

TRADE MARKS RULES, 2002

PART 1

CHAPTER 1

PRELIMINARY

1. Short title and commencement.

- (1) These rules may be called the Trade Marks Rules, 2002.
- (2) They shall come into force on the date on which the Act comes into force.

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** under section 145 of the Act;
 - (c) "application for registration of a trade mark" includes the trade mark 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 notified as such under sub-section (1) of section 154;
 - (g) "convention application" means an application for registration of a trade mark 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 initial application for the registration of a trade mark for **separate** classes of goods or services;
 - (i) "divisional fee" means fee prescribed against entry number 68 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 trade mark for goods or services in paper form;
 - (l) "Journal" means the Trade Marks Journal referred to in rule 43;
 - (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 thereunder existing immediately before the commencement of the Act;

- (o) "opposition" means an opposition to the registration of a trade mark or a collective mark or a certification trade mark, as the case may be;
- (p) "principal place of business in India" means the relevant place in India as specified in rule 3;
- (q) "publish" means publish in the Trade Marks Journal;
- (r) "registered trade mark agent" means a trade marks agent whose name is actually on the register of trade marks agents maintained under rule 148;
- (s) "renewal" means and includes renewal of a trade mark or a certification trade mark or collective mark, as the case may be;
- (t) "Schedule" means a schedule to these rules;
- (u) "section" means a section of the Act;
- (v) "specification" means the designation of goods or services in respect of which a trade mark or a registered user of a trade mark is registered or proposed to be registered;
- (w) All other words and expressions used but not defined in these rules but defined in the Act or in the Geographical Indications Goods (Registration and Protection) Act, 1999 (48 of 1999), the Copyright Act, 1957 (14 of 1957) shall have the meanings respectively assigned to them in these 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-

- (1) where a person carries on business in the goods or services concerned in a trade mark-
 - (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;
- (2) where a person is not carrying on a business in the goods or services concerned in a trade mark -
 - (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
- (3) 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 trade mark under section 18 or for giving notice of opposition under section 21 or an application for removal of a trade mark under section 47 or cancelling or varying the registration of a trade mark under section 57 or for any other proceedings under the Act and the rules shall be -

- (a) in relation to a trade mark 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 trade mark 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 mark or in the case of joint registration, of any of the joint proprietors of the mark, 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 trade mark was made, is situate, and
- (b) in relation to a trade mark 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 trade mark 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 trade mark 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 trade mark 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 trade mark shall be deemed to have been transferred to the appropriate office of the trade marks registry.

8. Leaving of documents, etc; -

(1) Save as otherwise provided in sub-rule (2), 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 trade mark on the Register of Trade Marks 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.

(2) Documents or fees authorised or required by the Act or the rules to be sent or paid may be sent or paid at or to either the appropriate office or the head office of the registry in the following matters -

- (a) communication and other documents including affidavits in relation to an application filed for registration of a trade mark;
- (b) application or request in Forms TM-10, TM-12, TM-13, TM-14, TM-16, TM-17, TM-19, TM-20, TM-21, TM-23, TM-24, TM-25, TM-28, TM-29, TM-30, TM-31, TM-32, TM-33, TM-34, TM-35, TM-36, TM-38, TM-40, TM-46, TM-47, TM-50, TM-54, TM-55, TM-58, TM-59, TM-61 and TM-62;
- (c) Notwithstanding anything contained in sub-rule 1 and under clause (a) or clause (b) of sub rule 2 or a request for search and issuance of certificate in Form TM-60, expedited examination in Form TM-63, or expedited certified copies of documents in Form TM-70, or for expedited search report in Form TM-71 or for expedited search certificate in Form TM-72 shall be filed at the head registry until the Registrar after informing the public in the Journals directs otherwise.

9. Documents etc. filed or left not at the appropriate office. - Subject to the provisions of rule 8, where an application, notice, statement or other document or any fee authorised or required by the Act or the rules is made, served, left or sent or paid, at or to an office inadvertently which is not the appropriate office of the Trade Marks Registry, the Registrar may on his own or on a request in writing, return such application, notice, statement or document to the appropriate office if he is satisfied that it was a bonafide error on the part of the applicant:

Provided that the period for which such application, notice or statement or document is retained by the office which is not the appropriate office shall be excluded for the purposes of computing the period of limitation where any of such application, notice, statement or document is required to be presented within the prescribed period:

Provided further that any fee paid at the office which is not the appropriate shall be deemed to have been paid at the appropriate office:

Provided also that before declining any such request, the Registrar shall provide the applicant an opportunity of being heard.

10. Issue of notices etc: - A 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 officers authorised by the Registrar.

11. Fees. -

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

(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, therefore, shall be accompanied by the prescribed fee.

(3) Fees may be paid in cash or sent by money order addressed to the Registrar or by a bank draft issued or by a 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 cheque would be delivered in the ordinary course of post.

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

(5) Subject to the provisions contained in sub-rule 19 of rule 25, 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.

(6) The Registrar may, after informing the public in the Journal, make available electronic fee transfer facilities subject to such guideline and instructions as may be specified on that behalf.

12. 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 Schedules is satisfied by the use either of a replica of that form or of a form which is acceptable to the Registrar and contains 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, specify such forms as are required to be submitted in electronic mode. Thereafter, such forms shall be completed in such a manner as may be specified as to permit an automated input of the content into a computer such as by character recognition or scanning.

13. 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 trade marks, authorised or required by the Act or the rules to be made, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar shall be neatly handwritten or typewritten or lithographed or printed in Hindi or in English in large and legible characters with deep permanent ink upon strong paper, and except in the case of affidavits, on one side only, and of size of approximately 33 centimeters by 20 centimeters and shall have on the left hand part thereof a margin of not less than 4 centimeters.

(2) Duplicate documents including copies of trade marks 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, etc; of all 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.

14. Signing of documents. –

(1) A document purporting to be signed by a partnership firm shall be signed by at least one of the partners stating that he signs on behalf of the firm and a document purporting to be signed by a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate. The capacity in which an individual signs a document on behalf of a partnership or a body corporate shall be stated below his signature.

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

15. 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 to be made, served, left or sent, at or to the Trade Marks Registry or with or to the Registrar or any other person may be sent through the post by a prepaid letter.

(2) An application or a 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 at 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 may, after informing the public in the Journal permit, transmission of any document by facsimile (fax) of specified documents not requiring payment of a fee.

(6) The Registrar may after informing the public in the Journal accept communications of a routine nature through E-mail not requiring the payment of a fee thereof.

16. 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, calling and such other particulars as are necessary for identification.

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

(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.

17. Statement of principal place of business in India in an application. –

(1) Every application for registration of a trade mark 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 as have a principal place of business in India.

(2) Subject to the provisions of rules 18, 19 and 21, 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 trade mark, at the address of his principal place of business in India given by him in the application shall be deemed to be properly addressed.

18. Address for service. –

(1) An address for service in India shall be given –

(a) by every applicant for registration of a trade mark who has no principal place of business in India;

(b) in the case of joint applicants for registration of a trade mark, if none of them has a principal place of business in India;

(c) by the proprietor of a trade mark who had his principal place of business in India at the date of making the application for registration but has subsequently ceased to have such place;

(d) by every applicant in any proceeding under the Act or the rules and every person filing a notice of opposition, who does not have a principal place of business in India.

(e) by every person granted leave to intervene under rule 94.

(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.

19. Address for service in application and opposition proceedings.- An applicant for registration of a trade mark or an opponent filing a notice of opposition may notwithstanding that he has a principal place of business in India, if he so desires, may specifically request in writing, the Registrar with an address in India to which communications in relation to the application or opposition proceedings only may be sent. Such address of the applicant or the opponent shall be deemed, unless subsequently cancelled, to be the actual address of the applicant or the opponent, as the case may be, and all communications and documents in relation to the application or notice of opposition may be served by leaving them at, or sending them by post to such address of the applicant or the opponent, as the case may be.

20. Non-availability of an address for service. - The Registrar may, at any time when a doubt arises as to the continued availability of an address for service in India entered

in the register, request the person for whom it is entered, by letter directed to any other address entered in the register or if no such address is entered in the register to the address at which the Registrar considers that the letter would reach him, to confirm the address for service in India and if within two months of making such a request the Registrar receives no such confirmation, he may strike the entry in the register of the address for service in India and require such person to furnish a fresh address for service in India or his address at the principal place of business in India, if he has any at that time.

21. Agency. –

(1) The authorisation of an agent for the purpose of section 145 shall be executed **in** Form TM-48 or in such other written form as the Registrar may deem sufficient and proper.

(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.

22. Classification of goods or services. –

(1) For the purposes of the registration of trade marks, goods and services shall be classified in the manner specified in the Fourth Schedule.

(2) The goods and services specified in the Fourth Schedule only provide a means by which the general content of numbered international classes can be quickly identified. It corresponds to the major content of each class and are not intended to be exhaustive in accordance with the international classification of goods and services. For determining the classification of particular goods and services and for full disclosure of the content of international classification, the applicant **may** refer to the alphabetical index of goods and services, if any, published by the Registrar under section 8 or the current edition of the International Classification of Goods and Services for the purpose of registration of trade mark published by the World Intellectual Property Organisation or subsequent edition as may be published.

(3) The Registrar shall identify and include in the alphabetical index of classification of goods and services, as far as practicable, goods or services of Indian origin.

23. Preliminary advice by Registrar as to distinctiveness. –

(1) 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 any one class in the Fourth Schedule, accompanied by three representations of the trade mark.

(2) The advice **referred** to sub-rule (1) shall ordinarily be given within seven working days of such filing of the application and such advice shall contain the reasons therefor.

24. Request to Registrar for search. –

(1) Any person may request the Registrar, in Form TM-54 to cause a search to be made in respect of a trade mark relating to specified goods or services classified in any one class in the Fourth Schedule to ascertain whether any mark is on record which resembles the trade mark in respect of which the request is made. The Registrar shall cause such search to be made and the result thereof communicated ordinarily to the

person making the request within thirty days of the receipt of such request:

Provided, that the Registrar shall cause an expedited search report to be issued ordinarily within seven working days on a request in Form TM-71 on payment of five times the ordinary fees for such search.

(2) If, within three months from the date of communication of the result of the search aforesaid, an application is made for the registration of the trade mark in question and the Registrar takes objection on the ground that the mark resembles a mark, which was not disclosed in the search but was on record on the last of the dates on which the search was made, the applicant shall be entitled, on giving notice of withdrawal of the application within the period mentioned in rule 39, to have repaid to him any fee paid on the filing of the application.

