



# Standing Committee Report Summary

## The Trademarks (Amendment) Bill, 2007

- The Standing Committee on Commerce submitted its 84th Report on 'The Trade Marks (Amendment) Bill, 2007' on March 19, 2008. The Chairperson was Dr Murlu Manohar Joshi.
- The Bill amends the Trade Marks Act, 1999 with regard to a time limit for filing opposition to a trademark application. The Act prescribes three months, plus one month (on request) to file opposition to an application. The Bill amends this to only three months in order to do away with discretionary powers of the Registrar. The Committee suggests that while discretionary power of the Registrar should be taken away, the Bill should prescribe a period of four months for filing an opposition to registration.
- The Bill specifies the circumstances under which the Registrar shall notify the International Bureau its acceptance of extension of protection of trade mark and prescribes a limit of 18 months for disposing of a domestic application for a trademark (prescribed in the Madrid Protocol). The Committee recommends that the government should not accede to the Madrid Protocol till the Trade Marks Registry in India is sufficiently and adequately equipped to dispose of both domestic and international applications within the stipulated period of 18 months from the filing of such application.
- The definition of "application" in the Bill is also applicable to a person who has a real and effective industrial or commercial establishment. The Committee suggests that the terms real and effective should be appropriately defined in the Rules.
- The Bill prescribes that the Registrar of India has to forward an international application originating from India to the International Bureau after completing verification formalities as soon as may be. Since under the Madrid Protocol, this procedure has to be completed within two months, the Committee recommends that the time limit should be set at two months.
- The Trade Marks Act, 1999 and the Madrid Protocol states that if a person seeking an extension of registration crosses the notice period but makes an application in the prescribed format and pays the fee within six months, his registration shall be renewed. The Bill does not have such a provision with regard to international registration. The Committee proposes that a suitable provision should be inserted.
- The Committee feels that there should be no quantitative or qualitative difference in goods and services being sold under the same trade mark, in different contracting parties (any contracting state or organisation party to the Madrid Protocol), unless such a difference is due to natural causes or the laws of a contracting party. The Committee recommends that a provision with regard to uniformity of standards should be incorporated in the Bill.
- The Bill deletes provisions regarding assignment of trade mark where multiple rights are created, assignment when exclusive rights would be created in different parts of India, and assignment of trade mark without the goodwill of business. The Committee is of the opinion that such a deletion only facilitates foreign players. Therefore, it suggests that these sections should be retained.
- The Committee is of the view that there is a need for a specific provision regarding effectiveness in case there is a conflict after a person has been assigned a registered trade mark.

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