



HANDBOOK ON TRADEMARK REGISTRATION PROCEDURE IN NEPAL

APEX LAW CHAMBER

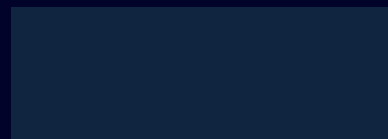
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TRADEMARK REGISTRATION IN NEPAL

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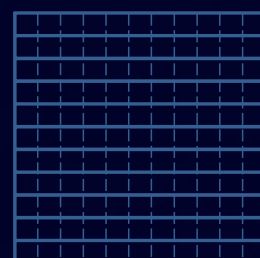
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TRADEMARK:

A trademark is a reputational asset useful to protect the intangible resources related to a specific firm/person. Section 2(c) of the Patent, Design and Trademark Act, 2022 defines trademark as a “word, symbol, or picture or a combination thereof to be used by any firm, company or individual in its products or services to distinguish them with the product or services of others”. The trademark is attracted in the case of goods while the service mark is attracted in the case of services.

HISTORICAL BACKGROUND OF TRADEMARK:

In Nepal, the history of formal registration of trademarks began with the enactment of the Patent, Design, and Trademark Act 1936 (1993 BS). The law was repealed with the enactment of The Patent, Design, and Trademark Act, of 1965 (2022 BS).

LAWS RELATING TO TRADEMARK IN NEPAL:

The Patent, Design, and Trademark Act (PDTA), 1965 (2022 B.S.) is the current governing law relating to trademarks in Nepal.

International Conventions Ratified by Nepal

1. Paris Convention for Protection of Industrial Property, 1883 (“Paris Convention”)
2. Agreement on Trade-Related Aspects of Intellectual Property Rights, 1995 (“TRIPS” Agreement)
3. Convention Establishing World Intellectual Property Organization, 1979 (“WIPO Convention”)

AUTHORIZED BODIES DECIDING ON MATTERS OF TRADEMARK:

The Department of Industries (“DOI”) is the competent authority that registers and administers trademarks in Nepal. Any matters related to trademarks are addressed by the DOI at first instance.

APPELLATE BODY:

Section 27 of the PDTA mentions that an appeal can be filed before the High Court within 35 days if the parties are not satisfied with the order issued by the DOI.



TRADEMARK REPRESENTATIONS:

There are various terms used to denote trademark procedures. The term TM represents an unregistered trademark. The mark is used to promote or brand the goods while the registration is pending. SM stands for an unregistered service mark. The mark is used to promote brand services while registration is pending. ® stands for a registered trademark.

CLASSIFICATION OF GOODS AND SERVICES FOR TRADEMARK REGISTRATION:

Nepal voluntarily follows the International Classification of Goods and Services under the Nice Agreement. The Nice Classification is a mechanism developed by the Nice Agreement (1957) to classify goods and services for trademark applications. The Nice Classification has a total of 45 classes where the first 34 classes are assigned to goods and the remaining classes (35-45) are assigned to services.

TRADEMARK PRINCIPLE:

“First to File” principle is followed in Nepal to guarantee the protection of Trademark.

TRADEMARK SEARCH:

Trademark search is not mandatory; however, it helps in avoiding future IP clashes. It is recommended to conduct a trademark search before filing a trademark application. This

way, one can have precise information about the availability of trademarks and the existence of similar marks in response to a particular search query. Search reports can be obtained from the DOI after paying the required fees.

APPLICATION FOR REGISTRATION OF TRADEMARK:

A person wishing to register the trademark of their business shall submit to the DOI an application in a format as specified in Schedule 1(c) of section 17, PDTA.

DOCUMENTS REQUIRED FOR THE REGISTRATION OF A DOMESTIC TRADEMARK

1. An application according to the format specified in PDTA
2. Specimen of Trademark
3. Payment Receipt of NPR 1000 made for application of registration
4. Power of Attorney if the authority has been delegated, and authenticated documents disclosing the identity of the person to whom the authority has been delegated
5. Certified/notarized copy of the tax clearance certificate of the applicant company
6. Certified/notarized copy of firm/business registration certificate
7. Certified/notarized copy of the PAN registration certificate

DOCUMENTS REQUIRED FOR THE REGISTRATION OF A FOREIGN TRADEMARK

1. An application according to the format specified in PDTA
2. Specimen of Trademark
3. Payment receipt of NPR 1000 made for application of registration
4. Power of Attorney
5. Certified/notarized copy of home or foreign country registration in English

PRIORITY TRADEMARK APPLICATION:

Nepal is a signatory to Paris Convention. Accordingly, a priority trademark application can be filed in Nepal within six months from the date of filing of trademark application in the convention country. For claiming priority in Nepal an application along with certified/notarized copy of the priority documents needs to be submitted before the DOI.

EXAMINATION:

Formality Examination: The submitted documents are examined by the DOI to determine whether the documents are appropriate according to the prevailing laws.

Substantive Examination: Examination is conducted by the DOI determining both absolute and relative grounds.

OPPOSITION:

Opposition can be filed within a period of 90 days from the date of publication of a trademark in the Industrial Property Bulletin. If no opposition is filed within the prescribed time, the trademark proceeds for registration.

TIME PERIOD:

It takes around one year for a trademark to be registered in Nepal.

CANCELLATION:

Section 18(3) of PDTA mentions that the DOI can cancel any trademark application/registered trademark if damages any individual/institution's trademark reputation or if the trademark is found to be registered in the name of another person.

NON-USE CANCELLATION:

The DOI may cancel the registered trademark if it is not brought into use within one year from the date of registration as per section 18C of PDTA.

RENEWAL:

Section 18D of PDTA specifies that the term for a trademark shall remain valid for a

period of **seven years**. A trademark must be filed within 35 days after the date of expiry. If a party fails to renew their trademark even after the term of 6 months grace period, the registered trademark will be cancelled in accordance with section 23B (2) PDTA.

PUNISHMENT FOR THE INFRINGEMENT:

Unauthorized use of a trademark is regarded as trademark infringement. Section 19 of PDTA specifies that any person involved in trademark infringement activity shall be punished with a fine not exceeding One Hundred Thousand Rupees along with confiscation of goods connected with such offense as per the gravity of the offense.

RESTORATION OF A TRADEMARK:

There is no provision for the restoration of a trademark in Nepal. A party is required to re-register a trademark if their previous registration has expired in the records of the DOI. The procedures for a new registration should be followed.

RECORDAL OF CUSTOM:

Recordal of custom is available for the registered trademark in Nepal.

OFFICIAL FEES:

PURPOSE (For Trademarks Only)	AMOUNT
Application	NPR 1000
Amendment	NPR 500
Registration	NPR 5000
Assignment	NPR 2000
Recordal	NPR 1000
Search	NPR 500
Opposition	NPR 1000
Cancellation	NPR 1000
Duplicate Certificate	NPR 2000
Renewal	NPR 3500

DISCLAIMER

We hereby inform all the readers that this article is for information purposes only and should not be considered as legal advice. For further information or legal consultation, please contact our trademark lawyers.

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