

THE TRADEMARK RULES, 2017

PART I

CHAPTER I - PRELIMINARY

1. Short title and commencement. –

- (1) These rules may be called the Trade Marks Rules, 2017.
- (2) They shall come into force on date of publication in the official Gazette.

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 as such under section 145 of the Act;
 - (c) “application for registration of a trademark” includes the trademark for goods or services contained in it;
 - (d) “appropriate office of the Trade Marks Registry” means the relevant office of the Trade Marks Registry as specified in rule 4;
 - (e) “class fee” means the fee prescribed for the filing of an application for registration of a trademark in a particular class;
 - (f) “convention country” means a country or group of countries or union of countries or Inter-Governmental organisations of countries declared as such under sub-section (1) of section 154;
 - (g) “convention application” means an application for registration of a trademark 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 application for the registration of a trade mark for separate classes of goods or services;

- (i) “divisional fee” means fee prescribed against entry no. 14 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 trademark for goods or services represented or capable of being represented in paper form and includes representation in digitised form;
- (l) “Journal” means the trademarks Journal made available at official website of Controller General of Patents, Designs and Trade Marks;
- (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 trademark or a collective trademark or a certification trademark, as the case may be and includes an opposition to grant of protection to an international registration designating India and opposition to alteration of registered trademark;
- (p) “principal place of business in India” means the relevant place in India as specified in rule 3;
- (q) “publish” means published in the trademarks Journal made available on the official website of Controller General of Patents, Designs and Trademarks;
- (r) “registered trademark agent” means a trademark agent whose name is actually on the register of trademarks agents maintained under rule 142;
- (s) “renewal” means and includes renewal of registration of a trademark, certification trademark or collective trademark, as the case may be;
- (t) “schedule” means a Schedule to the rules;
- (u) “section” means a section of the Act;
- (v) Small Enterprise means:
 - (i) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub- section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and

(ii) In case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for a medium enterprise under clause (b) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Explanation: “enterprise” means an industrial undertakings or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods in any manner pertain to any industry specified in the first schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engages in providing or rendering or any services or services in such an industry.

(iii) In case of a foreign enterprise, an enterprise which fulfills the requirements as mentioned in clauses (i) and (ii) above.

Explanation: In calculating the investment in the plant and machinery, reference rates of foreign currency of Reserve Bank of India shall prevail.

(w) “specification” means the designation of goods or services in respect of which a trademark or a registered user of a trademark is registered or proposed to be registered;

(x) “Startup” means

(i) an entity in India recognised as a startup by the competent authority under Startup India initiative,

(ii) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation / registration as per Startup India Initiative and submitting declaration to that effect.

Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.

(y) All other words and expressions used but not defined in these rules but defined in the Act or in the Geographical Indications of Goods (Registration and Protection) Act, 1999 (48 of 1999), the Copyright Act, 1957 (14 of 1957) shall have the meanings assigned to them in those 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 trademark —
 - (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 trademark—
 - (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 trademark under section 18 or for giving notice of opposition under section 21 or for making an application for removal of a trademark under section 47 or cancelling or varying the registration of a trademark under section 57 or for any other proceedings under the Act and the rules shall be —

- A. in relation to a trademark 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 trademark 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 trademark or in the case of joint registration, of any of the joint proprietors of the trademark, 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 trademark was made, is situate, and

B. in relation to a trademark 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 trademark 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 trademark 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 trademark 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 trademark shall be deemed to have been transferred to the appropriate office of the Trade Marks Registry.

8. Leaving of documents, etc.

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 trademark on the Register of trademarks 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:

Provided that the Registrar may, by notification in the journal, permit the filing of certain forms or documents, other than the application for the registration of a trademark in any other office of the Trade Marks Registry.

9. Issue of notices etc.

Any notice or communication relating to an application, matter or proceeding under the Act or the rules may be issued by the Head of Office or any other officer authorised by the Registrar.

10. Fees.

(1) The fees to be paid in respect of applications, oppositions, registration, renewal, expedited processing of application or any other matters under the Act and the rules shall be those as specified in the First Schedule.

(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 thereof, it shall be accompanied by the prescribed fee.

(3) Fees may be paid electronically or in cash or sent by money order addressed to the Registrar or by a bank draft issued or by a banker's 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 banker's cheque is received in the office.

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

(5) 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.

11. 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 Schedule shall be satisfied by the use of a replica of that Form containing all 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 or through public notice on official website specify such Forms as are required to be submitted in electronic mode. Thereafter, such Forms shall be completed in such manner as may be laid down by the Registrar so as to permit an automated input of the content into a computer by character recognition or scanning.

12. 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 trademarks, authorised or required by the Act or the rules made thereunder, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar shall be typewritten and printed in Hindi or in English in legible characters with deep permanent ink upon strong paper of A-4 or legal size on one side only, and shall have on the left hand side thereof a margin of not less than four centimeters.

(2) Duplicate documents including copies of trademark 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, of all such 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.

13. Signing of documents.

(1) Any document required to be signed under the Act and the Rules shall be signed by the applicant or opponent or by a person duly authorised for the purpose.

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

(3) In case of online filing of the document, the expression 'Signing' includes digital signature.

14. 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 made thereunder, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar or any other person may be delivered by hand or sent through the post by a prepaid letter or may be submitted electronically in the manner as laid down by the Registrar.

(2) An application or any 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 in 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 after informing the public in the Journal may accept applications, notices, statements, or other documents online through the gateway provided for this purpose, or in case of documents not requiring the payment of a fee, through e-mail to a designated email address for the purpose.

15. 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, and such other particulars as may be necessary for identification.

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

(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.

16. Statement of principal place of business in India in the application.

(1) Every application for registration of a trademark 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, a principal place of business in India and the same shall be the address of the applicant.

(2) Subject to the provisions of rules 17, 18 and 20, 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 trademark, at the address of his principal place of business in India given by him in the application shall be deemed to be properly addressed.

17. Address for service.

(1) Every applicant or opponent or any person concerned in any proceeding under the Act or rules shall furnish to the Registrar an address for service in India comprising of a postal address in India and a valid e-mail address and such address shall be treated as the address for service of such applicant or opponent or person:

Provided that a trademark agent shall also be required to furnish a mobile number registered in India.

(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.

18. Service of Documents by the Registrar.

(1) All communications and documents in relation to application or opposition matter or registered trademark may be served by the Registrar by leaving them at, or sending them by post to the address for service of the party concerned or by email communication.

(2) Any communication or document so sent shall be deemed to have been served, at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the email.

(3) To prove such service, it shall be sufficient to prove that the letter was properly addressed and put into the post or the email communication was sent to the email id provided by the party concerned.

19. Agency.

(1) The authorisation of an agent for the purpose of section 145 shall be executed in Form TM-M.

(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.

(4) In case of withdrawal by the agent from the proceedings or from doing any act for which he has been authorised, in respect of an application or opposition wherein no principle place of business in India is mentioned, the applicant or opponent shall, within a period of two months from the date of such withdrawal, provide an address for service in India. If he fails to provide address for service in India within such period, he shall be deemed to have abandoned the application or opposition, as the case may be.

(5) In case of revocation of authorisation by the applicant or opponent in respect of an application or opposition wherein no principle place of business in India is mentioned, the applicant or opponent, as the case may be, shall provide the address for service in India within a period of two months from such revocation. If he fails to provide address for service in India within such period, he shall be deemed to have abandoned the application or opposition, as the case may be.

20. Classification of goods and service

(1) Classification of goods and service for the purpose of registration of trademark, the goods and services shall be classified as per current edition of "the International Classification of goods and services (NICE classification)" published by the World Intellectual Property Organization (WIPO).

(2) The Registrar shall publish a class wise and an alphabetical index of such goods and services, including goods and services of Indian origin.

