

**LEGAL
ALERT**

**Proposed Amendments to Indian
Trademark Law**

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Draft of the Trademark (Amendment) Rules, 2015 proposing amendment to Trade Marks Rules, 2002 has been issued by Ministry of Commerce and Industry on November 19, 2015 and has invited comments from the public and stakeholders within a period of 30 days from the date on which the Gazette of India, in which this notification is published, made available to the public.

The highlight of the proposed amendment is hundred percent hike in the trademark filing fee.

Some of the notable amendments proposed in the Draft are as under:

100% hike in filing fee:

One of the major changes proposed in the Rule is 100% hike in official filing fee. Filing of a trademark application would cost double to an applicant after such amendment is in place. The Government in order to promote e-filing, streamline the current trademark practice and reduce the work load of trademark office has proposed to add 10% additional fee on the official fee on the application filed physically with the trademark registry. Some of the important changes in the current official fees are as under:

S.No	Fee Payable For	Current Fee (INR)	Fee after Amendment (INR)	
			E-Filing	Physical Filing
1	Application for registering a trademark in one class	4000	8000	8800
2	On counter-statement in answer to a notice of oppsition	1000	2000	2200
3	For renewal of registration of trademark in one class	5000	10000	11000
4	For renewal of registration of trademark when the trademark is not renewed within time	3000	6000	6600
5	For restoration of trademark within 1 year from the expiry date	5000	10000	11000
6	Application for assignment of trademark within 6 month of assignment	5000	10000	11000

7	Application for assignment of trademark within one year of assignment	7500	15000	16500
8	Application for assignment of trademark after one year of assignment	10000	20000	22000
9	Application requesting expedited examination of the application	20000	40000	44000
10	Application requesting inclusion of a mark in the list of well-known trademark		100000	110000

Reduction in number of forms:

The number of forms used for filings various applications has been reduced and there are only 8 forms in totality. This reduction in the forms has been done to simplify the filing process. The list of new forms is as under:

- TM A - Application for registration of any good/services
- TM M - Request for any amendment in application, grounds of decision, expedite examination, request for inclusion of a mark as well-known, authorization of an agent etc
- TM R - All Renewal related matters
- TM C - Application for Search Certificate request
- TM O - All opposition matters
- TM P - Applications to dissolve association, assignment; amendment for description of goods/services, etc
- TM U - Application for Registered users, etc
- TM G - Applications related for Trade mark Agent

Registration of sound mark:

The proposed amendment has provision for filing an application for registration of sound marks. A sound file in MP-3 format not exceeding thirty seconds along with graphical representation of its notation would be required to be submitted with the application.

Statement of user in applications:

Currently, if an application is filed claiming use prior to filing of an application then the Affidavit of use is submitted only when requested by the Examiner. However, under the proposed amendment if the use of trademark is claimed prior to the date of application, the applicant would require to file an affidavit testifying to such use along with supporting documents at the time of filing of application.

Expedited Examination of application:

There is a provision for filing of request for expedited examination of the application under the current trademark act and rules. However, the expedited process ends with the issuance of the examination report by the trademark registry and the applicant filing a response to the same. The application thereafter is processed at a regular pace by the trademark registry. However, the amendment proposes expeditious processing of the application that is scheduling of show cause hearing, if required, the publication of the application and the opposition thereto, if any, till final disposal of the application all to be dealt expeditiously.

Well Known Trademarks:

A notable highlight of the amendment is inclusion of power given to the Registrar of trademark to review an application to include a mark in the list of well-known trademarks. The amendment gives discretionary power to Registrar to decide the criteria for inclusion of a mark in the list of well-known trademark. The amendments also empowers the Registrar to remove the trademark from the list if it is found that a trademark has been erroneously included the list. However, the most remarkable point is the cost required to be paid by the applicant for such inclusion of a mark in the list of well-known trademark. The official fee for the same is one lakh Indian Rupees (INR 100000)

The abovementioned amendments are in draft stage and yet to come into effect. Therefore, it is right time to file trademark application for those who are planning to protect their brand in India before the fee is doubled.

Draft Trade Marks (Amedment) Rules, 2015 can be accessed at link provided below:

http://www.ipindia.nic.in/IPActs_Rules/TMR_Amendment_Rules_2015_19November2015.pdf



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