



**GUIDELINES FOR
FOR FUNCTIONING
UNDER THE MADRID
PROTOCOL**



**TRADE MARKS REGISTRY
MUMBAI**

VERSION- 1

INTRODUCTION

The system of international registration of marks is governed by two treaties: *the Madrid Agreement Concerning the International Registration of Marks* (referred as ‘**Madrid Agreement**’ in brief), which dates from 1891, and the *Protocol Relating to the Madrid Agreement* (hereinafter referred as ‘**Madrid Protocol**’ in brief), which was adopted in 1989, entered into force on December 1, 1995, and came into operation on April 1, 1996. *Common Regulations under the Agreement and Protocol* also came into force on that date.

Under the Madrid Protocol, a mark can be protected in many jurisdictions by filing an application for international registration. Such application is presented to the International Bureau of the World Intellectual Property Organization at Geneva, through the office of origin i.e. the trademark office of the applicant.

Where the application complies with the applicable requirements, the mark is recorded in the International Register and published in the *WIPO Gazette of International Marks*. The International Bureau then notifies each Contracting Party in which protection has been requested whether in the international application or subsequently.

Each designated Contracting Party has the right to refuse protection of mark by so notifying to the International Bureau within the time limits specified in the Madrid Protocol.

Unless such a refusal is notified to the International Bureau within the applicable time limit, the protection of the mark in each designated Contracting Party is the same as if it had been registered by the Office of that Contracting Party.

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. If, and to the extent that, the basic registration ceases to have effect within this five-year period, the international registration is no longer protected.

An international registration subsists for the period of 10 years from the date of its registration and it may be renewed further by paying renewal fee before the expiry of every 10 years.

All changes subsequent to the international registration, such as a change in name and/or address

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of the holder, a (total or partial) change in ownership of the holder or a limitation of the list of goods and services in respect of all or some of the designated Contracting Parties, may be recorded and have effect by means of a single procedure with the International Bureau and the payment of one fee.

After accession to the Madrid Protocol, the Trade Marks Registry (TMR) office of India will have two fold responsibilities-

As an office of origin it will receive International Applications, verify that such applications are in conformity with the provisions of the Madrid Protocol and if the International Applications are proper the office will certify and transmit such applications to the International Bureau of WIPO. If any irregularity is found by the International Bureau of WIPO in any International Application transmitted from the TMR, it notifies such irregularities to the applicant (or his representative) as well as to the TMR. The applicant is required to correct the irregularities. The TMR will respond to notification of irregularities by the International Bureau. If the basic registration or the basic application (on the basis of which the International Application was filed and transmitted to the International Bureau of WIPO) ceases to be in existence within the period of 5 years from the date of international registration, the TMR will communicate this fact to the International Bureau of WIPO.

As an office of the designated contracting party the Indian TMR shall be notified about the international registrations in which India has been designated, this office shall record the particulars of such international registrations, examine it in accordance with the provisions of the Trade Marks Act & Rules. In case an objection is found during the examination of such international registration or an opposition is received after publication, this office shall communicate a provisional refusal (on the basis of examination or on the basis of opposition, as the case may be) to the International Bureau of WIPO. This office shall duly consider response to provisional refusals and process it as per Trade Marks Act & Rules. After completion of all the procedures, this office will either withdraw the provisional refusal or confirm the same fully or partly and shall give protection to the international registration in India accordingly and shall send the notification to the International Bureau to that effect. The TMR shall also keep updating renewal of international registration and changes made therein as and when notified by the International Bureau of WIPO.

This document provides guidelines to officials of the TMR for discharging functions of this office *as an office of origin* as well as, *as an office of the designated contracting party* under the Madrid Protocol.

DEFINITIONS/GLOSSARY

Unless otherwise is specifically stated, the words mentioned in this document shall mean as follows-

- (a) “Attorney” means a person not being registered as a trademarks agent under the Trade Marks Rules 2002, but duly authorised on form TM-48 by a person to work on his behalf before the Trade Marks Registry
- (b) “Basic application” means an application for the registration of a trademark pending before the Registrar of Trade Marks which is used as a basis for applying for an international registration;
- (c) “Basic registration” means the registration of a trade mark before the Registrar of Trade Marks which is used as a basis for applying for an international registration;
- (d) “Common Regulations” means the Regulations concerning the implementation of the Madrid Protocol;
- (e) “Contracting Party” means a Contracting State or Contracting Organisation which is party to the Madrid Protocol;
- (f) “He” and its derivatives like “his”, “him”, etc. shall include “she” and its derivatives, as the case may be.
- (g) “International application” means an application for international registration of a trademark made under the Madrid Protocol;
- (h) “International Bureau” means the International Bureau of the World Intellectual Property Organisation;
- (i) “International registration” means the registration of a trade mark with the International Bureau of the WIPO, done under the Madrid Protocol;
- (j) “IAOI” means an “International Application Originating from India”, it is a unique application No allotted by the Trade Marks Registry to every International Application originating from India
- (k) “IPO” means “Intellectual Property Office” of India headed by the Controller General of Patents Designs and Trade Marks
- (l) “IRDI” means an “International Registration Designating India”, it is a unique number allotted by the Trade Marks Registry to every International Registration in which India has been designated.

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- (m) “Madrid Protocol” means the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time.
- (n) “Notification” includes “communication” to or from the International Bureau of the WIPO made under the Madrid Protocol.
- (o) Registrar of Trade Marks means the Controller General of Patents Designs and Trade Marks appointed under Section 3(1) of the Trade Marks Act 1999, and includes any other officer working on his behalf for discharging his functions under the Trade Marks Act.
- (p) “TMR” means the “Trade Marks Registry” established under Section 5 of the Trade Marks Act 1999
- (q) **Any other term not defined here but defined in** Trade Marks Act 1999 or the Trade Marks Rules 2002 shall have the same meaning as assigned to them in the said Act or Rules.

GUIDELINES

PART A: INDIA, AS THE OFFICE OF ORIGIN

1. RECEIVING INTERNATIONAL APPLICATIONS

1.1.1. The applicant desiring to file an application for international registration of trademark under the Madrid Protocol through India, must be able to meet one of the following three criteria –

- The applicant should be a national of India, or
- The applicant should be domiciled in India, or
- The applicant should have a real and effective business or commercial establishment in India

1.1.2 Apart from the above applicant must also have a national trade mark application or registration of a trademark with the Indian Trade Marks Registry. This national mark must be used as the basis of the international application. The international application will have the same trade mark as mentioned in the national trade mark application or registration; and the list of goods and services mentioned in the international application should be identical with or no wider than that of the basic (national) mark.

1.1.3 The applicant in the international application will designate one or more other member countries of the Madrid Protocol, where the applicant wants to protect his mark.

