Draft Manual of Trade Marks

Practice & Procedure

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

The Draft Manual of Trade Marks Practice and Procedure is 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 Draft 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 High Court .

For greater understanding and transparency, the Draft 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 Draft 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. It is expected that the Draft 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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Controller General of Patents, Designs & Trade Marks

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Chapter 01: Filing of a Document in Trade Marks Registry

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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 into 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 A, 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 2017 (hereinafter referred to as "the Rules").

Sr. No		General Description	Relevant provision of the Act & Rules
1.1		**How a document/s can be filed**	
	General Requirement	A document may be filed by a person, or by his duly authorised agent, at the appropriate office of the Trade Marks Registry as defined in Rule 4 of the Trade Marks Rules, 2017,which includes the Head Office (Mumbai) and the branch offices (Ahmedabad, Chennai, Delhi, and Kolkata) of the registry provided that the Registrar may, by notification in the Journal, permit the filing of certain forms or documents, other than the application for the registration of a trademark in any other office of the Trade Marks Registry. 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 place of business of the applicant in India is situated. Detailed provisions about the appropriate office for various categories of	Section 18, Rules 4, 8 & 14

		applicants are provided in Rule 4. 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. The communication may be sent to the Registrar through email as well as an email ID that is provided for communication in Examination Reports. 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. Electronic filing of Non fee bearing forms/documents can be done at all hours (24x7). In case of fee bearing documents/forms, the efiling is available.	
1.2		**Filing of documents -**	
1.2.1	**Requirement from the applicant**	**Requirements as to form** The requirements in respect of documents as specified in the Rules are set out below: 1. Documents must be in English or Hindi 2. Documents must be typewritten in legible characters with deep permanent ink upon strong A4 or legal size on one side only, and shall have on the left hand side a margin of not less than four centimeters. 3. The signature of the persons signing a document and the date of signature must be placed immediately at the end of the document. 4. The name of the person signing a document must be legibly written in English or Hindi in capital letters beside	**Rules 8, 12, 13**

		the signature of that person. 5. An alteration made in a document before it is filed at the Trade Marks Registry should be initiated in the margin by the person signing the document. 6. In case of online filing of the document, the expression 'Signing' includes digital signature	
1.2.2	**Requirement from the applicant**	**Requirements as to content** Applications, notices and some requests filed at the Trade Marks Registry are required to be in a prescribed form. ● The application, notice or request should generally include the following details, depending upon the nature of the document: 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	**Rule 14**

		the person(s) making application, notice or request and the name of signatory. ● Date and place of filing Note: In case of online filing of the document, digital signature will be considered as signing of the document. Details about e-filing are given at	
1.3	**Concept**	**When last date of filing is a public holiday** If a document is due to be filed on a date that is a weekend or a public holiday, the due date is the next date on which the Registry is open.	
1.4		**Documents must be signed and dated**	
1.4.1	**Concept**	**Who can sign?** Any document required to be signed under the Act and the Rules shall be signed by the applicant or opponent or by a person duly authorised for the purpose. In case of online filing of the document, the expression 'Signing' includes digital signature. 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. 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. A document on behalf of a partnership firm shall be signed by at least one partner stating that he is	**Section 145, Rule 13**

		signing on behalf of the firm. 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.	
1.4.2		**Applicant should supply an address for service**	
1.4.2.1	**Requirement from the applicant**	Every applicant or opponent or any person concerned in any proceeding under the Act or rules shall furnish to the Registrar an address for service in India comprised of a postal address in India and a valid e-mail address and such address shall be treated as the address for service of such applicant or opponent or person provided that a trademark agent shall also be required to furnish a mobile number registered in India. Note-While filing a document, the applicant/ agent should provide an email address for electronic communication from the Registry.	**Section 143** **Rules 17**
1.4.2.2	**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)**
1.4.2.3	**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 of business in India at the date of making the application for registration but has subsequently ceased to have such place.	**Rule 17**

