

India: Proposed Amendments to Trade Mark Rules, 2002

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The Indian Ministry of Commerce and Industry (MCI) has recently issued the draft Trade Mark (Amendment) Rules. The MCI has invited comments from the IP fraternity and general public before finalizing the said amendments to the Trade Mark Rules, 2002. Some of the key highlights of the proposed amendments are listed below.

1. **Fee:** There is a proposal to increase the official fee for filing applications, renewal of registrations, recordation of assignment of trade marks, request for expedited examination, handling fee for applications filed under Madrid Protocol designating India etc. by 100%.
2. **E-Filing:** In order to encourage the practitioners to file applications electronically, the MCI has proposed an additional fee of 10% on applications/ requests filed physically with the Trade Marks Office.
3. **Well Known Marks:** The brand owners will now have an option of approaching the Trade Marks Office to have their marks included in the list of “well-known marks” upon payment of applicable fee. The Registrar would have the discretion to decide whether a mark may be included in the list or not. Further, the Registrar will also have the discretion to remove a mark from the said list if he/she is of the view that the same has been erroneously included in the list.
4. **Statement of Use:** All trade mark applications (except those filed on an “intent to use” basis) will be required to contain a statement of use in respect of all the goods and services mentioned in the application. The Application will have to be accompanied by an Affidavit testifying to use of the mark along with supporting documents. As per the current practice, such an Affidavit is to be submitted only if the Registrar so directs.
5. **Expedited Examination Process:** A request for expedited examination would not be limited to the issuance of the Examination Report and would cover expedited processing of the application that may include show cause hearing, third party opposition, publication in the Trade Marks Journal, issuance of registration certificate etc. As per the current practice, the scope of such a request is limited to the issuance of the Examination Report only.

6. **Expedited Opposition Process:** The disposal of opposition matters may become quicker as the Applicant will now have an option of filing a Counter Statement to the Notice of Opposition as soon as the same is uploaded on the Trade Marks Registry's website. They need not necessarily wait for the Official service of the Notice of Opposition. Further both parties to the Opposition will now be required to serve a copy of exhibits to the other side at the time of submitting the same with the Registry unlike the current practice, where exhibits are served only upon a written request by the Opponent/ Applicant (as the case may be).
7. **Forms:** With a view to simplify the trade mark registration process, the number of official Forms have been consolidated to 8 Forms.
8. **Sound Marks:** In case of registration of sound marks, the Applicants will now be required to submit sound recordings in MP3 format not exceeding 30 seconds besides the graphical representation for registration of sound marks.

The amendments may not bring a dramatic change in the existing procedure of trade mark registration but they might ensure stricter timelines for processing of trademark applications.

From the brand owners' perspective, it is a good time for them to protect their trade marks in India as new rules may get implemented soon. Also, considering that the renewal fee is likely to be doubled once the amendment is implemented, it would make perfect sense to immediately pay the renewal fee for any upcoming renewals.

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