1.2. Relevant legal provisions

- Section 36D of the Trade Marks Act 1999
- Rule 67D of the Trade Marks Rules 2002
- Article 2 & 3 of the Madrid Protocol
- Rule 9 of the Common Regulations

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1.3 Procedure regarding for filing application for international registration

- 1.3.1** The International Application must be submitted on form MM 2(E) as per instructions attached therewith, *on line* and *through the system*. A gateway for submitting MM 2(E) has been provided at the office website www.ipindia.nic.in.
- 1.3.2** If the application is submitted through a registered trademark agent or attorney, a duly executed Power of Attorney on form TM-48 in favour of the said agent/attorney shall be scanned in pdf file format & attached with the International Application by the person making the application.
- 1.3.3** In case the United States is designated in the International Application, the applicant must also submit through the system a form MM18 (E) with the International Application.
- 1.3.4** In case the European Union is designated in the International Application, the applicant shall also indicate a second language before the office of the European Union, out of- *French, German, Italian & Spanish*
- 1.3.5** In every case the trademark mentioned in the International Application must be legibly scanned separately with following specification-
- a. File format – -jpeg
 - b. Size - -3cmx3cm to 8cmx8cm
- and the same shall be attached with the application.
- 1.3.6** In case of trademarks consisting of plain text i.e. words/letters/numerals/combinations of these, without any figurative element therein, the applicant must select a declaration that '*the applicant declares that he wishes the mark to be considered as a mark in standard characters*'. The textual aspect of the trademark should be mentioned in the relevant field of *verbal element of the mark*.
- 1.3.7** The applicant needs to have a level 3 Digital Signature Certificate of a competent authority recognised by the Intellectual Property Office (IPO) of India.
- 1.3.8** The applicant **must** pay Rs 2000/ **as handling fee for an International Application**, through the payment gateway provided for this purpose at the office website.
- 1.3.9** On successful receipt of the International Application by the system, an acknowledgement thereof is generated as *Annexure 1* mentioning therein IAOI Number.
- 1.3.10** The applicant/agent/attorney concerned will keep this acknowledgement as record and shall mention the IAOI Number in further correspondence regarding that International Application.
- 1.3.11** The fee for International Application and the fee for designated contracting parties should be paid in Swiss Francs (CHF) by the applicant directly to the International Bureau.

2. VERIFICATION OF INTERNATIONAL APPLICATIONS

2.1. The designated officer of the TMR shall look at the International Application received through the system and verify as to the following-

- The applicant of the International Application is the national of India, or his principal place of business as mentioned in the basic application/registration, is in India
- The applicant of the International Application is the same person as the applicant of the basic application or proprietor of the trademark under the basic Registration
- Basic Application/registration mentioned in International Application subsists in the TMR records, and it does not have status like *withdrawn, abandoned, refused, removed, cancelled*
- The trademark mentioned in the International Application [MM2 (E)] and indications mentioned in item 9 thereof correspond with those in the basic application or Registration.

[There is no provision under the Madrid system to register a series of marks. If an international application is to be based on series marks, registered or applied for registration in India, then the applicant will be asked to choose one of the marks in the series to act as the basis for his international mark. If an applicant wishes to register all the marks in series internationally, he must file a separate application for each one.]

- The nature of the trademark mentioned in the international application is same as that in the basic application or basic registration.
- That the goods or services in the International Application are covered by the list of goods or services of the basic application or Registration.
- In case the United States has been designated in the International Application, the applicant has submitted a form MM18 (E) with the International Application.
- In case the European Union is designated in the International Application, the applicant has indicated a second language before the office of the European Union, out of- *French, German, Italian & Spanish*
- In case the European Union has been designated in the International Application, and applicant has wished to claim seniority of an earlier mark registered in, or for, a member state of the European Union, the applicant has submitted a form MM17 (E) with the International Application.

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2.2 Relevant legal provisions

- Section 36D of the Trade Marks Act 1999
- Rule 67D of the Trade Marks Rules 2002
- Article 2 & 3 of the Madrid Protocol
- Rule 9 of the Common Regulations

2.3 Procedure for verification of international application

2.3.1 The designated officer of the TMR shall verify the International Application as per Para 2.1

2.3.2 In case of any deficiency in the application, a letter as per Annexure 2 shall be generated through the system and the same shall be sent by email, to the person who has submitted the application and he/she shall be required to rectify the deficiency within one month from the date the same was communicated.

2.3.3 The applicant/agent/attorney as the case may be, shall respond to the official communication relating to deficiencies online *through the system* or *by email* at the address prescribed by the office for this purpose.

2.3.4 The response of the applicant shall be considered by the officer designated for this purpose and if deficiencies are remedied he/she shall modify the application accordingly.

2.3.5 If the irregularities are not rectified, a refusal letter as per Annexure 3 shall be generated through the system and the same shall be sent to the applicant/agent/attorney as the case may be, by email.

2.3.6 If however, the irregularities are rectified after the period of one month from the date the irregularities were communicated or even after the refusal letter from the office, the designated officer shall modify the application.

2.3.7 If the International Application is properly filed or irregularities, if any, are rectified the International Application shall be moved for certification.

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3. CERTIFICATION AND TRANSMISSION OF INTERNATIONAL APPLICATIONS

- 3.3.1 International Applications found to be proper in all respect, are certified as per item 13 the MM2 (E) through the system.
- 3.3.2 All certified applications are transmitted to the IB of WIPO through the system.
- 3.3.3 An alert is sent to the applicant concerned at his email informing about such transmission of his application and the amount of fee to be paid by him directly to the WIPO.

3.2. Relevant legal provisions

- Section 36D of the Trade Marks Act 1999
- Rule 67E of the Trade Marks Rules 2002
- Article 2 & 3 of the Madrid Protocol
- Rule 9 of the Common Regulations

3.3. Procedure for certification and transmission of international applications

3.3.1 International Applications found to be proper in all respect, are certified as follow-

- That the request to present this application was received on(dd/mm/yyyy).....
- That the applicant named in the application is the same as the applicant named in the basic application or the holder named in the basic registration mentioned in item 5, as the case may be,
- That any indication given in item 7(d), 9(d) or 9(e) appears also in the basic application or the basic registration, as the case may be,
- That the mark in the application is the same as in the basic application or the basic registration, as the case may be,
- That, if color is claimed as a distinctive feature of the mark in the basic application or the basic registration, the same claim is included in item 8 or that, if color is claimed in item 8 without having being claimed in the basic application or basic registration, the mark in the

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basic application or basic registration is in fact in the color or combination of colors claimed, and

- That the goods and services listed in item 10 are covered by the list of goods and services appearing in the basic application or basic registration, as the case may be.
- Where the international application is based on two or more basic applications or basic registrations, the above declaration shall be deemed to apply to all those basic applications or basic registrations.

and the same is transmitted on each Monday to the International Bureau of WIPO by the authorized officials of the TMR through the system

3.3.2 While transmitting the International Application to the IB of WIPO, the designated officer of the TMR shall send an alert to the applicant at his email, informing about the transmission of his application to WIPO, and the amount of fee in Swiss Francs payable by the applicant directly to the WIPO.