(3) Any person may request the Registrar, in Form TM-60 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 trade mark 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 trade mark 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, however, the Registrar may call for a statement of requirements from the applicant and if the requirements are not complied within two months from the date of such calling of the statement, the request in Form TM-60 may be treated as abandoned.

(4) The Registrar may cancel the certificate issued under sub-rule (3) after giving notice and stating the grounds on which the Registrar proposes to cancel the certificate and after providing reasonable opportunity of being heard.

(5) Subject to proviso to sub-rule 3 or sub-rule 4, 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-72 on payment of five times the ordinary fee for such search.

(6) Before abandoning the request in Form TM-60 or TM-72, as the case may be, for non-compliance of the statement of requirements when called for, the Registrar shall offer an opportunity of being heard in the matter.

CHAPTER II

PROCEDURE FOR REGISTRATION OF TRADE MARKS APPLICATION

25. Form and signing of application. –

(1) An application to the Registrar for the registration of a trade mark shall be signed by the applicant or his agent.

(2) An application to register a trade mark for a specification of goods or services included in any one class shall be made in Form TM-1.

(3) An application to register a trade mark under sub-section (2) of section 154 for a specification of goods or services included in any one class from a convention country shall be made in Form TM-2.

- (4) A single application for the registration of a trade mark for different classes of goods or services from convention country under sub-section (2) of section 154 shall be made in Form TM-52.
- (5) An application to register a textile trade mark (other than a collective mark or a certification trade mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule under rule 145 shall be made in Form TM-22.
- (6) An application to register of a textile mark (other than a collective mark or a certification trade mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule under rule 145 from a convention country under sub-section (2) of section 154 shall be made in Form TM-45.
- (7) -
- (a) An application under section 63(1) to register a collective trade mark for a specification goods or services in any one class shall be made in Form TM-3.
 - (b) An application under section 63(1) to register a collective trade mark for a specification of goods or services from a convention country under sub-section (2) of Section 154 shall be made in Form TM-64.
- (8) -
- (a) An application under section 71 to register a certification trade mark for a specification of goods or services included in any one class shall be made in Form TM-4.
 - (b) An application under section 71 to register a certification trade mark for a specification of goods or services from a convention country under sub-section (2) of Section 154 shall be made in Form TM-65.
- (9) A single application for the registration of a trade mark for different classes of goods or services shall be made in Form TM-51.
- (10) An application to register a series trade marks under section 15 for a specification of goods or services included in a class or for different classes shall be made in Form TM-8.
- (11) An application to register a series trade mark under section 15 for a specification of goods or services included in a class or for different classes from a convention country under sub-section (2) of section 154 shall be made in Form TM-37.
- (12) An application for registration of a trade mark for goods or services shall: -
- (a) Explain with sufficient precision, a description by words, of the trade mark if necessary, to determine the right of the applicant;
 - (b) Be able to depict the graphical representation of the trade mark;
 - (c) Be considered as a three dimensional trade mark only if the application contains a statement to that effect;
 - (d) Be considered as a trade mark consisting of a combination of colours only if the application contains statement to that effect.
- (13) An amendment to divide an application under proviso to section 22 shall be made in Form TM-53.
- (14) An application shall be in respect of one trade mark only for as many class or classes of goods or services as may be made.

(15) 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 mark which the applicant has made or intends to make if and when it is registered.

(16) The specification of goods or services shall not ordinarily exceed five hundred characters. An excess space fee as prescribed in the First Schedule is payable with each application in Form TM-61.

(17) A single application for the registration of a collective mark –

(a) in different classes shall be made in Form TM-66;

(b) in different classes from a convention country shall be made in Form TM-67.

(18) A single application for the registration of certification trade mark –

(a) in different classes shall be made in Form TM-68;

(b) in different classes from a convention country shall be made in Form TM-69.

(19) Where an applicant files a single application for more classes than one, and the Registrar determines that the goods or services applied for fall in class or classes in addition to those applied for, the applicant may restrict the specification of goods or services to the class applied for or amend the application to add additional class or classes on payment of the appropriate class fee and the divisional fee. The new class created through a division retains the benefit of the original filing date or in the case of an application from a convention country the convention application date under sub-section (2) of Section 154 provided the claim was otherwise properly asserted in the initial application.

26. Application under convention arrangement. –

(1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a convention country under section 154 a certificate by the Registry or competent authority of that Trade Marks Office shall be included in an application for registration under sub-rule (3), (4), (6), (7)(b), (8)(b), (11), (17)(b) or (18)(b) of rule 25, as the case may be, and it shall include the particulars of the mark, the country or countries and the date or dates of filing of application and such other 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, the representation of the mark, and the goods or services covered by the application.

(3) The application shall include a statement indicating the date of filing **of** 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 Where the applicant files more priority claims than one under section 154 for some or all the goods or services in respect of the same trade mark, the Registrar shall take the date of the earlier application in a convention country, as the priority date;

Provided further that the Registrar shall take such priority date only in respect of goods or services referred to in convention application.

(4) Where a single application under sub-section (2) of section 18 is filed from a convention country for one or more classes of goods or services, the applicant shall establish a sufficient ground to the satisfaction of the Registrar for the date of filing of application in all such classes.

27. Statement of user in applications. An application to register a trade mark shall, unless the trade mark 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 the goods or services mentioned in the application. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

28. Representation of mark.

(1) Every application for the registration of a trade mark, and where additional copies of the application are required every such copy, shall contain a representation of the mark in the space (8cm x 8 cm) provided on the application form for that purpose:

Provided that in any case the size of such representation shall not exceed 33 centimeters by 20 centimeters with a margin of 4 centimeters on the left hand side.

29. Additional representations.

(1) Every application for registration of a trade mark shall, except as hereinafter provided, be made in triplicate and shall be accompanied by five additional representations of the mark. The representations of the mark on the application and each of its copies and the additional representations shall correspond exactly with one another. The additional representations shall in all cases be noted with the specification and class or classes of goods or services for which registration is sought, the name and address of the applicant, together with the name and address of his agent, if any, the period of use, if any, and such other particulars as may from time to time be required by the Registrar and shall be signed by the applicant or his agent.

(2) Where an application contains a statement to the effect that the applicant wishes to claim combination of colours as the distinctive feature of the mark, the application shall be accompanied with one reproduction of the mark in black and white and four reproduction of the mark in colour.

(3) Where the application contains a statement to the effect that the trade mark is a three dimensional mark, the reproduction of the mark shall consist of a two dimensional graphic or photographic reproduction as follows, namely:-

- (i) The reproduction furnished shall consist of three different view of the trade mark;
- (ii) Where, however, the Registrar considers that the reproduction of the mark furnished by the applicants does not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish within two months up to five further different views of the mark and a description by words of the mark;
- (iii) Where the Registrar considers the different views and/or description of the mark referred to in clause (ii) still do not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish a specimen of the trade mark.

(4)

- (i) Where an application for the registration of a trade mark consists of shape of goods or its packaging, the reproduction furnished shall consist

of at least five different views of the trade mark and a description by word of the mark.

- (ii) If the Registrar considers the different views and description of the mark in sub-clause (i) still does 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.

30. Representations to be durable and satisfactory.

(1) All representations of trade marks shall be of a durable nature, and each additional representation required to be filed with an application for registration shall be mounted on a sheet of strong paper of the size of approximately 33 centimeters by 20 centimeters, leaving a margin of not less than 4 centimeters on the left hand part of the sheet.

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

(3) Where representation of a trade mark cannot be given in the manner set forth hereinabove, a specimen or copy of the trade mark may be sent either in full size or on a reduced scale and in such form as the Registrar may think most convenient.

31. Series trade marks.

(1) Where an application is made for the registration of series trade marks under sub-section (3) of section 15, copies of representation of each trade mark of the series shall accompany the application in the manner set forth in rules 28 and 29.

(2) An applicant claiming to be the proprietor of a series trade mark under sub-section (3) of section 15 may apply to the Registrar in Form TM-8 or TM-37, as the case may be, for its registration as a series for one registration and there shall be included in each such application a representation of the trade mark of each class claimed to be in the series. The Registrar shall, if satisfied that the marks constitutes a series proceed further with the applications.

(3) At any time before the publication of the application in the Journal, the applicant applying under sub-rule (2) may request in Form TM-53 for the division of the application into separate application or applications, as the case may be, in respect of one or more marks 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.

(4) The division of an application into one or more applications under sub-rule (3) shall be on the payment of a divisional fee and such class fees as are appropriate.

32. Request for search of a company name: Any person may, after the Registrar has informed the public in the Journal permitting a request in Form TM-75 to cause a search to be made and for issuance of a certificate pursuant to clause (ii) of sub-section(2) of section 20 of the Companies Act, 1956 (1 of 1956) to the effect that no trade mark identical with or deceptively similar to the name of the company in respect of which the request is made has been registered as a trade mark or is pending under the Trade Marks Act,1999(47 of 1999).

33. Transliteration and translation. - Where a trade mark contains a word or words in scripts other than Hindi or English, there shall be endorsed on the application form and the additional representations thereof, a sufficient transliteration and translation to the satisfaction of the Registrar of each such word in English or in Hindi and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.

34. Names and representations of living persons or persons recently dead. - Where the name or representation of any person appears on a trade mark 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 trade mark, 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 trade mark.

35. Name or description of goods or services on a mark.

(1) Where the name or description of any goods or services appears on a trade mark, the Registrar may refuse to register such mark 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 trade mark, which name or description in use varies, the Registrar may permit the registration of the trade mark for those and other goods or services on the applicant giving an undertaking that the name or description will be varied when the trade mark 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.

36. Deficiencies.- Subject to sub-rule (2) of rule 11, where an application for registration of a trade mark does not satisfy the requirement of any of the provisions of the Act or these 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 may be treated as abandoned.

PROCEDURE ON RECEIPT OF APPLICATION FOR REGISTRATION OF A TRADE MARK

37. Acknowledgment and Search.

(1) Every application for the registration of a trade mark in respect of any goods or services shall on receipt, be acknowledged by the Registrar. The acknowledgment shall be by way of return of one of the additional representations of the trade mark filed by the applicant along with his application with the official number of the application duly entered thereon.

(2) Upon receipt of the application for registration of trade mark, the Registrar shall cause a search to be made amongst the registered trade marks and amongst the pending applications for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any mark identical with or deceptively similar to the mark sought to be registered and the Registrar may cause the search to be renewed at any time before the acceptance of the application but shall not be bound to do so.

