



SUBSTANTIVE COMMENTS
Chapter I

S. No.	Rule	Comments
1.	<p>Rule 2(r) - Definitions</p> <p>"publish" means publish in the Trade Marks Journal or <u>to make available on the official web site of Controller General of Patents, Designs and Trademarks</u></p>	<p>“Publishing” on website appears to be a vague term as it may be difficult to locate where exactly the content is published on the website. This is especially problematic since the website has several linked webpages. As a result, important notifications may be missed, especially by the general public.</p> <p>It is suggested that the Trade Marks Registry should publish all notices only on a specific dedicated webpage, a link whereof should be published in the Journal before these Rules come into effect.</p>
2.	<p>Rules 10 (3), (4), (5) and (6) - Fees</p> <p>(3) Fees may be paid in cash or sent by <u>money order addressed to the Registrar or by a bank draft issued or by a Banker's cheque drawn on a scheduled bank at the place where the appropriate office of the Trade Marks Registry is situated</u> and if sent through post, shall be deemed to have been paid at the time when the money order or the properly addressed bank draft or Banker's cheque is <u>received in the office</u>.</p> <p>(4) <u>Bank drafts and Banker's Cheque</u> shall be crossed and made payable to the Registrar at the appropriate office of the Trade Marks Registry and they shall be drawn on a scheduled bank at the place where the appropriate office of the Trade Marks Registry is situated.</p>	<ul style="list-style-type: none"> • Cheques not permitted - Issuance of bank draft and Banker’s cheque takes time and this creates issues during deadlines. It is, therefore, suggested that cheques payable at par be permitted. • “Received in office”- The Rule has been changed from ‘put in post’ to ‘received in office’. As per the present trend, online payments get reflected after two days and the receipts and application numbers get issued thereafter, whereas the physical filing application numbers are issued immediately. This restricts the deadline and the physical filing application numbers get priority over electronic filing. It is suggested that ‘Received in office’ should be amended to read as ‘put in post and courier’. Also, electronic filing payment should immediately reflect the payment and a receipt with application numbers should be generated immediately. • Insufficient fee implication in electronic filing- The present electronic system is not adapted to accept fees on ‘per mark per class’ basis fees for multi-class applications, which may be construed as payment of insufficient fees. As a result, such online applications may be deemed to have not been filed. It is, therefore, suggested that the electronic filing system be updated appropriately before implementation of the new Rules. • From sub-rule 6, it appears that the electronic filing will not be made available immediately upon



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	<p>(5) Where a fee is payable in respect of filing of a document and where the document is filed without fee or with insufficient fee, such document shall be <u>deemed not to have been filed for the purposes of any proceedings under these rules.</u></p> <p>(6) The Registrar <u>may</u>, after informing the public in the Journal or through public notice on official website, <u>make available electronic fee transfer facilities, subject to guidelines and instructions as may be specified on that behalf.</u></p>	<p>implementation of Rules. If that is true, applicants may end up paying additional fees through physical filing if electronic filing is not completely implemented. It is, therefore, suggested that electronic filing be implemented for all forms from the date the new Rules come into effect and sub-rule 6 be deleted.</p>
<p>3.</p>	<p>Rule 11(4) - Forms</p> <p>The Registrar may after informing the public in the Journal or through public notice on official website specify such Forms as are required to be submitted in electronic mode.</p> <p>Thereafter, such Forms shall be completed in such manner as may be specified so as to permit an automated input of the content into a computer by character recognition or scanning.</p>	<p>From sub-rule 4, it appears that the electronic filing will not be made available immediately upon implementation of rules. So, applicants may end up paying additional fees through physical filing if electronic filing is not completely implemented. It is, therefore, suggested that electronic filing be implemented for all forms from the date the new Rules come into effect and sub-rule 4 be deleted.</p>
<p>4.</p>	<p>Rules 13 (2) and (3) - Signing of documents</p>	<p>The definition of ‘Signing’, as set out in sub-rule 3, is not included anywhere else. Further, mentioning the names of the signatory in capital letters may not be possible in case of digital signatures. Accordingly, this requirement should be deleted.</p>

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	<p>(2) Signatures to any documents shall be accompanied by the name of the signatory in Hindi or in capitals letters if signed in English.</p> <p>(3) In case of online filing of the document, the expression 'Signing' includes digital signature.</p>	
<p>5.</p>	<p>Rule 14 - Service of documents—</p> <p>(1) All applications, notices, statements, papers having representations affixed thereto, or other documents authorised or required by the Act or the rules to be made, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar or any other person may be delivered by hand or sent through the post by a prepaid letter or may be submitted electronically in the manner specified by the Registrar.</p> <p>(2) An application or any document so sent shall be deemed to have been made, served, left or sent at the time when the letter containing the same would be delivered in the ordinary course of post,</p> <p>(3) In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.</p> <p>(4) After the filing of an application</p>	<p>This should include courier facility as well.</p>

