

Legal Issues in ‘Trademarks’

Topic: ‘Whether Procedural Lapses in Trademark Examination Constitute Independent Grounds for Rectification?’

Relevant Legal Provisions

❖ Section 57, Trade Marks Act, 1999

Power to cancel or vary registration and to rectify the register.

(1) Any person aggrieved by the absence or omission from the register of 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, may apply in the prescribed manner to the Appellate Board or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.

❖ Rule 33, Trade Marks Rules, 2017

Examination, Objection to acceptance, hearing.

(1) The Registrar shall cause the application to be examined as per provisions of the Act, wherein a search shall also be conducted amongst the earlier trademarks, registered or applied for registration, for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any trademark identical with or deceptively similar to the trademark applied for. *(emphasis supplied)*

Relevant Legal Provisions

❖ Rule 37, Trade Marks Rules, 2002

Acknowledgement and Search

(2) Upon receipt of the application for registration of trade mark, the Registrar shall cause a search to be made amongst the registered trademarks and amongst the pending applications for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any mark identical with or deceptively similar to the mark sought to be registered and the Registrar may cause the search to be renewed at any time before the acceptance of the application but shall not be bound to do so. (*emphasis supplied*)

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Relevant Case Laws

❖ **DCM Shri Ram Consolidated v. Sree Ram Agro Ltd.; I.A. Nos.7028/2010 & 11464/2010 in C.S. (OS) No.1042/2010; Single Judge Bench; Delhi High Court; February 8, 2012**

“27... At this stage, it is suffice to state that the registration has been secured by the defendants bearing No. 1867816 which has been although applied prior but, was prosecuted and obtained pursuant to the interim orders passed by this court in the matter. The Registrar of Trade Marks has not cited the previously registered trade mark No.1092754 of the plaintiff as a matter of the conflicting the mark in the examination report and proceeded to grant the registration without citing the plaintiff’s prior registered mark and also perhaps not been informed about the interim orders and seisen of the dispute by this court and granted the registration ... ”

“30.In the present case too, the situation like the one discussed above has occurred wherein the registration obtained by the defendant under some suspicious circumstances, wherein the present suit was filed on 19.05.2010 ... the registration of the same very mark was granted...Hence, there is clear violation of the provisions including Section 11 as the identical prior registered trade mark of the plaintiff was not cited as a conflicting mark as per the examination report handed over by the defendants counsel and also the same is contrary to rule Rule-37 of the Trade Mark Rules, 2002 which provides as a duty of the registrar to examine the application by causing search of the previously pending and registered marks and perhaps the registrar was also not informed about this court being in seisen of the dispute and interim orders passed by this court. Thus, considerable doubts can be expressed upon the validity of such registration.” (emphasis supplied)

Relevant Case Laws

❖ **Auto Pins (India) Ltd. v. S.R. Springs Pvt. Ltd. 2016(65)PTC380(IPAB); Division Judge Bench; IPAB Chennai; August 12, 2015**

“8. ...We are also constrained to state that from the materials available on record, it is not revealed that whether the first respondent has filed any search application in order to find out whether any similar trade mark as that of the impugned trade mark has been registered by the Registry. The materials also does not disclose any step taken even by the Registrar in respect of such a search.”

“9. The reading of the above said provision makes it crystal clear that it is incumbent on the Registrar to cause a search upon receipt of an application for registration of a trade mark, and the said provision is undoubtedly a mandatory provision and the non-compliance of the same would vitiate the entire proceedings culminating into the grant of a registration certificate. As far as the instant case is concerned, we are unable to get any material available on record to show that the Registrar of Trade Marks has complied with the said mandatory provision and on this ground alone, the application is liable to be allowed for rectification.” (emphasis supplied)

Relevant Case Laws

❖ **Prajapati Constructions Ltd. v. Manoj Ramanand Prajapad, 2018(74)PTC529(IPAB); Division Judge Bench; IPAB Mumbai; May 16, 2018**

“19. We have seen the Examiner Report dated 13th June, 2013 issued to the Respondent No. 1 by the Respondent No. 2. It is evident from the Examiner Report that the registered trademark and the pending applications of the applicant have not been cited in the Examiner Report. It appears from the said report that the Examiner has examined the application of the respondent No. 1 of the mark as SHIVAM and not PRAJAPATI.”