4. RECEIVING IRREGULARITIES, IF ANY, FROM THE WIPO AND RESPONDING TO THEM

4.1. The International Bureau of the WIPO scrutinizes International applications received from offices of origin. If any irregularity is found, the International Bureau notifies such irregularities to the office of origin concerned as well as to the applicant/applicant's authorized representative. The irregularities are ordinarily rectified through the office of origin within the period of three months from the date of notification.

4.2. Relevant legal provisions

- Section 36D of the Trade Marks Act 1999
- Rule 67E of the Trade Marks Rules 2002
- Article 2 & 3 of the Madrid Protocol
- Rules 11, 12 & 13 of the Common Regulations

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4.3. Procedures for receiving irregularities, if any, from the WIPO and responding to them

- 4.3.1 After receiving International applications from offices of origin, whenever the International Bureau of the WIPO finds that there is irregularity, it notifies such irregularities to the applicant/applicant's authorised representative as well as to the office of origin.
- 4.3.2 The TMR, being the office of origin for International applications originating from India, shall receive such notifications from the WIPO online and through the system.
- 4.3.3 The designated officer of the TMR will classify the irregularities as to which irregularities are to be rectified by the office and which are to be rectified by the applicant.
- 4.3.4 The designated officer of the TMR will generate a letter through the system as per *Annexure 4* and send it, by electronic means, to the person who has made the International application requiring the applicant to rectify the irregularities of the applicant's part within the period of one month from the date of such communication
- 4.3.5 The applicant/agent/attorney as the case may be, shall respond to the official communication relating to irregularities, **online through the system.**
- 4.3.6 The response of the applicant received shall be considered by the officer concerned.
- 4.3.7 If no response is received within the prescribed period, or the response received is not satisfactory, the designated officer shall send a reminder to the applicant/agent/attorney concerned along with his suggestion, as per *Annexure 5*
- 4.3.8 The TMR shall also consider the irregularities meant for the office and shall take action to rectify the same.
- 4.3.9 On the basis of response from the applicant and the action taken by the office the designated officer of the TMR shall respond to the International Bureau online through the system.

5. COMMUNICATION AS TO CEASING OF EFFECT OF BASIC APPLICATION OR REGISTRATION REFERRED IN THE INTERNATIONAL APPLICATION

- 5.1. Under the provisions of the Madrid Protocol the protection resulting from the international registration ceases to have effect if, before the expiry of five years from the date of the international registration, the basic application or the basic registration, as the case may be, ceases to exist. The office of origin which has forwarded such application for the international

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registration is under obligation to communicate to the International Bureau of WIPO, the fact relating to ceasing of effect of basic application or registration.

5.2 Relevant legal provisions

- Section 36D (5) & (6) of the Trade Marks Act 1999
- Article 6(3) & (4) of the Madrid Protocol
- Rule 22 of the Common Regulations

5.3. Procedure for communication as to ceasing of effect

- 5.3.1 Where the basic application or basic registration mentioned in the international application ceases to exist within the period of five years from the date of international registration, the designated officer of the TMR shall notify this fact to International Bureau of WIPO in *Annexure 6* (as per *Model form 9*) and through the system
- 5.3.2 Such communication shall indicate the number of the international registration concerned and the name of the holder (proprietor). The notification shall also indicate the facts and decisions affecting the basic application (or the registration resulting therefrom) or the basic registration, and the effective date of those facts and decisions.
- 5.3.3 Where these facts and decisions affect only some of the goods and services covered by the international registration, the communication shall indicate which goods and services are affected or which goods and services are not affected.
- 5.3.4 Where a refusal, withdrawal, cancellation etc., affects the basic application, the registration resulting therefrom or the basic registration only in respect of goods and services which are not covered by the international registration, no notification should be sent to the International Bureau.
- 5.3.5 The designated officer shall also communicate to the International Bureau, if the TMR is aware that any of the following is pending in respect of the basic application or registration, before the expiry of five years from the date of international registration-
- a. a judicial action concerning the basic registration,
 - b. an action requesting revocation or cancellation of basic registration
 - c. an appeal against a decision refusing the basic application,
 - d. an application requesting withdrawal of the basic application

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- e. an opposition to the basic application
- 5.3.6 Such notification shall indicate that the action in question has not yet resulted in a final decision.
- 5.3.7 Where the preliminary notification as referred to in the preceding paragraph has been sent, the officer concerned shall, once the decision has become final, promptly notify the International Bureau accordingly.
- 5.3.8 The International Bureau records any notification in the International Register, and transmits copies of the notification to the holder and to the Offices of the designated Contracting Parties. Where the notification requests cancellation of the international registration, it is so cancelled, to the extent applicable; the International Bureau notifies accordingly the holder and the Offices of the designated Contracting Parties.

PART B: INDIA AS OFFICE OF DESIGNATED CONTRACTING PARTY

6. RECEIVING INTERNATIONAL REGISTRATIONS DESIGNATING INDIA

6.1. Once the International Bureau receives an International Application, it carries out a scrutiny of such application to ascertain its compliance with the necessary requirements of the Agreement, the Protocol, and their Common Regulations. This examination is restricted to formalities, including the classification and comprehensibility of the list of goods and/or services. If there are no irregularities, the International Bureau records the mark in the International Register, publishes the international registration in the WIPO Gazette of International Marks, and notifies it to each designated Contracting Party.

If India is designated in the International Application, the International Bureau will notify the international registration to India. The particulars of the international registration shall be separately recorded in the computer database of the TMR.

6.2. Relevant legal provisions

- Section 36E (1) of the Trade Marks Act 1999
- Rule 67G of the Trade Marks Rules 2002
- Article 3(4) of the Madrid Protocol
- Rule 14 of the Common Regulations

6.3. Procedure for receiving international registrations designating India

6.3.1 All the notifications received from the International Bureau through the system shall be segregated by an officer designated for this purpose.

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- 6.3.2 The details of all the notifications as to BIRTHS i.e. new International Registrations Designating India shall be recorded in computer database of the TMR, to be called 'Record of Particulars of International Registrations.
- 6.3.3 In case the mark contains figurative elements, the TMR office will complete the codification as per Vienna Classification by adding 'Sections' as the third level of codification, if the same is not notified to us.
- 6.3.4 The **filing date** of an IRDI in our system shall be the date of international registration.
- 6.3.5 The **notification date** is the date on which TMR India electronically receives the notification from the International Bureau
- 6.3.6 The data entry of the particulars of the international registrations shall be verified by a designated officer of the TMR.
- 6.3.7 A reference No. like **IRDI/...(Number)...** shall be generated for each international registration.

