

# L. S. DAVAR & Co.

## Indian and Foreign Patents & Trade Marks

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Patent and Trademark Attorneys

Globsyn Crystals, Tower – 1, 2<sup>nd</sup> Floor, Block EP

Plot No. 11 & 12, Saltlake, Sector V, Kolkata - 700091

Branch Office (Delhi)  
5/1, Kalkaji Extension  
New Delhi – 110 019  
Telephones : (91) (11) 2641 – 8980  
Telephones : (91) (11) 2643 – 8162  
Telefax : (91) (11) 2923 – 4443



### PROPOSED TRADE MARKS RULES, 2015

The Department of Industrial Policy and Promotion, Ministry of Commerce and Industry vide Notification dated 17<sup>th</sup> November 2015 has certain amendments to the Trade Marks Rules, 2002 by virtue of the powers as conferred by Rule 157 of the Trade Marks Act, 1999. The amended rules would rightly be called the Trade Marks Rules, 2015 upon implementation.

Now, proceeding with the amendments, it may be stated that the term “Authenticated” has been defined in Rule 2 (e) of the new rules, wherein it means *authentication of any electronic record by means of “digital signature” as defined in the Information Technology Act, 2005*. Such inclusion is made to aptly authorize online filing of applications.

Rule 13(3) of the amended rules mentions that *with regard to online filing of the documents, the expression “signing” means digital signature*. This is in furtherance to the increased number of online filing of trademark applications. This procedure not only saves time which otherwise involved queuing up at the Trade Marks Registry to submit forms and fees but also leads to automatic digitization of the application forms and minimizes clerical and manual errors. Moreover, submission of applications in that manner, took much longer time to generate the Official Filing Receipts as the same were first digitized, followed by official stamping, generation of application number and lastly has to be collected from the Registry; the entire process would take 2 weeks. However, as applications when filed online, directly generates the official filing receipts within 2 to 3 working days, thereby saving much time and effort.

There has been an important addition to Rule 20 of the Trade Mark Rules 2002. Sub-clauses (4) and (5) have been duly added stating that withdrawal by the agent from the proceedings or revocation of authorization by the applicant/opponent in respect of a trademark application and opposition, wherein

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Phone: (91) (33) 2357 – 1010 / 12 / 15

Fax: (91) (33) 2357 – 1018 / 19 / 20

Emails: [davar@cal2.vsnl.net.in](mailto:davar@cal2.vsnl.net.in), [lsdavar@vsnl.net](mailto:lsdavar@vsnl.net), [lsdavar@cal2.vsnl.net.in](mailto:lsdavar@cal2.vsnl.net.in), [docketing@lsdavar.in](mailto:docketing@lsdavar.in),  
[mailinfo@lsdavar.in](mailto:mailinfo@lsdavar.in), [lsdavar@ndf.vsnl.net.in](mailto:lsdavar@ndf.vsnl.net.in), [ndf@bol.net.in](mailto:ndf@bol.net.in),

Accounts: [receivables.lsd@gmail.com](mailto:receivables.lsd@gmail.com)

Website: [www.lsdavar.org.in](http://www.lsdavar.org.in)

no principle place of business in India is mentioned, the applicant/opponent shall provide the address for service in India “*within a period of two months from such date of withdrawal or revocation*”. If the applicant fails to provide such address for service within such stipulated time, it shall be deemed that the application/opposition may be abandoned.

The proposed amendment of Rule 21(2) reads as “*the Registrar shall publish a classwise and an alphabetical index of such goods and services, including goods and services of Indian origin*”. Such mandatory mentioning of goods and services will enable the applicants to provide a better specification of their goods/services in their respective trademark applications; this shall also serve as significant information for foreign applicants who intend to extend their business in India.

When a trademark is applied for Copyright Registration by virtue of its containing artistic work (if any), it is imperative that an all-class search be conducted within the records of the Trade Marks Registry to obtain a No-Objection Certificate which is to be submitted at the Copyright Office alongwith the Copyright Application of the subject artistic work. Such search can be conducted by submitting one Form TM-60. Obtaining the certificate is a tedious job in terms of the time taken to issue the same; as a result of which filing the copyright application is delayed. The proposed amendment or the draft Trade Mark rules seeks to provide a solution for the same. Rule 23(3) states that “*the Registrar shall ordinarily within seven working days issue an expedited search certificate under Section 45 (1) of the Copyright Act, 1957 on payment of five times of the ordinary fee for such search*”. Additionally, Rule 23 (4) goes on to mention that before abandoning such request of an all-class search, the Registrar “*shall offer an opportunity of being heard in the matter*”.

When a trademark application is filed at the Indian Trade Marks Registry, it is mandatory to provide the date of first use of the subject trademark. In case the mark has not been used, it may be filed as “**proposed to used**” i.e. with the intention of using the mark in recent future. But in cases where a mark has already been used, such date of first use may be mentioned in the “*User Detail*” column of a trademark application. The present Trade Marks Rules 2002 does not require an Affidavit of Use, unless as directed by the Registrar. However, Rule 26 (2) states that “*in case the use of the trade mark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use alongwith supporting documents*”.

Rule 27 of the draft rules explicates the concept of “Representation of mark”. Rule 27 (3) expounds on the requisites of a three dimensional trademark. It states that “*when the application contains a statement to the effect that the trademark 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 trademark;*
- (ii) *Where, the Registrar considers that the reproduction of the mark furnished by the applicant 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;”*

The draft Trade Mark Rules 2015 for the first time seeks to include in its purview the concept of a Sound Mark. A sound mark is a type of trademark that designates its goods and services by a particular sound. In other words, the sound when heard, seeks to associate itself with the goods and services of the applicants from that of the others. Rule 27 (5) states that “*where an applicant for the registration of a trade mark consists of a sound as a trade mark, the reproduction of the same shall be submitted in the MP3 format not exceeding thirty seconds’ length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations.*”

In the last few years, it has been noted that several thousands of applications that are filed for International Registrations, have sought protection in India as of the allied countries. Moreover, with time it is noticed that Indian Applications are also extending their trademark protection in foreign countries for better and safer trade practices. Keeping such growing trends in mind, a new chapter, namely Chapter IV has been added in the draft rules **63 to 75** as included in this chapter enclosing the Special Provisions relating to protection of trademarks through the International Registration under Madrid Protocol. This chapter basically by virtue of the Doctrine of Transformation and Replacement as available within the theories of International Law seeks to implement necessary legal fictions required to effectively accommodate such filing for International Registration of trademarks.

Lastly, with regard to the proposed fee structure, it may be opined that a significant hike may be expected. Such changes in the official fee will be made available to the public vide a formal notification.

Now, it is to be observed that how effectively such rules are incorporated in the present legislation. The amendments are neither exclusive nor exhaustive.

**Ms. Sulagana Nandy**  
**Attorney at Law (Trademark)**  
**L. S. Davar & Co.**