“20. It is clear that there is a lapse on the part of the respondent no, 2 in Examiner Report. We failed to understand why the registered trade mark and pending applications have been ignored by the respondent No. 2. Had the said trade marks and pending applications of the applicant been referred in the Examiner Report, the application of the respondent No. 1 ought not to have been allowed. Despite of grave lapse on the part of respondent No. 2, the application of the respondent No. 1 was proceeded further and the same was registered....”

Relevant Case Laws

❖ **Prajapati Constructions Ltd. v. Manoj Ramanand Prajapad, 2018(74)PTC529(IPAB); Division Judge Bench; IPAB Mumbai; May 16, 2018 [Contd.]**

“23...The applicant has no option but to file the present application. We are of the view that a glaring error has been happened on the part of respondent No. 2 while accepting the trade mark of respondent No. 1. It is the duty of respondent No. 2 to examine the earlier registered trade marks as well as the pending applications otherwise the rights of the owner/registered owner shall be effected and entire system will be collapsed. The respondent No. 2 is bound to comply the mandatory provisions of section 9, section 11, 12 and section 18 of the Act very strictly so as the rule 37 of the Act. In many cases, we have been noticing from rectification proceedings that in the Examiner Report, the registered trade mark and pending applications of the owners have not been cited as conflicting marks. It is a matter of serious concern, lakhs of oppositions are pending in the office of respondent No. 2. Trade Mark Act is a Special Act. All these provisions are mandatory and cannot be ignored as the valuable rights are involved of the owners of trademarks....” (emphasis supplied)

Relevant Case Laws

❖ **Loreal India Pvt Ltd vs. Rajesh Kumar Taneja Trading as Innovative Derma Care and Ors.;**
RFA(OS)(IPD) 2/2023; Division Judge Bench; Delhi High Court: July 15, 2024

*“30. In the present case, there is no cavil that the impugned trademark was a registerable trademark and there were no grounds to refuse the registration under Section 9 of the Act. The controversy is limited to considering whether the Registrar had correctly examined the question that whether there were any grounds to refuse the registration of the impugned trademark because of its identicality with the earlier trademark in respect of similar goods or services, which would result in likelihood of any confusion on the part of the public including on account of association with an earlier trademark on record (whether registered or pending registration). **It is apparent that there was an error in conducting search in as much as the search report indicates that the search was conducted in respect of the mark CHARIWASH instead of CLARIWASH.** It is reasonable to assume that the search was confined to the trademark similar to CHARIWASH and not CLARIWASH.”*

“31. Although it cannot be disputed that there was a procedural error in conducting the examination, we are unable to accept that the registration of the impugned trademark in favour of respondent no.1 is required to be cancelled for the said reason.” (emphasis supplied)

Relevant Case Laws

❖ **Loreal India Pvt Ltd vs. Rajesh Kumar Taneja Trading as Innovative Derma Care and Ors.;**
RFA(OS)(IPD) 2/2023; Division Judge Bench; Delhi High Court; July 15, 2024 [Contd.]

*“32. As noted above, the principal purpose of conducting the search is to ascertain whether there were any identical or deceptively similar trademarks in respect of the same goods or services. The registration of the trademark, which is identical or deceptively similar to the trademarks on record in respect of the similar goods or services may be refused as it would result in confusion in the minds of public. Thus, unless, prima facie it is established that the impugned trademark is identical or deceptively similar to the trademark in respect of similar or identical goods which were on record, at the material time, the registration of the impugned trademark cannot be faulted. **Clearly, it would not be apposite to cancel the registration of the trademark, in respect of which there are no grounds for refusing registration under the Act, merely because of some error in the procedure adopted by the Registrar at the material time. It is important to bear in mind that the object of the examination is to ensure the compliance of the provisions of the Act. Thus, no interference with the registration of the trademark would be warranted, unless it is prima facie established that the registration of the trademark falls foul of the provisions of the Act.**” (emphasis supplied)*

Relevant Case Laws

❖ **Ashiana Ispat Limited vs Kamdhenu Limited & Ors; LPA 407/2025, CM APPL. 36781/2025 & CM APPL. 36783/2025; Single Judge Bench; Delhi High Court: September 3, 2025**

“11.10 There can be no manner of doubt that the exercise of examination of an application for registration of a trade mark, issuance of FER if deemed appropriate, the response thereto, the consideration thereof and passing of final orders after hearing the applicant is an exhaustive and detailed exercise, as envisaged in Rule 33 ...specifically requires the Registrar to search among the existing registered trade marks, or trade marks in respect of which applications for registration are pending, as to whether there are any trade marks which are deceptively similar to, or identical with, the mark of which the applicant seeks registration. If there are, it is the statutory duty of the Registrar to require the applicant, in the FER which the Registrar would issue, to satisfy the Registrar that the trade mark forming the subject matter of the application nonetheless merits registration, despite the existing trademarks that the Registrar chooses to cite....”