1.4.2.4	**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 –M or TM-P along with prescribed fee.	**Section 8(4), 22, 58, Rules 37, 96, 101**
1.4.2.5	**Office Action**	Any document that must be served on, or given or sent to a person by the Registry may be delivered by hand or sent through the post by a prepaid letter or may be submitted electronically in the manner as laid down by the Registrar. 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 14**
1.4.3	**Requirement from the applicant**	**Fees** All applications, notices and requests should be accompanied by the fees as prescribed in First Schedule of the Trade Marks Rules 2017. Fees can be paid either by way of DD or using the UPI mechanism through the BHIM mobile application. Online payment may be made through payment gateway provided in the official website i.e. ipindia.nic.in.	**Rule 10(3), 10(4) and 23(6)**
1.5		**Non-compliance of filing requirements** If a document received for filing at the Trade Marks Registry fails to comply with the Act or the Rules regarding the filing of documents: 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.	**Section 150** **Rule 10(2) , 11(2) 10(5)and**

		Non realization of Demand Draft for any technical reasons shall also be treated as appropriate fee not having been paid. 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.	
1.6		**Filing process**	
1.6.1	Office Action	Every document shall be received through the FRONT OFFICE module of the Trade Marks System (TMS).	
1.6.2	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.	
1.6.3	Office Action	The superintendent of the R&E section shall open the document on receipt through post. A fee bearing document shall be sent to the cash counter and the same will generate a fee receipt through the system. Acknowledgment shall be generated in case of non fee bearing documents.	
1.6.4	Office Action	The front office shall affix a stamp (with the signature of the official concerned) on all the documents received. The stamp should include the date on which the document is received, the amount of fee, if any, and indication of the office of the Registry at which the document is filed. The document so filed shall be given system generated receipts/acknowledgments which contains, as applicable, the name of the office, the receipt number, date and time, details of the person filing the document, TM forms filed, reference number, the person on whose behalf the document is filed, amount of fees paid and the mode of payment.	

1.6.5	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.	
1.6.6	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.	
1.6.7	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. The process for electronic communication should also be included in the aforesaid.	

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 a glimpse of formality requirements 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 under Sections 18(4) and 18(5) of the Trade Marks Act, 1999, the Registrar must determine whether the application has been filed in accordance with the provisions of the Trade Marks Act, 1999 (hereinafter referred to as "the Act") and the Trade Marks Rules, 2017 (hereinafter referred to as "the Rules").

Sr. No		**General Description**	**Relevant provision of the Act & Rules**

1.7		**<u>Filing of Trade Mark Application</u>**	
1.7.1	**Concept**	**Who can file a Trade Mark Application** 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. 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	**Sec. 18 (1)**
1.7.2	**Concept**	**Jointly owned trademark:** 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. 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.	**Section 24**
1.7.3	**Concept**	The Trade Mark being applied for registration may be: • 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, 2013 with a view to use thereof in relation to those goods and services by the company.	**Section 18(1) , 46(1) and Column 9 of form TM-A**

1.7.4	**Concept**	**Identification of proprietor before applying for a** **trademarks:** The person applying for registration of a trademark must be clearly identified as the proprietor.	**Section 18(1)**
1.8		**Details Required from the Applicant**	
1.8.1	Requirement from Applicant	**In case of Individual** The full 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.	**Rule 15**
1.8.2	Requirement from Applicant	**<u>In case of Joint owners</u>** 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.	**Rule 15**
1.8.3	Requirement from Applicant	**<u>In case of Partnership Firm</u>** The names of all the partners are essentially required to be mentioned in an application filed by a partnership firm. **<u>In case of Trust</u>** The names of all the Trustees are essentially required to be mentioned in an application filed by a Trust	**Rule 15**

