

## Trade Marks Rules, 2001

**Notification.-** WHEREAS certain draft Rules were published in exercise of the powers conferred by sub-section (1) read with section except clauses (XXIX),(XXX),(XXXI), (XXXII) and (XXXIII) thereof of section 157 of the Trade Marks Act, 1999 (47 of 1999) and sections 22 and 24 of the General Clauses Act, 1897 (10 of 1897), vide notification of the Government of India in the Ministry of Commerce and Industry (Department of Industrial Development) No. G.S.R. 373 (e) dated the 18th May, 2001 published in Part II Section 3, sub-section (i) in the Gazette of India, (Extraordinary), inviting objections and suggestions from all persons likely to be affected thereby before the expiry of thirty days from the date on which copies of the Gazette containing notification were made available to the public;

AND WHEREAS the such notification were made available to the public on 11th June, 2001;

AND WHEREAS the objections and suggestions were received from the public have been considered by the Central Government;

NOW, THEREFORE, in exercise of the powers conferred by sub-section (1) &(2) of section 157 of the Trade Marks Act, 1999 (47 of 1999), the Central Government hereby makes the following rules, namely:-

**1. Short title and commencement.-** (1) These rules may be called the Trade Marks Rules, 2001.

(2) They shall come into force on the date on which the Act comes into force.

**2. Definitions.-** (1) In these rules, unless the context otherwise requires, -

(a) "Act" means the Trade Marks Act, 1999 (47 of 1999);

(b) "Agent" means a person authorised to act under section 145 of the Act;

(c) "Application for registration of a trade mark" includes the trade mark 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 notified as such under sub-section (1) of section 154;
- (g) "Convention application" means an application for registration of a trade mark made by virtue of section 154;
- (h) "Divisional application" means-
- (i) An application containing a request for the division of goods or services in a class for the registration of a trade mark; or
- (ii) A divided application made by the division of a single initial application for the registration of a trade mark for separate classes of goods or services;
- (i) "Divisional fee" means fee prescribed in the First Schedule;
- (j) "Form" means a form set forth in either the Second or the Third Schedule;
- (k) "Graphical representation" means the representation of a trade mark for goods or services in paper form;
- (l) "Journal" means the Trade Marks Journal referred to in rule 43;
- (m) "Notified date" means the date on which these- rules come into force;
- (n) "Old law" means the Trade and Merchandise Marks Act, 1958 and rules made there under existing immediately before the commencement of the Act;
- (o) "Opposition" means an opposition to the registration of a trade mark or a collective mark or a certification trade mark, as the case may be;
- (p) "Principal place of business in India" means the relevant place in India as specified in rule 3;
- (q) "Publish" means publish in the Trade Marks Journal;
- (r) "registered trade mark agent" means a trade marks agent whose name is actually on the register of trade marks agents maintained under rule 148;
- (s) "Renewal" means and includes renewal of a trade mark or a certification trade mark or collective mark, as the case may be;
- (t) "Schedule" means a schedule to these rules;

(u) "Section" means a section of the Act;

(v) "Specification" means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered;

(w) All other words and expressions used but not defined in these rules but defined in the Act or in the Geographical Indications Goods (Registration and Protection) Act, 1999 (48 of 1999), the Copyright Act, 1957 (14 of 1957) shall have the meanings respectively assigned to them in these Acts.

(2) In these rules, except as otherwise indicated, a reference to a section is a reference to that section in the Act, a reference to a rule is a reference to that rule in these rules, a reference to a Schedule is a reference to that Schedule to these rules and a reference to a form is a reference to that form contained in the Second Schedule or the Third Schedule, as the case may be to these rules.

**3. Principal place of business in India.-** Principal place of business in India means-

(i) Where a person carries on business in the goods or services concerned in a trade mark-

(a) if the business is carried on in India at only one place, that place;

(b) if the business is carried on in India at more places than one, the place mentioned by him as the principal place of business in India;

(ii) where a person is not carrying on a business in the goods or services concerned in a trade mark – (a) if he is carrying on any other business in India at only one place, that place;

(b) if he is carrying on any other business in India at more places than one, the place mentioned by him as the principal place of business in India; and

(iii) where a person does not carry on any business in India but has a place of residence in India, then such place of residence in India.

**4. Appropriate office of the Trade Marks Registry.-** The appropriate office of the Trade Marks Registry for the purposes of making an application for registration of a trade mark under section 18 or for giving notice of opposition under section 21 or an application for removal of a trade mark under section 47 or canceling or varying the registration of a trade mark

under section 57 or for any other proceedings under the Act and the rules shall be -

(a) in relation to a trade mark on the Register of Trade Marks at the notified date, the office of the Trade Marks Registry within whose territorial limits-

(i) the principal place of business in India of the registered proprietor of the trade mark as entered in the register at such date is situate;

(ii) where there is no entry in the register as to the principal place of business in India of the registered proprietor, the place mentioned in the address for service in India as entered in the register at such date is situate;

(iii) in the case of jointly registered proprietors, the principal place of business in India of the proprietor whose name is entered first in the register as having such place of business in India at such date is situate;

(iv) where none of the jointly registered proprietors is shown in the register as having a principal place of business in India, the place mentioned in the address for service in India of the joint proprietors as entered in the register at such date, is situate;

(v) if no principal place of business in India of the registered proprietor of the mark or in the case of joint registration, of any of the joint proprietors of the mark, is entered in the register, and the register does not contain any address for service in India, the place of the office of the Trade Marks Registry where the application for registration of the trade mark was made, is situate, and

(b) in relation to a trade mark for which an application for registration is pending at the notified date or is made on or after the notified date, the office of the Trade Marks Registry within whose territorial limits -

(i) the principal place of business in India of the applicant as disclosed in the application or, in the case of joint applicants, the principal place of business in India of the applicant whose name is first mentioned in the application, as having such place of business is situate;

(ii) where neither the applicant nor any of the joint applicants, as the case may be, has a principal place of business in India, the place mentioned in the address for service in India as specified in the application is situate.

**5. Jurisdiction of appropriate office not altered by change in the principal place of business or address for service.-** No change in the

principal place of business in India or in the address for service in India, as the case may be,

(a) of a registered proprietor or of any of the jointly registered proprietors in relation to any trade mark on the register at the notified date, made or effected subsequent to that date or,

(b) of an applicant for registration or of any of the joint applicants for registration in relation to any trade mark for which an application for registration is either pending at the notified date or is made on or after that date, made or effected subsequent to that date or to the date of filing of such application, as the case may be,

shall affect the jurisdiction of the appropriate office of the trade marks registry .

**6. Entry of the appropriate office in the register.-** In respect of every trade mark on the register at the notified date or registered thereafter the Registrar shall cause to be entered in the register, the appropriate office of the trade marks registry and the Registrar may, at any time, correct any error in the entry so made.

**7. Transfer of pending applications and proceedings to appropriate offices of the trade marks registry.-** Every application and proceeding pending before the Registrar at the notified date in relation to a trade mark shall be deemed to have been transferred to the appropriate office of the trade marks registry.

**8. Leaving of documents, etc.-** (1) Save as otherwise provided in sub-rule (2), all applications, notices, statements or other documents or any fees authorised or required by the Act or the rules to be made, served, left or sent or paid at or to the trade marks registry in relation to a trade mark on the Register of Trade Marks on the notified date or for which an application for registration is pending on, or is made on or after the notified date, shall be made, served, left or sent or paid to the appropriate office of the trade marks registry.

(2) documents or fees authorised or required by the Act or the rules to be sent or paid may be sent or paid at or to either the appropriate office or the head office of the registry in the following matters -

(a) communication and other documents including affidavits in relation to an application filed for registration of a trade mark;

(b) application or request in Forms TM-10, TM-12, TM-13, TM-14, TM-16, TM-17, TM-19, TM-20, TM-21, TM-23, TM-24, TM-25, TM-28, TM-29, TM-30, TM-31, TM-32, TM-33, TM-34, TM-35, TM-36, TM-38, TM-40, TM-46, TM-47, TM-50, TM-54, TM-55, TM-58, TM-59, TM-61 and TM-62.