“11.11 It is, therefore, the bounden duty of the Registrar to confront the applicant seeking registration of a trade mark with all other trademarks, earlier registered or in respect of which applications for registration are pending, which, in the perception of the Registrar, are identical or deceptively similar to the trade mark of which the applicant seeks registration...” (emphasis supplied)

Relevant Case Laws

❖ **S.S. White Burs Inc v. The Registrar of Trade Marks, & Anr; C.O. (COMM.IPD-TM) 448/2022; Single Judge Bench; Delhi High Court; April 25, 2026**

“60. It is, however, an undisputed position on record that the Examination Report dated 07.08.2012 issued by the Trade Marks Registry, for TM no. 2147676, pertains only to Class 5 and does not reflect any examination whatsoever in respect of Class 10. No material has been placed on record by either the Registrar or the Respondent to demonstrate that any separate or subsequent examination was conducted for Class 10. It is clear that there is a lapse on the part of the Registrar in examiner report...”

“61. Petitioner contends that the Registrar’s failure to examine the marks registered in Class 10 led to incorrect acceptance of the trademark application for Class 10 and the consequent registration...”

“64. In the absence of any documentary evidence evidencing examination in Class 10, it must be held that the Respondent’s application escaped the mandatory scrutiny required under Rule 33 in respect of the very class in which it claims actual use and commercial activity. This omission is not peripheral but strikes at the core of the registration process.” (emphasis supplied)

Relevant Case Laws

- ❖ **S.S. White Burs Inc v. The Registrar of Trade Marks, & Anr; C.O. (COMM.IPD-TM) 448/2022; Single Judge Bench; Delhi High Court; April 25, 2026 [Contd.]**

“69. This Court is, therefore, of the considered opinion that the nonexamination of the Respondent’s application in Class 10 constitutes a material and substantive error, which has vitiated the entire registration process. The illegality of the registration is not curable, and its cancellation cannot be avoided merely because the Registrar committed an error in wrongly registering it. The mandatory statutory safeguard envisaged under Rule 33 has been bypassed, leading to the illegal grant of registration in favour of the Respondent.”

“86. In view of the foregoing discussion, this Court is satisfied that the impugned TM no. 2147676 in favour of the Respondent squarely falls within the meaning of an ‘entry made without sufficient cause’ as well as an ‘entry wrongly remaining on the register’ within the meaning of Section 57(2) of the Act. The registration, having been obtained in contravention of statutory provisions and tainted by lack of bona fides, cannot be permitted to subsist.” (emphasis supplied)

Conclusion

- ❖ Section 57 is broad enough to encompass cases where the registration process itself is vitiated by a faulty or incomplete examination report. A registration granted without compliance with the mandatory examination requirements under Rule 33/Rule 37 can legitimately be treated as an “*entry made without sufficient cause*” or an “*entry wrongly remaining on the register*”.
- ❖ The judicial trend prior to *S.S. White* had already recognised that non-citation of prior marks, failure to conduct statutory searches, or defective examination reports constitute serious procedural lapses affecting the validity of registration. These authorities consistently emphasise that examination under the Act is not a mere formality but a mandatory statutory safeguard.
- ❖ However, every procedural irregularity may not automatically justify cancellation. A registered proprietor should not become entitled to file a cancellation application solely on the basis that the Registrar had failed to cite its earlier registration during the examination stage and where failure to cite a conflicting mark results in the registration of an identical or deceptively similar mark, the person aggrieved may rely upon the omission on part of Registrar to corroborate and support his substantive grounds in the rectification or cancellation application. That is to say, the challenge of the registration must ultimately rest on the statutory invalidity of the registration.

THANK YOU!

Questions?

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