

Comments on Draft Trade Marks (1st Amendment) Rules, 2024

To

The Secretary

Department for Promotion of Industry and Internal Trade Ministry of Commerce and Industry, Government of India Vanijya Bhawan, NewDelhi- 110001

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Subject: Comments on the Draft Trademark (1st Amendment) Rules, 2024

This submission presents comments on the “Draft Trademark (1st Amendment) Rules, 2024, (“Draft Rules” or “Proposed Rules”)¹ released by the Department for Promotion of Industry and Internal Trade, (DPIIT) Ministry of Commerce and Industry.

The submission is divided into three parts- General Comments, Substantive Comments, and Procedural & Clarificatory Comments on the Draft Rules.

This submission is made by: Praharsh Gour, Pranav Aggarwal, Swaraj Paul Barooah and Reva Satish Makhija.² Views expressed here represent those of the authors’ alone. We are thankful for the opportunity to put forth our views.

This submission was made on 9th February, 2024 as per deadline prescribed for comments i.e. thirty days from the publication of the Draft Rules in the Gazette of India (January 10, 2024).

¹ <[https://egazette.gov.in/\(S\(gpyrvmkx5ygcrqsux4v1o221\)\)/ViewPDF.aspx](https://egazette.gov.in/(S(gpyrvmkx5ygcrqsux4v1o221))/ViewPDF.aspx)>

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Part 1: General Comments

1.1 Inclusion and Participation

The Draft Trademark (1st Amendment) Rules, 2024 were published on January 10, 2024, with an open call for comments on the Proposed Rules within the next 30 days from the date of its publication in the Gazette of India, i.e., February 09, 2024. While the call for comments on the Proposed Rules is appreciated, the 30-day period given to the stakeholders to submit their responses is very limited to appropriately engage with this process. For instance, the Ministry of Labour and Employment fixed 45 days for seeking objections and suggestions in the Draft Central Rules on The Code on Wages, 2019,³ Draft Central Rules on The Occupational Safety, Health and Working Conditions Code, 2020,⁴ and Draft Central Rules on The Code on Social Security, 2020.⁵ Similarly, for the Draft of the Drugs and Magic Remedies (Objectionable Advertisements) (Amendment) Bill, 2020, the Ministry of Health and Family Welfare gave 45 days for suggestions/comments/objections.⁶ In several foreign jurisdictions, the practice is similar, providing longer durations for public stakeholders to provide their comments on the legislation.⁷ To realise the democratic principles of meaningful inclusion and participation, it is vital that a reasonable chance be given to the public to Deliberate, Respond and Interact with the legislative process. This has not been adequately provided in the instant case.

Recommendation:

³ 'Occupational Safety, Health and Working Conditions Code, 2020,' Ministry of Labour and Employment, Government of India <https://labour.gov.in/sites/default/files/gazette_notification.pdf>

⁴ 'Occupational Safety, Health and Working Conditions Code, 2020,' Ministry of Labour and Employment, Government of India <<https://vgnli.gov.in/sites/default/files/Draft%20central%20rules%20on%20Code%20on%20OSH-2020.pdf>>

⁵ Code on Social Security, 2020,' Ministry of Labour and Employment, Government of India <<https://vgnli.gov.in/sites/default/files/Draft%20central%20rules%20on%20Code%20on%20Social%20Securit-2021.pdf>>

⁶ Draft of the Drugs and Magic Remedies (Objectionable Advertisements) (Amendment) Bill, 2020, Ministry of Health and Family Welfare, Government of India <<https://main.mohfw.gov.in/sites/default/files/Draft%20of%20the%20Drugs%20and%20Magic%20Remedies.pdf>>

⁷ In the UK for example, under the Code of Practice on consultation, consultations should normally last for at least 12 weeks with consideration given to longer timescales where feasible and sensible. <<https://assets.publishing.service.gov.uk/media/5a79b500ed915d07d35b781b/code-of-practice.pdf>>.

