

A draft of

Manual of Trade Marks

Practice & Procedure

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भारत सरकार
वाणिज्य और उद्योग मंत्रालय
कार्यालय महानियंत्रक एकस्व अभिकल्प एवं व्यापार चिन्ह
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General Objective of the Trade Marks Manual

The draft Manual of Trade Marks Practice and Procedure is being published to bring uniformity and consistency of practice with respect to the various procedures involved in the administration of the Trade Marks Act and it is hoped that the manual will be useful for the officers of the Trade Marks Registry and the users of the system. Indeed, section 98 of the Trade Marks Act gives statutory recognition to “practice of the Trade Marks Registry” as an important aspect in determination of legal proceedings on appeal before the Appellate Board.

For greater understanding and transparency, the manual attempts to explain the practice and procedure of the Trade Marks Registry by categorizing the issues outlined in three parts: underlying concepts, the requirements from the stakeholder and the office action involved as per the provisions of Trade Marks, 1999 and rules made thereunder.

The manual is in the nature of a guide for the users and, if any of the statements in this document are at variance or inconsistent with the provisions of the Act or the Rules, the latter shall prevail. Wherever appropriate, reference to case laws representing decisions of Courts in India have been made to facilitate better understanding of the law. The Manual will be finalised after receipt of comments of the stakeholders on this draft and careful consideration of the same. It is expected that the manual will be updated from time to time in the light of important judgments and decisions of courts involving interpretation of the provisions of the Act and Rules.

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Chapter I:
Filing of a Document in Trade Marks Registry

This chapter deals with filing of a document/new application in the Trade Mark Registry for registration of a Trademark or in relation to an earlier application for registration of a trademark.

This chapter is divided in to two parts i.e. Section A and Section B. Section A deals with general filing requirements for any document in trademarks registry and Section B deals with specific additional requirements related to trademark applications (TM 1, TM 2, TM 51, etc.).

Section A: General Filing Requirements

This section of the chapter covers the general requirements for filing any application, notice or request under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) or Trade Marks Rules 2002 (hereinafter referred to as “the Rules”).

Sr. No.	General Description	Relevant provision of the Act & Rules
1	<u>How a document/s can be filed</u>	
General Requirement	<p>A document can be filed by a person or his duly authorized agent at the appropriate office of the Trade Marks Registry as defined in Rule 4 of the Trade Marks Rules 2002, which includes the Head office (at Mumbai) or branch offices (at Ahmedabad, Chennai, Delhi, Kolkata) of the <u>Registry</u>. However, certain documents as specified under Rule 8(2) may either be filed at the Head office of the Trade Marks Registry or at the appropriate office while some documents as specified under Rule 8(2) (c) may only be filed at the Head office of the Trade Marks Registry (unless the Registrar directs otherwise).</p> <p>Appropriate office of the Trade Marks Registry for the purpose of filing a document is the office within the territorial jurisdiction of which the principal</p>	Section 18, Rules 4, 8 & 15

		<p>place of business of the applicant in India is situated. Detailed provisions about the appropriate office for various categories of applicants are provided in Rule 4.</p> <p>The document may be filed by delivery at the front office personally or by sending by post, or submitting electronically through the gateway provided in the official website i.e. ipindia.nic.in.</p> <p>All offices of the Trade Marks Registry are open for receipt of fee bearing documents from 10 am to 3.30 pm, on all working days. Non fee bearing documents can be filed at any time during office working hours.</p> <p>Electronic filing of documents can be done at all hours (24x7).</p>	
2		<u>Filing of documents -</u>	
2.1	Requirement from the applicant	<p>Requirements as to form</p> <p>The requirements in respect of documents as specified in the Rules are set out below:</p> <ul style="list-style-type: none"> • Documents must be in English or Hindi • Documents must be neatly handwritten or typewritten or printed upon strong paper of good quality and of size of approximately 33 cm X 20 cm. and shall have on the left hand part thereof a margin of not less than 4 cm. • Contents of the documents must be on one side of the paper in a deep permanent ink. • The contents of the documents must be in large and legible characters. • The signature of the persons signing a document and the date of signature must be placed immediately at the end of the document. • The name of the person signing a document must be legibly written in English or Hindi in capital letters beside the signature of that person. • An alteration made in a document before it is filed at the Trade Marks Registry should be initialed in the margin by the person signing the document. 	Rules 8, 13,14 and 15

2.2	Requirement from the applicant	<p>Requirements as to content</p> <p>Applications, notices and some requests filed at the Trade Marks Registry are required to be in a prescribed form.</p> <p>The application, notice or request should generally include the following details, depending upon the nature of the document:</p> <ul style="list-style-type: none"> • Trade mark number(s) in relation to which certain action is to be taken; • Name and address for service of person(s) making the application, notice or request (if the application, notice or request is made by the proprietor of the trade mark, the proprietor's address is also generally required); • Name of the proprietor of the trade mark if the proprietor is not the person making the application, notice or request; • Details and grounds of the action that is to be performed; and • Any other information or documentation that be relevant to enable action to be taken; • The appropriate class or classes, in relation to which the application is filed • Proprietor code or agent code if allotted, • Signature(s) of person(s) or on behalf of the person(s) making application, notice or request and the name of signatory. • Date and place of filing <p>Note: In case of online filing of the document, digital signature will be considered as signing of the document. <i>Details about e-filing are given at ---</i></p>	
3	Concept	<u>When last date of filing is a public holiday</u>	

		If a document is due to be filed on a date that is a weekend or a public holiday, the due date becomes the next day on which the Registry is open except when the document is filed online.	
4		<u>Documents must be signed and dated</u>	
4.1	Concept	<p><u>Who can sign?</u></p> <p>An application, notice or request must be signed by or on behalf of the person making the application.</p> <p>If the application, notice or request is made by more than one person (as defined in section B of Chapter 1) and it is not signed by an agent on behalf of all the persons, the document must be signed by each person in whose name the application, notice or request is made.</p> <p>A legal practitioner or a registered trade mark agent or a person in the sole and regular employment of the principal can sign on behalf of a person making an application, notice or request.</p> <p>A document on behalf of a partnership firm shall be signed by at least one partner stating that he is signing on behalf of the firm.</p> <p>A document on behalf of a body corporate shall be signed by a director or by the secretary or other principal officer of the body corporate and the capacity of the individual signing the document shall be stated below his signature.</p>	Section 145, Rule 14
4.2		<u>Applicant should supply an address for service</u>	
4.2.1	Requirement from the applicant	<p>A person making an application, notice or request or the proprietor of a trade mark, or a person whose claim to an interest or right in a trade mark is recorded in the Register and who has no principal place of business in India, must supply an address for service in India.</p> <p>Indian applicants may also mention address for service in India.</p> <p>Note:</p>	Section 143 Rules 18 and 19

		While filing a document, the applicant/agent should provide email address for electronic communication from the Registry.	
4.2.2	Requirement from the applicant	An address for service to which documents from the Trade Marks Registry (or other parties) are served or given must be an address in India.	Section 18 (3)
4.2.3	Requirement from the applicant	An address for service of a person who has filed an application, notice or request is the address for service stated in the application, notice or request, unless the person notifies the Registrar of another address. An address for service in India should be provided by every applicant or by joint applicants or by the proprietor of a trade mark, who has principal place <i>of business in India</i> at the date of making the application for registration but has subsequently ceased to have such place.	Rule 18 & 19
4.2.4	Requirement from the applicant	A change in an address for service must be notified in writing to the Registrar, by way of request on form TM-16 or TM-50 along with prescribed fee.	Section 8(4), 22, 58, Rules 41, 91, 96, 97
4.2.5	Office Action	Any document that must be served on, or given or sent to a person by the Registry may be <i>left</i> at or sent by post to the address for service of the person. Where there are multiple applicants or multiple persons making a single notice or request, and more than one address for service is given, the correspondence should only be sent to first addressee.	Sec. 143 Rule 15
4.3		Fees	
	Requirement from the applicant	All applications, notices and requests should be accompanied by the fees as prescribed in First Schedule of the Trade Marks Rules 2002. Fees can be paid in cash or by a bank draft or a cheque drawn on a scheduled bank at the place where the appropriate office of the Trade Marks Registry is situated. Bank drafts and cheques should be crossed. Online payment may be made through payment	Rule 11(5) & 25(19)

		gateway provided in the official website i.e. ipindia.nic.in.	
5		Non-compliance of filing requirements	
		<p>If a document received for filing at the Trade Marks Registry fails to comply with the <i>Act</i> or the Rules regarding the filing of documents:</p> <p>In case of fee bearing documents wherein appropriate fee has not been paid, the concerned document shall be deemed not to have been filed. The document shall be deemed to have been filed only when the appropriate fee is received.</p> <p>Dishonor and non realization of a cheque shall be treated as appropriate fee not having been paid.</p> <p>Non realization of Demand Draft for any technical reasons shall also be treated as appropriate fee not having been paid.</p> <p>In case of non fee bearing documents, the documents will not be accepted if it is unsigned or does not contain the referred application /opposition / rectification / RU/CC number.</p>	Section 150 Rule 11(2) & 11(5)
6		Filing process	
6.1	Office Action	Every document shall be received through the FRONT OFFICE module of the Trade Marks System (TMS).	
6.2	Office Action	All documents addressed to the Registrar of Trade Marks shall be received by the office superintendent or in his/her absence, by the Assistant/clerk of the section.	
6.3	Office Action	The superintendent of the R&E section shall open the document on receipt through post. Fee bearing document shall be sent to cash counter and the same will generate fee receipt through system. Acknowledgment shall be generated in case of non fee bearing documents.	
6.4		The front office shall affix a stamp (with the signature of the official concerned) on all the documents received. The stamp should include <i>the date</i> on	

		which the document is received, <i>the amount of fee</i> , if any, and <i>indication of the office of the Registry</i> at which the document is filed. The document so filed shall be given system generated receipts/acknowledgments which contains, as applicable, the <i>name of the office</i> , the <i>receipt number</i> , <i>date and time</i> , <i>details of the person filing the document</i> , <i>TM forms filed</i> , <i>reference number</i> , <i>the person on whose behalf the document is filed</i> , <i>amount of fees paid</i> and the <i>mode of payment</i> .	
6.5	Office Action	The data entry shall be made in the EDP module. The device marks shall be separately scanned in original colours and shall be uploaded in the system.	
6.6	Office Action	R&E section shall digitalize all incoming papers/documents and upload the same in the system through the appropriate module viz. Application, Opposition, Post Registration, RU, and Copyrights. Correspondence shall be transferred to the appropriate section.	
6.7	Office Action	In Post Registration requests where multiple marks are involved in a single request, scanned copies of documents shall be uploaded against every registered trademarks covered in the request.	

Section B: Filing of Trade Mark Application

This section deals with the provisions for filing of a trade mark application which are supplemental or additional to the general filing requirements as given in section A of Chapter I. An applicant making an application for registration of a trademark shall, in any case, have to comply with the general filing requirements.

In Addition to the above it also gives glimpse of formality requirement in relation to the acceptability of a trademark application to move towards examination.

As part of the examination of an application for registration of a trademark u/s 18 (4) and 18 (5), the Registrar must determine as to whether the application has been made in accordance with the Trade Mark Act 1999 (here in after the Act) and / or Trade Marks Rules 2002 (here in after the Rules) or not.

Sr. No.		General Description	Relevant provision of the Act & Rules
1		<u>Filing of Trade Mark Application</u>	
1.1	Concept	<p><u>Who can file a Trade Mark Application</u> A person who claims to be the proprietor of the trade mark in relation to goods and /or services may apply for the registration of a Trade Mark.</p> <p>For the purpose of making an application of Trademarks, "Person" includes: A Natural Person, A Body Incorporate, A Partnership Firm, HUF, Association of Persons (in case of collective Trademarks), Joint Proprietor A Trust, A Society, or A Government Authority/Undertaking</p>	Sec. 18 (1)
1.2	Concept	<p><u>Jointly owned trademark:</u> When two or more persons who use a trademark independently or propose so to use it, as joint proprietors, they may apply for registration of a trade mark as joint proprietors.</p> <p>The circumstances under which two or more persons may apply for registration of a trade mark are set out in Section 24 (2) of the Act.</p>	Section 24
1.3	Concept	<p>The Trade Mark being applied for registration may be:</p> <ul style="list-style-type: none"> • already in use or • proposed to be used or intended to be used or • intended to be assigned to a company that is about to be formed and registered under Companies Act 1956 with a view to use thereof in relation to those goods and services by the company. 	Section 18(1)
1.4	Concept	<p><u>Identification of proprietor before applying for a trademarks:</u> The person applying for registration of a trademark must be clearly identified as the proprietor.</p>	

2		Details Required from the Applicant	
2.1	Requirement from Applicant	<p><u>In case of Individual</u></p> <p>The <i>full</i> name of the applicant is required. A business name or trading style is not acceptable as the name of an individual. This is because a business name or trading style does not denote the nature of applicant (legal entity) - it is more in the nature of an alias for the purposes of a trade mark application: If a trading style or business, name is included on the Application in addition to the name of an individual applicant, those details will be captured separately.</p>	
2.2	Requirement from Applicant	<p><u>In case of Joint owners</u></p> <p>In case of joint owners, the full name of each of the joint owners, whether individuals or companies, is essentially required. A trading style or business name is not acceptable as the name of the joint owners and, if given in addition to the joint owners, such names will be recorded separately.</p>	
2.3	Requirement from Applicant	<p><u>In case of Partnership Firm</u></p> <p>The names of all the partners are essentially required to be mentioned in an application filed by a partnership firm.</p>	
2.4	Requirement from Applicant	<p><u>In case of Companies</u></p> <p>The name under which a company is incorporated is required. A trading style or business name, if given, will be recorded separately.</p> <p><u>Abbreviations of the type of company are acceptable. Annex A1 at the end of this Part contains a list of abbreviations of types of companies which are recognized as bodies corporate.</u></p>	
2.5	Requirement from Applicant	<p><u>In case of Government Departments</u></p> <p>Where the applicant is a government department, the traditional form of the name of the applicant is “<i>the Government of India /State of _____ (followed by the name of the department) represented by _____ (name of the authorized person followed by the name of department)</i>”.</p>	
2.6	Requirement from Applicant	<p><u>In case of statutory organizations/public sector undertakings:</u></p> <p>Reference should be made to the statute under which such organization/undertaking is discharging its</p>	

		functions. The application can be made in the name of the organization/undertaking as “Life Insurance Corporation of India (established under the Act) through its authorised signatory and executed in the manner prescribed by the rules regulating it.	
2.7	Requirement from Applicant	<u>If applied as Conventional application</u> – The address of the applicant’s home country in addition to his address for service in India is to be provided.	
2.8	Requirement from Applicant	Statement of Use: A statement of user showing the date since when the mark is used by the applicant or by his predecessor in title has to be mentioned in the application, unless the trade mark is proposed to be used, which is to be mentioned specifically. The statement of user will not be allowed to be changed subsequently.	Rule 27
2.9	Requirement from Applicant	Clear Specification of goods / Services: The specification of goods and/or services should not be unrealistically broad otherwise it will impinge on the scope of use or intended use by others. In such cases, the Registrar may require a declaration to confirm the intended use of the trade mark.	[Rule 25(15)]
3		<u>Form of the Application:</u>	
3.1	Requirement from applicant	Applicants should submit their applications in the relevant prescribed forms given in Schedule II of the Trade Marks Rules 2002. Specific directions given in some prescribed forms with regard to filling up the form must be complied with.	Section 18, Rule 12(1) Rule 13(1), Rule 14(2)
4		Information required in the Application Form	
4.1	Requirement from applicant	Application must contain the following information: <ul style="list-style-type: none"> • Name of the proprietor(s) • Valid email id • Principle place of business • Address for service • Type of Mark, i.e. Word, Label, Device etc, • In case of Convention Applications, only single priority date should be claimed; separate applications should be filed if different priority dates are claimed for different goods and/or services. 	Sec 143, Rule 16, 18, 19 Rules and 19

		<ul style="list-style-type: none"> • Two additional representation of the mark, • Description of the trade mark including whether it is a shape or colour trade mark • (When a proprietor of a trade mark applies to register the trade mark, he or she is seeking statutory protection for the trade mark. The proprietor must define sufficiently in the application what is to be protected so that protection can be afforded). • Class numbers under which description belongs (as per classification determined and published by the Registrar at official web site), • Specification of goods and services (as per list of items published in the classification) • If applied mark contains words in a language other than English/Hindi and/or characters other than Roman/Devnagari: translation and transliteration of the applied mark, • Signature and full name of signatory • Designation of signatory and the capacity under which the application is signed. <p>Note: <i>all the above mentioned information should be legible and clear</i></p>	
4.2	Requirement from applicant	<p><u>Representation of the Trade Mark</u></p> <p>The representation of the trade mark must clearly identify the trade mark and should be in the prescribed manner as provided in the application form. It should show clearly all the features of the trade mark. Additionally, in the case of a trade mark that consists of a 3 dimensional mark or colour combination it is necessary to make a statement to that effect in the application. The representations must be durable and satisfactory.</p>	Rule 15, 28, 30 (1),
4.3	Requirement from applicant	<p><u>Requirement of graphical representation</u></p> <p>As a trade mark must be able to be represented graphically for registration. The Registrar will, as a matter of practice, require that the representation of the trade mark that is included in the application must be a graphical representation. Each trade mark consisting of or containing colours, shape or packaging must also be accompanied by a concise</p>	Section 2(zb)

		and accurate description of the trade mark. Such descriptions will be entered as an endorsement and, taken together with the graphical representation, will help to define the scope of the registration. The onus remains with the applicant to provide a suitable representation of the trade mark.	
4.4	Requirement from applicant	<p><u>Size of The Trademarks</u></p> <p>The size of the representation of the trade mark should, where practicable, be no larger than 8cm x 8cm. Where a series of trademarks is applied for and the representations of the trade mark are together and more than 8cm x 8cm then, the representation of each trade mark in the series should, where practicable, be no larger than 8cm x 8cm and must be attached to the application.</p>	Rule 28 Section 15(3) Rule 25(10)
4.5	Requirement from applicant	<p><u>The representation must</u></p> <ul style="list-style-type: none"> • show all the features of the trade mark clearly, • be of a quality that ensures all the features of the trade mark will be preserved over time, and • be suitable for reproduction. 	
4.6	Requirement from applicant	<p><u>In case of series Trademarks:</u></p> <p>Where a series is claimed and one trade mark is in black and white and the others <i>in</i> colour or where the series is for a number of trade marks in different colours, an endorsement in the application required –</p> <p><u>Where the first representation is in black and white and subsequent ones coloured:</u></p> <p><i>The second trade mark in the series of trademarks is depicted in the colour, and as shown in the representation attached to application form.</i></p> <p>(This would be repeated for subsequent trade marks in the series.)</p> <p><u>Where there are two trade marks in the series:</u></p> <p><i>The coloured trade mark in the series of trademarks is depicted in the colours and as shown in the representation attached to the application form.</i></p> <p><u>Where all the trade marks in the series are coloured:</u></p> <p><i>The first trade mark in the series of trademarks is depicted in the colours and as shown in the</i></p>	

		<i>representation attached to the application.</i> (This would be repeated for subsequent trade marks in the series.)	
4.7		<u>In case of Shape trademarks</u>	
4.7.1	Requirement from applicant	The applicant must state on the application form that the application is for a shape trade mark. If this is not stated but it is fairly clear, because the trade mark has been depicted in a three-dimensional (3-D) drawing, then the examiner should query whether or not the trade mark is in fact a shape trade mark.	Rule 29(4)
4.7.2	Requirement from applicant	The representation of a shape trade mark or a trade mark containing a shape should, where practicable, be in the form of a perspective drawing that shows clearly all the features of the trademark. The parts of the configuration claimed to constitute the representation must be accompanied by a concise and accurate description of the trade mark. This description will be entered as an endorsement of the registration and will thereby serve to help define the scope of the registration. There should be no discrepancy between the representation and the description and generally the description should refer to the representation to make clear what the relationship between them is.	Rule 29(4)
4.7.3	Requirement from applicant	Where more than one view of the trade mark is filed, representation of the each view of trade mark should (where practicable, in the size of not larger than 8cm x 8cm) be attached to the application or uploaded along with application if filed online.	
4.7.4	Requirement from applicant	If the representation of the trade mark provided by the applicant does not show clearly all the features of the trade mark, the Registrar may require up to 5 further views of the trade mark.	
4.7.5	Requirement from applicant	If the description or representation of the trade mark is not satisfactory as it does not demonstrate the nature of the trade mark sufficiently or able show each feature of the trade mark sufficiently, the applicant may be asked to provide a description or further description of the trade mark and a specimen of the trade mark within one month from the date of issuance of the letter. If the applicant fails to comply	Rule 36

		the requirement, the application may be treated as abandoned.	
4.7.6	Requirement from applicant	<p>Black and white or colour photographs of shape trademarks which have been mounted on good quality paper will be acceptable as representations of the trade mark. They must, however, be able to be reproduced for the purposes of advertisement. If there are doubts as to how the photograph/s would reproduce, a black and white photocopy should be taken. If the photocopy is clear then the photographs are acceptable - if not then the applicant should be requested to furnish clear photographs. A maximum of two copies of each photograph may be required. In case of online filing the photographs should be scanned uploaded along with application.</p> <p>Photographs should be clear originals as the office will not accept <i>photocopies of photographs</i>. <i>Nor will "instant" type photographs be accepted as these fade over time.</i></p>	
4.8		<u>In case of trademarks: as Combination of Colours</u>	
4.8.1	Requirement from applicant	<p>If the applicant is claiming a combination of colours, as applied to the goods or their packaging or as used in relation to their services, as a trade mark, they should claim this by identifying the trade mark as a colour trade mark on the application form. The exact description of the colour combination as per International Classification System of Colours (to be verified) As well as supplying a graphical representation of the trade mark, the applicant must also provide a concise and accurate description of the trade mark on the application. The description, which should state precisely what the mark consists of and how the description relates to the representation, will be entered as an endorsement of the registration and will thereby help define the scope of the registration. An example of a suitable form of description for a trade mark which consists of a combination of colours applied to a pharmaceutical capsule would be:</p> <p>The trade mark consists of a maroon colour applied to one half of a capsule at one end, and a gold colour applied to the other half, as illustrated in the representation on the application.</p>	Rule 29

4.8.2	Requirement from applicant	<p>Application for the registration of the trade mark shall be submitted in triplicate with five copies of additional representation.</p> <p>Representations of the trademark in additional representation / application shall correspond exactly with one another.</p> <p>Additional representation shall consists specification and classes of goods / services for which the registration is sought, name and address of the applicant, name and address of the agent, if any, the period of use, if any, and such other particulars required by registrar from time to time.</p> <p>If an applied trademark is claimed as combination of colour, it is required to submit one reproduction of mark in black & white and rest four in colours.</p> <p>The reproduction furnished shall consist of three different views,</p> <p>If registrar considers that the reproduction is not able to show all features of three dimensional mark he may call upon to furnish within two months up to five further different views and a description by words of the marks,</p> <p>If registrar considers the furnished different views is not sufficiently show the particulars of the trade marks, he may call up the specimen of the trade marks.</p> <p>If the applied trade mark consists of shape of the goods of its packaging, the reproduction furnished by the applicant shall consist of the five different views and a description by words of the marks.</p> <p>If registrar considers the furnished different views is not sufficiently show the particulars of the trade marks, he may call up the specimen of the goods or packaging as the case may be.</p>	
4.8.3	Requirement from applicant	<p>If a trade mark is always used in particular colours, a different form of endorsement would be required. This situation is most likely to occur when a trade mark which is lacking in Capability to distinguish is shown through evidence of use to be capable of distinguishing when used in particular colours. Acceptance for registration may be allowed on the <i>basis</i> of a limitation to colour.</p> <p>endorsement <i>will be as follows:</i></p>	

		<p><i>Registration of this trade mark consists of colours ...</i></p> <p><i>Note:</i></p> <p><i>If an applicant chooses to limit to some colours, the same form of endorsement would be the appropriate one.</i></p>	
5		A representation that includes words in a language other than English/Hindi and/or characters other than Roman /Devnagari characters.	
5.1	Requirement from applicant	Where a trade mark includes words in a language other than English/Hindi and/or characters other than Roman/Devnagari characters, the applicant must file an English/Hindi translation and/or transliteration in support of the trade mark application.	Rule 33
5.2	Officer Action	An endorsement must be entered on the Register for all trademarks containing words in a language other than English/Hindi and/or characters other than Roman/Devnagari characters.	
5.3	Office Action	Where an applicant has provided the translation / transliteration, an endorsement will be entered on the system.	
5.4	Office Action	Where no translation / transliteration have been provided, the examiner should request <i>one</i> and enter the appropriate endorsement on the <i>system</i> when the information has been received through TM-16. In absence of the compliance of such request, Application shall be deemed to have been abandoned for non-compliance.	
5.4	Office Action	<p>In the case of the trade mark containing words not in English / Hindi, the form the endorsement should take is as follows: <i>The applicant has provided that the translation of the</i> <u>(NATIONALITY / LANGUAGE)</u> <i> words</i> <i>appearing in the trademark is...</i></p> <p>Where the trade mark contains words in characters that are not Roman/Devnagari characters, the form of endorsement should be as follows: <i>The applicant has provided that the</i> <u>(NATIONALITY / LANGUAGE)</u> <i> characters</i> <i>appearing in the trade mark may be transliterated as</i> ... <i>which may be translated into English as...</i></p>	
5.5	Concept	The information provided by applicants in formality	

		related matters should be accepted as correct unless otherwise found during the examination.	
6		<u>Specification of the goods and/or services for which registration is sought</u>	
	Concept	An application for registration of a single trade mark may be made in respect of goods and/or services in one or more classes. Note: The applicant should specify the goods and/or services in relation to which the application is made. A specification that claims registration for all goods, products or services etc. in a particular class would be regarded as too wide.	Section 18(2)
6.1	Requirement from applicant	The applicant must specify, in the manner set out in the Rule 103, the goods and/or services in respect of which the registration is sought.	Rule 103
6.1.1	Requirement from applicant	Where the application is in respect of more than one class the goods and/or services it must be grouped together according to class number.	
6.1.2	Requirement from applicant	A class number <i>must</i> be selected for each group of goods and/or services. Where the application is in respect of more than one class the goods and/or services must be grouped together according to class number and the groups of goods and/or services must be presented in ascending numerical order of the class number.	
6.1.3	Requirement from applicant	As far as practicable, the applicant should specify the goods and/or services for which registration is sought in terms appearing in the Classification as published by the Registrar This listings are available through Trade Marks Registry or on website www.ipindia.nic.in	Section 7
6.1.4		Adequate information regarding the goods and/or services should accompany any specification where the goods and/or services cannot be described using the terms preferred at 6.1.3 above.	
6.2		<u>Limitations on the specification.</u>	
	Concept	Limitations exist as to the scope of the goods and/or services that may be claimed in a specification.	Section 29(2)