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	<p>in the Trade Marks Registry, any person while making any correspondence relating thereto shall furnish the following particulars, namely:—</p> <p>(a) the application number or numbers, if any;</p> <p>(b) the date and place of filing;</p> <p>(c) the appropriate class or classes, as the case may be, in relation to which the application is filed;</p> <p>(d) an address for communication; and</p> <p>(e) the concerned agent's code, if any, and the concerned Proprietor's code, if allotted.</p>	
<p>6.</p>	<p>Rule 19 - Service of Documents by the Registrar</p> <p>(1) All communications and documents in relation to application or opposition matter or registered trademark may be served by the Registrar by leaving them at, or sending them by post to the address of the party concerned or by <u>e-mail communication</u>.</p> <p>(2) Any communication or document so sent shall be deemed to have been served, at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the <u>e-mail</u>.</p>	<p>Email communications are likely to create issues whilst ensuring delivery to the applicants/agents. A proper system needs to be worked out for such email communications. One possible solution is for the Trade Marks Office to publish the email address from which such emails will be sent so that recipients can include the same in the white list.</p>

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	(3) To prove such service, it shall be sufficient to prove that the letter was properly addressed and put into the post or the e-mail communication was sent to the <u>e-mail-id provided by the party concerned.</u>	
7.	<p>Rule 20 - Agency</p> <p>(1) The authorisation of an agent for the purpose of section 145 shall be executed in Form TM-M.</p>	The prescribed form is confusing as it is not clear whether a separate form (on the lines of Form TM-48) is required. Further, the option of having a general power of attorney is deleted. Accordingly, it is suggested that the earlier language ('or such other written document') be re-inserted.

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Chapter II

S. No.	Rule	Comments
1.	Rule 24 (6) - Where an applicant files a single application for more classes than one and the Registrar determines that the goods or services applied for falls in class or classes in addition to those applied for, the applicant shall restrict the specification of goods or services to the class or classes already applied for.	<p>The proposed Rule is restrictive in nature. The previous Rule 25 (19) stated that in such a case, <i>the applicant may restrict the specification of goods or services to the class or classes already applied for or amend the application to add additional class or classes on payment of appropriate class fee and the divisional fee.</i></p> <p>It is recommended that the aforesaid wordings should be retained in the new Rules so that addition of class and transfer of goods/services from one class to another is allowed.</p>
2.	Rule 25 - Application under convention arrangement	Clause (3) proviso should also include... “where the applicant files more priority claims than one under Section 154 for some or all the goods or services”
3.	<p>Rule 26 - Statement of user in applications</p> <p>(1) An application to register a trade mark shall, unless the trade mark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of all the goods or services mentioned in the application.</p> <p>(2) In case, the use of the trade mark 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 requirement for mandatory submission of a user-affidavit at the time of filing of the application is onerous and we do not support this requirement in the Rules. Additionally, inclusion of such a requisition creates a disparity between the national applications and the applications filed through Madrid Route where there is no provision to even specify the user date. The said disparity is detrimental to national filings by the applicants.</p> <p>It may instead be contemplated that a Declaration of Intention to Use or Actual use of the mark be submitted.</p> <p>Further, the following should also be taken into consideration:</p> <ol style="list-style-type: none"> a. There is ambiguity in terms of how statement of use should be made for some goods for which user is claimed and for some that are on intent to be used basis. We suggest rewording of this Rule. b. Use of the word “may” instead of “shall” c. Clarification as to when such affidavit is to be filed. Is it at the stage of filing the application or at the examination stage? d. The Rules should provide more clarity on the issue of split user. Currently, it is not possible to file an application with multiple user electronically. <p>With respect to column 8 of Form A ‘<i>statement as to use of the mark</i>’, it is mentioned that the <i>statement as to use of the mark once made, shall be final</i>. Thus, the rules propose to convey that amending user information will not be allowed. This is contrary to the existing rules on amendment and recent decision of the Delhi High Court.</p>
4.	Rule 27 - Representation of mark	Only Clause 3 (ii) has a time frame of 2 months. This should be the same for all sub clauses under this Rule to