It is recommended that an extension of 2-4 weeks be given to increase the ability for more stakeholders to participate in this process, and further enrich the outcome of the same.

1.2 Accountability, Transparency and Openness Related Concerns

It is noted that there have been no public calls for stakeholder consultations for the drafting of these Proposed Rules. There is also no stated information as to who has drafted the current Proposed Rules. This lack of information is concerning as this undermines the well expounded democratic principles of due process, transparency and openness. For example, the Supreme Court has held in *Global Energy Ltd. v. Central Electricity Regulatory Commission* (SCC p. 589, para 71):

“ All law-making, be it in the context of delegated legislation or primary legislation, has to conform to the fundamental tenets of transparency and openness on one hand and responsiveness and accountability on the other. These are fundamental tenets flowing from due process requirement under Article 21, equal protection clause embodied in Article 14 and fundamental freedoms clause ingrained under Article 19. A modern deliberative democracy cannot function without these attributes.”

We have seen successful examples of implementation of these democratic principles in action vis-a-vis the consultation process adopted by the Telecom Regulatory Authority of India.⁸ Further, the importance of diverse and inclusive stakeholder consultations is well recognised in the international context as well.⁹

⁸ ‘Consultation’, Telecom Regulatory Authority of India, access at [.<https://www.trai.gov.in/release-publication/consultation>](https://www.trai.gov.in/release-publication/consultation).

⁹ Among international bodies, the Cybercrime Convention Committee (T-CY) of the Council of Europe invited stakeholders to submit written or participate in online meetings regarding the draft 2nd Additional Protocol to the Budapest Convention (access at: [.<https://www.coe.int/en/web/cybercrime/protocol-consultations>](https://www.coe.int/en/web/cybercrime/protocol-consultations)). Among developed countries, stakeholder consultation is followed strictly, as in the United States, where it involves a consultation process when negotiating new trade agreements and making legislative changes (access at: [.<https://ustr.gov/about-us/policy-offices/press-office/blog/2014/February/a-note-on-stakeholder-consultation>](https://ustr.gov/about-us/policy-offices/press-office/blog/2014/February/a-note-on-stakeholder-consultation)). The FDA in the US engaged in several Patient and Consumer Stakeholder Discussions on the Medical Device User Fee Amendments 2022 Reauthorization (access at: [.<https://www.fda.gov/industry/medical-device-user-fee-amendments-mdufa/medical-device-user-fee-amendments-2022-mdufa-y>](https://www.fda.gov/industry/medical-device-user-fee-amendments-mdufa/medical-device-user-fee-amendments-2022-mdufa-y)). The European Directorate for the Quality of Medicines & Healthcare (EDQM) sought the opinions of stakeholders on its Draft Guidelines for Medication Review in 2022 (access at: [.<https://www.edqm.eu/en/-/stakeholder-consultation-draft-guidelines-for-medication-review>](https://www.edqm.eu/en/-/stakeholder-consultation-draft-guidelines-for-medication-review)). The Swedish Government conducted stakeholder consultations for its Pandemic Law in 2020 (access at:

Comparing this with the practice at home, no public consultation circular for any input from other research bodies and public stakeholders seems to have been released.

Recommendation:

We recommend that the following information be shared with the Indian public via official notifications:

1. The authors of the draft rules.
2. Whether any stakeholder consultations were done, with or without a public notice for the same. If a public notice was issued for the consultation, then it is suggested that such notices be publicised more notably.
3. If such stakeholder consultations were done, then a copy of the minutes from those meetings, or a disclaimer that such minutes were not maintained.

