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NEW RULE TO OFFICIALLY DECLARE TRADE MARKS AS WELL-KNOWN IN INDIA

India has introduced a new set of rules for trade mark prosecution under the Trade Marks Rules, 2017 (the “New Rules”), effective 6 March 2017.

One of the major changes introduced by the New Rules is an option for official declaration of trade marks’ well-known status. Other key changes include the increase in the official fees, reduced timelines for filing evidences in opposition proceedings, provision for filing MP3 files along with the sound mark applications, simplification of application forms for various purposes, etc.

The registration of trade marks’ well-known status is a much awaited change, which will help the well-known trade mark owners to enforce their trade mark rights in India more efficiently. Prior to this, trade marks were regarded as well-known in India only if a court of law or the Intellectual Property Appellate Board (the “IPAB”) had declared so. Further, the Trade Marks Registry (the “Registry”) has been maintaining a register of well-known trade marks. However, this register included only the trade marks declared as well-known by a court or the IPAB. Therefore, the new option to register a trade mark as well-known eliminates the cumbersome requirement to get a trade mark declared as well-known through legal proceedings.

However, the rules on well-known declaration lack clarity on certain aspects, such as the detailed procedure for examination of application, timeline for filing objections by the third parties, timelines for disposing of applications, appeal procedures, the renewal process, consequences of rejection of the well-known application and option for re-filing, and so on. We anticipate that the Registry will soon provide clarity on these aspects.

Please find below the steps for the official declaration of trade marks’ well-known status.

The Application Procedure

An application in the prescribed form (Form M) must be filed in the Registry for a trade mark’s well-known status declaration. (Rule 124 of the New Rules)

The Guidelines for filing well-known applications issued by the Registry dated 22 May 2017 (the “Guidelines”) require the following supporting documents to be filed along with the application:

- i. A statement of case describing the applicant's rights and well-known claim in the concerned trade mark; and
- ii. Following documentary evidence in support of the applicant's rights and claim:

- a. Use of the trade mark;

[ANA Comment: Copies of the advertisements, invoices, articles published about the products/services under the trade mark, annual reports of the trade mark owner, etc., can be filed to substantiate the trade mark's use. These can be in respect of both international and India.]

- b. Any applications made for registration or any registration obtained in respect of the trade mark;
- c. Annual sales turnover of the applicant's business carried out under the trade mark;
- d. The number of actual or potential customers of goods or services under the trade mark;
- e. Publicity and advertisement of the trade mark, and the expenses thereof;
- f. The knowledge or recognition of the trade mark in the relevant section of the public in India and abroad.

[ANA Comment: Ranking given by any prominent ranking agencies, accolades, articles published about the brand in popular journals, market survey reports, etc., can be filed in support of knowledge or recognition of the trade mark in the relevant section of the public in India and abroad.]

[ANA Comment: The Guidelines do not specify whether it is mandatory to submit all the aforesaid documents and information, or provide much practical guidance in that regard. As information such as publicity expenses may be confidential for certain brand owners, we feel that the Registry will provide more clarity in the coming days on the nature and extent of documents and information to be submitted. In the meantime, it is advisable to file maximum possible documentary evidence to support the well-known claim.]

- iii. Additionally, a copy of the judgement of any Indian Court or the Registrar of Trade Marks, which has declared or recognized the trade mark as a well-known trade mark can also be filed in support of the application.

Benefit of Well-Known Declaration

Once a trade mark is declared as "well-known", the protection will be available to that trade mark across all goods and services irrespective of whether the trade mark has been registered or used in India. The declaration can also be used to strengthen the ground of "dilution" in infringement cases

in courts. Therefore, this initiative will significantly help to protect the international well-known brands in India from conflicting trade marks.

Costs

The official fees for filing an application for declaration as a well-known trade mark is INR 100,000 (USD 1540 approximately).

Objections to Well-Known Applications

Upon receipt of the application, the Registrar will examine the application and the supporting evidence, and may issue an office action in case of any objections or further requirements. Thereafter, if found appropriate to be declared as a well-known trade mark, the Registry will publish the details of the trade mark presumably in the Trade Marks Journal, to invite objections from the public. Any person can file an objection in writing with reasons for the objections along with supporting documents, if any. Thereafter, a copy of the objection may be communicated to the applicant for comments. The Registrar's final decision regarding the objection will be communicated to both the parties. In case the trade mark is declared as well-known, it will be notified in the Trade Marks Journal and will be included in the list of well-known trade marks maintained by the Registrar.

Timeline for Disposal of Well-Known Applications

The New Rules or the Guidelines have not prescribed any time limits to declare a trade mark as well-known or to dispose of the application for declaration.

Validity and Renewal of Well-Known Designation

The New Rules have not prescribed any validity period for a trade mark's well-known designation or for its renewal.

Rejection of Well-Known Applications and its Consequences

The New Rules do not provide any clarity on the consequences of a well-known application's rejection, such as whether the rejection will nullify the applicant's well-known claims in Indian legal proceedings, how many times the applicant can re-file the application, what is the appeal procedure against the Registry's order of rejection, whether the rejection orders will be available publically, etc.

We shall update you as soon as there is more clarity on this in the coming days.

Please let us know if you require any clarifications.

OUR INTELLECTUAL PROPERTY PRACTICE

ANA Law Group has a distinguished intellectual property practice and represents a niche clientele. The Firm's IP clients include top multinational corporations including a large number of pharmaceutical companies, universities and educational institutions, etc. The Firm manages the trade mark portfolios for prestigious and valuable brands across India and the SAARC countries.

The Firm's IP team comprises of Indian and internationally qualified and experienced attorneys and former senior officials of Indian IP Offices who have vast statutory and practical knowledge and exposure in all areas of IP laws. The solution-driven pragmatic IP advice coupled with speed, consistency, quality and ability to deliver under pressure are the unique attributes of the Firm's IP practice.

Additionally, our team has significant experience in franchising/licensing matters. We have done several of such transactions (pure technology, trade mark, franchise, etc.) for numerous clients across a variety of industries. As we are a full-service law firm, we bring significant value to such transactions because our corporate and regulatory team provides assistance in the exchange control and other legal issues also with respect of such transactions.

**** The content of this update does not constitute legal advice and may not be relied on as such. If you wish to seek legal advice, please contact us at mailbox@anaassociates.com.***