



Revamping the Trademark Rules- the practical aspects

~ Kunal Tandon and Kanika Jain

The Ministry of Commerce and Industry, Department of Industrial Policy & Promotion (DIPP) has published Draft Trade Marks (Amendment) Rules, 2015¹ inviting objects and suggestions from the general public. Once the Government receives comments from the stake holders, and modifications if any are made, it will published in the Gazette with an effective date. However, in the past, on occasions the amendments to the Trademark Rules have been given retrospective effect and the additional fees collected from the applicants/proprietors.

The Rules are intended to amend the current Trademark Rules, 2002 and have proposed a complete revamping of the same. The main highlights of the proposed amendments are in the following terms:

- Number of forms reduced. The Draft Rules have reduced the total number of forms to 8, for filing various applications. Reduction in the number of forms will simplify the filling process to a great extent. The proposed forms for various actions are as follows:
 - i. TM A- Application for registration of any good/services
 - ii. TM M- Request for any amendment in application, grounds of decision, expedite examination, request for inclusion of a mark as well-known etc
 - iii. TM R- All Renewal related matters
 - iv. TM C- Application for Search Certificate request
 - v. TM O- All opposition matters
 - vi. TM P- Applications to dissolve association, assignment; amendment for description of goods/services, etc
 - vii. TM U- Application for Registered users, etc
 - viii. TM G- Applications related for Trade mark Agent
- Fee for filing application has been increased
- Deficient fee critical: in the event an application at the first instance is filed with any deficient fee or without fee, the same shall be deemed not to have been filed for all purposes.
- Registration under different classes to be specified at the first instance: If registration of trademark is desired under different classes then all intended

¹ http://www.ipindia.nic.in/IPActs Rules/TMR Amendment Rules 2015_19November2015.pdf

classes have to be mentioned at the first instance while filing the application for registration. Earlier while seeking registration under additional class, the date of application was deemed from the date of the first application. However, under the proposed Rules, the subsequent request will be counted from the date of the fresh application.

- Now the Forms required to be submitted have to be the exact replica of the form available on the site. Earlier, only the main contents of the prescribed forms had to be necessarily mentioned in the application.
- No hand written information is permissible now. All filings have to be typed and submitted in the exact replica of the prescribed format.
- IP gate way – all filings not requiring any fee deposit can be made under a separate window
- Address of the applicant has to be correct and no follow up would be done by the Registrar. On change of attorney/agent, service would be done on the (Indian) address provided by the applicant.
- The Classification provided under Scheduled IV to be replaced by ‘the International classification of Goods and Services’ (the NICE classification), published by the WIPO
- Registrar to maintain a list of well known registered/non registered marks. Request can be made for inclusion in such list on payment of fees, subject however to the discretion of the Registrar.
- Regarding application under convention arrangement for claiming priority, it has been proposed that only a single priority shall be claimed in respect of all the goods or services mention in the Application for registration of trademark.
- Number of reproductions to be submitted along with the application has been reduced
- Notice of hearing will be sent by the Registrar in all cases, and will not be optional now.

Comparative analysis between old and new Draft Trademark rules.

A comparative analysis of some relevant rules is as follows:

Old Provision	New Provision	Comment
Rule 11. 3. Fees may be paid by a bank draft issued or a cheque drawn on a scheduled bank	Rule 10. 3. Fees may be paid by a bank draft issued or a <i>banker's cheque</i> drawn on a scheduled bank	In erstwhile Rule 11 (now Rule 10), the mode of payment of fee has been amended, i.e. payment by way of a cheque has been substituted by payment by way of Banker's cheque. Further, the payment by way of any instrument, if sent by post shall be deemed to be paid only if the same is 'received' in the office, whereas earlier the payment was deemed made if the same was 'delivered in