Part 2: Substantive Comments

2.1 Mandate Public Hearings by the Authorities and Publication of the Orders passed by the Authorities for Public Access

Though the Proposed Rules mandate hearing of the parties, they lack a provision mandating that these hearings shall be public. Holding such hearings would legitimise the integrity of the authorities and will further transparency in these processes. It is advised that to maintain transparency and accountability with

<<https://www.loc.gov/item/global-legal-monitor/2020-12-11/sweden-government-sends-pandemic-law-forstakeholder-consultation/>>). The Australian government sought feedback on an exposure draft of the Online Safety Bill to improve Australia's online safety legislation (access at: <<https://www.infrastructure.gov.au/have-your-say/consultation-bill-new-online-safety-act>>). Even in developing countries, such as Brazil, the government has sought stakeholder opinions on the draft Normative Instruction (IN) for new transfer pricing rules (access at: <<https://kpmg.com/us/en/home/insights/2023/07/tnf-brazil-public-consultation-on-new-transfer-pricing-rules.html>>) and the Brazilian Internet Bill of Rights (access at: <<https://www.oecd-ilibrary.org/sites/3f9009d4-en/1/3/6/index.html?itemId=%2Fcontent%2Fpublication%2F>

regard to findings of such proceedings, these orders should be available in the public domain as well.

Recommendations:

- 1) The Proposed Rules should specify that the hearings by the Authorities under the Proposed Rule(s) 105D and 105H shall be public; and
- 2) Copies of the orders passed by the Adjudicating Officers and Appellate Authority should be published preferably on the **IP India website**¹⁰ for public access to improve transparency and accountability in such proceedings.

2.2. Limited Scope of Offences Falling under the Proposed Mechanism:

The Adjudicating Officer is being appointed by virtue of the newly inserted Section 112A of the Trade Marks Act. The substantive provision empowers the Registrar to appoint any officer to conduct an inquiry and impose penalties under the provisions of the Act. As per the Proposed Rule 105A, the role of the Adjudicating Officer shall be limited to only the offences committed by a “person” falling under Section 107. However, this may exclude offences committed by a “Company”, which are listed under Section 114¹¹. The provision starts with “*If the person committing an offence under this Act is a company, ...*” and therefore, explains how the liability shall be determined in a case where a company is accused of committing an offence under any provision of Chapter XII of the Act. Thus, the provision is explanatory in nature which would be read along with the main provision prescribing the punishment for an offence.

For instance, Section 107 imposes a punishment against a person for falsely representing a trademark as registered. However, chances are that those accused may not always be an individual and rather would be a company. Thus, for such cases, the complaint would ideally be filed under Section 107 read with Section 114.

¹⁰ <<https://www.ipindia.gov.in/>>

¹¹ Offences by companies, Section 114, The Trade Marks Act, 1999, <https://www.indiacode.nic.in/show-data?actid=AC_CEN_11_60_00004_199947_1517807323972§ionId=16906§ionno=114&orderno=122>.

Recommendation: The Proposed provision along with the Proposed forms be amended to include adjudication over offences when committed by a company under Section 114 for certainty of the adjudicatory proceedings.

2.3 Onus on the Parties to keep the Other Relevant Parties Informed about the Necessary Submissions

The Proposed Rule 105G (2) requires the “Appellant” to convey any kind of written submission or application to the “other party”. However, it is unclear who this “other party” is. Will it only be the Adjudicating Officer passing the impugned order? Or will it also include the Appellant’s original adversary before the Adjudicating Officer? Furthermore, by imposing an obligation only on the “Appellant”, the Proposed Rule makes this an Appellant-specific provision, however, all the relevant parties must be informed about the filings made by the other parties.

Recommendation: The Proposed Rule 105G (2) shall be amended to replace “Appellant” with “a party”. It is also recommended that the Proposed Rules be amended to specify who the “Other Party” shall be.

