

**Intellectual Property**  
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**Lecture – 43**  
**International Arrangements**

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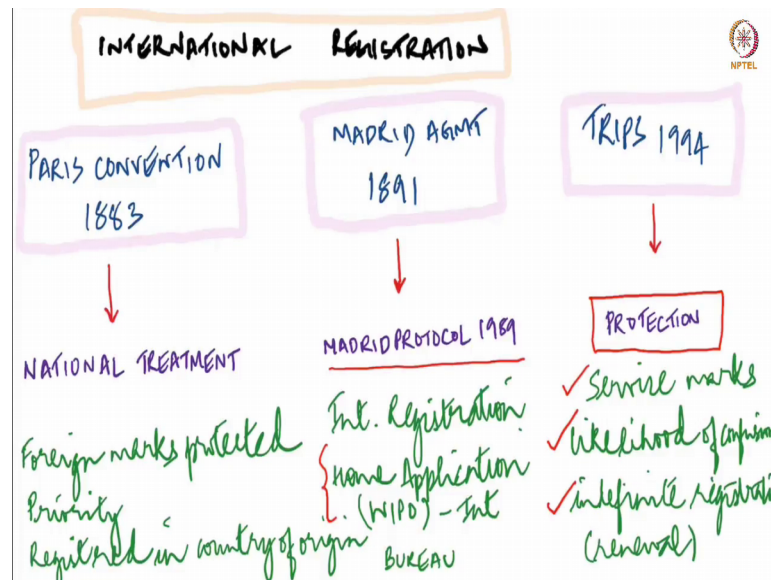


## Introduction

- International Agreements
  - Paris Convention, 1883
  - Madrid Agreement, 1891
  - Madrid Protocol, 1989
  - World Intellectual Property Organization
    - International registration
  - TRIPS Agreement

When we look at the international arrangements on trademarks, we find that most of the arrangements started off with the Paris convention in 1883, that is the point at which there was a need to have an international arrangement on trademarks. Then we have the Madrid agreement, which pertain to registration of trademarks; then the Madrid protocol in 1989. And we had international registration under the WIPO and certain substance to measures under the TRIPS agreement.

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So, international registration itself came about with the Madrid agreement. The Paris convention in 1883 brought out the principle of national treatment, which is something which we had already seen, which said that foreign marks will be protected just in the same manner as national or domestic marks will be protected. It kind of preserve the priority, you could file a foreign mark, it kind of preserve the priority, you could file a mark in the domestic country and then get it registered in a foreign country. So, foreign country registration is where allowed provided a application was made in the country of origin.

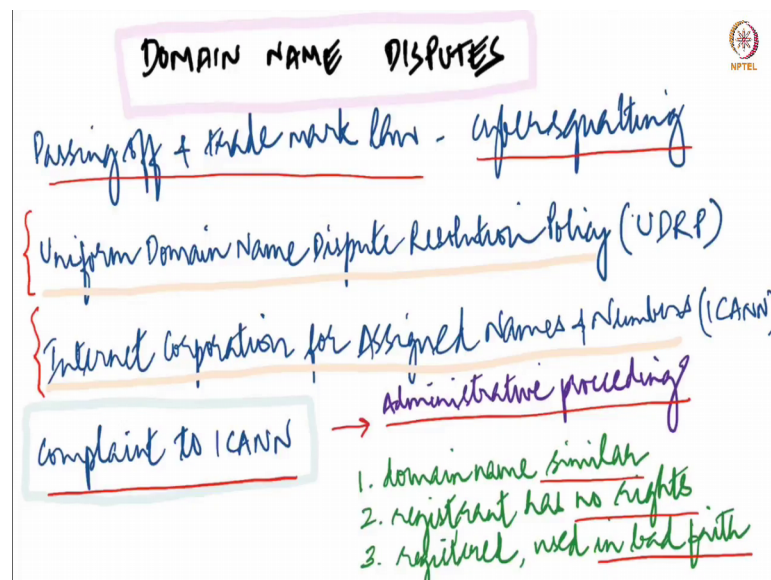
But, apart from this, the Paris convention did not have anything which could enable a international registration for trademarks, that came about in the Madrid agreement in 1891 and that was further enhanced by the Madrid protocol in 1989. This brought a system of international registration, where you could file a home application and later on follow it up with applications in different countries something similar to the arrangement that we had under the pattern cooperation treaty.