(c) Notwithstanding anything contained in sub-rule 1 and under clause (a) or clause (b) of sub rule 2 or a request for search and issuance of certificate in Form TM-60, expedited examination in Form TM-63, or expedited certified copies of documents in Form TM-70, or for expedited search report in Form TM-71 or for expedited search certificate in Form TM-72 shall be filed at the head registry until the Registrar after informing the public in the Journals directs otherwise.

**9. Documents etc. filed or left not at the appropriate office.-** Subject to the provisions of rule 8, where an application, notice, statement or other document or any fee authorised or required by the Act or the rules is made, served, left or sent or paid, at or to an office inadvertently which is not the appropriate office of the Trade Marks Registry, the Registrar may on his own or on a request in writing, return such application, notice, statement or document to the appropriate office if he is satisfied that it was a bonafide error on the part of the applicant.

**Provided that** the period for which such application, notice or statement or document is retained by the office which is not the appropriate office shall be excluded for the purposes of computing the period of limitation where any of such application, notice, statement or document is required to be presented within the prescribed period:

**Provided further that** any fee paid at the office which is not the appropriate shall be deemed to have been paid at the appropriate office

**Provided also that** before declining any such request, the Registrar shall provide the applicant an opportunity of being heard.

**10. Issue of notices etc.-** Any notice or communication relating to any application, matter or proceeding under the Act or the rules shall ordinarily be issued by the Head of Office or any other officers authorised by the Registrar.

**11. Fees.-** (1) The fees to be paid in respect of applications, oppositions, registration, renewal, other expedited examination or reports and any other matters under the Act and the rules shall be those specified in the First Schedule, hereinafter referred to as the prescribed fees.

(2) Where in respect of any matter, a fee is required to be paid under the rules, the form or the application or the request of the petition, therefore, shall be accompanied by the prescribed fee.

(3) Fees may be paid in cash or sent by money order addressed to the Registrar or by a bank draft issued or by a cheque drawn on a scheduled bank at the place where the appropriate office of the Trade Marks Registry is situated 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 cheque would be delivered in the ordinary course of post.

(4) Bank drafts and cheques shall be crossed and made payable to the Registrar at the appropriate office of the Trade Marks Registry and these shall be drawn on a scheduled bank at the place where the appropriate office of the Trade Marks Registry is situate.

(5) Subject to the provisions contained in sub-rule 19 of rule 25, 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 deemed not to have been filed for the purposes of any proceedings under these rules.

(6) The Registrar may, after informing the public in the Journal, make available electronic fee transfer facilities subject to such guideline and instructions as may be specified on that behalf.

**12. Forms.-** (1) The forms set forth in the Second and the Third Schedules shall be used in all cases to which they are applicable and may be modified as directed by the Registrar to meet other cases.

(2) Any form, when filed at the Trade Marks Registry, shall be accompanied by the prescribed fee.

(3) A requirement under this rule to use a form as set forth in the Schedules is satisfied by the use either of a replica of that form or of a form which is acceptable to the Registrar and contains the information required by the form as set forth and complies with any direction as to the use of such a form.

(4) The Registrar may after informing the public in the Journal, specify such forms as are required to be submitted in electronic mode. Thereafter, such forms shall be completed in such a manner as may be specified as to permit an automated input of the content into a computer such as by character recognition or scanning.

**13. Size, etc; of documents.-** (1) Subject to any other directions that may be given by the Registrar, all applications, notices, statements or other documents except trade marks, 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 shall be neatly handwritten or typewritten or lithographed or printed in Hindi or in English in large and legible characters with deep permanent ink upon strong paper, and except in the case of affidavits, on one side only, and of size of approximately 33 centimetres by 20 centimetres and shall have on the left hand part thereof a margin of not less than 4 centimetres.

(2) Duplicate documents including copies of trade marks shall be filed at the Trade Marks Registry if at any time required by the Registrar.

(3) The Registrar may after informing the public in the Journal alter the size, etc; of all applications, notices, statements or other document and forms required under the rules to make it compatible in electronic mode.

(4) The Registrar may, after informing the public in the Journal, permit the filing of applications, statements, notices or other documents by electronic mode subject to such guidelines and instructions as he may specify in the Journal.

**14. Signing of documents.-** (1) A document purporting to be signed by a partnership firm shall be signed by at least one of the partners stating that he signs on behalf of the firm and a document purporting to be signed by a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate. The capacity in which an individual signs a document on behalf of a partnership or a body corporate shall be stated below his signature.

(2) Signatures to any document shall be accompanied by the name of the signatory in Hindi or capital letters, if signed in English.

**15. Service of documents.-** (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 sent through the post by a prepaid letter.

(2) An application or a 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.

(3) In proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

(4) After the filing of an application at the Trade Marks Registry, any person while making any correspondence relating thereto shall furnish the following particulars, namely:-

(a) the application number or numbers, if any

(b) the date and place of filing;

(c) the appropriate class or classes, as the case may be, in relation to which the application is filed;

(d) an address for communication; and

(e) the concerned agent's code, if any and the concerned proprietor's code if allotted.

(5) The Registrar may, after informing the public in the Journal permit, transmission of any document by facsimile (fax) of specified documents not requiring payment of a fee.

(6) The Registrar may after informing the public in the Journal accept communications of a routine nature through E-mail not requiring the payment of a fee thereof.

**16. Particulars of address etc; of applicants and other persons.-** (1) Names and addresses of the applicants and other persons shall be given in full, together with their nationality, calling and such other particulars as are necessary for identification.

(2) In the case of a firm, the full name and nationality of every partner thereof shall be stated.

(3) In the case of an application from a convention country and persons having no principal place of business in India, their addresses in their home country shall be given in addition to their address for service in India.

(4) In the case of a body corporate or firm, the country of incorporation or the nature of registration, if any, as the case may be, shall be given.

**17. Statement of principal place of business in India in an application.-** (1) Every application for registration of a trade mark shall

state the principal place of business in India, if any, of the applicant or in the case of joint applicants, of such of the joint applicants as have a principal place of business in India.

(2) Subject to the provisions of rules 18, 19 and 21, any written communication addressed to an applicant, or in the case of joint applicants to a joint applicant, in connection with the registration of a trade mark, at the address of his principal place of business in India given by him in the application shall be deemed to be properly addressed.

**18. Address for service.-** (1) An address for service in India shall be given -

(a) by every applicant for registration of a trade mark who has no principal place of business in India;

(b) in the case of joint applicants for registration of a trade mark, if none of them has a principal place of business in India;

(c) by the proprietor of a trade mark who had his principal place of business in India at the date of making the application for registration but has subsequently ceased to have such place;

(d) by every applicant in any proceeding under the Act or the rules and every person filing a notice of opposition, who does not have a principal place of business in India.

(e) by every person granted leave to intervene under rule 94.

(2) Any written communication addressed to a person as aforesaid at an address for service in India given by him shall be deemed to be properly addressed.

(3) Unless an address for service in India as required in sub-rule (1) is given, the Registrar shall be under no obligation to send any notice that may be required by the Act or the rules and no subsequent order or decision in the proceedings shall be called in question on the ground of any lack or non-service of notice.

**19. Address for service in application and opposition proceedings.-**

An applicant for registration of a trade mark or an opponent filing a notice of opposition may notwithstanding that he has a principal place of business in India, if he so desires, may specifically request in writing, the Registrar with an address in India to which communications in relation to the

application or opposition proceedings only may be sent. Such address of the applicant or the opponent shall be deemed, unless subsequently cancelled, to be the actual address of the applicant or the opponent, as the case may be, and all communications and documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to such address of the applicant or the opponent, as the case may be.

**20. Non-availability of an address for service.-** The Registrar may, at any time when a doubt arises as to the continued availability of an address for service in India entered in the register, request the person for whom it is entered, by letter directed to any other address entered in the register or if no such address is entered in the register to the address at which the Registrar considers that the letter would reach him, to confirm the address for service in India and if within two months of making such a request the Registrar receives no such confirmation, he may strike the entry in the register of the address for service in India and require such person to furnish a fresh address for service in India or his address at the principal place of business in India, if he has any at that time.