38. Expedited examination, objection to acceptance, hearing.

(1) After the receipt of the official number of an application under sub-rule (1) of rule 37, an applicant may request for expedited examination of an application for registration of a trade mark in Form TM-63 together with a declaration stating the reason for the request, on payment of five times the application fee.

(2) If the Registrar is satisfied on the basis of declaration filed under sub-rule(1) that an expedited examination of the application is warranted, he shall cause the expedited

examination of such application in the order in which the requests are filed and may ordinarily issue the examination report within three months of the date of such request.

(3) Where the Registrar declines the request under sub-rule (1), the applicant shall be entitled to have the fee refunded:

Provided that before declining any such request, the Registrar shall provide the applicant an opportunity of being heard.

(4) If on consideration of an application for registration of a trade mark or on an application for an expedited examination of an application referred to in sub-rule (1) 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 right to impose under sub-section (4) of section 18, the Registrar shall communicate such objection or proposal in writing to the applicant.

(5) If within one month from the date of communication mentioned in sub-rule (4), the applicant fails to amend his application according to the proposal or fails to submit his observations to the Registrar or apply for a hearing or fails to attend the hearing, the application shall be deemed to have been abandoned.

39. Notice of withdrawal of application for registration.- A notice of withdrawal of an application for the registration of a trade mark under sub-section 2 of section 133, or sub-rule (2) of rule 24, 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 (4) of rule 38.

40. Decision of Registrar.

(1) The decision of the Registrar under rule 38 or rule 42 after a hearing or without a hearing if the applicant has duly communicated his observations in writing and has stated that he does not desire to be heard, shall be communicated to the applicant in writing and if the applicant intends to appeal from such decision he may within thirty days from the date of receipt of such communication apply in Form TM-15 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 therewith 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 shall be deemed to be the date of the Registrar's decision for the purpose of an appeal.

41. Correction and amendment of application. - An applicant for registration of a trade mark may, whether before or after acceptance of his application but before the registration of the mark, apply in Form TM-16 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, however, no such amendment shall be permitted which shall have the effect of substantially altering the original trade mark or substitute a new specification of goods or services not included in the initial application.

42. Withdrawal of acceptance by the Registrar.

(1) If, after the acceptance of an application but before the registration of the trade mark, the Registrar has any objection to the acceptance of the application on the

ground that it was accepted in error, or that the mark ought not to have been accepted in the circumstances of the case, or proposes that the mark 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 15 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

43. Manner of Advertisement.

(1) Every application for registration of a trade mark 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 ordinarily within six months of the acceptance of an application for registration or after the expiry of the period referred to sub-section (2) of section 154 whichever is later.

(2) Where a trade mark applied is other than a word, the Registrar may call upon the applicant to furnish a camera ready copy of the trade mark ordered to be advertised to scan electronically into a Desk Top publishing package.

(3) The Registrar may after informing the public in the Journal, put the applications published in the Journal on the internet, web site or any other electronic media.

(4) The Registrar may after informing the public in the Journal make available the Journal in CD-ROM on payment of the cost thereof.

44. Advertisement of series. - Where an application relates to a series trade marks differing from one another in respect of the particulars mentioned in sub-section (3) of section 15, the Registrar may, if he thinks fit, insert with the advertisement of the application a statement of the manner in which the several trade marks differ from one another.

45. 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.

46. Request to Registrar for particulars of advertisement of a mark. - Any person may request the Registrar in Form TM-58 to be informed of the number, date and page of the Journal in which a trade mark 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

47. Notice of Opposition.

(1) A notice of opposition to the registration of a trade mark under sub-section (1) of section 21 shall be given in triplicate in Form TM-5 within three months or within such further period not exceeding one month in the aggregate from the date the Journal is made available to the public (which date shall be certified by the Registrar as such) The notice shall include a statement of the grounds upon which the opponent objects to the registration. If the registration is opposed on the ground that the trade mark in question resembles marks already on the register, the registration numbers of such trade marks and the dates of the Journals in which they have been advertised shall be set out.

(2) Where a notice of opposition has been filed in respect of a single application for the registration of a trade mark, it shall bear the fee in respect of each class in relation to which the opposition is filed in Form TM-5.

(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-53 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 trade mark, 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) All notices of opposition to the registration of a trade mark for goods or services received in respect of a particular Journal shall be notified in the Journal:

Provided that nothing in this sub-rule shall be construed to presume that all remaining trade marks from a particular journal so notified shall automatically proceed to registration.

(6) An application for an extension of the period within which a notice of opposition to the registration of a trade mark may be given under sub-section (1) of section 21, shall be made in Form TM-44 accompanied by the fee prescribed in First Schedule before the expiry of the period of three months under sub-section (1) of section 21.

(7) 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.

48. Requirement 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 of the application against which opposition is entered;
 - (ii) an indication of the goods or services listed in the trade mark application against which opposition is entered; and
 - (iii) the name of the applicant for the trade mark.
- (b) In respect of the earlier mark or the earlier right on which the opposition is based,-
- (i) Where the opposition is based on an earlier mark, a statement to that effect and an indication of the status of earlier mark;
 - (ii) Where available, the application number or registration number and the filing date, including the priority date of the earlier mark;
 - (iii) Where the opposition is based on an earlier mark which is alleged to be a well-known trade mark within the meaning of sub-section 2 of section 11 of the Act, an indication to that effect and an indication of the country or countries in which the earlier mark is recognised to be well known;
 - (iv) where the opposition is based on an earlier trade mark 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 mark is registered or applied for;
 - (v) A representation of the mark of the opponent and where appropriate, a description of the mark or earlier right; and
 - (vi) Where the goods or services in respect of which earlier mark has been registered or applied for or in respect of which the earlier mark 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 mark 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 mark or of the earlier right, his name and address and an indication that he is the proprietor of such mark 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 trade mark 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 some other person who is acquainted with the facts of the case.

(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.

49. Counterstatement.

(1) The counterstatement required by sub-section (2) of section 21 shall be sent in triplicate in Form TM-6 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 same manner as the notice of opposition as stated in clause (c) of sub-rule (1) of rule 48.

50. Evidence in support of opposition.

(1) Within two months from services on him of a copy of the counterstatement or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, 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 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.

(3) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.

51. Evidence in support of application.

(1) Within two months or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, 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 relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies thereof.

(2) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.

52. Evidence in reply by opponent.-Within one month from the receipt by the opponent of the copies of the applicant's affidavit or within such further period not exceeding one

month in the aggregate thereafter as the Registrar may on request in Form TM-56 allow, the opponent may leave with the Registrar evidence by affidavit in reply and shall deliver to the applicant copies thereof. This evidence shall be confined to matters strictly in reply.

53. 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.

54. Exhibits.- Where there are exhibits to affidavits filed in an opposition a copy or impression of each exhibit shall be sent to the other party on his request and at his expense, or, if such copies or impression cannot conveniently be furnished, the originals shall be left with the Registrar in order that they may be open to inspection. The original exhibits shall be produced at the hearing unless the Registrar otherwise directs.

55. 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 furnished in duplicate.

56. Hearing and decision.

(1) Upon completion of the evidence, if any, the Registrar shall give notice to the parties of the first date of hearing. Such notice shall be ordinarily given within three months of completion of the evidence. The date of hearing shall be for a date at least one month after the date of the first notice. Within fourteen days from the receipt of the first notice, any party who intends to appear shall so notify the Registrar in Form TM-7. Any party who does not so notify the Registrar within the time as aforesaid may be treated as not desiring to be heard and the Registrar may act accordingly in the matter.

(2) If sufficient cause for adjournment is not shown by either of the parties the Registrar may proceed with the matter forthwith.

(3) If the applicant is not present at the adjourned date of hearing and has not notified his intention to attend the hearing in Form TM-7, the application may be treated as abandoned.

(4) If the opponent is not present at the adjourned date of hearing and has not notified his intention to attend the hearing in Form TM-7, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to Section 19.

(5) In every case of adjournment the Registrar shall fix a day for further hearing of the case and shall make such order as to cost occasioned by the adjournment or such higher costs as the Registrar deems fit.

(6) The fact that the agent or advocate on record of a party is engaged in another court, shall not be a ground for adjournment.

(7) Where illness of legal practitioner or an agent or his inability to conduct the case for any reason is put forward as a ground for adjournment, the Registrar may refuse to grant the adjournment unless he is satisfied that the legal practitioner or an agent, as the case may be, could not have engaged another agent or legal practitioner in time.

(8) The Registrar shall take on record written arguments if submitted by a party to the proceeding.

(9) The decision of the Registrar shall be notified to the parties in writing.

57. 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

58. 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 O-1 to the applicant at the address of his principal place of business in India or if he has no principal place of business in India at the address for service in India stated in the application but if the applicant has authorised an agent for the purpose of the application, the notice shall be sent to the agent and a duplicate thereof to the applicant. 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-56 for completion of the registration.

REGISTRATION

59. 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 trade mark on the register.

(2) The entry of a trade mark 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 trade mark or in the case of a jointly owned trade mark, of such of the joint proprietors of the trade mark as have a principal place of business in India;
- (b) where the proprietor of the trade mark 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 trade mark, 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) particulars of the trade, business, profession, occupation or other description of the proprietor or, in the case of a jointly owned trade mark, of the joint proprietors of the trade mark 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 mark is a collective or certification mark, that fact;
- (h) where the mark is registered pursuant to sub-section 4 of section 11 with the consent of the proprietor of an earlier trade mark or other earlier right, that fact; and
- (i) the appropriate office of the Trade Marks Registry in relation to the trade mark.

(3) The Registrar may from time to time, in consultation with computer experts, formulate guidelines for keeping official records in electronic form.

60. Associated marks.

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

(2) An application under sub-section (5) of section 16 to dissolve the association as respects any of the trade marks registered as associated trade marks shall be made in Form TM-14 and shall include statement of the grounds of the application.

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

62. Certificate of registration.

(1) The certificate of registration of a trade mark to be issued by the Registrar under sub-section (2) of section 23 shall be in Form O-2 with such modification as the circumstances of any case may require, and the Registrar shall annex a copy of the trade mark to the certificate.

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

(3) The Registrar may issue a duplicate or further copies of the certificate of registration on request by the registered proprietor in Form TM-59 accompanied by the prescribed fee. An unamounted representation of the mark exactly as shown in the form of application for registration thereof at the time of registration shall accompany such request.

CHAPTER III

RENEWAL OF REGISTRATION AND RESTORATION

63. Renewal of registration.

(1) An application for the renewal of the registration of a trade mark shall be made in Form TM-12 and may be made at any time not more than six months before the expiration of the last registration of the trade mark.

