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Procedure of TradeMarks Registration

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THE TRADE MARKS RULES, 2017

Short Title and Commencement – These rules may be called the Trade Marks Rules, 2017.

They shall come into force on 6th day of March, 2017 of publication in the Official Gazette.

Definitions –

- (a) “Act” means the Trade Marks Act, 1997;
- (b) “agent” means a person authorized to act as such under section 145 of the Act;
- (c) “application for registration of a trademark” includes the trademark for goods or services contained in it;
- (d) “appropriate office of the Trade Marks Registry” means the relevant office of the Trade Marks Registry as specified in rule 4;
- (e) “class fee” means the fee prescribed for the filing of an application for registration of a Trademark in a particular class;
- (f) “convention country” means a country or group of countries or union of countries or Inter – Governmental organizations of country declared as such under sub-section (1) of section 154;



- (g) “graphical representation” means the representations of a trademark for goods or services represented or capable of being represented in paper form and includes in digitized form;
- (h) “Journal” means the trademarks journal made available at official website of Controller General of Patents, Designs and Trade Marks;
- (i) “opposition” means an opposition to the registration of a trademark or a collective trademark or a certification trademark as the case may be and includes an opposition to grant of protection to an international registration designating India and opposition to alteration of registered trademark;
- (j) “principal place of business in India” means the relevant place in India
- (k) “publish” means published in the trademark journal made available on the official website of Controller General of Patents, Design and Trademarks;
- (l) “registered trademark agent” means a trademark agent whose name is actually on the register of trademarks agent maintained under rule 142;
- (m) “renewal” means and includes renewal of registration of a trademark certification trademark or collective trademark, as the case may be ;
- (n) “schedule” means a Schedule to the rules;
- (o) “section” means a section of the Act;



PROCEDURE FOR REGISTRATION OF TRADEMARKS APPLICATION

Form and signing of application

1. An application for the registration of a trademark in respect of specification of goods or services shall be made in TM-A and shall be signed by the applicant or his agent.
2. An application for the registration of a trademark for goods or services shall –
 - (a) Explain with sufficient precision, a description by words, of the trademark
 - (b) Be able to depict the graphical representation of the trademark
 - (c) Be considered as a three dimensional trademark only if the application contains a statement to that effect
 - (d) Be considered as a trademark consisting of a combination of colors if the application contains a statement to that effect.
3. An amendment to divide an application under proviso to section 22 shall be made in Form TM-M

Representation of trademark

Every application for the registration of a trademark are required every such copy, shall contain a clear and legible representation of the trademark of size not exceeding 8cm x 8cm.



Transliteration and translation

Where a trademark contains one or more words or numbers in scripts other than Hindi or English, the applicant shall provide in the application, a precise transliteration and translation of each such word and number in English or Hindi and state the language of which the word(s) or number(s) belong.

Name or description of goods or services on a trademark

Where the name or description of any goods or services appears on a trademark, the Registrar may refuse to register such trademark in respect of any goods or services other than the goods or services so named or described.

Where the name or description of any goods or services appear on a trademark, which name or description in use varies, the Registrar may permit the registration of the trademark for those and other goods or services on the applicant giving an undertaking that the name or description will be varied when the trademark is used upon goods or services covered by the specification other than the named or described goods or services. The undertaking so given shall be included in the advertisement of the application in the journal under sec 20.

Deficiencies

Where an application for registration of a trademark does not satisfy the requirement of any of the provisions of the Act or rules, the Registrar shall send notice thereof to



the applicant to rectify the deficiencies within one month of the date of notice, if the applicant failed to remedy deficiencies as mentioned in the notice, the application shall be treated as abandoned.

Acknowledgement of the Application

Every application for the registration of a trademark in respect of any goods or services shall be acknowledged by giving a system generated electronic receipt or sending such receipt to the e-mail address provided for the purpose.

Examination, objection before acceptance and hearing

The Registrar shall examine the application as per the 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 trademark 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 trademarks at any time before the acceptance of the application .

If , on consideration of the application for registration of a trademark and any evidence of use or of distinctiveness or of any other matter which applicant may or may be required to furnish, the Registrar has any objection to the acceptance of the application or purposes to accept it subject to such condition ,amendments ,



modifications or limitations as he may think fit to impose , the Registrar shall communicate such objection or proposal in writing to the applicant in the form of an examination report.

On consideration of the application for registration of a trademark and any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish, the Register accepts the applications for registration absolutely, he shall communicate such acceptance to the applicant and then the application to be advertised as accepted under sub-section (1) of section 20.

If within one month from the date of receipt of the examination report, the applicant fails to respond to the communication, the Registrar may treat the application as abandoned.

If the response to the examination report is not satisfactory or where the applicant has requested for hearing, the registrar shall provide an opportunity of hearing to the applicant.

In case the applicant fails to appear at the scheduled date of hearing and no reply to the objection has been submitted by the applicant, the Registrar may treat the application as abandoned.