		<p>These limitations have been included in the legislation in light of the fact that infringement action under the provisions of the <i>Trade Marks Act 1999</i> may be taken in respect of unauthorized use of a trade mark on:</p> <p><i>goods of the same description as that of goods (registered goods) in respect of which the trade mark is registered; or</i></p> <p><i>services that are closely related to registered goods; or</i></p> <p><i>services' of the same description as that of services (registered services) in respect of which the trade mark is registered; or</i></p> <p><i>goods that are closely related to registered services</i></p> <p><i>present Act (TM Act 1999) has a much broader provision than that which exists under the <i>Trade & Merchandise Marks Act 1958</i> as in the latter infringement actions was limited to cases where the goods in relation to which the unauthorized use occurred were exactly the same as the goods for which registration was granted, it is therefore anticipated that applicants will now limit their specifications to goods and/or services that reflect their current and/or intended future trading activities. To do otherwise would be to their own detriment in that they would leave their registrations open to non-use actions, in which the onus now lies on the registered owner to show that they have used or there is an intention, in good faith, to use the trade mark on all the goods and/or services specified.</i></p>	
6.2.1	Concept	<p>Use of the expressions, "all goods", "all services", "all other goods" and "all other services" in a specification of goods and/or services in respect of which registration is sought is prohibited. Use of these expressions or equivalent expressions such as "all items" or "all products" will not be accepted as the whole or part of a specification. Where an application is made in respect of specific goods and/or services but also includes one of the above non-specific expressions in the specification, that application will be taken as filed but the applicant will be requested, as soon as practicable after filing, to delete the prohibited expression. If, at the time of examination the expression has not been deleted, the</p>	Rule 25(15)

		examiner will again require the expression to be deleted. Additional items will not be able to be entered in its place.	
6.2.2	Concept	<p>An application may not claim as part of the specification of goods and/or services a range of goods or services in a particular class which, in the Registrar's opinion, is unrealistically broad in that in commercial terms it is highly unlikely that the applicant would deal in or provide that range of goods or services. In such instances the applicant may not be able to demonstrate that the trade mark is used or intended to be used on all the goods and/or services specified.</p> <p>For example if the applicant specified the class heading of class 9 the Examiner may consider the specification unrealistically broad and advise the applicant accordingly. To overcome the problem, the applicant would need to confirm his or her intention to use on all the goods or services specified in that broad specification by making a declaration to the Registrar in the form of an Affidavit. This Affidavit is required to satisfy the Registrar that the application meets the requirements of Rule 25(15) of the Act in respect of all the items specified for the class <i>or</i> classes in question. Alternatively, the applicant may wish to amend the specification in a manner that limits the scope of the application to a more commercially realistic range of items. It <u>should be</u> noted that the provisions of Rule 25(15) will usually be invoked only in relation to a wide range of goods or services within a class, rather than a wide range of items across classes</p>	Rule 25(15)
6.3		<u>Problems with a specification</u>	
6.3.1	Office Action	While a preliminary check of classification is made as part of the check for compliance with minimum filing requirements, it is the examiner's responsibility to ensure that the goods and/or Services have been properly specified and classified. For a single class application, this includes checking that the goods or the services are in the class that has been selected for the application. For a multi-class application the examiner must check that the goods or the services	

		grouped within each of the designated classes are properly classified. The following problem may arise.	
6.3.2	Office Action	<p>If single application is filed for goods or services falling in more than one class but some of the goods and/or services specified fall not in that class but in other classes, the applicant has the option of either deleting the goods and/or services which do not fall in the nominated class, or of classes to cover those items. Additional fees will be required to add additional classes providing divisional fee and class fee paid.</p> <p>The examiner should advise the applicant <i>of</i> these options. If the applicant chooses to add class, the examiner should advise what additional fees are required and also advise that examination of the applied Trademark related to ability of registration will not proceed until the fees are paid.</p> <p>Note Where an item of goods or a service is properly classified in the class nominated but could also fall into classes not nominated, it will be taken that the applicant only wished to specify the good or service in the class nominated. No further enquiry will be made and no additional classes will be added.</p>	Rule 25(19)
6.3.3	Office Action	Where only one class has been nominated but goods and/or services in more than one class have been specified and the applicant has paid the fees for the extra classes, the examination will continue and the applicant will be required to consent to the insertion of the appropriate class numbers.	
7		Signature and Date	
	Requirement from the Applicant	The application form must be signed and dated.	Rule 25(1)
	Requirement from the Applicant	The application must be signed by the applicants or a person authorized to sign the application on their behalf. Persons who may sign on behalf of the applicant are defined to section 145 who is (a) legal practitioner (b) Trade Marks Agent (c) a person in the sole and regular employment of the principal.	Section 145
	Requirement	If the application was signed on behalf of the	

	from the Applicant	applicant/s, the name and designation of the person who signed the application must be given so that it can be determined if the person who signed the application had authority to do so.	
	Requirement from the Applicant	Where an application for registration of a trade mark is in the name of a <i>trustee</i> or <i>trustees</i> it should be signed by the managing trustee <i>or</i> trustees or a person who is empowered to sign on behalf of the trustee or trustees.	
	Requirement from the Applicant	If persons who are not authorized to sign have done so, such as an accountant who is not in the sole employment of the applicant, then the applicant should be requested to have an authorized person sign the application form.	
	Requirement from the Applicant	If the application is in the name of more than one person and the individuals themselves signed the application, rather than someone on their behalf, each individual must sign the application form.	
	Requirement from the Applicant	The name of each signatory must be written legibly (preferably in block capitals) under or beside the signature. This is so that <i>the</i> person who signed the application can be identified.	
	Requirement from the Applicant	Where the application form has not been dated, no request should be made for the applicant to provide this information. The date on which the application was signed is not vital information as the filing date is the date of receipt in the Office which is based on the "fee stamp date".	
8		Fees:	
	Requirement from applicant	The application should be submitted along with the appropriate fee as per Schedule I. Where the specification exceeds 500 characters, excess character fee is payable in form TM-61.	Rule 11(3) & (4) Rule 25 (16)
9		<u>Consequences of non-compliance of filing requirements</u>	
	Office Action	The Registrar will notify the applicant of deficiencies in the application with respect to the filing requirements and allow the applicant one month time to rectify the same. If the deficiencies are not rectified in the time allowed, the application may be treated as	Rule 36

		abandoned.	
10		<u>Data Entry</u>	
	Office Action	<p>The data entry shall be made in the EDP module. The device marks shall be separately scanned in original colours and shall be uploaded in the system.</p> <p>Data entries shall be verified by officer in-charge of Receipt and EDP Section.</p> <p>After verification the application moves through the TMS system for examination except where the application contains a device mark. In such a case, the application moves for Vienna codification.</p>	
11		<u>VIENNA Codification</u>	
	Office Action	<p>In the VIENNA CODIFICATION SECTION (VCS), the authorized officials shall codify the figurative elements of the trade marks appearing in the application for registration. The officials of the VCS shall enter codes as per the “International Classification of the Figurative Elements of Marks under the Vienna Agreement” and enter the application codes in the specified module of the TMS system.</p> <p>Thereafter the application moves through the TMS system for examination.</p>	

Chapter II

Examination of Applications filed for Registration of Trademarks

Introduction and Scope

Once the data entry of an application for registration of a trademark is made and digitization of the trademark application & other connected documents, if any, is complete, the application is allotted to an examiner for examination of application under the provisions of the Trademarks Act & Rules.

The word 'Examiner' hereinafter includes any officer assigned the duty of examination of applications.

The allotment of applications to existing examiners for the purpose of examination is done automatically through the Trade Marks System and strictly in order of the date and time of submission of applications.

However the applications in which request for expedited examination is made on form TM-63 and the same is approved by the officer in charge of the Receipt & EDP Section of the respective branch of the TMR, these applications shall be allotted for examination on priority basis.

The Examiner ordinarily gets a lot of 20 applications in his account. The Examiner looks at the **application detail** and the original **application (viz TM-1, TM-51, etc.)** and scrutinizes the application as to-

- a. *whether the application has been filed in the manner as prescribed in the Trademarks Rules 2002*
- b. *whether the trademark applied for registration can be refused registration(- on relative grounds and/or absolute grounds) under the Trademarks Act 1999, if yes, the reasons; and*
- c. *whether any restriction, condition or limitation is required to be imposed, in case the application is accepted for registration*

The Examiner shall thoroughly examine the application as above and make a search of earlier trademarks which are identical with or similar to the mark being examined and shall prepare his consolidated examination report through the system containing therein, as for as applicable,-

- i. all the objections relating to formality requirements as to filing of application,
- ii. objections to acceptance of the application for registration of the trademark under Section 9, 11 and other Sections of the Trademarks Act 1999, and

- iii. proposals for conditions of acceptance or limitation to use of the mark, in case the application is accepted for registration.

In case the Examiner is unable to examine the application thoroughly because of any formality requirement, for example, the trademark is in a language other than English or Hindi, he may ask the applicant to comply the requirements and he may defer the examination, till the requirements are complied with.

In this document any reference to ‘the applicant’ in connection with *communication of any document* to him or *compliance of any requirement* or *reply* by him shall hereinafter include reference to the authorised agent of the applicant, unless otherwise appears from the context.

This chapter deals with practice and procedures involved in examination of trademark applications.

Sr. No.		General Description	Relevant provision of the Act & Rules														
1.		Identification of Nature of Application															
1.1	Office Action	<p>The examiner shall identify the nature of the application for registration, on the basis of the form submitted.</p> <p>The prescribed forms for various types of applications are as follows-</p> <table border="1" data-bbox="507 1332 1161 2047"> <thead> <tr> <th data-bbox="507 1332 1038 1384">Type of application</th> <th data-bbox="1038 1332 1161 1384">Form</th> </tr> </thead> <tbody> <tr> <td data-bbox="507 1384 1038 1496">Application for registration of trademark for goods or services included in any one class</td> <td data-bbox="1038 1384 1161 1496">TM-1</td> </tr> <tr> <td data-bbox="507 1496 1038 1646">Application for registration of trademark for goods or services included in any one class and with priority claim under Section 154</td> <td data-bbox="1038 1496 1161 1646">TM-2</td> </tr> <tr> <td data-bbox="507 1646 1038 1758">A single application for registration of trademark for different classes of goods or services</td> <td data-bbox="1038 1646 1161 1758">TM-51</td> </tr> <tr> <td data-bbox="507 1758 1038 1908">A single application for registration of trademark for different classes of goods or services and with priority claim under Section 154</td> <td data-bbox="1038 1758 1161 1908">TM-52</td> </tr> <tr> <td data-bbox="507 1908 1038 2020">Application for registration of Collective mark for goods or services included in any one class</td> <td data-bbox="1038 1908 1161 2020">TM-3</td> </tr> <tr> <td data-bbox="507 2020 1038 2047">Application for registration of</td> <td data-bbox="1038 2020 1161 2047">TM-64</td> </tr> </tbody> </table>	Type of application	Form	Application for registration of trademark for goods or services included in any one class	TM-1	Application for registration of trademark for goods or services included in any one class and with priority claim under Section 154	TM-2	A single application for registration of trademark for different classes of goods or services	TM-51	A single application for registration of trademark for different classes of goods or services and with priority claim under Section 154	TM-52	Application for registration of Collective mark for goods or services included in any one class	TM-3	Application for registration of	TM-64	Schedule I to the Trademarks Rules 2002
Type of application	Form																
Application for registration of trademark for goods or services included in any one class	TM-1																
Application for registration of trademark for goods or services included in any one class and with priority claim under Section 154	TM-2																
A single application for registration of trademark for different classes of goods or services	TM-51																
A single application for registration of trademark for different classes of goods or services and with priority claim under Section 154	TM-52																
Application for registration of Collective mark for goods or services included in any one class	TM-3																
Application for registration of	TM-64																

		Collective mark for goods or services included in any one class with priority claim under Section 154		
		A single application for registration of Collective mark for different classes of goods or services	TM-66	
		A single application for registration of Collective mark for different classes of goods or services with priority claim under Section 154	TM-67	
		Application for registration of Certification mark for goods or services included in any one class	TM-4	
		Application for registration of Certification mark for goods or services included in any one class with priority claim under Section 154	TM-65	
		A single application for registration of Certification mark for different classes of goods or services	TM-68	
		A single application for registration of Certification mark for different classes of goods or services with priority claim under Section 154	TM-69	
		An application to register a series trademarks under for a specification of goods or services included in a class or classes	TM-8	
		An application to register a series trademarks for a specification of goods or services included in a class or classes, with priority claim under Section 154	TM-37	
1.2	Office Action	In case the application is not on proper form, the examiner shall examine the application as per the nature of the application submitted irrespective of the form number mentioned and require the applicant to correct form of the application by filing a request on form TM-16. The objection, for example, should be raised as follows- <i>The application is made on form TM-1, for certification mark in respect of goods or services falling in a class, the form of the application should be corrected as TM-4 by filing a request on form TM-16.</i>		
2		Ensuring the appropriate name of the Applicant:		
2.1	Office action	The examiner shall ensure that the name of the applicant claiming to be proprietor of the trademark is properly mentioned in the application.		

2.2	Concept	<p>Section 18 of the Trade Marks Act states that ‘<i>any person</i> claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark...’</p> <p>An application for registration of a trademark may be made by/on behalf of an Individual, a Company, Society, Trust, Government body or a Public Sector Undertaking, a Partnership firm or two or more individuals in business together who jointly own a trademark. The circumstances under which two or more persons may apply for registration of a trademark are set out in section 24 of the Act.</p> <p>If the applicant is Individual-</p> <p>The full name of the individual is required. A business name or trading style is additional information which shall be provided along with the name of the individual.</p> <p>The applicant name, in such case, should be like <i>“Ram Kumar Verma, an Indian National trading as Verma Trading Company”</i></p> <p>If the applicant is Company</p> <p>A company may make an application for registration of a trademark in its own corporate name. The nature of registration, country of incorporation and the law under which the company is registered, are to be mentioned.</p> <p>The applicant name, in such case, should be like <i>M/s Singh Industries Limited, a company registered in India under Indian Companies Act 1956</i></p> <p>A company being an incorporated body has its own identity other than its directors, therefore a director of the company cannot be the applicant, although the application can be signed and submitted by him, if he is so authorised.</p> <p>If the applicant is Firm</p> <p>A partnership firm may make the application, in such case, the names of all partners shall be mentioned, like <i>A, B, C, & D trading as M/s XYZ, an Indian Partnership Firm registered under Indian Partnership Act 1932.</i></p> <p>When partnership includes a minor in the partnership, the name of guardian representing the minor shall also be mentioned.</p>	Section 18
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	<p>If the applicant is Trust</p> <p>Application may be made on behalf of a trust. In such case, the name of its managing trustee/chairman representing the trust should also be mentioned.</p> <p>The applicant name, in such case, should be like <i>M/s XYZ, a trust registered in India under Indian Trust Act 1882, and represented by Mr X, its Managing Trustee.</i></p> <p>If the applicant is a Society</p> <p>Application may be made on behalf of a society.</p> <p>The applicant name, in such case, should be like <i>M/s XYZ, a society registered in India under Maharashtra Co-operative Societies Act through its secretary Mr. A.</i></p> <p>If the applicant is Government</p> <p>The Central or State Government or any undertaking/company owned or controlled by such Government may also make application for registration of trademark like any other person. Where the applicant is a government department.</p> <p>The applicant name, in such case, should be like <i>“The Government of India/ Government of (state)___Represented by_ (name of the Department)___through its Secretary Mr. xxx</i></p> <p>If the applicant is Governmental undertaking-</p> <p>The application can be made in the name of the undertaking and executed in the manner prescribed by the rules regulating the body. When the applicant is any government undertaking, a reference shall also be made to the Authority (usually legislative) under which the undertaking functions, along with the name of the undertaking.</p> <p>The applicant name, in such case, should be like <i>M/s Life Insurance Corporation, a Public Sector undertaking established under the Life Insurance of India Act 1956</i></p> <p>If there are Joint Applicants</p> <p>Section 24 enables registration of two or more persons to be registered as joint proprietors of the trademark, where the mark is used or proposed to</p>	
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		<p>be used in relation to goods or services connected with the joint applicants.</p> <p>The applicants' name, in such case, should be like</p> <p><i>M/s XXXX a company registered in India under Indian Companies Act 1956 and M/s YYYY a company registered in India under Indian Companies Act 1956.....claiming to be joint proprietors of the trademark.</i></p>	
2.3	Office action	<p>In case the name of the applicant is not appropriately mentioned, the Examiner should raise objection as follows-</p> <p><i>The application appears to have been filed in the name of a partnership firm, names of all Partners of the firm should be brought on record by filing a request form TM-16</i></p>	
3		Ensuring the submission of the TM-48 / Power of Attorney	
3.1	Office action	The examiner shall ensure that duly stamped TM-48/Power of Attorney is filed, in case the application has been submitted by a person other than the applicant	
3.2	Concept	<p>In case the application has been not been filed & signed by the applicant but by any other person claiming to be the agent of the applicant, a power of attorney duly executed by the applicant in favour of that person on form TM-48, is required to be filed. The agent can be a legal practitioner (Advocate), a registered trademark agent or a constituted attorney (a person under sole and regular employment) of the applicant.</p> <p>A Power of Attorney in favour of a firm without the name of any individual agent or attorney should not be accepted.</p>	Section 145 Rule 21
3.3	Office action	<p>In case no proper Power of Attorney is submitted and the application has been submitted by a person other than the applicant, the Examiner should communicate objection as</p> <p><i>The application has been submitted by a person other than the applicant, a duly stamped Power of Attorney in favour of a particular agent should be filed.</i></p>	
4		Ensuring about the applicant's principal place of business	

4.1	Office action	The examiner shall ensure that the applicant's principal place of business and the address for service of the applicant is properly mentioned in the application.	
4.2	Concept	Every application for registration of trademark is required to have the principal place of business of the applicant. In case the applicant has no principal place of business in India, the applicant's address for service in India should be mentioned in the application. The applicant who has a principal place of business in India may also mention another address for service in India which may be the address of the applicant's authorised agent.	Section 18(3), 143 Rules 17 &18
4.3	Office action	If the Principal Place of business of the applicant is not mentioned, or if the applicant has no Principal Place of business in India and the applicant's address for service in India is not mentioned, the Examiner shall communicate objection as follows- <i>The Principal Place of business of the applicant should be brought on record by filing a request on form TM-16, or</i> <i>The applicant's address for service in India should be brought on record by filing a request on form TM-16, since the applicant has no principal place of business in India.</i>	
5		Ensuring transliteration and translation of trademark in non-English or non-Hindi characters.	
5.1	Office Action	If the trademark applied for registration is in a language other than English or Hindi, the examiner shall ensure that a transliteration is properly mentioned in the application.	
5.2	Concept	Where a trade mark contains a word or words in scripts other than Hindi or English, a sufficient transliteration into roman script and its translation of each such word in English shall be endorsed on the application form and the additional representations thereof, and every such endorsement shall state the language to which the word belongs and shall be signed by the applicant or his agent.	Rule 33
5.3	Office action	If the trademark applied for registration is in a language other than English or Hindi, the Examiner shall defer the examination; and communicate it as deficiency to the applicant concerned and require the applicant to provide a sufficient transliteration into roman script and its translation in English by	

		<p>filing a request on form TM-16.</p> <p>The objection, for example, should be raised as follows-</p> <p><i>The trademark applied for registration is in a language other than English or Hindi; you should provide the transliteration of the mark into roman script and its translation in English by filing a request on form TM-16.</i></p> <p><i>Only after compliance of this the application shall be further examined.</i></p>	
6		Ensuring the consent of a person or his legal representative, if the trademark contains a name or representation of that person	
6.1	Office action	If the trademark applied for registration contains a name or representation of a person, the Examiner shall ensure that the consent of that person or his legal representative is submitted with the application	
6.2	Concept	Where the name or representation of any person appears on a trade mark the applicant shall furnish 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, the consent of his legal representative, as the case may be, to the use of the name or representation.	Section 14 and Rule 34
6.3	Office action	<p>If the trademark applied for registration contains a name or representation of a person in it, and no consent of that person or consent of his legal representative (if that person is dead) is submitted, the Examiner shall communicate objection as follows-</p> <p><i>The identity of the person, whose portrait appears on the trademark, should be disclosed and the consent of that person or, the consent of his legal representative, if he is expired, should be furnished in writing.</i></p>	
7		Ensuring submission of draft regulations in case of an application for registration of a collective mark	
7.1	Office action	If the application is made for collective mark on form TM-3, TM-64, TM-66 or TM-67, the Examiner shall ensure that a draft regulation on form TM-49 regarding association of persons authorised to use the mark is submitted along with	

		the application.	
7.2	Concept	<p>The collective mark is owned by an association of persons not being a partnership. It belongs to a group and its use therefore is reserved for members of the group. The primary function of a collective mark is to indicate a trade connection with the association or organization who is the proprietor of the mark.</p> <p>In case of application for registration as collective mark a draft regulation under Section 63 of the Trade Marks Act 1999, governing the use of the collective mark is required to be submitted in triplicate, with the application on form TM-49. which shall include –</p> <ol style="list-style-type: none"> 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 <p>such other relevant particulars as may be called for by the Registrar</p>	Section 63 Rule 128
7.3	Office action	<p>If the application is made for registration of a collective mark on and no proper draft regulation on form TM-49 is submitted with the application, the Examiner shall defer the examination; and communicate it as deficiency to the applicant concerned and require the applicant to furnish proper draft regulation on form TM-49 by filing a request on form TM-16.</p> <p>The objection, for example, should be raised as follows-</p> <p><i>A proper draft regulation on form TM-49 as per Rule 128 of the Trade Marks Rules 2002 should be submitted with the application by filing a request on form TM-16.</i></p> <p><i>Only after compliance of this the application shall be further examined.</i></p>	

8		Ensuring submission of draft regulations in case of an application for registration of a certification mark	
8.1	Office action	If the application is made for Certification mark on form TM-4 or TM-65, TM-68 or TM-69, the Examiner shall ensure that a draft regulation on form TM-49 regarding competence of the proprietor for certification of relevant goods or services, is submitted along with the application.	
8.2	Concept	<p>The purpose of a certification trade mark is to show that the goods or services in respect of which the mark is used have been certified by some competent person in respect of certain characteristics such as Origin, mode of manufacture, quality etc.</p> <p>Application for registration should be made on form TM-4 or TM-65, TM-68 or TM-69 as the case may be, accompanied by prescribed fee. A draft regulation under Section 74 of the Trade Marks Act 1999 in triplicate should also be deposited on form TM-49 , which shall include</p> <ol style="list-style-type: none"> 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. 	Section 74 Rule 135
8.3	Office action	<p>If the application is made for registration of a Certification mark on and no proper draft regulation on form TM-49 is submitted with the application, the Examiner shall defer the examination; and communicate it as deficiency to the applicant concerned and require the applicant to furnish proper draft regulation on form TM-49 by filing a request on form TM-16.</p> <p>The objection, for example, should be raised as follows-</p>	

		<p><i>A proper draft regulation on form TM-49 as per Rule 135 of the Trade Marks Rules 2002 should be submitted with the application by filing a request on form TM-16.</i></p> <p><i>Only after compliance of this the application shall be further examined.</i></p>	
9		Ensuring submission of adequate priority documents, in case of applications with priority claims	
9.1	Office action	If the application is made on form TM-2, TM-37, TM-52, TM-64, TM-65, TM-67 or TM-69, with priority claim by virtue of similar application made in any conventional country, the Examiner shall ensure that documents in support of priority claim are submitted along with the application.	
9.2	Concept	<p>Section 154 (1) of the Trademarks Act, 1999 empowers the Central Government to declare any country or a group of countries or any inter-governmental organization, as a convention country, which affords to Indian citizens same privilege as granted to its own citizens.</p> <p>India has ratified the Paris Convention for Protection of Industrial Property through a gazette notification No S. O. 1041(E) dated 3rd September 1998, which came into effect from 7th December 1998. As on the date of India's ratification, there were 150 countries as members of the convention. India declared all the 150 countries as convention countries.</p> <p>According to Section 154 (2) of the Trademarks Act, 1999 where a person, who has made an application for the registration of the trade mark in the convention country, makes an application for registration of the trade mark in India within six months after the date on which the application was made in the convention country, the trade mark shall, if registered, under the Trade Marks Act, 1999 be registered as of the date on which the application was made in the convention country.</p> <p>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 is required to be included in an application for registration, and it should include the particulars of the mark, the country or countries and the date or dates of filing</p>	Section 154 Rule 26

		<p>of application.</p> <p>The application should also 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</p>	
9.3	Office action	<p>If the application is made on form TM-2, TM-37, TM-52, TM-64, TM-65, TM-67 or TM-69, with priority claim by virtue of similar application made in any conventional country, and no document in support of priority claim is submitted, the Examiner shall communicate the objection as follows-</p> <p><i>Authentic documents in support of priority claim should be filed</i></p>	
10		Examination of application as to classification of goods and services	
10.1	Office action	The examiner shall ensure that the application for registration of a trademark has been filed with proper specification of goods and/or services and with proper classification of such goods and/or services.	
10.2	Concept	<p>An application for registration of trademark is filed only in respect of specific goods or services; therefore the application is required to have an exact specification of goods or services in respect of which the registration of the trademark is sought.</p> <p>For the purpose of registration of trademark the goods or services are classified, as far as may be, in accordance with current edition of International Classification of Goods and Services (NICE Classification) published by the WIPO.</p> <p>Section 8 of the Trademarks Act, 1999 authorises and Rule 22(2) of the Trade Marks Rules 2002 requires that the Classification of Goods and Services for the purpose of registration of trademark, be published by the registrar of trademarks. Accordingly the Classification of Goods and Services for the purpose of registration of trademark have been published and put up on the office website.</p> <p>An application is filed for registration of trademark in respect of goods or services falling in a particular class of the International Classification of Goods and Services, as published by the Registrar of trademarks. Under Section 18 (2) of</p>	<p>Section 7 Rule 22</p> <p>Section 18(2)</p>

		the Trademarks Act, 1999, a single application can however be filed for registration of trademark in respect of goods and/or services falling in more than one of such classes.	
10.3	Office action	<p>In case the class of goods or services mentioned in the application is other than the relevant class of the International Classification of Goods and Services, as published by the Registrar of trademarks, and no aspect of such goods or services falls in the class mentioned in the application, the Examiner shall suggest the appropriate class for those goods or services and require the applicant to correct the class through a request on form TM-16.</p> <p><i>For example, if an application for registration of trademark in respect of 'cosmetics' is filed in class 34, the Examiner shall require the applicant to correct the class as '3' by a request on form TM-16.</i></p> <p>If some of the items of goods or services mentioned in the application is other than the relevant class of the International Classification of Goods and Services, as published by the Registrar of trademarks, but some items fall in the appropriate class, or some category of such goods or services fall in that class, the Examiner shall require the applicant to delete items not falling in the class applied and confine the goods or services which fall in that class through a request on form TM-16.</p> <p><i>For example, if an application for registration of trademark in respect of 'cosmetics', 'medicines' and 'readymade garments' is filed in class 3, the Examiner shall require the applicant to delete items 'medicines' and 'readymade garments' from the specification of goods by a request on form TM-16.</i></p> <p>However, if the application is made for registration of trademark in respect of goods or services falling in more than one class, and some items mentioned in the specification of one particular class don't fall in that class but fall in some other class, the applicant may amend the application to add additional class or classes on payment of the appropriate class fee and the divisional fee.</p>	
10.4	Office action	In case the specification of goods or services mention in the application is too wide or vague, the Examiner shall raise objection to this effect.	