**21. Agency.-** (1) The authorisation of an agent for the purpose of section 145 shall be executed in Form TM-48 or in such other written form as the Registrar may deem sufficient and proper.

(2) In the case of such authorisation, service upon the agent of any document relating to the proceeding or matter shall be deemed to be service upon the person so authorising him; all communications directed to be made to such person in respect of the proceeding or matter may be addressed to such agent, and all appearances before Registrar relating thereto may be made by or through such agent.

(3) In any particular case, the Registrar may require the personal signature or presence of an applicant, opponent, proprietor, registered user or other person.

**22. Classification of goods or services.-** (1) For the purposes of the registration of trade marks, goods and services shall be classified in the manner specified in the Fourth Schedule.

(2) The goods and services specified in the Fourth Schedule only provide a means by which the general content of numbered international classes can be quickly identified. It corresponds to the major content of each class and are not intended to be exhaustive in accordance with the international

classification of goods and services. For determining the classification of particular goods and services and for full disclosure of the content of international classification, the applicant may refer to the alphabetical index of goods and services, if any, published by the Registrar under section 8 or the current edition of the International Classification of Goods and Services for the purpose of registration of trade mark published by the World Intellectual Property Organisation or subsequent edition as may be published.

(3) The Registrar shall identify and include in the alphabetical index of classification of goods and services, as far as practicable, goods or services of Indian origin.

**23. Preliminary advice by Registrar as to distinctiveness.-** (1) An application for preliminary advice by the Registrar under sub-section (1) of section 133 shall be made in Form TM-55 in respect of any goods or services comprised within any one class in the Fourth Schedule, accompanied by three representations of the trade mark.

(2) The advice referred to sub-rule (1) shall ordinarily be given within seven working days of such filing of the application and such advice shall contain the reasons therefor.

**24. Request to Registrar for search.-** (1) Any person may request the Registrar, in Form TM-54 to cause a search to be made in respect of a trade mark relating to specified goods or services classified in any one class in the Fourth Schedule to ascertain whether any mark is on record which resembles the trade mark in respect of which the request is made. The Registrar shall cause such search to be made and the result thereof communicated ordinarily to the person making the request within thirty days of the receipt of such request:

**Provided that** the Registrar shall cause an expedited search report to be issued ordinarily within seven working days on a request in Form TM-71 on payment of five times the ordinary fees for such search.

(2) If, within three months from the date of communication of the result of the search aforesaid, an application is made for the registration of the trade mark in question and the Registrar takes objection on the ground that the mark resembles a mark, which was not disclosed in the search but was on record on the last of the dates on which the search was made, the applicant shall be entitled, on giving notice of withdrawal of the application within the period mentioned in rule 39, to have repaid to him any fee paid on the filing of the application.

(3) Any person may request the Registrar, in Form TM-60 to cause a search to be made and for issue of certificate under sub-section (1) of section 45 of Copyright Act, 1957 (14 of 1957) to the effect that no trade mark identical with or deceptively similar to such artistic work, as sought to be registered as copyright under the Copyright Act, 1957 (14 of 1957) has been registered as a trade mark under the Trade Marks Act, 1999(47 of 1999) in the name of, or that no application has been made under that Act for such re-registration by any person other than the applicant. The certificate shall ordinarily be issued within thirty working days of the date of request:

**Provided**, however, the Registrar may call for a statement of requirements from the applicant and if the requirements are not complied within two months from the date of such calling of the statement, the request in Form TM-60 may be treated as abandoned.

(4) The Registrar may cancel the certificate issued under sub-rule (3) after giving notice and stating the grounds on which the Registrar proposes to cancel the certificate and after providing reasonable opportunity of being heard.

(5) Subject to proviso to sub-rule 3 or sub-rule 4, the Registrar shall ordinarily within seven working days issue an expedited search certificate under sub-section (1) of section 45 of the Copyright Act, 1957 (14 of 1957) on a request received in Form TM-72 on payment of five times the ordinary fee for such search.

(6) Before abandoning the request in Form TM-60 or TM-72, as the case may be, for non-compliance of the statement of requirements when called for, the Registrar shall offer an opportunity of being heard in the matter.

## **CHAPTER II: PROCEDURE FOR REGISTRATION OF TRADE MARKS APPLICATION**

**25. Form and signing of application.-** (1) An application to the Registrar for the registration of a trade mark shall be signed by the applicant or his agent.

(2) An application to register a trade mark for a specification of goods or services included in any one class shall be made in Form TM-1.

(3) An application to register a trade mark under sub-section (2) of section 154 for a specification of goods or services included in any one class from a convention country shall be made in Form TM-2.

(4) A single application for the registration of a trade mark for different classes of goods or services from convention country under sub-section (2) of section 154 shall be made in Form TM-52.

(5) An application to register a textile trade mark (other than a collective mark or a certification trade mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule under rule 145 shall be made in Form TM-22.

(6) An application to register of a textile mark (other than a collective mark or a certification trade mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule under rule 145 from a convention country under sub-section (2) of section 154 shall be made in Form TM-45.

(7) (a) An application under section 63(1) to register a collective trade mark for a specification goods or services in any one class shall be made in Form TM-3.

(b) An application under section 63(1) to register a collective trade mark for a specification of goods or services from a convention country under sub-section (2) of Section 154 shall be made in Form TM-64.

(8) (a) An application under section 71 to register a certification trade mark for a specification of goods or services included in any one class shall be made in Form TM-4.

(b) An application under section 71 to register a certification trade mark for a specification of goods or services from a convention country under sub-section (2) of Section 154 shall be made in Form TM-65.

(9) A single application for the registration of a trade mark for different classes of goods or services shall be made in Form TM-51.

(10) An application to register a series trade marks under section 15 for a specification of goods or services included in a class or for different classes shall be made in Form TM-8.

(11) An application to register a series trade mark under section 15 for a specification of goods or services included in a class or for different classes from a convention country under sub-section (2) of section 154 shall be made in Form TM-37.

(12) An application for registration of a trade mark for goods or services shall: -

(a) Explain with sufficient precision a description by words of the trade mark, if necessary to determine the right of the applicant;

(b) Be able to depict the graphical representation of the trade mark;

(c) Not be acted upon which consists of a three dimensional mark unless it contains a statement to that effect;

(d) Not be acted upon which consists of a colour combination is claimed as an element of a trade mark unless it contains a statement to that effect and specifies the colours.

(13) An amendment to divide an application under proviso to section 22 shall be made in Form TM-53.

(14) An application shall be in respect of one trade mark only for as many class or classes of goods or services as may be made.

(15) In the case of an application for registration in respect of all the goods or services included in a class or of a large variety of goods or services in a class, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made or intends to make if and when it is registered.

(16) The specification of goods or services shall not ordinarily exceed five hundred characters. An excess space fee as prescribed in the First Schedule is payable with each application in Form TM-61.

(17) (a) A single application for the registration of a collective mark in different classes shall be made in Form TM-66

(b) A single application for the registration of a collective mark in different classes from a convention country shall be made in Form TM-67.

(18) (a) A single application for the registration of certification trade mark in different classes shall be made in Form TM-68.

(b) A single application for the registration of a certification trade mark in different classes from a convention country shall be made in Form TM-69.

(19) Where an applicant files a single application for more classes than one, and the Registrar determines that the goods or services applied for fall in class or classes in addition to those applied for, the applicant may restrict the specification of goods or services to the class applied for or amend the application to add additional class or classes on payment of the appropriate class fee and the divisional fee. The new class created through a division retains the benefit of the original filing date or in the case of an application from a convention country the convention application date under sub-section (2) of Section 154 provided the claim was otherwise properly asserted in the initial application.

**26. Application under convention arrangement.-** (1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a convention country under section 154 a certificate by the Registry or competent authority of that Trade Marks Office shall be included in an application for registration under sub-rule (3), (4), (6), (7)(b), (8)(b), (11), (17)(b) or (18)(b) of rule 25, as the case may be, and it shall include the particulars of the mark, the country or countries and the date or dates of filing of application and such other particulars as may be required by the Registrar.