21. Preliminary advice by Registrar as to distinctiveness.

An application for preliminary advice by the Registrar under sub-section (1) of Section 133 shall be made in Form TM-M in respect of any goods or services comprised as published by the Registrar under sub-rule (2) of rule 20, along with the fees specified in entry number 14 of the First Schedule and accompanied by one representation of the trademark.

22. Request to Registrar for Search.

(1) Any person may request the Registrar, in Form TM-C 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 trademark 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 trademark 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, the Registrar may call for a statement of requirements from the applicant and if the requirements are not complied with within two months from the date of such calling of the statement, the request on Form TM-C shall be treated as abandoned.

(2) The Registrar may cancel the certificate issued under sub-rule (1) after giving notice and stating the grounds on which the Registrar proposes to cancel the certificate and after providing reasonable opportunity of being heard.

(3) Subject to proviso of sub-rule (1) or sub-rule (2), 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-C on payment of fee specified in First Schedule.

(4) Before abandoning the request in Form TM-C, as the case may be, for non-compliance of the statement of requirements when called for, the Registrar shall provide an opportunity of being heard in the matter.

CHAPTER II - PROCEDURE FOR REGISTRATION OF TRADEMARKS APPLICATION

23. Form and signing of application. —

- (1) An application for the registration of a trademark in respect of specification of goods or services shall be made in TM-A and shall be signed by the applicant or his agent.
- (2) An application for the registration of a trademark, for goods or services shall—
 - (a) explain with sufficient precision, a description by words, of the trademark, if necessary, to determine the right of the applicant;
 - (b) be able to depict the graphical representation of the trademark;
 - (c) be considered as a three dimensional trademark only if the application contains a statement to that effect;
 - (d) be considered as a trademark consisting of a combination of colours only if the application contains a statement to that effect.
- (3) An amendment to divide an application under proviso to section 22 shall be made in Form TM-M.
- (4) An application, not being a series trademark shall be in respect of one trademark only, for as many class or classes of goods or services as may be made.
- (5) 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 trademark which the applicant has made or intends to make if and when it is registered:

Provided that while making an application for registration of a trademarks, the names of goods and services stated in the application shall, as far as may be, correspond to those given in the classification of the goods and services published by the registrar under sub-rule (2) of rule 20.

- (6) Where an applicant files a single application and the Registrar determines that the goods or services applied for fall in class or classes in addition to those applied for, the applicant shall restrict the specification of goods or services to the class or classes already applied for or amend the application to add additional class

or classes by filing an application on Form TM-M and by payment of the appropriate fee:

Provided that in case all the goods or services fall in a class other than the class specified, the registrar may permit the correction of class by filing the request on Form TM-M.

24. Application under convention arrangement.

(1) Where a right to priority is claimed by reason of an application for registration of a trademark duly filed in a convention country under section 154, a certificate by the Registrar or competent authority of that Trade Marks Office shall be submitted with the application for registration of trademark and it shall include the particulars of the trademark, the country or countries and the date or dates of filing of application and such other relevant 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 or countries, the representation of the trademark, and the goods or services covered by the application.

(3) The application shall include a statement indicating the filing date of the filing in 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 that where the applicant files more priority claims than one under section 154 in respect of the same trademark, the Registrar shall take the date of the earlier application in a convention country, as the priority date:

Provided further that such priority date shall not be allowed for the goods and services not covered in the convention application:

Provided also that only a single priority shall be claimed in respect of all the goods or services mentioned in the application for registration of a trademark filed under rule 23(1).

25. Statement of user in applications.

(1) An application to register a trademark shall, unless the trademark 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 all the goods or services mentioned in the application.

(2) In case, the use of the trademark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents.

26. Representation of trademark.

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

(2) Where an application contains a statement to the effect that the applicant wishes to claim combination of colours as a distinctive feature of the trademark, the application shall be accompanied with reproduction of the trademark in that combination of colours.

(3) Where the application contains a statement to the effect that the trademark is a three dimensional trademark, the reproduction of the trademark 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 trademark furnished by the applicant does not sufficiently show the particulars of the three dimensional trademark, he may call upon the applicant to furnish within two months, up to five further different views of the trademark and a description by words of the trademark;

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

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

(ii) If the Registrar considers the different views or description of the trademark referred to in clause (i) 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.

(5) Where an application for the registration of a trademark consists of a sound as a trademark, 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.

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

27. Series Trademarks.

(1) Where an application is made for the registration of trademarks as a series under sub-section (3) of section 15, copies of representation of each trademark of the series shall accompany the application in the manner set forth in rule 26. The Registrar, if satisfied that the trademarks constitute a series, shall proceed further with the applications.

(2) At any time before the publication of the application in the Journal, the applicant applying under sub-rule (1) may request in Form TM-M, for the division of the application into separate application or applications, as the case may be, in respect of one or more trademarks 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 on payment of divisional fees.

28. Transliteration and translation.

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

29. Names and representations of living persons or persons recently dead.

Where the name or representation of any person appears on a trademark, 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 trademark, 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 trademark.

30. Name or description of goods or services on a trademark.

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

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

31. Deficiencies.

Subject to sub-rule (2) of rule 10, where an application for registration of a trademark does not satisfy the requirement of any of the provisions of the Act or rules, the Registrar shall send notice thereof to the applicant to 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 shall be treated as abandoned.

32. Acknowledgement of the Application.

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

33. Examination, Objection to acceptance, hearing.

(1) The Registrar shall cause the application to be examined as per provisions of the Act, wherein a search shall also be conducted amongst the earlier trademarks, registered or applied for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any trademark identical with or deceptively similar to the trademark applied for. The Registrar may cause the re-examination of the application including re-search of earlier trademarks at any time before the acceptance of the application but shall not be bound to do so.

(2) If, on consideration of the application for registration of a trademark and any evidence of use or of distinctiveness or of any other matter which 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 fit to impose under sub-section (4) of section 18, the Registrar shall communicate such objection or proposal in writing to the applicant in the form of an examination report.

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

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

(5) In case the response to the examination report is received within the aforesaid time, the same shall be duly considered and if the Registrar accepts the application for registration, he shall communicate such acceptance to the applicant and cause the application to be advertised as accepted under sub-section (1) of section 20.

(6) If the response to the examination report is not satisfactory or where the applicant has requested for hearing, the registrar shall provide an opportunity of hearing to the applicant and the same shall be conducted as per rule 115.

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

(8) Where the applicant has submitted his reply to the examination report within the aforesaid period or has appeared in the hearing and made his submissions, the Registrar shall pass an appropriate order.

34. Expedited Processing of Application.

(1) The applicant may, after the receipt of the official number of the application, request for expedited processing of application made for the registration of a trademark in Form TM-M on payment of fee as specified in First Schedule. Such an application shall be examined expeditiously and ordinarily within three months

from the date of submission of the application. Thereafter, the following proceedings viz. the consideration of response to the examination report, scheduling of show cause hearing, if required, the publication of the application and the opposition thereto, if any, till final disposal of the application shall also be dealt with expeditiously subject to such guidelines as may be published in this regard by the Registrar in the trademarks Journal.

(2) The Registrar may limit the number of applications for expedited processing of trademark applications by publishing the same in the trademarks Journal.

35. Notice of withdrawal of application for registration.

A notice of withdrawal of an application for the registration of a trademark under sub-section (2) of section 133, 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 (2) of rule 33.

36. Decision of Registrar.

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

(2) In a case where the Registrar makes any requirements to which the applicant does not object the applicant shall comply the said requirement 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 by the applicant, shall be deemed to be the date of the Registrar's decision for the purpose of appeal.

37. Correction and amendment of application.

An applicant for registration of a trademark may, whether before or after acceptance of his application but before the registration of the trademark, apply in Form TM-M 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, no such amendment shall be permitted which shall have the effect of substantially altering the trademark applied for or substitute a new specification of goods or services not included in the application as filed.

