

Introduction

Intellectual property law constitutes the regulatory framework for protection and enforcement of Intellectual Property Rights ("IPR") like trademarks, patents, know-how, etc. The maturity of this framework is a crucial factor in stimulating creativity, incentivizing and encouraging research, protecting rights and settling IPR related disputes. Also, more the IPR law of the country is aligned with the global IPR regime, the better the flow of foreign investment will be. The law governing trademarks in India has developed at a rapid pace in the past few decades.

With an aim to simplify and transform trademark rules and to sync with the current techno-friendly world, Government has notified the "Trade Mark Rules, 2017" ("Rules") on 6th March 2017 after much deliberation. The Rules bring prominent amendments to the procedures prescribed under the erstwhile "Trade Mark Rules, 2002", is Startup friendly and in line with the "Digital India" vision. Trade Marks Rules, 2017 consist of 158 rules which are divided into 6 Parts and 4 Schedules. The Major highlights of the New Rules are elucidated below:

Applicant Categories

Applicants have broadly been classified into "Individual/Startup/Small Enterprise" and "Others", the prominent difference being in respect to trademark filing fee which has been kept at INR 4,500 per mark per class for the former category and INR 9,000 for the latter category of applicants.

Address for Service

According to Rule 17, every applicant/opponent/any person concerned in any proceeding under the Trade Mark Act, 1999 or Rules shall furnish a valid email id in addition to postal address. This is aimed at digitalizing the prosecution and communication process. The trade mark agents are also required to furnish a mobile number registered in India.

Preliminary advice by Registrar as to distinctiveness

This is pursuant to Section 133 of the Trade Marks Act, 1999 which provides for filing of application to get preliminary advice from the Registrar with respect to distinctiveness of trademark. Rule 21 of the New Rules provide that such an application shall be made in Form TM-M along with fee of INR 1,800 and one representation of the trademark.

Forms

There has been a drastic cut down in the number of trademark forms to enable easier compliance. Forms have been cut down from around 74 to only 8. Schedule 1 to the Rules contains nature of service and corresponding form along with applicable fees. In order to boost E-filing, fees of online applications have been kept 10% lower than that of paper applications. Application under Rule 12, "request for expedited search", Rule 34 for "expedited process of an application for the registration of trademark" and Rule 124, "request to include trademark in list of well-known trademark" are necessarily to be done through E-filing only.

Trademark Filing

Currently, there is a single form, Form TM-A, for filing all new trademark applications. Also the New Rules enable filing of sound trademark, for which, the applicant has to submit sound clipping in MP3 format along with representation of specific musical notes. Apart from this, application can be filed in respect of word mark, 3D mark and device mark.

Expedited processing of Application

According to Rule 34, the applicant may request for expedited processing of application made for the registration of trademark in Form TM-M on payment of INR 40,000 (INR 20,000 for individual/startup/small enterprise), after which, the entire processing will be expedited unlike old regime which only provided for expedited examination of application. Time limit of 3 months, from the date of submission of application, has been provided under the New Rules for examination. Additionally, the entire procedure, including examination, reviewing of reply to examination report, appointment of hearings, publication of the application and opposition thereto till final disposal of application shall also be dealt with expeditiously subject to such guidelines as may be published in this regard by the Registrar.

Notice of Opposition

According to Rule 42, a notice of opposition to the registration of a trade mark shall be filed in Form TM-O within 4 months from the date of publication of the trademark journal in which the application for registration was advertised along with fee of INR 2,700.

Renewal of registration

According to Rule 57, an application for renewal of the registration of a trademark shall be made in Form TM-R at any time not more than 1 year before the expiration of the last registration of trademark. Previously, renewal application could be filed anytime not more than 6 months before the expiration of the last registration of the trade mark.

Hearings

Rule 115 enables hearings to be conducted through video conferencing or any other audio-visual communication devices thereby upholding the idea of Digital India.

Adjournment

According to Rule 50, a party to proceeding may make a request for adjournment of hearing with reasonable cause in Form TM-M at least 3 days before the date of hearing to the Registrar. The Rule also restricts the adjournments to 2 only, lasting not more than 30 days each.

Statement of User in application

According to Rule 25, if an application is filed to register a trademark, claiming use of trademark prior to the date of application, then the applicant shall file an affidavit testifying to such use along with supporting documents. Under the 2002 Rules, requirement to submit affidavit was at the discretion of the Registrar.

Determination of Well Known Trademark by Registrar

Well Known Trademarks are designated as such by competent authorities like Intellectual Property Appellate Board, High courts and other Lower Courts as a result of trade mark infringement disputes. Presently there are 81 trademarks in this category. Rule 124 provides that any person may apply in Form TM-M requesting the Registrar for determination of a trademark as well-known. Such application shall be accompanied by supporting evidence and documents. The fee is INR 1,00,000 for one mark and is the highest fee envisaged under the New Rules.

Conclusion

Our laws should evolve with changing times and suit the needs of society in its present context. The new set of Trademark Rules, is a welcome step and will go a long way in simplifying and streamlining the trademark procedures in India. However, benefits come at a substantial cost. A comparison of Schedule 1 of 2002 and the New Rules reveals that fee for each type of application has been increased significantly, in certain cases even by 400%. However, concessions have also been provided to small enterprises and startups which will prove beneficial in the long run. The real impact of the 2017 Rules will soon be evident.

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