7. EXAMINATION OF INTERNATIONAL REGISTRATIONS DESIGNATING INDIA

7.1. Every international registration designating India received from the International Bureau of WIPO will be examined by the TMR under the provisions of the Trade Marks Act 1999 & Rules made thereunder. If there is any objection for protection of such registration, a provisional refusal will be notified to the International Bureau of WIPO latest within the period of 18 months from the date the international registration was notified to India. The International Bureau records the provisional refusal in the international register and communicates such provisional refusal to the holder (applicant) of the international registration. The holder may respond to the provisional refusal. The TMR then considers the response of the holder of the international registration and may either confirm the refusal or move for publication of the international registration in the Trade Marks Journal.

7.2 Relevant legal provisions

- Section 36E (2) of the Trade Marks Act 1999
- Rule 67H of the Trade Marks Rules 2002
- Articles 4 & 5 of the Madrid Protocol
- Rules 17, 18 & 18ter of the Common Regulations

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7.3. Procedure adopted for examination of international registrations designating India

- 7.3.1** After the data entry of particulars of the international registrations has been verified, all international registrations shall be examined under the relevant provisions of the Trade Marks Act 1999 & Trade Marks Rules 2002.
- 7.3.2** International Registrations Designating India (IRDIs) will be examined at the time when national applications with the filing date same as the date of international registrations of such IRDIS, are examined. However when India has been subsequently designated, relevant IRDIs will be examined when national applications with the filing date same as the date of notification of such IRDIs, are examined
- 7.3.3** In case of IRDI regarding collective or certification mark, the Examiner shall look for draft regulations and examine the IRDI as per relevant provisions of the Trade Marks Act 1999 & Trade Marks Rules 2002.
- 7.3.4** The Examiner of the TMR office, while examining the international registrations, shall see whether the mark contained in the international registration, could be refused registration as per provisions of the Trade Marks Act & Rules.
- 7.3.5** In case the mark contained in the international registration could be refused registration a draft of the provisional refusal shall be generated by the Examiner concerned, through the system.
- 7.3.6** The said draft generated by the Examiner shall be approved by a Supervising Officer through the system, who may send the case back to Examiner for re-examination with his/her remark, if the Supervising Officer thinks that the examination was not duly done.
- 7.3.7** If the draft examination report is not approved, the Examiner shall re-examine and modify the draft as per instructions of the Supervising Officer.
- 7.3.8** On approval of an Examination Report containing objections, the status of the IRDI shall be changed as *objected* and a provisional refusal based on ex officio examination, shall be communicated in the form of *Annexure 7(as per Model Form 3)* to the International Bureau of WIPO, through the system.
- 7.3.9** The IRDI shall ordinarily be examined within the period of six months from the date the international registration was notified to India.
- 7.3.10** The provisional refusal is recorded in the International Register, together with an indication of the date on which the notification was sent. The provisional refusal is also published in the WIPO Gazette, with an indication as to whether the refusal is total (i.e. relates to all the goods and services covered by the designation) or partial (i.e., relates to only some of those goods and

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services).

- 7.3.11** The International Bureau then transmits a copy of the provisional notification to the holder of the international registration.
- 7.3.12** Where the holder of the international registration receives, through the International Bureau, a notification of provisional refusal, he has the same rights and remedies as if the application has been filed directly in India.
- 7.3.13** The holder of the international registration may engage a local agent who is familiar with the law and practice of the TMR India.
- 7.3.14** The holder of the international registration may also amend his international application at the level of IB of WIPO by deleting goods/services or by otherwise limiting the scope of registration to overcome the provisional refusal. Such amendment may be received through the notification from WIPO.
- 7.3.15** Any amendment or limitation requested by the holder of the international registration, if permissible as per the Trade Marks law, shall be incorporated in Record of Particulars of International Registration, through the system.
- 7.3.16** In case a hearing is required a show cause hearing shall be fixed and the same shall be conducted by a designated officer.
- 7.3.17** If no response to the provisional refusal is received by the office even after 2 months' of the notification and neither any request for extension of time is received on behalf of the holder nor any limitation of scope of international registration is made pursuant to the provisional refusal, or if the office objections could not be waived by the designated officer of the TMR, even after considering response and after giving an opportunity for hearing, the confirmation of the provisional refusal of the protection of the international registration in *Annexure 9* (as per Model form 6.) shall be communicated to the International Bureau of WIPO, through the system.
- 7.3.18** All the Examination Reports, wherein no objections were found at examination stage and it was proposed to accept the international registration for protection in India, shall be approved by a Supervising Officer. In such case the international registration shall be advertised in a separate part of the Trade Marks Journal accordingly.

8: PUBLICATION OF INTERNATIONAL REGISTRATION IN THE TRADEMARKS JOURNAL

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8.1. When the international registration is accepted for protection in respect of all or some of goods/services, the particulars of the international registration shall be published in a separate part of the Trade marks Journal.

8.2. Relevant legal provisions

- Section 36E (2)& (3) of the Trade Marks Act 1999
- Rule 67H of the Trade Marks Rules 2002

8.3. Procedure regarding the publication

8.3.1 If no objection for protection of the international registration is found at examination stage or if after considering the response of the holder or after a hearing, the international registration is proposed to be accepted for protection, the particulars of the international registration shall be published in a separate part of the Trade marks Journal.

8.3.2 The publication of the international registration shall contain following particulars-

- IRDI No
- International Registration No
- Date of International Registration
- Priority detail, if any
- Reproduction of the trademark
- Transliteration and Translation of the trademark in English, if the mark is in non-English characters
- Nature & Description of the trademark like standard character, colour mark, three dimensional or packaging of goods
- Nature & Description of International Registration like certification mark or collective mark
- The name and address of the holder of the international registration
- The name and address of the holder's agent in India
- Class(es) and corresponding description of goods and services
- Statement as to use of the trademark in India
- Limitation & Conditions of International Registration desired by the holder or imposed by the TMR and agreed to by the holder.

8.3.3 The publication in the trademark journal will also mention that the Notice of Opposition, if any,

to the international registration shall be filed, on line through the system, within the period of four months from the date of its publication in the journal.

