

Practitioner's perspective

Get protected internationally

Manisha Singh and Zoya Nafis explain why Indian companies should register their IP in overseas markets

India has proved the notion that the twenty-first century is the century of knowledge, indeed the century of intellect. It has not only translated knowledge into wealth and economic success, but has also provided a framework for the protection and enforcement of intellectual property. India's IP regime is now well established and stable from every perspective, be it legal, judicial or administrative. It is also in total compliance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). In addition to this, India is a signatory to a wide range of international treaties and conventions relating to intellectual property.

The relevance of intellectual property has risen over time and is now known to all. Even the smallest companies take stringent efforts to protect their IP, at least in their domestic market. However, Indian companies must note that intellectual property rights are territorial in nature and operate only within the boundaries of the countries in which such rights have been registered. With the impact of globalization, even the smallest businesses have started to operate globally, and with a global footprint comes the necessity to register IP in overseas markets.

Misconceptions

Some companies and inventors already seek protection for their IP at an international level. However, the majority still fail to put in place adequate international protection. Cost is certainly one of the major reasons why inventors are reluctant to file for overseas IP protection. Many still live with the misconception that obtaining overseas protection is extremely costly. This is especially the case now that Indian IP lawyers no longer work for meagre fees. In fact their rates are often comparable to those of IP lawyers in developed markets. But in spite of this, acquiring protection in international markets is often cheaper than people expect.

Why file overseas?

The registration of IP assets in overseas markets increases the overall valuation of a company and often attracts investors. Unlike registering IP domestically in India, registering intellectual property overseas does not require a great deal of time and documentation. Indeed, the process is relatively streamlined.

Furthermore, in cases where registration in India is not possible, protection may still be obtained by filing for registration overseas.

India recognizes the trans-border reputation of well-known trademarks even without any local registration. However, certain other countries require marks to be registered locally in order to be afforded any protection. In such countries registration is all the more important, since without it one cannot oppose cases of infringement.

Smoothing the path

The fact that India is a signatory to several key international conventions on intellectual property means that Indian companies can enjoy easier routes to obtaining international protection. The Madrid Protocol route can be used to apply for overseas protection for trademarks, while the Patent Cooperation Treaty (PCT) route can be used to protect patents in various countries. The Madrid system allows a trademark applicant to file a single application to protect his or her mark in a number of countries. Similarly, the PCT route provides for a unified procedure for filing patent applications in each of its contracting jurisdictions.

India acceded to the Madrid Protocol in 2013, enabling Indian companies to file a single application in an "office of origin" to obtain trademark registration in 94 countries. India, being one such "office of origin", has the authority to receive international applications, to verify

LexOrbis INTELLECTUAL PROPERTY ATTORNEYS

709/710 Tolstoy House
15-17 Tolstoy Marg
New Delhi – 110 001
India

T: +9111 2371 6565

Email: manisha@lexorbis.com



Manisha Singh



Zoya Nafis

that such applications conform to the provisions of the Madrid Protocol and, if the international applications are found to be in order, to certify and transmit such applications to the international bureau of the World Intellectual Property Organization. The Indian Trade Marks Registry is always notified of international registrations in which India has been designated. It records the particulars of such international registrations and examines them in accordance with the provisions of the Trade Marks Act.

As a contracting party to the PCT, Indian companies can file for overseas patent registration without having to file separate applications in numerous countries.

The final hurdle

While there are numerous benefits to seeking overseas protection, a major stumbling block is the lack of awareness among Indian companies and inventors of the importance of registering in overseas markets.

It is imperative that such awareness is promoted by authorities in India, as well as by the country's legal professionals, in order to ensure that Indian companies and individuals are protected on the world stage.

Manisha Singh is the managing partner of LexOrbis, where Zoya Nafis is an associate.