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		expedite the processing of application. With the substantial increase in fees, the stakeholders would be expecting efficient and timely service from the Trade Marks Registry.
5.	<p>Rule 34 (1) - Examination, Objection to acceptance, hearing</p> <p>The Registrar shall cause the application to be examined as per provisions of the Act, wherein a search shall also be conducted amongst the earlier trademarks, registered or applied for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any mark identical with or deceptively similar to the trademark applied for. The Registrar may cause the re-examination of the application including re-search of earlier marks at any time before the acceptance or the application but shall not be bound to do so.</p>	<p>Well-known marks and INN's should also be looked into at the time of examination irrespective of goods and services. Thus, we suggest the following addition of words-</p> <p>“...a search shall also be conducted amongst the earlier trademarks, registered or applied for registration, <u>well known marks as well as declared non-proprietary names (INN's)</u>”</p>
6.	<p>Rule 34 (5) - In case the response to the examination report is received within the aforesaid time, the same <u>shall be duly considered</u> and if the Registrar accepts the application for registration, he shall communicate such acceptance to the applicant and cause the application to be advertised as accepted under sub-section (1) of section 20.</p>	<p>In order to have time-lines to be adhered to, we would suggest amending “<u>shall be duly considered</u>” to read as “shall be considered within 6 months”.</p>
7.	<p>Rule 35 - Expedited Processing of Application-</p> <p>The applicant may, after the receipt of the official number of the application, request for expedited processing of application made for the registration of a trade mark in Form TM - M on payment of five times of the application fee specified in First Schedule. Such</p>	<ul style="list-style-type: none"> • Time-lines must be fixed for activities post-examination. Thus, we suggest adding the following - “the consideration of response to the examination report, scheduling of show cause hearing, if required, the publication of the application <u>shall be completed within 6 months</u>” • Modalities with time lines for expedited processing should be defined under this Rule. • Entry No. 64 in First Schedule: The fee for expedited examination has been mentioned as INR 20000 for electronic request and the same should be INR 40000.

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	<p>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. Modalities for expedited processing of trademark application shall be determined by the Registrar.</p>	
8.	Rule 40 - Manner of advertisement	A time frame should be incorporated for advertisement of the application.
9.	<p>Rule 43 - Notice of opposition (1) A notice of opposition to the registration of a trade mark under subsection (1) of section 21, with such particulars as specified in rule 44, shall be given in duplicate in form TM-0 within four months from the date of publication of the Trade Mark Journal in which the application for registration of the trade mark was advertised or re-advertised. (5) A copy of notice of opposition shall be ordinarily served by the Registrar to the applicants within three months of the receipt of the same by the appropriate office: Provided that where the applicant has already filed the counter statement on the basis of the copy of notice of opposition available on the official web site, the requirement of service of copy of the notice of opposition to the applicant shall</p>	<p>We suggest the following:</p> <ol style="list-style-type: none"> a. The system for service of opposition and counterstatement via email should be automated. b. The Trade Marks Office should link the fee module with the opposition deadline calculator so that fee receipt is generated only if the opposition is filed within the 4 months period. Further, it should be made mandatory for all applicants to provide email addresses so that the system serves the notice of opposition automatically to the applicant and updates the online platform for service. Essentially the online platform should be made to scrutinize the opposition deadline and serve the notice of opposition automatically. c. For counterstatement, again, the fee module should be linked to the deadline calculator so that no fee receipt is generated if the counterstatement is beyond the 2 months' deadline. In case the counterstatement is not filed or filed beyond statutory period, an email order abandoning the application should go out automatically and the system updated. d. There is ambiguity on 4 months in Rule 43 as the online calculator has 120 days set up. Thus, it is better to substitute 4 months with 120 days or harmonize it by taking 4 months. e. The following wording should be added- "from the date when the Trade Mark Journal is made available to public on the website"

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	<p>be dispensed with. 45. Counterstatement (1) The counterstatement required by sub-section (2) of section 21 shall be sent in triplicate on Form TM-O within two months from the receipt by the applicant of the copy of the notice of opposition from the Registrar and shall set out what facts, if any, alleged in the notice of opposition, are admitted by the applicant. A copy of the counterstatement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same.</p>	
10.	Rule 45 - Counter Statement	Opposition is to be provided in duplicate whereas Counter Statement is to be provided in triplicate. This should be made consistent.
11.	Rule 49 - Further Evidence	Provisions for procedure and time-line for Interlocutory Petition should be included.
12.	<p>Rule 47 - Evidence in support of application (1) Within two months or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, on the receipt by the applicant of the copies of affidavits in support of opposition or of the intimation that the opponent does not desire to adduce any evidence in support of his opposition, the applicant shall leave with the Registrar such evidence by way of affidavit as he desires to adduce in support of his application and shall deliver to the opponent copies thereof or shall intimate to the Registrar and the opponent that he does not desire to adduce any evidence but intends to</p>	<p>We suggest adding the following wording: “...deliver to the opponent copies of the same including exhibits <u>on a CD ROM or any other medium which allows for downloading and printing of evidence filed.</u>”</p>

