

Speed - Past



INTELLECTUAL
PROPERTY **INDIA**
Patents/Designs/Trademark
GEOGRAPHICAL
INDICATIONS



सत्यमेव जयते

No.PL/2014/HO/
GOVERNMENT OF INDIA
MINISTRY OF COMMERCE & INDUSTRY Fax No.28032381
Trade Marks Registry
Intellectual Property Office
Plot No.32, Sector - 14, Dwarka
NEW DELHI - 110 078.
<http://ipindia.nic.in>

☎ 28031838

Dated: 24/07/2014

To,

Shri Gurvinder Singh, Advocate
Secretary,
Intellectual Property Attorneys Association,
Suite 404, Law Arcade, 18 Pusa Road,
New Delhi-110005.

**Sub: - Disposal of Representation of IPAA against Officer Order No. 16 of 2012-13
dated 08/06/2012.**

Sir,

I am directed to forward herewith an order disposing off representation of
Intellectual Property Attorneys Association dated 11/02/2013.

Yours Sincerely,

(PREM LATA)

ASSTT. REGISTRAR OF TRADE MARKS

Encls: As above.

Copy To:- 1) Shri Jatan Singh, Advocate
Central Government Standing Counsel,
Chamber No. 460, Lawyers Chamber,
Delhi High Court, New Delhi-110001.

2) The Office of the CGPDTM,
IPO Building, Mumbai.

THE TRADE MARKS ACT, 1999.
(Before the Registrar of Trade Marks, New Delhi)

IN THE MATTER OF
Representation dated 11.02.2013
submitted by the
Intellectual Property Attorneys'
Association, regarding the
Office Order No. 16 of 2012-13

Date of hearing: 26.06.2014

Present: 1) Shri Chander M. Lall, Advocate
2) Shri Gurvinder Singh. Advocate
3) Shri Mohan Vidhani. Advocate and
4) Shri M.K. Miglani, Advocate-
jointly representing the Intellectual Property Attorney
Association (IPAA).

Order

In order to conduct day to day affairs of the Trade Marks Registry in accordance with the provisions of Trade Marks Act 1999 and Trade Marks Rules 2002 made there under , certain Office Orders were issued on 07th and 8th June , 2012 which included the Office Order No.16 pertaining to Pre-Registration Amendment Section (PRAS). The clause 3 of the said order is reproduced hereunder:-

"No request for amendment shall be allowed which seeks substantial alteration in the application for registration of trademark. The substantial amendment in the trade mark, 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. However request for amendment in the proprietorship of the trademark on the basis of valid assignment or transmission; amendment in the address of the application or in the applicant's address for service; deletion or confinement of any item in the specification of goods/services: confinement/limitation in the area of sale of goods/rendering of service may be allowed."

The Intellectual Property Attorneys' Association (hereinafter referred to as 'IPAA') filed W.P. No. 3679/14 before the Honorable High Court of Delhi, challenging clause 3 of Office Order No 16 of 2012 on various grounds as mentioned in the petition. A representation dated 11.2.2013 was also filed by the IPAA before the undersigned for recalling of the impugned clause 3 of the said order, which remained undisposed. The Writ Petition came up for hearing before the Hon'ble High Court of Delhi on 29.5.2014. During the hearing, the Government Counsel assured the Hon'ble Court that the representation dated 11.2.2013 would be disposed of by the Registrar within a period of six weeks. The Hon'ble Court accepted the statement/assurance given by Government Counsel and directed that, before disposing off the representation, an authorized representative of the petitioner (IPAA) would be given an oral hearing in Delhi. Hence, hearing was fixed for 16.06.2014, which was rescheduled to 26.06.2014 on the request of IPAA.

The submissions of IPAA with reference to the representation dated 11.02.2014 were as follows: -

(1) The relevant section of Trade Marks Act 1999 regarding the amendment reads as-

"22. Correction and amendment.-- The Registrar may, on such terms as he thinks just, at any time, whether before or after acceptance of an application for registration under section 18, permit the correction of any error in or in connection with the application or permit an amendment of the application.