Now, the final arrangement pertains to the protection for trademarks under the TRIPS agreement in 1994, which came into effect in 1995. Now, the TRIPS agreement provided for service marks as well. The recent version of the trademarks Act that is in trademarks Act 1999, provide for trademarks for goods and services. And service marks where introduced in 1999 (Refer Time: 03:02) to India's obligation under the trips agreement.

So, it provided for service marks, it characterised likelihood of confusion as reason why other marks should not be allowed, because that could lead to likelihood of confusion. And it also provided for indefinite registration, indefinite registration is unique amongst other inclination property rights to trademarks. Trademarks can be indefinitely renewed. And the period of registration can be renewed these 10 years.

So, every 10 years, trademarks can be renewed indefinitely. Intellectual property rights like patents, copyright and designs are time bound rights, they are also referred to as limited life IP Intellectual Property having limited life. Trademark does not have limited life, it has an unlimited life, but the unlimited life is tied to renewal on a regular basis.

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The international arrangement also provided for a particular type of trademark dispute, this pertains to dispute with regard to domain names. Domain names are URL or web addresses, which could be registered in an entirely different form. So, companies which would register a company name under the say if it is an Indian company, under the Indian companies Act should also register a trademark at the trade mark office. Now, if the company needs a domain name, it has to go to a service provider like go daddy or name cheap dot com and get the domain name registered.

Now, when domain name registration picked up, it was hard for all existing companies to rush and get their domain names registered. In fact, this led to an issue called cybersquatting, where cybersquatters or people who would register a domain name or a

trademark without having any proprietary or ownership rights over it. Now, this was lastly done to book the trademark which belong to another entity and to ask for some kind of a compensation or ransom to give or sell back the domain name.

Now, domain name disputes initially, was settled through passing of and the trademark law. You could file a case against a squatter, who uses the domain name that or to have belong to your business and who is refusing to hand it over to you. So, you could get an order, injunction the person from using the domain name, because the domain name happens to be your trade mark or your trade name as well.

But, the registry for registering domain names, which is the internet cooperation for assign names and numbers, I can has a uniform domain name dispute resolution policy. Now, this policy is interesting, because the terms of the policy say that if any person raises a complaint to the ICANN saying that their domain name has being used unjustly. Then the ICANN policy can have administrative proceedings in which the registrant has to participate and it has a dispute settle and it has a dispute settlement mechanism by which it can settle the dispute. Now, this is been affective in solving thousands of cases pertaining to domain name disputes.

Now, the requirements of this administrative proceeding is that the aggrieved party should show that the domain name similar to their business name or to their trademark. And it has to show that the registrant, who had squatted, who had registered it before the legitimate owner registered the domain name has no rights whatever whatsoever to the domain name and that it has being registered, and it was used in bad faith. So, three things to raise a dispute, you can raise a dispute a domain name dispute to the ICANN. And this is an administrative proceeding, and the disputes are settled, because the terms of the ICANN provide for a dispute settlement mechanism.

So, the complainant who feels that his business name has been from him by an earlier registrant has to show that the domain name is similar to his business name or his existing business mark to he has to show that the registrant has no rights. Without any right, the registrant had registered the domain name and the domain name has now been registered and it has been used in bad faith. This is been very effective proceeding in fact some of the reputed trade names in India for example, the one belonging to TATA was able to use this mechanism to take back a registration that was unjustly taken away.