2.4 Incorrect use of “Summary”

The Proposed Rule 105D provides for Summary Proceedings when a case is made out. Generally, the term “Summary” for proceeding connotes a situation where the court is convinced that the parties do not have succeeding claims and there is no compelling reason to not dispose of the matter after following all the otherwise applicable procedures. However, the Proposed Rules prescribe a detailed separate procedure to ensure that the competing parties are heard and are allowed to file relevant evidence under the Proposed Form TM-D. In light thereof, though the Proposed Rules seemingly aim to “expeditiously” dispose of the complaints, the doing to “summarily” may connote a different meaning as understood from the procedural laws. Therefore, the use of the term “summary proceedings” in the Proposed Rule seems like a misnomer

Recommendation: It is recommended that the title of the Proposed Rule be amended to “Proceedings when a case is made out”. In case the purpose behind

using the word “Summary” in the Proposed Rule is merely to connote expeditious adjudication of a complaint, then the Proposed Rules should be modified to clarify this.

2.5 Clarity on the Qualifications of Adjudicating Officers

The Proposed Rule 105B of the draft rules provides the mechanism for the appointment of an Adjudicating Officer. Under the said rule, the Registrar shall give authorization to an officer as appointed under Section 3 of the Trade Marks Act¹² to act as an Adjudicating Officer. However, no specific qualification for the officer has been provided in the said rule.

Recommendation: The Proposed Rule should mention the particular designation or qualification for the Adjudicating Officer. Preferably a Deputy or an Assistant Registrar should be appointed as the Adjudicating Officer.

2.6 Appointment and Qualifications of Appellate Authority

Unlike the appointment of the Adjudicating Officer by the Registrar under Section 112A¹³ r/w the Proposed Rule 105B, the appointment of the Appellate Authority is done by the “Central Government” under Section 112B (1)¹⁴. However, for the purpose of appointment of the Appellate Authority, it is unclear who shall be regarded as the “Central Government”. While Section 3 clearly states that the Registrar is appointing authority, no specific office has been referred to here to fill in the shoes of “Central Government” for the appointment of the Appellate Authority.

Furthermore, the Proposed Rule 105E provides that the Appellate Authority shall be an officer at least one rank above the Adjudicating Officer thus, making the Qualification of the Appellate Authority relative to the Adjudicating Officer.

¹² Appointment of Registrar and other officers, Section 3, The Trade Marks Act, 1999, <https://www.indiacode.nic.in/show-data?actid=AC_CEN_11_60_00004_199947_1517807323972§ionid=16788§ionno=3&orderno=3>

¹³ Adjudication of penalties, Section 112A, The Trade Marks Act, 1999, <<https://egazette.gov.in/WriteReadData/2023/248047.pdf>>

¹⁴ Appeal, Section 112B, The Trade Marks Act, 1999, <<https://egazette.gov.in/WriteReadData/2023/248047.pdf>>

However, for certainty, the last rank of officer eligible to be appointed as the Appellate Authority should be specified.

Recommendations:

1) The Proposed Rule must clearly state the authorising authority for the Appellate Authority. If it is the Central Government, then the rule must define which authority should be considered as the “Central Government” to avoid any possible confusion.

2) The Proposed Rule should mention the particular designation or qualification for the Appellate Authority, preferably, deputing an officer not below the rank of a Joint Registrar as the Appellate Authority.

2.7 Ambiguity over the definition of ‘Complainants’

The Proposed Rule 105A provides that ‘any person’ can file a complaint, using the Proposed Form TM-D, against any contravention or default committed by any person. Enabling “any person” to file a complaint under the Proposed Rules will be fruitful for the overall trademark regime of India. It will enable the authorities (specifically the trademarks registry) to keep a check on defaulters under the Act efficiently, which may otherwise go unnoticed. Furthermore, allowing “any person” to file a complaint under the Proposed Rules will ensure that public participation is not limited only to trademark prosecution but rather encourages public-spirited individuals to assist the Registry in other areas like curbing the use of false descriptions in products etc.

But the Form TM-D, under which a complaint can be filed, specifies “Complainant” under the 1st particular (See below). The term Complainant has been defined under Proposed Rule 2(aa) as “an aggrieved person who makes a complaint before the Adjudicating Officer”.