(2) Such application for renewal may be filed by the person who is the proprietor of the registered trade mark or his agent.

(3) If the proprietor, as set forth in the application for renewal is not the same person or the same legal entity as the registered proprietor, continuity of title from the registered proprietor in whose name the last renewal was effected to the present owner shall be shown in the first instance by way of affidavit along with supporting chain of documents.

(4) The Registrar may accept an application for renewal from the managing trustee, executors, administrators and the like, when supported by court order or other evidence of authority to act on behalf of the present proprietor.

64. Notice before removal of trade mark from register.

(1) At a date not less than one month and not more than three months before the expiration of the last registration of a trade mark, if no application in Form TM-12 for renewal of the registration together with the prescribed fee has been received, the Registrar shall notify the registered proprietor or in the case of a jointly registered trade mark each of the joint registered proprietors and each registered user, if any, in writing in Form O-3 of the approaching expiration at the address of their respective principal places of business in India as entered in the register or where such registered proprietor or registered user has no principal place of business in India at his address for service in India entered in the Register.

(2) Where, in the case of a mark the registration of which (by reference to the date of application for registration) becomes due for renewal, the mark 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 66, remove the mark from the register.

(3) Where, in the case of a mark the registration of which (by reference to the date of application for registration) becomes due for renewal, the mark 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 66, remove the mark from the register.

(4) The renewal of registration of a collective mark or a certification trade mark shall be in Form TM-12 with the prescribed fee specified in the First Schedule.

65. Advertisement of removal of trade mark from the register.-If, at the expiration of last registration of a trade mark, the renewal fees has not been paid, the Registrar may remove the trade mark from the register and advertise the fact forthwith in the Journal:

Provided that the Registrar shall not remove the trade mark from the register if an application is made for payment of surcharge under proviso to sub-section (3) of section 25 in Form TM-10 within six months from the expiration of the last registration of the trade mark.

66. Restoration and renewal of registration.- An application for the restoration of a trade mark to the register and renewal of its registration under sub-section (4) of section 25, shall be made in Form TM-13 within one year from the expiration of the last registration of the trade mark 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.

67. 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

ASSIGNMENT AND TRANSMISSION

68. 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 trade mark shall be made in Form TM-24 or TM-23 according as it is made by such person alone or conjointly with the registered proprietor.

69. Particulars to be stated in application.-An application under rule 68 shall contain full particulars of the instrument, if any, under which the applicant, or, in the case of a joint application, the person other than the registered proprietor claims to be entitled to the trade mark and such instrument or a duly certified copy thereof shall be produced at the Trade Marks Registry for inspection at the time of application. The Registrar may require and retain an attested copy of any instrument produced for inspection in proof of title.

70. Case accompanying application.-Where a person applying under rule 68 for registration of his title, does not establish his claim under any document or instrument which is capable in itself of furnishing proof of his title, he shall, unless the Registrar otherwise directs, either upon or with the application, state a case setting forth the full particulars of the facts upon which his claim to be proprietor of the trade mark is based, and showing that the trade mark has been assigned or transmitted to him. If the Registrar so requires, the case shall be verified by an affidavit in Form TM-18.

71. Proof of title.-The Registrar may call upon any person who applies to be registered as proprietor of a registered trade mark to furnish such proof or additional proof of title as he may require for his satisfaction.

72. 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).

73. 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 trade mark by an assignment which involves such transmission except on production of the permission of the authority specified in such law for such transmission.

74. Application for Registrar's direction as to advertisement of an assignment of a trade mark without goodwill of the business.

(1) An application for directions under section 42 shall be made in Form TM-20 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 trade mark, and in the case of an unregistered mark shall show the mark and give particulars including user of the unregistered trade mark 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) may be made shall be made in Form TM-21.

75. Application for entry of assignment without goodwill.- An application under rule 68 relating to an assignment of a trade mark in respect of any goods or services shall state-

- (a) whether the trade mark 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 74, 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.

76. Separate registration.-Where pursuant to an application under rule 68, 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 trade mark, 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.

77. 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-17 or Form TM-19, as the case may be, 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.

78. Entry in register of particulars of assignment.-Where the Registrar has allowed the assignment of a trade mark 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 mark, 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.

79. 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 trade mark upon application made under rule 68 shall be six months from the date of advertisement in the Journal of the registration of the trade mark or such further period not exceeding six months as the Registrar may allow on application being made in Form TM-25 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 V

REGISTERED USERS

80. 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 trade mark shall be made jointly by that person and the registered proprietor of the trade mark in Form TM-28 and shall be accompanied by the following:-

- (a) the agreement in writing or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark;
- (b) the documents and correspondence, if any mentioned in the agreement referred to in clause (a) entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark or duly authenticated copies thereof.

(2) There shall be filed along with the application an affidavit made by the registered proprietor or by some person authorised to the satisfaction of the Registrar to act on his behalf testifying to the genuineness of the documents accompanying the application and containing:

- (a) the particulars and statements required by clause (b) of sub-section (1) of section 49;
- (b) the precise relationship between the registered proprietor and the proposed registered user, if any; for instance, whether their relationship is as principal and subsidiary company or whether there is common control between their business;
- (c) a statement as to the goods or services in which the registered proprietor is dealing, together with details as to whether the trade mark which is the subject of the application has been used by him in the course of trade before the date of the application and if so the amount and duration of such user;

(3) 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.

(4) 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-rule (1).

(5) Notwithstanding anything contained in sub-rule (1), 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 trade marks covered by the same agreement, the documents mentioned in sub-rule (1) may be filed with any one of the applications and a cross reference to such documents given in the other application or applications.

81. Particulars to be stated in the agreement.- The agreement referred to in clause (a) of sub-rule (1) of rule 80 shall-

- (a) set out the particulars specified in sub-clause (i) to (iv) of clause (b) of sub-section (1) of section 49;
- (b) disclose the terms as to royalty and other remuneration payable to the registered proprietor by the proposed registered user for the permitted use of the trade mark;
- (c) provide means for bringing the permitted use to an end when the relationship between the parties or the control by the registered proprietor over the permitted use ceases; and
- (d) contain a condition that when the registered trade mark is used by the proposed registered user in relation to his goods or services, other than goods or services for export, the mark shall be so described as clearly to indicate that it is being used only by way of permitted use.

82. 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, and the matters specified in sub-clause (i) to (iv) of clause (b) of sub-section 1 of section 49, register the proposed registered user in respect of the goods or services as to which he is so satisfied.

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

(1) The Registrar shall give a notice in writing to the applicants where he proposes to accept the application subject to any conditions, restrictions or limitations. The notice shall state the grounds on which the Registrar proposes to issue such orders and shall inform the applicants that they are entitled to be heard.

(2) Unless within one month from the receipt of the notice mentioned in sub-rule (1) the registered proprietor and the proposed registered user apply for a hearing, the Registrar may refuse the application or to accept it conditionally, as the case may be.

(3) If the registered proprietor and the proposed registered user apply for a hearing the Registrar shall appoint a time for the hearing within two months and shall give them not less than a month's notice of the time so appointed.

(4) After hearing the registered proprietor and the proposed registered user, the Registrar shall decide whether to accept the application or to refuse it or to accept it conditionally.

(5) The Registrar shall, communicate in writing his order on the application to the applicants and to other registered users of the mark, if any.

84. 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.

(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.

85. Registration not to imply authorisation to transmit money outside India. -The registration as registered user of a trade mark 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 trade mark, to any place outside India.

86. Notification of registration as registered user. - A notification in writing of the registration of a registered user shall be sent by the Registrar to the registered proprietor of the trade mark, to the registered user and to every other registered user whose name is entered in relation to the same trade mark and shall also be inserted in the Journal within three months of such entry in the register.

87. Registered proprietor's application to vary entry.-An application by the registered proprietor of a trade mark for the variation of the registration of a registered user of that trade mark under clause (a) of sub-section (1) of section 50 shall be made in Form TM-29 and shall be accompanied by a statement of the grounds on which it is made, and where the registered user in question consents, by the written consent of the registered user.

88. 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-rule (1) of Section 50 shall be made in Form TM-30 or Form TM-31, as the case may be, and shall be accompanied by a statement of the grounds on which it is made.

(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 trade mark is registered, the Registrar shall at the same time omit them from those specifications of registered users of the trade mark 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 trade mark.

89. 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.

90. 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 trade mark.

(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-32 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 canceling 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-32 and statement of case filed and shall dispose of the application and also inform the parties in writing accordingly.

91. Registered user's application.-An application under sub-section (2) of section 58 shall be made in Form **TM-16** or Form-**TM-33** or Form-**TM-34** or Form-**TM-50** as may be appropriate by a registered user of a trade mark or by such person as may satisfy the Registrar that he is entitled to act in the name of a registered user; and the Registrar may require such evidence by affidavit or otherwise as he may think fit as to the circumstances in which the application is made.

CHAPTER VI

RECTIFICATION AND CORRECTION OF REGISTER

ALTERATION OR RECTIFICATION OF REGISTER

92. Application to rectify or remove a trade mark 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 trade mark or a collective mark or certification trade mark in the register shall be made in triplicate in Form TM-26, or Form TM-43, as the case may be, and shall be accompanied by statement in triplicate 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 trade mark in question, the application and the statement aforesaid shall also be left at the Trade Marks Registry triplicate. In case there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered user. 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 trade mark. The application shall be verified in the manner prescribed under clause (i) of sub-rule © of rule 48 for verification of a notice of opposition.

93. Further procedure.-Within two months from the receipt by a registered proprietor of the copy of the application mentioned in rule 92 or within such further period not exceeding one month in the aggregate, he shall send to the Registrar in Form TM-6 a counterstatement in triplicate 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. The provisions of rules 50 to 57 shall thereafter apply *mutatis mutandis* to the further proceedings on the application. The Registrar shall not, however, rectify the register or remove the mark from the register merely because the registered proprietor has not filed a counterstatement unless he is satisfied that the delay in filing the counterstatement is

willful and is not justified by the circumstance of the case. In any case of doubt any party may apply to the Registrar for directions.

94. Intervention by third parties. -Any person, other than the registered proprietor, alleging interest in a registered trade mark in respect of which an application is made under rule 92 may apply in Form TM-27 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.

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

(1) The Notice, which the Registrar is required to give 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 trade mark, 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.