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	<p>rely on the facts stated in the counterstatement and or on the evidence already left by him in connection with the application in question. In case the applicant adduces any evidence or relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies of the same including exhibits, if any, and shall intimate the Registrar in writing of such delivery.</p>	
<p>13.</p>	<p>Rule 51 (9) - The decision of the Registrar shall be notified to the parties in writing.</p>	<p>There should be a fixed time-line set for decision by the Registrar. We suggest adding: The decision of the Registrar should be notified to the parties in writing <u>within 6 weeks of the hearing.</u></p>

SUBSTANTIVE COMMENTS
Chapter V

S. No.	Rule	Comments
1.	<p>Rule 77 - Case accompanying application.-</p> <p>(1) A person applying for registration of his title under rule 76, shall, along with his request on form TM-P, file original document, duly stamped original instrument or deed, as the case may be, purporting to transfer the title in the trade mark and a statement of case in support of his request. If the Registrar so requires, the statement of case shall be verified by an affidavit in Form TM-P and <u>an affidavit from the applicant</u> to the effect that no litigation relating to the proprietorship of the trademark is pending in any court of law or tribunal:</p> <p>Provided that the Registrar may permit the applicant to submit the duly certified copy of the instrument or deed, in case the applicant justifies that original instrument of deed cannot be submitted.</p>	<p><i>Affidavit to the effect that there are no pending proceedings</i></p> <p><u>Affidavit from Applicant:</u></p> <p>The Rules now require that this affidavit be filed by the Applicant. In most cases, it is the Assignor who is aware of the past infringement cases. To avoid these issues, it is recommended that the registered proprietor should also have the option to file such an affidavit. Accordingly the underlined portion can be amended to read as ‘an affidavit from the applicant or the registered proprietor’</p>

SUBSTATIVE COMMENTS
Chapter VII

S. No.	Rule	Comments
1.	<p>Rule 100 – Further Procedure</p> <p>Within two months from the receipt by a registered proprietor of the copy of the application mentioned in Rule 99 or within such further period not exceeding one month in the aggregate, he shall send to the Registrar in Form TM-O a counter statement in triplicate of the grounds on which the application is contested and if he does so, the Registrar shall serve a copy of the counter statement on the person making the application within one month of the receipt of the same. In case no counter statement has been filed within the period of three months from the date of receipt of the application mentioned in Rule 99, the applicant for rectification shall file evidence in support of his application for rectification under the provisions of sub-Rule (1) of Rule 46. The provision under Rule 47 to 52 shall thereafter apply <i>mutatis mutandis</i> to the further proceedings on the application.</p>	<p>While the inclusion of ‘In case no Counter Statement has been filed within a period of three months from the date of receipt of the application mentioned in Rule 99, the applicant for rectification shall file evidence in support of its application for rectification under the provision of sub rule (1) of rule 46’ is a positive change which will expedite the cancellation petitions, at the same time, it is suggested that a provision be inserted to ensure that the Trade Marks Office intimates the applicant about the non-filing of the Counter Statement so that the applicant is in a position to file its evidence.</p>
2.	<p>Rule 106 - Advertisement before decision and opposition etc.</p> <p>(2) Within three months from the date of advertisement under sub-rule (1), or within such further period not exceeding one month in the aggregate as the Registrar may allow, any person may give notice of opposition to the application in Form TM-P and may also send therewith a statement of his objections. The notice and the statement, if any shall be sent in triplicate. In case there are any registered users under the registration of the trade mark in question, such notice and statement shall also be accompanied by as many</p>	<p>It is suggested that this Rule be amended to read as:</p> <p>Within four months from the date of advertisement under sub-rule (1), any person may give notice of opposition to the application in Form TM-P.....</p>

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<p>copies thereof as there are registered users. A copy of each of the notice and statement shall be transmitted forthwith by the Registrar to the registered proprietor and each registered user, if any, and within two months from the receipt by the registered proprietor of such copies he shall send to the Registrar in Form TM-O, a counter statement in triplicate of the grounds on which the opposition is contested. If the registered proprietor sends such a counterstatement, the Registrar shall ordinarily serve a copy thereof on the person giving notice of opposition within one month and the provisions of rules 46 to 52 shall apply <i>mutatis mutandis</i> to the further proceedings on the opposition. The Registrar shall not, however, refuse the application merely because the registered proprietor has not filed a counterstatement unless he is satisfied that the delay in filing the counterstatement is willful and is not justified by the circumstance of the case. In case of any doubt any party may apply to the Registrar for directions.</p>	
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SUBSTANTIVE COMMENTS
Chapter VIII