10.5	Concept	<p>The application for registration of trademark in respect of <i>all goods or services</i> or <i>large variety of goods and services in a class</i>, may be refused registration unless the Registrar of trademark is satisfied that the specification is justified by the use of the mark or the applicant <i>intends</i> to make in respect of all such goods/services. Accordingly goods or services, in respect of which application of registration of trademark is made, should be specific and should not be wide or vague.</p> <p><i>Some examples of wide and vague specification are as follows-</i></p> <p><i>In Class 7, claims to ‘machines’ without further qualification should be objected to. The following gives examples of descriptions which are acceptable, since in each case the end use of the machine has been identified:</i></p> <p><i>Machines for agricultural purposes;</i></p> <p><i>Machines for use in manufacturing processes;</i></p> <p><i>Machines for the 42woolen industry</i></p> <p><i>Or other specific machines, e.g. washing machines.</i></p> <p><i>Applications filed in Class 9, which continue to make vague and generalized reference to ‘electric, electrical and/or electronic apparatus, devices, equipment and instruments’ should be objected to whether listed separately or in combination.</i></p> <p><i>The Class 42, 43 and 44 headings are acceptable, but applications which include claims such as ‘services that cannot be classified in other classes’ or ‘miscellaneous services’ will face an objection under Rule 25(15).</i></p> <p><i>The class heading to Class 45 is:</i></p> <p><i>“Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals”.</i></p> <p><i>The first part of the heading, ‘Personal and social services rendered by others to meet the needs of individuals’ is considered too vague and consequently a Rule 25 (15) objection should be raised against applications containing this description. Objections will also be taken against applications where specifications contain either ‘personal services’ or ‘social services’ as individual elements, e.g., ‘personal services</i></p>	Rule 25(15)
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		<p><i>rendered by others to meet the needs of individuals' or the like descriptions. The second part of the heading, 'security services for the protection of property and individuals' is sufficiently precise and will not attract an objection.</i></p> <p>The objection to this effect should be raised as follows-</p> <p><i>The specification of goods/services mentioned in respect of class xx, is very vague and wide. You should provide exact items in respect of which the trademark is sought to be registered, by filing a request on form TM-16.</i></p>	
11		Examination of application as to relative grounds for refusal of registration	
11.1	Office action	<p>The Examiner shall make a search of same or similar earlier trademarks in respect of same or similar description of goods or services, and in case such earlier trademarks are found in the name of persons other than the applicant, he shall raise objection to acceptance of the application for registration on relative grounds.</p> <p>The search of same/similar trademarks is performed through the Trade Marks System.</p> <p>The system enables examiner to make search with three modes-<i>word mark search, phonetic search and device mark search</i>. The system automatically selects the class(es) for search of earlier marks as per the application filed. The Examiner may also add more class(es) for search</p> <p>In the word mark mode the examiner can make search of earlier marks on the basis of selected characters as prefix or suffix.</p> <p>In the phonetic search the Examiner may specify one or two phonetic variant of the trademark, and system will fetch all earlier trademarks having phonetic similarity with the trademark applied.</p> <p>In device mark search, the system enables examiner to find out earlier trademarks having same/similar features.</p> <p>All trademarks consisting of any figurative elements, are codified as per International Classification of the Figurative Elements of Marks (commonly referred to as 'Vienna Codification'). The examiner in this mode has to put correct Vienna code(s), and the system will fetch all</p>	

		<p>trademarks bearing that Vienna code(s).</p> <p>The examiner selects same/similar earlier marks from the list of trademarks provided by the system. The details of the selected marks can be seen by the Examiner and he then finally selects conflicting marks, if the earlier marks belong to persons other than the applicant. In case same/similar earlier marks belong to the applicant the examiner shall select such marks as associated trademarks.</p>	
11.2	Concept	<p>According to Section 11(1) of the Trade Marks Act 1999 - a trade mark shall not be registered if, because of its <i>identity or similarity with earlier trade mark(s)</i> and because of <i>identity or similarity of goods or services covered by such trademarks, there exists a likelihood of confusion</i> on the part of the public, which includes the likelihood of association with the earlier trade mark.</p> <p>Explanation in Section 11 (4) of the Trade Marks Act 1999, defines earlier trade mark. Under this provision,</p> <p>“a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 36E 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 trademarks;”.</p> <p>Thus earlier trademark will include an earlier registered mark and a prior pending application</p> <p>Identical trademark</p> <p>A mark is identical with the trade mark where it reproduces without any modification or additions, all elements constituting the trade mark or where, viewed as a whole it contains differences so insignificant that they may go unnoticed by an average consumer</p> <p>Similarity of marks</p> <p>The terms similarity of trademarks is to be construed as “deceptively similar” which expression has been defined “as so nearly resembling that other mark as to be likely to deceive or cause confusion”.</p> <p>Likelihood of confusion</p>	<p>Section 11(1) Explanation in Section 11 (4)</p> <p>Section 2(1)(h) of the Trade Marks Act 1999</p>

	<p>For likelihood of confusion to exist it must be <i>probable</i>; it is not necessary <i>that actual confusion</i> has arisen or should arise in the mind of public i.e. the average consumer.</p> <p>The three most relevant factors in examination of trade mark applications by the Office will usually be</p> <ol style="list-style-type: none"> i. the similarities and differences between the respective trademarks, ii. how distinctive the earlier mark is, and iii. the degree of similarity between the respective goods or services. <p>Rules of comparison as developed over the years and as laid down Parker J. in Pianotist case should continue to be followed- (1906) 23 RPC 774 page 777.</p> <p>“You must take the two words, you must judge them by the look and by the sound, you must consider the goods to which they are to be applied, the nature and kind of customer who would be likely to buy the goods. Consider all the surrounding circumstances, as to what is likely to happen if each of those trademarks is used in the normal way as a trade mark for the goods, the respective owners of the mark. If there is likely to be confusion, the application must be refused.”</p> <p>General rules for comparison of marks</p> <p>The general well settled principles for comparison of trademarks are:-</p> <ul style="list-style-type: none"> • The trademark must be considered as a whole. It is not right to take a part of the trademark and compare it with part of the other trademark • No meticulous or letter by letter comparison is required. side by side comparison is not the correct test • Comparison should be made from the point of view of a person of average intelligence and of imperfect recollection • The overall structural, visual & phonetic similarity and similarity of the idea in the two marks and the fact as to whether it is reasonable likelihood to cause confusion should be taken into account. <p><i>Additional precautions required where the goods are medicinal preparations</i></p> <p>“Exacting judicial scrutiny is required if there is a</p>	<p>Cadila Healthcare Limited vs. Cadila Pharmaceutical Limited(AIR 2001) SC 1952,</p>
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	<p>possibility of confusion over marks on medicinal products because the potential harm may be far more dire than that in a confusion over ordinary consumer products”</p> <p>Where composite trade mark comprises different distinctive element</p> <p>In the case of composite marks comprised of two or more distinctive elements, it will often be difficult to determine that any one of those elements is dominant. For example in ‘Alexander Morgan’, where both elements contribute roughly equally to the origin identification message sent by the composite sign, which therefore depends upon the presence of both elements. Accordingly, the view is that the all the marks consisting of ‘Alexander’ or ‘Morgan’ will not be conflicting with the mark comprised of the full name, even if the respective goods are the same. The same principle is recognized in Section 17(1) of the Act which enacts that the mark must be considered as a whole.</p> <p>However if prominent and distinctive portion of a two trademarks are identical, earlier mark may be regarded as conflicting with later mark. For example <i>CROCIN PLUS</i> may be conflicting with <i>CROCIN FORTE</i> for medicines.</p> <p>It is possible for a word to be subsumed within a multiple slogan mark even though the words do not combine to form a totality with an obvious meaning. For example, it would be difficult to say that the word ‘<i>targets</i>’ has an independent and distinctive role in the composite mark ‘<i>Fashion Week Targets Friday</i>’ (for clothing). Consequently, it is not likely that it would be held to be in conflict with the mark ‘Targets’ (again assuming same goods) because it is not the dominant element of that mark, and neither is it an independent and distinctive element of the composite mark. Accordingly the trademark ‘<i>targets</i>’ should not be cited as conflicting with the trademark ‘<i>Fashion Week Targets Friday</i>’ (for clothing).</p> <p>In a different case e.g. the mark CAREAID is included in a two word composite mark such as SPINESPAN CAREAID (for medical services) where the two elements would appear to the consumer to be a) normally distinctive, and b) entirely independent of each other. If the respective goods/services are also identical, it is quite likely that the relevant consumer will assume that the</p>	
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		inclusion of the CAREAID mark as an element in the composite mark SPINESPAN CAREAID is indicative of an economic connection between the undertakings using the marks. A section 11(1) objection would therefore be justified if the marks are in different ownership.	
11.3	Office action	<p>In case, same or similar earlier trademarks of different persons are found on records in respect of same or similar description of goods or services, the Examiner should raise objection as follows-</p> <p><i>The trademark applied for registration is not registrable under Section 11(1) of the Trade Marks Act 1999 since identical or similar marks in respect of identical or similar description of goods or services are there on records and because of such identity or similarity of marks and goods or services there exists a likelihood of confusion on the part of the public.</i></p>	
12		Examination of application as to absolute grounds for refusal of application for registration	
12.1	Office action	The examiner shall examine the application to see as to whether the trademark applied for registration is capable of distinguishing goods or services of one person from those of other and its registration is liable to be refused registration under Section 9 of the Trade Marks Act 1999	
12.2.1	Concept	<p>Section 9(1) of the Act sets down the following absolute grounds for refusal of registration, according to it,</p> <ul style="list-style-type: none"> a) trademarks which are devoid of any distinctive character; that is to say, not capable of distinguishing the goods or services of one person from those of another person; b) trademarks which consist exclusively of marks or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin ,or the time of production of goods or of rendering of services, or other characteristics of goods or service, c) trademarks which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade: <p>Devoid of distinctive character</p> <p>“The expression ‘distinctive’ in relation to goods in</p>	

	<p>respect of which a trademark is proposed to be registered means adopted to distinguish goods, with which the proprietor of trademark is or may be connected in the course of trade, from goods in case of which no connection subsists.”</p> <p>“Distinctiveness has been understood to mean some quality in the trademark which earmarks the goods so marked as distinct from those of others”</p> <p>In the 1999 Act ‘distinctive’ & ‘capable of distinguishing’ have been made synonymous. It means a trademark which is inherently distinctive or which has become capable of distinguishing goods/service of applicants from those of others, can be considered for registration.</p> <p>A mark which has a direct reference to the Character or quality of the goods/service is considered as inherently not capable of distinguishing. If the mark consists of common surname, name, name of place, section of society, common geometrical devices, etc are not regarded as Capable of distinguishing the goods or services. The fundamental principle is that “traders should not obtain any monopoly in the use of words as trademarks to the detriment of the members of the public, who, in the future and in connection with their goods might desire to use them”.</p> <p>Under Section 9(1)(b) trademarks which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services” shall not be registered.</p> <p>The expression “may serve in trade” means that there exists a reasonable likelihood that other honest traders will wish to use the mark in question to designate characteristics of the goods/services.</p> <p>‘kind’</p> <p>The expression “kind” would include the name of the goods or services claimed and any words recognized as indicating size or type, such as “old”, “new” “Extra large” or “Large” or “Small” would fall in this category and as such objectionable in respect of any goods or service.</p> <p>“Quality”</p> <p>Laudatory words such as GOOD or BEST are not</p>	
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	<p>registerable for any goods or services since all traders should be equally free to use them in the course of advertising their products.</p> <p>“Quantity”</p> <p>Numeral 12 would not, for e.g. be acceptable for wine (12 bottles = one case of wine) or 20 or numeral 200 as a pack of cigarettes. Similarly, “1000” would not be acceptable for butter (1000 gm – 1 Kg)</p> <p>"Intended purpose"</p> <p>Words which refer directly to the use to which the goods are put or which describe the consequences of providing the service are not acceptable. Examples are: KETTLE CLEAN for preparations for cleaning kettles; TWIST AND CURL for hand implements operated by a twisting action for curling the hair; SLIM AND FIT for slimming preparations. Words which describe the effect of the goods / services would also be open to objection as a characteristic of the goods /services, for example RUSTFREE for paints; and articles made of steel.</p> <p>"Value"</p> <p>Words or symbols which merely serve to indicate the worth merit or importance of the goods or services are not acceptable. Examples are "TWO FOR ONE; WORTH THEIR WEIGHT IN GOLD.</p> <p>"Geographical origin"</p> <p>Name of places with populations of less than 5000 in India will prima facie be acceptable. However if the location covers a large area having a reputation in respect of the goods or service, the application may attract objections.</p> <ul style="list-style-type: none"> – In the case of overseas names, the location is considered more important than size. – In the case of Industrialized countries such as U.S.A., Japan, or Europe, while population size of 100,000 is considered reasonable for acceptability, it is to be borne in mind if the location has reputation for the type of goods or services, the size of the location or its remoteness will not help acceptability of the geographical name as a trademark. – Name of rivers, mountains, seas, lakes, etc will be considered prima facie acceptable in respect of goods, not associated with the geographical feature. For example, in respect of “fish” in 	
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		<p>class 29 the names of rivers or seas will not be acceptable.</p> <p>“Mediterranean” for transport services may be objectionable. Likewise names of mountains in respect of agricultural produce will be considered non-distinctive.</p> <p>– Names of streets such as Wall street, Dalal street which have strong links with financial services such as stocks and investments will entail objections in respect of such services or related goods.</p> <p>where there are more than one person manufacturing the same goods in a place , the name of that place will be incapable of acquiring a distinctive character as a trademark[55 RPC 253, page 260(HL)]</p> <p>Geographical names used fancifully</p> <p>Geographical names, used in a fanciful manner, such as NORTH POLE or MOUNT EVEREST for bananas, which are not likely to be taken as Indicating the origin of the goods, can be accepted.</p> <p>Names of rivers, seas & deserts etc.</p> <p>The names of rivers, seas, lakes and mountains etc. are usually accepted <i>prima-facie</i> for goods which are not associated with these geographical features. However, “Ganga” or “Kaveri”, the name of rivers, which are also better known personal names, can be registered only on the basis of acquired distinctiveness. Names of rivers, seas and lakes would not normally be acceptable as marks for fish or fish products. The names of mountains would not be acceptable as marks for agricultural produce. Some rivers flow through heavily industrialized areas and they would not be acceptable , for example, "Treated with Ganges water " is a Common expression. As regards oceans, the practice is to accept ATLANTIC and PACIFIC, for goods / services which are not directly relevant, and used in a fanciful manner. In the case of deserts, reputation is a factor to be taken into account .SAHARA would not be accepted for dates, nor 'Surat' and Kalahari" for diamonds.</p> <p>In respect of natural produce, population figures are not as reliable a guide to acceptability. Natural produce would include fresh vegetables, fruits, eggs, milk, cream, water and minerals but not processed foods or beverages.</p> <p>Where the geographical location covers a large area (even if sparsely populated) and/or has a reputation in the goods, the application will face an objection.</p>	
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	<p>The names of streets & roads</p> <p>These are generally acceptable unless the geographical name is associated with the goods/service. For example, DALAL STREET which is well-known for stock market would not be acceptable for Stock Market Services, nor names of popular roads for a wide range of consumer goods. Well known names of foreign streets, roads etc are similarly dealt with: 2"d avenue etc is almost be on par with Dalal street for fashion goods and Wall Street for example would be objectionable for services connected with stocks and shares or investments.</p> <p>Names of Districts</p> <p>Generally, the districts carry the name of Headquarters of concerned town/city, and as use of such names will attract the same objections applicable to geographical locations. Acceptance of such names will depend upon the extent of reputation of the place for such goods /services.</p> <p>Names of suburbs of big cities</p> <p>In India many suburbs of Mumbai such as Andheri, Borivali or Bhandi Bazar etc., are as large and well known as many towns. They should be considered as a town <i>per se</i> with comparable population figures. In the case of an application to register the name of a district of Mumbai, Examiners should consider whether the name is likely to be seen as fanciful use of the name or as a plausible indication of geographical origin.</p> <p>In deciding whether the name is likely to be seen as fanciful examiners should consider</p> <ol style="list-style-type: none"> a) Whether the goods/services are likely to be generally sold/provided from the area concerned; and if so; b) Whether the use of such name in relation to the goods/services are likely to indicate the origin of goods/services. <p>Towns with company names</p> <p>In rare instances, applicants may be able to show that they established their business at a particular location and that subsequently a town grew up around the business and adopted the same name. Any reputation which the town has in respect of the products concerned originates from the business. In such cases <i>prima facie</i> acceptance is normally possible for such goods. For example TATANAGAR for steel.</p>	
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		<p>Different approach for service marks consisting of geographical names</p> <p>Goods are almost invariably transported from the area and sold elsewhere in India, whereas a service may be provided generally in a particular locality. Accordingly, while geographical limitations will not usually overcome objections under Section 9(1)(b) in respect of goods in the case of service marks, there could be a more liberal approach.</p> <p>Two or more Indian geographical names combined</p> <p>Where a combination of two or more Indian geographical names refers to particular region, this will be prima facie objectionable for registration as a trademark.</p> <p>For example Vasai-Virar for ‘building constructions’</p> <p>Where the combination of locations does have a reputation e.g. MUMBAI - PUNE for "information technology or financial services", objection will be raised.</p> <p>Foreign geographical names</p> <p>Regardless of population size or type of service, these must be considered on the basis of facts as to whether the name of the location has a reputation for the service and whether other traders with a business in India are reasonably likely to wish to use the name to indicate the geographical origin <i>or other characteristics</i> of their own such services. In many cases the use of foreign geographic locations as trademarks for services would be fanciful, e.g. KARACHI for "shoe repairs"; as would KANSAS FRIED CHICKEN for restaurant services.</p> <p><i>Prima facie</i> objections would arise if the name of the place has a connection or reputation for the service claimed e .g. PARIS for fashion design", MADRAS for "Masala Dosa" or "Italian" for restaurant services (indicates type of food served).</p>	
12.2.2	Concept	<p>Prohibition of registration of geographical indication as trademark:</p> <p>Section 25 of the GI Act prohibits registration of “geographical indication” as trademark or invalidate the registration of a trademark either <i>suo moto</i> or at the request of an interested party. The basic intention of section 25 is to prevent misappropriation of a public property in the nature of a GI by an individual as a trademark leading to</p>	

		<p>confusion in the market. Section 26 of the GI Act, however, protects the trademark consisting of a Geographical Indication which has been applied for or registered in good faith before the commencement of the GI Act.</p>	
12.2.3	Concept	<p>Section 9(1) (c) of the Act applies where the mark consists of a word which has become customary in the current language or in the bona fide and established practices of the trade. The expression “trade” means the “trade” which is concerned with the goods or services covered by the application.</p> <p>When a mark is in common use in the trade or when it is open to the trade to use the mark is said to be ‘common to trade’ and it ceases to be a trademark of a single source. Marks falling in this category include, for example, simple devices of flowers or their names for ‘agarbathis’; devices of grapes for wines, star devices for brandy, tobacco products etc.</p> <p>Before an objection is taken under Section 9(1) (c) it is necessary to be satisfied about sufficient use of the mark by third parties prior to the date of the application being examined.</p>	
12.2.4	Concept	<p>Acquired distinctiveness</p> <p>A trademark which offends against Section 9(1) of the Act may still be registered if it can be shown that on the date of application the mark has in fact acquired a distinctive character as a result of the use made of it.</p> <p>Evidence of use</p> <p>In any proceeding before the Registrar, evidence is to be given by way of an affidavit. However the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit. Rule 116 prescribes the manner in which the affidavits are to be executed. In case Evidence of use of the trademark in conformity with user statement mentioned in the application has already been given by way of affidavit (with exhibits) of the applicant, the examiner may take this into account while raising objections under Section 9(1) of the Act.</p> <p>In assessing the distinctive character of a mark in respect of which registration has been applied for, on the basis of evidence of use provided by the applicant, the following factors shall be taken into</p>	

		<p>account:</p> <ol style="list-style-type: none"> a) the market share held by the mark; b) how intensive, geographically widespread and long-standing the use of the mark has been; c) the amount invested by the undertaking in promoting the mark; d) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; e) statements from Chambers of Commerce and Industry or other trade and professional associations”. 	
12.2.5	Concept	<p>Distinctiveness in various types of trademarks</p> <p><u>Letters and numerals</u></p> <p>Marks consisting of single letters or two letters will be generally regarded as “devoid of distinctive character” for goods because of tendency in trade to use letters as models or catalogue references, further these may be used as abbreviation of names. Two letter marks may be acceptable in respect of services having regard to the trade practice.</p> <p>Single numbers which involve little or no stylization will often face an objection because many such numbers are used in trade to designate a quantity, quality or characteristic of many goods (e.g. 6 = cylinders in an engine, 2 = liters of milk) similarly two digit numerals may be devoid of any distinctive character because they are commonly used in trade as descriptions</p> <p>Numbers/letters which may be used in trade to designate:</p> <ul style="list-style-type: none"> ▪ the date of production of goods/provision of services (e.g. 1996, 2000) ▪ size, e.g. XL for clothes, 1600 for cars, 34R for clothing, 185/65 for tyres ▪ quantity, 200 for cigarettes ▪ dates e.g. 1066 for history books, 1996 for wines ▪ telephone codes e.g. 0800 or 0500 ▪ the time of provision of services, e.g. 8 – 10, 24/7 ▪ the power of goods, e.g. 115 (BHP) for engines or cars or ▪ speed, e.g. 486, 586, 686 & 266, 333, 500, 550 for computers ▪ strength e.g. "8.5%" for lager <p>Such marks will be subject to objection under Section 9(1)(b) and 9(1)(c) of the Act.</p>	

	<p><i>Common names/surnames</i></p> <p>Marks consisting of a common name or surname or the name of a particular section of citizens of India are prima facie regarded as not capable of distinguishing goods/services, as persons with that name/surname or persons connected with that group or community may use that name in course of the trade since Section 35 of the Trademarks Act 1999 protects bona fide use of name, address & description of goods or services.</p> <p>Objections under Section 9(1) (a) should be raised in case of marks consisting of a common name or surname or the name of a particular section of citizens of India, unless it is established that the mark has acquired distinctive character by prior use.</p> <p><i>Mis-spelling of descriptive words</i></p> <p>Mis-spellings of descriptive words are also excluded from registration and objections should be raised as and if correct word was objectionable, such as XTRA instead of EXTRA; KOMMUNIKATION instead of COMMUNICATION. Where mis-spellings or abbreviations are commonly used in the trade, the marks would still be open to objection. For example : CUT ‘N BLOW DRY for hairdressing. DRIVE THRU /DRIVE IN for restaurant services. STARTER PAK for beginner packages. FRESHLY PREPARED 2 GO for takeaway pizzas. BEST 4 YOU</p> <p><i>Descriptive words in foreign languages/little known languages</i></p> <p>If the foreign word is in a language that is not likely to be known to a significant proportion of the public in India, there will not exist, any ground for objection that the mark is descriptive. However if a word is descriptive in local language of the Indian applicant, the objection under Section 9 must be raised since the goods would be sold/services would be rendered in that locality.</p> <p><i>Domain names</i></p> <p>A domain name is a written representation of a website address, e.g. www.ipindia.nic.in, It is common practice amongst traders to have their</p>	
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	<p>website address and use the same in respect of their goods/services as trade name. In other words the domain name is being used as a trade name or trademark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trademarks if otherwise registerable. Elements of the domain name such as ".com" or "co.in" are considered to be totally non-distinctive, much in the same way as "Ltd" and "Plc". As a general rule, the examiner should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there will be an objection under Section 9.</p> <p><i>Trademarks consisting of a number of features each of which is non-distinctive</i></p> <p>When a trademark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trademark taken as a whole. If the combination of descriptive elements was unusual and created an impression that was sufficiently far removed from being simply a composite description of the goods/services, the trademark might be registrable. Again if the mark is constituted by purely descriptive phrase (e.g. HIGH TECH HOME COMPUTING SYSTEM for computer software) it would not be permitted registration.</p> <p><i>Slogans</i></p> <p>One or more words, constituted as a slogan mark may be registrable provided it is distinctive per se or has acquired distinctiveness. ‘Slogans’ serving a promotional function will be objectionable because average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans. Plain descriptive phrase of a slogan is always considered non-distinctive. Like NEVER CLEAN YOUR SHOWER AGAIN (Class 3) is to be objected because it describes in plain language the intended purpose of the goods. The mark “THE BEST WAY TO PREDICT THE FUTURE IS TO CREATE IT” (for technology related services in classes 35, 38 & 42) can be accepted because this is not considered to be a normal way of designating these services nor to be a commonplace phrase.</p> <p><i>Combination of colours</i></p> <p>If a statement has been made in the application that the trademark consists of combination of colours</p>	
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		<p>only, the trademark will be regarded as colour trademark.</p> <p>If a particular combination of colours of packaging has become distinctive, in fact, as indicating the goods of a particular trader, there is no reason why it should not be protected by registration. It is conceivable that extensive use of two colours in many different arrangements may result in the colour combination per se becoming distinctive of the applicants' goods</p> <p>Marks consisting of a single colour will usually be liable to objection under Section 9(1)(a) of the Act because they inherently lack the capacity to distinguish.</p> <p>Wherever the exclusive right to color is sought, weighty evidence should be necessary to overcome objection under Section 9(1)(a) of the Act.</p> <p><i>Sound marks</i></p> <p>A trademark may consist of a sound and represented graphically by a series of musical notes with or without words. Applications for sound marks must clearly state that they are sound marks. Otherwise the application will be examined as if it were a word and/or device mark (e.g. in the case of musical notation).</p> <p>The acceptability of a sound mark must, like words or other types of trademarks, depend upon whether the sound is or has become a distinctive sign; that is whether the average consumer will perceive the sound as meaning that the goods or services are exclusively associated with one undertaking.</p> <p>Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness.</p>	
12.2.6	Concept	<p>Section 9(2) prohibits registration of a trademark–</p> <ol style="list-style-type: none"> a) if the mark is of such nature as to deceive the public or cause confusion b) if it contains or comprises any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India. c) if it comprises or contains scandalous or obscene matters d) if its use is prohibited under the Emblems and Names (Prevention of Improper use) Act, 1950 	

		<p>Deceptive marks</p> <p>An objection under Section 9(2) (a) to the registration of a mark will only be raised if there is any real potential for deception of the public.</p> <p>Section 9(2)(a) is primarily concerned with the deceptive nature of the mark by reason of something inherent in the mark itself or in its use, such as to nature, quality or geographical origin of the goods or services. The mark may be in the nature of misrepresentation as to the characteristics of the goods or services or to the effect that they were made in a specified geographical region or place when in fact not so made.</p> <p>Deceptive use may also arise where the mark contains misleading indication (such as the use of the word “registered” when the mark is not registered) or marks which are used in a fraudulent trade.</p> <p>objections under this Section at first examination stage should be taken where there is <i>prima facie</i> misrepresentation as to “nature or quality of goods/services, geographical origin” etc:</p> <p>It is not necessary to raise an objection to the mark where there is no realistic possibility of deception. For example, there would be no objection against HARTLEY'S STRAWBERRY JAM for “jam”; an application to register such a trademark for "jams" will not be regarded as a “misrepresentation." The applicant will be required as a condition of registration to use the mark only on or he will be required to agree to a Variation Condition which may be imposed by the Registrar so that the name of the actual product in respect of which the mark is used will be required to be substituted for words STRAWBERRY JAM</p> <p>However, if in response to an objection under Section 9(2) of the Act an applicant seeks to exclude goods or services from the specification, the Examiner shall reconsider whether the mark has now become free from objection of such a nature as to deceive the public.</p> <p>Deception as to Quality</p> <p>For example application for registration of ORLWOOLA for "suits", is objectionable under this Section if it is used in respect of non woolen suits, because the public would expect the goods to be made of all wools and to pay more for suits containing wool. If the trademark is to be used in respect of woolen suits it is descriptive u/s 9(1)(b)</p>	
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		<p>Deception as to Geographical origin</p> <p>Objections under this Section shall be taken at examination stage to place names or figurative marks indicating geographical origin where the goods in fact do not originate from that geographical area. For example PIAZZA D' ITALIA for "clothing", is indicative of the goods being from Italy. The public would be deceived if the goods were not manufactured in Italy. In such cases, objections would be raised.</p> <p>So also SWISSTEX for "watches", because Switzerland is famous for high quality watches.</p> <p>Geographical names appearing in trademarks for wines and spirits, not originating from such place would amount to deceptive use. E.g. word SCOTCH for whisky, not produced in Scotland should be refused as it involves misleading allusion. From the above it would be clear that the general rule is that mis-statement of any material fact calculated to deceive the public will be sufficient to constitute an objection under section 9(2)(a) of the Act and unless the objection is remedied , the application will be refused.</p> <p>Practice regarding Olympic Symbol or Word</p> <p>The Olympic Symbol, the Olympic Motto and the words Olympic(s), Olympian(s) and Olympiad(s) are not to be registered as trademarks except under the authority of the Olympic Committee.</p> <p>Protection extends to marks which are sufficiently similar to the Olympic Symbol or the Olympic Motto as are likely to create in the public mind an association with those signs.</p> <p>Where an application is made consisting of or containing the Olympic symbol or words. Objection under Section 9(1)(a) of the Trademarks Act. Should be raised.</p> <p>Marks likely to hurt religious susceptibilities -</p> <p>Under this Section a mark is prohibited for registration as a trademark if it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India.</p> <p>It is to be noted that it is a common trade practice in India to use names and pictures of Gods and Goddesses or religious symbols as trademark. Accordingly such use <i>per se</i> is not regarded by public as offending religious sentiments of any</p>	
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	<p>class or section of public. However, such use in relation to certain goods may offend the religious sentiments of the people. For Example, use of names/device of deities or religious heads on footwear will be considered distasteful and will be open to objection. Similarly use of Hindu Gods in respect of Beef or meat products or use of names of Muslim saints for pork products would offend the religious feeling of respective sections of the public to attract the objection under this Section. Certain names and pictures of God and Goddess and also religious heads are prohibited from being registered as trademarks in terms of directions issued by the Central Government under section 23(1) of the Trade & Merchandise Marks Act, 1958. These directions continue to remain valid.</p> <p>Use of religious symbols (like OM) or names (e.g. Jesus) as trademarks is likely to undermine/offend religious value and sentiments. Names of Gods/Goddesses which are also used as personal names may be considered as personal names for registration purpose, unless accompanied by the device of such God/Goddess</p> <p>Mark containing scandalous or obscene matter-</p> <p>The Act prohibits registration as a trademark if the mark “comprises or contains scandalous or obscene matter”.</p> <p>Scandalous marks are those likely to offend accepted principles of morality. A mark which on its face appears to be offensive shall be refused. In this category will fall marks which could induce public disorder, or incite the criminal or other offensive behaviour.</p> <p>The applicability of the objection must be decided objectively and non-discriminately.</p> <p>If a mark is merely distasteful an objection under Section 9(2) (c) is unlikely to be justified whereas if it would cause outrage or would be likely significantly to undermine religious, family or social values then an objection must be raised. The outrage must be amongst an identifiable section of the public.</p> <p>In order to make this assessment, the Examiner must be objective, not subjective. Objectivity means being neither out of date nor a trend setter; not setting some kind of moral standard but also not being insensitive to public opinion.</p> <p>A vulgar mark not may be acceptable on any goods</p>	
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	<p>or services and similarly racially offensive mark will face a blanket objection, regardless of the goods and services. Where an obscene or crude mark is concerned, an objection will be certain where the goods or services are primarily or equally aimed at children, such as toys, games, confectionery, soft drinks etc. For goods intended for adults such as alcohol and contraception there may be less cause for concern.</p> <p>Objections should be raised against explicit full frontal nudes and offensive (scandalous) back views.</p> <p>Each case must be decided on its own facts. The dividing line is to be drawn between the mark which amounts only to dis-taste and the mark which would justifiably cause outrage or would be the subject of justifiable censure as being likely to undermine current religious, family or social values.</p> <p>Examples of marks which may considered to be objectionable under this Section –</p> <p><i>WHITE DOVE YOU DON'T NEED WINGS TO FLY</i></p> <p>Contrary to public policy as it would be seen as promoting drugs (White Dove is a nickname for a type of drug)</p> <p><i>SNUFF MOVIES</i></p> <p>Obscene and scandalous, promoting pornography and murder.</p> <p>This is contrary to accepted principles of morality in view of bad language.</p> <p>Prohibition under Emblems and Names (Prevention of Improper Use) Act, 1950-</p> <p>Section 9(2) (d) bars registration as a trademark if “its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).</p> <p>Section 4(b) of the Emblems Act prohibits generally registration as trademark or design which bears any emblem or name the use of which is in contravention of section 3 of the Emblems Act. The prohibited name or emblem is specified in the schedule to the said Act. Under section 8 the Central Govt. is empowered to add or alter the schedule. The full text of the schedule must be seen to confirm whether the name or emblems falls within the prohibition. The schedule inter alia contains the name or emblems or official seal of the UNO, WHO, Govt. of India or any State</p>	
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	<p>Government or of a department of any Government or the President, or Union of India.</p> <p>Item 7 of the Schedule expressly includes “any name which may suggest or may calculate to suggest –</p> <ol style="list-style-type: none"> i. Patronage of the Govt. of India or Government of a State ii. Connection with any local authorities or any corporation or body constituted by the Government under any law for the time being in force. <p>Certain guidelines under Item 7 have been issued by the Central Government, in terms of which registration of any name is prohibited under the Emblems Act, if :</p> <ol style="list-style-type: none"> 1. it is identical with the name of any society/corporation or local body which has been set up by the Govt. of India or State Govt. under any law for the time being in force; 2. it gives the impression of the patronage of Central Government or State Government. For example, Indian Council of Agricultural Research (ICAR) is a registered body under the Ministry of Agriculture and Co-operation. Any name beginning with the words “Indian Council of” may mislead the public that it is patronized by the Government. 3. It too nearly resembles a name of body corporation or local authority set up by Government under any law for the time being in force. For example, ‘Indian Institute of Mass Communication’ is an autonomous body under Ministry of Communication. Names like Institute of Mass Communication may give the impression and the said society is also patronized by the Central Government. <p>The Central Government has issued directions not to register following trademarks.</p> <p>These trademarks are therefore not registrable in view of Section 23 (1) of the Trademarks Act, 1999</p> <ol style="list-style-type: none"> 1. Words “UNITED NATIONS”, letters “UNO” and the official Seal and Emblem of UNO. 2. The device of an arrow on the ground that is the property of the Government of India. 3. Letters “N.C.L.”. 4. Letters “I.S.I.” if applied by any person or body other than the Indian Standards Institution. 5. Letters “I.C.S.”, 6. Letters “N.P.L.” 	
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		<p>7. Words “ASHOK CHAKRA” or DHARMA CHAKRA” or the device of Asoka Chakra or any other colourable limitation thereof.</p> <p>8. The British Royal Arms, The British Crown or the Union jack or any colourable limitation thereof.</p> <p>9. Letters “I.S.O.” if applied by any person or body other than the Indian Standards Institution.</p> <p>10. Words “Lord Buddha” or the device of Lord Buddha or any colourable imitation thereof.</p> <p>11. Words “Shree Sai Baba” or the device of Shree Sai Baba or any colourable imitation thereof.</p> <p>12. Words “Sri Ramkrishna, Swami Vivekananda, the Holy Mother alias Sri Sarada Devi or the devices of Sri Ramkrishna, Swami Vivekananda, the Holy Mother alias Sri Sarada Devi and the Emblems of the Ramkrishna Math and Mission or colourable imitation thereof.</p> <p>13. Words “National”, and “Panchsheel”,</p> <p>14. Following common names for pesticides:- ALDRIN DINEX ALLETHRIN DINOSAM BHC NEOD GAMMA-BHC MAZIDOX CHLORDANE MIPAFOX CHLOROBENZILATE CHLORFENSON PP-DDT CHLORPROPHAM DDT DINOPROP DIAZINON DNOC DIELDRIN ENDRIN DNC FENSON HEPTACHLOR HHND HETHOXYCHLOR LINDANE PARATHION WARFARIN SCHRADAN ATRATON TOXAPHENE AZINPHOS-ETHYL FERBAM AZINPHOS-METHYL THIRAM DAZOMET ZINEB DIMETHOATE 2,4,D FENOPROP 2,4,5- T FENTHION MCPA MECARBAM PROPHAM MEVINPHOS ANTU MORPHOTHION MALATHION PARAQUAT CHLORBENSIDE * ▪ Coumachlor ▪ dichlone ▪ dimefox ▪ dinoseb</p>	
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		<ul style="list-style-type: none"> ▪ maneb ▪ nabam ▪ parathion-methyl ▪ Proxan-Na or proxan-sodium ▪ Tecnazene ▪ TEPP ▪ ziram ▪ Captan ▪ sulfotep] <p>15. Letters “IR”</p> <p>16. Names and pictures of Sikh Gurus, viz. Guru Nanak, guru Angad, Guru Amar das, Guru Ram Das, Guru Arjun dev, Guru Hargobind, guru Har Raj, Guru Har Krishnan, Guru Teg Bahadur and Guru Govind Singh</p> <p>17. Name and picture of Chhatrapati Shivaji Maharaj</p> <p>18. Letters “STC”.</p> <p>19. Name and/or picture of the deity of Lord Venkateswara and/or Balaji</p> <p>20. Representation of the Election Symbol of any political party in India.</p> <p>Practice with regard to Red Cross</p> <p>Marks consisting of words “Red Cross” or “Geneva Cross” or any cross device in red or in any closely resembling colour is not accepted for registration – However, applications made in black and white, which contain the device of a cross, or a crescent moon or lion and sun, will not attract objection.</p> <p>Green crosses on a white background are generic for pharmacy and medical goods and services. Use of such emblems as trades mark is not to be permitted.</p> <p>White crosses on green backgrounds are generic for first aid goods and services, and are based on European Union legislation establishing a white cross on a green background as the First Aid sign. Objection must be raised for registration of such devices as trademarks</p> <p>In respect of mark generally consisting of cross device, applicant is required to comply with the condition not to use the cross device in red or in any similar colour, or in the manner prohibited under the Geneva Convention Act, 1960</p>	
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12.2.6	Concept	<p>Under Section 9 (3) a mark is not registrable as a trade mark if it consists exclusively of –</p> <ul style="list-style-type: none"> a) the shape of goods which results from the nature of the goods themselves; or b) the shape of goods which is necessary to obtain a technical result; or c) the shape which gives substantial value to the goods. <p>It provides an explanation which reads as- ‘For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.’</p> <p>Shape of goods</p> <p>A <i>distinctive</i> shape of goods or its packaging or any three dimensional object capable of being represented graphically, can be a trademark and application for registration of the same can be filed.</p> <p>However the trademark shall not be registered if it consists exclusively of –</p> <ul style="list-style-type: none"> a) the shape of goods which results from the nature of goods themselves; or b) the shape of goods which is necessary to obtain a technical result ; or c) the shape of goods, which gives substantial value to the goods <p>The purpose of Section 9(3) (a) is to keep free, basic shapes of goods that should be available for use by the public.</p> <p>Shape necessary to obtain a technical result</p> <p>This sub-clause prohibits registration as a trademark where the shape of goods is necessary to obtain a technical result. In this connection this subsection must be interpreted to mean that a mark consisting exclusively of the shape of a product is not registrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result. This does not automatically mean that a shape is not registrable even when all its features serve some functional purpose. If it can be shown that an essential feature (which may include the overall impact arising from the way the individual features are arranged) is not only attributable to a technical result, i.e. the shape is not one which would be adopted for its functional efficiency, it will not be caught by section 9(3)(b). Shapes which do consist</p>	
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		<p>exclusively of functional features attributable only to the technical result will be open to objections under Section 9(3)(b); marks in this category are deemed to be incapable of acquiring a distinctive character and therefore the filing of evidence will not overcome the objection.</p> <p>Shape which gives substantive value to the goods</p> <p>This subsection deals with shapes which add substantial value to the goods, disregarding the main function attributable to a trademark i.e. source identification function.</p> <p>‘Whilst the legal test for distinctiveness is the same for shape marks as for other marks, recognition must be given to the differing perceptions of the average consumer in relation to non-traditional trademarks. In particular, the average consumer may not as readily accept the appearance of the goods themselves as an indication of trade origin. This is because “average consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element’</p> <p>The more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character.</p> <p>the shape of packaging is to be treated as the shape of the goods themselves where the goods are traded in packaged form, for reasons associated with the nature of the goods; for example, beverages, cleaning fluids etc.</p>	
12.2.7	Concept	<p>Prohibition of registration of names of chemical elements or international Non-Proprietary Names</p> <p>Under Section 13, the registration of a word as a trademark, which is commonly used and accepted name of any single chemical element or compound in respect of chemical substances or preparation is prohibited. Also the law prohibits registration of a word which is declared by the World Health Organization (WHO) and notified by the Registrar as international non-proprietary name, or which is deceptively similar to such name.</p> <p>This will mean that not only a word which is declared to be non-proprietary by WHO but also any word which is deceptively similar to such word</p>	Section 13

		<p>is prohibited from registration</p> <p>For example word CYLOVIR was refused, as being confusingly similar to the non-proprietary name ACYCLOVIR</p> <p>It should be noted that such prohibition is only in respect of chemical element or compound and does not extend to other goods. For example, the word “Radium” may be registered in respect of readymade garments or any services.</p>	
13		Draft for communication of objections to acceptance of application for registration, which are liable to be refused on absolute grounds	
13.1	Office action	<p>The Examiner shall communicate objections to acceptance of application for registration, which are liable to be refused on absolute grounds, as for as it is applicable to the case, as follows-</p> <p><i>The mark applied for registration is liable to be refused registration under S 9(1)(a) of the Trade Marks Act 1999, as it is devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person because it is a common surname/personal name/...;</i></p> <p><i>The mark applied for registration is liable to be refused registration under S 9(1)(b) of the Trade Marks Act 1999, as it consists exclusively of words or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;</i></p> <p><i>The mark applied for registration is liable to be refused registration under S 9(1)(c) of the Trade Marks Act 1999, as it consists exclusively of words or indications which have become customary in the current language or in the bona fide and established practices of the trade,</i></p> <p><i>The mark applied for registration is liable to be refused registration under S 9(2) of the Trade Marks Act 1999, as</i></p> <p><i>it is likely to deceive the public or cause confusion in the mind of public; or</i></p> <p><i>it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or</i></p> <p><i>it comprises or contains scandalous or obscene</i></p>	Rule 38

		<p><i>matter;</i> <i>its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950, or.</i></p> <p><i>The mark applied for registration is prohibited under the Central Government Instructions issued under Section 23(1) of the Trade Marks Act 1999</i></p> <p><i>The mark applied for registration is liable to be refused registration under S 9(3) of the Trade Marks Act 1999, as it</i> <i>it consists exclusively of the shape of goods which results from the nature of the goods themselves; or</i> <i>the shape of goods which is necessary to obtain a technical result; ;or</i> <i>the shape which gives substantial value to the goods</i></p> <p><i>The mark applied for registration is liable to be refused registration under S 13 of the Trade Marks Act 1999, as it is in respect of chemical substance or chemical preparation and</i> <i>it is name of a chemical element or compound; or</i> <i>it is a word similar to the name of a chemical element or compound; or</i> <i>it is word which is declared as international non-proprietary name; or</i> <i>it is a word similar to an international non-proprietary name.</i></p>	
14		Examination of series marks	
14.1	Office action	In case an application has been filed on forms TM-8 or TM-37 for registration of a series of trademarks in a single application, the Examiner shall examine the application under Section 15 of the Trade Marks Act 1999	
14.2	Concept	<p>Series marks</p> <p>Where a person claiming to be the proprietor of several trademarks in respect of the same goods or services which, while substantially resembling with each other in the material particulars thereof, yet differ in respect of matter of a non-distinctive character which does not substantially affect the identity of the trademark; seeks to register those trademarks, they may be registered as a series in one registration.</p> <p>Where a group of marks are applied for registration as series in one registration and the examiner does not consider any or some of them eligible for</p>	Section 15(3)

		<p>registration as series marks under section 15, an objection to this effect will be raised in the examination report and the applicant will be required to delete such marks from the group.</p> <p>For example trademarks RIN-1, RIN-2, RIN-3 may be accepted as series trademarks. However trademarks SUPER RIN or RIN PLUS may not be accepted as series trademarks if applied with trademarks RIN-1, RIN-2, RIN-3.</p>	
14.3	Office action	<p>The Examiner shall communicate objections to acceptance of application for series marks, as follows-</p> <p><i>The trademarks xxx yyy applied for registration as series marks don't resemble with other remaining trademark(s) aaa bbb mentioned in the application.</i></p> <p><i>You should therefore delete the trademarks xxx yyy from the application by making a suitable request on form TM-16.</i></p> <p><i>You may however divide the application by making a suitable request on form TM-53</i></p>	
15	Office action	Proposing appropriate condition of acceptance of the application or limitation of use of the trademark	
15.1	Office action	In case the examiner considers that the application may be accepted for registration subject to any condition or limitation, or it may be proceeded for advertisement subject to any condition or limitation, the examiner shall propose such condition or limitation in clear terms.	
15.2	Concept	<p>Section 18(4) of the Trade Marks Act 1999 states that subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.</p> <p>However in all such cases the Registrar should communicate an objection or proposal in writing to the applicant. The applicant may agree to the requirement of the Registrar or submit his observation or apply for a hearing. Failure to do so within the prescribed period of one month, (unless the period is extended) will result in the application being deemed to have been abandoned.</p> <p>Accordingly if it appears to the examiner that in case the application is accepted it should be accepted for registration subject to any condition or limitation, then the examiner should propose such</p>	Section 18(4)

		<p>condition or limitation in the Examination Report.</p> <p>In any situation, the condition proposed should not be for substantially altering the particulars of trademark application. Only when it appears to the Examiner that the application can be accepted for registration if the scope of registration is confined to a little extent by putting a condition or limitation of use of the trademark.</p> <p>However if it appears to the Examiner that the application can be accepted for registration by slightly modifying the trademark without any substantial alteration or by confining the specification of goods or services /deleting some items in the specification of goods or services, the examiner should suggest the applicant for such modification/deletion by filing a request on form TM-16, but should not propose to accept the application or advertise the application before registration subject to condition of such modification/deletion.</p> <p>The Examiner, for example, should not impose condition like <i>'the application may be accepted for registration subject to deleting the picture of elephant appearing on the trademark'</i></p>	
15.3	Office action	In case the Examiner considers appropriate, he shall propose in his examination report, the condition or limitation as follows-	
15.3.1	Office action	<p>Variation condition governing the use of the mark:</p> <p><i>"In actual use of the marks the name of the goods appearing in the label shall be varied by indicating the name of the goods in respect of which the mark is used."</i></p>	Rule 35
15.3.2	Office action	<p>Blank space condition</p> <p>Where blank space appears in a label, the condition may read as</p> <p><i>"The Blank space appearing on the label shall be accepted only by a matter of wholly descriptive and non-trade mark characters"</i></p>	
15.3.3	Office action	<p>Condition as to joint use:</p> <p>In a case of jointly owned trade mark, the condition should be</p> <p><i>"The mark shall be used jointly by all the applicants mentioned in the application"</i> or</p> <p><i>"The mark shall be used only in relation to goods or services with which all the applicants mentioned</i></p>	Section 24

		<i>in the application are connected in the course of trade with all the joint applicants and it shall not be used against each other.</i>	
15.3.4	Office action	Condition as to association “ The mark is associated with T.M. No.”	Section 16
15.3.5	Office action	Limitation as to area of use or mode of use: Condition of limitation to goods may be imposed as <i>“Bidis for sale in the states of(or as “except for sale in the state of.....”), or</i> <i>“Bidis solely for exports”.</i>	
15.3.6	Office action	In case the use of mark is limited to certain colours, it should be imposed as- <i>“the use of mark is limited is limited to the colours, blue and red in stripes as appearing in the label”</i>	Section 10
15.3.7	Office action	Condition as to disclaimer Since the provision for requiring disclaimer has been omitted in the present Act, where it is considered by the examiner that some conditions should be imposed to clearly specify the rights of the proprietor, he may suitably word the condition, as follows- <i>“Registration of the trademark shall give no right to the exclusive use of word.....appearing in the mark”.</i>	
16		Communication of Examination report to the applicant	
16.1	Office action	The Examiner shall prepare his consolidated examination report through the system containing therein, as for as applicable,- i. all the objections relating to formality requirements as to filing of application, ii. objections to acceptance of the application for registration of the trademark under Section 9, 11 and other Sections of the Trademarks Act 1999, and iii. proposals for conditions of acceptance or limitation to use of the mark, in case the application is accepted for registration; and shall change the status of the application accordingly.	
16.2	Office action	The Examination report shall be transmitted to the Supervising Examiner through the system, who would either approve the Report or send back to the	

		Examiner for re-examination of the case, through the system along with his clear remarks.	
16.3	Office action	In case the examination report proposing to accept the application or to advertise the application before acceptance is approved by the Supervising Examiner, he shall move the application for advertisement in the journal through the system.	
16.4	Office action	In case the examination report is sent back to the Examiner for re-examination, the application the Examiner shall re-examine the application in light of remarks of the Supervising Examiner and shall be resent to the Supervising Examiner through the system.	
16.5	Office action	All the Examination reports approved by Supervising Examiner shall be released on the date of such approval and shall be made available on office website www.ipindia.nic.in with the status of the relevant application. However the Examination reports in respect of applications examined expeditiously due to a request filed on form TM-63 shall be released only after approval of the Supervisor Controller and overall In-charge of the EPR Section, who may also send back the case for re-examination, if required.	
16.6	Office action	The Examination report so released shall be sent to applicant or his authorised agent on his email as registered with this office.	
16.7	Office action	The Examination report shall also be sent to applicant or his authorised agent by post, unless the reply to examination report on the basis of the report available on the website has already been received.	

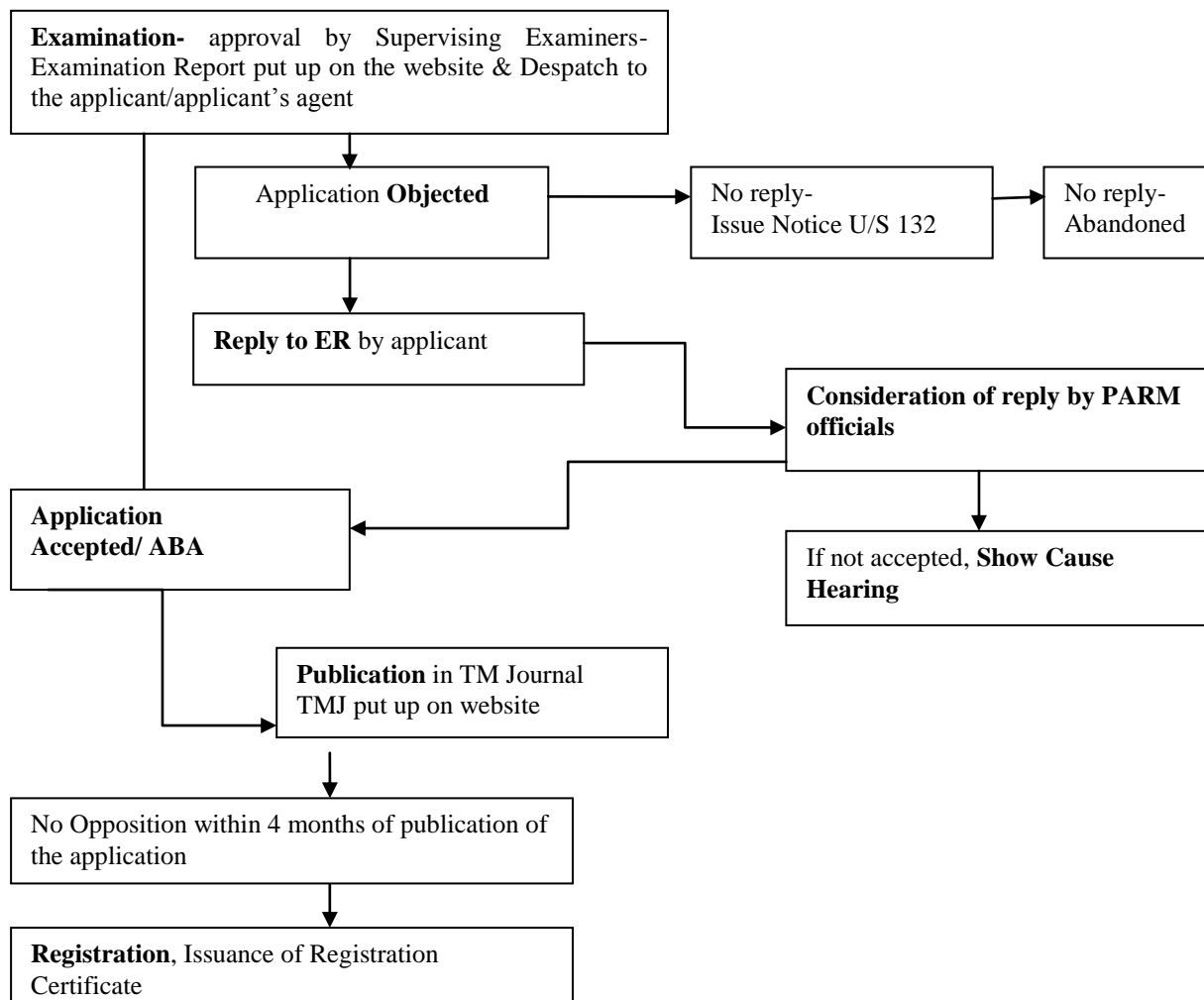
Chapter III

Post Examination Disposal of Applications Filed For Registration of Trademarks

Introduction and Scope

Once the application made for registration of trademark is examined and any objection to acceptance of the application for registration is found, the examination report with objection(s) is sent to the applicant/applicant's authorised agent. The examination report is also put up on the office website along with application details of the relevant application. The applicant or his authorised agent submits response to office objections. The response is duly considered, if objections can be waived on the basis of the applicant's response and application is accepted for registration the same is published in the trademark journal. If no opposition to published application is received or if received, the same is disposed in favour of the applicant, the application is moved for registration.

The following is a flow chart for functions relating to *Post Examination disposal of applications filed for registration of trademarks*



Sr. No.		General Description	Relevant provision of the Act & Rules
1		Consideration of applicant's reply to examination report	
1.2	Requirements from the applicant	After coming to know of the examination report containing office objection(s) to acceptance of the application for registration, the applicant should submit proper response to waive office objection(s)	
1.3	Requirements from the applicant	<p><u>Mode of replying</u></p> <p>The response to office objections mentioned in the examination report, should be submitted by the applicant or applicant's authorised agent concerned, as the Reply to Examination Report</p> <p>The response to office objections can be submitted by sending the scanned copy (in colour pdf file format) of the Reply to Examination Report, at parm.tmr@nic.in.</p> <p>In case the applicant/applicant's authorised agent has a level III digital signature he may send the Reply to Examination Report online through the gateway provided at the home page of the office website www.ipindia.nic.in</p> <p>The Reply to Examination Report may also be submitted at the Head Office/appropriate office of the Trade Marks Registry, personally or by post.</p> <p>Any affidavit and supporting documents may also be submitted along with the Reply to Examination Report</p>	
1.4.1	Requirements from the applicant	<i>In case of objections as to formality requirement(s), the applicant should comply the requirements as desired by the office. The applicant may however submit to establish that as per Trade Marks Act and Rules the formality requirement(s) called by the office are not necessary. For example if the office may has called for consent of the person whose portrait appears on the trademark, the applicant may state that portrait appearing on the trademark is not of a particular person, but it is general picture of a man or woman.</i>	
1.4.2	Requirements from the applicant	<i>In case of objection to the effect that goods or services mentioned in the application do not fall in the class mentioned in the application, the applicant may file a request for amendment of the application by correcting the class; the applicant may however submit that as per classification of goods or services</i>	

		published by the Registrar, goods or services have been rightly classified. In case of objection to the effect that some goods or services mentioned in the application do not fall in the class, the applicant may file a request for amendment of the application by deleting items that do not fall in the relevant class. the applicant may however submit that as per classification of goods or services published by the Registrar, all items fall in the class mentioned in the application.	
1.4.3	Requirements from the applicant	<i>In case of objections as to non distinctiveness of the trademark</i> , the applicant's may submit response to establish that the trademark applied for registration is capable of distinguishing applicant's goods or services; or the trademark has acquired a distinctive character in view of its extensive use in relation to relevant goods or services, before the date of application. If the applicant claims that the trademark has acquired distinctiveness by virtue of its extensive use, the applicant should file an affidavit as evidence of use of the trademark along with supporting documents.	
1.4.4	Requirements from the applicant	<i>In case of objections on relative grounds of refusal because of identical or similar trademarks in respect of similar goods or services, existing on records</i> , the applicant may submit to the effect that trademarks cited as conflicting marks in the examination report are different than the applicant's trademark; or goods or services mentioned in the application are different than those covered in marks cited as conflicting in the examination report. The applicant may also produce consent/No objection from the proprietor of marks cited as conflicting in the examination report	
1.5.	Office action	Once the reply to examination report communicating office objections, is received by the office, the application is assigned through the Trade Mark System to officers of PARM (Pending Applications Records Management). The designated officer of PARM shall duly consider the Reply to Examination Report and other documents attached therewith.	Section 18(4) Rule 38(4)
1.5.1	Office action	If after considering the Reply to Examination Report and other documents attached therewith in view of the provisions of the Trade Marks Act 1999 and Trade Marks Rules 2002 the designated officer thinks that office objections can be waived, he/she shall accept the application or publish the same in the trademark journal. He may also put the	

		<p>condition(s) and impose limitation(s) as the case may be, depending upon the application, office objections and applicant's reply.</p> <p>In certain circumstances the application may be advertised before acceptance in the Trade Marks journal. The provision for Advertisement Before Acceptance, is invoked in "exceptional circumstances"</p> <p>The provision for advertisement before acceptance, as the law itself enacts, should be invoked in "exceptional circumstances". Where the Officer concerned finds strong evidence of bonafide commercial adoption and use of the mark.</p>	
1.5.2	Office action	<p>In case an application for amendment/correction of the application on form TM-16 is filed by the applicant, the designated officer shall at first dispose of the TM-16 and take appropriate action through the system and then take appropriate decision about the acceptability of the trademark for registration.</p> <p>In case the TM-16 is allowed, amendment in the details of the application shall be incorporated accordingly by the Officer concerned and the case is considered taking into account the amendment.</p>	
1.5.3	Office action	<p>If the designated officer considers that even after applicant's response the office objections cannot be waived, he shall move the case for hearing through the system.</p>	
1.6.1	Concept	<p>Under Section 3 of the Trade Marks Act 1999, the controller General of Patents, Designs and Trade Marks is the <i>Registrar of Trade Marks</i> for the purposes of the Trade Marks Act & Rules. The Central Government appoints various other officers with various designations like Examiner of Trade Marks & GI, Senior Examiner of Trade Marks & GI, Assistant Registrar of Trade Marks & GI, Deputy Registrar of Trade Marks & GI, Joint Registrar of Trade Marks & GI, and Senior Joint Registrar of Trade Marks & GI to discharge the functions of the Registrar.</p> <p>Under Section 2(2) (d) any reference to the 'Registrar' includes a reference to any of these officers who perform the functions of the Registrar, assigned to him.</p>	Section 3, 2

1.6.2		Under Section 18(4) of Trade Marks Act 1999 applications made for registration of trademarks may be refused registration or accepted for registration subject to some condition or limitation which may be appropriate under the provisions of the Trade Marks Act 1999.	Section 18(4)
1.6.3		Accordingly all applications are examined as to whether these have been properly filed and whether the mark sought to be registered, is registrable under the provisions of the Trade Marks Act & Rules and whether it is appropriate to impose any condition or limitation, in case the application is accepted for registration. The applicant's reply to examination report and evidence of use of mark or any other matter/circumstance relevant to the application is duly considered and the case is moved further by the designated officer.	Rule 38(4)
2		Treating the application as abandoned, if no reply to examination report is received	
2.1	Office action	<p>In addition to putting the examination report on the office website, it is also sent to the applicant/applicant's agent by post if it contains objections to acceptance of the application for registration or condition or limitations of acceptance of the application, unless the reply to such examination report has already been received.</p> <p>If the examination report contains objections to acceptance of the application for registration or condition or limitations of acceptance of the application and no response to examination report is submitted by the applicant even after one month from the date of receipt of examination report by post, a notice under Section 132 of Trade Marks Act 1999 shall be generated from the system requiring the applicant to submit response to examination report within one month.</p> <p>If no response to examination report is submitted by the applicant even after service of the said notice, an order treating the application to be abandoned shall be generated through the system and the same shall be sent to the applicant/applicant's agent.</p>	Section 132 Rule 38(5)
2.2	Concept	Rule 38(4) of the Trade Marks Rules 2002 states that 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	Rule 38(4), 38(5) Section 132

		<p>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.</p> <p>Rule 38(5) states that if within one month from the date of communication referred to in sub-rule (4), the applicant fails to comply with any such proposal or fails to submit his comments regarding any objection or proposal to the Registrar or apply for a hearing or fails to attend the hearing, the application shall be deemed to have been abandoned.</p> <p>Further Section 132 of Trade Marks Act 1999 states that where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade marks in force prior to the commencement of this Act, the Registrar may, by notice require the applicant to remedy the default within a time specified and after giving him, if so, desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in the notice.</p>	
3		Show Cause Hearing	
3.1	Office action	<p>In case the office objections to acceptance of the application for registration cannot be waived even after considering the applicant’s response to examination report, the matter is set down for hearing through the system.</p> <p>This hearing commonly known as show cause hearing is scheduled and conducted at the appropriate office of the Trade Marks Registry.</p>	
3.1.1		All matters set for hearing are automatically moved to TLA module of Trade Marks System.	
3.1.2		The Show Cause Hearing section of respective office of the TMR shall schedule hearing for all such cases in order of their seniority and as per availability of hearing officers.	
3.1.3		A hearing notice shall be sent to the applicant/agent/attorney concerned, intimating him about the application No & date of hearing. The hearing notice shall be sent approximately 15 days before the date of hearing.	

3.1.4		A cause list in respect of cases fixed for hearing shall be prepared on monthly basis and the same shall be put up on office website shall be displayed on the notice board	
3.1.5		After allocation of cases to specific hearing officers, the cause list with the name of the Hearing Officer shall be displayed on the notice board of the respective office	
3.1.6		The Show Cause Hearing Section shall ensure that all the relevant documents pertaining to the application scheduled for hearing are digitised and available in the system.	
3.1.7		<p>The Hearing Officer shall patiently hear submissions of the applicant or applicant's authorised agent concerned and peruse all other documents submitted or referred to during the course of hearing.</p> <p>The Hearing Officer shall be courteous in hearing submissions of the applicants or applicant's authorised agent concerned. However he shall be strict in case the person attending hearing attempts to create nuisance or behaves improperly or takes time unnecessarily by making irrelevant submissions</p>	
3.1.8		In case the relevant documents pertaining to the application scheduled for hearing are not digitised and available in the system, the Hearing Officer concerned shall get it done through the staff provided to him. In case of erroneous data entry in the application details, the Hearing Officer shall rectify the error himself or if it is not possible by the help of other officials.	
3.1.9		The Hearing Officer shall dispose of the application through the system as per provisions of the Trade Marks Act & Rules and generate the order/letter to be sent to the applicant or applicant's authorised agent concerned	
3.1.10		<p>In case a request for amendment of application is made on form TM-16 the Hearing Officer concerned shall dispose this request first and then decide about the acceptability of the application for registration, since most of such requests are filed to overcome office objections.</p> <p>In case the TM-16 is allowed, amendment in the details of the application shall be incorporated accordingly by the Hearing Officer concerned and</p>	

		the case is considered taking into account the amendment.	
3.2.1	Concept	<p>Applications for registration of trademarks are normally objected for registration on following main provisions of the Trademarks Act-</p> <ol style="list-style-type: none"> 1) Section 9- which describes “absolute grounds for refusal of trademarks” which are not prima facie “capable of distinguishing” the goods/services of one person from those of another person are devoid of distinctive character. 2) Section 11, which sets out “relative grounds for refusal” by reason of conflict with prior trademarks and well-known marks, however under Section 12 a mark could be registered on the basis of “honest concurrent use” when supported by evidence to that effect 3) Section 13 under which a mark is prohibited for registration in respect of chemical products on the ground that it consists of name of a chemical element or an international non-proprietary name 4) Section 14 under which a necessary consent of a person, whose portrait appears on the trademark, is required 5) Section 15, which governs provisions relating to registration of a trademark as “a series” 6) Section 16, which govern provisions relating to association of trademarks. 	
3.2.2		<p>Section 9 (1) of the Act sets down the following absolute grounds for refusal of registration: It states that-</p> <ol style="list-style-type: none"> a) trademarks which are devoid of any distinctive character; that is to say, not capable of distinguishing the goods or services of one person from those of another person; b) trademarks which consist exclusively of marks or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin ,or the time of production of goods or of rendering of services, or other characteristics of goods or service, c) trademarks which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade: shall not be registered. 	

	<p>distinctive character</p> <p>“The expression ‘distinctive’ in relation to goods in respect of which a trademark is proposed to be registered means <i>adopted to distinguish goods</i> with which the proprietor of trademark is or may be connected in the course of trade, from goods in case of which no connection subsists.”</p> <p>Acquired distinctiveness</p> <p>As per proviso appearing in Section 9(1) of the Act, a trademark which comes within the ambit of this sub-Section may still be registered if it can be shown that on the date of application the mark has in fact acquired a distinctive character as a result of the use made of it.</p>	
3.2.3	<p><i>In order to overcome office objections raised under Section 9(1) the applicant may submit the mark has acquired a distinctive character by virtue of its prior use</i></p> <p>The use of trademark must be established by adequate evidence. Under section 129 of the Act, ‘in any proceeding before the Registrar, evidence shall be given by affidavit. But the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit’. Rule 116 prescribes the manner in which the affidavits are to be executed.</p> <p>The requirements for securing protection under the proviso to section 9(1), as expressed in Duckham & Co’s Trade Mark Application, [(2004) RPC 28] are as follows:</p> <ul style="list-style-type: none"> a) the mark must have been used by an undertaking as a means of identifying the trade origin of the goods; b) the effect of this use is that the relevant public(or a significant proportion thereof) have come to rely upon the mark, in the course of trade, as a means of identifying the trade origin of the goods; c) if the mark is but one of a number used by the undertaking to identify the trade origin of the goods, the competent authority must be satisfied that the mark applied for has, by itself, come to foster a concrete expectation amongst the relevant public that goods bearing that mark originate from, or under the control of, a single undertaking.” 	

		<p>A descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source [2005(30)PTC(SC)1]</p> <p>Acquired distinctiveness cannot therefore be shown to exist <i>solely</i> by reference to general, abstract data such as pre-determined percentages of recognition by the relevant class of persons. Instead the views of an average consumer must also be taken into account.</p>	
3.2.4		<p>Examination of evidence of use as a Trade Mark</p> <p>In <i>Windsurfing Chiemsee (C108&109/97)</i> [1999] <i>ETMR</i> 585 the court observed that: “If the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied.”</p> <p>Having established that the mark has been used as a trade mark (including use as a secondary trade mark) the next thing is to assess the <i>extent</i> and <i>effect</i> of the use. In this regard, ECJ provided guidance as follows:</p> <p>“In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account:</p> <ol style="list-style-type: none"> i. the market share held by the mark; ii. how intensive, geographically widespread and long-standing the use of the mark has been; iii. the amount invested by the undertaking in promoting the mark; iv. the proportion of the relevant class of persons who, because of the mark, v. identify goods as originating from a particular undertaking; vi. statements from chambers of commerce and industry or other trade and professional associations”. <p>In the affidavit submitted as evidence of use the trademark, specific statement should be there as to the use of the mark in relation to specific goods or services, when it first commenced and the annual turnover based on use of the mark in relation to specific goods or services.</p>	

	<p>The use of trademark must be before the date of filing. Any use after that date should not be taken into account.</p> <p>If there have been gaps in the use, it will be necessary to consider how this affects the reputation of the mark applied for. For example, a strawberry grower may not be able to demonstrate sales throughout the year, but if he sells his strawberries for two months of the year every year for ten years, that is likely to be sufficient to illustrate continuous use, given the seasonal nature of his product. Another trader might sell goods under a certain mark for twelve years, but there may be a two year gap leading up to the date of the application in which few or no sales took place. Before a judgement can be made about accepting or refusing the mark, it would be necessary to look at all the surrounding facts to see what effect that gap had. If sales weren't particularly strong beforehand, the reputation of the mark may have been severely diminished. If, on the other hand, sales were very good both before and after, it may be that the gap would have no negative effects on the reputation at all.</p> <p>Annual Turnover figures should be given for the sales of goods/rendering of services under the mark starting from year of first use to the date of making affidavit. In case of figures are not available for earlier years, the deponent should make statement to this effect.</p> <p>If the period of use is shorter, the turn over for the period in question should be considerable, having regard to the nature of goods. The greater the turnover, the more likely it is for the mark to be accepted. Turnover, advertising and period of use are considered together - massive turnover and/or advertising could compensate for a short period of use.</p> <p>The words "<i>acquired a distinctive character as a result of the use made of it</i>" therefore mean the use made of the mark in relation to the goods/services for which it is proposed to be registered</p> <p>An analysis of the nature of the use of the mark followed by a careful evaluation of the extent of the use prior to the date of the application will, in virtually all cases, enable the Registrar to reach a reliable finding on whether, and for which goods/services, the mark has acquired a distinctive</p>	
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character because of the use made of it.

Regarding unconventional trade marks

The following types of marks come under the category:

- Colour trade marks
- Sound marks
- Shape of goods, packaging,
- Smell trade marks

Colour trade marks

In order to constitute a trade mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders. If a particular colour of packaging has become distinctive in fact as indicating the goods of a particular trader, there is no reason why it should not be protected by registration.

It is conceivable that extensive use of two colours in many different arrangements may result in the colour combination per se becoming distinctive of the applicants' goods. However, if the colours are used not in a special or particular pattern or arrangement, it is likely to be more difficult to prove that in such cases colour would lend distinctiveness as a badge of origin.

Single Colours

A single colour may be registerable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods.

As colour per se is not normally used by traders as a means of brand identification, unlike words or pictures, consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colour or the colour of their packaging. It follows therefore that single colours will only in exceptional circumstances be capable of denoting the origin of a product or service. Marks consisting of a single colour will usually be liable to objection under Section 9(1) (a) of the Act because they inherently lack the capacity to distinguish.

Combination of colours

The expression "trade mark" in section 2(1) (zb) is defined to include "combination of colours".

		<p>A combination of colours may be registrable, but this will depend on its uniqueness and how they are used. If the colours are presented as a figurative mark, then as few as two colours could be accepted; but if they are simply the colours of the packaging of the product they are less likely, <i>prima facie</i>, to indicate trade source. When applications consist merely of colours applied to the goods or their packaging it will be necessary to consider how unusual the colour combination is in relation to the goods and whether, <i>prima facie</i>, the combination is likely to strike the relevant consumer as an indication of trade source. It is, for example, unlikely that the average consumer of washing soaps would, without extensive and exclusive use, view colour combinations such as blue and white or yellow and white as an indication of trade source.</p> <p>Wherever the exclusive right to color is sought, weighty evidence should be necessary to overcome objection under Section 9(1)(a) of the Act.</p> <p>It is for the applicants to demonstrate whether the way colour is used forms an essential part of the subject matter of their trade mark. For example, if evidence of acquired distinctiveness shows that a specific colour has come to be recognised as a trade mark when it is used in a particular manner, as in the case of logo used by HP or Bharat Petroleum in their service centres, it may be advisable to define the mark in this way and establish claim for registration of mark, i.e. logo or particular geometrical device, limited to colours under section 10 of the Act. In such cases, the rights in trademark lies in particular logo or geometrical device limited to be used in that colour /those colours.</p> <p>Sound marks</p> <p>The law does not explicitly exclude “sound marks” from registration. Sound marks, in a trade mark sense, are extremely rare. Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words. To this end-</p> <ol style="list-style-type: none"> 1) applications for sound marks must clearly state that they are sound marks. Otherwise the application will be considered as if it were a word and/or device mark (e.g. in the case of musical notation) and 2) graphic representation requirements are met by representation of the sign by a musical stave divided into measures and showing, in 	
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		<p>particular, a clef, musical notes and rests, indicating relative value, and sharps, flats and naturals (accidentals).</p> <p>Assessing distinctive character of sound marks:</p> <p>The acceptability of a sound mark must, like words or other types of trademarks, depend upon whether the sound is or has become a distinctive mark; that is, whether the average consumer will perceive the sound as meaning that the goods or services are exclusively associated with one undertaking.</p> <p>Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness. In particular, the following sounds may not be accepted for registration as trademarks since these are incapable of distinguishing goods or services of one person from those of others-</p> <ul style="list-style-type: none"> • very simple pieces of music consisting only of only 1 or 2 notes; • songs commonly used as chimes; • well known popular music in respect of entertainment services, park services; • childrens nursery rhymes, for goods or services aimed at children; • music strongly associated with particular regions or countries for the type of goods/services originating from or provided in that area. <p>Smell trade marks</p> <p>As a marketing strategy, manufacturers of goods introduce smells of scents to make the use of the products more pleasant or attractive. These goods could include cleaning preparations, cosmetics and fabric softeners. Even less obvious goods are now manufactured with particular scents to add to the product's appeal, for example, magazines, pens, paper and erasers.</p> <p>Consumers of such fragranced goods are unlikely to attribute the origin of the products to a single trader based on the fragrance. Whatever may be the case, for purposes of registration as a trade mark, unless the mark is 'graphically represented' it will not be considered to constitute as a trade mark.</p> <p>The expression "trade mark" is defined inter alia to mean "a mark capable of being represented graphically and" Rule 2(1) (k) clarifies that "graphical representation means the representation</p>	
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		<p>of a trade mark for goods or services in paper form”.</p> <p>As indicated above, the definition of trade mark makes it clear that in order to constitute a trade mark it should be “represented graphically” [section 2(1)(zb)] Accordingly since smell marks do not meet this requirements, under the Indian trademark system.</p> <p>Shape of goods</p> <p>The expression “trade mark” is defined to mean “a mark capable of being represented graphically” and “may include shape of goods and their packaging”.</p> <p>Section 9(3) provides that the trade mark shall not be registered if it consists exclusively of –</p> <ul style="list-style-type: none"> a) the shape of goods which results from the nature of goods themselves; or b) the shape of goods which is necessary to obtain a technical result ; or c) the shape of goods, which gives substantial value to the goods <p>When an application for a trade mark consisting of a shape of goods or packaging is made, the application should be in relation to the goods only and not in respect of the container e.g. where the right in a mark is claimed in respect of perfumes contained in a bottle , the goods should be shown as “perfumes” and not as “bottles” which is merely a container</p> <p>“Shape which results from the nature of the goods”</p> <p>The purpose of Section 9(3)(a) is to keep free basic shapes of goods that should be available for use by the public.</p> <p>Section 9(3)(b)- Shape necessary to obtain a technical result”.</p> <p>This sub-clause prohibits registration as a trade mark where the shape of goods is necessary to obtain a technical result.</p> <p>Accordingly only when it can be shown that an essential feature (which may include the overall impact arising from the way the individual features are arranged) is not only attributable to a technical result, i.e. the shape is not one which would be adopted for its functional efficiency, it will not be caught by section 9(3)(b). Shapes which do consist exclusively of functional features attributable only</p>	
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	<p>to the technical result will be open to objections under Section 9(3)(b); marks in this category are deemed to be incapable of acquiring a distinctive character and therefore the filing of evidence will not overcome the objection. The ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.</p> <p>Section 9(3)(c)- “Shape which gives substantive value to the goods”.</p> <p>This subsection deals with shapes which add substantial value to the goods, disregarding the main function attributable to a trade mark i.e. source identification function.</p> <p>Whilst the legal test for distinctiveness is the same for shape marks as for other marks, recognition must be given to the differing perceptions of the average consumer in relation to non-traditional trademarks. In particular, the average consumer may not as readily accept the appearance of the goods themselves as an indication of trade origin. This is because “average consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element”. [<i>Procter and Gamble v OHIM</i>]</p> <p>In <i>Procter and Gamble</i>, the ECJ rejected the appellant’s argument that the marks were distinctive because, inter alia, the type of product was relatively new and there were no similar dishwasher tablets on the market at the time the applications were filed. The Court repeated its conclusions in <i>Henkel</i> and pointed out that “the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character”.</p> <p>The fact that functional claim has been previously made in a patent application will be prima facie evidence that those aspects of the shape covered by the patent claim are necessary to achieve a technical result. This will attract objection under section 9(3)(b). The test is whether there are any significant aspects of the shape or its arrangement which are not only attributable to the achievement of a technical result.</p> <p>As European Court of Justice Ruled in the <i>Henkel</i> case for the purposes of Sections 9(1), the shape of</p>	
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3.2.5		<p>Overcoming objections as to Section 9 (2) and 13,</p> <p>In case of objections raised under Section 9(2) and Section 13 which enlist trademarks which are prohibited for registration, or in case of objections raised to the effect that the trademark is prohibited for registration by any law or direction of the Government, for instance instructions issued by the Central Government under Section 23(1), the applicant can only submit that the trademark sought to be registered does not come under specified prohibition(s). Once it is established that the registration of the trademark applied for registration or the use thereof, is prohibited by any provision of the Trade Marks Act or any other law or Government direction, it shall not be accepted for registration, even if the applicant adduces ample evidence of use of the trademark.</p> <p>The only option the applicant has is to submit that his trademark does not come under said prohibition(s). He, however amend the application by filing application on form TM-16, to avoid prohibitions. The TM-16 then shall be disposed.</p>	

3.2.6	<p>Overcoming objection regarding the relative grounds for refusal</p> <p>Objections raised under Section 11 can be overcome by the applicant by :</p> <ul style="list-style-type: none"> • removing the conflicting goods/services by way of amendment. • obtaining consent from the proprietor of the cited mark(s) under Section 11(4) • filing evidence to establish honest concurrent use to secure registration under section 12; • By securing rectification of register excluding such goods/service of the same description from the specification of the cited mark, under section 57; • By dividing the application and allowing the objections- free apart of the application to proceed further. <p><i>By removing the conflicting goods/services.</i></p> <p>Many applications are filed with very wide specifications and/or include terms which cover a wide range of goods/services. The applicant may not actually intend to trade in all the goods or offer all services and therefore may be able to be more specific about his intended activities. If deletion of conflicting goods/services is desired during the course of hearing, the Hearing Officer may consider it and allow the request for such amendment of goods/ services but in no case he shall allow enlargement, addition or substitution of goods/services originally mentioned in the application.</p> <p>When using exclusion as a means of overcoming a citation it is normally necessary to ensure that all the goods and/or services considered to be both identical and similar to the cited mark are excluded from the application. the application will need to be amended to explicitly exclude not only all those goods/services that are considered to be identical, but also any descriptions of goods/services that are considered to be sufficiently similar that the mark applied for would give rise to a likelihood of confusion if it were used in respect of those goods/services.</p> <p>For example if application in Class 9, is in respect of “Electric cables” and citation of earlier application in Class 9, is in respect of “Speakers and parts and fittings there for”, the requested amendment should be as “Electric cables for use in</p>	
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	<p>providing electric supply in building premises”. Or “Electric cables not for use in relation to speakers”</p> <p><i>By obtaining consent from the proprietor of the cited mark(s)</i></p> <p>Section 11(4) of the Trade Marks Act 1999 overrides the prohibitory provisions of section 11 in empowering the Registrar to allow registration notwithstanding the objections where the proprietor of the earlier trade mark(s) or other earlier rights consents to the registration. In such case the application may be accepted for registration under “<i>special circumstances</i>”</p> <p>Consent letter from the proprietor of the earlier mark must contain the following particulars:</p> <ol style="list-style-type: none"> 1. Assertion of proprietorship over the same/similar trademark(s) by virtue of registration under particular NO(s) 2. The goods/services to which the proprietor of the cited mark is consenting. If the specification of goods/services indicated in the Letter of consent is not the same as that for which registration is sought or narrower than that applied for the applicant must seek to amend the specification of goods covering only those goods in respect of which consent is given 3. The Letter of consent should be from the same person whose name appears in the citation. The genuineness of the consent letter should be thoroughly verified by the Hearing Officer by seeing records of cited marks concerned. 4. Letters of consent should be in English or Hindi, if it is in a regional or foreign language, it should be accompanied by a certified translation. <p><i>Considering evidence to establish honest concurrent use</i></p> <p>If during the course of hearing the applicant demonstrates on the basis of evidence produced, that they have built up a sufficient amount of goodwill or common-law right in their mark, the Hearing Officer will allow an application which conflicts with an earlier mark. The important point to be considered is that common-law rights have accrued by reason of honesty of adoption, continuous & concurrent use of the trade mark, and without the owner of the earlier right having taken any prohibitive action against the applicant.</p> <p>If Hearing Officer is convinced that the applicant</p>	
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	<p>had bonafidely adopted the trademark and had acquired common law rights in the mark by virtue of honest & concurrent use of it, he may , in spite of earlier similar trademarks in respect of same/similar goods/services being on record, order for advertisement of application before acceptance.</p> <p><i>By dividing the application and allowing the objections- free apart of the application to proceed further</i></p> <p>In the Trade Marks Act 1999, a facility for division of application is provided to the applicant.</p> <p>Under proviso to section 22, if an amendment is made to single application, involving division of such application into two or more applications, the divided application will retain the date of making the original application.</p> <p>A request to divide his application is made on behalf of the applicant, on form TM-53. Each divided application is treated as separate application, with the same filing date. A separate new serial number is allotted to the divided application and they are linked by cross reference with the initial application.</p> <p>In case of a multiclass application, if citations of conflicting marks are limited to particular class (es) of that application the applicant may request for division of application so that application with clear classes may be separated.</p>	
3.2.7	<p>Attending to request made in form TM-16 for change in the application details</p> <p>A correction of any error in the application or any amendment in the application is permitted by the Trade Marks Act.</p> <p>An applicant for registration of a trade mark may, before the registration of the mark, apply in Form TM-16 accompanied by the prescribed fee for the correction of any error in his application or any amendment of his application.</p> <p>This provision is made for correction of mere clerical errors in the application. No correction shall therefore be allowed which seeks substantial alteration in the application as filed. The substantial amendment in the trademark, proprietor details, specification of goods/services (except deletion of some of the existing items, statement as to the use of mark shall not be permitted in the name of correction.</p>	Section 22 & Rule 41

		<p>However request for amendment as to change in the proprietorship of the mark on the basis of valid assignment or transmission; amendment in address of the applicant or in the applicant address for service; deletion confinement, clarification of specification of goods/services, confinement/limitation in the area of sale of goods/rendering of service, division of multiclass application etc. can be allowed.</p>	
3.3	Office action	<p>Adjournment of hearing</p> <p>If the applicant or his authorized agent is not prepared or is unable to appear for hearing and files an application for adjournment of hearing, the Hearing officer may allow the request for adjournment and then a next date will be fixed for hearing. However no adjournment will be given on frivolous grounds. Hearings may also be adjourned and may be fixed on another date due to administrative reasons. In all adjournments of hearing, a fresh hearing notice fixing hearing on another date shall be issued to the applicant/agent/attorney concerned.</p>	
3.4	Office action	<p>Acceptance of the application</p> <p>After duly considering the evidence of use of the mark, the distinctive nature of the mark, existence of earlier similar marks, if any, the nature of goods/services covered under the application and other relevant facts, the Hearing Officer may accept the application for registration or he may accept the application with condition as to use of the trademark or limitation as to area of trade, as he thinks fit; or he may propose the application to be advertised before acceptance.</p> <p>In certain circumstances the application may be advertised before acceptance. The provision for Advertisement Before Acceptance, is invoked in “exceptional circumstances”</p> <p>The provision for advertisement before acceptance, as the law itself enacts, should be invoked in “exceptional circumstances”. Where the the Hearing Officer concerned finds strong evidence of bonafide commercial adoption and use of the mark, the Examiner or the hearing officer may “Accept” the application and order the mark to be advertised “as accepted”</p>	

3.5	Office action	<p>Allowing division of the application</p> <p>On a request made on form TM-53 on behalf of the applicant to divide a multiclass application, the application shall be divided as requested. Each divided application will be treated as separate application, with the same filing date. A separate new serial number is allotted to the divided application and they will be linked by cross reference with the initial application.</p>	Proviso to Section 22 of the Trade Marks Act 1999 and Rule 104 of the Trade Marks Rules 2002
3.6	Office action	<p>Withdrawal of application</p> <p>During the course of hearing the applicant may desire to withdraw the application, or the authorised agent of the applicant may desire to withdraw the application on half of the applicant. In such circumstances, the Hearing officer will require the withdrawal letter to be submitted in writing. The withdrawal letter will be uploaded in the system. The genuineness of withdrawal letter as well as the authority of the person withdrawing the application shall be verified by the Hearing Officer on the basis of records of the application. If withdrawal of application is done by the competent person, the Hearing officer concerned will treat the application as withdrawn, enter his remarks in the system to this effect and update the status of application accordingly.</p>	
3.7	Office action	<p>Refusal of application</p> <p>If the Hearing Officer is not convinced with the materials produced & submissions made in the course of hearing and he may refuse the application for registration.</p>	
3.8	Office action	<p>Communication of decision</p> <p>A communication letter shall be generated through the system, in respect of all types of orders passed by the Hearing Officer. The said letter shall be sent to the applicant/applicant's authorised agent concerned, latest within one week of the order.</p>	
3.9		<p>Communication of grounds of decision</p> <p>On request made by the applicant on form TM-15 for seeking grounds of decisions of the Registrar, the grounds of decisions as to acceptance (or advertisement before acceptance) of application with any condition or limitation, or refusal of the application shall be generated through the system, on the basis of remarks or noting of the then hearing officer, and the same shall be communicated to the applicant.</p>	Section 18(5)

3.10.1	Requirement from the applicant	The applicant or applicant's authorised agent concerned should attend hearing before the designated hearing officer and make his submissions with decency and courteously. In case it is not possible for the applicant or applicant's authorised agent concerned to attend hearing, he should file an application for adjournment as per the Trade Marks Act & Rules.	
3.10.2		Every person appearing for the hearing should show his identity and authority to attend the hearing on behalf of the applicant. In case of the agent, he should establish that he is authorised agent of the applicant on record, or else he should file latest PA in his favour along with a request on form TM-16 to record his address as address for service of the applicant.	
3.10.3		In case the application is filed or prosecuted by a trademark agent, applicant's address for service is normally requested to be that of the trademark agent. In case, the trademark agent is changed or the applicant withdraws the Power of Attorney and wants to prosecute the application himself, he should necessarily file an amendment application on form TM-16, for recordal of such change in address for service of the applicant.	
3.10.4		An application on form TM-16 should be filed on behalf of the applicant for recording all changes that have taken place in respect of the application. The applicant or applicant's authorised agent appearing for the hearing should point out about all the requests made on form TM-16, which are still pending and should insist on their disposal.	
3.10.5		The applicant or applicant's authorised agent should file proper requests/application with proper fee in accordance with the Trade Marks Act & Rules.	
3.10.6		The applicant or applicant's authorised agent concerned should abide by the order of the Hearing Officer. In case he is aggrieved he may file an appeal before the IPAB or review, as per relevant provisions of the Trade Marks Act & Rules	
4		Publication of applications in the trademarks journal	
4.1.1	Office action	When an application for registration of a trade mark has been accepted whether absolutely or subject to conditions or limitations or it is even ordered to be advertised before acceptance, the application is accordingly advertised in the trademark journal along with conditions or limitations, if any.	Section 20, Rule 43

		The Supervisory Examiner approving the Examination report proposing to accept the application or advertise the application before acceptance, or the designated officer in PARM or Hearing Officer, as the case may be, who accepts the application or orders to advertise the application before acceptance shall himself move such application for advertisement in journal through relevant module of the Trade Marks System.	
4.1.2		The advertisement of application in the trademark journal should contain details of the <i>trademark, date of application, priority claim (if any), details of the applicant with his address, applicant's address for service including his agent's detail, class & specification of goods or service , the statement as to use of the trademark and the appropriate office.</i>	
4.1.3		The system generates a preview of the advertisement, the officer concerned if finds the contents proper, approves the case for advertisement and the application is accordingly compiled through the system for publication in the trademark journal.	
4.1.4		All such applications which are compiled for publication in the trademark journal are published in the journal by a designated officer from Head Office of the Trade Marks Registry at every Monday and the same is made available on the home page of the official website www.ipindia.nic.in free of cost to the public.	
4.1.4		The trademark journal contains- <ul style="list-style-type: none"> • Public Notices and notifications, if any, issued by the office • Trade Mark applications which are accepted or ordered to be advertised before acceptance • re-advertisements of applications, if ordered by any competent officer • Corrigenda or further notification in respect of earlier published application, • List of trademarks, which are registered, renewed, removed, application withdrawn, etc. • Post registration changes including Assignments/transmission recorded • International non-proprietary names as published by WHO from time to time. • Other information as considered necessary to be published from time to time 	

4.1.5		Other matters to be published in the journal are collected from different Sections of the TMR.	
4.2	Concept	<p>The Section 20 of the Trade Marks Act 1999 states that-</p> <p>1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner:</p> <p>Proviso to section 20 enables the Registrar to cause an application for registration of trade mark to be advertised before acceptance if it relates to a trade mark to which sub-section (1) of section 9 and sub-sections (1) and (2) of section 11 apply. Such a course can also be adopted by the Registrar in any other case where it appears to him to be expedient “by reason of any exceptional circumstances so to do”</p>	
5		<p>Withdrawal of acceptance</p> <p>Registrar of trademark is empowered to withdraw acceptance of an application for registration which is done in error or it should have been accepted for registration subject to conditions or limitations other than those under which it is accepted.</p>	
5.1.1	Office action	<p>Where it is found that an application for registration of trademark has been accepted in error; or</p> <p>the trade mark should not be registered subject to conditions or limitations subject to which the application has been accepted; or</p> <p>the trade mark should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted,</p> <p>any officer, in particular the officer in Charge of EPR or PRAS of the TMR, shall put up a note to the CGPDTM, who is the Registrar of Trade Marks, proposing to withdraw the acceptance of the application.</p> <p>This may also happen in case the application, due to data entry errors, is examined and accepted for registration with a trademark other than that applied by the applicant, or the application is examined and accepted for registration with specification of goods</p>	

		or services, or classification thereof, other than that applied by the applicant. The need to withdraw the acceptance of the application may arise, in case an International Non Proprietary Name is erroneously accepted for registration in respect of medicinal preparations, or in case a prohibited or not-registrable trademark is erroneously accepted for registration.	
5.1.2		After approval of the said note by the CGPDTM, the officer concerned shall move the matter to the Show Cause Hearing Section, through the system.	
5.1.3		The Show Cause Hearing Section shall issue a notice under Rule 42 of the Trade Marks Rules 2002, to the applicant to communicating the Registrar's objection to such acceptance and proposal of the Registrar, if any, to acceptance of that application.	Rule 42
5.1.4		After receipt of the notice, the applicant may either withdraw the application or agree to office proposal and amend the application accordingly or request for hearing.	
5.1.5		The Hearing Officer shall dispose of the matter accordingly as per provisions of Trade Marks Act & Rules. The concerned Hearing Officer shall withdraw the acceptance of application or change the conditions or limitations imposed while accepting the application, as the case may be.	
5.2	Concept	<p>Section 19 enables the Registrar to withdraw acceptance of an application in error or in circumstances the trade mark should not be registered or should be registered subject to conditions or limitations.</p> <p>In such cases, rule 42 provides for the following procedure</p> <ul style="list-style-type: none"> – The Registrar shall communicate in writing such objection to the applicant – 30 days notice from date of receipt of communication for response is mandatory – the applicant may amend the application to comply with the requirements of the Registrar or may apply for a hearing. – If the applicant does not respond within the prescribed time, the acceptance of the application shall be deemed to be withdrawn. – The application thereafter shall proceed as if it had not been accepted 	Section 19, Rule 42

5.3.1	Office action	Where the applicant desires a hearing, Registrar a notice appointing shall be issued by the Show Cause Hearing section scheduling the hearing at least 15 days after the notice.	
5.3.2		On the said date of hearing, the Hearing Officer will pass such orders as he may deem fit under the Trade Marks Act & Rules.	
5.3.3		The Hearing officer shall accordingly move the application further through the System but putting his appropriate remarks.	
6.		Registration of trademarks	
6.1.1	Office action	Every application advertised in the trademark journal and a period of 4 months has expired after advertisement or re-advertisement of the application, and in respect of which no oppositions has been filed, or opposition, if filed, has been disposed of favour of the applicant; proceeds for registration unless any instruction of a competent officer to withdraw the acceptance or cancel the advertisement of the application is received.	
6.1.2		In case the application was advertised before acceptance and it becomes due for registration in terms of the conditions as mentioned in earlier Para, the application shall be accepted for registration through the system and only then it shall be moved for registration.	
6.1.3		All such applications are taken up for registration process in order of seniority of their advertisement or re-advertisement in the trademarks journal.	
6.1.4		All applications brought under the registration process shall be approved by the officer concerned through the system, before generation of registration certificates. The officer concerned of the Registration wing of the EPR section shall ensure that the application being approved for registration is OK.	
6.1.5		In fact there are in-built checks in the system which does not allow such cases for registration, however the officer concerned should also ensure that- 1. The data entry of the application has been done correctly and the application has been duly & correctly advertised in the trade marks journal. In case of major errors in the advertisement as to the trademark, date of application, class &	

		<p>specification of goods or services and the statement as to use of the trademark the application shall be re-advertised. The matter shall be sent through the system to Pre Advertisement Amendment Section (PRAS) for re-advertisement by putting a remark to this effect in the system. Such cases shall not be processed for registration.</p> <ol style="list-style-type: none"> 2. No request for amendment of the application is pending. In such cases the matter shall be sent through the system to Pre Advertisement Amendment Section (PRAS) for disposal of amendment application, by putting a remark to this effect in the system. Such cases shall not be processed for registration until the amendment application has been allowed & a notification to this effect has been published in the trademark journal or the amendment application has been refused. 3. No instruction as to withdrawal of acceptance is there in the matter. In such cases the matter shall be sent through the system to Show Cause Hearing Section (SCHS) for hearing of application, by putting a remark to this effect in the system. Such cases shall not be processed for registration until the hearing as to Section 19 of the Trade Marks Act 1999 is concluded in favour of the advertisement of the application. 4. No opposition to registration of the application is pending. In case opposition(s) to any application has/have been disposed of in favour of the applicant, the officer shall see whether all the vital documents of the application and opposition(s) including final order(s) of opposition proceeding have been scanned & uploaded in the system and the status of the application has been updated accordingly. 5. The registration of the trademark is not prohibited by any instruction from the Government or from the court of law. In such cases the matter shall be kept pending by putting a remark to this effect in the system. 6. No formality requirement is left in respect of the application. For example No fee like association fee, extra space fee for goods or services exceeding 500 characters are due to be paid by the applicant, no formality requirement like filing of the Power of Attorney in favour of the agent is required. In such cases, the officer concerned shall generate a letter requiring the applicant to comply with above formalities, and 	
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		the application shall proceed for registration only after compliance of requirements.	
6.2.1	Concepts	<p>The Registrar of Trade Marks has a Register of Trade Marks as mentioned in Section 6 of the Trade Marks Act 1999, which has all details of registered trademarks.</p> <p>Once a trademark is registered, it is entered in the Register or its entry is made on the Register.</p>	Section 6
6.2.2		<p>Under Section 23(1) of the Trade Marks Act 1999 when an application for registration of trade mark has been accepted and either-</p> <p>a) the application has not been opposed and the time for notice of opposition has expired; or</p> <p>b) the application has been opposed and the opposition has been disposed of in favour of the applicant,</p> <p>the trade mark is registered, unless the Central Government otherwise directs, and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 154, be deemed to be the date of registration.</p> <p>Under Section 23(2), on the registration of a trade mark, a certificate in the prescribed form with the seal of the Trade Marks Registry, is issued to the applicant</p> <p>Under Section 23(3) where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.</p>	Section 23
6.2.3		<p>Rule 59 provides the manner as to how the entry in the Register of trademarks is made. Under this Rule-</p> <p>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.</p> <p>2) The entry of a trade mark in the register shall specify the date of filing of application, the</p>	

		<p>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 –</p> <ol style="list-style-type: none"> 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. the 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 the appropriate office of the Trade Marks Registry in relation to the trade mark. <p>The Registrar may from time to time, in consultation with computer experts, formulate guidelines for keeping official records in electronic form.</p>	
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Chapter IV
Tribunal Section
(Opposition & Rectification Proceedings)

Introduction:

The Tribunal Section is constituted for dealing with contested matters- namely oppositions to applications made for registration of trademarks, applications made for rectification of registration of trademarks, and other contested matters assigned to this section.

This Chapter is divided in to three Sections – Section A deals with Opposition Proceeding, Section B deals with Rectification Proceeding and Section C deals with proceeding relegated to review petition.

Section A: Opposition

After advertisement of a trade mark in the Trade Marks Journal, section 21 provides a period of 4 months within which the registration of the trade mark may be opposed by any person. This opposition proceeding can be filed only before the Registrar and cannot be taken direct either to the Court or the Appellate Board (IPAB). If the opposition is successful, the registration of the trade mark will be refused. If it fails, the mark will be registered.

Sr. No.		General Description	Relevant provision of the Act & Rules
1.		How a opposition proceeding can be started	
1.1	Concept	<p><i>Who may oppose the Application:</i></p> <p>“Any person” may give a notice of opposition to the registration of a trade mark.</p> <p><u>Notes:</u> The person filing the opposition need not to have any commercial or personal interest in the matter or a prior registered trade mark owner.</p> <p>The question of bona fides of the opponent does not arise.</p>	Section 21(1)
1.2	Concept	<p><i>Grounds of opposition:</i></p> <p>The law doesn’t specify the grounds of opposition. However, an opposition is ordinarily based on any</p>	Section 9, 11, 13, 14 and 18(1)

		<p>one or more of –</p> <ul style="list-style-type: none"> - absolute grounds as mentioned in Section 9; - relative grounds as mentioned in Section 11; - prohibitions contained in Section 13; - absence of consent in writing in Section 14; - Besides, the opponent may also raise objection U/s 18 (1) with regard to the proprietorship of the trade mark opposed. 	
1.3	Requirement from the opponent	<p><u>Limitation Period for filing Notice of opposition:</u></p> <p>Within four months from the date of advertisement or re- advertisement of an application for registration in the Trademarks Journal.</p>	Section 21(1)
1.4	Requirement from the opponent	<p><u>Prescribed Form:</u></p> <p>Opposition required to be filed as per prescribed form i.e. TM-5</p>	Section 21(1) & Rule 47 (1)
1.5	Requirement from the opponent	<p><u>Prescribed Fee:</u></p> <p>To file a opposition against any advertised mark prescribed fee is Rs. 2500/-.</p>	First Schedule entry No.12 of the Trade Marks Rules 2002
1.6	Requirement from the opponent	<p><u>Place of filing:</u></p> <p>To be filed in the appropriate office (of application under opposition)</p>	Rule 8 (1) of the Trade Marks Rules 2002
1.7	Requirement from the opponent	<p><u>Contents of TM-5:</u></p> <p>Notice of opposition to contain-</p> <p>(a) <u>In respect of an application against which opposition is entered –</u></p> <ul style="list-style-type: none"> (i) Impugned application no.; (ii) Indication of the goods or services from the trade mark application; and (iii) Name of the applicant for the trade mark sought to be opposed. <p>(b) <u>in respect of the earlier mark or the earlier right on which the opposition is based ,-</u></p> <ul style="list-style-type: none"> (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- 	Rule 48(1) of the Trade Marks Rules 2002

		<p>section 2 of section 11, an indication to that effect and an indication of the country or countries in which the earlier mark is recognized to be well known;</p> <p>(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;</p> <p>(v) a representation of the mark of the opponent and where appropriate, a description of the mark or earlier right; and</p> <p>(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.</p> <p>(c) <u>in respect of the opposing party –</u></p> <p>(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;</p> <p>(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 authorized to enter the opposition;</p> <p>(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</p> <p>(iv) Where the opposing party has no place of business in India, the name of the opponents and his address for service in</p>	
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1.8	Requirement from the opponent	<p><u>Verification of the notice of opposition:</u></p> <p>The notice of opposition shall be verified at the foot by the opponent or by authorized person who is acquainted with the facts of the case.</p> <p>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.</p> <p>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.</p>	Rule 48(2), (3) & (4) of the Trade Marks Rules 2002
1.9	Requirement from the applicant	<p><u>Filing of counter statement by the applicant:</u></p> <p>The applicant shall file a counter statement in Form TM-6 at the appropriate office.</p> <p>The prescribed fee is Rs. 1000/-.</p> <p>The limitation to file counter statement is within two months from the date of receipt of the copy of the notice of opposition.</p> <p>The counterstatement shall be verified in the same manner as the notice of opposition.</p>	<p>Section 21(2), Rule 49 & item 14 of First Schedule of the Trade Marks Rules 2002</p> <p>Rule 49(2) of the Trade Marks Rules 2002</p>
1.10	<u>Office action</u>	<p><u>Abandonment of application for not filing of counter Statement</u></p> <p>If within the period of two months from the date of receipt of the copy of the notice of opposition, the applicant does not file counter statement against the notice of opposition, he shall be deemed to have abandoned his application and an order to the effect shall be issued.</p>	Section 21 (2) of the Trademarks Act 1999
2.	Office Action	After receiving of the Application for opposition the office required to check the documents and comply with some other formalities.	
2.1	Office Action	<p><u>Formality Check</u></p> <p>The notice of opposition is received by the Cash section. The Cash Section will check whether correct fee is paid. If the fee is correct, then it will enter the appropriate fee code against the trade mark number and forward the notice of opposition to the Tribunal Section.</p> <p>The Tribunal Section shall attach the notice of opposition with physical file of the application opposed and arrange the same in order.</p>	

2.2	Office Action	<p><u>Service of notice of opposition upon the applicant:</u></p> <p>The entry as to the notice of opposition shall be made in the ‘Tribunal’ module of the Trade Marks Automation System (TMAS).</p> <p>The copy of the notice of opposition along with the system generated letter shall be served by the office of the trademark registry, upon the applicant for registration.</p>	Section 21(2) of the Trademarks Act 1999
2.3	Office Action	<p><u>Service of counter statement upon the opponent</u></p> <p>The entry as to the counter statement shall be made in the ‘Tribunal’ module of the Trade Marks Automation System (TMAS).</p> <p>A copy of the counter statement along with the system generated letter shall be served by the office of the trademark registry, upon the opponent</p>	Section 21 (3) of the Trademarks Act 1999
3.	Requirement from the applicant/opponent in respect of Evidence	<p><u>Mode of evidence</u></p> <p>Evidence to be given on affidavits. The Registrar may, in his discretion, allow oral evidence also.</p>	Section 129 of the Trade Marks Act, 1999
3.1		<p>Affidavits</p> <p>The Affidavits shall –</p> <ul style="list-style-type: none"> - be duly stamped; - be headed in the matter or matters to which they relate; - be drawn up in the first person; - be divided into paragraphs; - be consecutively numbered; and each paragraph shall, as far as practicable, be confined to one subject. <p>Every affidavit shall –</p> <ul style="list-style-type: none"> - state the description and the true place of abode of the person making the same; - bear the name and address of the person filing it; - State on whose behalf it is filed. <p>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.</p> <p>Affidavits shall be taken -</p> <ul style="list-style-type: none"> - in India, before any court or person having by law authority to receive evidence, or 	Rule 116 of the Trade Marks Rules 2002

		<p>before any officer empowered by such court as aforesaid to administer oaths or to take affidavits;</p> <ul style="list-style-type: none"> - 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. <p>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.</p> <p>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.</p> <p>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.</p>	
3.2	Requirement from the opponent	<p><u>Filing evidence in support of opposition:</u></p> <p>Any evidence in support of opposition must be filed within two months from the date of receipt of a copy of the counterstatement.</p> <p>The Registrar may, on a request on form TM-56, extend the period of filing to a period not exceeding one month in aggregate.</p> <p>Within the aforesaid time, the opponent must either file evidence or may rely on the facts already stated in the notice of opposition, in which case he must intimate the same in writing to the Registrar and to the applicant.</p> <p>The copies of any evidence filed by the opponent must be delivered by him to the other party and a written intimation thereof must be given to the Registrar.</p>	Rule 50 (1) of the Trade Marks Rules 2002

3.3	Office Action	<p><u>Abandonment of opposition for not filing of evidence in support of opposition:</u></p> <p>In case the opponent neither files evidence in support of opposition nor intimates as prescribed, he shall be deemed to have abandoned his opposition, in which case an order to the effect shall be issued to the parties.</p>	Rule 50 (2) of the Trade Marks Rules 2002
3.4	Requirement from the applicant	<p><u>Filing evidence in support of application:</u></p> <p>The applicant must file evidence, if any, in support of application within two months after the receipt by him 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.</p> <p>The Registrar may, on a request on form TM-56, extend the period of filing to a period not exceeding one month in aggregate.</p> <p>Within the aforesaid, the applicant must either file evidence or may rely on the facts already stated in the counterstatement or on the evidence already left by him in connection with the application, in which case he must intimate the same in writing to the Registrar and to the opponent.</p> <p>The copies of any evidence filed or relied upon by the applicant must be delivered by the applicant to the other party.</p>	Rule 51 of the Trade Marks Rules 2002
3.5	Requirement from the Opponent	<p><u>filing evidence in reply by opponent:</u></p> <p>The opponent may, within one month from the receipt by the opponent of the copies of the applicant's affidavit, file evidence in reply, if any. The evidence shall be confined to matters strictly in reply.</p> <p>The Registrar may, on a request on form TM-56, extend the period of filing to a period not exceeding one month in aggregate.</p> <p>The copies of evidence in reply, if any filed, must be delivered by the opponent to the applicant.</p>	Rule 52 of the Trade Marks Rules 2002
3.6	Requirement from the applicant/opponent in respect of Evidence	<p><u>Filing of further evidence</u></p> <p>The Registrar may, at any time, give leave to either the applicant or the opponent to submit any further evidence upon such terms as to costs or otherwise as he may think fit.</p> <p>Note: Further evidence may be filed by filing an</p>	Rule 53 of the Trade Marks Rules 2002; entry 58 of First Schedule of Trade Marks Rules, 2002

		<p>Interlocutory Petition (IP) with fee of R. 2500/- Copies of IP and all supporting documents must be served on the other party and an acknowledgement or proof of delivery be obtained.</p> <p>Hearing shall be fixed on IP. The Hearing Officer shall hear submissions of both parties for or against the IP and shall dispose of the petition as per trademarks law & practice.</p> <p>In case the Hearing Officer allows the IP and grants the leave to the petitioner to submit any evidence or takes the evidence already submitted with the IP, on record, the other party shall also be given an opportunity to file evidence in rebuttal within such period as may be allowed by the Hearing Officer.</p>	
3.7	Requirement from the applicant/opponent in respect of Evidence	<p><u>Exhibits</u></p> <p>Copies of exhibits to affidavits, if any, shall be sent to the other party on his request and at his expense, or, if the same cannot conveniently be furnished, the originals shall be left with the Tribunal Section of the office of the trademarks registry where they can be inspected by the other party.</p> <p>The original exhibits shall be produced at the hearing unless the Hearing Officer otherwise directs.</p>	Rule 54 of the Trade Marks Rules 2002
3.8	Requirement from the applicant/opponent	<p><u>Translation of documents</u></p> <p>Where any document relied upon is in a language other than Hindi or English, an attested translation thereof in Hindi or English shall be furnished in duplicate.</p>	Rule 55 of the Trade Marks Rules 2002
3.9	Requirement from the applicant/opponent	<p><u>Request for Extension of time:</u></p> <p>An application for extension of time under section 131 shall be made in Form TM-56 with fee of Rs. 500/.</p> <p>If the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act (not being a time expressly provided in this Act), whether the time so specified has expired or not, he may, subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly.</p>	Section 131 of the Trade Marks Act 1999 and Rule 105 of the Trade Marks Rules 2002
3.10	Office Action	<p><u>Digitization of record</u></p> <p>The notice of opposition, the counterstatement, the evidence filed & other application/petitions or</p>	

		replies thereto submitted by the parties shall be digitized & uploaded in the TMAS and shall be electronically integrated with the relevant records of opposition proceedings, concerned. If exhibits are also submitted with the affidavit, the party concerned will also be required to submit in CD ROM or email the electronic copy of exhibits reduced in non editable colored PDF file format.	
4.	Office Action in Respect of Hearing	After completion of the formality check and submission of the evidences hearing is fixed to represent their cases by the opponent as well as applicant.	
4.1	Office Action	<p><u>Fixing Hearing of cases:</u></p> <p>Upon completion of the evidence stage, the Tribunal Section shall generate the hearing notice from the Tribunal (TOP) module of the TMAS, mentioning therein the first date of hearing. The hearing notices so generated shall be sent to the parties or their authorized agents of the applicant or the opponent who are presently on records, as the case may be.</p> <p>The date of hearing shall be for a date at least one month after the date of the first notice.</p> <p>A cause list in respect of cases fixed for hearing shall be prepared on monthly basis. The cause list shall be displayed on the notice board and will be put up on office website.</p> <p>Within fourteen days from the receipt of the first notice, any party who intends to appear shall so notify by submitting a Form TM-7. Any party who does not so notify he may be treated as not desiring to be heard and the matter may proceed accordingly.</p> <p>The hearing will be conducted by the Hearing Officer as per the cause list.</p>	Rule 56 (1) of the Trade Marks Rules 2002
4.2	Office Action	<p><u>Adjournment/ Abandonment of application for non appearance at the date of hearing</u></p> <p>In case the applicant is not present on the <i>first date of hearing</i> and has not notified his intention to attend the hearing in Form TM-7, the Hearing officer shall adjourn the matter whether or not any application for adjournment is filed.</p> <p>If the applicant is not present <i>on the adjourned date of hearing</i> and has not notified his intention to attend the hearing in Form TM-7, the application may be treated as abandoned.</p>	Rule 56 (3) of the Trade Marks Rules 2002

4.3	Office Action	<p><u>Adjournment/Dismissal of opposition on non appearance at the date of hearing :</u></p> <p>In case the opponent is not present <i>on the first date of hearing</i> and has not notified his intention to attend the hearing in Form TM-7, the Hearing officer shall adjourn the matter whether or not any application for adjournment is filed.</p> <p>In case the opponent is not present on the <i>adjourned date of hearing</i> and has not notified his intention to attend the hearing in Form TM-7, the opposition may be dismissed for want of prosecution.</p>	Rule 56 (4) of the Trade Marks Rules 2002
4.4	<p>Requirement from the applicant/opponent in respect of Adjournment</p> <p>Office Action</p> <p>concept</p>	<p><u>Request for adjournment of hearing:</u></p> <p>A request for adjournment of hearing shall be made in Form TM-56 with fee of Rs. 500/.</p> <p>In every case of adjournment the Hearing Officer shall fix a day for further hearing of the case and shall make such order as to cost occasioned by the adjournment as he thinks fit.</p> <p>The fact that the agent or advocate on record of a party is engaged in another court shall not be a ground for adjournment.</p> <p>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 Hearing Officer 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.</p>	<p>Rule 105 of the Trade Marks Rules 2002</p> <p>Rule 56 (5), (6) & (7) of the Trade Marks Rules 2002</p>
4.5	Requirement from the applicant/opponent in respect of Correction of error or amendment	<p><u>Correction of error or amendment:</u></p> <p>A correction of any error in or any amendment of a Notice of Opposition or a counterstatement may be allowed by the Hearing Officer on such terms as he thinks just.</p> <p>A request for correction of error in or in connection with the application for registration of trademarks, or a request for amendment of application may also be filed by the applicant, which includes division of a multiclass application.</p> <p>Any request for amendment shall be filed on form TM-16 with a fee of Rs 500/-.</p> <p>For division of a multiclass application, request shall be filed on form TM-53 with fee of Rs 1000/- and multiples of Rs 3500/- as per number of additional classes being created out of this TM-53.</p>	<p>Section 21 (7) of the Trade Marks Act 1999</p> <p>Section 22 of the Trade Marks Act 1999; Rule 104 of the Trade Marks Rules, 2002</p>

	Office Action	<p>A new class with new items of goods/services is not permissible.</p> <p><u>Note:</u> The proper course would be to send a copy of any such request to the other party and to invite objections, if any. A hearing should be fixed and the parties be heard before disposing of the request.</p> <p>The decision shall be communicated to both parties and the same shall be incorporated in the relevant modules of TMAS. In case the request is allowed, the application, the notice of opposition or counterstatement shall stand amended or corrected accordingly and the matter will proceed further.</p>	
4.6	Office Action	<p><u>Decision in the matter</u></p> <p>On the date fixed for hearing the Hearing officer shall hear the submissions of the parties.</p> <p>In case any party desires to file written arguments, the Hearing Officer shall allow the same to be taken on record.</p> <p>After conclusion of the hearing the Hearing officer shall give his decisions along with facts and materials considered by him in arriving at such decisions, at the earliest.</p> <p>The decision of the Hearing Officer shall be communicated to the parties concerned as per procedure & practice of the Trademarks Registry and shall be incorporated in the 'decision process' of 'opposition' module of the TMAS and the status of opposition & application opposed shall be updated accordingly.</p>	<p>Rule 56 (8) of the Trade Marks Rules, 2002</p> <p>Rule 56 (9) of the Trade Marks Rules, 2002</p>

Section B: Rectification of Register

A request under section 47 may be filed before tribunal (the Registrar or the IPAB) for rectification of register by removing the mark for non-use or under section 57 or 58 for rectification of/ correction of register.

Sr. No.		General Description	Relevant provision of the Act & Rules
1.		Who may apply for Rectification of a registered Trade Marks	
1.1	Concept	<p><u>Who may file a rectification Petition</u></p> <p>Any person may make an application before the</p>	Section 47, 57, 58, 59, 60, 68, 77 of the Trade Marks Act

	<p>Registrar of trademarks or before the Appellate Board (IPAB), for removal of a registered trademark or for cancelling or varying the registration of the trademark and for rectification of the Register of trademarks, as such.</p> <p>Aforesaid rectification of register may arise out of the following procedures under the Trade Marks Act 1999</p> <ul style="list-style-type: none"> (i) Under Section 47, a trade mark which is not used within five years of its registration becomes liable for removal either completely or in respect of those goods or services for which the mark has not been in use and any person may make an application for removal of a registered trademark on this ground. (ii) Under Section 57(1) & (2) a “person aggrieved” may make an application for canceling or varying the registration of a trade mark on the ground of any contravention or failure to observe the conditions entered on the register or by absence or omission from the register any entry or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register. (iii) Under Section 68 a “person aggrieved” may make an application for removing the registration of a collective trade mark (iv) Under Section 77 a “person aggrieved” may make an application for cancellation or for varying the registration of a certification trade mark (v) The Tribunal (the Registrar or the Appellate Board) of its own motion after giving a notice to the parties concerned and giving them an opportunity of hearing, make any order as above. – Section 57(4) (vi) On application made in the prescribed manner by the registered proprietor, the Registrar of trademarks may correct any error in the name, address or description or any other entry relating to the trade mark ;enter any change in the name, address or description of the registered proprietor; cancel the entry of a trade mark in the register; strike out any goods or classes of goods or services in respect of the registered mark and make consequential amendments or alterations in certificate of registration.- section 58. (vii) Alteration of the registered trade mark by the 	1999
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		<p>of application, or</p> <p>(b) A continuous period of five years from the actual date of registration or longer has elapsed during which there was no bonafide use thereof up to three months before the date of application.</p> <p>“bonafide use” means use that is honest and genuine and “not pretended” -substantiality of use judged by ordinary commercial standards, depending upon the nature and circumstances of the case may be relevant to determine whether it was in fact bonafide”</p> <p>The period of five years under section 47(1) will commence from the date on which the trade mark is actually entered in the register. This is different than the date of application for registration of the trademark being the date of registration in view of Section 23(1) of the Trade Marks Act 1999</p> <p>However the registration may not be removed under this Section if</p> <p>(a) A company is about to be formed & registered under the Companies Act and the registered proprietor intends to assign the trade mark to that company; or</p> <p>(b) Proprietor intends it to be used by a person to be registered as the registered user, after the registration of the mark.</p> <p>(c) If alleged non-use of a trade mark is due to special circumstances in the trade, which includes restrictions on the use of the trade mark in India imposed by any law or regulation and not to any intention to abandon or not to use the trade mark in relation to the goods or services to which the application relates.</p> <p><i>Partial removal of a registered trademark</i></p> <p>Where in relation to any goods or services in respect of which a trade mark is registered and a person has been permitted under section 12 to register an identical or nearly resembling trade mark in respect of those goods/services, on application by that person for removal of the other trademark due to its nonuse, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.</p> <p>If the registration of a trade mark covered a wide</p>	<p>Section 46 of the Trade Marks Act 1999</p> <p>Section 47(3) of the Trade Marks Act 1999</p>
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		specification of goods and it is found that the trade mark has been actually used only in relation to some of those goods, it is open to the Registrar to require the specification of goods or services for which the trade mark was registered to be rewritten in order to achieve the required degree of rectification.	
1.4	Concept	<p><u>Canceling or varying the registration of a trade mark under Section 57(1)&(2)</u></p> <p>An application for canceling or varying the registration of a trade mark may be made on the ground of any contravention or failure to observe the conditions entered on the register or by absence or omission from the register any entry or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register.</p> <p><u>contravention on failure to observe a condition</u> “Contravention on failure to observe a condition”, is attracted only if there is non-compliance or violation of any conditions. However it does not extend to “limitations” as defined in section 2(1)(l). For example when a trade mark is registered with limitations as to colour under section 10, the use of the mark in any other colour will not be considered to constitute contravention of any condition. On the contrary if there is an express condition imposed against use of a particular colour or combination of colours in the label of the trade mark, it would be a condition of registration and accordingly the violation of such condition may attract rectification under section 57(1).</p> <p><u>absence or omission from the register of any entry</u> The ground of “absence or omission” of any entry in the register may be invoked against a trade mark which has been registered without a condition, whereas the trademark ought to have been registered with such condition.</p> <p><u>entry made in the register without sufficient cause</u> If the registration is found to have been made in contravention of any of the provisions of the Trademarks Act or the Rules, the registration may be challenged as “made without sufficient cause”</p> <p><u>wrongly remaining on the register</u> The existence of a registered trademark or its entry on the register can be challenged, if it is established that the registration of trademark erroneously continues.</p>	Section 57 (1) & (2) of the Trade Marks Act 1999

		<p>The relevant date in such cases is the date of application for rectification.</p> <p>For example, where a mark has become due for renewal, and the registered proprietor has not complied with the provisions concerning renewal, the registration lapses and as such the trade mark is wrongly remaining on the register.</p>	
1.5	Concept	<p><u>Additional grounds for removal of registration of collective mark</u></p> <p>The registration of a collective mark may also be removed from the register on the ground-</p> <p>(a) that the manner in which the collective mark has been used by the proprietor or authorised user has caused it to become liable to mislead the public as a collective mark; or</p> <p>(b) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.</p> <p><u>Note:</u> "Authorised user" means a member of an association authorised to use the registered collective mark of the association. Use of a collective mark by an authorised user to shall be deemed to be the use by the registered proprietor thereof.</p>	Section 68 of the Trade Marks Act 1999
1.6	Concept	<p><u>Cancellation or varying of registration of certification trade marks</u></p> <p>on the application of any aggrieved person and after giving the registered proprietor an opportunity of opposing the application, an order for expunging or varying any entry in the register to a certification trade mark, or for varying the regulations may be passed, on any of the following grounds, namely:-</p> <p>(a) that the proprietor is no longer competent, in the case of any of the goods or services in respect of which the mark is registered, to certify those goods or services;</p> <p>(b) that the proprietor has failed to observe any provisions of the regulations to be observed on his part;</p> <p>(c) that it is no longer to the public advantage that the mark should remain registered;</p> <p>(d) that it is requisite for the public advantage that if the mark remains registered, the regulations should be varied.</p>	Section 77 of the Trade Marks Act 1999
1.7	Requirement from the applicant	<p><u>Filing application for rectification of register</u></p> <p>An application under Section 47, 57, 68 or 77 for the making, expunging or varying of any entry</p>	Rule 92 of the Trade Marks Rules 2002

		<p>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 in Form TM-43 (in case of collective trademark or certification trademark) 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 be submitted to the Trade Marks Registry in triplicate. In case there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered users.</p> <p>The application shall be verified in the manner prescribed under clause (i) of sub-rule (c) of rule 48 for verification of a notice of opposition.</p>	
1.8	Requirement from the Registered Proprietor	<p><u>Further procedure</u></p> <p>Within two months or within such further period not exceeding one month in the aggregate, from the receipt of the copy of the application for rectification, the registered proprietor shall send to the office of the Trade Marks Registry from where the application for rectification was sent, a counterstatement in Form TM-6 in triplicate stating the grounds on which the application for rectification is contested and if he does so, the Tribunal Section of the Trade Marks Registry 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 of the Trade Marks Rules 2002 (dealing with filing of evidence & conducting of hearing in opposition proceeding) shall thereafter apply mutatis mutandis to the further proceedings on the application for rectification.</p> <p>The Registrar of Trademarks 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.</p> <p>In any case of doubt any party may apply to the Registrar for directions.</p>	Rule 93 of the Trade Marks Rules 2002
1.9	Office Action	<u>Hearing & disposal</u>	

		Regarding fixing & conducting hearing, adjournment of hearing and the disposal of application for rectification, the procedure as mentioned earlier in opposition proceeding, shall be followed.	
1.10	Office Action	<p>Digitization:</p> <p>The application for rectification of the register, the counterstatement, the evidence filed & other application/petitions or replies thereto submitted by the parties shall be digitized & uploaded in the TMAS and shall be electronically integrated with the relevant records of rectification proceedings, concerned. If exhibits are also submitted with the affidavit, the party concerned will also be required to submit in CD ROM or email the electronic copy of exhibits reduced in non editable colored PDF file format.</p>	
1.11	Office Action	<p><u>rectification of register of trademarks by Tribunal “of its motion under Section 57(4)</u></p> <p>The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order for canceling or varying the registration of a trade mark.</p>	Section 57(4) of the Trade Marks Act 1999
1.12	Office Action	<p><u>Procedure for rectification of register of trademarks by Tribunal under Section 57(4)</u></p> <p>The tribunal section of the Trademarks registry shall send a notice in writing to the registered proprietor and to each registered user if any, stating the grounds on which the Registrar of trademark proposes to rectify the register. The notice should 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.</p> <p>If the person so notified does not send 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.</p> <p>In case a reply to the notice issued under Section 57(4) has been received, a hearing shall be fixed and a hearing notice shall be sent as per procedure to the registered proprietor & to each registered user, if any, stating therein the date & time of the hearing.</p> <p>On the date fixed for hearing, the hearing officer shall hear the submissions of the parties present and</p>	Rule 95 of the Trade Marks Rules 2002

		<p>peruse the records.</p> <p>The Hearing Officer shall dispose of the notice under Section 57(4) as per trademark law practice & procedure of the trademarks registry by giving the grounds of his decision.</p> <p>The decision of the Hearing Officer shall be communicated to the parties concerned.</p> <p>The decision of the Hearing Officer shall be incorporated in relevant module of TMAS and the status of the registered trademark shall be updated accordingly.</p>	
1.13	Office Action	<p><u>Digitization</u></p> <p>The notice issued under section 57(4) for rectification of the register, the reply of the notice, the evidence, if any, filed & other application/petitions submitted on behalf of the registered proprietor shall be digitized & uploaded in the TMAS and shall be electronically integrated with the relevant records of the registered trademark concerned. If exhibits are also submitted with the affidavit, the party concerned will also be required to submit in CD ROM or email the electronic copy of exhibits reduced in non editable colored PDF file format.</p>	

Section C: Review

Section 127 (c) empowers the Registrar on an application made in prescribed manner, to review his own decision. Rule 115 provides that an application to the Registrar for the review of his decision shall be made on 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. The review application is to be accompanied by a statement setting out the grounds on which the review is sought. If the decision sought to be reviewed concerns any other person, the review application and the statement should be filed and the Registrar will dispose of the review application after giving the parties an opportunity of hearing.

Sr. No.	General Description	Relevant provision of the Act & Rules
1	The registrar may, on an application made in prescribed manner, review his own decision.	

1.1	Concept	<p>Who may apply: Any party to the proceeding aggrieved by the impugned decision.</p>	Section 127 (c) of the Trademarks Act 1999
1.2	Concept	<p><u>Grounds of Review:</u> The trademarks law doesn't provide for the grounds of review, however, It is a well established practice to follow the provisions in section 145 of the Civil Procedure Code, read with rule 1 under Order 47, which limits the review to the following classes:</p> <p>(a) where there is discovery of new and important matter or evidence; (b) where there is a mistake or error apparent on the face of the record; and (c) for any other sufficient reason.</p> <p>While the circumstance in (a) above would obviously justify a review 'an error apparent on the face of record' must be such an error which must strike one on merely looking at the record and would not require any long drawn process of reasoning on points where there may be conceivably two opinions.</p> <p><i>(Meera Bhanja vs. Smt. Nirmala Kumari Chaudhary, AIR 1995 SC 455)</i></p> <p>The words "any other sufficient reason" have been interpreted as "reason sufficient on grounds at least analogous to those specified immediately previously" i.e. excusable failure to bring to the notice of the court new and important matters or error apparent on the face of the record.</p> <p><i>(Maranmar vs. Mar Paulose, AIR 1954 SC 526)</i></p> <p>A decision means a concluded opinion. An order granting extension of time is not of such a nature. It is not such a decision as to give the aggrieved person a right to appeal. It is just a procedural order in aid of proceedings Similarly an order refusing extension of time to file evidence in support of opposition is not a decision and hence not reviewable.</p> <p><i>(Ajit Kumar Rath V. State of Orissa (1999)9 SCC 596)</i></p>	
1.3	Requirement from the Applicant	<p><u>Prescribed form:</u> TM-57 to be accompanied by a statement setting forth the grounds on which the review is sought.</p> <p>In case, the decision sought to be reviewed concerns any other person, the review application and the statement should be filed in triplicate.</p>	Rule 115 of the Trademarks Rules 2002

1.4	Requirement from the Applicant	<u>Prescribed fee:</u> Rs. 2000/-	Entry 57 of First Schedule of the Trademarks Rules 2002
1.5		<u>Limitation:</u> One month from the date of the decision sought to be reviewed or within such further period not exceeding a month thereafter as the Registrar may on request allow.	Rule 115 of the Trademarks Rules 2002
1.6	Office Action	<u>Service of documents:</u> In case, the decision sought to be reviewed concerns any other person, office is required to send a copy of the application and statement to the other person concerned.	Rule 115 of the Trademarks Rules 2002
1.7	Office Action	<u>Hearing and Decision:</u> An application for review of decision issued by the Registrar is generally considered by the same officer who passed the impugned decision. This is subject to the specific provision contained in section 4 of the Trademarks Act 1999 empowering the Registrar to transfer a case to another Hearing Officer. A hearing notice shall be issued to the applicant for review and other concerned person, if any, stating therein the date & time for hearing. The Hearing Officer shall hear the submissions of the party or parties peruse the relevant records and may reject or grant the application for review, either unconditionally or subject to any conditions or limitations, as he thinks fit.	Rule 115 of the Trademarks Rules 2002
1.8	Office Action	<u>Digitization</u> The review application and other relevant records relating thereto shall be digitized, uploaded and integrated with the relevant application or opposition as the case may be.	

Chapter V

Pre-Registration Amendment

This chapter deal with the provision related to correction of data entry errors of request related to amendment to data before registration of the Trade Marks, issuance of corrigenda in case of erroneous advertisement of the applied Trademarks, re advertisement of the applied trademarks in case of major errors in advertisement, and correction in registration certificate. The Pre – Registration Amendment Section (PRAS) is headed by Senior Examiner of Trade Marks and assisted by other officials depending upon the quantum of work. This section will function in all the offices of Trade Marks Registry.

Sr. No.		General Description	Relevant provision of the Act & Rules
1.	Concept	A correction of any errors in the application of any amendment in the application is permitted by the Trade Marks Act 1999 and Rules 2002.	Section 22 Rule 41
1.2	Requirement from the Applicant	An applicant for the registration of the Trademark may, before the registration of the trade mark, apply in Form-16 accompanied by prescribed fee and supporting document, if required, for correction of any errors in his application of amendment in the application.	
1.3	Office Action	The section in charge shall ensure that the request made on form TM-16 are digitized and uploaded in the system. Thereafter he/she shall dispose the request in accordance with Trade Marks Act and rules and incorporate the amendments in the application.	
1.4	Concept	<p>This provision is made for correction mere clerical errors in the application.</p> <p>No request for correction / amendment shall be allowed which seeks substantial alteration in the application for registration of trade mark.</p> <p>Any amendment in the applied Trademark which may consider substantial alteration, proprietor details, specification of goods and services (except deletion of some items), statement as to the use of the mark shall not be permitted, however request for amendment in the proprietorship of the trade mark on the basis of valid assignment or transmission, change in address of the applicant or in the address for service, deletion or confinement of any item in the specification of goods/services, confinement/limitation in the area of sales of goods/services, division of multiclass application, etc. can be allowed.</p>	

1.5	Office Action	<p>The officer assigned this work shall allow / refuse the request for correction / amendment made on form 16 through the system. In case the request is allowed, the officer shall update the application details accordingly by putting remark to that effect in the system.</p> <p>A request for correction / amendment in the application filed during the show-cause hearing or during opposition proceeding, shall be disposed by concern hearing officer, though the same shall be given effect in the system by the PRAS section.</p>	
1.6		<u>Request for correction of Data Entry Errors</u>	
	Office Action	<p>In case where there is an error/s in the data entry and request for the correction is made for the same, the officer assigned this work shall verify the facts with the relevant original documents whether available on paper or already scanned and uploaded in the system. In case original document is not available, a certified and authentic copy of the document shall be called from the applicant.</p> <p>After the verification of relevant document, if officer satisfied that errors exists, a correction shall be made in the system along with the remarks top this effect in the system by concerned officer.</p>	
1.7		<u>Correction of Data after Advertisement</u>	
	Office Action	<p>If any application erroneously advertised in the trade marks journal due to data entry errors and the same is brought to the notice, the section In-charge shall examine the contents on the basis of relevant documents and if error is found genuine, the section in charge shall make necessary correction and put his/her remarks in the system. In case of the correction of errors regarding the proprietor's details, the code of the correct proprietor shall be substituted; significant changes in the Proprietor's detail shall not be made without changing the Code.</p> <p>In case errors complained of not digitized section In-charge shall forward the matter to EDP for digitization.</p>	
1.8		<u>Issuance of Corrigenda or notification or re-advertisement</u>	
	Officer Action	<p>In case of error/s in advertisement considered to be clerical, a corrigendum is published.</p> <p>In case errors in the advertisement considered to be major such as - relates to the trade mark, proprietorship, statement of user, class or specification of goods and services (except spelling mistakes) jurisdiction,</p>	

		condition or limitation for acceptance/advertisement of the mark, the section in charge shall proceed to re-advertisement of application after written approval from supervising officer, thereafter such re advertisement shall be digitized, uploaded and integrated with the application.	
1.9		<u>Correction in the Registration Certificate</u>	
	Officer Action	<p>On receipt of complain regarding erroneous registration certificate, the section in charge shall examine the contents of the grievances on the basis of relevant documents and if complaint filed genuine, he/she shall take back the registration certificate from the applicant / complainant, and will correct the data entry errors by putting his/her remark in the system.</p> <p>In case of minor errors in the certificate, a registration certificate with corrected data shall be generated and shall be sent to the applicant or his authorized agent.</p> <p>However in case of major errors found, as if registration certificate is generated on the basis of wrong publication of mark, class, goods/services, statement of user in Trademarks journal, the section In-charge shall initiate proceeding under 57(4) after obtaining approval from competent authority. The note and approval shall be digitized thereafter forwarded to Tribunal Section for further proceeding. The activities of this section will be governed through a system module.</p>	
2.		DIVISION OF APPLICATIONS	
	Concept	<p>In the Trade Marks Act 1999, a facility for division of application is provided to the applicant.</p> <p>Under proviso to section 22, if an amendment is made to single application, involving division of such application into two or more applications, the divided application will retain the date of making the original application.</p>	Proviso to Section 22, Rule 104
2.1	Requirement from the Applicant	Applicant is required to file request for dividing his multi class application in to more than one application as per prescribed form i.e. TM 53 and fee.	
2.2	Office Action	Each divided application will be treated as separate application, with the same filing date. A separate new serial number is allotted to the divided application and they will be linked by cross reference with the initial application.	

Chapter VI

Renewal, Assignment/Transmission, Registered User and Post Registration

Changes of Registered User

This chapter deals with the renewals, restorations & post registration amendments in respect of registered trademarks. A Renewal, Restoration & Amendment (RR&A) Section is created in every branch of the Trade Marks Registry for dealing with requests for above purposes.

Sr. No.		General Description	Relevant provision of the Act & Rules
1		Renewal of trademark(s):	
1.1	Concept	<p><u>Date of registration & period of registration:</u></p> <p>For the purposes of renewal, the effective date of registration is the date of making of the application. The registration of trade mark is valid for a period of ten years (10 years) from the date of registration which may be renewed from time to time in accordance with the provisions of Trade Marks Act & Rule.</p>	Section 23(1) & 25(1) of the Trade Marks Act, 1999
1.2	Office Action	<p><u>Prior notice as to renewal of trademarks:</u></p> <p>The Office shall send a notice to the Registered Proprietor on Form O-3 intimating the approaching expiration of registration of trade mark and the condition as to the renewal of trade mark.</p> <p>The O-3 notice shall be electronically generated from the Trade Mark Automation System (TMAS) and the same shall be dispatched by the Registered Post so that it is received by the Registered Proprietor at any date not less than one month and not more than three months before the expiration of last renewal of trade mark.</p>	Section 25(3) of the Trade Marks Act, 1999 and Rule 64(1) of the Trade Marks Rules, 2002
1.3	Requirement from the applicant	<p><u>Application for renewal:</u></p> <p>An application for renewal of registration of trade mark shall be made on Form TM-12 at the appropriate office or Head Office of the Trade Marks Registry, at any time not more than six months before the expiration of last registration of the trade mark.</p> <p>Where the registration of a trade mark takes more than 10 years, namely after the first renewal date, the application for the renewal may be made within the period of six months from the actual date of registration.</p>	<p>Rule 63(1) of the Trade Marks Rules, 2002</p> <p>Rule 64(3) of the Trade Marks Rules, 2002</p>

1.4	Requirement from the applicant	<p><u>Who can apply:</u></p> <p>The application for renewal may be made by a person who is proprietor of the registered trade mark or by a person who is his duly authorized agent.</p> <p>In case of application by an agent, if not already on record, a request for change of address for service of the applicant on Form TM-50 along with the duly executed Power of Attorney in his favour shall also be filed.</p> <p>In case the renewal application is filed by some person/entity as proprietor different from the registered proprietor on record or his agent, the application may be accepted subject to an affidavit stating the entitlement of the applicant in respect of the trademark(s), whereof renewal is applied, the entire chain of title along with supporting documents.</p> <p>In case of an application for renewal from managing trustee, executors, administrators and the like, the same be accepted subject to court order(s) or documents of other authority to act on behalf of the present proprietor.</p>	<p>Rule 63(2) of the Trade Marks Rules, 2002</p> <p>Rule 63(4) of the Trade Marks Rules, 2002</p>
1.5	Requirement from the applicant	<p><u>Prescribed fee for renewal:</u></p> <p>The fee for renewal is as follows :</p> <p>For the renewal of registration of trade mark in a class before the expiration of last registration – Rs. 5,000/-;</p> <p>For the renewal of registration of trade mark consisting of series of trade mark – Rs. 5,000/- per mark;</p> <p>For the renewal of registration of trade mark in respect of goods or services falling in more than one class (Multi-class application) – Rs. 5,000/- for each class.</p> <p>For the renewal of registration of collective trade mark/ certification trade mark – Rs. 10,000/-.</p>	<p>Items nos. 17, 18, 19 & 20 of Schedule-I of Trade Marks Rules, 2002</p>
1.6	Requirement from the applicant	<p><u>Renewal after expiration of last registration:</u></p> <p>In case the application for renewal is filed within 6 months from the expiration of last registration, the same shall be accepted subject to payment of a surcharge of Rs. 3,000/- on Form TM-10.</p>	<p>Proviso to Section 25(3) of the Trade Marks Act, 1999 and Proviso to Rule 65 of the Trade Marks Rules, 2002</p>

1.7	Office Action	<p>Removal & Restoration:</p> <p>In case no renewal fee is paid along with the surcharge within six months from the expiration of last registration, the mark becomes liable to be removed from register.</p> <p>The Registrar has the power to restore the trademark provided an application for restoration of the same is made on Form TM-13 with the prescribed fee of Rs. 5,000/- accompanied by a renewal application with prescribed fee and surcharge after six months but within one year from the expiration of last registration.</p> <p>While restoring the trademark, the registrar may impose such conditions or limitations as he thinks fit. The registrar shall, while considering the request for such restoration and renewal, have regard to the interest of other affected persons.</p> <p>If case no request for the renewal of registration of trade mark has been filed on behalf of the registered proprietor even up to one year after expiration of last registration of the trade mark, the trade mark will be removed from the Register since the date of expiration of its last registration irrespective of the actual date of removal.</p>	Section 25 (4) of the Trade Marks Act, 1999; Rule 66 of the Trade Marks Rules, 2002
1.8	Office Action	<p>All requests for the renewal filed on Form TM-12, payment of surcharge filed on Form TM-10 and request for restoration filed on Form TM-13 and other documents submitted along with such requests shall be scanned and uploaded in the system.</p> <p>The requests for renewal and/or restoration shall be processed through the 'Renewal' module of Trade Mark Automated System and as per provisions of Trade Marks Act, 1999 and Trade Marks Rules, 2002.</p> <p>Irrespective of the actual date of renewal of a registered trade mark, the trademark shall be renewed from the date of last expiration of its registration.</p> <p>The intimation to the renewal will be generated from the system, accordingly and shall be sent to the applicant.</p> <p>All the renewals done through the system shall be sent through the system for publication in the trademark journal.</p> <p>In case of any objection to the renewal of registered</p>	

		trade mark, the Office shall generate a query letter through the system and send it to the applicant for the renewal accordingly and shall keep the request pending till the response of query letter is received. In case of removal of trademark(s) for non-payment of renewal fees, a letter notifying the removal of trade mark shall be sent to the registered proprietor by post and all removals done during a particular period shall be sent through the system, for publication in the trademark Journal.	
2.		Assignment & Transmission of A Registered Trademarks	
2.1.	Concept	<p><u>Assignment & Transmission –</u></p> <ol style="list-style-type: none"> 1. Assignment or transmission of a trade mark refers to the process by which proprietorship of a registered trade mark/ trade mark whose registration is being sought, is passed from one party to another/ devolves upon the other party, as the case may be. 2. The right of the registered proprietor to assign a trade mark for any consideration is recognized. 3. A registered trade mark is assignable or transmissible with or without the goodwill in respect of all goods /services or some only of such goods/services for which the mark is registered. 4. An important change introduced by the new Trade Marks Act 1999 law is that it enables an unregistered trade mark to be assigned or transmitted with or without the goodwill of the business. 5. Restrictions are imposed on assignment or transmission where multiple exclusive rights would be created in more than one person and also, to prevent splitting of right on territorial basis & creating right in different persons in different parts of India. However the Registrar of Trade Marks is empowered to approve assignment where he is satisfied that it would not be contrary to the public interest. 6. Where there is an assignment without goodwill of business, it will not take effect unless the assignor obtains directions of the Registrar of Trade Marks and advertises the Assignment as per directions. 7. Assignment of certification trade mark can only be done with the consent of the Registrar of Trade Marks. 8. Associated trademarks will have to be assigned 	Section 37,38, 39, 41, 42, 43, 44, 45 and Rule 73 of the Trade Marks Rules 2002

		<p>together.</p> <p>9. The Trademark law that provides that if the validity of assignment is in dispute, Registrar of Trade Marks may refuse to register the assignment unless the rights of the parties are determined by a competent court.</p> <p>10. Where the assignment involves transmission of money outside India, permission of authority specified in any law for transmission of money abroad will have to be produced before recordal of assignment.</p>	
2.2	Requirement from the Registered Proprietor	<p><u>Who can assign:</u> Registered proprietor of subsisting trademarks can assign his trademarks to subsequent users.</p>	Section 37 of the Trade Marks Act 1999
2.3	Requirement from the Registered Proprietor	<p><u>What can be assigned/transmitted:</u> Any registered trade mark can be assigned or transmitted with or without goodwill.</p>	Section 38 of the Trade Marks Act 1999
2.4	Requirement from the subsequent Proprietor	<p><u>Registration of assignments and transmissions:</u> Any person who becomes entitled by assignment or transmission to a registered trademark should apply for registration of the assignment/transmission, as the case may be, in the prescribed manner.</p>	Section 45(1) of the Trade Marks Act 1999
2.5	Requirement from the subsequent Proprietor	<p><u>Prescribed form(s):</u> An application to register the title of a person who becomes entitled to a registered trade mark by assignment or transmission shall be made in Form TM-24. The assignor & assignee can also make a joint request to register assignee as subsequent proprietor in form TM-23.</p>	Rule 68 of the Trade Marks Rules 2002
2.6	Requirement from the subsequent Proprietor	<p><u>Prescribed fee for TM-23/24:</u> On application to register a subsequent proprietor in a case of assignment or transfer of a single trade mark: If made within six months from the date of acquisition of proprietorship – Rs. 5000/- If made after expiration of six months but before 12 months from the date of acquisition of proprietorship – Rs. 7500/- If made after 12 months from date of acquisition of proprietorship – Rs. 10,000/- On application to register a subsequent proprietor of more than one trade mark registered in the same name, the devolution of title being the same in each case:- If made within six months from the date of acquisition of proprietorship-</p>	Items nos. 27 & 28 of Ist Schedule

		<p>For the first mark – Rs. 5000/- For every additional mark – Rs. 1000/- If made after the expiration of six months but before twelve months from the date of acquisition of proprietorship:- For the first mark – Rs. 7500/- For every additional mark – Rs. 1,500/- If made after the expiration of twelve months from the date of acquisition of proprietorship:- For the first mark – Rs. 10,000/- For every additional mark – Rs. 2000/-</p>	
2.7	Requirement from the subsequent Proprietor	<p><u>Contents of application:</u> Application must contain full particulars of the instrument of title. In addition to the above, in respect of assignment of trademark(s) without goodwill, the application must state that-</p> <p>(a) the trade mark had been or was used in the business in any of the subject goods or services, and (b) the assignment was made otherwise than in connection with the goodwill of that business.</p>	Rule 69 and 75 of the Trade Marks Rules 2002
2.8	Requirement from the subsequent Proprietor	<p><u>Documents required:</u> Original or duly certified copy of the instrument of title. In case, the applicant does not establish his claim under any document or instrument he shall 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. An affidavit in Form TM-18, if the Registrar so requires.</p>	Rule 70 of the Trade Marks Rules 2002
2.9	Requirement from the subsequent Proprietor	<p><u>Requirement of directions of Registrar in case of Assignment without goodwill:</u> Assignment of trademark(s) without goodwill shall not take effect unless the assignee, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, not exceeding three months in the aggregate, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment, and advertises it in such form and manner and within such period as the Registrar may direct. In case of an application for assignment of trademark(s) without goodwill, a copy of the directions (infra) of the Registrar to advertise the assignment and such proof, including copies of</p>	<p>Section 42 of the Trade Marks Act 1999; Rule 74 of the Trade Marks Rules 2002</p> <p>Rule 75 of the Trade Marks Rules 2002</p>

		advertisements or otherwise, as required by the office, to show that the directions have been fulfilled for in case the directions have not been fulfilled, the application will not be proceeded further.	
2.10	Requirement from the subsequent Proprietor	<p><u>Prescribed form(s) for request for direction/extension:</u></p> <p>The application for directions of the Registrar of Trade Marks shall be made in Form TM-20 and it shall state the date on which the assignment was made. A request for an extension of the period, within which the application for Registrar's direction may be made, shall be made in Form TM-21. 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.</p>	Section 42 of the Trade Marks Act 1999; Rule 74 of the Trade Marks Rules 2002
2.11	Concept	<p>Restrictions against creation of multiple exclusive rights:</p> <p>The trade marks law lays down restrictions on assignment or transmission of trademarks so as to prevent splitting of rights over the trade mark on a territorial basis and creating exclusive rights on different persons to use the trademark in different parts of India.</p> <p>However, the Registrar of Trade Marks has been empowered to approve such assignment, if he is satisfied that it would not be contrary to public interest.</p>	Sections 40 & 41 of the Trade Marks Act 1999
2.12	Requirement from the subsequent Proprietor Office Action	<p><u>Registrar's certificate/notification of approval in cases of multiple exclusive rights</u></p> <p>The proprietor of a registered trade mark who proposes to make such assignment shall make an application on form TM-17 (if multiple exclusive rights are likely to be created in different persons in view of their use of trademark for same/similar goods or services) or on form TM-19 (if multiple exclusive rights are likely to be created in different persons in view of their use of trademark in different parts of India), together with a statement of case setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission.</p> <p>A written approval or disapproval of the proposed assignment will be given after hearing the applicant</p>	Rule 77 of the Trade Marks Rules 2002

		& any other person considered to be interested in the transfer. Where an approval has been given, application for registration of the title is to be made within six months from the date of approval.	
2.13	Requirement from the subsequent Proprietor	<p><u>Registrar's consent in cases of assignment / transmission of Certification trademark</u></p> <p>Certification trademarks can be assigned only after the consent of the Registrar is obtained thereafter follows the normal process for assignment.</p> <p>The application for consent must be made on form TM-62</p>	Section 43 of the Trade Marks Act 1999; Rule 140(2) the Trade Marks Rules 2002.
2.14	Requirement from the subsequent Proprietor	<p><u>Prescribed Fee for TM-17/19/20/21/62:</u></p> <p>Fee for TM-17/19/20</p> <p>For the first mark – Rs. 2500/-</p> <p>For every additional mark – Rs. 500/-</p> <p>Fee for TM-21 for direction of the Registrar for advertisement of assignment without goodwill of trademark in use in respect of devolution of title -</p> <p>Not exceeding one month – Rs. 500/-</p> <p>Not exceeding two month – Rs. 1000/-</p> <p>Not exceeding three month – Rs. 1500/-</p> <p>Fee for TM-62 – Rs. 1000/-</p>	Items nos. 23, 24 & 25 of Ist Schedule.
2.15	Office Action	<p><u>Disputes regarding assignment/transmission:</u></p> <p>In case of dispute between the parties as to the validity of assignment/transmission of trademark(s), the Registrar may refuse to register the assignment/transmission until the rights of the parties have been determined by a competent Court.</p>	Section 45(3) of the Trade Marks Act 1999
2.16	Office Action	<p>All requests for the recordal of assignment/transmission and other documents submitted along with such requests shall be scanned and uploaded in the system. The documents being currently received at the Office of the Trade Marks Registry shall be digitized and uploaded in the system by the EDP Section, while all pending requests and accompanied documents submitted with such requests shall be digitized by A&R Section.</p> <p>The data entry of a request for Recordal of assignments/transmission shall be made in 'PR Entry' of POST REGISTRATION module of TMAS. Thereafter a scrutiny of the request and scrutiny as to existence/nonexistence of supporting documents shall be made. Then the request shall be examined & disposed of in terms of relevant</p>	

	<p>provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2002.</p> <p>The Officer-in-Charge of A&R Section while disposing the aforesaid requests for the correction or amendment shall take into account the following facts :</p> <ol style="list-style-type: none"> 1. Whether the trade mark in respect of which the request has been filed, is renewed and valid; 2. Whether the person shown to be assignor of the trademark in the assignment deed, or the person from whom the devolution of title in the trademark is claimed, appears as registered proprietor with same details as to address etc. 3. After how much time of the assignment or of the devolution of title, the request for recordal is filed; the assignment deed is duly stamped & executed and whether necessary fee is paid. 4. In case of assignment of trademark without goodwill, or in case of assignment likely to create multiple exclusive rights in different persons, or in case of assignment of certification trademark, the necessary permission of the Registrar of trademarks is obtained and whether conditions of the Registrar's permission are followed. 5. Whether there exists any dispute as to the title or as to any interest in the trademark sought to be assigned or transmitted. An affidavit of the assignee or of the assignor to this effect should be called for. <p>In case of any objection, query letter will be generated through the system and the same will be sent to the applicant who has made the request, by post.</p> <p>In case an application for recordal of assignment or transmission is allowed, the same shall be effected in the system and communication to this effect be sent to the applicant. All the requests allowed during a particular period shall be compiled and sent through the system for publication in the ensuing Trade Mark Journal.</p>	
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3		REGISTERED USERS:	
3.1	Concept:	<p><u>Permitted Use of a trademark</u> - "permitted use", in relation to a registered trade mark, means the use of trade mark - (i) by a registered user of the trade mark in relation to goods or services- (a) with which he is connected in the course of trade; and (b) in respect of which the trade mark remains registered for the time being; and (c) for which he is registered as registered user; and (d) which complies with any conditions or limitations to which the registration of registered user is subject; or (ii) by a person other than the registered proprietor and registered user in relation to goods or services - (a) with which he is connected in the course of trade; and (b) in respect of which the trade mark remains registered for the time being; and (c) by consent of such registered proprietor in a written agreement; and (d) which complies with any conditions or limitations to which such user is subject and to which the registration of the trade mark is subject;</p>	Section 2(1)(r) of the Trade Marks Act 1999
3.2	Concept	<p><u>Registered user:</u> A person other than the registered proprietor of a trade mark may be registered as a registered user thereof in respect of any or all of the goods or services in respect of which the trade mark is registered.</p>	Section 48 (2) of the Trade Marks Act 1999
3.3	Requirement from the applicant	<p>Application for registration of registered user: An Application for registration of registered user will be filed by the registered proprietor and proposed user jointly on form TM-28. An Application for registration of registered user in respect of more than one trademark may be filed in one request.</p>	Section 49 (1) of the Trade Marks Act 1999; Rule 80 of the Trade Marks Rules 2002
3.4	Requirement from the applicant	<p><u>Documents required:</u> The application to be accompanied by the following documents - 1. Agreement in writing between the registered proprietor and proposed user or duly authenticated copy thereof with respect to the permitted use of the trade mark. No application will be entertained unless the same has been filed within 6 months from the date of</p>	Section 49 (1) of the Trade Marks Act 1999 and Rule 80 of the Trade Marks Rules 2002

		<p>agreement.</p> <p>2. Document and correspondence, if any mentioned in the agreement or authenticated copies thereof</p> <p>3. An affidavit of the registered proprietor or by some person authorized, testifying to the genuineness of the documents accompanying the application and containing-</p> <ol style="list-style-type: none"> a. the particulars and statements required by clause (b) of sub-section (1) of section 49;[including degree of control to be exercised by the proprietor over the permitted use; the fact as to whether the proposed user shall be sole registered user or their shall be any restriction; terms & the duration of the permitted use, goods/services in relation to which registration of registered user is proposed, etc.] b. the precise relationship between the registered proprietor and proposed user, if any, 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. <p>4. Such further or other documents and evidence/information, as the Registrar may call for.</p>	
3.5	Requirement from the applicant	<p><u>Variation or cancellation as registered user:</u></p> <p>The registration of a person as registered user-</p> <ol style="list-style-type: none"> a) <u>may be varied by the Registrar of trademarks, as regards the goods or services in respect of which it has effect, on the application in form TM-29 of the registered proprietor of the trade mark;</u> b) <u>may be cancelled by the Registrar on the application on form TM-30 by the registered proprietor of the mark or by any other registered users;</u> c) <u>may be cancelled by the Registrar or on the application on form TM-31 any person on any of the following, rounds, namely:-</u> <ol style="list-style-type: none"> i. that the registered user has used the 	Section 50 of the Trade Marks Act 1999

		<p>trade mark otherwise than in accordance with the agreement or in such way as to cause or to be likely to cause, deception or confusion;</p> <p>ii. that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for registration which if accurately represented or disclosed would not have justified the registration of the registered user;</p> <p>iii. that the circumstances have changed since the date of registration in such a way that at the date of such application for cancellation they would not have justified registration of the registered user;</p> <p>iv. that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested;</p> <p>d) <u>may be cancelled by the Registrar on his own motion</u> or on the application in writing in the prescribed manner by any person, on the ground that any stipulation in the agreement between the registered proprietor and the registered user regarding the quality of the goods or services in relation to which the trade mark is to be used is either not being enforced or is not being complied with;</p> <p>e) may be cancelled by the Registrar in respect of any goods or services in relation to which the trade mark is no longer registered.</p>	
3.6	Requirement from the applicant	<p><u>Prescribed Fee TM-28/29/30/31:</u> For application under section 49 to register a registered user of a registered trade mark in respect of goods or services within the specification thereof: <u>Rs. 5000/-</u></p> <p>For application to register the same registered user of more than one registered trade mark of the same registered proprietor, where all the trademarks are covered by the same registered user agreement in respect of goods or services within the respective specification thereof and subject to the same conditions and restrictions in each case:- For the first mark - <u>Rs. 5000/-</u> For every additional mark of the proprietor included in the application, and in the registered user</p>	Item no. 32, 33, 34, 35 & 36 of Ist Schedule

		<p>agreement - <u>Rs 3000/-</u></p> <p>For application under Section 50(1) (a) to vary the entry of a registered user of one trademark, where the trademarks are covered by the same registered user in respect of each of them</p> <p>For the first mark – <u>5000/-</u></p> <p>For every additional mark – 2500/-</p> <p>For application under Section 50(1) (b) to cancel the entry of a registered user of one trademark – <u>2500/-</u></p> <p>Where the application includes more than one trademark-</p> <p>For the first mark – <u>2500/-</u></p> <p>For every additional mark – <u>500/-</u></p> <p>For application under Section 50(1) (c) or (d) to cancel the entry of a registered user of one trademark – <u>5000/-</u></p> <p>Where the application includes more than one trademark-</p> <p>For the first mark – <u>5000/-</u></p> <p>For every additional mark – <u>2000/-</u></p>	
3.7	Office Action	<p>All requests for the registration of registered user, requests for cancellation of registration of registered user and documents submitted along with such requests shall be scanned and uploaded in the system.</p> <p>The data entry of a request for registration of registered user shall be made in ‘REGISTERD USER’ module of TMAS. Thereafter a scrutiny of the request and scrutiny as to existence/nonexistence of supporting documents shall be made. Then the request shall be examined & disposed of in terms of relevant provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2002.</p> <p>The Officer-in-Charge of A&R Section while disposing the aforesaid requests shall take into account the following facts:</p> <ol style="list-style-type: none"> 1. Whether the trade mark in respect of which the request has been filed, is renewed and valid; 2. Whether there exists any dispute as to the title or as to any interest in the trademark sought to be licensed. 3. Whether the person entering into agreement for registered user as a registered proprietor, actually appears as registered proprietor in the trademark registry records, with same details as to address etc. 	

		<p>4. Whether registered user agreement is duly stamped & executed.</p> <p>5. Whether terms & conditions of registered user agreement including the tenure & conditions of permitted use, are in conformity with the registration of trademarks concerned.</p> <p>In case of any objection, a query letter will be generated through the system and the same will be sent to applicants who have made the request, by post.</p> <p>In case an application for registration of registered user or the application for variation or cancellation of registration of registered user is allowed, the same shall be effected in the system and communication to this effect be sent to the applicant. All the requests allowed during a particular period shall be compiled and sent through the system for publication in the ensuing Trade Mark Journal.</p>	
4.		<u>POST-REGISTRATION AMENDMENTS:</u>	
4.1	Concept	<p><u>Amendments in the registration details:</u> The registered proprietor of a trade mark may apply for correction of error or amendment as to the name, address, description of registered proprietor or cancelling the entry of the trademark on the register, or for striking out any goods or services mentioned in the registered trade mark.</p> <p>In case there are registered users of the trademarks referred in the application, the copy of such application shall be served by the applicant on the registered user(s).</p> <p>The application for correction of error or for amendment may also be made by the registered user, but in such case a notice as to such application shall be given to the registered proprietor.</p>	<p>Section 58(1) of the Trade Marks Act, 1999; Rule 97 of the Trade Marks Rules 2002</p> <p>Section 58(2) of the Trade Marks Act, 1999</p>
4.2	Requirement from the applicant	<p><u>Amendment as to the name or the description of registered proprietor:</u> A request for correction of error or for amendment as to the name or the description of registered proprietor shall be made on Form TM-33.</p> <p>The supporting documents (like certificate from the Registrar of Companies in case of change of name of the company) shall have to be attached along with the request for change of name of registered proprietor.</p> <p>The registered proprietor may file a request for correction or amendment in the name or description</p>	<p>Rules 91 & 97 of the Trade Marks Rules 2002</p>

		of the registered proprietor in respect of more than one trade mark, in one request.	
4.3	Requirement from the applicant	<u>Amendment as to the address of the registered proprietor:</u> The request for correction of error or for change in the address of the registered proprietor shall be made on Form TM-34 along with supporting documents. The registered proprietor may file a request for correction of error or for change in the address of the registered proprietor in respect of more than one trade mark in one request.	Rules 91, 96 & 97 of the Trade Marks Rules 2002
4.4	Requirement from the applicant	<u>Amendment as to the address for service of the registered proprietor:</u> An application for amendment in the address for service of a registered proprietor shall be made on Form TM-50 alongwith supporting documents. In case the address for service of the registered proprietor is sought to be amended on the basis of Power of Attorney executed in favour of an Agent, a copy of the Power of Attorney shall also be attached along with the request A single application may be made for amendment in the address of the registered proprietor in respect of more than one trade mark.	Rules 91, 96 & 97 of the Trade Marks Rules 2002
4.5	Requirement from the applicant	<u>Cancellation of registered trade mark:</u> An application for cancellation of registered trade mark shall be made on Form TM-35 .	Rule 97 of the Trade Marks Rules 2002
4.6	Requirement from the applicant	<u>Application to strike out any or some goods or services:</u> An application to strike out any or some goods or services for which a trade mark is registered shall be made on Form TM-36 .	Rule 97 of the Trade Marks Rules 2002
4.7	Requirement from the applicant	<u>Adaptation after amendment in Fourth Schedule:</u> On the classification set forth in the Fourth Schedule being amended, the registered proprietor of a trade mark may apply on 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.	Rule 101 of the Trade Marks Rules 2002
4.8	Requirement from the applicant	<u>Alteration in registered trademark:</u> An application for making alteration in the registered trade mark may be made by registered proprietor on Form TM-38 alongwith 5 legible copies of the mark as it will appear after the	Section 59 of the Trade Marks Act, 1999; Rule 98 of the Trade Marks Rules

		proposed alteration, shall be attached with the application.	2002
4.9	Requirement from the applicant	<p><u>Prescribed fee for various amendment applications:</u></p> <ul style="list-style-type: none"> • <u>(Form TM-33) – Rs. 1000/-</u> Where the application includes more than one trade mark For the first trade mark is - Rs. 1,000/- For every additional mark - Rs. 500/- • <u>(Form TM-34) – Rs. 500/-</u> Where the application includes more than one trade mark and where the address in each case is the same and is altered in the same way: For the first entry - Rs. 500/- For every other entry as per the application - Rs. 200/- • <u>(Form TM-50) – Rs. 500/-</u> Where the application includes more than one trade mark and where the address for service to be entered/altered/substituted in each case is the same and is altered in the same way: For the first trade mark is - Rs. 500/- For every additional mark - Rs. 200/- • <u>(Form TM-35) - Rs. 200/-</u> • <u>(Form TM-36) - Rs. 200</u> • <u>(Form TM-40) - Rs. 1000/</u> <p>In case more class(es) is/are added pursuant to such request, class fee @ Rs 3500/- per class is required to be paid.</p> <ul style="list-style-type: none"> • <u>(Form TM-38) – Rs. 2500/-</u> Where the application includes more than one trade mark and the addition or alteration to be made in each case being the same - For the first mark - Rs. 2500/- For every other Mark as per application - Rs. 1000/- 	Items nos. 38, 39, 40, 41, 42, 43 & 45 of Schedule-I of the Trade Marks Rules 2002
4.10	Office Action	<p>All requests for the correction/amendment of the register renewal and other documents submitted along with such requests shall be scanned and uploaded in the system. .</p> <p>The data entry of the request for correction/amendment of the register shall be made in 'PR Entry' of POST REGISTRATION module of TMAS. Thereafter a scrutiny of the request and that as to existence/nonexistence of supporting</p>	

	<p>documents shall be made. Then the request shall be examined & disposed of as per relevant provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2002.</p> <p>The Officer-in-Charge while disposing the aforesaid requests for the correction or amendment shall take into account the following facts :</p> <ol style="list-style-type: none"> 1. Whether the trade mark (marks) in respect of which requests for correction or amendment in the Register has been filed are renewed and valid; 2. Whether the person on whose behalf the request for correction or error is filed, is the person who is, at present the registered proprietor or registered user competent to file such request, or in case of Agent whether he is duly authorized by the person who is at present on records of Register; 3. If there is any change in proprietorship of the trade mark, the application for change in the name or details of registered proprietor cannot be made on Form TM-33; in such case, a request on Form TM-23 or TM-24 should be filed. 4. In case of request for alteration of goods or services made on Form TM-36, no request shall be allowed which would have the effect of adding any goods or services in respect of which the trade mark was registered; 5. In case of request for alteration in the trade mark made on Form TM-38, no request which would have effect of adding any distinctive feature in the trade mark or which would have effect of substantially affecting the identity of the trade mark shall be allowed. <p>In case of any objection, query letter may be generated through the system and the same may be sent to the applicant by post.</p> <p>In case an application for amendment in Register details is allowed, the same shall be effected in the system and all the requests allowed during a particular period shall be compiled and sent through the system for publication in the ensuing Trade Mark Journal.</p>	
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