1.8.4	Requirement from Applicant	**<u>In case of Companies</u>** The name under which a company is incorporated is required. A trading style or business name, if given, will be recorded separately. Abbreviations of the type of company are acceptable. Annex Al at the end of this Part contains a list of abbreviations of types of companies which are recognized as bodies corporate.	**Rule 15**
1.8.5	Requirement from Applicant	**<u>In case of Government Departments</u>** Where the applicant is a government department, the traditional form of the name of the applicant is "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)".	**Rule 15**
1.8.6	Requirement from Applicant	**<u>In case of statutory organizations/ public sector undertakings:</u>** Reference should be made to the statute under which such organization/ undertaking is discharging its 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.	**Rule 15**
1.8.7	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.	**Rule 15**
1.8.8	Requirement from Applicant	**<u>Statement of Use:</u>** A statement of use showing the date since when the	**Rule 25**

		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. In case of User claim, an Affidavit of Use along with supporting documents should be submitted.	
1.8.9	Requirement from Applicant	**<u>Clear Specification of goods / Servicers:</u>** 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.	**Rule 23(5)**
1.9		**<u>Form of the Application:</u>**	
1.9.1	Requirement from Applicant	Applicants should submit their applications in the relevant prescribed forms given in Second Schedule of the Trade Marks Rules 2017. Specific directions given in some prescribed forms with regard to filling up the form must be complied with.	**Section 18**
1.10		**<u>Information required in the Application Form</u>**	
1.10.1	Requirement from Applicant	Application must contain the following information: • Name of the proprietor(s) • Valid email id • Principle place of business • Address for service • Type of Mark, i.e. Word, Label, Device, Sound, 3 dimensional 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. • One additional representation of the mark, • Description of the trade mark including whether it is a shape or colour trademark or sound trademark. • For sound marks, a clear and audible sound clipping in MP3 format not exceeding thirty seconds of the	**Sec 143, Rule 15, 16 , 17& 26**

		trademark is to be uploaded (in case of online filing) and provided in CD/ Pen Drive (in case of Manual filings) accompanied with graphical representation of its notations. • In case of colour trademarks and three dimensional trademark, the proprietor must define sufficiently the distinguishable feature of the mark for which protection is sought. • (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 shall be classified as per the current edition of the International classification of goods and services (NICE Classification) as published by WIPO. Specification may also include goods or services from the list published by the Registrar for goods and services of Indian origin. • 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. Note: all the above mentioned information should be legible and clear	
1.10.2	Requirement from Applicant	**<u>Representation of the Trade Mark</u>** 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.	**Rule 23(2) & 26**

		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.	
1.10.3	Requirement from Applicant	**<u>Requirement of graphical representation</u>** 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, sound or packaging must also be accompanied by a concise 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.	**Section 2(1)(zb)**
1.10.4	Requirement from Applicant	**<u>Size of The Trademarks</u>** 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.	**Section 15(3)** **Rule 26(1) and 27**
1.10.5	Requirement from Applicant	The representation must • 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.	
1.10.6	Requirement from Applicant	**<u>In case of series Trademarks:</u>** Where a series is claimed and one trade mark is in	**Section 15(3), Rule 26(1) and 27**

		black and white and the others in colour or where the series is for a number of trade marks in different colours, an endorsement in the application required – <u>Where the first representation is in black and white and subsequent ones coloured:</u> The second trade mark in the series of trademarks is depicted in the colour, and as shown in the representation attached to application form. (This would be repeated for subsequent trade marks in the series.) <u>Where there are two trade marks in the series:</u> 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. <u>Where all the trade marks in the series are coloured:</u> The first trade mark in the series of trademarks is depicted in the colours and as shown in the representation attached to the application. (This would be repeated for subsequent trade marks in the series.)	
1.10.7	Requirement from Applicant	**<u>In case of Shape trademarks</u>**	
1.10.7.1	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 trademark is in fact a shape trade mark. 3 representations of the mark should be furnished if the application is for a three dimensional mark.	**Rule 26(3)**
1.10.7.2	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	**Rule 26(3)**