Provided that if an amendment is made to a single application referred to in subsection (2) of section 18 involving division of such application into two or more applications, the date of making of the initial application shall be deemed to be the date of making of the divided applications so divided."

Accordingly, the section-

- a) permits correction of any error in/or in connection with application OR
 - b) permits an amendment of application any time before registration,
- which implies that the legislature did not intend to impose any restrictions

on the corrections of error and amendment in trade mark application. The term 'correction' is a remedial action, which may be a typographical error, whereas the amendment is open ended. Changing the name of proprietor, address, address for service are a few instances of amendment. The stress is placed on the word 'OR' used in the section in the middle of correction and amendment for broad coverage. Thus, the imposition of absolute restriction on amending the statement of use is contrary to the scheme of Section 22.

(2) It was argued that the expression 'trade mark' and the expression 'application' are two different expressions. Thus, the amendment or correction to an application is different from an amendment or correction to a trade mark. The user date is part of the application and not of the trade mark and thus, the provision of rule 41 imposing the restrictions on amendment which have the effect to substantially altering the trade mark applied for shall not be applied to statement of use.

(3) Section 22 also involves the exercise of discretionary powers by the Registrar which have to be in line with Section 128, which is reproduced hereunder:-

"128. Exercise of discretionary power by Registrar.— Subject to the provisions of section 131, the registrar shall not exercise any discretionary or other power vested in him by this Act or the rules made thereunder adversely to a person applying for the exercise of that power without (if so required by that person within the prescribed time) giving to the person an opportunity of being heard.

Thus, the imposition of absolute restrictions and refusing amendment/corrections to the user date without hearing also makes the impugned clause of the office order ultra vires the Act.

(4) The restriction of making amendment in statement of use is also contrary to Section 58 of the Act wherein it is provided that the Registrar may correct any error in name, address or description of the registered proprietor or

any other entry relating to trade mark.

(5) The Trade Marks Registry itself released the Draft Manual of Trade Mark Practice and Procedure 2009 wherein guidelines were laid down as to the circumstances in which an amendment would be permitted and it did not mention any restriction on amendment of the date of use.

(6) That not allowing the amendment of use is contrary to the past practice of the Trade Marks Registry. Two orders passed after the impugned clause of the Office Order have been stressed upon regarding altering the use that and it has been claimed that the Hon'ble Ld. IPAB has recognized the amendment of use in (i) *Pidilite Industries Ltd. V. Jubilant Agriand Consumer Products Ltd.* 2014Indlaw MUM 51 (end of para 6 on page 4) and (ii) *Voltas Ltd. V. DebrajDey* 2014Indlaw IPAB 1.

(7) Reliance was also placed on the observations made by Hon'ble Supreme Court in *B.K. Narayan Pillai vs. Parameshwaram Pillai & Anr.* (2000) 1 SCC 712.

It was argued that in view of the above, the Office Order, so far it relates to imposing absolute restrictions on amending the statement of use on record, should be recalled.

I have heard the submissions of the advocates on behalf of the IPAA and perused the records placed before me.

An application for the registration of a trademark is filed under Section 18 of the Trade Marks Act 1999 which states as follows-

"18. Application for registration

(1) *Any person claiming to be the proprietor of a trade mark used or purposed 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."

Under this provision, the application for registration of a trademark is filed by a person who *claims to be proprietor of the trademark*. The Proprietorship over a trademark can be claimed only by *use of the trademark* or by *intention to use the trademark*. In view of this, the statement of the applicant regarding use of the trademark being applied for registration is the most vital element of the application.

Further, as per the scheme of the Trade Marks legislation, all the applications made for registration of the trademark are examined by the Trade Marks Registry office to ensure that the application satisfies the parameters of the registration mentioned in the Trade Marks Act. In case any objection to acceptance of the application for registration of the trademark is found, an examination report mentioning such objections therein, is communicated to the applicant or his authorized agent concerned. If the application is accepted for registration, the same is published in the Trade Marks Journal whereupon any person may file opposition to the registration of the trademark mentioned in the application.