(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 OF ADDRESS

96. Alteration of address in register.

(1) A registered proprietor or a registered user of a trade mark, the address of whose principal place of business in India or whose address in his home country, as the case may be, is changed so that the entry in the register is rendered incorrect, shall forthwith request the Registrar in Form TM-34 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 trade mark, whose address for service in India entered in the register is changed, whether by discontinuance of the entered address or otherwise, so that the entry in the register is rendered incorrect, shall forthwith request the Registrar in Form TM-50 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.

(3) A registered proprietor or a registered user of a trade mark 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 in Form TM-34 or TM-50 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 11 or sub-rule (2) of rule 12.

(4)

- (i) Where a registered proprietor makes a request under sub-rule (1), (2) or (3), 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.

(5) 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 trade marks, 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-50 amended 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.

(6) All applications under this rule in Form TM-50 shall be signed by the registered proprietor or the registered user, as the case may be, or by an agent expressly authorised by him for the purpose of such an application, unless in exceptional circumstances the Registrar otherwise allows.

CORRECTION OF REGISTER

97. Application for correction of register:-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 he may think fit, as to the circumstances in which the application is made. Such application shall be made in Form TM-16, TM-33, TM-34, TM-35, TM-36, or TM-50 as may be appropriate and a copy thereof shall be served by the applicant on the registered user or users, if any, under the registration of the trade mark in question and to any other person who appears from the register to have an interest in the trade mark.

98. Alteration of registered trade mark. - Where a person applies under section 59 for leave to add to or alter his registered trade mark, he shall make the application in writing in Form TM-38 and shall furnish five copies of the mark as it will appear when so added to or altered. A copy of the application and of the trade mark so amended or altered shall be served by the applicant on every registered user, if any.

99. Advertisement before decision and opposition etc.

(1) The Registrar shall consider the application and shall, if it appears to him expedient, advertise the application in the Journal before deciding it.

(2) Within three months from the date of advertisement under sub-rule (1), or within such further period not exceeding one month in the aggregate as the Registrar may allow, any person may give notice of opposition to the application in Form TM-39 and may also send therewith a statement of his objections. The notice and the statement, if any, shall be sent in triplicate. In case there are any registered users under the registration of the trade mark in question, such notice and statement shall also be accompanied by as many copies thereof as there are registered users. A copy of each of the notice and statement 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-6 a counterstatement in triplicate 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 50 to 57 shall apply *mutatis mutandis* to the further proceedings on the opposition. The Registrar shall not, however, refuse the application merely because the registered proprietor has not filed a counterstatement unless he is satisfied that the delay in filing the counterstatement is willful and is not justified by the circumstance of the case. In case of any doubt any party may apply to the Registrar for directions.

(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.

100. Decision - Advertisement – Notification.- If the Registrar decides to allow the application he shall alter the mark in the register accordingly and insert in the Journal a notification that the mark has been altered. If the application has not been advertised under rule 99, he shall also advertise in the Journal the trade marks as altered.

RE-CLASSIFICATION OF GOODS IN RESPECT OF EXISTING REGISTRATION

101. Re-classification in respect of existing registration.

(1) On the classification set forth in the Fourth Schedule being amended, the registered proprietor of a trade mark may apply to the Registrar in Form TM-40 for the conversion of the specification relating to his trade mark, so as to bring that specification into conformity with the amended classification. The application shall include a request for the like conversion of the specification in respect of any registered users under that registration, and the registered proprietor shall serve a copy of the application on the registered user or users of the trade mark, if any.

(2) The Registrar shall, thereupon, notify in writing to the registered proprietor and to the registered user or users, if any, a proposal showing the form in which, in the Registrar's view, the amendment of the register should take in consequence of the proposed conversion. Two or more registrations of a trade mark having the same date and in respect of goods which fall within the same class under the amended or substituted classification, may be amalgamated upon conversion in accordance with this rule.

(3) The proposal referred to in sub-rule (2) shall be advertised in the Journal.

(4) Notice of opposition to such proposal shall be given in Form TM-41 in triplicate within three months from the date of the advertisement or within such period not exceeding one month in the aggregate and shall be accompanied by a statement in triplicate showing how the proposed amendment would contravene the provisions of sub-section (1) of section 60. Where there are any registered users under the registration of the trade mark in question, such notice and statement shall also be accompanied by as many copies thereof as there are registered users. The Registrar shall within two months send a copy each of the notice and the statement to the registered proprietor and to each registered user, if any, and within two months from the receipt by him of such copies the registered proprietor may send to the Registrar in Form TM-6 a counterstatement in triplicate setting out fully the grounds on which the opposition is contested. If the registered proprietor sends such counterstatement the Registrar shall serve a copy thereof on the person giving notice of opposition within two months and the further procedure for the disposal of the opposition shall be

regulated by the provisions of rules 50 to 57 *mutatis mutandis*. In any case of doubt, any party may apply to the Registrar for directions.

(5) If there is no opposition within the time specified in sub-rule (4), or in case of opposition if the conversion of the specification is allowed, the proposal as allowed shall be advertised in the Journal, and all necessary entries shall be made in the register. The date when such entries are made in the register shall be recorded therein. Any entry made in the register in pursuance of this sub-rule shall not affect the date of the renewal of registration under section 25 which shall be determined in the same manner as before the allowing of the conversion.

CHAPTER VII MISCELLANEOUS

102. Refusal of invalidation of registration of a trade mark conflicting with a geographical indication. A request in Form TM-73 or TM-74 as the case may be, may be made to the Registrar for the refusal or invalidation of a **registered** trade mark 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 trade mark 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).

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

(1) Where an application for the registration of a trade mark 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) If the specification of goods or services contained in the initial application for registration of a trade mark makes a reference to a class or classes in the Fourth Schedule in which they do not fall, the Registrar shall require the applicant to correct the classification error in Form TM-16.

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

(4) 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.

104. Divisional Application.-

(1) Where an application is made in Form **TM-53** under proviso to section 22 for the division of a single pending application, such application shall be divided into two or

more separate applications on the payment of a divisional fee and such class fees as are appropriate in accordance with the division.

(2) At any time before registration an applicant may request the Registrar in Form **TM-53** for a division of his initial application for registration into two or more separate applications (divisional applications), indicating for each division the specification of goods or services. The Registrar shall treat each divisional application as a separate application for registration with the same filing date as the initial application.

(3) In the case of a request to divide some goods or services, but not all in a class, a divisional fee for separate application to be created by division shall be paid. 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) If the request to divide is not accompanied by necessary fee or is otherwise deficient, the Registrar shall notify the applicant of the deficiency. The applicant may correct any such deficiency within thirty days. If the applicant fails to correct the deficiency within the time provided, the request shall be considered as abandoned and the application shall proceed further without regard to the request.

(5) Where a request to divide an application is received, 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. Such additional separate application or applications shall be assigned the same filing date as the initial application.

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

105. 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 79 or by sub-rule (4) of rule 80 or a time for the extension of which provision is made in the rules) shall be made in Form **TM-56**.

(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 and notify 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.

106. Exercise of discretionary power of Registrar.-The time within which a person entitled under Section 128 to an opportunity of being heard shall exercise his option of requiring to be heard shall, save as otherwise expressly provided in the Act or the rules, be one month from the date of a notice which the Registrar shall give to such person before determining the matter with reference to which such person is entitled to be heard. If within that one month such person is required to be heard, the Registrar shall appoint a date for the hearing and shall give 10 day's notice thereof.

107. Notification 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 notified to the person affected.

108. 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, if the Registrar thinks fit and on such terms as he may direct.

(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.

109. 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.

110. 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.

HEARINGS

111. Hearings.-

(1) In relation to a trade mark for which an application for registration is made on or after the notified date, the application as well as any proceeding under the Act and the rules shall, in the event of a hearing becoming necessary, be heard at the office of the Trade Marks Registry at which such application was made under sub-section (3) of section 18, or at such place within the territorial jurisdiction of that office as the Registrar may deem proper.

(2) In relation to a trade mark for which an application for registration is pending before the Registrar, at the notified date, the hearing, if any, in respect of such application or any proceeding under the Act and the rules shall be taken at the appropriate office of the Trade Marks Registry or at such place within the territorial jurisdiction of that office as the Registrar may deem proper.

(3) In relation to a trade mark on the register of trade marks at the notified date, the hearing, if any, in respect of any proceeding under the Act and the rules shall take place at the appropriate office of the Trade Marks Registry or at such place within the territorial jurisdiction of that office as the Registrar may deem proper.

(4) 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.

AWARD OF COSTS BY REGISTRAR

- 112. Costs in uncontested cases.**-Where any opposition duly instituted under the rules is not contested by the applicant, the Registrar in deciding whether costs should be awarded to the opponent shall consider whether the proceedings might have been avoided if reasonable notice had been given by the opponent to the applicant before the notice of opposition was filed.
- 113. Exception to rule 112.**-Notwithstanding anything in rule 112, costs in respect of fees specified under entries, 12,14 and 15 of the First Schedule and of all stamps used on and affixed to affidavits used in the proceedings shall follow the event.
- 114. Scale of costs.**- Subject to the provisions of rules 112 and 113, 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 Sixth Schedule, as he considers reasonable having regard to all the circumstances of the case.

REVIEW OF DECISION BY REGISTRAR

- 115. 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-57** 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.

AFFIDAVITS

116. 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 shall be taken –
 - (a) in India -before any court or person having by law authority to receive evidence, or before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;

- (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 court to which he is attached thereto and sign his name and description at the end thereof.
- (5) Any affidavit purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by sub-rule (3) to take an affidavit, in testimony of the affidavit having been taken before him, may be admitted by the Registrar without proof of the genuineness of the seal or signature or of the official character of that person.
- (6) 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.
- (7) Where the deponent is illiterate, blind or unacquainted with the language in which the affidavit is written, a certificate by the person taking the affidavit that the affidavit was read, translated or explained in his presence to the deponent, that the deponent seemed perfectly to understand it and that the deponent made his signature or mark in his presence, shall appear in the jurat.
- (8) 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 THE PUBLIC

117. Inspection of documents.-The documents mentioned in sub-section (1) of section 148 shall be available for inspection at the head office of the Trade Marks Registry. A copy of the register and such of the other documents mentioned in section 148, as the Central Government may by notification in the Official Gazette direct, shall be available for inspection at each branch office of the Trade Marks Registry. The inspection shall be on payment of the prescribed fee and at such times on all the days on which the offices of the Trade Marks Registry are not closed to the public, as may be fixed by the Registrar.

118. Distribution of copies of Journal and other documents.-The Central Government may direct the Registrar to distribute the Journal and any other document which it may consider necessary, to such places as may be fixed by the Central Government in consultation with the State Governments and notified from time to time in the Official Gazette.