		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.	
1.10.7.3	Requirement from Applicant	Where more than one view of the trade mark is filed, representation of the each view of trade mark should (in the size of not larger than 8cm x 8cm) be attached to the application or uploaded along with the application if filed online.	**Rule 26(1)**
1.10.7.4	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.	**Rule 26(3)(ii)**
1.10.7.5	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 the requirement, the application may be treated as abandoned.	**Rule 26(3)**
1.10.7.6	Requirement from Applicant	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 two copies of each photograph may be required. In case of online filing the photographs should be scanned and uploaded along with the application. Photographs should be clear originals as the office will not accept photocopies of photographs. Nor will "instant" type photographs be accepted as these fade over time.	
1.10.8		**<u>In case of trademarks: as Combination of Colours</u>**	
1.10.8.1	Requirement from Applicant	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: 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.	**Section 10 ,** **Rules 23(2)(d) and 26(2)**
1.10.8.2	Requirement from Applicant	Application for the registration of the trademark shall be submitted as per Form TM- A. Representations of the trademark in additional representation / application	

		shall correspond exactly with one another. 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 the registrar from time to time. 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. The reproduction furnished shall consist of three different views, 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, 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. 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. 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.	
1.10. 8.3	Requirement from Applicant	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 basis of a limitation to colour.	

		Endorsement will be as follows: Registration of this trade mark consists of colours ... Note: If an applicant chooses to limit to some colours, the same form of endorsement would be the appropriate one.	
1.11		A representation that includes words in a language other than English/Hindi and/or characters other than Roman /Devnagari characters.	
1.11.1	Requirement from Applicant	Where a trademark includes words or numbers in a language other than English/ Hindi and/or characters other than Roman/ Devnagari characters, the applicant must state the language in which the Trademark has been applied for along with its English/Hindi translation and/or transliteration.	**Rule 28**
1.11.2	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.	**Rule 28**
1.11.3	Officer Action	Where an applicant has provided the translation / transliteration, an endorsement will be entered on the system.	**Rule 28**
1.11.4	Officer Action	Where no translation / transliteration have been provided, the examiner should request one and enter the appropriate endorsement on the system when the information has been received through TM-M . In absence of the compliance of such request, Application shall be deemed to have been abandoned for non-compliance.	**Rule 28**

1.11.5	Officer Action	In the case of the trade mark containing words not in English / Hindi, the form the endorsement should take is as follows: The applicant has provided that the translation of the (NATIONALITY / LANGUAGE) words appearing in the trademark is... Where the trade mark contains words in characters that are not Roman/Devnagari characters, the form of endorsement should be as follows: The applicant has provided that the (NATIONALITY / LANGUAGE) characters appearing in the trade mark may be transliterated as ... which may be translated into English as...	**Rule 28**
1.11.6	Concept	The information provided by applicants in formality related matters should be accepted as correct unless otherwise found during the examination.	
1.12		**<u>Specification of the goods and/or services for which registration is sought</u>**	
1.12.1	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)**
1.12.1.1	Requirement from applicant	The applicant must specify, in the manner set out in the Rule 107, the goods and/or services in respect of which the registration is sought.	**Rule 107**
1.12.1.2	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.	

1.12.1.3	Requirement from applicant	A class number must 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 ofthe class number.	**Rule 20**
1.12.1.4	Requirement from applicant	As far as practicable, the Applicant should specify the goods and services as per the current edition of "the International Classification of Goods and Services (NICE Classification)" as published by WIPO from time to time. The Applicant may include the specification of goods and services from the list published by the Registrar in relation to goods/services of Indian origin. Assistance may be taken from the link http://euipo.europa.eu/ec2/ which specifically provides for the official database of Indian Trademarks Office.	**Section 7**
1.12.1.5		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.	
1.12.2		Limitations on the specification.	
1.12.2.1	Concept	Limitations exist as to the scope of the goods and/or services that may be claimed in a specification.These limitations have been included in the legislation in light of the fact that infringement action under the provisions of the Trade Marks Act 1999 maybe taken in respect of unauthorized use of a trade mark on: goods of the same description as that of goods (registered goods) in respect of which the trade mark is registered; or services that are closely related to registered goods; or services of the same description as that of services (registered services) in respect of which the trade mark is registered; or goods that are closely related to registered services	**Section 29(2)** **Rule 23(5)**