38. Withdrawal of acceptance by the Registrar.

(1) If, after the acceptance of an application but before the registration of the trademark, the Registrar has any objection to the acceptance of the application on the ground that it was accepted in error, or that the trademark ought not to have been accepted in the circumstances of the case, or proposes that the trademark 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 fifteen 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 hearing the applicant, on considering the submissions, if any, of the applicant, pass such orders as he may deem fit.

Advertisement of Application

39. Manner of Advertisement.

(1) Every application for the registration of a trademark 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.

40. 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:

Provided that in case of any error in the advertisement in respect of the trademark or specification of goods or services except for any trivial spelling mistake or class or statement of use of the trademark or in any other case as the Registrar thinks fit, the Registrar may advertise the trademark again cancelling the earlier advertisement.

41. Request to Registrar for particulars of advertisement of a trademark.

Any person may request the Registrar in Form TM-M to be informed of the number, and date of the Journal in which a trademark 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

42. Notice of Opposition.

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

(2) Where a notice of opposition has been filed in respect of a single application for the registration of a trademark for different classes of goods and services, it shall bear the fee in respect of each class in relation to which the opposition is filed.

(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-M 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 trademark 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) 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:

Provided that where the applicant has already filed the counter statement on the basis of the copy of notice of opposition made available in the electronic records on the official website, the requirement of service of copy of the notice of opposition to the applicant shall be dispensed with.

43. Requirements of Notice of Opposition.

(1) A notice of opposition shall contain,— (a). in respect of an application against which opposition is entered—

(i) the application number against which opposition is entered;

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

(iii) the name of the applicant for the trademark.

(b). in respect of the earlier trademark or the earlier right on which the opposition is based,—

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

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

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

(iv) where the opposition is based on an earlier trademark 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 trademark is registered or applied for;

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

(vi) Where the goods or services in respect of which earlier trademark has been registered or applied for or in respect of which the earlier trademark 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 trademark is protected, also indicate those goods or services on which the opposition is based.

(c). in respect of the opposing party –

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

(2) A notice of opposition shall be verified at the foot by the opponent or by his duly authorised agent.

(3) 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.

(4) 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.

44. Counterstatement.

(1) The counterstatement required by sub-section (2) of section 21 shall be sent on Form TM-O 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 manner as provided in sub-rules (2), (3) and (4) of rule 43.

45. Evidence in support of opposition.

(1) Within two months from service of a copy of the counterstatement, 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 including exhibits, if any, 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.

46. Evidence in support of application.

(1) Within two months 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 adduces any evidence or relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies of the same, including exhibits, if any, and shall intimate the Registrar in writing of such delivery.

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

47. Evidence in reply by opponent.

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

48. 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.

49. 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 submitted before the registrar and a copy thereof shall be provided to opposite party.

50. Hearing and decision.

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

(2) A party to a proceeding may make a request for adjournment of the hearing with reasonable cause in Form TM-M accompanied by the prescribed fee, at least three days before the date of hearing and the Registrar, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly:

Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.

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

(4) If the opponent is not present at the adjourned date of hearing and at time mentioned in the notice, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to section 19.

(5) The Registrar shall consider written arguments if submitted by a party to the proceeding.

(6) The decision of the Registrar shall be communicated to the parties in writing at the address given for service.

51. 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.

Notice of Non-Completion of Registration

52. 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 RG-1 to the applicant at the address for service. 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 form TM-M for completion of the registration.

Registration

53. 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 trademark on the register.

(2) The entry of a trademark 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 trademark or in the case of a jointly owned trademark, of such of the joint proprietors of the trademark as have a principal place of business in India;

(b) where the proprietor of the trademark has no place of business in India, his address for service in India as entered in the application for registration together with his address in his home country;

(c) in the case of a jointly owned trademark, 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) the particulars of the trade, business, profession, occupation or other description of the proprietor or, in the case of a jointly owned trademark, of the joint proprietors of the trademark 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 trademark is a collective or certification trademark, that fact;
 - (h) where the trademark is registered pursuant to sub-section 4 of section 11 with the consent of the proprietor of an earlier trademark or other earlier right, that fact; and the appropriate office of the Trade Marks Registry in relation to the trademark.
- (3) The Registrar may from time to time, in consultation with computer experts, formulate guidelines for keeping official records in electronic form.

54. Associated trademarks.

(1) Where a trademark is registered as associated with any other trademarks, the Registrar shall note in the register in connection with the first mentioned trademark the registration numbers of the trademarks with which it is associated and shall also note in the register in connection with each of the associated trademarks, the registration number of the first mentioned trademark as being a trademark associated therewith.

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

55. Death of applicant before registration.

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

56. Certificate of registration.

(1) The certificate of registration to be issued by the Registrar under sub-section 2 of section 23 shall be on Form RG-2 and shall include the trademark. It shall bear the seal of the Trade Marks Registry.

(2) The certificate of registration referred to in sub-rule (1) shall not be used in legal proceedings or for obtaining registration abroad. The certificate issued under section 137 shall be used for these purposes.

(3) The Registrar may issue duplicate or further copies of the certificate of registration on request by the registered proprietor in Form TM-M accompanied by the prescribed fee:

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

CHAPTER III - RENEWAL OF REGISTRATION AND RESTORATION

57. Renewal of registration.

(1) An application for the renewal of the registration of a trademark shall be made in Form TM-R along with the fee as prescribed in the first schedule and may be made at any time not more than one year before the expiration of the last registration of the trademark.

(2) A request for renewal of registration of the trademark filed within prescribed time shall be allowed unless the trademark has been removed or cancelled or is otherwise not renewable under any of the provisions of the Act and rules or by any order of the competent court or the Registrar.

58. Notice before removal of trademark from register.

(1) In case no application for renewal of the registration in the prescribed form together with the specified fee has been received, the Registrar shall send, not more than six months before the expiration of registration of the trademark, a notice in Form RG-3 at the address of service informing the registered proprietor of the approaching date of expiration and the conditions, if any, subject to which the renewal of the registration may be obtained.

(2) Where, in the case of a trademark the registration of which (by reference to the date of application for registration) becomes due for renewal, the trademark 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 60, remove the trademark from the register.

(3) Where, in the case of a trademark the registration of which (by reference to the date of application for registration) becomes due for renewal, the trademark 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 60, remove the trademark from the register.

(4) The renewal of registration of a collective trademark or a certification trademark shall be in Form TM-R along with the prescribed fee as specified in the First Schedule.

59. Advertisement of removal of trademark from the register.

If at the expiration of registration of a trademark, the renewal fees has not been paid, the Registrar may remove the trademark from the register and advertise the fact forthwith in the Journal:

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

60. Restoration and renewal of registration.

An application for the restoration of a trademark to the register and renewal of its registration under sub-section (4) of section 25, shall be made in Form TM-R within one year from the expiration of the registration of the trademark 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.

61. 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.

CHAPTER IV - SPECIAL PROVISIONS RELATING TO PROTECTION OF TRADEMARKS THROUGH THE INTERNATIONAL REGISTRATION UNDER MADRID PROTOCOL

62. Definitions.

(1) For the purpose of this Chapter, unless the context otherwise requires, —

(a) 'Article' means article referred to in Madrid Protocol;

(b) "electronic form" shall have the meaning as is assigned to it in clause (r) of sub-section (1) of section 2 of the Information Technology Act, 2000 (21 of 2000);

(2) Words and expressions used in these rules, in the context of international application or international registration under Chapter IVA of the Act, but not defined shall have the same meaning and respectively assigned to them in the Madrid Protocol or the Common Regulations.

63. Language.

An International Application or any communication relating thereto for transmission to International Bureau or any advice by way of notification of extension of protection to India resulting from the international registration shall be in English.

64. Issue of notices or communications etc. and response thereto.

Any notice or communication relating to both an international application under section 36D and international registration where India has been designated, under section 36E, shall be issued by the Registrar only in electronic form, and any response thereto shall also be received likewise.

65. International application in respect of which India is the country of origin.

International application originating from India, or any communication relating thereto in accordance with the Common Regulations shall be filed electronically through the Trade Marks International Application System.