(2) Unless such certificate has been filed at the time of the filing of the application for registration, there shall be filed, within two months of the filing of such application certifying or verifying to the satisfaction of the Registrar, the date of the filing of the application, the country, the representation of the mark, and the goods or services covered by the application.

(3) The application shall include a statement indicating the date of filing of the convention application, the name of the convention country where it was filed, the serial number, if any, and a statement indicating that priority is claimed:

**Provided** Where the applicant files more priority claims than one under section 154 for some or all the goods or services in respect of the same trade mark, the Registrar shall take the date of the earlier application in a convention country, as the priority date;

**Provided further that** the Registrar shall take such priority date only in respect of goods or services referred to in convention application.

(4) Where a single application under sub-section (2) of section 18 is filed from a convention country for one or more classes of goods or services, the applicant shall establish a sufficient ground to the satisfaction of the Registrar for the date of filing of application in all such classes.

**27. Statement of user in applications.-** 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 the goods or services mentioned in the application. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

**28. Representation of mark.-** (1) Every application for the registration of a trade mark, and where additional copies of the application are required every such copy, shall contain a representation of the mark in the space (8cm x 8 cm) provided on the application form for that purpose:

**Provided that** in any case the size of such representation shall not exceed 33 centimetres by 20 centimetres with a margin of 4 centimetres on the left hand side.

**29 Additional representations.-** (1) Every application for registration of a trade mark shall, except as hereinafter provided, be made in triplicate and shall be accompanied by five additional representations of the mark. The representations of the mark on the application and each of its copies and the additional representations shall correspond exactly with one another. The additional representations shall in all cases be noted with the specification and class or classes of goods or services for which registration is sought , the name and address of the applicant, together with the name and address of his agent, if any, the period of use, if any, and such other particulars as may from time to time be required by the Registrar and shall be signed by the applicant or his agent.

(2) Where an application contains a statement to the effect that the applicant wishes to claim combination of colours as the distinctive feature of the mark, the application shall be accompanied with one reproduction of the mark in black and white and four reproduction of the mark in colour.

(3) Where the application contains a statement to the effect that the trade mark is a three dimensional mark, the reproduction of the mark shall consist of a two dimensional graphic or photographic reproduction as follows, namely:-

(i) The reproduction furnished shall consist of three different view of the trade mark;

(ii) Where, however, the Registrar considers that the reproduction of the mark furnished by the applicants does not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish within two months up to five further different views of the mark and a description by words of the mark;

(iii) Where the Registrar considers the different views and/or description of the mark referred to in clause (ii) still do not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish a specimen of the trade mark.

(4) (i) Where an application for the registration of a trade mark consists of shape of goods or its packaging, the reproduction furnished shall consist of at least five different views of the trade mark and a description by word of the mark.

(ii) If the Registrar considers the different views and description of the mark in sub-clause (i) still do not sufficiently show the particulars of the shape of goods or its packaging, he may call upon the applicant to furnish a specimen of the goods or packaging as the case may be.

**30. Representations to be durable and satisfactory.-** (1) All representations of trade marks shall be of a durable nature, and each additional representation required to be filed with an application for registration shall be mounted on a sheet of strong paper of the size of approximately 33 centimetres by 20 centimetres, leaving a margin of not less than 4 centimetres on the left hand part of the sheet.

(2) If the Registrar is not satisfied with any representation of a mark he may at any time require another representation satisfactory to him to be substituted before proceedings with the application.

(3) Where representation of a trade mark cannot be given in the manner set forth hereinabove, a specimen or copy of the trade mark may be sent either in full size or on a reduced scale and in such form as the Registrar may think most convenient.

**31. Series trade marks.-** (1) Where an application is made for the registration of series trade marks under sub-section (3) of section 15, copies of representation of each trade mark of the series shall accompany the application in the manner set forth in rules 28 and 29.

(2) An applicant claiming to be the proprietor of a series trade mark under sub-section (3) of section 15 may apply to the Registrar in Form TM-8 or TM-37, as the case may be, for its registration as a series for one registration and there shall be included in each such application a representation of the trade mark of each class claimed to be in the series. The Registrar shall, if satisfied that the marks constitutes a series proceed further with the applications.

(3) At any time before the publication of the application in the Journal, the applicant applying under sub-rule (2) may request in Form TM-53 for the division of the application into separate application or applications, as the case may be, in respect of one or more marks in that series and the Registrar shall, if he is satisfied that the division requested conforms with sub-section (3) of section 15, divide the application or applications accordingly.

(4) The division of an application into one or more applications under sub-rule (3) shall be on the payment of a divisional fee and such class fees as are appropriate.

**32. Request for search of a company name.-** Any person may, after the Registrar has informed the public in the Journal permitting a request in Form TM-75 to cause a search to be made and for issuance of a certificate pursuant to clause (ii) of sub-section(2) of section 20 of the Companies Act, 1956 (1 of 1956) to the effect that no trade mark identical with or deceptively similar to the name of the company in respect of which the request is made has been registered as a trade mark or is pending under the Trade Marks Act,1999(47 of 1999)

**33. Transliteration and translation.-** Where a trade mark contains a word or words in scripts other than Hindi or English, there shall be endorsed on the application form and the additional representations thereof, a sufficient transliteration and translation to the satisfaction of the Registrar of each such word in English or in Hindi and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.

**34. Names and representations of living persons or persons recently dead.-** Where the name or representation of any person appears on a trade mark the applicant shall, if the Registrar so requires, furnish him with the consent in writing of such person in case he is living or, in case his death took place within twenty years prior to the date of the application for registration of the trade mark, of his legal representative, as the case may be, to the use of the name or representation and in default of such consent

the Registrar may refuse to proceed with the application for registration of the trade mark.

**35. Name or description of goods or services on a mark.-** (1) Where the name or description of any goods or services appears on a trade mark, the Registrar may refuse to register such mark in respect of any goods or services other than the goods or services so named or described.

(2) Where the name or description of any goods or services appear on a trade mark, which name or description in use varies, the Registrar may permit the registration of the trade mark for those and other goods or services on the applicant giving an undertaking that the name or description will be varied when the trade mark 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 section 20.

**36. Deficiencies.-** Subject to sub-rule (2) of rule 11, where an application for registration of a trade mark does not satisfy the requirement of any of the provisions of the Act or these rules, the Registrar shall send notice thereof to the applicant to remedy the deficiencies and if within one month of the date of the notice the applicant fails to remedy any deficiency so notified to him, the application may be treated as abandoned.

## **PROCEDURE ON RECEIPT OF APPLICATION FOR REGISTRATION OF A TRADE MARK**

**37. Acknowledgement and Search.-** (1) Every application for the registration of a trade mark in respect of any goods or services shall on receipt, be acknowledged by the Registrar. The acknowledgement shall be by way of return of one of the additional representations of the trade mark filed by the applicant along with his application with the official number of the application duly entered thereon.

(2) Upon receipt of the application for registration of trade mark, the Registrar shall cause a search to be made amongst the registered trade marks and amongst the pending applications 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 mark sought to be registered and the Registrar may cause the search to be renewed at any time before the acceptance of the application but shall not be bound to do so.

**38. Expedited examination, objection to acceptance, hearing.-** (1) After the receipt of the official number of an application under sub-rule (1) of rule 37, an applicant may request for expedited examination of an application for registration of a trade mark in Form TM-63 together with a declaration stating the reason for the request, on payment of five times the application fee.

(2) If the Registrar is satisfied on the basis of declaration filed under sub-rule(1) that an expedited examination of the application is warranted, he shall cause the expedited examination of such application in the order in which the requests are filed and may ordinarily issue the examination report within three months of the date of such request.

(3) Where the Registrar declines the request under sub-rule (1), the applicant shall be entitled to have the fee refunded:

**Provided that** before declining any such request, the Registrar shall provide the applicant an opportunity of being heard.

(4) If on consideration of an application for registration of a trade mark or on an application for an expedited examination of an application referred to in sub-rule (1) and any evidence of use or of distinctiveness or of any other matter which the applicant may or may be required to furnish, the Registrar has any objection to the acceptance of the application or proposes to accept it subject to such conditions, amendments, modifications or limitations as he may think right to impose under sub-section (4) of section 18, the Registrar shall communicate such objection or proposal in writing to the applicant.

