

IP Hotline

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TRADEMARK RULES REFORMED: FILING APPLICATIONS IN INDIA

With a view to bring about radical changes in the trademark registration process, the Government of India has introduced completely new Trade Marks Rules 2017 ("**Trade Marks Rules**") to replace The Trade Marks Rules, 2002 ("**Old Rules**"). We have discussed the essential requirements to file for a trademark as per the Trade Marks Rules in this note.

KEY CHANGES TO THE TRADEMARK FILING PROCESS IN INDIA:-

- New Forms:** The forms for filing and other related matters have been consolidated from 74 forms under Old Rules to only 8 forms. However, the information to be provided in the new forms is similar to the information required under the Old Rules.
- Usage Affidavit format and content:** In case of a prior user based trademark application, an affidavit is **mandatorily required to be filed** at the time of filing the trademark application. This affidavit is to be filed to support usage of the mark in India.¹ This is a new requirement. The Trade Marks Rules does not prescribe the format of the affidavit or the nature of the supporting documents to be provided. However, based on our discussion with Trade Marks Registry ("**Registry**"), we understand that documents such as sales invoices, purchase orders, or statement of accounts, which justify the use of the mark for relevant goods or services for each year of usage in India, can be filed. While this is an ideal list, we understand that some of the foreign companies may not have all these documents easily available. In such a case, any other evidence to show usage in India, such as press coverage, photos at trade fairs, awards and accolades etc. in India, may also be filed. It will however be the decision of the Registry to accept the information provided or not. In our view, this is a progressive change as collecting usage information at the time of filing the trademark application will help the Registry official to verify the user claim at the time of examination of the mark itself. This should therefore help in expediting the trademark registration/prosecution as well as refuse false claim of user.
- Well known marks:** The Trade Marks Rules provide applicants with the opportunity to apply for recognition of their marks as "Well-Known Trademarks"² in India. To apply, an applicant is required to file form TM – M and pay a fees of INR 1, 00,000 (approx. USD 1543) for each trademark.³ The applicant is also mandatorily required to submit evidence/documents supporting the claim that the applied mark is a well-known one. The Trade Marks Rules do not specify the kind of documents that are required to be filed in support of such an application. However, in our view, documents such as press releases talking about the global nature of the mark, global recognition of the mark, net worth of the brand, recognition of the mark as well-known mark in any other jurisdiction, etc may be filed as supporting documents.

Prior to the notification of the Trade Marks Rules, such recognition was provided via a court order/judgment, whereas now such recognition is proposed to be provided by registration of mark as a well-known mark. This is a positive change and beneficial to multinational companies who aim at protecting their brand on a global level. Registration of a mark as a well-known mark is also likely to help them while taking actions in potential opposition, infringement, brand dilution or disparagement cases.
- New Fee Structure:** The Trade Marks Rules provide for a new fee structure for filing trademark applications. The fees differ depending on the nature of the applicant. To encourage online filing, the online filing fees are lower. The new fee structure is as provided below,

| Nature of Applicant | Physical Filing Fee, per mark per class | Online Filing Fee, per mark per class |
|-------------------------------------|---|---------------------------------------|
| Individual/Startup/Small Enterprise | INR 5,000/- (approximately USD 77) | INR 4,500/- (approximately USD 69) |
| Other than provided above | INR 10,000/- (approximately USD 155) | INR 9,000/- (approximately USD 138) |

- Expedited application:** Under the Old Rules, an applicant was only provided with the opportunity apply to request for expedited examination of a trademark application. However, the Registry was given the discretion to decide

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as to whether the examination of an application warrants expedition. Under the New Rules, an applicant is provided with the opportunity to request for expedited processing of trademark application. This can be achieved by filing form TM – M and paying a fees of INR 30,000 (approximately USD 463) for each class in which the trademark application is being filed.⁴ Such an application shall be examined expeditiously and ordinarily within three months from the date of submission of the application. Thereafter, the following proceedings viz. the consideration of response to the examination report, scheduling of show cause hearing, if required, the publication of the application and the opposition thereto, if any, till final disposal of the application shall also be dealt with expeditiously subject to such guidelines as may be published by the Registry. Furthermore, the discretion provided to the Registry to decide whether an application for examination of an application should be expedited under the Old Rules has been removed by the Trade Marks Rules. This should ensure that the entire trademark prosecution procedure is expedited. This application can be filed immediately after the filing of the trademark application. While this fast track process has been introduced, the Trade Marks Rules do not prescribe a fixed or minimum time period within which the examination and registration process will be completed. In our experience, we have noticed that since online filings have begun, the time period for the aforementioned process has significantly reduced (less than a year). If there is not too much time difference between getting registration by filing an expedited application and normal filing, the applicant may not necessarily incur additional costs.

CONCLUSION:

The notification of the Trade Marks Rules is an important step taken towards streamlining, digitizing and simplifying the process of trademark registration in India. The new measures, especially digital filings, will expedite the registration process as filings can be made from anywhere, anytime. The online filing processes are also likely to bring more transparency and give comfort to the applicants, who can track applications real-time.

– Abhishek Senthilnathan, Gowree Gokhale & Aarushi Jain
You can direct your queries or comments to the authors

¹ Rule 25(2) of the Trade Marks Rules, 2017
² A “well- known trade mark” in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.
³ Rule 124 of the Trade Marks Rules, 2017
⁴ Rule 34 of the Trade Marks Rules, 2017

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