66. Verification and Certification of international application in respect of which India is the country of origin.

(1) Where an international application is filed under section 36D for transmission to the International Bureau, the Registrar shall certify the contents of the application in Form MM2(E) as provided by International Bureau subject to the payment of fees as specified in Entry Number 23 of the First Schedule.

(2) Where the international application complies with the requirements, the Registrar shall so certify in the international application indicating also the date on which the said international application was received; and shall forward the same to the International Bureau within two months from the date of receipt of the said application.

(3) Where the international application does not meet the requirements, the Registrar shall not forward it to the International Bureau, and shall require the applicant by notice to comply with the requirement as specified therein, and shall forward the International Application only after such compliance within the period specified in the notice.

67. Handling fee.

A handling fee as specified in First Schedule shall be payable to the Registrar for certification and transmittal of international application to the International Bureau and such fee shall be paid in Indian rupees electronically along with the application.

68. Manner of keeping the record of international registrations where India has been designated.

(1) On receipt of advice from the International Bureau about an international registration designating India and notification about the extension of protection resulting from such international registration, the Registrar shall enter all the particulars thereof electronically in a record called the 'Record of Particulars of International Registration'. Any change in the particulars as and when received from the International Bureau shall be entered in the said record.

(2) Any entry made in such record shall, to the extent that it applies to India as a designated contracting party, have the same effect as if it had been recorded by the Registrar in the Register of trademarks.

69. Examination of application under section 36E.

(1) The advice referred to in rule 68 shall be examined ordinarily within two months from the date of receipt of such advice.

(2) Where, the Registrar finds that the trademark which is the subject of an international registration designating India, cannot be protected, he shall, before the expiry of refusal period applicable under article 5 of the Madrid Protocol, notify to the International Bureau a provisional refusal of protection.

(3) Where there are no grounds for refusal to grant protection, the Registrar shall advertise the particulars concerning international registration under section 20 of the Act in a separate part of the trademarks Journal ordinarily within a period of six months from the date of receipt of advice.

(4) Where an opposition is filed under section 21 of the Act, the Registrar shall, notify that fact to the International Bureau as a provisional refusal based on the opposition in accordance with the Protocol and Common Regulation.

(5) The international registration, on receipt of an opposition thereto, shall be processed in accordance with the provisions contained in rules 42 to 51.

(6) Where the procedure mentioned under sub-rules (1) to (5) have been completed with and the Registrar has decided to confirm such refusal of protection of the trademark for all the goods or services for which the protection has been requested, the Registrar shall send to the International Bureau a statement to that effect.

(7) Where, the provisional refusal has been either totally or partially withdrawn, the Registrar shall send to the International Bureau

(a) a statement to the effect that the provisional refusal is withdrawn and the protection of the trademark is granted for all the goods or services for which the protection has been requested; or

(b) a statement indicating conditions or limitations subject to which, and the goods or services in respect of which the protection is granted.

(8) Where there is no ground to refuse protection, the Registrar shall notify the International Bureau to the effect that protection is granted to the trademark in India.

(9) Where there is further decision affecting the protection of trademark in India, the Registrar shall send further statement to the International Bureau to that effect.

70. Invalidation of protection.

Where the protection resulting from an international registration has ceased to have effect, or varied, in India, as a result of legal proceedings under the Act, the Registrar shall notify the International Bureau accordingly.

71. Effect of cancellation of international registration.

Where an international registration is cancelled at the request of office of origin, the provisions of article 9 quinquies of the Protocol shall apply to such international registration in so far as it designates India.

72. Collective and Certification Trademarks.

Where an international registration designating India is in respect of a collective trademark or a certification trademark, the regulations governing the use of such collective trademark or certification trademark shall be submitted directly, by the holder of that international registration to the registrar within the period of one month from the date of advice by the International Bureau.

73. Replacement of national registration.

Where an international registration is deemed to replace the registration held in India under sub-section (6) of section 36E of the Act, the registrar shall, upon request of the holder of international registration take note of the international registration and make necessary entry in the Register maintained under sub-section (1) of section 6 of the Act. Thereafter, the Registrar shall notify the International Bureau accordingly under rule 21 of the Common Regulations.

74. Applicability

Subject to provisions of the Act, the provisions of the Madrid Protocol, Common Regulations and Administrative Instructions shall apply in relation to international applications originating from India and international registrations where India has been designated.

CHAPTER V - ASSIGNMENT AND TRANSMISSION

75. 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 trademark shall be made in Form TM-P.

76. Case accompanying application.

(1) A person applying for registration of his title under rule 75, shall, along with his request in form TM-P, file duly certified copy of original document, instrument or deed, as the case may be, purporting to transfer the title in the trademark and a statement of case in support of his request.

(2) The Registrar shall dispose of an application made under rule 75 ordinarily within three month from the date of application and intimate the same to the applicant.

77. Proof of title.

The Registrar may, where there is a reasonable doubt about the veracity of any statement or any document furnished, call upon any person who applies to be registered as proprietor of a registered trademark to furnish such proof or additional proof of title as the Registrar thinks fit.

78. 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).

79. 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 trademark by an assignment which involves such transmission except on production of the permission of the authority specified in such law for such transmission.

80. Application for Registrar's direction as to advertisement of an assignment of a trademark without goodwill of the business.

(1) An application for directions under section 42 shall be made in Form TM-P 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 trademark, and in the case of an unregistered trademark shall show the trademark and give particulars including user of the unregistered trademark 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) shall be made shall be in Form TM-P

81. Application for entry of assignment without goodwill.

An application under rule 75 relating to an assignment of a trademark in respect of any goods or services shall state—

(a) whether the trademark 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 80, 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.

82. Separate registration.

Where pursuant to an application under rule 75, 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 trademark, 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.

83. 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-P, 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.

84. Entry in register, of particulars of assignment.

Where the Registrar has allowed the assignment of a trademark 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 trademark, 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.

85. 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 trademark upon application made under rule 75 shall be six months from the date of advertisement in the Journal of the registration of the trademark or such further period not exceeding six months as the Registrar may allow on application being made in Form TM-P 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 VI - REGISTERED USER

86. 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 trademark, shall be made jointly by that person and the registered proprietor of the trademark in Form TM-U and shall be accompanied by the documents, evidence and details as required in sub-section (1) of section 49.

(2) 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.

(3) 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-section (1) of section 49.

(4) 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 trademarks covered by the same agreement, the documents mentioned in sub-section (1) of section 49 may be filed with any one of the applications and a cross reference to such documents given in the other application or applications.

87. 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, register the proposed registered user in respect of the goods or services as to which he is so satisfied.

88. Hearing before refusing an application or to accept it conditionally.

The Registrar may, after giving an opportunity of hearing to the parties concerned, either refuse the application or accept the same with such condition(s), if any, as he may think fit and shall communicate such order in writing to the parties.

89. 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 and publish the same in the Journal.

(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 paragraphs (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.

90. Registration not to imply authorisation to transmit money outside India.

The registration as registered user of a trademark 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 trademark, to any place outside India.

91. Communication of registration as registered user.

Communication in writing of the registration of a registered user shall be sent by the Registrar to the registered proprietor of the trademark, to the registered user and to every other registered user whose name is entered in relation to the same trademark and shall also be inserted in the Journal within three months of such entry in the register.

92. Registered proprietor's application to vary entry.

An application by the registered proprietor of a trademark for the variation of the registration of a registered user of that trademark under clause (a) of sub-section (1) of section 50 shall be made in Form TM-U and where the registered user has given consent to such variation, a copy of such consent in writing shall also be filed.

93. 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-section (1) of section 50 shall be made in Form TM-U.

(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 trademark is registered, the Registrar shall at the same time omit them from those specifications of registered users of the trademark 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 affected thereby and to the registered proprietor of the trademark.

94. 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.

95. 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 trademark.