CERTIFICATES

119. Certified copies of documents.-The Registrar may furnish certified copies of any entry in the register or certified copies of any documents referred to in sub-section (1) of section 148 or of any decision or order of the Registrar, or give 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 or do, upon receipt from any person of an application therefore in Form **TM-46** accompanied by the prescribed fee. The Registrar shall not be obliged to include in any certificate or

certified copy, a copy of any mark unless he is furnished by the applicant with a copy thereof suitable for the purpose:

Provided that the Registrar may furnish an expedited certified copies of the documents aforementioned within thirty working days on a request in Form **TM-70** received to that effect on payment of five times the ordinary fees for such request.

120. Certificate for use in obtaining registration abroad. –

(1) Where a certificate relating to the registration of a trade mark is desired for use in obtaining registration in any territory outside India, the Registrar shall include in the certificate a copy of the mark and may require the applicant for the certificate to furnish him with a copy of the mark suitable for that purpose, and if the applicant fails to do so, the Registrar may refuse to issue the certificate.

(2) Where a trade mark is registered without limitation of colour, the copy of the mark to be included in the certificate, may be either in the colour in which it appears upon the register or in any other colour or colours and it shall be stated in the certificate that the trade mark is registered without limitation of colour.

(3) The Registrar may state in the certificate such particulars concerning the registration of the mark as may deem fit to him, and may specify the terms and conditions and other limitation appearing on the Register. The purpose for which the certificate is issued shall be stated therein.

121. 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.

APPEALS TO THE INTELLECTUAL PROPERTY APPELLATE BOARD

122. 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.

123. 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

124. 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 trade mark the registered proprietor thereof may request the Registrar in Form **TM-47** 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.

125. 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.

126. Destruction of records.-Where an application for the registration of a trade mark has been withdrawn/abandoned or refused or a trade mark 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 three years after the application is withdrawn or is abandoned or is refused or after the trade mark 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 trade mark concerned.

PART II

SPECIAL PROVISIONS FOR COLLECTIVE MARKS

127. Rules to apply to collective marks.-The provisions of Part I, Part IV, and VII of the rules shall, in their application to collective marks, apply only subject to the provisions of this Part.

128. Application for registration and proceedings relating thereto.-

(1) An application for the registration of a collective mark for goods or services under sub-section (1) of section 63 shall be made to the Registrar in Form **TM-3**, Form **TM-64** or in the case of a single application in Form **TM-66** or Form **TM-67** as the case may be, in triplicate and shall be accompanied by five additional representations of the mark. The draft regulations to be submitted with the application under sub-section (1) of section 63 shall be in triplicate and shall be accompanied by Form **TM-49**.

(2) References in Part I of the rules to the acceptance of an application for the registration of a trade mark for goods or services, shall, in their application to collective mark, be substituted by references to authorisation to proceed with the application.

(3) An applicant for the registration of a collective mark shall not be deemed to have abandoned his application, if in the circumstances of sub-rule (5) of rule 38 he does not apply for a hearing or reply in writing.

(4) The address in India, if any, of an applicant to register a collective mark 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.

(5) The regulations governing collective marks 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 mark and the nature of control the applicant exercise over the use of the collective mark;
- (f) the conditions governing use of the collective mark, including sanctions;
- (g) the procedure for dealing with appeals against the use of the collective mark;
- (h) such other relevant particulars as may be called for by the Registrar.

129. 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 case shall be furnished in triplicate.

130. Examination and Hearing.-

- (1) The Registrar shall cause an application for the registration of a collective mark to be examined, in the first instance, as to whether it satisfies the requirement of the Act and the rules and issue a report to the applicant.
- (2) The Registrar shall not refuse an application for the registration of a collective mark or accept the application subject to any conditions or limitations or impose amendments or modifications to the application or to the regulation without giving the applicant an opportunity of being heard and the procedure thereto shall be regulated by the provision of sub-rule (4) of rule 38 to rule 42.

131. Opposition to registration of collective marks –

- (1) On acceptance of the application the Registrar shall cause the application to be advertised in the Journal and the provisions of rules 47 to 57 shall apply *mutatis mutandis* to further proceedings in the matter as they apply in relation to an application for the registration of a trade mark.
- (2) In any case of doubt with regard to proceedings on the opposition to the registration of a collective mark, any party may apply to the Registrar for directions.

132. Amendment of regulations relating to collective marks and renewal-

- (a) An application by the registered proprietor of a collective mark for any amendment to the regulation under Section 66 shall be made in Form **TM-42** 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 47 to 57.
- (b) A collective mark may be renewed from time to time and the provision of rule 63 to 67 shall apply *mutatis mutandis* in respect of such request for renewal.

133. Removal of collective mark.-An application for removal of a collective mark from the register including on any of the grounds mentioned in section 68 shall be made in Form **TM-43** and shall set forth particulars of the grounds on which the application is made. The provisions of rule **92 to 94** of these rules shall apply *mutatis mutandis* for further proceeding in the matter.

PART III

SPECIAL PROVISIONS FOR CERTIFICATION TRADE MARKS

134. Rules to apply to certification trade marks.-The provisions of Part I, Part IV and Part VII of the rules shall, in their application to certification trade marks, apply only subject to the provisions of this Part.

135. Application for registration and proceedings relating thereto.-

(1) An application for the registration of a certification trade mark under sub-section (1) of section 71 shall be made to the Registrar in Form **TM-4**, Form **TM-65** and in the case of a single application in Form **TM-68** or Form **TM-69** as the case may be, in triplicate and shall be accompanied by five additional representations of the mark. The draft regulations to be submitted with the application shall be in triplicate and shall be accompanied by Form **TM-49**.

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

(3) An applicant for the registration of a certification trade mark shall not be deemed to have abandoned his application, if, in the circumstances of sub-rule (5) of rule 38 he does not apply for a hearing or reply in writing.

(4) The address in India, if any, of an applicant to register a certification trade mark 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.

(5) The regulation governing a certification trade mark shall specify inter alia:-

(a) a description of the applicant;

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

(c) the particulars of infrastructure like R &D, technical manpower support;

(d) the applicants competence to administer the certification scheme;

(e) the applicants 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 the mark will indicate in the certified goods or in relation to the rendering of certified services;

(h) the manner of monitoring the use of the mark in India; and

(i) such other relevant particulars as may be called for by the Registrar.

136. Statement of Case accompanying application.-

(1) The applicant shall forward a statement of case to the Registrar with the application setting out the grounds in which he relies in support of the application. Such case shall be furnished in triplicate.

(2) The Registrar shall cause the application for the registration of a certificate trade mark to be examined in the first instance as to whether it satisfies the requirement of the Act and the rules and issue a report to the applicant.

137. Hearing by the Registrar before refusing an application or to accept it conditionally.- The Registrar shall not refuse an application for registration of a certification trade mark or accept the application subject to any conditions or limitations or impose amendments or modifications to the application or to the regulations without giving to the applicant an opportunity of being heard and the

procedure thereto shall be regulated by the provisions of sub-rule (4) of rule 38 to rule 42 of these rules.

138. Opposition to registration of certification trade mark and renewal.-

(1) On acceptance of the application the Registrar shall cause the application to be advertised in the Journal and the provisions of rules 47 to 57 shall apply *mutatis mutandis* as they apply in relation to an application for the registration of a trade mark.

(2) In case of doubt with regard to the proceedings on the opposition to the registration of a certification trade mark, any party may apply to the Registrar for directions.

(3) A certification trade mark may be renewed from time to time and the provisions of rule 63 to 67 shall apply *mutatis mutandis* in respect of such request for renewal.

139. Rectification of certification trade mark.-An application for cancellation or variation of registration of a certification trade mark on any of the grounds mentioned in section 77 shall be made in Form **TM-43** and shall set forth particulars of the grounds on which the application is made. The provisions of rule 92 to 94 shall apply *mutatis mutandis* to further proceedings in the matter.

140. Alteration of deposited regulations and consent of the Registrar for assignment or transmission of certification trade marks.-

(1) An application by the registered proprietor of a certification trade mark under subsection (2) of section 74 to alter the deposited regulation shall be made in Form **TM-42** 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 47 to 57.

(2) An application for the consent of the Registrar to the assignment or transmission of a certification trade mark under section 43 shall be made in Form **TM-62**.

PART IV

SPECIAL PROVISION FOR TEXTILE GOODS

141. Definitions.-For the purposes of rules 146 and 147 –

"balanced numeral" means a trade mark consisting of either identical numerals or identical letters of not less than three nor more than seven digits;

"digit" includes a single letter;

"letter fraction" means a fraction containing one or more letters.

142. Rules to apply to textile marks.-Subject to the provisions of this Part, the provisions of Part I, Part II, Part III and Part VII of the rules shall apply to trade marks in respect of textile goods as they apply to trade marks in respect of non-textile goods.

143. Textile Marks.-The expression "textile mark" means a trademark used or proposed to be used in relation to goods specified in rule 144 as "textile goods" for the purpose of Chapter X of the Act.

144. Textile Goods.-The classes of goods in relation to trade marks to which Chapter X of the Act shall apply and which are in the Act and the rules referred to as textile goods shall be classes 22 to 27 (inclusive) of the Fourth Schedule.

145. Application to register letters or numerals or any combination thereof in respect of items of textile goods.-

(1) A separate application for the registration of a trade mark (other than a collective mark or a certification trade mark) shall be made in Form **TM- 22** or **TM-45** as the case may be, in respect of each of the items of textile goods mentioned in the Fifth Schedule where the mark consists exclusively of letters or numerals or any combination thereof.

(2) The items of the Fifth Schedule shall be grouped as follows; and goods falling in each group shall be deemed to be goods of the same description, and goods falling in different groups shall not be deemed to be goods of the same description for the purpose of an application for the registration of trade marks consisting exclusively of letters or numerals or any combination thereof made under sub-rule(1) and proceedings relating thereto but not for any other purpose-

Group-1-Items 1,4,5,8,9,10,11,12,16,19,20,22,23,24,25,26,27,30,33,36,37, 39,41,42,44,45,48,49,54,55,59,61,62,65 and 91.

Group 2 - Items 2,3,14,17, 18,34,35 and 47.

Group 3 - Items 6,7,21,38 and 52.

Group 4 - Items 13,29,75,77 and 78.

Group 5 - Items 15,28,31,40,60,66,79,88,90 and 93.

Group 6 - Items 32,43,64 and 94.

Group 7 - Items 46,83 and 85.