		present Act (TM Act 1999) has a much broader provision than that which exists under the Trade & Merchandise Marks Act 1958 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.	
1.12.2.2	Concept	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 examiner will again require the expression to be deleted. Additional items will not be able to be entered in its place.	**Rule 23(5)**
1.12.2.3	Concept	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	**Rule 23(5)**

		applicant would deal in or provide that range of goods or services. In such instances the applicant may not able to demonstrate that the trade mark is used or intended to be used on all the goods and/or services specified. 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 23(5) of the Act in respect of all the items specified for the class or 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 should be noted that the provisions of Rule 23(5) 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	
1.12.3		**<u>Problems with a specification</u>**	
1.12.3.1	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.	

1.12.3.2	Office Action	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. The examiner should advise the applicant of 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. 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.	**Rule 23(6)**
1.12.3.3	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.	
1.13		**<u>Signature and Date</u>**	
1.13.1	Requirement from the Applicant	The application form must be signed and dated.	**Rule 23(1)**
1.13.2	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	**Section 145**

		sole and regular employment of the principal.	
1.13.3	Requirement from the Applicant	If the application was signed on behalf of the 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.	
1.13.4	Requirement from the Applicant	Where an application for registration of a trade mark is in the name of a trustee or trustees it should be signed by the managing trustee or trustees or a person who is empowered to sign on behalf of the trustee or trustees.	
1.13.5	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.	
1.13.6	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.	
1.13.7	Requirement from the Applicant	The name of each signatory must be written legibly (preferablyinblockcapitals)underorbesidethesignature. Thisissothatthepersonwhosignedthe applicationcan be identified.	
1.13.8	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".	

1.14		**Fees:**	
	Requirement from applicant	The application should be submitted along with the appropriate fee as per 'The First Schedule'	**Rule 10**
1.15		**Consequences of non-compliance of filing requirements**	
	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 from the date of notification, to rectify the same. If the deficiencies are not rectified in the time allowed, the application may be treated as abandoned as per Rule 31.	**Rule 31**
1.16		**Data Entry**	
	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. Data entries shall be verified by officer in-charge of Receipt and EDP Section. 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.	
1.17		**VIENNA Codification**	
	Office Action	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. Thereafter the application moves through the TMS system for examination.	

Chapter 02 Back

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 and other connected documents, if any, is complete, the application is allotted to an examiner for examination under the provisions of the Trade Marks Act and 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, strictly in order of the date and time of submission of applications.

The Examiner ordinarily gets a lot of 20 applications in his account. The Examiner looks at the application detail and the original application TM-A) and scrutinizes the application as to:-

(a) whether the application has been filed in the manner prescribed in the Trade Marks Rules, 2017;

(b) whether the trademark applied for registration can be refused registration (on relative grounds and/or absolute grounds) under the Trade Marks Act, 1999, and if so, 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 a consolidated examination report through the system containing, as far as applicable:

(i) all objections relating to formality requirements as to filing of the application;

(ii) objections to acceptance of the application for registration of the trademark under Section 9, 11 and other Sections of the Trade Marks Act, 1999; and

(iii) proposals for conditions of acceptance or limitation of 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, where the trademark is in a language other than English or Hindi – he may ask the applicant to comply with the requirement and may defer the examination till the requirement is 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 apparent from the context.

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

Note: "Section" refers to a provision of the Trade Marks Act, 1999, and "Rule" refers to a provision of the Trade Marks Rules, 2017, unless otherwise specified.