(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-U 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-U and statement of case filed and shall dispose of the application and also inform the parties in writing accordingly.

96. Registered user's application.

An Application under sub-section (2) of section 58 shall be made in Form TM-P by a registered user of a trademark or by a person duly authorised by the registered user in that behalf; and the Registrar may require such evidence as he may think fit as to the circumstances in which the application is made.

CHAPTER VII - RECTIFICATION AND CORRECTION OF REGISTER ALTERATION OR RECTIFICATION OF REGISTER

97. Application to rectify or remove a trademark 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 trademark or a collective trademark or certification trademark in the register shall be made in Form TM-O, as the case may be, and shall be accompanied by statement in 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 trademark in question, the application and the statement aforesaid shall be left at the Trade Marks Registry. In case there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered users. 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 trademark. The application shall be verified in the manner prescribed under clause (i) of sub-rule (c) of rule 43 for verification of a notice of opposition.

98. Further procedure.

Within two months from the receipt by a registered proprietor of the copy of the application mentioned in rule 97 or within such further period not exceeding one month in the aggregate, he shall send to the Registrar on Form TM-O a counterstatement of the grounds on which the application is contested and if he does so, the Registrar shall serve a copy of the counterstatement on the person making the application within one month of the receipt of the same. In case no counter statement has been filed within the period of three months from the date of receipt of the application mentioned in rule 97, the applicant for rectification shall file evidence in support of his application for rectification under the provisions of rules 45 (1). The provision under rule 46 to 51 shall thereafter apply mutatis mutandis to the further proceedings on the application.

99. Intervention by third parties.

Any person, other than the registered proprietor, alleging interest in a registered trademark in respect of which an application is made under rule 97 may apply on Form TM-O for leave to intervene, stating the nature of his interest, and the Registrar may refuse or grant such leave after hearing (if so required) the parties concerned,

upon such conditions and terms including undertakings or conditions as to security for cost as he may deem fit to impose.

100. Rectification of the register by the Registrar of his own motion.

(1) The Notice, which the Registrar is required to issue under sub-section (4) of section 57, shall be sent in writing to the registered proprietor, to each registered user, if any, and to any other person who appears from the register to have any interest in the trademark, and shall state the grounds on which the Registrar proposes to rectify the register and shall also specify the time, not being less than one month from the date of such notice, within which an application for a hearing shall be made:

Provided that no notice shall be required to be sent to the registered proprietor, in case the registered proprietor has requested or agreed in writing for cancellation of the registration; and thereupon register shall be rectified accordingly.

(2) Unless within the time specified in the notice aforesaid, any person so notified sends to the Registrar a statement in writing setting out fully the facts upon which he relies to meet the grounds stated in the notice or applies for a hearing, he may be treated as not desiring to take part in the proceedings and the Registrar may act accordingly.

(3) If the Registrar decides to rectify the register he shall communicate his decision in writing to the registered proprietor and to each registered user, if any.

Alteration or Correction in Register

101. Alteration of address in register.

(1) A registered proprietor or a registered user of a trademark, the address of whose principal place of business in India or whose address in his home country as the case may be or address for service in India, is changed so that the entry in the register is rendered incorrect, shall forthwith request the Registrar in Form TM-P to make the appropriate alteration of the address in the register, and the Registrar shall alter the register accordingly if he is satisfied in the matter.

(2) A registered proprietor or a registered user of a trademark the address of whose principal place of business in India or whose address for service in India is altered by a public authority, so that the changed address designates the same premises as entered in the register, may make the aforesaid request to the Registrar on Form TM-P or as the case may be, and if he does so he shall leave therewith a

certificate of the alteration given by the said authority. If the Registrar is satisfied, as to the facts of the case, he shall alter the register accordingly but shall not require any fees to be paid on the forms, notwithstanding the provisions of sub-rule (2) of rule 10 or sub-rule (2) of rule 11.

(3)(i) Where a registered proprietor makes a request under sub-rule (1) or (2), he shall serve a copy of the request on the registered user or users, if any, and inform the Registrar accordingly.

(ii) where the request aforesaid is made by a registered user, he shall serve a copy thereof on the registered proprietor and every other registered users, if any, and inform the Registrar that he had done so.

(4) In case of the alteration of the address of a person entered in the register as the address for service in India of more than one registered proprietor or registered user of trademarks, the Registrar may, on proof that the said address is the address of the applicant and if satisfied that it is just to do so, accept an application from the person in Form TM-P so as to suit the case, for the appropriate alteration of the entries of his address as the address for service in the several registrations, particulars of which shall be given in the Form and may alter the entries accordingly.

(5) All applications under this rule on Form TM-P shall be signed by the registered proprietor or the registered user, as the case may be, or by an agent authorised by him.

(6) Where an application has been made under sub-section (1) of section 58 for the alteration of the register by correction, change, cancellation or striking out of goods or services or for the entry of a memorandum, the Registrar may require the applicant to furnish such evidence by affidavit or otherwise as the Registrar may think fit, as to the circumstances in which the application is made. Such application shall be made in Form TM-P and a copy thereof shall be served by the applicant on the registered user or users, if any, under the registration of the trademark in question and to any other person who appears from the register to have an interest in the trademark.

102. Alteration of registered trademark.

Where a person applies under section 59 for leave to add to or alter his registered trademark, he shall make the application in writing in Form TM-P and shall furnish copy of the trademark as it will appear when so added to or altered. A copy of the

application and of the trademark so amended or altered shall be served by the applicant on every registered user, if any.

103. Advertisement before decision and opposition etc.

(1) The Registrar shall consider the application made under rule 102 and shall, if it appears to him expedient, publish the application in the Journal before deciding it.

(2) Within three months from the date of advertisement under sub-rule (1), any person may give notice of opposition to the application in Form TM-O. A copy of the notice shall be transmitted forthwith by the Registrar to the registered proprietor and each registered user, if any, and within two months from the receipt by the registered proprietor of such copies he shall send to the Registrar in Form TM-O a counter statement of the grounds on which the opposition is contested. If the registered proprietor sends such a counterstatement, the Registrar shall ordinarily serve a copy thereof on the person giving notice of opposition within one month and the provisions of rules 45 to 51 shall apply mutatis mutandis to the further proceedings on the opposition:

Provided that where the registered proprietor fails to file the counter statement within the specified time, the application shall be deemed to have been abandoned.

(3) If there is no opposition, within the time specified in sub-rule (2), the Registrar shall, after hearing the applicant if he so desires, allow or refuse the application and shall communicate his decision in writing to the applicant.

104. Decision, Advertisement, Notification.

If the Registrar decides to allow the application he shall alter the trademark in the register accordingly and publish in the Journal a notification that the trademark has been altered along with trademark as altered.

Re-classification of Goods in Respect of Existing Registration

105. Re-classification in respect of existing registration.

(1) On the amendment in international classification of goods and services (NICE Classification), the registered proprietor of a trademark may apply to the Registrar in Form TM-P for the conversion of the specification of goods and services relating to the trademark, so as to bring that specification into conformity with the amended classification.

(2) The Registrar may, thereupon, amend the description of goods and services or the classification as the case may be in accordance with international classification of goods and services (NICE Classification).

(3) The amendment in the specification of goods or services or in the classification if approved shall be advertised in the Journal; thereafter the entry in the register in respect of that registration shall be modified accordingly.

CHAPTER VIII - MISCELLANEOUS

106. Refusal or invalidation of registration of a trademark conflicting with a geographical indication.

A request in Form TM-O, may be made to the Registrar for the refusal or invalidation of a registered trademark by an interested party along with a statement of case together with an affidavit and which—

(a) contains or consists of a geographical indication with respect to goods or class or classes of goods not originating in the territory of a country, or a region or locality in that territory which such geographical indication indicates, if the use of such geographical indication in the trademark for such goods, is of such nature as to confuse or mislead the persons as to the true place of origin of such goods or class or classes of goods;

(b) contains or consists of geographical indication identifying goods or class or classes of goods notified under sub-section (2) of section 22 of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (48 of 1999).

