

# Trade Marks (Amendment) Act, 2010

February 26, 2013

## Section 1. Short title and commencement

### **TRADE MARKS (AMENDMENT) ACT, 2010<sup>1</sup>**

[No. 40 OF 2010]

[21st September, 2010]

An Act to amend the Trade Marks Act, 1999

Be it enacted by Parliament in the Sixty-first Year of the Republic of India as follows—

Prefatory Note—Statement of Objects and Reasons.

At present, a person desirous of obtaining registration of his trade mark in other countries has to make separate applications in different languages and pay different fees in the respective countries. There is no provision under the Trade Marks Act, 1999 (hereinafter referred to as the Trade Marks Act) to facilitate Indian nationals as well as foreign nationals to secure simultaneous protection of trade marks in other countries.

2. The Madrid Protocol, administered by the International Bureau of the World Intellectual Property Organisation, a specialised agency of the United Nations, was adopted in 1989. The Madrid Protocol is a simple, facilitative and cost-effective system for international registration of trade marks. It enables the nationals of the Member countries of the Protocol to obtain protection of trade marks within the prescribed period of 18 months by filing a single application with one fee and in one language in their country of origin, which in turn is transmitted to the other designated countries through the International Bureau.

3. Accession to the Madrid Protocol entails amendments to the Trade Marks Act. For this purpose, it is proposed to suitably amend the Trade Marks Act and to incorporate therein a new Chapter IV-A containing special provisions relating to protection of international registration of trade marks under the Madrid Protocol. It is sought to empower the Registrar of Trade Marks to deal with international applications originating from India as well as those received from the International Bureau and maintain record of international registrations. Definitions of new terms are being given. It is further proposed to provide for the effect of international registration, duration and its renewal.

4. It is also proposed to remove the discretion of the Registrar to extend the time for filing notice of opposition of published applications and provide for a uniform time limit of four months in all cases. Further, with a view to simplify the law relating to transfer of ownership of trade marks by assignment or transmission and to bring the law generally in tune with international practice and modern business needs, Section 45 is proposed to be modified. It is also proposed to omit Chapter X of the Trade Marks Act dealing with special provisions for textile goods, as it has now become redundant.

5. The Bill seeks to achieve the above objects.

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**1. Received the assent of the President on September 21, 2010 and published in the Gazette of India, Extra., Part II, Section 1, dated 22nd September, 2010, pp. 1-4, No.**

(1) This Act may be called the Trade Marks (Amendment) Act, 2010.

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

## Section 2. Amendment of Section 11

In Section 11 of the Trade Marks Act, 1999 (47 of 1999) (hereinafter referred to as the principal Act), in the Explanation, for clause (a), the following clause shall be substituted, namely—

“(a) a registered trade mark or an application under Section 18 bearing an earlier date of filing or an international registration referred to in Section 36-E or convention application referred to in Section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks;”.

## Section 3. Amendment of Section 21

In Section 21 of the principal Act, for sub-section (1), the following sub-section shall be substituted, namely—

“(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.”.

## Section 4. Amendment of Section 23

In Section 23 of the principal Act, in sub-section (1), after the words “register the said trade mark”, the words “within eighteen months of the filing of the application” shall be inserted.

## Section 5. Insertion of new Chapter IV-A

After Chapter IV of the principal Act, the following chapter shall be inserted, namely—

### ‘Chapter IV-A

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

36-A. Application of Act in case of international registration under Madrid Protocol.—



The provisions of this chapter shall apply to international applications and international registrations under the Madrid Protocol.

### 36-B. Definitions.

In this chapter, unless the context otherwise requires,—

(a) “application”, in relation to a Contracting State or a Contracting Organisation, means an application made by a person who is a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organisation, as the case may be.

#### Explanation

For the purposes of this clause, “real and effective industrial or commercial establishment” means and includes any establishment where some bona fide industrial or commercial activity takes place and need not necessarily be the principal place of business;

(b) “basic application” means an application for the registration of a trade mark filed under Section 18 and which is used as a basis for applying for an international registration;

(c) “basic registration” means the registration of a trade mark under Section 23 and which is used as a basis for applying for an international registration;

(d) “common regulations” means the regulations concerning the implementation of the Madrid Protocol;

(e) “contracting organisation” means a Contracting Party that is an inter-governmental organisation;

(f) “contracting party” means a Contracting State or Contracting Organisation party to the Madrid Protocol;

(g) “contracting state” means a country party to the Madrid Protocol;

(h) “international application” means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;

(i) “international bureau” means the International Bureau of the World Intellectual Property Organisation;



(j) "international registration" means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;

(k) "Madrid Agreement" means the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on the 14th day of April, 1891, as subsequently revised and amended;

(l) "Madrid Protocol" means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time.

36-C. Trade Marks Registry to deal with international applications.

Notwithstanding anything contained in sub-section (3) of Section 5, an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.