9: RECEIVING OPPOSITION TO PROTECTION OF INTERNATIONAL REGISTRATIONS, COMMUNICATING PROVISIONAL REFUSAL ON THE BASIS OF OPPOSITION, CONDUCTING OPPOSITION PROCEEDINGS AND NOTIFYING THE FINAL DECISION

9.1 International designations are opposed in exactly the same way as national marks, that is, by filing form TM-5, together with a statement of grounds of opposition and a fee. If an opposition to protection of the international registration is received within the prescribed period after publication of an international registration in the trademark journal, the TMR shall communicate the provisional refusal based on opposition to the WIPO and dispose the opposition as per the relevant provisions of the Trade Marks Act & Rules and notify the final decision thereafter to the IB of the WIPO.

9.2 Relevant legal provisions,

- Section 36E (4) & (5) of the Trade Marks Act 1999
- Rule 67H of the Trade Marks Rules 2002
- Articles 4 & 5 of the Madrid Protocol
- Rules 17,18,18bis & 18ter of the Common Regulations

9.3. Procedure relating to opposition proceedings

9.3.1 A Notice of Opposition to protection of the international registration, if any, shall be received by the TMR on form TM-5, on line through the system.

9.3.2 The notice of opposition may be filed by the opponent himself (having address in India), or through a registered trademark agent or an advocate having address in India, who would represent and work on behalf of the opponent, before the Trade Marks Registry

9.3.3 The opponent if engages an agent, shall execute a Power of Attorney on form TM-48 in favour of the agent and shall submit to the TMR, the scanned copy of the Power of Attorney in pdf file

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format, through the system.

- 9.3.4 The opponent shall mention in the notice of opposition his email address or the email address of his authorized agent.
- 9.3.5 A statement of grounds of opposition consisting of facts as mentioned in Rule 48 of the Trade Marks Rules 2002, shall be signed by the opponent or by his agent/attorney acquainted with the facts of the case .The *grounds of opposition*, duly executed *Power of Attorney* on form TM-48 (in case of authorisation) shall be scanned in pdf file format and shall be attached with the notice of opposition filed online through the system.
- 9.3.6 With every opposition, the necessary fee as per First Schedule of the Trade Marks Rules 2002 shall be paid online and through the system.
- 9.3.7 In case no opposition to protection of the international registration is received and the period of 4 months has not expired after its advertisement or re-advertisement in the trademark journal, and the period of 18 months after the date of notification of the relevant IRDI is likely to expire, a statement as per *Annexure 10* shall be sent electronically to the International Bureau of WIPO to the effect that the *ex officio* examination has been completed and that the TMR has found no grounds for refusal, but that the protection of the mark is still subject to opposition by third parties. In the said statement the date by which such oppositions may be filed, shall also be indicated.
- 9.3.8 On receipt of the opposition, a provisional refusal based on opposition in the form of *Annexure 7(as per Model Form 3)* shall be generated through the system and shall be sent to the international Bureau of the WIPO electronically along with the scanned copy of grounds of opposition
- 9.3.9 The notification as to provisional refusal based on opposition shall, in addition to other information, contain-
- a. the name and address of the opponent and,
 - b. where the opposition is based on a mark which has been the subject of an application or registration, a list of the goods and services on which the opposition is based
 - c. the period and manner of responding to the opposition
 - d. the fact that the holder of the international registration should engage a registered trademark agent or an advocate having address in India, as his agent by executing a Power of Attorney in the favour of the agent so engaged
 - e. the relevant provisions of the Trade Marks Act & Rules particularly relating to opposition proceedings

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- 9.3.10 The International Bureau transmits the provisional refusal based on opposition to the holder or his authorised agent.
- 9.3.11 If the holder wants to defend his international registration in India, he shall file counter statement on form TM-6. In such case the holder shall engage a trademark agent/attorney having address in India by executing a Power of Attorney in the favour of the agent/attorney in the form TM-48 Such an authorised agent/attorney shall submit the scanned copy of the counterstatement signed by the holder or a person authorised by him, and the scanned copy of the Power of Attorney in the favour of the agent/attorney online through the system, The authorised agent/attorney shall also provide his email address.
- 9.3.12 If no reply or counterstatement is received on behalf of the holder within the prescribed time, the international registration shall be refused protection and the provisional refusal communicated to the WIPO shall be confirmed and a notification in form of *Annexure 9* shall be sent to the WIPO electronically.
- 9.3.13 The counterstatement on behalf of the holder shall be sent electronically to the opponent or his agent.
- 9.3.14 The evidences, if any, on behalf of the holder of international registration, or on behalf of the opponent shall be received in pdf file format through the system.
- 9.3.15 All communications from the TMR office, during the opposition proceedings, meant for the agent of the holder of international registration, or for the opponent/opponent's authorized agent, shall be sent only in electronic form.
- 9.3.16 The opposition proceedings shall be conducted in usual procedure, as if an application submitted directly with the TMR is opposed; the international registration, however, shall not be treated as abandoned for the lack of prosecution. In case of the lack of prosecution, the designated officer concerned shall proceed ex parte, decide about the protection the international registration on merit and may confirm the provisional refusal.
- 9.3.17 After completion of the all the proceedings before TMR office-
- a. If the Registrar of Trade Marks has decided to confirm such refusal of protection of the mark for all the goods or services for which the protection has been requested, a notification of confirmation to the provisional refusal in *Annexure 9* shall be sent to the International Bureau of WIPO through the system.
 - b. Where, the provisional refusal has been either totally or partially withdrawn, a notification of revocation in *Annexure 11* (as per Model form 5) to the effect that the provisional refusal is withdrawn and the protection of the mark is granted for all or some

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of the goods or services for which the protection has been requested, shall be sent to the International Bureau of WIPO through the system.

- c. Where no notification of provisional refusal was communicated to the WIPO and all procedures before the office (i.e. examination & opposition) is completed and there is no ground to refuse the protection of the international registration, a notification as to grant of protection in the form of *Annexure 12* (as per Model form 4) shall be sent to the International Bureau of WIPO through the system.
- d. All international registrations for which protection have been granted in India shall be published in the ensuing issue of the trademark journal. Such publication will consist of list of IRDI along with corresponding International Registration numbers
- e. It should be noted that **no registration certificate is issued** with regard to international designations. The reason for this is that the mark has already received its “registration certificate” from WIPO when it was registered internationally, prior to being forwarded to India.
- f. Where an international registration has been protected India but the office later on becomes aware of any further decision that affects the protection of the mark (for example, a decision resulting from an appeal or writ or any decision on an application for cancellation), a further statement in the form of *Annexure 13* (as per Model form 7), indicating the goods and services for which the mark is now protected, shall be sent to the International Bureau of WIPO through the system.

10: RECORDING RENEWALS AND CHANGES AND CORRECTIONS IN THE INTERNATIONAL REGISTRATIONS

10.1 The renewals of international registrations and amendments or corrections in the international registrations are done by the international bureau of the WIPO. In case of objectionable corrections or amendments in the international registrations where India has been designated, the TMR office notifies its objections and in rest of cases the TMR office updates its records pertaining to international registrations concerned.