107. Single application under sub-section (2) of section 18.

(1) Where an application for the registration of a trademark for different classes of goods or services is made under sub-section (2) of section 18, the specification of goods or services contained in it shall set out the classes in consecutive numerical order beginning with the lowest number and indicate in each class the goods or services appropriate to that class.

(2) Applications filed under sub-section (2) of section 18 when ordered to be advertised shall be published in a separate section of the Journal.

(3) The Registrar shall issue a single certificate of registration in respect of an application made under sub-section (2) of section 18, which has proceeded to registration.

108. Divisional Application.

(1) Where an application is made in Form TM-M under proviso to section 22 for the division of a single pending application, the registrar may, on payment of a divisional fee, divide such application into two or more separate applications.

(2) In case of division of application, The Registrar shall treat each divisional application as a separate application for registration with the same filing date as the initial application.

(3) Any time limit for any action by the applicant in relation to the initial application at the time of division shall be applicable to each new separate application created by division irrespective of the date of the division.

(4) In case of division of application, the Registrar shall assign an additional separate new serial number or numbers, as the case may be, and it shall be cross-referenced with the initial application.

(5) For the removal of doubt, it is clarified that no new registration shall be effected when a single application is divided. On the contrary, application already filed shall be merely separated or divided into individual files.

109. Extension of time

(1) An application for extension of time under section 131 (not being a time expressly provided in the Act or prescribed by rule 85 or by sub-rule (3) of rule 86 or a time for the extension of which provision is made in the rules) shall be made in Form TM-M.

(2) Upon an application made under sub-rule (1) the Registrar, if satisfied that the circumstances are such as to justify the extension of the time applied for, may, subject to the provisions of the rules where a maximum time limit is prescribed and subject to such conditions as he may think fit to impose, extend the time not exceeding one month and communicate the parties accordingly and the extension may be granted though the time for doing the act or taking the proceeding for which it is applied for has already expired.

110. Exercise of discretionary power of Registrar.

Any person who has applied for the exercise of discretionary or other power of the Registrar and requires a hearing under section 128, shall inform the Registrar in writing of his intention to be heard within one month from the date of notice which the registrar shall give to such person before determining the matter. Upon the

receipt of such information, if any, the Registrar shall appoint a date of hearing of not less than twenty one days and give notice thereof.

111. Communication of decision.

The decision of the Registrar in the exercise of any discretionary power given to him by the Act or the rules shall be communicated to the person affected.

112. Amendments and correction of irregularity in procedure.

(1) Any document or drawing or other representation of a trade mark may be amended, and any irregularity in procedure which, in the opinion of the Registrar, may be obviated without detriment to the interests of any person, may be corrected.

(2) The Registrar may require the amendment of any application or representation of a trade mark or any other document or the addition of any matter thereto in order to bring it in accordance with the formal requirements of the Act.

113. Directions not otherwise prescribed

Where in the opinion of the Registrar, it is necessary for the proper prosecution or completion of any proceedings under the Act or rules for a person to perform an act, file a document or produce evidence, which is not provided for by the Act or the rules, the Registrar may by notice in writing require the person to perform the act, file the document or produce the evidence, specified in the notice.

114. Opinion of the Registrar under section 115(4).

(1) Where a matter has been referred to the Registrar for his opinion under proviso to sub-section (4) of section 115 such opinion shall be forwarded under a sealed cover within seven working days of the receipt of such written intimation to the referring authority and the Registrar shall ensure complete confidentiality in the matter so referred.

(2) The opinion under this rule shall be given by the Registrar or an officer specially authorised for this purpose under sub-section (2) of section 3 and the name of the designated officer shall be published in the journal.

115. Hearings.

(1) The hearing if any, in relation to any proceeding under the Act and rules may be held at the notified date and time and at such place within the territorial jurisdiction of the appropriate office as the Registrar may think fit:

Provide that the hearing may also be held through video- conferencing or through any other audio-visual communication devices and in such cases the hearing shall be deemed to have taken place at the appropriate office.

Explanation - For the purposes of this rule, the expression "communication device" has the same meaning as assigned to it in clause (ha) of sub section (ii) of section 2 of the Information Technology Act,2000 (21 of 2000).

(2) Where an officer exercising the powers of the Registrar who has heard any matter under the Act or the rules, has reserved orders therein, is transferred from one office of the Registry to another or reverts to another appointment before passing an order or rendering decision therein, he may, if the Registrar so directs, pass the order or render the decision as if he had continued to be the officer in the office of the Trade Marks Registry where the matter was heard.

Awards of Costs by Registrar

116. Costs in uncontested cases.

(1) Where a reasonable notice has been given to an applicant by the opponent before filing the notice of opposition and the applicant fails to contest the opposition, the Registrar may impose such costs on the applicant as may be specified in Forth Schedule.

(2) Where an opposition has been filed and the opponent fails to contest the proceedings after the applicant has filed counter statement, the Registrar may impose such costs on the opponent as may be specified in Forth Schedule.

117. Exception to rule 116.

Notwithstanding anything in rule 116, costs in respect of fees specified under entries, 10 and 11 of the First Schedule and of all stamps used on and affixed to affidavits used in the proceedings shall follow the event.

118. Scale of costs.

Subject to the provisions of rules 116 and 117, in all proceedings before the Registrar, he may, save as otherwise expressly provided by the Act, award such costs, not exceeding the amount admissible thereof under the Forth Schedule, as he considers reasonable having regard to all the circumstances of the case.

Review of Decisions of the Registrar

119. Application for review of Registrar's decision.

An application to the Registrar for the review of his decision under sub-section (c) of section 127 shall be made in Form TM-M within one month from the date of such decision or within such further period not exceeding one month thereafter as the Registrar may on request allow, and shall be accompanied by a statement setting forth the grounds on which the review is sought. Where the decision in question concerns any other person in addition to the applicant, such application and statement shall be left in triplicate and the Registrar shall forthwith transmit a copy each of the application and statement to the other person concerned. The Registrar may, after giving the parties an opportunity of being heard, reject or grant the application, either unconditionally or subject to any conditions or limitations, as he thinks fit.

Affidavit

120. Form, etc; of Affidavits.

(1) The Affidavits required by the Act and the rules to be filed at the Trade Marks Registry or furnished to the Registrar, unless otherwise provided in the Second Schedule, shall be headed in the matter or matters to which they relate, shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered; and each paragraph shall, as far as practicable, be confined to one subject. Every affidavit shall state the description and the true place of abode of the person making the same and shall bear the name and address of the person filing it and shall state on whose behalf it is filed.

(2) Where two or more persons join in an affidavit, each of them shall depose separately to such facts which are within his personal knowledge and those facts shall be stated in separate paragraphs.

(3) Affidavits –

(a) In India, before any court or before any officer empowered such to administer oaths or to take affidavits or before the Registrar or before the Notary Public.

(b) In any country or place outside India, before a diplomatic or consular officer, within the meaning of the Diplomatic and Consular Officers (Oaths and Fee) Act, 1948 (41 of 1948), of such country or place or before a notary public or before a Judge or Magistrate, of the country or place.

(4) The person before whom an affidavit is taken shall state the date on which and the place where the same is taken and shall affix his seal, if any, or the seal of the

office to which he is attached thereto and sign his name and description at the end thereof.

(5) Alterations and interlineations shall, before an affidavit is sworn or affirmed, be authenticated by the initials of the person before whom the affidavit is taken.

(6) Every affidavit filed before the Registrar in connection with any of the proceedings under the Act or the rules shall be duly stamped under the law for the time being in force.

Inspection of Documents by Public

121. Inspection of documents.

The documents mentioned in sub-section (1) of section 148 shall be available for inspection at the appropriate office of the Trade Mark Registry on payment of the fee mentioned in First Schedule on all working days and at such times as may be fixed by the Registrar.