(5) If within one month from the date of communication mentioned in sub-rule (4), the applicant fails to amend his application according to the proposal or fails to submit his observations to the Registrar or apply for a hearing or fails to attend the hearing, the application shall be deemed to have been abandoned.

**39. Notice of withdrawal of application for registration.-** A notice of withdrawal of an application for the registration of a trade mark under sub-section 2 of section 133, or sub-rule (2) of rule 24, for the purpose of obtaining repayment of any fee paid on the filing of the application, shall be given in writing within one month from the date of the receipt of communication mentioned in sub-rule (4) of rule 38.

**40. Decision of Registrar.-** (1) The decision of the Registrar under rule 38 or rule 42 after a hearing or without a hearing if the applicant has duly communicated his observations in writing and has stated that he does not

desire to be heard, shall be communicated to the applicant in writing and if the applicant intends to appeal from such decision he may within thirty days from the date of receipt of such communication apply in Form TM-15 to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at, his decision.

(2) In a case where the Registrar makes any requirements to which the applicant does not object the applicant shall comply therewith before the Registrar issues a statement in writing under sub-rule (1).

(3) The date when the statement in writing under sub-rule (1) is received shall be deemed to be the date of the Registrar's decision for the purpose of an appeal.

**41. Correction and amendment of application.-** An applicant for registration of a trade mark may, whether before or after acceptance of his application but before the registration of the mark, apply in Form TM-16 accompanied by the prescribed fee for the correction of any error in or in connection with his application or any amendment of his application:

**Provided**, however, no such amendment shall be permitted which shall have the effect of substantially altering the original trade mark or substitute a new specification of goods or services not included in the initial application.

**42. Withdrawal of acceptance by the Registrar.-** (1) If, after the acceptance of an application but before the registration of the trade mark, the Registrar has any objection to the acceptance of the application on the ground that it was accepted in error, or that the mark ought not to have been accepted in the circumstances of the case, or proposes that the mark should be registered only subject to conditions, limitations, divisions or to conditions additional to or different from the conditions, or limitations, subject to which the application has been accepted, the Registrar shall communicate such objection in writing to the applicant.

(2) Unless within thirty days from the date of receipt of the communication mentioned in sub-rule (1) the applicant amends his application to comply with the requirements of the Registrar or applies for a hearing, the acceptance of the application shall be deemed to be withdrawn by the Registrar, and the application shall proceed as if it had not been accepted.

(3) Where the applicant intimates the Registrar within the period mentioned in sub-rule (2) that he desires to be heard, the Registrar shall give notice to the applicant of a date when he will hear him. Such appointment shall be for a date at least 15 days after the date of the notice, unless the applicant

consents to a shorter notice. The applicant may state that he does not desire to be heard and submit such submissions as he may consider desirable.

(4) The Registrar may, after h

## **ADVERTISEMENT OF APPLICATION**

**43. Manner of Advertisement.-** (1) Every application for registration of a trade mark required to be advertised by sub-section (1) of section 20 or to be re-advertised by sub-section (2) of that section shall be advertised in the Journal ordinarily within six months of the acceptance of an application for registration or after the expiry of the period referred to sub-section (2) of section 154 whichever is later.

(2) Where a trade mark applied is other than a word, the Registrar may call upon the applicant to furnish a camera ready copy of the trade mark ordered to be advertised to scan electronically into a Desk Top publishing package.

(3) The Registrar may after informing the public in the Journal, put the applications published in the Journal on the internet, web site or any other electronic media.

(4) The Registrar may after informing the public in the Journal make available the Journal in CD-ROM on payment of the cost thereof.

**44. Advertisement of series.-** Where an application relates to a series trade marks differing from one another in respect of the particulars mentioned in sub-section (3) of section 15, the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the several trade marks differ from one another.

**45. Notification of correction or amendment of application.-** In the case of an application to which clause (b) of sub-section (2) of section 20 applies, the Registrar may, if he so decides, instead of causing the application to be advertised again, insert in the Journal a notification setting out the number of the application, the class or classes in which it was made, the name and address of the principal place of business in India, if any, of the applicant or where the applicant has no principal place of business in India his address for service in India, the Journal number in which it was advertised and the correction or amendment made in the application.

#### **46. Request to Registrar for particulars of advertisement of a mark.-**

Any person may request the Registrar in Form TM-58 to be informed of the number, date and page of the Journal in which a trade mark which is sought to be registered specified in the form was advertised and the Registrar shall furnish such particulars to the person making the request.

### **OPPOSITION TO REGISTRATION**

**47. Notice of Opposition.-** (1) A notice of opposition to the registration of a trade mark under sub-section (1) of section 21 shall be given in triplicate in Form TM-5 within three months or within such further period not exceeding one month in the aggregate from the date the Journal is made available to the public (which date shall be certified by the Registrar as such) The notice shall include a statement of the grounds upon which the opponent objects to the registration. If the registration is opposed on the ground that the trade mark in question resembles marks already on the register, the registration numbers of such trade marks and the dates of the Journals in which they have been advertised shall be set out without fail.

(2) Where a notice of opposition has been filed in respect of a single application for the registration of a trade mark, it shall bear the fee in respect of each class in relation to which the opposition is filed in Form TM-5.

(3) Where an opposition is filed only for a particular class or classes in respect of a single application made under sub-section (2) of section 18, the application for remaining class or classes shall not proceed to registration until a request in Form TM-53 for division of the application together with the divisional fee is made by the applicant.

(4) Where in respect of a single application for the registration of a trade mark, no notice of opposition is filed in a class or classes, the application in respect of such class or classes shall subject to section 19 and sub-section 1 of section 23 proceed to registration after the division of the application in the class or classes in respect of which an opposition is pending.

(5) All notices of opposition to the registration of a trade mark for goods or services received in respect of a particular Journal shall be notified in the Journal:

**Provided that** nothing in this sub-rule shall be construed to presume that all remaining trade marks from a particular journal so notified shall automatically proceed to registration.

(6) An application for an extension of the period within which a notice of opposition to the registration of a trade mark may be given under sub-section (1) of section 21, shall be made in Form TM-44 accompanied by the fee prescribed in First Schedule before the expiry of the period of three months under sub-section (1) of section 21.

(7) 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.

**48. The Notice of Opposition shall contain.-** (a) as concern the application against which opposition is entered -

(i) the application number of the application against which opposition is entered.

(ii) an indication of the goods or services listed in the trade mark application against which opposition is entered; and

(iii) the name of the applicant for the trade mark.

(b) As concerns the earlier mark or the earlier right on which the opposition is based -

(i) Where the opposition is based on an earlier mark, a statement to that effect and an indication of the status of earlier mark;

(ii) Where available, the application number or registration number and the filing date, including the priority date of the earlier mark;

(iii) Where the opposition is based on an earlier mark which is alleged to be a well-known trade mark within the meaning of sub-section 2 of section 11 of the Act, an indication to that effect and an indication of the country or countries in which the earlier mark is recognised to be well known;

(iv) where the opposition is based on an earlier trade mark having a reputation within the meaning of paragraph (b) of sub-clause (2) of section 11 of the Act, an indication to that effect and an indication of whether the earlier mark is registered or applied for;

(v) A representation of the mark of the opponent and where appropriate, a description of the mark or earlier right; and

(vi) Where the goods or services in respect of which earlier mark has been registered or applied for or in respect of which the earlier mark is well known within the meaning of Sub-section (2) of section 11 or has a reputation within the meaning of that section the opponent shall when indicating all the goods or services for which the earlier mark is protected, also indicate those goods or services on which the opposition is based.