		the ordinary course of post’.
<p>Rule 11</p> <p>5. Includes provisions contained in sub-rule 19 of the rule 25 for payment of fees for filing a document.</p>	<p>Rule 10.</p> <p>5. Provisions contained in sub-rule 19 of the rule 25 no longer applicable.</p>	<p>In erstwhile Rule 11(now Rule 10), sub Rule 5, the exception as to cases falling under sub rule 19 of Rule 25 has been omitted. Sub Rule 19 of Rule 25 provided for amendment of the application by payment of the deficient fee and in such cases date of filing would be the original filing date. In effect, in the event an application at the first instance is filed with any deficient fee or without fee, the same shall be deemed not to have been filed for all purposes.</p>
<p>Rule 12.</p> <p>3. Use of form in the schedules satisfied by the use of either a replica of that form or of a form which is acceptable to the Registrar.</p>	<p>Rule 11.</p> <p>3. Use of form in the schedules satisfied by the use of a replica of that form only.</p>	<p>In erstwhile Rule 12 (now Rule 11), it is now mandated that the Form of application should only be a replica of the form provided for in the Schedule. Earlier, either such replica could be used or any form which is acceptable to the Registrar and contained all information as required under the prescribed Form.</p>
<p>Rule 13.</p> <p>1. All applications, statements, notices, or other documents shall be neatly handwritten or typewritten or lithographed or printed in Hindi or in English of size of approximately 33 centimetres by 20 centimetres.</p>	<p>Rule 12.</p> <p>1. All applications, statements, notices, or other documents shall be typewritten or computer printout in Hindi or in English in legible characters.</p>	<p>Under erstwhile Rule 13 (now Rule 12), the documents to be filed could either be handwritten or typewritten or lithographed or printed, whereas under the amended rule, the documents can only be typewritten or computer printout. The prescribed size 33cm x 20 cm for submission of documents has been omitted.</p>
<p>Rule 15.</p> <p>6. The registrar may after informing the public in the journal accept communications of a routine nature through E-mail.</p>	<p>Rule 14.</p> <p>6. The registrar may after informing the public in the journal accept notices, applications or statements online through the gateway provided for this purpose through designated e-mail for the purpose.</p>	<p>Provision for service of documents through fax has been omitted. Additionally, service through the prescribed gateway/portal for the purpose has been provided and also through email, where documents are to be submitted without any fee.</p>
<p>Rule 20.</p> <p>Non availability of</p>	<p>Rule 19.</p> <p>1. All</p>	<p>Rule 20 providing for ‘Non availability of address for service’ has been omitted and a</p>

<p>an address for service.</p>	<p>communications and documents may be served by the registrar by leaving them, at or sending them by post to the address of the party concerned or by e-mail communication.</p> <p>3. To prove such service it shall be sufficient that the letter was properly addressed and was sent to the e-mail ID provided by the party concerned.</p>	<p>new Rule 19 has been inserted providing for 'Service of documents by the Registrar'. In effect, the aforesaid changes oblige the applicant to provide the correct address for service and also to ensure that the same is duly updated in case of any change.</p>
	<p>Rule 20</p> <p>4. In case of withdrawal by the agent the applicant or opponent shall within a period of two months from the date of such withdrawal provide an address for service in India. If he fails to provide address within such period he shall be deemed to have abandoned the application or opposition.</p>	<p>It has been provided in the proposed Rules that in case of withdrawal by the agent or revocation of an agent, and in the event no principal place of business in India has been provided for, the applicant must within 2 months of the withdrawal or revocation, provide an address for service. Any failure to do so shall be treated as abandonment of the Application.</p>
	<p>Rule 21</p> <p>1. Classification of goods and services for the purpose of registration of trademark, the goods and services shall be classified as per current edition of "The international classification of goods and services (NICE Classification)" published by the World Intellectual Property</p>	<p>The classification of Goods and Services which was earlier provided under the Fourth Schedule of the Act has been replaced with classification as per the current edition of 'the International classification of Goods and Services' (the NICE classification), published by the WIPO. It has been further provided that the Registrar shall publish a class wise and an alphabetical index of such goods and services, including goods and services of Indian Origin.</p>

	Organization (WIPO)	
<p>Rule 23.</p> <p>Preliminary advice by Registrar as to distinctiveness</p>	<p>Rule 22</p> <p>An application for preliminary advice by the registrar under sub-section (1) of section 133 shall be made in the form TM-M along with the fees specified and accompanied by one representation of the trade mark.</p>	<p>Regarding preliminary advice by Registrar as to distinctiveness, the application may now be made in the prescribed form for goods and services comprised in class as published by the Registrar under Rule 21(2), along with fee prescribed in entry number 45 in First Schedule and accompanied by one representation of the trade mark. Under the earlier Rules, three representations of the trade mark were required.</p>
	<p>Proviso to Rule 24</p> <p>While making an application for registration of trade marks, the names of goods and services stated in the application shall as far as may be correspond to those given in the classification of goods and services published by the registrar under sub-rule (2) of rule 21.</p>	<p>A proviso has been inserted in proposed Rule 24 (corresponding to existing Rule 25), to the effect that while making the application, the names of the goods or services shall as far as may be correspond to those given in the classification of goods published by the Registrar under proposed Rule 21(2).</p>
<p>Rule 25</p> <p>19. Where an applicant files a single application for more classes than one, the applicant may restrict the specification of goods or services to the class applied for or amend the application to add additional class or classes on payment of the appropriate class fee and the divisional fee.</p>	<p>Rule 24.</p> <p>Form and signing of applications</p>	<p>Existing Rule 25(19) has been amended and provision as to amendment of an Application to add additional class or classes has been omitted. In effect, an applicant must specify with due caution all the classes in which registration is sought as no occasion shall be provided to make such amendments.</p>
<p>Rule 26.</p>	<p>Rule 25.</p>	<p>Regarding application under convention arrangement for claiming priority, it has</p>