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.1		**Identification of Nature of Application**	
2.1.1	Office Action	The examiner shall identify the nature of the application for registration. The prescribed forms for various types of applications are as follows: • TM-A – Application for registration of trademark for goods or services included in any one class • TM-A – Application for registration of trademark for goods or services included in any one class and with priority claim under Section 154 • TM-A – A single application for registration of trademark for different classes of goods or services • TM-A – A single application for registration of trademark for different classes of goods or services and with priority claim under Section 154 • TM-A – Application for registration of Collective mark for goods or services included in any one class • TM-A – Application for registration of Collective mark for goods or services included in any one class with priority claim under Section 154 • TM – A single application for registration of Collective mark for different classes of goods or services • TM-A – A single application for registration of Collective mark for different classes of goods or services with priority claim under Section 154 • TM-A – Application for registration of Certification mark for goods or services included in any one class • TM-A – Application for registration of Certification mark for goods or services included	Trade Marks Rules, 2017

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		in any one class with priority claim under Section 154 • TM-A – A single application for registration of Certification mark for different classes of goods or services • TM-A – A single application for registration of Certification mark for different classes of goods or services with priority claim under Section 154 • TM-A – An application to register series trademarks for a specification of goods or services included in a class or classes • TM-A – An application to register series trademarks for a specification of goods or services included in a class or classes, with priority claim under Section 154	
2.2		**Ensuring the appropriate name of the Applicant:**	
2.2.1	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.	
2.2.2	Concept	Section 18 of the Trade Marks Act states that 'any person 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…' 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.	Section 18

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		If the applicant is an Individual The full name of the individual is required. A business name or trading style is additional information which may be provided along with the name of the individual. *e.g. "Ram Kumar Verma, an Indian National trading as Verma Trading Company"* ***If the applicant is a Company*** 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. *e.g. "M/s Singh Industries Limited, a company registered in India under the Companies Act, 2013"* 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. ***If the applicant is a Firm*** A partnership firm may make the application; in such case, the names of all partners shall be mentioned, e.g. "A, B, C, & D trading as M/s XYZ, an Indian Partnership Firm registered under the Indian Partnership Act, 1932." When the partnership includes a minor, the name of the guardian representing the minor shall also be mentioned. ***If the applicant is a Trust*** 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		e.g. "M/s XYZ, a trust registered in India under the Indian Trusts Act, 1882, and represented by Mr. X, its Managing Trustee." ***If the applicant is a Society*** Application may be made on behalf of a society. *e.g. "M/s XYZ, a society registered in India under the Maharashtra Co-operative Societies Act through its secretary Mr. A."* ***If the applicant is the Government*** The Central or State Government or any undertaking/company owned or controlled by such Government may also make an application for registration of a trademark like any other person. *e.g. "The Government of India/Government of __(State)__, represented by __(name of the Department)__ through its Secretary, Mr. xxx"* ***If the applicant is a Government undertaking*** The application can be made in the name of the undertaking and executed in the manner prescribed by the rules regulating the body. A reference shall also be made to the Authority (usually legislative) under which the undertaking functions, along with the name of the undertaking. *e.g. "M/s Life Insurance Corporation, a Public Sector undertaking established under the Life Insurance Corporation Act, 1956"* ***If there are Joint Applicants*** Section 24 enables registration of two or more persons as joint proprietors of the trademark, where the mark is used or proposed to be used in relation to goods or services connected with the joint applicants. *e.g. "M/s XXXX, a company registered in India under the Companies Act, 2013, and M/s YYYY, a company registered in India under the Companies*	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Act, 2013…claiming to be joint proprietors of the trademark." ***If the applicant is a Micro, Small or Medium Enterprise (MSME)*** An application for registration of a trademark may be filed by an enterprise classified as a Micro, Small or Medium Enterprise under the Micro, Small and Medium Enterprises Development Act, 2006, as amended from time to time. Where the applicant claims the benefit of MSME status for the purposes of payment of statutory fees, or any other benefit available under the Trade Marks Rules, the applicant shall furnish the Udyam Registration Number or such other documentary evidence as may be prescribed by law. The applicant name shall be recorded in the legal name of the proprietor, partnership firm, limited liability partnership, company or other legal entity owning the trademark. MSME status shall be treated only as a classification of the applicant for statutory purposes and shall not constitute a separate juristic entity. *e.g. "M/s ABC Foods Private Limited, a company incorporated under the Companies Act, 2013 and registered as a Small Enterprise under the Micro, Small and Medium Enterprises Development Act, 2006",*	
2.2.3	Office action	In case the name of the applicant is not appropriately mentioned, the Examiner should raise an objection as follows: *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 on form TM-M.*	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.3		**Ensuring the submission of the Authorization of Agent by way of Form TM- M**	
2.3.1	Office action	The examiner shall ensure that a duly stamped Letter of Authorisation/Power of Attorney is filed, in case the application has been submitted by a person other than the applicant. The Examiner shall further verify that such Letter of Authorisation or Power of Attorney has been duly executed and is properly stamped in accordance with the provisions of Chapter IV of the Indian Stamp Act, 1899 applicable to the place of execution of the instrument. Any Letter of Authorisation or Power of Attorney not duly stamped as per the concerned Indian Stamp Act, 1899 shall be treated as deficient, and the applicant shall be required to rectify the deficiency in accordance with law before the same is acted upon by the Registry.	Section 145, Rule 19, Rule 78, Rule 120, Indian Stamp Act 1899 (Chapter IV)
2.3.2	Concept	In case the application has not been filed and 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-M is required to be filed. The agent can be a legal practitioner (Advocate), a registered trademark agent, a constituted attorney (a person under sole and regular employment) of the applicant, or a member of the Institute of Company Secretaries of India duly authorised to act on behalf of the applicant in accordance with law. An Authorization of agent in favour of a firm without the name of any individual agent or attorney should not be accepted.	Section 145, Rule 19