“FORM TM-D
THE TRADE MARKS ACT, 1999
&
THE TRADE MARKS RULES, 2017
COMPLAINT FOR CONTRAVENTION OR DEFAULT OF SECTION 105(1)
[See rule 105A]

1. Particulars of Complainant:- a. Name: b. Address for service: c. Contact no.: d. Email (for service):	
2. Particulars of Complaint:- a. Date, time, and instance of commission of the alleged contravention or default: b. Statement of contravention or default setting out all relevant material particulars: c. Evidence in support of the statement:	
I/We....., the Complainant herein declare that the facts stated herein are correct to the best of my/our knowledge, information and belief.	
3. Signature of the Complainant:	Signature
4. Name of the natural person who has signed:	(.....)
	To, The Registrar of Trade Marks, The Trade marks Office, at

Note.- Strike out whichever is not applicable.”

(Form TM -D as taken from the Proposed Rules on page 13)

The condition of such a person to be “aggrieved” has not been mentioned in the Proposed Rule 105(A) and thus, the definition clause and the operating clause of the Proposed Rules conflict with each other. As per the Black’s law dictionary, “an aggrieved” is a person or entity having legal rights that are adversely affected or having been harmed by an infringement of legal rights. However, for a complainant to file a complaint under the present mechanism they need not necessarily be “aggrieved” per se.

Recommendation: In order to encourage public participation and considering its perks in building a robust trademark regime, it is recommended that the definition of the term ‘complainant’ under the Proposed Rule 2(aa) should be amended to not just include an “aggrieved” person but “any person” as mentioned in the Proposed Rule 105A(1). A similar mechanism allowing “any person” to file a pre-grant opposition has been prescribed under Section 21(1) of the Trade Marks Act¹⁵. Such flexibility will empower public-spirited individuals to complain against any default committed in contravention of aforementioned provisions of the Trade Marks Act.

2.8 Ambiguity on the procedure to hold an inquiry by the Adjudicating Officer

The procedure described under Proposed Rule 105D (c) (1) lacks clarity in several aspects.

First, it mandates the alleged violator to “show cause”. However, it hasn't specified what should the alleged violator show cause to. Furthermore, this seems like an additional obligation on the violator who will anyway be contesting their case via filing a written submission, setting out the facts along with the necessary evidence.

Second, the Proposed Rule states that no inquiry can be made except upon receiving a complaint in writing by “any officer authorised by a general or special order”. However, this is contradictory to the Proposed Rule 2(aa)¹⁶ defining a complainant as “an aggrieved person” and thus restricts this definition to mean an officer authorised by general or special order. Furthermore, it is pertinent to note that Section 107 of the Trade Marks Act prescribes punishment for falsely representing a mark as registered and states who shall be held liable for the same. However, it does not restrict the scope of a person who can file a complaint against such violations. Thus, the Proposed Rule contradicts the provision of the substantive law as well.

Recommendations:

¹⁵ Opposition to registration, Section 21(1), The Trade Marks Act, 1999, <https://www.indiacode.nic.in/show-data?actid=AC_CEN_11_60_00004_199947_1517807323972§ionId=16806§ionno=21&orderno=21>

¹⁶ See comment no. 3.10 under “Procedural and Clarificatory Comments” on page 18.

- 1) The mandate for “show cause” notice should be omitted to avoid redundant procedural barriers.
- 2) The Proposed Rule should not restrict the initiation of an inquiry just on the complaint of an authorised officer, rather should keep it open to ‘any person’ as under Proposed Rule 105A.