10.2. Relevant legal provisions.

- Rule 67G of the Trade Marks Rules 2002

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- Articles 7,9 & 9bis of the Madrid Protocol
- Rule 24 to 33 of the Common Regulations

10.3. Procedure for recording renewals of international registrations and amendments or corrections in the international registrations

10.3.1. Renewal of the international registration-

- The registration of a mark at the International Bureau is for a period of 10 years. It is then renewable for a further 10 years upon payment of the required fees. On the *request* made by the holder of the international registration for its renewal and after receipt of the renewal fee, the International Bureau records the renewal in the International Register, with the date on which it was due, even if the fees required were paid within the grace period of six months after the due date.
- The effective date of the renewal is the same for all designations contained in the international registration, irrespective of the date on which such designations were recorded in the International Register.
- Where the international registration has been renewed, the International Bureau so notifies the Offices of the designated Contracting Parties concerned and sends a certificate to the holder. The relevant data concerning the renewal are published in the Gazette. The publication is in effect a re-publication of the international registration, in the form at which it stands after renewal.
- If an international registration is not renewed (because the holder did not pay the renewal fees or because the fees paid were not sufficient), it lapses with effect from the date of expiry of the previous period of protection. In such case, this fact is notified to the Offices of the designated Contracting Parties and is published in the WIPO Gazette.
- Where an international registration is not renewed in respect of a particular designated Contracting Party, the International Bureau notifies accordingly the Office concerned.
- After receipt of the notification from the WIPO as to renewal or non-renewal of the international registration designating India, the TMR office shall update its records pertaining to that of the international registration.

10.3.2 Change in name or address of the holder of international registration

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- A request to record a change in name or address of the holder of international registration is presented to the International Bureau of WIPO. The International Bureau records the change of name or address in the International Register and notifies accordingly the Offices of the designated Contracting Parties. At the same time, it informs the holder and, where the request was presented by an Office, that Office.
- The change is recorded as of the date of receipt of a request by the International Bureau complying with the applicable requirements. The International Bureau thereafter publishes the relevant data in the Gazette.
- After receipt of the notification from the WIPO as to change in name or address of the holder of international registration designating India, the TMR office shall update its records pertaining to that of the international registration.

10.3.3 Limitation, renunciation or cancellation

- The holder of international registration may wish to have recorded one of the following restrictions in the protection of his international registration:
 - a *limitation* of the list of goods and services, which may affect *some or all* of the designated Contracting Parties (“limitation”);
 - a *renunciation* of the protection in respect of some of, but not all, the designated Contracting Parties, for *all* the goods and services (“renunciation”);
 - the *cancellation* of the international registration in respect of *all* the designated Contracting Parties, for *some or all* of the goods and services (“cancellation”).
- A request to record a limitation, renunciation or cancellation is presented to the International Bureau on the appropriate official form (MM6,MM7 or MM8) established by the International Bureau or on a form having the same contents and format. The International Bureau records the limitation, renunciation or cancellation in the International Register and notifies accordingly the Offices of those designated Contracting Parties concerned (necessarily all of them in the case of a cancellation). The recording is made as of the date of receipt by the International Bureau of a request complying with the applicable requirements. The International Bureau then publishes the relevant data in the WIPO Gazette.

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- If the request for limitation, renunciation or cancellation is not against the provisions of the Trade Marks Act, the records of the relevant IRDI shall be updated by the designated officer of the TMR.

10.3.4 Change in ownership

- A request to record a change in ownership is presented to the International Bureau on the official form (MM5) established by the International Bureau or on a form having the same contents and format. The International Bureau records the change in ownership in the International Register and notifies accordingly the Offices of the designated Contracting Parties in respect of which the international registration has been transferred. At the same time it informs the holder. The International Bureau also informs the former holder (in the case of a total change in ownership) or the holder of the part of the international registration which has been assigned or otherwise transferred (in the case of a partial change in ownership).
- The validity of a change in ownership of an international registration where India has been designated, will be governed by Indian law. In particular, where the change in ownership is for only some of the goods and services, the Registrar of Trade Marks has the right to refuse to recognize the validity of the change if the goods and services included in the part transferred are similar to those remaining in the name of the holder. Similarly the change in ownership of international registration regarding a certification mark recorded by the International Bureau will not automatically have effect in India.
- If it is found that any change in the ownership has no effect in India, a declaration to this effect shall be communicated to the International Bureau of WIPO, electronically maximum within the period of 18 months from the date on which that notification was sent by the WIPO.
- It is to be clarified that licenses of international registrations requested and effected by the International Bureau of WIPO, shall have no effect in India. The licenses of international registrations, where India has been designated, will have to be requested to the Registrar of Trade Marks and the same will be decided by the TMR. In its declaration, the designated officer shall indicate the reasons for which the change in the ownership has no effect and where the declaration does not affect all the goods and services to which the limitation relates, those which are affected by the declaration or those which are not affected by the declaration, as well as the corresponding essential provisions of the law.

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- The effect of above declaration by India, as far as the International Register is concerned, is that the change of ownership has no effect with respect to India.
- In cases where no objection to any change ownership in the international registration notified by the WIPO has been sent, the computer record of particulars of the corresponding international registration shall be updated.

10.3.5. Correction of errors

- Where the International Bureau considers that there is an error concerning an international registration in the International Register, it corrects that error *ex officio*. It also corrects such an error on request of the holder or of an Office. Where an error in the International Register has been corrected, the International Bureau notifies the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect.
- Such corrections shall be examined by the designated officer of the TMR.
- If it is found that protection of international registration as corrected may not be granted, a notification of refusal of the effects of correction along with the reasons therefor shall be sent to the WIPO electronically within the period of 12 months from the date of notification from the WIPO.
- In cases where no objection to any change in the international registration notified by the WIPO has been sent, the computer record of particulars of the international registration shall be updated.

10.3.6. Notifications received from International Bureau regarding any change in the details of international registrations designating India shall be examined by a designated officer of the TMR. If such change is against the provisions of the Trade Marks Act & Rules made thereunder, a notification of refusal of the effects of such changes along with the reasons therefor, shall be sent to the WIPO electronically within the period of 12 months from the date of notification from the WIPO. If changes in the details of international registrations designating India are not against the law the details of international registrations designating India shall be updated in the system.

10.3.7 All the changes in the details of international registrations designating India recorded at the International Bureau, and updated in the records of particulars of international registrations, after its publication in trademarks journal, shall be advertised in the journal as a notification.

