

India's new trademark registry rules raise filing fees more than expected

08
MAR 17

Further to [our report](#) earlier this week, India's Department of Industrial Policy and Promotion (DIPP) has ratified new trademark registry rules and published final fees – some of which are higher than most industry observers had anticipated.

A note from Gurgaon-based law firm Chadha & Chadha confirms that under the newly implemented rules, the official fee for filing a trademark application in one class – originally expected to double from 4,000 rupees (approximately US\$60) to 8,000 rupees – has in fact risen 125% to 9,000 rupees (\$135).

On the other hand, the revised rate of renewal fees is slightly less than the 100% increase projected, at 9,000 rupees from the earlier 5,000 (\$75). The cost of expedited examination has doubled from 20,000 (\$300) to 40,000 (\$600) rupees. All of these figures are for online filings; traditional paper filings will command a 10% surcharge.

As expected, Indian brand owners falling into certain categories will get a discount of as much as 50% on trademark application fees. Included are individual applicants, businesses recognised as start-ups under the government's Startup India programme and 'small enterprises' as defined under the country's Micro, Small and Medium Enterprises Development Act 2006.

The change introduced by the new rules that could prove to be the most popular with global brand owners is the improved recognition for 'well-known' marks. Rights holders can now apply for their trademark to be declared as such by the Indian registry, at a cost of 100,000 rupees (\$1,500).

As reported by the *Times of India*, this contrasts with the previous situation where a trademark's 'well-known' status could effectively only be confirmed if a court held so in the context of an infringement dispute. This was the case for such brands as Amul, Daimler-Benz, Rolex and Whirlpool in the Indian market. "The rules will be a boon to foreign companies that do not have a registered trademark in India but at the same time wish to protect themselves," Gowree Gokhale, partner at Nishith Desai Associates in Mumbai, told the *Times*. "This should also reduce the cost of opposition as, typically, the registrar will cite the registered well-known trademarks as conflicting marks to subsequent applications."

Dev Robinson, partner at Shardul Amarchand Mangaldas & Co in New Delhi, [told](#) Livemint: "At an elementary level, it makes a lot of difference because now you'll have to recognise trans-border reputation and well-known marks in other jurisdictions." Shamnad Basheer, founder of the SpicyIP blog, offered a more restrained view, telling the news site: "We have to be really cautious about what trademarks we declare as 'well-known' ones, given that it confers huge legal power on these marks. Owners of such marks can stop



Jack Ellis

even those goods and services that are far removed from their ordinary line of business. Courts have been quite circumspect about declaring marks to be well known and have done it through a hard fought adversarial process. One hopes that the government would be equally cautious.”

Overall however, it would appear that the inclusion of a well-known marks ‘list’ will be seen as a positive move by the international brand-owner community. Among other measures implemented by the new trademark rules are:

- A requirement to submit a sound recording in MP3 format, of a maximum 30 seconds in length, alongside a graphical representation of the sound and musical notation, as part of filing an application for a sound trademark.
- A requirement that trademark applications not filed on an ‘intent to use’ basis include a ‘statement of use’ with respect to all potential goods and services mentioned in the application, as well as an affidavit testifying to use of the mark.
- Speedier opposition proceedings – applicants will be able to file a response to a notice of opposition as soon as it appears online, rather than having to wait for it to be officially served. Both parties will also have to send exhibits to each other at the same time as submitting them to the registry, rather than waiting for a written request from the opposite party. Deadlines for the filing of evidence by both parties will no longer be extendable; while parties will no longer be able to request than two adjournments.