2.9 Authority to Grant Compensation

The Proposed Rule 105D(4) prescribes that “compensation” may be awarded by the Adjudicating Officer. Similarly, the Proposed Rule 105D(c)(2) prescribes the mode for determining the quantum of “compensation” under the Act. However, it must be noted that the Proposed Rules 105D(4) has not stated where the Officer is deriving the authority to award compensation. Furthermore, regarding the mechanism under the Proposed Rule 105D(c)(2) it must be noted that the Trademarks Act, under provisions of Chapter XII, only mandates the imposition of a penalty or imprisonment of the alleged violators. Therefore, the Proposed Rule must specify the justification behind the power of the Adjudicating Officer to award compensation. Otherwise, the Proposed Rules may contravene the doctrine of ultra vires which prohibits supersession of a substantive provision by a delegated legislation. On this, the Supreme Court in *Kerala State Electricity Board v. Thomas Joseph* clarified that :-

“Ultra vires may arise in several ways; there may be simple excess of power over what is conferred by the parent Act; delegated legislation may be inconsistent with the provisions of the parent Act or statute law or the general law; there may be noncompliance with the procedural requirement as laid down in the parent Act. It is the function of the courts to keep all authorities within the confines of the law by supplying the doctrine of ultra vires.”

Recommendation: While the proposal to award compensation is appreciated, it is recommended that the Proposed Rules specify the provision where it is deriving the power to award compensation. Alternatively, the Proposed Rules should be amended removing the provisions awarding compensation.

2.10 Specifying the desired principles of Natural Justice under the Proposed Rules 105H

The Proposed Rule 105H provides that the Appellate Authority shall give an opportunity to the Appellant to be heard as per the principles of natural justice. This is a well appreciated clause to be provided in the Trademark rules. However, the term ‘Natural Justice’ has been loosely used and can have varied meanings and interpretations. Therefore, it provides unnecessary discretion to the Appellate Authority to construe the term ‘Natural Justice’ as it feels suitable.

Recommendation: The Proposed Rule 105H should specify the particular principles of Natural Justice that should be included in the Trade Mark Rules so that no ambiguity over its implementation will be left.¹⁷

2.11 Inclusion of Subject Matter in the Proposed Rule 105D(2) for adjudging the quantum of compensation

The Proposed Rule 105D(2) provides the three factors that the Adjudicating officer has to take into account while adjudging the quantum of compensation. However, the mentioned factors do not take into account the subject matter-specific considerations, for eg. the value of the trade mark in question, that might affect the quantum of the compensation being awarded.¹⁸

Recommendation: The Proposed Rule 105D(2) shall be amended to include additional criteria regarding subject matter-specific considerations like the value of the trademark in question, to calculate the amount of compensation.

Part 3: Procedural and Clarificatory Comments

3.1. Ambiguity in Timelines

¹⁷The critique was noted from a blogpost by Pragya Singh and Lakshita Handa, Research Fellows with the Legal Design and Regulation team at Vidhi Centre for Legal Policy. Pragya Singh and Lakshita Handa “A SARAL Analysis of the Proposed Trade Marks (1st Amendment) Rules, 2024.” <<https://spicyip.com/2024/02/a-saral-analysis-of-the-proposed-trade-marks-1st-amendment-rules-2024.html>>

¹⁸ See Pragya Singh and Lakshita Handa “A SARAL Analysis of the Proposed Trade Marks (1st Amendment) Rules, 2024.” <<https://spicyip.com/2024/02/a-saral-analysis-of-the-proposed-trade-marks-1st-amendment-rules-2024.html>>

Some of the deadlines to make submissions before the authorities under the Proposed Rules are unclear. We are listing the issues with these deadlines along with our recommendations below:-

3.1.1. Clarity regarding the time limit to make a prima facie finding by the Adjudicating Officer under Proposed Rule 105C (1)

The Proposed Rule states that ‘the Adjudicating Officer shall quash and dismiss the complaint summarily and pass a speaking order within a period of one month’. However, the date from which the one month has to be ascertained is not clear.

Recommendation: The Proposed Rule should be amended to clarify that the speaking order shall be passed within one month from the date of allocation of the complaint to the Adjudicating Officer (under the Proposed Rule 105B(2)) or within one month from the date of filing of the complaint by a complainant.