Certificates

122. Certified copies of documents.

The Registrar may, on request being made in Form TM-M along with fees mentioned in First Schedule, furnish certified copies of any entry in the register or of any documents referred to in sub-section (1) of section 148 or of any decision or order of the Registrar, or of a certificate other than a certificate under sub-section (2) of section 23 as to any entry, matter or thing which he is authorised or required by the Act or the rules to make.

Provided that the Registrar may furnish an expedited certified copies of the documents aforementioned within seven working days on a request in Form TM-M received to that effect on payment fees as specified in First Schedule.

Explanation: A certified copy of any record available digitally with the Registrar shall be a duly certified copy of that record.

123. Power of Registrar to notify International Non-proprietary names.

The Registrar shall from time to time publish in the Journal, the words which are declared by the World Health Organisation as international non-proprietary names referred to in sub-section (b) of section 13.

Well-Known Trademarks

124. Determination of Well Known Trademark by Registrar.

(1) Any person may, on an application in Form TM-M and after payment of fee as mentioned in First schedule, request the Registrar for determination of a trademark as well-known. Such request shall be accompanied by a statement of case along with all the evidence and documents relied by the applicant in support of his claim.

(2) The Registrar shall, while determining the trademark as well-known take in to account the provisions of sub section (6) to (9) of section 11.

(3) For the purpose of determination, the Registrar may call such documents as he thinks fit.

(4) Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection.

(5) In case the trademark is determined as well-known, the same shall be published in the trademark Journal and included in the list of well-known trademarks maintained by the Registrar.

(6) The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party.

Appeal to the Intellectual Property Appellate Board

125. Time for appeal.

An appeal to the Intellectual Property Appellate Board from any decision of the Registrar under the Act or the rules shall be made within three months from the date of such decision.

126. Service to the Registrar.

A copy of every application to Intellectual Property Appellate Board under the Act shall be served on the Registrar.

Certificate of Validity

127. Certificate of validity to be noted.

Where the Intellectual Property Appellate Board has certified as provided in section 141 with regard to the validity of a registered trademark the registered proprietor

thereof may request the Registrar in Form TM-M to add to the entry in the register a note that the certificate of validity has been granted in the course of the proceedings, particulars of which shall be given in the request. An officially certified copy of the certificate shall be sent with the request, and the Registrar shall record a note to that effect in the register and publish the note in the Journal.

Return of Exhibits and Destruction of Records

128. Return of exhibits.

(1) Where the exhibits produced in any matter or proceeding under the Act or the rules are no longer required in the Trade Marks Registry, the Registrar may call upon the party concerned to take back the exhibits within a time specified by him and if the party fails to do so, such exhibits shall be destroyed.

(2) Where, before the notified date any exhibits have been produced in any proceeding, the Registrar may, if satisfied that it is no longer necessary to retain them call upon the party concerned to take back the exhibits within a time specified by him and if the party fails to do so, such exhibit shall be destroyed.

129. Destruction of records.—

Where an application for the registration of a trademark has been withdrawn or abandoned or refused or a trademark has been removed from the register or in an opposition or rectification proceeding the matter has been concluded and no appeal is pending before the Intellectual Property Appellate Board, the Registrar may, at the expiration of one year after the application is withdrawn or is abandoned or is refused or after the trademark is removed from the register or the opposition or rectification proceeding is closed, as the case may be, destroy all or any of the records relating to the application, opposition or rectification or the trademark concerned.

PART II - SPECIAL PROVISIONS FOR COLLECTIVE TRADEMARKS

130. Rules to apply to collective trademarks.

The provisions of Part I, Part IV, and VII of these rules shall, in their application to collective trademarks, apply only subject to the provisions of this Part.

131. Application for registration and proceedings relating thereto.

(1) An application for the registration of a collective trademark for goods or services under sub-section (1) of section 63 shall be made to the Registrar in Form. TM-A along with the draft regulations.

- (2) References in Part I of the rules to the acceptance of an application for the registration of a trademark for goods or services, shall, in their application to collective trademark, be substituted by references to authorisation to proceed with the application.
- (3) The address in India, if any, of an applicant to register a collective trademark shall be deemed to be the address of his principal place of business in India for all the purposes for which such an address is required by the rules.
- (4) The regulations governing collective trademarks shall specify, inter alia—
- (a) the name of the association of persons and their respective office addresses;
 - (b) the object of the association;
 - (c) the details of members;
 - (d) the conditions for membership and relation of each member with the group;
 - (e) the persons authorised to use the trademark and the nature of control the applicant exercise over the use of the collective trademark;
 - (f) the conditions governing use of the collective trademark, including sanctions;
 - (g) the procedure for dealing with appeals against the use of the collective trademark;
 - (h) such other relevant particulars as may be called for by the Registrar.

132. Case accompanying application.

The applicant shall submit to the Registrar along with his application a statement of case setting out the grounds on which he relies in support of his application. Such statement of case shall be furnished in duplicate.

133. Examination, Hearing, Opposition, Registration, and Renewal.

The provisions related to examination, hearing, opposition, registration and renewal of trademarks shall apply mutatis mutandis in respect of collective trademarks.

134. Amendment of regulations relating to collective trademarks and renewal.

(a) An application by the registered proprietor of a collective trademark for any amendment to the regulation under Section 66 shall be made in Form TM-M and where the Registrar accepts any such amendment he shall advertise, such

application in the Journal and further proceedings in the matter shall be governed by rules 42 to 51.

(b) A collective trademark may be renewed from time to time and the provision of rule 57 to 61 shall apply mutatis mutandis in respect of such request for renewal.

135. Removal of collective trademark.

An application for removal of a collective trademark from the register shall be made in Form TM-O and shall set forth particulars of the grounds on which the application is made. The provisions of rule 97 to 100 of these rules shall apply mutatis mutandis for further proceeding in the matter.

PART III - SPECIAL PROVISION FOR CERTIFICATION TRADEMARKS

136. Rules to apply to certification Trademarks.

The provisions of Part I of these rules shall, in their application to certification Trade Marks, apply only subject to the provisions of this Part.

137. Application for registration and proceedings relating thereto.

(1) An application for the registration of a certification trademarks for goods or services under sub-section (1) of section 71 shall be made to the Registrar in Form TM-A along with the draft regulations.

(2) References in Part I of the rules to the acceptance of an application for the registration of a trademark, shall, in their application to certification trademark, be substituted by references to authorisation to proceed with the application.

(3) The address in India, if any, of an applicant to register a certification trademark shall be deemed to be the address of his principal place of business in India for all the purposes for which such an address is required by the rules.

(4) The regulation governing a certification trademark shall specify, inter alia—

(a) a description of the applicant;

(b) the nature of the applicant's business;

(c) the particulars of infrastructure like Research and Development, technical manpower support;

(d) the applicant's competence to administer the certification scheme;

(e) the applicant's financial arrangement;

- (f) an undertaking from the applicant that there will be no discrimination of any party if they meet the requirements set down in the regulations;
- (g) the characteristic, which the trademark will indicate in the certified goods or in relation to the rendering of certified services;
- (h) the manner of monitoring the use of the trademark in India; and
- (i) such other relevant particulars as may be called for by the Registrar.

138. Statement of case accompanying application.

The applicant shall submit to the Registrar along with his application a statement of case setting out the grounds on which he relies in support of his application.

139. Examination, Hearing, Opposition, Registration, and Renewal.

The provisions related to examination, hearing, opposition, registration and renewal of trademarks shall apply mutatis mutandis in respect of certification trademarks.

140. Cancellation or variation of registration of certification trademark.

An application for cancellation or variation of registration of a certification trademark on any of the grounds mentioned in section 77 shall be made in Form TM-O and shall set forth particulars of the grounds on which the application is made. The provisions of rule 97 to 100 shall apply mutatis mutandis to further proceedings in the matter.