ANNEXURES

ANNEXURE 1

ACKNOWLEDGEMENT OF SUBMISSION OF INTERNATIONAL APPLICATION UNDER THE MADRID PROTOCOL

Receipt No	Date of the receipt	IAOI/..(Sequential No)....
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Basic application/registration No(s)

The name & address of the agent/attorney

(if the IA has been submitted by a person other than the applicant)

The name & address of the applicant,

Class (es) of goods/services

Details of the payment including amount paid

Note: This is computer generated receipt and needs no authentication

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ANNEXURE 2

FORMAT OF COMMUNICATION TO THE APPLICANT OF INTERNATIONAL APPLICATION IN CASE OF ANY DEFICIENCY FOUND BY THE TMR

To,

....(payer's name & address)....

Subject: Deficiency in IAOI No.....

Dear Sir/Madam

With reference to the IAOI as mentioned above received by the TMR vide receipt No.....dated....., it is to inform that the said International Application can't be certified and forwarded by this office to the International Bureau under Section 36D (4) of the Trade Marks Act 1999, due to the following reasons-

- (1) The applicant is not authorised to make the International Application because the applicant is the not a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in India.
- (2) The registered trademark No(s)..... on the basis of which the international application is made, is not renewed and no more exists on the Register of Trade Marks
- (3) The application No(s)..... on the basis of which the International Application is made, is already withdrawn/treated as abandoned or refused for registration of trademark.
- (4) The goods/services mentioned in the International Application don't correspond with the goods/services covered under the basic registration(s)/basic application(s).
- (5) The trademark mentioned in the International Application doesn't correspond with the trademark mentioned in the registration No..... / application No....., on the basis of which the international application is made,
- (6)(Any other reason).....

A notice is given under Rule 67E (3) of the Trade Marks Rules 2002 to remedy the abovementioned deficiencies and respond to this letter within the period of one month from the date of this letter.

The abovementioned International Application will be certified and forwarded by this office to the International Bureau only when the deficiencies are satisfactorily remedied.

Response to this letter should be sent only through the gate way available at the comprehensive e-filing services of trademarks available at the website www.ipindia.nic.in

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ANNEXURE 3

FORMAT OF COMMUNICATION TO THE APPLICANT OF INTERNATIONAL APPLICATION, IN CASE ANY DEFICIENCY FOUND BY THE TMR IS NOT REMEDIED

To,

....(payer's name & address)....

Subject: Deficiency in IAOI No.....

Dear Sir/Madam

With reference to the IAOI as mentioned above received by the TMR vide receipt No.....dated....., it is to inform that ***the said International Application could not be certified and forwarded*** by this office to the International Bureau under Section 36D (4) of the Trade Marks Act 1999, because the deficiencies in the International Application, communicated by this office vide letter No .../TMR/..... dated, have not been remedied so far.

If the deficiencies in the International Application communicated by this office under letter No .../TMR/..... dated, are satisfactorily remedied, ***the said International Application can still be certified and forwarded*** by this office to the International Bureau but the date of filing of the International Application may not be the date on which it was received by the TMR.

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ANNEXURE 4

FORMAT OF COMMUNICATION TO THE APPLICANT OF INTERNATIONAL APPLICATION IN CASE ANY IRREGULARITY IN THE INTERNATIONAL APPLICATION IS NOTIFIED BY THE INTERNATIONAL BUREAU OF THE WIPO

To

....(payer’s name & address)....

Subject: Notification of irregularity received from the International Bureau of the WIPO, in **IAOI No.....**

Dear Sir/Madam

With reference to the IAOI as mentioned above received by the TMR vide receipt No.....dated....., it is to inform that the said International Application was certified and forwarded by this office to the International Bureau of the WIPO, under Section 36D (4) of the Trade Marks Act 1999. The International Bureau of the WIPO has however notified the following irregularity (es) in the said application-

.....

A notice is given to remedy the abovementioned irregularity (es) and reply to this letter within the period of one month from the date of this letter.

The response to the notification of the International Bureau mentioning the irregularity in your application will be sent by this office only when abovementioned irregularities are remedied and a satisfactory reply to this letter is received

Response to this letter should be sent only through the gate way available at the comprehensive e-filing services of trademarks available at the website www.ipindia.nic.in

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ANNEXURE 5

FORMAT OF COMMUNICATION TO THE APPLICANT OF INTERNATIONAL APPLICATION, IN CASE ANY IRREGULARITY NOTIFIED BY THE INTERNATIONAL BUREAU OF WIPO IS NOT REMEDIED

To,

....(payer's name & address)....

Subject: Notification of irregularity received from the International Bureau of the WIPO, in
IAOI No.....

Dear Sir/Madam

With reference to the IAOI as mentioned above received by the TMR vide receipt No.....dated....., it is to inform that *the response to the notification of the International Bureau mentioning the irregularity in your application could not be sent by this office*, because neither irregularity(es) communicated to you vide this office letter No/TMR/..... dated have not been satisfactorily remedied, nor any satisfactory reply to this letter has been received.

If irregularity (es) in the International Application, communicated to you are satisfactorily remedied, *the response to the notification of the International Bureau mentioning the irregularity in your application can still be sent by this office*, but the date of the International Application may not be the date on which it was received by the TMR.

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ANNEXURE 6

CEASING OF EFFECT OF THE BASIC APPLICATION, OF THE REGISTRATION RESULTING THEREFROM, OR OF THE BASIC REGISTRATION

Notified to the International Bureau of the World Intellectual Property Organization (WIPO) in accordance with Rule 22(1)(a) or (c) of the Common Regulations under the Madrid Agreement and Protocol

Office making the notification:	GOVERNMENT OF INDIA TRADE MARKS REGISTRY Boudhik Sampada Bhawan S. M. Road, Antop Hill Mumbai—400037, India.
II. Number of the international registration:	
III. Name of the holder	
IV. <input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(a) <input type="checkbox"/> The notification is sent in accordance with Rule 22(1)(c)	
V. Facts and decisions affecting the basic application, the registration resulting therefrom, or the basic registration: <input type="checkbox"/> Not resulting from an action brought by a third party <input type="checkbox"/> Resulting from an action brought by a third party: <input type="checkbox"/> an opposition to the basic application	

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<input type="checkbox"/> a request of revocation of the basic registration or the registration resulting from the basic application
<input type="checkbox"/> a request of invalidation of the basic registration or the registration resulting from the basic application
<input type="checkbox"/> a request of cancellation of the basic registration or the registration resulting from the basic application
<input type="checkbox"/> other (please specify):
VI. <input type="checkbox"/> These facts and decisions affect all the goods and/or services
<input type="checkbox"/> These facts and decisions affect some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] ¹
VII. <input type="checkbox"/> The cancellation of the international registration is requested to the extent indicated under item VI
VIII. Effective date of those facts and decisions:
IX. Signature or official seal of the Office making the notification:

¹ The goods and/or services to be indicated here are as follows:

- those goods and/or services in the **international registration concerned** which are affected by the facts and decisions, or
- if there has already been a partial cancellation, those, out of the remaining goods and/or services, which are affected by the facts and decisions.

Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or all services) in class X”. In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

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ANNEXURE 7

NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION OF AN INTERNATIONAL REGISTRATION DESIGNATING INDIA

Rule 17(1) of the Common Regulations

I. Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA Boudhik Sampada Bhawan S. M. Road, Antop Hill Mumbai—400037, India.
II. Number of the international registration: (Reference IRDI No allotted to this international registration by the TMR India.....)	
III. Name of the holder (or other indication enabling the identity of the international registration to be confirmed):	
IV. <input type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input type="checkbox"/> Provisional refusal based on an opposition² <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition¹	
V. <input type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] ³	

² The name and address of the opponent should also be provided.

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VI. Grounds for refusal [(where applicable, see item VII)]:				
VII. Information relating to an earlier mark⁴ :				
S. N o	Registration Number/applicati on No	Registration date/date of application/date of priority	Trademark	Status of the trademark/applicati on
1				
	Class and list of goods & services	Date of prior use claimed	Date of priority claimed	
	Registration Number/applicati on No	Registration date/date of application/date of priority	Trademark	Status of the trademark/applicati on
2				
	Class and list of goods & services	Date of prior use claimed	Date of priority claimed	
VIII. Corresponding essential provisions of the applicable law [(see text under XII)]:				

³ Where all the goods or services included in a given class are to be mentioned, the indication should read “all goods (or all services) in class X”. In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

⁴ Where the grounds on which the provisional refusal is based relate to an earlier mark, as indicated under item VI. The indication required under this item may be given by annexing a printout from the register or database.

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<p>IX. Information relating to subsequent procedure:</p> <p>(i) Time limit for response or for a request to reconsider the provisional refusal: one month from the date of receipt of provisional refusal by the holder of international registration.</p> <p>(ii) Authority to which such request for review or appeal should be made: The response to, or a request for reconsideration of , the provisional refusal must be sent by email ataddressing to the Registrar of Trade Marks, Trade Marks Registry Mumbai</p> <p>(iii) Indications concerning the appointment of a representative: The response to, or a request for reconsideration of, the provisional refusal must be filed through an agent or a representative whose address is within the territory of India. The said agent may submit on behalf of the owner of the international registration the response or a request for reconsideration of the provisional refusal, submit the evidence of prior use of the trademark in India by the way of owner's affidavit or may agree to limit the scope of protection, or request for personal hearing.</p> <p>(iv) In further communication with respect to the aforesaid International Registration, the IRDI No written should always be mentioned</p>
<p>X. Date of the notification of provisional refusal:</p>
<p>XI. Signature or official seal of the Office making the notification:</p>

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XII. Corresponding essential provisions of the applicable law:

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ANNEXURE 8

FORMAT OF COMMUNICATION FOR OFFERING HEARING, IN CASE THE RESPONSE TO THE PROVISIONAL REFUSAL IS NOT SATISFACTORY

To,
...(Authorised agent of the holder of
The International registration designating India)....
.....

Subject: Provisional Refusal communicated in IRDI NO.....

Dear Sir/Madam

It is to inform that your response to the provisional Refusal communicated in IRDI NO..... (and documents attached therewith) are duly considered, but the objections to protection of the international registration No....., cannot be waived. In such circumstances the protection to the international registration may not be granted in India.

An opportunity of personal hearing however is being given to you before the final decision on protection to the international registration, is taken.

You are therefore requested to attend hearing scheduled to be held aton.....before the Assistant Registrar of Trade Marks, Trade Marks Registry, Boudhik Sampada Bhawan S. M. Road, Antop Hill Mumbai—400037, India.

You may make your submission, produce any further document or agree for any condition or limitation of the international registration, which will be binding on the holder.

In case you fail to attend the hearing the provisional refusal to protection of the international registration may be confirmed.

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ANNEXURE 9

FINAL DISPOSITION ON STATUS OF A MARK

– CONFIRMATION OF TOTAL PROVISIONAL REFUSAL –

Rule 18ter(3) of the Common Regulations

I. Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA Boudhik Sampada Bhawan S.M.Road, Antop Hill Mumbai—400037, India.
II. Number of the international registration:.....	(Reference IRDI No allotted to this international registration by the TMR India).....
III. Name of the holder	
IV. Protection of the mark is refused for <u>all</u> the goods and/or services.	
V. Signature or official seal of the Office sending the statement:	
VI. Date:	

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ANNEXURE 10

INFORMATION RELATING TO POSSIBLE OPPOSITIONS

Rule 16(1) (a) of the Common Regulations

I. Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA Boudhik Sampada Bhawan S. M. Road, Antop Hill Mumbai—400037, India.
II. Number of the international registration:..... (Reference IRDI No allotted to this international registration by the TMR India).....	
III. Name of the holder (or other information enabling the identity of the international registration to be confirmed):	
IV. <input type="checkbox"/> Dates on which the opposition period begins and ends known: – Date on which the opposition period begins: – Date on which the opposition period ends: <input type="checkbox"/> Opposition period extendable and date on which the opposition period begins known: – Date on which the opposition period begins: <input type="checkbox"/> Dates on which the opposition period begins and ends not known.	
V. Signature or official seal of the Office communicating the information	
VI. Date:	

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ANNEXURE 11

FINAL DISPOSITION ON STATUS OF A MARK

– STATEMENT OF GRANT OF PROTECTION FOLLOWING A PROVISIONAL REFUSAL –

Rule 18ter(2) of the Common Regulations

I. Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA Boudhik Sampada Bhawan S. M. Road, Antop Hill Mumbai—400037, India.
II. Number of the international registration:.....	(Reference IRDI No allotted to this international registration by the TMR India).....
III. Name of the holder	
IV. <input type="checkbox"/> Protection for all the goods and/or services	<i>(This box should be ticked where a notification of provisional refusal has previously been communicated but, eventually, protection is granted to <u>all</u> the goods and/or services.)</i> All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for <u>all</u> the goods and/or <u>all</u> the services requested (Rule 18ter(2)(i))
<input type="checkbox"/> Protection for some only of the goods and/or services	<i>(This box should be ticked where a notification of provisional refusal has previously been communicated and protection is now granted to <u>some</u> only of the goods and/or services – giving an indication of the goods and/or services protected. NOTE: Where all the</i>

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goods or services included in a given class are to be mentioned, the indication should read “all goods (or, all services) in class X”. In all other cases, the goods and/or services should be clearly indicated.)

All procedures before the Office have been completed; protection is granted to the mark that is the subject of this international registration for the following goods and/or services (Rule 18ter(2)(ii)) (please use a continuation sheet if necessary):

V. Signature or official seal of the Office sending the statement:

VI. Date: