

Notable IP Division Decisions Pertaining to Procedural Requirements for Prosecution and Evaluation of Trademark Applications

Relevant Legal Provisions

❖ Article 19(1)(g) of the Constitution of India, 1950

“19. Protection of certain rights regarding freedom of speech, etc.—

(1) All citizens shall have the right—

(g) to practise any profession, or to carry on any occupation, trade or business”.

❖ Section 36E of the Trade Marks Act, 1999

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

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

Relevant Legal Provisions (Contd.)

❖ **Section 65B of the Indian Evidence Act, 1872**

“ 65 B. Admissibility of electronic records. —

(4) In any proceedings where it is desired to give a statement in evidence by virtue of this section, a certificate doing any of the following things, that is to say, —

(a) identifying the electronic record containing the statement and describing the manner in which it was produced; ... ”

❖ **Rule 25 of the Trade Marks Rules, 2017**

“25. Statement of user in applications.—

(2) In case, the use of the trademark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents. ... ”

Relevant Legal Provisions (Contd.)

❖ Rule 36 of the Trade Marks Rules, 2017

“(1) The decision of the Registrar under rules 33, 34 or 41 shall be communicated to the applicant in writing at his address of service and if the applicant intends to appeal from such decision he may within thirty days from the date of such communication apply in Form TM-M to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at, his decision.

(2) In a case where the Registrar makes any requirements to which the applicant does not object the applicant shall comply the said requirement before the Registrar issues a statement in writing under sub-rule (1). ...”

Relevant Judicial Decisions

❖ **Agatha Christie Limited v. Registrar Of Trade Marks [C.A.(COMM.IPD-TM) 10/2021]**

*“19. The impugned order is also liable to be set aside, in my view, as being unreasoned. **The right to register a mark under which one intends to provide good or services is a valuable right, partaking of the character of Article 19(1)(g) of the Constitution of India. Any decision not to allow registration of a mark has, therefore, to be informed by reasons which should be apparent on the face of the decision. The impugned order, in my view, is bereft of sufficient reasons to justify the decision taken therein.**” (Emphasis supplied)*

❖ **Abro Industries, Inc. v. The Registrar Of Trade Marks [C.A.(COMM.IPD-TM) 28/2021]**

*“9. **5...impugned order as also the statement of grounds of decision has not stated any reason why such invoices cannot be taken cognizance of or relied upon by the appellant for its claimed user date....the respondent cannot add to or improve the grounds contained in the impugned order. The impugned orders are to be read for what they state and so read, it is apparent that the learned Senior Examiner of Trade Marks has given no reason to reject reliance of the appellant on these invoices..**” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

❖ **Pioneer Adhesives, Inc. v. The Registrar Of Trade Marks [C.A.(COMM.IPD-TM) 41/2021]**

“6. Apart from quoting Section 9 and 11 of the Trade Marks Act, 1999, the above order does not deal with any of the contentions raised by the appellant.

7. Clearly, therefore, the Impugned Orders in both the present appeals as also the Statement of Grounds of Decision are non-speaking.” (Emphasis supplied)

❖ **Kaira District Cooperative Milk Producers Union Ltd. and Ors. v. Registrar of Trademarks and Ors. [W.P. (C)-IPD 14/2021]**

“21. The Trade Marks Act does not require the passing of a reasoned order by the Registrar of Trade Marks before accepting or advertising any trade mark.” (Emphasis supplied)

“24. ..this Court is not agreeable to requiring any further orders to be passed by the Registrar at interlocutory stages of examination of an application or consideration of objections, beyond the orders which are required to be passed by the Trade Marks Act and the Trade Marks Rules.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ **Pawandeep Singh v. The Registrar of Trademarks and Ors. [W.P. (C) IPD 7/2022]**

“8.it is necessary for the Controller General of Patents, Designs & Trade to device a proper mechanism for holding show cause hearings by including the following features:

- i. **Publication of cause list notice on a daily basis**, with serial numbers for the applications to be taken up, preferably with morning and afternoon slots, if required.*
- ii. Utilising a platform with an **open link** which permits more individuals to join a hearing at a time basis.*
- iii. **Matters be called serial number-wise** for the purpose of certainty and convenience of the applicants, so that the concerned Applicant/Agent/Counsel can make submissions in respect of the application being examined when the appropriate number is called out, instead of waiting endlessly in the waiting room.*

Relevant Judicial Decisions (Contd.)

iv. Removal of templates from the order statements such as 'hearing took place before me' which may vary on case-to-case basis.

*v. Some extra space being made available in the order for Senior Examiners to put their **brief reasons for allowing or refusing the application.***” (Emphasis supplied)

“12. The office of the Registrar of Trade Marks, shall afford a proper hearing to the Applicant and pass orders in accordance with law. The date of hearing shall be communicated to the Applicant through email by the Examiner.”

Relevant Judicial Decisions (Contd.)

❖ **Allergan Inc And Anr v. Controller General Of Patents Designs And Trade Marks And Anr [W.P.(C)-IPD 55/2021]**

*“There is a marked difference in the language used in Article 5 of the Madrid Protocol, as reproduced hereinabove, and Section 36E(5) of the Act. Unlike the Madrid Protocol, where the Trade Mark office of the Contracting State is to communicate its ‘refusal’ to register the trade mark to the International Bureau, in Section 36E(5) of the Act, the Trade Mark Office of India is to communicate its ‘acceptance’ to such International application. **While in Madrid Protocol, it is failure to communicate ‘refusal’ within the time prescribed, which shall result in deemed extension of protection to the Trade Mark, in Section 36E(5) of the Act, it is the failure to convey ‘acceptance’ that leads to such deeming extension of protection.**” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

❖ **Excitel Private Limited v. The Registrar Of Trade Marks [C.A. (COMM.IPD-TM) 5/2021]**

*“14. This Court is of the opinion that **rejecting the evidence extracted hereinabove, on the ground that it does not constitute primary evidence would be an incorrect approach inasmuch as the genuineness of the printout can be easily checked by the examiner by accessing the internet at the time of hearing. Moreover, if there is any doubt in respect of printouts that have been filed by the Appellant, at best, the examiner can call for an affidavit under Section 65B of the Information Technology Act, 2000 Simply rejecting the website printouts would be contrary to law as the law permits reliance on website printouts, so long as they can be they can be accompanied with a certificate under Section 65B of the IT Act....**”* (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ **Karim Hotels Pvt. Ltd. v. The Registrar Of Trademarks [C.A. (COMM.IPD-TM) 16/2021]**

“9. The reasoning given by the Registrar of Trademarks in rejecting the trade mark application of the Appellant is not sustainable in the opinion of the Court, as an NOC is being sought. It is not clear as to who is to give the NOC. Presumably, the Registrar’s order is silent but may be intending to communicate that NOC ought to be issued by the founder. The Reply to the examination report is stated to be not satisfactory by the Senior Examiner.”

(Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ **Sunway Berhad v. Registrar Of Trade Marks [C.A.(COMM.IPD-TM) 78/2021]**

*“4. without going into the merits of the case, since the **impugned order does not deal with the contentions urged by Appellant in its above-said reply to the FER**, the impugned order is liable to be set-aside and the matter is remanded back to the Senior Examiner for fresh consideration..”*

*“5. It is made clear that the **Court has not expressed any opinion on the merits of the case**. The Senior Examiner shall consider the reply ... and take a decision thereon, in accordance with law within six weeks from today, **uninfluenced by the observations made hereinabove.**” (Emphasis supplied)*

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Relevant Judicial Decisions (Contd.)

❖ **Lite Bite Travel Foods Private Limited v. The Registrar Of Trademarks [C.A.(COMM.IPD-TM) 4/2021]**

“15. the impugned order does not reflect any examination or consideration of the submissions contained in the reply... the affidavit... or the documents filed with the affidavit.”

“18. ...keeping in mind the principle that justice should not only be done but must be seen to be done, as enunciated by the Supreme Court in P.V. Narasimha Rao v. State (CBI/SPE), the learned Registrar is requested to assign the task of adjudication to an officer other than the officer who has passed the impugned order.” (Emphasis supplied)

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Relevant Judicial Decisions (Contd.)

❖ **MVS Eduexcellence Pvt Ltd v. The Registrar Of Trademarks, Delhi [C.A.(COMM.IPD-TM) 148/2022]**

“12. ..an application or petition would be governed by the procedure, or format, applicable at the time when it is filed, and that subsequent changes in procedure or format introducing during the pendency of the application would not affect it. Besides, Rule 158 of the 2017 TM Rules saves acts done under the 2002 TM Rules before the 2017 TM Rules came into force ...(Emphasis supplied)

14. the claim of prior user by the appellant, predicated on the aforesaid documents, be considered in the first instance by the learned Registrar, as it primarily involves examination into facts.” ...(Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ **The American Physical Society v. The Registrar Of Trade Marks [C.A.(COMM.IPD-TM) 120/2021]**

*“6. Regarding the alleged inadequacy of the user affidavit, it is important to note that the application for the subject mark was submitted on 27th November, 2013, which predates the implementation of the Trademarks Rules, 2017. **The requirement to substantiate user claims with an affidavit was introduced through the Trademark Rules, 2017, and the Appellant was not obligated to submit one with their application..**” (Emphasis supplied)*

Conclusion

- ❖ Refusal orders under absolute and relative grounds are often accompanied with procedural grounds.
- ❖ Unsubstantiated, un-reasoned and non-speaking orders from the Trade Marks Registry have been interpreted by the Delhi HC IPD as against the interest of justice, as well as violative of the rights of the Applicants.
- ❖ These Delhi High Court decisions have given careful consideration to the scheme of the Trade Marks Act, 1999 and Trade Marks Rules, 2017 and ample importance has been attributed to safeguarding the legislative intent behind these provisions.

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Thank you!
Questions?

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