141. Alteration of deposited regulations and consent of the Registrar for assignment or transmission of certification Trademarks.

(1) An application by the registered proprietor of a certification trademark under sub-section (2) of section 74 to alter the deposited regulation shall be made in Form TM-M and where the Registrar decides to permit such alteration it shall be advertised in the Journal and further proceeding in the matter shall be governed by rules 42 to 51.

(2) An application for the consent of the Registrar to the assignment or transmission of a certification trademark under section 43 shall be made in Form TM-P.

PART IV - REGISTRATION OF TRADEMARKS AGENTS

142. Register of Trademarks Agents.

The Registrar of Trade Marks shall maintain a Register of trademarks agents wherein shall be entered the name, address of the place of residence, address of the

principal place of business, the nationality, qualifications and date of registration of every registered trademarks agent.

143. Registration of existing registered trademarks agents, code of conduct, etc.

(1) Notwithstanding anything contained in rule 144, every person whose name has been entered in the register of trademarks agents maintained under the old law shall be deemed to be registered as a trademarks agent under these rules.

(2) The Registrar may publish in the Journal a code of conduct for the registered trademarks agent authorising them to act as such.

144. Qualifications for registration.

Subject to the provisions of rule 145, a person shall be qualified to be registered as a trademarks agent if he—

- (i) is a citizen of India,
- (ii) is not less than 21 years of age;
- (iii) is a graduate of any university in India or possesses an equivalent qualification and has passed the examination prescribed in rule 148 or is an Advocate within the meaning of the Advocates Act, 1961 (25 of 1961) or is a member of the Institute of Company Secretaries of India;
- (iv) is considered by the Registrar as a fit and proper person to be registered as a trademark agent.

145. Persons debarred from registration.

A person shall not be eligible for registration as a trademarks agent if he—

- (i) has been adjudged by a competent Court to be of unsound mind;
- (ii) is an undischarged insolvent;
- (iii) being a discharged insolvent has not obtained from the court or the appropriate forum as the case may, a certificate to the effect that his insolvency was caused by misfortune without any misconduct on his part;
- (iv) has been convicted by a competent court or the appropriate forum as the case may, whether within or outside India of an offence punishable with transportation or imprisonment, unless the offence of which he has been convicted has been pardoned or unless on an application made by him, the Central Government by order in this behalf, has removed the disability;

(v) being a legal practitioner has been held guilty of professional misconduct by any High Court in India;

(vi) being a chartered accountant, has been held guilty of negligence or misconduct by a High Court; or

(vii) being a registered trademarks agent has been held guilty of professional misconduct by the Registrar.

146. Manner of making application.

All applications under the provisions of this Part shall be made in duplicate and shall be sent to or submitted at that office of the Trade Marks Registry within whose territorial limits the principal place of business of the applicant is situate.

147. Application for registration as a trademarks agent.

(1) Every person desiring to be registered as a trademarks agent shall make an application in Form TM-G.

(2) The applicant shall furnish such further information bearing on his application as may be required of him at any time by the Registrar.

148. Procedure on application and qualifying requirements.

(1) On receipt of an application for the registration of a person as a trademarks agent, the Registrar, if satisfied that the applicant fulfils the prescribed qualifications, shall appoint a date in due course on which the candidate will appear for examination in Trade Marks Law and practice.

(2) The qualifying marks for the examination shall be as advertised by the Registrar.

149. Certificate of registration. — If the Registrar considers the applicant eligible and qualified under rule 144 for registration as a trademark agent, he shall enroll the candidate as a registered trademark agent after payment of prescribed fee and shall issue a certificate in Form RG-4 and the registration shall subsist till end of the financial year of the registration.

150. Continuance of the name in the register of Trade Marks Agents.

The continuance of a person's name in the register of trademarks agents shall be subject to his payment of the fees prescribed in First Schedule.

151. Removal of agent's name from the register of Trade Marks agents.

(1) The Registrar shall remove from the register of trademarks agents the name of any registered trademarks agent-

- (a) from whom' a request has been received to that effect; or
- (b) from whom the annual fee has not been received on the expiry of three months from the date on which it became due.

(2) The Registrar shall remove from the register of trademarks agents, the name of any registered trademarks agent—

- (a) who is found to have been subject at the time of his registration, or thereafter has become subject, to any of the disabilities stated in clauses (i) to(vii) of rule 145;or
- (b) whom the Registrar has declared not to be a fit and proper person to remain in the Register by reason of any act of negligence, misconduct or dishonesty committed in his professional capacity;
- (c) whose name has been entered in the register by an error or on account of misrepresentation or suppression of material fact:

Provided that before making such declaration under clauses (b) and (c) the Registrar shall call upon the person concerned to show-cause why his registration should not be cancelled and shall make such further enquiry, if any, as may be consider necessary.

(3) The Registrar shall remove from the register of trademarks agents the name of any registered trademarks agent who is dead.

(4) The removal of the name of any person from the register of trademarks agents shall be notified in the Journal and shall, wherever possible, be communicated to the person concerned.

152. Power of Registrar to refuse to deal with certain agents.

(1) The Registrar may refuse to recognise—

- (a) any individual whose name has been removed from, and not restored to the register;
- (b) any person, not being registered as a trademarks agent, who in the opinion of the Registrar is engaged wholly or mainly in acting as agent in applying for

trademarks in India or elsewhere in the name or for the benefit of the person by whom he is employed;

(c) any company or firm, if any person whom the Registrar could refuse to recognise as agent in respect of any business under these rules, is acting as a director or manager of the company or is a partner in the firm.

(2) The Registrar shall refuse to recognise as agent in respect of any business under this rule any person who neither resides nor has a place of business in India.

153. Restoration of removed names.

(1) The registrar may, on an application made in Form TM-G with fee as specified in the First Schedule, within three years from the date of removal of the name of a person from the Register of trademarks agents, whose name has been removed under clause (b) of sub-rule (1) of rule 151, restore his name to the register of Trade Marks agents.

(2) The restoration of a name to the register of trademarks agent shall be notified in the Journal and shall be communicated to the person concerned.

154. Alteration in the register of Trademarks Agents.

(1) A registered trademarks agent may apply in Form TM-G for alteration of his name, address of the place of residence, address of the principal place of business or qualifications entered in the register of trademarks agents. On receipt of such application and the fee prescribed in that behalf, the Registrar shall cause the necessary alteration to be made in the register of trademarks agents.

(2) Every alteration made in the register of trademarks agents shall be notified in the Journal.

155. Publication of the register of trademarks agents.

The Registrar shall ordinarily publish the list of agents in the register of trademarks agents from time to time, and at least once in two years together with their addresses as entered in the register.

156. Appeal.

An appeal shall lie to Intellectual Property Appellate Board from any order or decision of the Registrar in regard to the registration or removal of trademarks agents under Part IV of these rules, and the decision of the Appellate Board shall be final and binding.

Part V

Language of the Trade Marks Registry

157. Language of the Trade Marks Registry.

(1) The language of the Trade Marks Registry shall be English: Provided that the parties to a proceedings before the Trade Marks Registry may file documents drawn up in Hindi, if they so desire:

Provided further that that where-

- (a) the Registrar permits the use of Hindi in the proceedings of the Tribunal and hearing in such proceedings, he may in his discretion direct English translation of pleadings and documents to be filed;
- (b) the Trade Marks Registry located in "Region A" as defined in clause (f) of rule 2 of the Official Languages (Use for Official Purposes of the Union) Rules, 1976, the Registrar may, in his discretion, make final orders either in Hindi or in English.

(2) Notwithstanding anything contained in paragraph (1), where a final order is made in Hindi, an authenticated English translation thereof shall simultaneously be prepared and kept on record.

PART VI - REPEAL

158. Repeal.

The Trade Marks Rules, 2002, are hereby repealed without prejudice to anything done under such rules before the coming into force of these rules.

Forms

Forms related to Trademark Rules can be accessed [here](#)