3.1.2 .Clarity on the date of commencement of proceedings under Proposed Rule 105D

The Proposed Rule provides for the procedure of proceedings when a prima facie case on maintainability is made out. It states that proceedings under the Proposed Rule shall commence within one month. However, the date from which the one-month period is to be calculated has not been specified.

Recommendation: The Proposed Rule should be amended to clarify that the proceedings will commence within one month from the date of allocation of the complaint to the Adjudicating Officer (under the Proposed Rule 105B(2)) or within one month from the date of filing of the complaint by a complainant or one month from the date of prima facie finding on the maintainability of the complaint by the Adjudicating Officer.

3.1.3. Clarity on the dates of serving the notice and complaint to the alleged violator

The Proposed Rule 105D(a) states that the alleged violator shall be served with a copy of the notice within one month from the date of the alleged contravention. Further, the Proposed Rule states that a copy of the complaint shall be served to the

alleged violator within one week. The two deadlines for issuing the notice and the copy of the complaint are extremely ambiguous. Furthermore, the notice is required to be served within one month from the date of the alleged contravention, but often a complainant may get to know about the contravention after one month from the date of commission in offenses under Section 105 of the Trade Marks Act. Additionally, these two deadlines may also disrupt the right of the alleged violator to file the written statement under Proposed Rules 105D(b).

Recommendation: For clarity and uniformity, the Proposed amendment should be amended to state that the complaint shall be filed along with the notice of the complaint within one month from the date of prima facie finding on the maintainability of the complaint by the Adjudicating Officer.

3.1.4. Inadequate time-limit to file the Written Statement

The time limit Proposed to make the written submission against a complaint, under the Proposed Rule 105D(b), is 15 days from the date of issuance of the “notice”. However, the same is extremely inadequate, especially when as per the Proposed Rule 105D(a) the complaint will be served separately by the Adjudicating Officer.

Recommendation: The Proposed Rule be amended to “15 days from the receipt of the complaint” instead of “15 days from the issuance of the notice”. Such a mechanism will also take into consideration the transit time in case the documents are shared via post and will enable the responding party to consider the allegations made in the complaint against it.

3.2. Amending Typographical Error regarding extension by Adjudicating Officer

The proviso of the Proposed Rule 105G (1) states that the ‘Appellant’ has to satisfy the Appellate authority for extending the time limit beyond 21 days for filing their reply. However, the said rule prescribes the procedure wherein the ‘opposite party’ can file their reply to the appeal. The method to seek an extension as provided under the proviso, thus, should be limited to the “opposite party” satisfying the “Appellate Authority” about the causes for the delay and not the “Appellant”.

Recommendation: The term ‘Appellant’ in the proviso to the Proposed Rule 105G (1) shall be replaced with ‘opposite party’.

3.3. Define “Endorsement” under the Proposed Rule 105F(1)

The Proposed Rule 105F(1) states that “the Appellate Authority shall endorse the date on such appeal and shall sign such endorsement”. However, the term ‘endorsement’ has not been defined anywhere in the Proposed Rules. The term creates ambiguity when read with the following Proposed Rule 105F(2) which prescribes the obligation of the Appellate Authority to “register” the appeal after scrutinising it. Thus, clarifying what endorsement means would also help in differentiating it from “registering” the appeal.

Recommendation: The Proposed Rule 105F (1) should define/ explain what “endorsement” shall mean. Alternatively, the Proposed sub-Rule can also be deleted, effectively making the Proposed Rule 105F(2) the only clause for registration of an appeal.

3.4. Clarity on Speaking order passed under the Proposed Rule 105D (2)(d)(1)

The Proposed Rule 105D states:

“The Adjudicating officer may, for reasons to be recorded in writing, extend the further period not exceeding fifteen days, if the said person satisfies the Adjudicating officer that it has sufficient cause for not responding to the notice within the stipulated period, only upon the payment of costs under Section 35B of Code of Civil Procedure, 1908.¹⁹ The Adjudicating Officer shall hear the parties and pass a speaking order thereon that pertains to the extension of time period and states that the Adjudicating Officer shall hear the parties and pass a speaking order.”