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.3.3	Office action	In case no proper Power of Authorization of Agent is submitted and the application has been submitted by a person other than the applicant, the Examiner should communicate an objection as follows: *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.*	
2.4		**Ensuring about the applicant's principal place of business**	
2.4.1	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.	
2.4.2	Concept	Every application for registration of a 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 16 & 17
2.4.3	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 an objection as follows: *The Principal Place of business of the applicant should be brought on record by filing a request on form TM-M; or the applicant's address for service*	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		in India should be brought on record by filing a request on form TM-M, since the applicant has no principal place of business in India.	
2.5		**Ensuring transliteration and translation of trademark in non-English or non-Hindi characters.**	
2.5.1	Office Action	If the trademark applied for registration is in a language other than English or Hindi, the examiner shall ensure that a transliteration and translation is properly mentioned in the application.	
2.5.2	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 28
2.5.3	Office action	If the trademark applied for registration is in a language other than English or Hindi, the Examiner shall defer the examination, communicate it as a deficiency to the applicant concerned and require the applicant to provide a sufficient transliteration into roman script and its translation in English by filing a request on form TM-M. The objection, for example, should be raised as follows: *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-M.*	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Only after compliance of this shall the application be further examined.	
2.6		**Ensuring the consent of a person or his legal representative, if the trademark contains a name or representation of that person**	
2.6.1	Office action	If the trademark applied for registration contains a name, signature, portrait, likeness, image, or any other representation of an identifiable natural person, an identifiable attribute, or an AI-generated representation, the Examiner shall ensure that the consent of that person or his legal representative is submitted with the application. *Note: Contemporary technological developments permit the creation of digitally generated and AI-generated likenesses capable of identifying individuals. This requirement gives full effect to Section 14 of the Trade Marks Act, 1999 and is consistent with the personality and publicity rights recognised by Indian courts, including Anil Kapoor v. Simply Life India & Ors., CS(COMM) 652/2023, and D.M. Entertainment Pvt. Ltd. v. Baby Gift House and Ors., CS(OS) 893/2002.*	Section 14, Rule 29
2.6.2	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, Rule 34
2.6.3	Office action	If the trademark applied for registration contains a name or representation of a person in it, and no consent of that person, or of his legal representative (if	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		that person is dead), is submitted, the Examiner shall communicate an objection as follows: *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 deceased, should be furnished in writing.*	
2.7		**Ensuring submission of draft regulations in case of an application for registration of a collective mark**	
2.7.1	Office action	If the application is made for a collective mark on form TM- A, the Examiner shall ensure that a draft regulation on form TM- M regarding the association of persons authorised to use the mark is submitted along with the application.	
2.7.2	Concept	The collective mark is owned by an association of persons, not being a partnership. It belongs to a group and its use is therefore reserved for members of the group. The primary function of a collective mark is to indicate a trade connection with the association or organization which is the proprietor of the mark. In case of an application for registration as a 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, with the application on form TM-A, which shall include: 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;	Section 63, Rule 131, 132