Group 8 - Items 50,51,56,57,63,76,80,84,86,87 and 89.

Group 9 - Items 53.

Group 10 -Items 58,82 and 92.

Group 11- Items 67,68,69,70 and 71.Group 12 - Items 72.

Group 13 - Items 73.

Group 14- Items 74.

Group 15- Items 81.

(3) Notwithstanding anything contained in sub-rule (2) in respect of any proceeding relating to trade marks consisting exclusively of letters, numerals or any combination thereof for the registration of which applications were made on or before the 31st July,1945, the goods falling in different items of the Fifth Schedule shall not be deemed to be goods of the same description.

146. Non-registrability of certain marks.- In respect of textile goods the following marks shall not be capable of registration, namely:-

- (a) any numerals of one digit or of more than six digits not being a balanced numerals;
- (b) a single letter or any combination of letters of more than six letters, not being a balanced numeral;

- (c) any combination of numerals and letters of more than eight digits;
- (d) any fraction or letter fraction consisting of more than eight digits together;
- (e) any fraction or letter fraction having less than three digits together;
- (f) any combination of numerals, and fractions of more than six digits;
- (g) any combination of numerals, letters, fractions and letter fractions either having more than eight digits or ending with a fraction of more than one digit in the numerator or in the denominator;
- (h) numerals or letters representing cloth dimensions;
- (i) a balanced numeral which does not consist of at least two more or two less digits than a balanced numeral of the same series already registered in the name of a different person, in respect of the same goods or description of goods.

147.Marks likely to deceive or cause confusion.-

(1) A trade mark consisting of numerals, letters, fractions, letter fractions or any combination thereof, and not being a balanced numeral shall not be capable of being registered as a textile mark if it does not differ from a trade mark registered in the name of a different person in respect of the same goods or description of goods-

- (a) in the case of a numeral not exceeding four digits, in at least one corresponding digit;
- (b) in the case of a numeral of five digits, in at least two corresponding digits;
- (c) in the case of a numeral of six digits, in at least three corresponding digits;
- (d) in the case of a combination of two letters, in at least one corresponding letter;
- (e) in the case of a combination of three or four letters, in at least two corresponding letters;
- (f) in the case of a combination of five or six letters, in at least three corresponding letters;
- (g) in the case of a mark consisting of one letter and one numeral digit, in at least one of them;
- (h) in the case of a mark consisting of one letter and two or three numeral digits, in at least one corresponding numeral digit;
- (i) in the case of a mark consisting of one letter and four or more numeral digits, in at least two corresponding digits;
- (j) in the case of a mark consisting of two or more letters and one or more numeral digits, in at least one corresponding letter and one corresponding numeral digit;
- (k) in the case of a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is three or four, in at least one corresponding digit from either the numerator or the denominator;
- (l) in the case of a fraction or letter fraction or any combination thereof in which the total number of digits in the numerator and denominator is five or more, in at least one corresponding digit in the numerator and one corresponding digit in the denominator or two corresponding digits in either the numerator or the denominator;

- (m) in the case of a combination consisting of a numeral and a fraction in at least one corresponding numeral digit;
 - (n) in the case of a combination of letters, numerals and fractions (including letter fractions)-
 - (i) where the total number of digits excluding the fraction is not more than three in at least one corresponding digit;
 - (ii) where the total number of digits, excluding the fraction, is four or more, in at least two corresponding digits.
- (2) Nothing in sub-rule (1) shall be construed to signify that where a trade mark does not come within the scope of any case specified in the said sub rule, the mark shall necessarily be registered as not being likely to deceive or to cause confusion.

PART V

REGISTRATION OF TRADE MARKS AGENTS

148. Register of trade marks agents.-The Registrar of trade marks shall maintain a register of trade marks 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 trade marks agent.

149. Registration of existing registered trade marks agents, code of conduct, etc;

(1) Notwithstanding anything contained in rule 150, every person whose name has been entered in the register of trade marks agents maintained under the old law shall be deemed to be registered as a trade marks agent under these the rules.

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

150. Qualifications for registration.-Subject to the provisions of rule 151, a person shall be qualified to be registered as a trade marks agent if he-

- (i) is a citizen of India;
- (ii) is not less than 21 years of age;
- (iii) has passed the examination prescribed in rule 154 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 a graduate of any university in India or possess an equivalent qualification; and
- (v) is considered by the Registrar as a fit and proper person to be registered as a trade mark agent.

151. Persons debarred from registration.-A person shall not be eligible for registration as a trade marks 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 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, whether within or without 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 or by any Court beyond the limits of India;
- (vi) being a chartered accountant, has been held guilty of negligence or misconduct by a High Court; or
- (vii) being a registered trade marks agent has been held guilty of professional misconduct by the Registrar.

152. Manner of making application.- All applications under the provisions of this Part shall be made in triplicate and shall be sent to or left at that office of the Trade Marks Registry within whose territorial limits the principal place of business of the applicant is situate.

153. Application for registration as a trade marks agent.-

- (1) Every person desiring to be registered as a trade marks agent shall make an application in Form **TMA-1**.
- (2) The applicant shall furnish such further information bearing on his application as may be required of him at any time by the Registrar.

154. Procedure on application and qualifying requirements.-

- (1) On receipt of an application for the registration of a person as a trade marks 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 before him for a written examination in Trade Marks Law and practice followed by an interview. The candidate will be expected to possess a detailed knowledge of the provisions of the Act and the rules and knowledge of the elements of Trade Marks Law.
- (2) The qualifying marks for the written examination and for interview shall be forty percent and sixty percent respectively and a candidate shall be declared to have passed the examination only if he obtained an aggregate of fifty percent. of the total marks.

155. Certificate of registration.-After a candidate has been interviewed and any further information bearing on his application, which the Registrar may consider necessary has been obtained and if the Registrar considers the applicant eligible and qualified for registration as a trade marks agent, he shall send an intimation to that effect to the applicant and any person so intimated may pay the prescribed fee for his registration as a trade marks agent. Upon receipt of the prescribed fee the Registrar shall cause the applicant's name to be entered in the register of trade marks agents and shall issue to him a certificate in Form O-4 of his registration as a trade marks agents.

156. Continuance of the name in the register of trade marks agents.-The continuance of a person's name in the register of trade marks agents shall be subject to his payment of the fees prescribed in First Schedule.

157. Removal of agent's name from the register of trade marks agents.-

- (1) The Registrar shall remove from the register of trade marks agents the name of any registered trade marks 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 trade marks agents, the name of any registered trade marks 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 151; 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 clause (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 it may consider necessary.
- (3) The Registrar shall remove from the register of trade marks agents the name of any registered trade marks agent who is dead.
- (4) The removal of the name of any person from the register of trade marks agents shall be notified in the Journal and shall, wherever possible, be communicated to the person concerned.

158. 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 trade marks agent, who in the opinion of the Registrar is engaged wholly or mainly in acting as agent in applying for trade marks 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 also 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.

159. Restoration of removed names.-

- (1) The Registrar may , on an application made in Form-**TMA-2** within six months from the date of removal of his name from the Register of trade marks agents accompanied by the fee specified in the First Schedule from a person whose name has been removed under clause (b) of sub-rule(1) of rule 157, restore his name to the register of trade marks agents and continue his name therein for a period of one year from the date on which his last annual fee became due.

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

160. Alteration in the register of trade marks agents.-

(1) A registered trade marks agent may apply in Form **TMA-3** 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 trade marks 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 trade marks agents.

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

161. Publication of the register of trade marks agents.- The Registrar shall ordinarily publish the list of agents in the register of trade marks agents shall be published in the Journal from time to time, and at least once in two years together with their addresses as entered in the register, the entries being arranged in the alphabetical order of the surnames of the registered trade marks agents and copies thereof may be placed for sale.

162. 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 trade marks agents under Part V of these rules, and the decision of the Appellate Board shall be final and binding.

PART VI

PROVISIONS RELATING TO TESTING AND MARKING OF PIECE-GOODS AND YARN

163. Definitions.- For the purposes of this Part, unless the context otherwise requires-

(a) "count" in relation to yarn means the relation of length to weight thereof either in the English system or the Metric system, as follows:-

(i) The English count for yarn shall be the number of hanks each of 840 yards in length that weight one pound avoirdupois or in other words the number of yards of yarn that weight 8.3 grains.

(ii) The metric count for all yarn with the exception of raw and prepared silk shall represent the relation between 1000 meters of yarn to 500 grammes or 2 metres to 1 grammes or in other words half the number of hanks (each of 1,000 metres length) that weigh 500 grammes.

The English system of counts may be converted into the metric system of counts and *vice versa* by the following formulae:-

The English count No. of yarn $\times 0.847$ the metric count. The metric count No. of yarn $\times 1.181$ -the English count.

(iii) The metric count for raw and prepared silk shall be the weight in grams of 10,000 metres of yarn.

(b) "Customs collector" shall have the meaning assigned to the term in the Customs Act, 1962 (52 of 1962).

164. Testing for length and width of piece-goods.-

(1) In testing for length of piece-goods such as are ordinarily sold by the length or by the piece the measurement shall be made along the selvage.

(2) In testing piece-goods aforesaid for width the cloth shall be measured by each of the following methods and the mean of the measurements so taken shall be adopted. Care shall be exercised in applying each method to select a portion of the cloth where the creases are fewest, and the warp and weft respectively as straight as possible:

(a) A double-fold of the cloth shall be laid on the table and the creases smoothed out, so that it may lie perfectly flat. The measuring rod shall then be placed across the cloth, and the finger and thumb run down the rod on each side of it across the cloth so as to once more flatten the creases. Care shall be taken in doing this to see that whilst the creases are smoothed out, stretching is avoided and the warp threads remain perpendicular to the rod. The measurement shall then be recorded.

(b) A fold of the cloth shall be taken, and the doubled edge held between a finger and thumb at each end, and extended over the measuring rod which shall be kept flat on the table. The extension shall be sufficient to remove the creases but not to stretch the warp out of the perpendicular.

165. Allowances for peculiarities of cloth and for stretching.-

(1) In taking the measurements aforesaid the peculiarities of the cloth under measure shall be taken into consideration and due allowances be made for these characteristics.

(2) If owing to the peculiarities of the cloth it is found difficult to determine a reasonable degree of tension for purposes of measurement, the mean between stretching to the full and not stretching, shall be adopted.

(3) The influence of stretching for length on the width shall always be taken into account in measuring cloth. Where the cloth has been stretched lengthwise in the making, it will lose in length as the weft is straightened to measure the width. It may then have to be ascertained, whether the trade description of length does not become false in the process of making that for width correct. To ascertain this a measurement along the selvages both lengthwise and across shall be made.