If the applicant has submitted his reply to the examination report within the given time period or has appeared in the hearing and made his submissions, the Registrar shall pass an appropriate order.



Notice of withdrawal of application for registration

A notice of withdrawal of an application for the registration of a trademark under sub sec (2) of sec 133 , for the purpose of obtaining repayment of any fee paid on the filing of the application shall be given in writing one month from the date of the receipt of communication mentioned in sub – rule (2) or rule 33.

Decision of Registrar

The decision of the Registrar under rule 33, 34 or 41 shall be communicated to the applicant in writing at his address of service and if the applicant intends to appeal from such decision he may within 30 days from the date of such communication apply in Form TM.M to the Registrar requiring him to state in writing the grounds of and the materials used by him in arriving at his decision.

Correction and amendment of application

An application for registration of a trademark may, whether before or after acceptance of his application but before the registration of the trademark, for any correction or amendment apply in form TM-M accompanied with the application fee for the correction of any error connection with the filed application.



Note: No such amendment permitted which are related to altering the applied trademark or addition of new specification of goods or services not included in the filed application.

Manner of Advertisement

All filed applications for the Trademark Registrations are require to be advertised as per sec 20 sub sec 1 or sub sections in the Journal

Notice of Opposition

A notice of opposition to the registration of a trademark under sub section 1 of section 21 with such particulars as specified in Rule 43 shall be filed in for TM-O within four months from the date of publication of the trademark journal in which the application of registration of the trademark was advertised or re-advertised.

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.

Counter Statement

Counter statement in Form –O require to be submit within two months from the date of receipt by the applicant of the copy of the notice of opposition. A copy of the counter statement shall be served ordinarily by the Registrar to the opponent within two month from the date of receipt of the same.



Evidence in support of opposition

Within two months from service of a copy of the counter statement, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to submit in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to submit evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver to the applicant copies of any evidence including documents if any and intimate the Registrar in writing of such deliver.

If the opponent takes no action within the time mentioned therein he shall be deemed to have abandon his opposition.

Evidence in reply by opponent

Within one month from the receipt by the opponent of the copies of the applicant's affidavit the opponent may leave with the Registrar evidence by affidavit in reply and shall deliver to the applicant copies of the same including documents if any and intimate the same to the Registrar in writing of such delivery.

Translation of documents

Where a documents is in a language other than Hindi or English, an attested translation thereof in Hindi or English shall be submitted before the registrar and copy thereof shall be provided to opposite party.



Hearing and Decision

The Registrar after the closure of the evidence shall give notice to the parties of the first date of hearing. The date of hearing shall be for a date at least one month after the date of first notice.

A party may make a request to adjournment of the hearing with reasonable cause in form TM-M accompanied by prescribed fees at least three days before the date of hearing and the Registrar if he thinks fit to do so and upon such terms he may direct to adjourn the hearing and intimate the parties accordingly.

Provided parties shall be given not more than two adjournments and each adjournment shall not be for more than thirty days.

If the applicant not present at the adjourned date of hearing and at the time mentioned in the notice, the application may be treated as abandoned.

Entry in the Register

The entry of a trademark in the register shall specify the date of filing of application, the actual date of the registration, the particulars including –

- The address of the principal place of business ;
- If the Proprietor of the trademark has no place of business in India , his address for service in India as entered in the application for registration together with his address in his home country;
- In case of jointly owned trademark , where non of joint proprietor has place of business in India, the address for service in India as given in the application together with the address of each of the joint proprietors in his home country;



- Particulars of trade business, profession, occupation ;
- Particulars affecting the scope of the registration or the rights conferred by the registration;
- Where trademark is registered pursuant to section 11 (4) with the consent of the proprietor of an earlier trademark , that fact ;
- The appropriate office of the Trade Marks Registry in relation to the trademark.

Death of applicant before registration

In case of death of any applicant for the registration of a trademark after the date of his application and before the trademark has been entered in the register, the Registrar may on request on form TM-M and on proof of the applicant's death and on proof of the transmission of the interest of the deceased person, substitute in the application the name of successor in interest in place if he name of such deceased applicant and the application may proceed thereafter as so amended.

Certification of registration

- The certificate of registration to be issued by the Registrar under Sec 23(2) shall be in form RG-2 and shall include Trademark. It shall bear the seal of the Trade Mark Registry.
- The certificate issued under Sec 137 shall be used for any legal proceeding or obtaining registration abroad.



- For obtaining duplicate copies of certificate of registration, Proprietor shall request to the Registrar in Form TM-M accompanied by the prescribed fee.

Provided that no such duplicate or copy of certification of registration shall be issued where such request is received after the expiry of time limit for renewal of registration and restoration of registered trademark

Renewal of Registration and Restoration

An application for the renewal of the registration of a trademark shall be made in Form TM-R along with the prescribed fee mention in the first schedule and may be paid any time not more than one year before the expiration of the last registration of the trademark, unless the trademark has been removed or cancelled or is otherwise not renewal under any of the provisions of the Act and rules or by any order of the competent court or Registrar

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