36-D. International application originating from India.

(1) Where an application for the registration of a trade mark has been made under Section 18 or a trade mark has been registered under Section 23, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application corresponding to the particulars appearing, at the time of the certification, in the application under Section 18 or the registration under Section 23, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall within the prescribed period, forward the international application to the International Bureau for Registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under Section 18 or the registration under Section 23, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect:

Provided that where an appeal is made against the decision of registration and an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(6) The Registrar shall, during the period of five years beginning with the date of international registration, transmit to the International Bureau every information referred to in sub-section (5).



(7) The Registrar shall notify the International Bureau the cancellation to be effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case may be.

#### 36-E. International registrations where India has been designated.

(1) The Registrar shall, after receipt of an advice from the International Bureau about any international registration where India has been designated, keep a record of the particulars of that international registration in the prescribed manner.

(2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in India should not be granted or such protection should be granted subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires, refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the advice referred to in sub-section (1) was received.

(3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), he shall within the prescribed period cause such international registration to be advertised in the prescribed manner.

(4) The provisions of Sections 9 to 21 (both inclusive), 63 and 74 shall apply mutatis mutandis in relation to an international registration as if such international registration was an application for registration of a trade mark under Section 18.

(5) When the protection of an international registration has not been opposed and the time for notice of oppositions has expired, the Registrar shall within a period of eighteen months of the receipt of advice under sub-section (1) notify the International Bureau its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.

(6) Where a registered proprietor of a trade mark makes an international registration of that trade mark and designates India, the international registration from the date of the registration shall be deemed to replace the registration held in India without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the register referred to in sub-section (1) of Section 6.

(7) A holder of international registration of a trade mark who designates India and who has not been extended protection in India shall have the same remedy which is available to any person making an application for the registration of a trade mark under Section 18 and which has not resulted in registration under Section 23.

(8) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than India has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration in India shall cease to have effect.

#### 36-F. Effects of international registration.



(1) From the date of the international registration of a trade mark where India has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark to India, the protection of the trade mark in India shall be the same as if the trade mark had been registered in India.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark.

36-G. Duration and renewal of international registration.

(1) The international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period.

(2) Subject to payment of a surcharge prescribed by the rules, a grace period of six months shall be allowed for renewal of the international registration.

## Section 6. Substitution of new section for Section 45

For Section 45 of the principal Act, the following section shall be substituted, namely—

“45. Registration of assignments and transmissions.—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of such assignment or transmission to be entered on the register.

(2) The Registrar may require the applicant to furnish evidence or further evidence in proof of title only where there is a reasonable doubt about the veracity of any statement or any document furnished.

(3) Where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court and in all other cases the Registrar shall dispose of the application within the prescribed period.

(4) Until an application under sub-section (1) has been filed, the assignment or transmission shall be ineffective against a person acquiring a conflicting interest in or under the registered trade mark without the knowledge of assignment or transmission.”

## Section 7. Omission of Chapter X

Chapter X of the principal Act shall be omitted.

## Section 8. Amendment of Section 150

In Section 150 of the principal Act, in sub-section (1), for the word “applications”, the words “applications, international applications” shall be substituted.

## Section 9. Amendment of Section 157

In Section 157 of the principal Act, in sub-section (2),—

(a) for clause (vii), the following clause shall be substituted, namely—

“(vii) the manner of giving a notice of opposition and the fee payable for such notice under sub-section (1) and sending counter-statement under subsection (2) and submission of evidence and the time therefor under sub-section (4) of Section 21;”;

(b) after clause (ix), the following clauses shall be inserted, namely—

“(ix-a) the time within which the international application is to be forwarded to the International Bureau and the manner of certifying the particulars by the Registrar under sub-section (4) of Section 36-D;

(ix-b) the manner of keeping a record of particulars of an international registration under sub-section (1) of Section 36-E;

(ix-c) the manner of informing the International Bureau under sub-section

(2) of Section 36-E;

(ix-d) the manner of advertising the international registration and the time within which the international registration shall be advertised under sub-section

(3) of Section 36-E;”

(c) after clause (xiii), the following clause shall be inserted, namely—

“(xiii-a) the period within which the Registrar shall dispose of an application under sub-section (3) of Section 45;”

(d) clauses (xxvi), (xxvii) and (xxviii) shall be omitted.

## Section 10. Power of Central Government to remove difficulties

(1) Notwithstanding anything contained in Section 156 of the principal Act, if any difficulty arises in giving effect to the provisions of this Act, the Central Government may, by order published in the Official Gazette, make such provisions not inconsistent with the provisions of this Act as may appear to it to be necessary for removing such difficulty:

Provided that no order shall be made under this section after the expiry of five years from the commencement of this Act.

(2) Every order made under this section shall, as soon as may be after it is made, be laid before each House of Parliament.



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