<p>Where the applicant files more priority claims than one under section 154 for some or all the goods and services in respect of the same trademark, the registrar shall also take the date of the earlier application in a convention country, as the priority date.</p>	<p>A single priority shall only be claimed in respect of all the goods or services mentioned in the application for registration of a trademark filed under sub-rule (1) of Rule 24</p>	<p>been proposed that only a single priority shall be claimed in respect of all the goods or services mention in the Application for registration of trademark.</p>
<p>Rule 27. An application to register a trademark shall contain a statement of the period during which, and the person by whom it has been used.</p>	<p>Rule 26. In case the use of trademark is claimed prior to the date of application the applicant shall file an affidavit testifying to such use along with supporting documents.</p>	<p>The existing Rule 27 regarding statement of user has been amended and it has been made obligatory on an Applicant to file an Affidavit testifying the user, in case the user is stated to be of a date prior to the Application.</p>
<p>Rule 29 2. The application shall be accompanied with one reproduction of the mark in black and white and four reproduction of the mark in colour where applicant claims combination of colours.</p>	<p>Rule 28 The application shall be accompanied with one reproduction of the mark in that combination of colours, where the applicant claims combination of colours.</p>	<p>In cases of applications claiming combination of colour as distinctive feature of the mark, the application shall be accompanies with reproduction of that mark in the combination of colours. In the existing regime, one reproduction of the mark in black and white and four representations of the mark in colour are required.</p>
<p>Rule 37. The acknowledgement of application shall be by way of return of one of the additional representations of the trademark filed by the applicant along with his application, with the official number of the application duly entered thereon.</p>	<p>Rule 33. The acknowledgement of application shall be by way of return of duplicate of the application filed by the complainant with the official number of the application duly entered thereon.</p>	<p>The acknowledgement of an Application by Registrar is proposed to be made on a duplicate copy of the Application, as against the acknowledgement on one additional representation under the present regime.</p>

<p>Rule 56.</p> <p>Within fourteen days from the receipt of the first notice, any party who intends to appear shall notify the registrar in form TM-7.</p>	<p>Rule 51.</p> <p>Upon completion of the evidence if any the registrar shall give notice to the parties of the first date of hearing. Such notice shall be ordinarily given within three months of completion of the evidence. The date of hearing be for a date atleast one month after the date of the first notice.</p>	<p>In the section 51 of the new rules the text of the earlier section which dealt with hearing and decision wherein 'within fourteen days from the receipt of the first notice, any party who intends to appear shall notify the registrar in form T-7 and any party who does not so notify the registrar within the time as aforesaid may be treated as not desiring to be heard and the registrar may accordingly act in the matter' has been omitted.</p>
<p>Rule 62.</p> <p>1. The certificate of registration of a trademark to be issued by the registrar under sub-section (2) of section 23 shall be in form Q-2.</p>	<p>Rule 57.</p> <p>1. The certificate of registration of a trademark to be issued by the registrar under sub-section (2) of section 23 shall be in form O-2 and shall include the trademark. It shall include the seal of the trademarks registry.</p>	<p>In the section mentioning certificate of registration seal of the trademarks registry has been made mandatory to be on the certificate of registration issued by the registrar as well as the provision regarding an unmounted representation of the mark exactly as shown in the form of application for registration has been omitted.</p>
<p>Rule 71.</p> <p>The registrar may call upon any person who applies to be registered as proprietary of a registered trademark to furnish such proof or additional proof of title as may require for his satisfaction.</p>	<p>Rule 78.</p> <p>Proviso</p> <p>Provided that the registrar may call upon such proof only where there is reasonable doubt about the veracity of any statement or any document furnished.</p>	<p>A proviso has been added in the rule regarding the proof of title wherein it has been stated that the registrar may call for such proof only where there is a reasonable doubt regarding the veracity of any statement or any document furnished.</p>

Tandon & Co.
Advocates and Solicitors

X-3, Green Park Main,
New Delhi – 110016, India

Telephones : - +91-11-26520041-42
E Mail : - info@tandonandco.com
Website : www.tandonandcompany.com