each case should be scrutinised against such considerations.

Of course, there are some generic factors in favour of the Madrid route – for example, Madrid applications are centralised and enable the applicant to manage numerous jurisdictions effectively and simply. There are also some generic factors in favour of national applications – for example, the life and fate of all the designate-jurisdictions are dependent on that of the basic application. Beyond these known factors, this article lists a few practical considerations that may make the choice between a Madrid application and a national application a notch easier (or at least better informed).

## Prior use versus proposed use

National applications for trademarks in India can be filed either on a proposed use basis (also known as an "intent to use" basis) or by relying on prior use of the mark in India. If the latter is chosen as the use basis, the rights that accrue upon registration would stretch back to the claimed date of prior use. For Madrid applications, however, the option of choosing the use basis is not available at the time of filing the application. As a result, all Indian designates of Madrid applications are filed on a proposed use basis by default.

While it is possible to amend the default proposed use basis to add a prior use claim even in the later stages of the prosecution process (which can currently be done by filing a domestic statutory form for amendment), this entails additional costs and may result in some delays. Further, in India, the claimed prior use date should corroborate each of the classes covered under an application. In cases where the Madrid application is a multiclass application and the prior use dates for each of the classes covered differ, the option to amend and add a prior use claim in the later stages of the prosecution process may become even more cumbersome (or even impossible).

Thus, if the trademark over which a registration is intended to be secured has already had significant use in India, and particularly for a multiclass application, this may be considered as a deciding factor.

## Unavailability of certain processes and procedures

Certain legislative procedures that are available and enabled for a national application are currently not possible for a Madrid application, even though such options are allowed or available for Madrid applications on paper. For instance, the division of a multiclass Madrid application is currently not possible at the Indian Trademark Office, but this option is enabled for national applications).

According to the World Intellectual Property Office's (WIPO's) notes and guidelines, [divisional requests](#) must be made at local trademark offices, and not at WIPO level, which means there is currently no way for a divisional request to be filed for an Indian designate of a Madrid application. Thus, even though this option is theoretically available for Madrid applications, it is practically moot.

As a result, for multi-class Madrid applications, if any of the classes designated for India face an objection or opposition, and other classes in the same application are free from any objections, the only practical option left would be for the entire objected class(es) to be deleted (at WIPO level) for India to save the objection-free applications from suffering delays.

Some (other) practice-related issues also need to be ironed out in India with respect to Madrid applications. A good example of this would be the lack of any procedure or processes in place for WIPO forms to be filed through the Indian Trademark Office, even though WIPO provides applicants with the option of filing at WIPO or through the local designated trademark offices.

Having said that, all the "standard" processes and procedures are available to Madrid applications without any hiccups. However, when it is foreseeable for any reason that a Madrid application (particularly a multiclass application) might hit some out-of-the ordinary roadblocks, these factors could be considered in arriving at a decision as to whether to go for a Madrid application or a national application. All in all, the differences, albeit minor, between the on-paper law with respect to Madrid applications and the practically possible options may throw applicants a curveball and somewhat (even if temporarily) derail the process of successfully and smoothly registering a Madrid application designating India.

## Timeframes

There are statutorily set time limits to steer the progress of a Madrid application where India is designated, though these are applicable only to the initial few stages in the registration process. This was previously a big "pro" factor (pre-2017), when national applications faced lengthy delays to surpass even the initial stages of scrutiny and examination. After 2017, the processes of the Trademark Office were revamped and digitised, which resulted in the timeframe for a national application to undergo the initial scrutiny being drastically reduced – it is now akin to the timeframes associated with a Madrid application. After the initial few stages of scrutiny, Madrid applications are treated on par with national applications, and both progress at the same rate towards registration.

Lastly, to overcome any objections or administrative actions faced by a Madrid application, a local counsel will need to be appointed. Sometimes, the timeframe assigned to respond to the objections is approximately one month or less, which may not be sufficient to appoint a local counsel, strategise and respond to the objections or administrative actions fully on merits.

#### **Comment**

If, despite the above considerations, uncertainty remains over which route should be preferred, a "clearance" search conducted in India prior to the filing should help. Clearance searches usually get a trademark owner acquainted with many (if not all) potential hurdles, and if these hurdles are hit by any of the aforementioned considerations, timely course-correction can be implemented.

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