(c) As concerns the opposing party –

(i) where the opposition is entered by the proprietor of the earlier mark or of the earlier right, his name and address and an indication that he is the proprietor of such mark or right;

(ii) where opposition is entered by a licensee not being a registered user, the name of the licensee and his address and an indication that he has been authorised to enter the opposition ;

(iii) where the opposition is entered by the successor in title to the registered proprietor of a trade mark who has not yet been registered as new proprietor, an indication to that effect, the name and address of the opposing party and an indication of the date on which the application for registration of the new proprietor was received by the appropriate office or, where this information is not available, was sent to the appropriate office; and

(iv) where the opposing party has no place of business in India, the name of the opponents and his address for service in India.

(d) The grounds on which the opposition is based.

(e) (i) the notice of opposition shall be verified at the foot by the opponent or by some other person who is acquainted with the facts of the case.

(ii) the person verifying shall state specifically by reference to the numbered paragraphs of the notice of opposition, what he verifies of his own knowledge and what he verifies upon information received and believed to be true.

(iii) the verification shall be signed by the person making it and shall state the date on which and the place at which it was signed.

**49. Counterstatement.-** (1) The counterstatement required by sub-section (2) of section 21 shall be sent in triplicate in Form TM-6 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.

(2) The counterstatement shall be verified in the same manner as the notice of opposition as stated in sub-rule(e) of rule 48.

**50. Evidence in support of opposition.-** (1) Within two months from services on him of a copy of the counterstatement or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce 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 that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.

(2) If an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition.

(3) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.

**51. 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 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 relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies thereof.

(2) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.

**52. Evidence in reply by opponent.-** Within one month from the receipt by the opponent of the copies of the applicant's affidavit or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request in Form TM-56 allow, the opponent may leave with the Registrar evidence by affidavit in reply and shall deliver to the applicant copies thereof. This evidence shall be confined to matters strictly in reply.

**53. Further evidence.-** No further evidence shall be left on either side, but in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit.

**54. Exhibits.-** Where there are exhibits to affidavits filed in an opposition a copy or impression of each exhibit shall be sent to the other party on his request and at his expense, or, if such copies or impression cannot conveniently be furnished, the originals shall be left with the Registrar in order that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

**55. Translation of documents.-** Where a document is in a language other than Hindi or English and is referred to in the notice of opposition, counterstatement or an affidavit filed in an opposition proceeding, an attested translation thereof in Hindi or English shall be furnished in duplicate.

**56. Hearing and decision.-** (1) Upon completion of the evidence (if any), the Registrar shall give notice to the parties of the first date of hearing. Such notice shall be ordinarily given within three months of completion of the evidence. The date of hearing shall be for a date at least one month after the date of the first notice. Within fourteen days from the receipt of the first notice, any party who intends to appear shall so notify the Registrar in Form TM-7. Any party who does not so notify the Registrar within the time as aforesaid may be treated as not desiring to be heard and the Registrar may act accordingly in the matter.

(2) If sufficient cause for adjournment is not shown by either of the parties the Registrar may proceed with the matter forthwith.

(3) If the applicant is not present at the adjourned date of hearing and has not notified his intention to attend the hearing in Form TM-7, the application may be treated as abandoned.

(4) If the opponent is not present at the adjourned date of hearing and has not notified his intention to attend the hearing in Form TM-7, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to Section 19.

(5) In every case of adjournment the Registrar shall fix a day for further hearing of the case and shall make such order as to cost occasioned by the adjournment or such higher costs as the Registrar deems fit.

(6) The fact that the agent or advocate on record of a party is engaged in another court, shall not be a ground for adjournment.

(7) Where illness of legal practitioner or an agent or his inability to conduct the case for any reason is put forward as a ground for adjournment, the Registrar may refuse to grant the adjournment unless he is satisfied that the legal practitioner or an agent, as the case may be, could not have engaged another agent or legal practitioner in time.

(8) The Registrar shall take on record written arguments if submitted by a party to the proceeding.

(9) The decision of the Registrar shall be notified to the parties in writing.

**57. Security for costs.-** The security for costs which the Registrar may require under sub-section (6) of section 21 may be fixed at any amount which he may consider proper, and such amount may be further enhanced by him at any stage in the opposition proceedings.

**58. Procedure for giving notice.-** The notice which the Registrar is required by sub-section(3) of section 23 to give to an applicant, shall be sent in Form O-1 to the applicant at the address of his principal place of business in India or if he has no principal place of business in India at the address for service in India stated in the application but if the applicant has authorised an agent for the purpose of the application, the notice shall be sent to the agent and a duplicate thereof to the applicant. The notice shall specify twenty one days time from the date thereof or such further time not exceeding one month as the Registrar may allow on a request made in the prescribed form for completion of the registration.

## REGISTRATION

**59. Entry in the Register.-** (1) Where no notice of opposition to an application advertised or re-advertised in the Journal is filed within the period specified in sub-section (1) of section 21, or where an opposition is filed and it is dismissed, the Registrar shall, subject to the provisions of sub-section (1) of section 23 or section 19, enter the trade mark on the register.

(2) The entry of a trade mark in the register shall specify the date of filing of application, the actual date of the registration, the goods or services and the class or classes in respect of which it is registered, and all particulars required by sub-section (1) of section 6 including -

(a) the address of the principal place of business in India, if any, of the proprietor of the trade mark or in the case of a jointly owned trade mark, of such of the joint proprietors of the trade mark as have a principal place of business in India;

(b) where the proprietor of the trade mark 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;

(c) in the case of a jointly owned trade mark, where none of the joint proprietors has a principal 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;

(d) particulars of the trade, business, profession, occupation or other description of the proprietor or, in the case of a jointly owned trade mark, of the joint proprietors of the trade mark as entered in the application for registration;

(e) particulars affecting the scope of the registration or the rights conferred by the registration;

(f) the convention application date (if any), to be accorded pursuant to an application from applicants of a convention country made under section 154.

(g) where the mark is a collective or certification mark, that fact;

(h) where the mark is registered pursuant to sub-section 4 of section 11 with the consent of the proprietor of an earlier trade mark or other earlier right, that fact; and

(i). the appropriate office of the Trade Marks Registry in relation to the trade mark.

(3) The Registrar may from time to time, in consultation with computer experts, formulate guidelines for keeping official records in electronic form.

**60. Associated marks.-** (1) Where a trade mark is registered as associated with any other marks, the Registrar shall note in the register in connection with the first mentioned mark the registration numbers of the marks with which it is associated and shall also note in the register in connection with each of the associated marks the registration number of the first mentioned mark as being a mark associated therewith.

(2) An application under sub-section (5) of section 16 to dissolve the association as respects any of the trade marks registered as associated trade marks shall be made in Form TM-14 and shall include statement of the grounds of the application.

**61. Death of applicant before registration.-** In case of death of any applicant for the registration of a trade mark after the date of his application and before the trade mark has been entered in the register, the Registrar may, on proof of the applicant's death and on proof of the transmission of the interest of the deceased person, substitute in the application his successor in interest in place of the name of such deceased applicant and the application may proceed thereafter as so amended.

**62. Certificate of registration.-** (1) The certificate of registration of a trade mark to be issued by the Registrar under sub-section (2) of section 23 shall be in Form O-2. with such modification as the circumstances of any case may require, and the Registrar shall annex a copy of the trade mark to the certificate.

(2) The certificate of registration referred to in sub-rule (1) shall not be used in legal proceedings or for obtaining registration abroad.

(3) The Registrar may issue a duplicate or further copies of the certificate of registration on request by the registered proprietor in Form TM-59 accompanied by the prescribed fee. An unmounted representation of the mark exactly as shown in the form of application for registration thereof at the time of registration shall accompany such request.

**63. Renewal of registration.-** (1) An application for the renewal of the registration of a trade mark shall be made in Form TM-12 and may be made

at any time not more than six months before the expiration of the last registration of the trade mark.

(2) Such application for renewal may be filed by the person who is the proprietor of the registered trade mark or his agent.

(3) If the proprietor, as set forth in the application for renewal is not the same person or the same legal entity as the registered proprietor, continuity of title from the registered proprietor in whose name the last renewal was effected to the present owner shall be shown in the first instance by way of affidavit along with supporting chain of documents.

(4) The Registrar may accept an application for renewal from the managing trustee, executors, administrators and the like, when supported by court order or other evidence of authority to act on behalf of the present proprietor.