S. No.	Rule	Comments
1.	Rule 110 – Single application under sub-section (2) of section 18	<ul style="list-style-type: none"> • A provision should be included for re-advertisement, if necessary. • The earlier provision [Rule 103 (2)] with respect to re-classification of goods/services stated that the Registrar shall <i>require the applicant to correct the classification error</i>. However, the proposed rule [Rule 110 (2)] states that the Registrar shall <i>require the applicant to delete the item by filing an application in Form TM-M</i>. <p>This means that no movement of the already filed goods/services from one class to another would be allowed. This is onerous and should not be introduced as the proposed change is not in the interest of the applicants.</p> <p>The proposed Rule, as before, should also provide for amendment by virtue of correction.</p>
2.	Rule 111 – Divisional Application	The earlier provision 104 (3) which provided for “ <i>in case of a request to divide some goods or services, but not all in a class, a divisional fee for separate application to be created by division shall be paid</i> ” has been done away with. The said sub clause should be retained as it provides for addition of class and partial transfer of goods from one class to another.
3.	Rule 121 – Scale of costs AND Sixth Schedule	<ul style="list-style-type: none"> • In the proposed Trade Marks Rules, 2015, there is no Fourth or Fifth Schedule. Thus, the Sixth Schedule (Scale of costs) should be re-numbered or re-arranged as Fourth Schedule. Accordingly, the wording in Rule 121 should be changed (<i>also stated separately as a clerical error in accompanying “Clerical Error” list</i>). • The Sixth Schedule should provide for Entries in respect of payment of: <ul style="list-style-type: none"> a) Legal fees and expenses incurred by a party; b) Any other expenses incurred by a party in connection with any proceedings. <p>The above is in line with The Commercial Courts, Commercial Division and Commercial Appellate Division of High Courts Ordinance, 2015.</p>
4.	(Old) Rule 120 – Certificate for use in obtaining registration abroad	The (old) Rule 120 has been deleted. No alternate or corresponding provision has been inserted for obtaining a certified copy of a pending application (certificate relating to registration of a trade mark outside India). Moreover, Rule 125 of the proposed Rules does not provide for issuance of a certified copy of a pending application. Therefore, the earlier Rule must be provided for in the proposed Rules.

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S. No.	Rule	Comments
5.	Rule 127 – Determination of Well Known Trade Mark by Registrar	<ul style="list-style-type: none"> • Sub-clause 2 empowers the Registrar to stipulate criteria for determination of a trade mark as well-known. However, a criteria is already prescribed for under S. 11 [specifically sub-clauses (6), (7), (8) & (9)] of the Trade Marks Act, 1999. Therefore, the basis for stipulating the criteria is not clear. It is also not apparent as to whether ‘determination’ by the Registrar is required if the mark has (already) been pronounced as a well-known trade mark by a Court of law/IPAB/Registrar in a contentious proceeding. • There is already a list of well-known trade marks published on the website of the Trade Marks Registry. The fate of the list is unclear and it is not apparent whether a ‘new’ list shall be created or the existing list updated. • The fees for filing a request for determination of a trade mark as well-known (Rs. 1 lac for e-filing / Rs. 1.1 lac for physical filing) is unreasonable, excessive and without any justification. • In order to safeguard rights of an aggrieved person, a procedure for publication and opposition/intervention against determination of a trade mark as well-known should be provided for. • Sub-clause 4 says that if a trade mark has been erroneously included, the Registrar may remove the same from the list. Any such decision should be taken by giving an opportunity of being heard to the aggrieved party as the provision in its current form is against principles of natural justice, fair play and equity. The clause should be amended accordingly. • The time-line in which the Registrar has to revert on the request has not been provided and the Rule should be amended to include the same. <p>Note that INTA has adopted a resolution containing a list of recommended practices for nations that have established or may establish a well-known mark registry- http://www.inta.org/Advocacy/Pages/Well-KnownMarkRegistries.aspx</p> <p>This recommended list of practices is non-exhaustive and can be expanded as registration authorities and trademark owners gain more experience with registries. The link also contains a brief explanation of why INTA recommends these practices. We encourage the DIPP to review this list in order to strengthen the procedures around well-known marks and their protection.</p>