¹⁹ Costs for causing delay, Section 35B, Code of Civil Procedure, 1908, <https://www.indiacode.nic.in/show-data?actid=AC_CEN_3_20_00051_190805_1523340333624§ionId=33371§ionno=35B&orderno=38>.

In the Proposed Rule, however, it is not clear if this speaking order is only with reference to the request for an extension or generally for the procedure under the Proposed Rule 105D.

Recommendation: Clarity should be provided as to whether the speaking order passed under the Proposed Rule 105D(2)(d)(1) is with reference to the request for an extension or generally for the entire procedure under the Proposed Rule.

3.5. Clarity on the mode of service of Notice and Written Submission

The Proposed Rule 105D (a) states that on the ground of exceptional and extraordinary circumstances, the complaint shall be sent by registered post. However, whether notice and written submission can be sent through post under such exceptional and exceptional circumstances has not been clearly laid down in the Proposed rule.

Recommendation: The mode of service should be clearly specified. Preferably, it should be stated that the notice and the written submission shall be served via post only in extraordinary situations.

3.6. Opportunity to be heard before a prima facie finding on maintainability is made by the Adjudicating Officer under the Proposed Rule 105C(1)

The Proposed Rule does not specify whether the complainant will be provided with an opportunity to be heard before the prima facie finding on the complaint's maintainability is made by the Adjudicating Officer. Granting such an opportunity is essential as it will assist the Adjudicating Officer in making a well- informed call on the maintainability and will enable the complainant to address/ clarify concerns of the Adjudicating Officer, which could have otherwise led to rejection of the complaint.

Recommendation: An opportunity to be heard shall be granted to a complainant before a finding is passed by the Adjudicating Officer on its maintainability.

3.7. Clarification in the Proposed Form TM-OPP

The Proposed Rule 105D (b) proposes that an alleged violator can file their statement with relevant facts and evidence against the complaint under the Proposed Form TM-OPP. However, there are no columns or sections in the Proposed Form TM-OPP (such as present in the Proposed Form TM-D) wherein such a statement/ submission can be made.

Recommendation: The Proposed TM-OPP should have a section/ entry to accommodate “relevant facts” and “evidence in support of opposition”.

3.8. Clarity on the “Certified Copy”

The Proposed Rule 105E(2) states that the appeal shall be accompanied by a certified copy of the impugned order. However, the method of deriving the certified copy has not been mentioned under the Proposed Rule.

Recommendation: The Proposed Rule 105E(2) should be amended to state the method of deriving the certified copy of the impugned order passed by the Adjudicating Officer. For reference, the Proposed Rule can refer to Section 76 of the Indian Evidence Act or specify a similar mechanism.

3.9. Clarity on the allegation in the notice to the alleged violator under the Proposed Rule 105D (a)

The Proposed Rule 105D (a) states that the Adjudicating officer shall serve a copy of the notice to the alleged violator within a period of thirty days from the date of commission of alleged contravention. However, no provision has been made for informing the alleged violator about the allegation against him/her.

Recommendation: The Proposed Rule should also specify the contents of the notice that will be served to the alleged violator, clearly stating the allegations levelled against them.

3.10. Clarity on Rule number mentioned in the Definition Section of the Proposed Rules

Rule 2 of the Trade Mark Rules provides for the definition of necessary terms. The Proposed Rules include the definitions of the terms ‘Adjudicating officer’ and ‘Complaint’ under Rule 2. However, the Proposed Rule allots the same sub Rule (aa) to both the aforementioned terms. Thus, it causes grave confusion over the exact Rule no.s of the said terms.

Recommendation: The terms ‘Adjudicating officer’ and ‘Complaint’ should be allotted distinct Rule no.s. Preferably, the term ‘Complaint’ can be allotted Rule no. 2 (aae) to avoid the aforementioned confusion.