**64. Notice before removal of trade mark from register.-** (1) At a date not less than one month and not more than three months before the expiration of the last registration of a trade mark, if no application in Form TM-12 for renewal of the registration together with the prescribed fee has been received, the Registrar shall notify the registered proprietor or in the case of a jointly registered trade mark each of the joint registered proprietors and each registered user, if any, in writing in Form O-3 of the approaching expiration at the address of their respective principal places of business in India as entered in the register or where such registered proprietor or registered user has no principal place of business in India at his address for service in India entered in the Register.

(2) Where, in the case of a mark the registration of which (by reference to the date of application for registration) becomes due for renewal, the mark is registered at any time within six months before the date on which renewal is due, the registration may be renewed by the payment of the renewal fee within six months after the actual date of registration and where the renewal fee is not paid within that period the Registrar shall subject to rule 66, remove the mark from the register.

(3) Where, in the case of a mark the registration of which (by reference to the date of application for registration) becomes due for renewal, the mark is registered after the date of renewal, the registration may be renewed by the payment of the renewal fee within six months of the actual date of registration and where the renewal fee is not paid within that period the Registrar shall, subject to rule 66, remove the mark from the register.

(4) The renewal of registration of a collective mark or a certification trade mark shall be in Form TM-12 with the prescribed fee specified in the First Schedule.

**65. Advertisement of removal of trade mark from the register.-** If at the expiration of last registration of a trade mark, the renewal fees has not been paid, the Registrar may remove the trade mark from the register and advertise the fact forthwith in the Journal:

**Provided that** the Registrar shall not remove the trade mark from the register if an application is made for payment of surcharge under proviso to sub-section (3) of section 25 in Form TM-10 within six months from the expiration of the last registration of the trade mark.

**66. Restoration and renewal of registration.-** An application for the restoration of a trade mark to the register and renewal of its registration under sub-section (4) of section 25, shall be made in Form TM-13 within one year from the expiration of the last registration of the trade mark accompanied by the prescribed fee. The Registrar shall, while considering the request for such restoration and renewal have regard to the interest of other affected persons.

**67. Notice and advertisement of renewal and restoration.-** Upon the renewal or restoration and renewal of registration, a notice to that effect shall be sent to the registered proprietor and every registered user and the renewal or restoration and renewal shall be advertised in the Journal.

**68. Application for entry of assignment or transmission.-** An application to register the title of a person who becomes entitled by assignment or transmission to a registered trade mark shall be made in Form TM-24 or TM-23 according as it is made by such person alone or conjointly with the registered proprietor.

**69. Particulars to be stated in application.-** An application under rule 68 shall contain full particulars of the instrument, if any, under which the applicant, or, in the case of a joint application, the person other than the registered proprietor claims to be entitled to the trade mark and such instrument or a duly certified copy thereof shall be produced at the Trade Marks Registry for inspection at the time of application. The Registrar may require and retain an attested copy of any instrument produced for inspection in proof of title.

**70. Case accompanying application.-** Where a person applying under rule 68 for registration of his title, does not establish his claim under any

document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, either upon or with the application, state a case setting forth the full particulars of the facts upon which his claim to be proprietor of the trade mark is based, and showing that the trade mark has been assigned or transmitted to him. If the Registrar so requires, the case shall be verified by an affidavit in Form TM-18

**71. Proof of title.-** The Registrar may call upon any person who applies to be registered as proprietor of a registered trade mark to furnish such proof or additional proof of title as he may require for his satisfaction.

**72. Impounding of Instruments.-** If in the opinion of the Registrar any instrument produced in proof of title of a person is not properly or sufficiently stamped, the Registrar shall impound and deal with it in the manner provided by Chapter IV of the Indian Stamp Act, 1899 (2 of 1899).

**73. Assignments involving transmission of moneys outside India.-** If there is in force any law regulating the transmission of moneys outside India, the Registrar shall not register the title of a person who becomes entitled to a trade mark by an assignment which involves such transmission except on production of the permission of the authority specified in such law for such transmission.

**74. Application for Registrar's direction as to advertisement of an assignment of a trade mark without goodwill of the business.-** (1) An application for directions under section 42 shall be made in Form TM-20 and shall state the date on which the assignment was made. The application shall give particulars of the registration in the case of a registered trade mark, and in the case of an unregistered mark shall show the mark and give particulars including user of the unregistered trade mark that has been assigned therewith. The Registrar may call for any evidence or further information and if he is satisfied with regard to the various matters he shall issue directions in writing with respect to the advertisement of the assignment.

(2) The Registrar may refuse to consider such an application in a case to which section 41 applies, unless his approval has been obtained under the said section and a reference identifying the Registrar's notification of approval is included in the application.

(3) A request for an extension of the period within which the application mentioned in sub-rule (1) may be made shall be made in Form TM-21.

**75. Application for entry of assignment without goodwill.-** An application under rule 68 relating to an assignment of a trade mark in respect of any goods or services shall state -

(a) whether the trade mark had been or was used in the business in any of those goods or services, and

(b) whether the assignment was made otherwise than in connection with the goodwill of that business,

and if both those circumstances subsisted, then the applicant shall leave at the Trade Marks Registry a copy of the directions to advertise the assignment, obtained upon application under rule 74, and such proof, including copies of advertisements or otherwise, as the Registrar may require, to show that his directions have been fulfilled and if the Registrar is not satisfied that the directions have been fulfilled, he shall not proceed with the application.

**76. Separate registration.-** Where pursuant to an application under rule 68, and as the result of a division and separation of the goods or services of a registration or a division and separation of places or markets, different persons become registered separately under the same registration number as subsequent proprietors of a trade mark, each of the resulting separate registrations in the names of those different persons shall be deemed to be a separate registration for all the purposes of the Act.

**77. Registrar's certificate or approval as to certain assignment and transmissions.-** Any person who desires to obtain the Registrar's certificate under sub-section 2 of section 40 or his notification of approval under section 41 shall send to the Registrar with his application in Form TM-17 or Form TM-19, as the case may be, a statement of case in duplicate setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission. The Registrar may call for any evidence or further information that he may consider necessary and the statement of case shall be amended if required to include all the relevant circumstances and shall, if required, be verified by an affidavit. The Registrar, after hearing (if so required) the applicant and any other person whom the Registrar may consider to be interested in the transfer, shall consider the matter and issue a certificate thereon or a notification in writing of approval or disapproval thereof, as the case may be, to the applicant and shall also inform such other person accordingly. Where a statement of case is amended, three copies thereof in its final form shall be left at the Trade Marks Registry. The Registrar shall seal a copy of the statement of case in its final form to the certificate or notification.

**78. Entry in register of particulars of assignment.-** Where the Registrar has allowed the assignment of a trade mark under this Act, there shall be entered in the register the following particulars of assignment, namely:

- (i) the name and address of the assignee;
- (ii) the date of the assignment;
- (iii) where the assignment is in respect of any right in the mark, a description of the right assigned;
- (iv) the basis under which the assignment is made; and
- (v) the date on which the entry is made in the register

**79. Registration of assignment to a company under section 46.-** For the purposes of sub-section (4) of section 46, the period within which a company may be registered as the subsequent proprietor of a registered trade mark upon application made under rule 68 shall be six months from the date of advertisement in the Journal of the registration of the trade mark or such further period not exceeding six months as the Registrar may allow on application being made in Form TM-25 by the applicant for registration of title or the registered proprietor, as the case may be, at any time before or during the period for which the extension can be allowed.

## **CHAPTER V: REGISTERED USERS**

**80. Application for registration as registered user.-** (1) An application to the Registrar for the registration under section 49 of a person as a registered user of a registered trade mark shall be made jointly by that person and the registered proprietor of the trade mark in Form TM-28 and shall be accompanied by the following document-

- (a) the agreement in writing or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark;
- (b) the documents and correspondence, if any mentioned in the agreement referred to in clause (a) entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark or duly authenticated copies thereof.