One of the major objections for acceptance of the application for the registration of a trademark, as mentioned in Section 9 of the Trade Marks Act, 1999, is that the trademark applied for registration is not capable of distinguishing the goods or services of one person from those of others, or it is descriptive of the goods or services, or it has become customary in respect of such goods or services. This Section also provides that even such a trademark shall not be refused registration, if, before the date of the application, the trademark has acquired a distinctive character as a result of use made of it.

Another major objection for acceptance of the application for the registration of a trademark, as mentioned in Section 11 of the Trade Marks Act, 1999, is that the trademark applied for registration is identical with or similar to earlier trademarks on records in respect of same or similar description of goods or services. The Section 12 of the Trade Marks Act 1999,

however, provides that-

"In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose."

In the past, it has been found that after receiving the office objections for acceptance of the application for the registration of a trademark, applicants filed a request for amendment in the trademark application seeking to incorporate the prior date of use of the trademark. Examination of trademark applications is ordinarily done after 6 months or more from the date of submissions of the applications. In such circumstances, an application seeking to incorporate the prior date of use of the trademark in the original application after receiving office objections can hardly be taken as an application to rectify a clerical error.

It was also been observed that many unscrupulous traders concoct the statement of use of the trademark and seek amendment as an afterthought by way of a request on form TM-16 with the ulterior motive of treading upon the bonafide use of trademarks by rivals in trade.

The user statement plays such a vital role that even the proprietor of an un-registered trademark claims advantage over the registered trademark. Section 34 provides for protecting the vested rights, so that even the proprietor of an un-registered trade mark or a registered user cannot interfere with the use of any identical or similar mark by any other person if that person has been using the mark from an earlier date. The benefit of Section 34 is available to a defendant to prevent a proprietor or registered user of a registered trade mark from interfering with or restraining the continuous use of an identical or merely resembling mark by the defendant. As such, the user statement in trade mark applications has immense importance in determination of the validity of a trademark.

Further, the functions of the Registrar of Trade Marks are performed by various officers of the Trade Marks Registry, therefore it is essential to have harmony in the decisions of officers in similar circumstances and office orders and guidelines are issued to ensure the same.

Accordingly, in order to stop the misuse of the provisions of Section 22, a clause 3 was inserted in Office Order No.16 pertaining to Pre-Registration Amendment Section (PRAS).

Regarding the case laws submitted on behalf of IPAA to the effect that the authorities should be liberal in allowing applications for amendments, it deserves to be mentioned that the statement as to use of the mark is the most vital information of the application for registration of a trademark and the amendment as to this may re-define the rights of the applicant and possibly may affect the rights of other entrepreneurs who would have bona fide adopted the same or similar trademark. Accordingly, the facts of the cited judgments are not relevant for amendments in the applications for registration of trademark seeking to change the statement of use of the trademark.

The Hon'ble Intellectual Property Appellate Board, in *Titan Industries Limited V Registrar of Trade Marks 2007(34) PTC 346*, has set aside the order of Assistant Registrar allowing an application to amend the statement of use of the trademark. The Hon'ble Board, in the said case, has held that


"We are of the opinion that any amendment which will materially change the nature of the application should not be allowed..."

"Taking the principles of law as guidelines and the facts of the case into consideration, we observe that by allowing the application for amendment of the date of user will definitely prejudice the rights of the appellant, as the very nature of the application gets substantially changed. We, therefore, hold that the application for amendment of the date of user which alters the nature of the application cannot be allowed."

The Trade Mark law is a merchandise law and a trader always has to be alert in the market. The trader and / or his agent is expected to ensure due diligence at the time of filing of the trade mark application. It is inconceivable that a trader would not know about the period since when his trademark has

been used at the time of filing of application and he would 'hit' upon evidence of the same at a later stage. In rare cases, he has the option of filing a fresh application. Since the change in statement of use at a later stage would adversely affect the bonafide rights of continuous use of the trademark by rivals in trade, the balance of convenience lies in the trader filing a fresh application if he wishes to claim a change in the statement of use.

In view of the above facts, the representation dated 11.02.2013 cannot be accepted and the same is disposed of accordingly.



23/7/2014

(Chaitanya Prasad)

Controller General of Patents, Designs and Trade Marks

New Delhi, dated 23rd July 2014