166. Testing of yarns. - Yarns may be tested by the customs- collector for length and count when he has reason to suspect or on information by any informant that the trade description is false.

167. Number of samples to be selected.- A testing of yarns to test the accuracy of the description of count or length shall be made, in the first instance, up to the limit of one bundle in every one hundred bales or fractions of one hundred bales in a consignment.

168. Further testing.-If, on such testing the difference between the average count or length and the described count or length is in excess of the variation permitted in the notification issued by the Central Government under section 121 of the Act, the importer or any other person having any claim to or in relation to, goods in question or otherwise interested may apply for a further testing.

169. Manner of selection and testing of Samples.-The test to determine length of yarns shall be as follows:-

(i) From every one hundred bales, or fraction of 100 bales, in a consignment one bundle, shall be selected at random. The hanks in this bundle shall then be measured on the warp wheel one after the other, in the presence of the importer or any other person interested as is referred to in the last foregoing rule, or his representative and the length noted, the process

being continued (within the limits of the bundle) until either the importer or other person, as the case may be, is satisfied that the yarn is short, or the average of the lengths noted shows that it is of full length.

- (ii) When the importer or other person is dissatisfied with the test aforesaid he may, on payment of the cost, require the customs-collector to measure more hanks up to one percent of the total number of hanks in the consignment, such hanks being taken at random by an officer of the customs out of any bundles in the consignment.

170. Stove Test.-

(1) The stove test may be applied by the customs officers only in cases where weighment by the ordinary methods shows the weight of the yarn to be short or in which the feel and appearance of yarn indicate that it is abnormally moist or over-conditioned or where the importer demands the test. Where the test is carried out on demand by the importer, the fee levied for carrying out the test shall be returned if the test fails to support the original determination of count and length by the customs officers. If more than one application of the test is demanded a further fee shall be levied for each fresh test, the whole sum charged being retained or refunded according to his final decision on the results of the tests.

(2)

- (a) In carrying out the stove test, in the case of cotton yarn a regain of 8 1/2 per cent shall be added to the weight obtained after the yarn is reduced to an absolute dry conditions, and the figure so obtained shall be regarded as the actual weight of the yarn under normal conditions.
- (b) In the case of silk, or woollen or other yarns other than cotton yarn the regain to be added to the weight obtained after reducing such yarns to dry condition shall be according to the table of officials standards supplied with the stove test apparatus.

171. Place of testing.-The testing of piece-goods and yarn referred to in rules 164 to 170 shall be made at the customs laboratories or at such place and by such officer as the customs-collector may direct.

172. Security.-The customs-collector may require from any informant referred to in rule 166 security not exceeding five hundred rupees and where he is satisfied that the information given is willfully false, the security shall be forfeited.

STAMPING OF PIECE-GOODS COTTON YARN AND UNDER SECTION 81

173. Piece-goods.- "Piece-goods such as are ordinarily sold by length or by the piece" (hereinafter referred as "piece-goods") shall for the purposes of section 81 of the Act or the Customs Act, 1962 (52 of 1962) include cotton piece-goods, woollen piece-goods, silk piece-goods, art silk piece-goods of synthetic fibre and other piece-goods of mixed fabrics, shall not include the following descriptions of goods namely:-

- (a) Alhambras, except Alhambras quiltings.
 - Blankets.
 - Blind Cloth in cut-pieces.
 - Book-Binding cloth in cut-pieces.
 - Buckrams in cut-pieces.

Carpets (in rolls).
Counterpanes.
Decatising wrappers.
Dusters in woven pieces.
Embroidered all-overs and embroidered saris of all sorts.
Embroidered flounces.
Filter cloth.
Glass cloth in woven pieces.
Handkerchiefs in woven pieces.
Laces and nets including Cotton Brettone nets.
Lace curtain cloth.
Pillow Calico (Tubular)
Prayer Mats.
Press cloth in cut pieces.
Quilts.
Rugs.
Sarongs upto 2 ½ yards 2.28 metres in length.
Shawls (finished) with ends hemmed or fringed, imported singly or in pieces, containing two or more shawls.
Sponge Cloth (for swabs).
Teddy Bear or imitation Seal Skin Cloth.
Towels in woven pieces.
Woollen cleaner cloth.
Woollen knitted cloth
Woollen roller cloth.
Woollen sizing Flannel.

(b)

- (i) Cotton remnants or cut lengths measuring less than fifteen yards (or fourteen meters) which are not in current ordinary trade practice sold by length or by the piece;
- (ii) Fents regardless of their length, which are so defective owing to accidents in the weaving, dyeing or printing that they are not ordinarily capable of being sold by length or by the piece.

174. Stamping of piece-goods.-

(1) Piece-goods which have been manufactured, bleached, dyed, printed or finished in India in premises which are a factory as defined in the Factories Act, 1948 (63 of 1948) shall be stamped with the particulars required under sub-section(1) of section 81.

(2) In the case of piece-goods manufactured outside India (each piece shall be marked with the name of the manufacturer, exporter, or wholesale purchaser in India of the goods and with the real length of the piece in standard yards or in standard metres as required under the Customs Act, 1962 (52 of 1962)).

175.Cases where requirement as to stamping may be waived.-

(1) The customs-collector may not detain any unstamped piece-goods if he is satisfied that although they are not mentioned in the list of excepted goods under rule 173 they are of such a nature that they would be liable to serious depreciation in value if stamped;

Provided , however, where a customs-collector exercises his discretion under this sub-rule, he shall forthwith report the case, sending a sample of the goods to the Central Government through the Central Board of Revenue, so that the question of issuing general orders in favour of such goods may be considered.

(2) Cotton and woollen piece-goods imported for the personal use of individuals or private associations of individuals and not for trade purposes need not be stamped.

176.Nature of stamping required.-

(1) In marking the length of the piece-goods the words "yards" or "yds" "metres" shall accompany the numerals, and in the case of cut-lengths or pieces of the kind other than that described in clause (b) of rule 173, the number of pieces shall be marked as well as the yards or metres on the front or outer face fold of the cut-piece, the figures being presented in a way to show clearly what they are intended to mean.

(2) The length shall be in standard yards or fractions of such yards or standard metres or fractions of a metre and shall represent the actual length of the goods, and not the length before shrinkage or dryage, resulting from processes such as dyeing, or from atmospheric changes which can reasonably be foreseen. Marking in inches or centimetres may be permitted on cloths of small dimensions and delicate make in accordance with the custom of the trade.

(3) The marking shall be such that it is not likely to be removal except by washing the fabric or in the case of goods that are not ordinarily washed, it shall be of such a nature that it is not likely to be obliterated in the ordinary course of handling before the goods reach the purchaser.

(4) The marking shall be conspicuous and in a different colour from that of the fabric, upon the fabric itself, and not upon a removable label or ticket. The marking shall not be upon an inner fold which cannot readily be seen, nor upon a wholly detached piece, but it may be upon piece that is partly detached without being entirely severed. In the case of sarongs which are required to be stamped, the stamping may be made on the selvage in the inner fold instead of one the uppermost fold of the cloth. Marks which are stitched on the fabric and are easily removable by cutting shall not be permitted.

177. Languages and numerals to be used for marking.-All markings required by sub-section (2) of section 81 shall be in English and the international form of Indian numerals shall be used.

178.Indications of weight, length, name of manufacturer etc.,

(1) The weight of yarn or thread in each bundle or unit shall ordinarily be indicated thereon in pounds or ounces in the English system or in grammes according to the metric system.

(2) The length of threads in each bundle or unit shall be indicated thereon in yards or metres.

(3) The name of the manufacturer or of the wholesale purchaser in India shall be indicated in full or, provided that the said name is clearly and unambiguously indicated thereby in an abbreviated form, on each bundle or unit.

179.Manner of marking cotton yarn and cotton thread.-

(1) Each bundle of cotton yarn shall be marked with the particulars required under Sub-section (2) Section 81 of the Act by one or more inscribed wrappers, labels or cards applied, affixed or stitched thereto, provided that all the required particulars shall be contained on the exposed surface.

(2) Units of cotton thread shall be marked with the required particulars-

- (a) when made up in skeins, by an inscribed label applied round each skein or bundle of skeins or secured by twine thereto;
- (b) when made up in balls, by an inscribed label attached to each ball, or inserted therein but remaining exposed;
- (c) when wound on cards, wheels, or stars, by inscription on the exposed portion of the card, wheel or star;
- (d) when wound on reels, by one or two inscribed label applied to the end or ends of the reel;
- (e) when wound on paper tubes or cones, by an inscribed label applied round or otherwise affixed to the thread or to the exposed portion of the outer surface of the tube or cone, or, where the diameter of the tube or cone is sufficient for the label to be clearly exposed to views, to the inner surface of the tube or cone, or, by inscription on the exposed portion of the outer surface of the tube or cone;
- (f) when made up in any other form, by an inscribed label or card applied, affixed or stitched to or enclosed or inserted in, such make up.

(3) Labels or cards used in accordance with sub-rules (1) and (2) shall be so applied as not to be easily detachable or removable from a bundle of cotton yarn or from each unit of cotton thread in the ordinary course of handling before it reaches the normal consumer.

180. Marking of cover.- Where units of cotton thread are enclosed in a cover, such cover shall be marked with the required particulars.

181. Markings to be clear and distinct.-All markings on bundles of cotton yarn or units of cotton thread shall be legible, distinct and in a colour which is not likely to be easily obliterated and which shall be different from the colour of the surface marked.

182. Manner of expressing count of cotton-yarn.-The count of cotton yarn shall ordinarily be expressed in English the metric system by adding the letter 'S' after the numeral or numerals where, however, a bundles is packed on the metric system, the count shall be accompanied by the words "metric count" or by some other clear and definite indication conveying the fact and in the absence of such words or indication the marking shall be regarded as indicating that it is in the English system.

183. Indication of other particulars.- Nothing in rules 177 shall be construed as prohibiting the indication in any manner of other particulars relating to the cotton yarn or cotton thread so long as the conspicuousness of the required particulars is not affected thereby.

184. Exemptions.-All premises where the work is done by members of one family with or without the assistance of not more than ten other employees and all premises controlled by a co-operative society where not more than twenty workers are employed in the premises shall be exempted from the operation of rules 177 to 182.

PART VII

REPEAL

185. Repeal.- The Trade and Merchandise Marks Rules, 1959 are hereby repealed without prejudice to anything done under such rules before the coming into force of the rules.