(2) There shall be filed along with the application an affidavit made by the registered proprietor or by some person authorised to the satisfaction of the Registrar to act on his behalf testifying to the genuineness of the documents accompanying the application and containing:

(a) the particulars and statements required by clause (b) of sub-section (1) of section 49;

(b) the precise relationship between the registered proprietor and the proposed registered user, if any; for instance, whether their relationship is as principal and subsidiary company or whether there is common control between their business;

(c) a statement as to the goods or services in which the registered proprietor is dealing, together with details as to whether the trade mark which is the subject of the application has been used by him in the course of trade before the date of the application and if so the amount and duration of such user;

(3) The registered proprietor and the proposed registered user shall also produce and file such other documents and furnish such other evidence and information as may be required in that behalf by the Registrar.

(4) No application shall be entertained unless the same has been filed within six months from the date of the agreement referred to in clause (a) of sub-rule (1).

(5) Notwithstanding anything contained in sub-rule (1), where more than one application for registration as registered user is made by the same registered proprietor and the same proposed registered user in respect of trade marks covered by the same agreement, the documents mentioned in sub-rule (1) may be filed with any one of the applications and a cross reference to such documents given in the other application or applications.

**81. Particulars to be stated in the agreement.-** The agreement referred to in clause (a) of sub-rule (1) of the last foregoing rule shall-

(a) set out the particulars specified in sub-clause (i) to (iv) of clause (b) of sub-section (1) of section 49;

(b) disclose the terms as to royalty and other remuneration payable to the registered proprietor by the proposed registered user for the permitted use of the trade mark;

(c) provide means for bringing the permitted use to an end when the

relationship between the parties or the control by the registered proprietor over the permitted use ceases; and

(d) contain a condition that when the registered trade mark is used by the proposed registered user in relation to his goods or services, other than goods or services for export, the mark shall be so described as clearly to indicate that it is being used only by way of permitted use.

**82. Consideration by the Registrar.-**The Registrar under sub-section (2) of section 49, shall, if satisfied that the application and the accompanying documents comply with the relevant provisions of the Act and the rules, and the matters specified in sub-clause (i) to (iv) of clause (b) of sub-section 1 of section 49, register the proposed registered user in respect of the goods or services as to which he is so satisfied.

**83. Hearing before refusing an application or to accept it conditionally.-** (1) The Registrar shall give a notice in writing to the applicants where he proposes to accept the application subject to any conditions, restrictions or limitations. The notice shall state the grounds on which the Registrar proposes to issue such orders and shall inform the applicants that they are entitled to be heard.

(2) Unless within one month from the receipt of the notice mentioned in sub-rule (1) the registered proprietor and the proposed registered user apply for a hearing, the Registrar may refuse the application or to accept it conditionally, as the case may be.

(3) If the registered proprietor and the proposed registered user apply for a hearing the Registrar shall appoint a time for the hearing within two months and shall give them not less than a month's notice of the time so appointed.

(4) After hearing the registered proprietor and the proposed registered user, the Registrar shall decide whether to accept the application or to refuse it or to accept it conditionally.

(5) The Registrar shall, communicate in writing his order on the application to the applicants and to other registered users of the mark, if any.

**84. Entry in the register.-** (1) Where the Registrar under sub-section (2) of section 49 accepts an application for registration as registered user, he shall register the proposed registered user as registered user.

(2) The entry of a registered user in the register shall state the date on which the application for registration of registered user was made, which date shall be deemed to be the date of registration as registered user of the person mentioned in the entry. The entry shall also state, in addition to the particulars and statements mentioned in para (i) to (iv) of sub-clause (b) of clause (1) of section 49, the name, description and principal place of business in India of the registered user and if he does not carry on business in India his address for service in India.

**85. Registration not to imply authorisation to transmit money outside India.-** The registration as registered user of a trade mark,, shall not be deemed to imply an approval of the agreement in so far as it relates to the transmission of any money, as consideration for the use of the said trade mark, to any place outside India.

**86. Notification of registration as registered user.-** A notification in writing of the registration of a registered user shall be sent by the Registrar to the registered proprietor of the trade mark, to the registered user and to every other registered user whose name is entered in relation to the same trade mark and shall also be inserted in the Journal within three months of such entry in the register.

**87. Registered proprietor's application to vary entry.-** An application by the registered proprietor of a trade mark for the variation of the registration of a registered user of that trade mark under clause (a) of sub-section (1) of section 50 shall be made in Form TM-29 and shall be accompanied by a statement of the grounds on which it is made, and where the registered user in question consents, by the written consent of the registered user.

**88. Cancellation of registration of registered user.-** (1) An application for the cancellation of the registration of a registered user under sub-clause (b) to sub-clause (d) of sub-rule (1) of Section 50 shall be made in Form TM-30 or Form TM-31, as the case may be, and shall be accompanied by a statement of the grounds on which it is made.

(2) In case of the registration of a registered user for a period, in accordance with paragraph (iv) of sub-clause (b) of sub-section (1) of section 49, the Registrar shall cancel the entry of the registered user at the end of that period. Where some or all the goods or services are omitted from those in respect of which a trade mark is registered, the Registrar shall at the same time omit them from those specifications of registered users of the trade mark in which they are comprised. The Registrar shall notify every cancellation or omission under this sub-rule to the registered users whose

permitted use is effected thereby and to the registered proprietor of the trade mark.

**89. Power of the Registrar to call for information with respect to registered user.-** The Registrar may at any time, by notice in writing, require the registered proprietor to furnish him information under sub-section (1) of section 51 and take action in accordance with sub-section (2) of that section.

**90. Procedure on application to vary entry or cancel registration.-** (1) The Registrar shall notify in writing applications under section 50 to the registered proprietor and each registered user (not being the applicant in either case ) of the trade mark.

(2) Any person notified under sub-rule (1) who intends to intervene in the proceedings, shall within one month of the receipt of such notification give notice to the Registrar in Form TM-32 to the effect and shall send therewith a statement of the grounds of his intervention. The Registrar shall thereupon serve or cause to be served copies of such notice and statement on the other parties, namely, the applicant, the registered proprietor, the registered user whose registration is the subject matter of the proceeding in question and any other registered user who intervenes.

(3) In the case of any application made under section 50, the applicant and any person notified under sub-rule (1), may, within such time or times as the Registrar may appoint, leave evidence in support of his case, and the Registrar after giving the parties an opportunity of being heard, may accept or refuse the application or accept it subject to any conditions, amendments, modifications or limitations he may think right to impose and shall inform the parties in writing accordingly.

(4) In the case of an application for varying any registration under paragraph (a) of sub-section (1) of section 50 or cancelling any registration on any of the grounds mentioned in items (i) to (iv) of sub-clause (c) of sub-section (1) of section 50, the Registrar shall consider the application together with any notice in Form TM-32 and statement of case filed and shall dispose of the application and also inform the parties in writing accordingly.

**91. Registered user's application.-** An application under sub-section (2) of section 58 shall be made in Form TM-16 or Form-TM-33 or Form-TM-34 or Form-TM-50 as may be appropriate by a registered user of a trade mark or by such person as may satisfy the Registrar that he is entitled to act in the name of a registered user; and the Registrar may require such evidence by

affidavit or otherwise as he may think fit as to the circumstances in which the application is made.

## **CHAPTER VI: RECTIFICATION AND CORRECTION OF REGISTER ALTERATION OR RECTIFICATION OF REGISTER**

### **92. Application to rectify or remove a trade mark from the register.-**

An application to the Registrar under Section 47, 57, 68 or 77 for the making, expunging or varying of any entry relating to a trade mark or a collective mark or certification trade mark in the register shall be made in triplicate in Form TM-26, or Form TM-43, as the case may be, and shall be accompanied by statement in triplicate setting out fully the nature of the applicant's interest, the facts upon which he bases his case and the relief which he seeks. Where the application is made by a person who is not the registered proprietor of the trade mark in question, the application and the statement aforesaid shall also be left at the Trade Marks Registry triplicate. In case there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered user. A copy each of the application and statement shall be ordinarily transmitted within one month by the Registrar to the registered proprietor and to each of the registered user and to any other person who appears from the register to have an interest in the trade mark. The application shall be verified in the manner prescribed under rule 48(e) for verification of a notice of opposition.