

Trade Marks (Amendment) Rules, 2013

NOTIFICATION

New Delhi, the 14th January, 2013

GS.R. 21(E).-Whereas certain draft rules further, to amend the Trade Marks Rules, 2002, were published, as required under sub-section (1) of section 157 of the Trade Marks Act, 1999 (47 of 1999) vide notification of the Government of India in the Ministry of Commerce and Industry (Department of Industrial Development) No. G.S.R. 652 (E) dated the 24th August, 2012 published in the Gazette of India, Extraordinary, Part II Section 3, sub-section (i) dated 25th August 2012, inviting objections and suggestions from all persons likely to be affected thereby, before the expiry of forty Five days from the date on which copies of the Gazette containing notification were made available to the public;

And whereas, the said notification was made available to the public on 25th August, 2012;

And whereas, no objections and suggestions were received from the public;

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

1. (1) These rules may be called the Trade Marks (Amendment) Rules, 2013 .

(2) They shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint.

2. In the Trade Marks Rules, 2002 (hereinafter referred to as the said rules), for rule 22, the following rule shall be substituted, namely:

22. Classification of goods or services- (1) For the purposes of registration of trademarks, the goods and services shall be classified as per current edition of the International Classification of goods and

services (NICE Classification) published by World Intellectual Property Organization (WIPO)

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

3. For rule 23 of the said rules, the following rule shall be substituted namely:

23. 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-55 in respect of any goods or services comprised within anyone class of goods or services as published by the Registrar under sub-rule (2) of rule 22, along with the fees specified in Entry No 50 of the FIRST SCHEDULE and accompanied by one representation of the trade mark.

4. In rule 25 of the said rules,

(a) sub-rules (5) and (6) shall be omitted;

(b) in sub-rule (15), the following proviso shall be inserted namely:

Provided that while making an application for registration of a trade mark the names of goods and services stated in the application shall as far as may be, correspond to those given in the classification of goods and services published by the Registrar under sub-rule (2) of rule 22.

5. In rule 47 of the said rules,-

(a) for sub-rule (1) the following sub-rule shall be substituted, namely:

(1) A notice of opposition to the registration of a trade mark under sub-section (1) of section 21, with such particulars as specified in rule 48, shall be given in duplicate in form TM-5 within four months from the date of publication of the Trade Marks Journal in which the application for registration of the trade mark was advertised or re-advertised.

(b) Sub-rule (6) shall be omitted.

6. After Chapter III of the said rules, the following Chapter shall be inserted, namely:

CHAPTER III A

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

67A. 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 subsection (1) of section 2 of the Information Technology Act, 2000(No.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 respectively assigned to them in the Madrid Protocol or the Common Regulations;

67B. 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.

67C. 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.

67D. 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.

67E. 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 No 88 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.

67F. 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.

67G. 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 Trade Marks.

67H. Examination of application under section 36E- (1) The advice referred to in rule 67G shall be examined ordinarily within two months from the date of receipt of such advice.

(2) Where, the Registrar finds that the mark 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 Trade Marks 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 47 to 57 of the Trade Marks Rules 2002.

(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 mark 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 mark 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 mark in India.

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

67I. 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.

67J. 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.

67K. Collective and Certification Marks- Where an international registration designating India is in respect of a collective mark or a certification mark, the regulations governing the use of such collective mark or certification mark 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

67L. 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 60f the Act. Thereafter, the Registrar shall notify the International Bureau accordingly under rule 21 of the Common Regulations .

67M. 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.

7. Rule 69 of the said rule shall be omitted.

8. For rule 70 of the said rule, the following rule shall be substituted, namely:

70. Case accompanying application- (1) A person applying for registration of his title, under rule 68, shall, along with his request on form TM-23 or TM-24, file original document, duly stamped original instrument or deed, as the case may be, purporting to transfer the title in the trade mark and a statement of case in support of his request. If the Registrar so requires, the statement of case shall be verified by an affidavit in form TM-18:

Provided that the Registrar may permit the applicant to submit the duly certified copy of the instrument or deed, in case the applicant justifies that original instrument or deed cannot be submitted.

(2) The Registrar shall dispose of an application made under rule 68 ordinarily within three months from the date of application, and intimate the same to the applicant.

(3) After entry of the transfer of title, the Registrar shall return the original document, instrument or deed to the applicant applying under rule 68, along with the intimation of recordal and retain duly certified copy of the instrument or deed for records:

Provided that the Registrar shall not return any affidavit filed in support of the request filed under rule 68.

9. In rule 71 of the said rules, the following proviso shall be inserted, namely:

Provided that the Registrar may call such proof only where there is a reasonable doubt about the veracity of any statement or any document furnished.

10. In Chapter VII of the said rules Part IV shall be omitted

11. In Chapter VII of the said rules Part VI shall be omitted

12. In the FIRST SCHEDULE to the said rules-

a. Entry number 2 and the description relating thereto shall be omitted.

b. Entry number 10 and the description relating thereto shall be omitted.

c. Entry number 13 and the description relating thereto shall be omitted.

d. After entry number 87, the following shall be inserted namely-

13. In the SECOND SCHEDULE to the said rules under column (1) relating to Form No,-

(a) TM-22 and the entries relating thereto in column (2), (3) and (4) shall be omitted

(b) TM-44 and the entries relating thereto in column (2), (3) and (4) shall be omitted

(c) TM-45 and the entries relating thereto in column (2), (3) and (4) shall be omitted.

(d) Forms TM-22, TM-44 and TM-45 shall be omitted

14. The FOURTH SCHEDULE of the said rules shall be omitted.

15. The FIFTH SCHEDULE of the said rules shall be omitted.

[F. No. 8/112/20 II-IPR-IV]

D. V. PRASAD, Jt. Secy.

Note: The Principal rules were published in the Gazette of India, Extraordinary, Part-II, Section 3, Sub-section (i) vide notification number G.S.R. 114(E), dated 26th day of February, 2002, and subsequently were amended vide notification numbers G.S.R. 428(E), dated 20th May, 2010 and G.S.R. 1024(E), dated 29th December, 2010.