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## Good, Bad and the Challenges of New Trade Marks Rules, 2017

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The Trademarks Registry has notified the new Trademark Rules, 2017. The changes when looked from the point of view of streamlining the functioning of trademark registry and embracing the technology to expedite the registration process are laudable. We thought to analyse these changes and how they will pan out in practice. We have classified them in three buckets - good, bad and the challenges.

### Good

1. Reduction in number of forms for each activity during the lifecycle of a trademark. Now there are only 8 forms in totality from the earlier 75 forms. The reduction in the forms will simplify the filing/s for the Applicants as a single form can be used to cover multiple tasks though these are required to be filed separately.
2. To encourage online filing, the Registry has incentivised the agent/applicant to file applications/documents electronically/online and pay 10% less fees on such filing.
3. To encourage Individuals, Start-ups and Small Enterprises to create and protect their brand, further reduction has been offered in official fees.
4. Procedure for recording a mark as "well-known" has been laid out including publication of a well known mark for objection by a third party before granting coveted status of "well known" mark.
5. To move all communications through email, it is now mandatory to provide email address by the Applicants.
6. Hearing through video conferencing or other audio-video communication devices have been provided
7. To cut down delays in disposal of opposition, it has been provided that a party cannot ask for more than two adjournments. This will likely reduce the time for decision.
8. Procedure for filing sound mark applications by providing MP3 files along with a graphical representation of the musical notations have been provided.

### Bad

While it sounds being critical to group them under the heading 'bad'. We have provided the reasoning for our thinking;

1. Expedited examination of the application – We have put this under "bad" category as the Registry is already struggling with backlog and this provision will only disrupt the current working. In particular the new Rule now provides expeditious processing of the application on payment of fees which would inter alia include setting up of show cause hearing, if required, - the publication of the application and the opposition thereto, if any, till final

disposal of the application. All such proceedings would be dealt with expeditiously. Thus, one can jump the queue if one can afford it.

2. In opposition/s cases no extensions to be allowed for filing evidence. It is a fix 2 months period which on the face of it is a good step. However it is equally possible the parties may not be able to meet the deadline especially the ones which are based outside India given that the affidavit must be filed as paper copy in original. In the digitized environment a concession could have been made as regards filing of the scanned copy followed by the paper copy to meet the strict timelines.
3. The secrecy of implementation of the Rules was maintained and no sunrise period was provided to the Applicants/Stake holders. As a result frequent technical glitches are being faced in the online filing processes.

### Challenges

The new Rules list out several steps by the Indian Government to streamline the functioning of the Intellectual Property office and to somehow reduce frivolous new filings so as to expedite the process of filing, grant, recordation/updating of the records and opposition. However, it does not seem to address the current challenges in clearing backlog;

- 1) Currently several hundred applications, whether filed through Madrid or national applications which have received preliminary refusal, are awaiting scrutiny by the Examiner/s.
- 2) There is an opposition gridlock at the Trademarks Registry with more than 114,218 oppositions pending as per summary of applications under oppositions given on "Dynamic Utilities" of TM Registry website.
- 3) The new Rules for declaration of well known marks, it seems, will need a separate department as the current officers (Senior Examiner, Assistant Registrar and Deputy Registrar), who will be expected scrutinise the applications, struggle to cope up with the workload. Thus the brand owners may find the whole process taking far too long.

Overall, more good than bad.

For more information about the new Rules, you can reach us at [info@rnaip.com](mailto:info@rnaip.com).

401-402, 4th Floor, Suncity Success Tower,  
Sector - 65, Golf Course Extension Road,  
Sector-54, Gurgaon-122005  
National Capital Region (Haryana)  
India

Tel. +91-124 2841222  
Fax. +91124 2841144  
Email [info@rnaip.com](mailto:info@rnaip.com)

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