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		e. the persons authorised to use the mark and the nature of control the applicant exercises 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; and such other relevant particulars as may be called for by the Registrar.	
2.7.3	Office action	If the application is made for registration of a collective mark and no proper draft regulation on form is submitted with the application, the Examiner shall defer the examination, communicate it as a deficiency to the applicant concerned and require the applicant to furnish a proper draft regulation on form TM-M The objection, for example, should be raised as follows: *A proper draft regulation on form TM-M as per Rule 131 of the Trade Marks Rules, 2017 should be submitted with the application by filing a request on form TM-M.* Only after compliance of this shall the application be further examined.	Rule 133, 134
2.8		**Ensuring submission of draft regulations in case of an application for registration of a certification mark**	
2.8.1	Office action	If the application is made for a certification mark on form TM-A the Examiner shall ensure that a draft regulation on form TM-M regarding the competence of the proprietor for certification of the relevant goods or services is submitted along with the application.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.8.2	Concept	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. Application for registration should be made on form TM-A, as the case may be, accompanied by the prescribed fee. A draft regulation under Section 74 of the Trade Marks Act, 1999, in triplicate, should also be deposited on form TM-M, which shall include: a. a description of the applicant; b. the nature of the applicant's business; c. the particulars of infrastructure, like R&D and technical manpower support; d. the applicant's competence to administer the certification scheme; e. the applicant's 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 137, 138
2.8.3	Office action	If the application is made for registration of a certification mark and no proper draft regulation on form TM-M is submitted with the application, the Examiner shall defer the examination, communicate it as a deficiency to the applicant concerned and require the applicant to furnish a proper draft regulation on form TM-m by filing a request on form TM-ML	Rule 141

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		The objection, for example, should be raised as follows: *A proper draft regulation on form TM-m as per Rule 135 of the Trade Marks Rules, 2017 should be submitted with the application by filing a request on form TM-16.* Only after compliance of this shall the application be further examined.	
2.9		**Ensuring submission of adequate priority documents, in case of applications with priority claims**	
2.9.1	Office action	If the application is made on form TM - A, with a priority claim by virtue of a similar application made in any convention country, the Examiner shall ensure that documents in support of the priority claim are submitted along with the application.	
2.9.2	Concept	Section 154(1) of the Trade Marks 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 the same privileges as granted to its own citizens. India has ratified the Paris Convention for Protection of Industrial Property through 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 150 countries as convention countries. According to Section 154(2) of the Trade Marks Act, 1999, where a person who has made an application for registration of a trade mark in a convention country makes an application for registration of the trade mark	Section 154, Rule 24

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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. 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 the application for registration, and it should include the particulars of the mark, the country or countries, and the date or dates of filing of the application. 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.	
2.9.3	Office action	If the application is made on form TM - A with a priority claim by virtue of a similar application made in any convention country, and no document in support of the priority claim is submitted, the Examiner shall communicate the objection as follows: *Authentic documents in support of the priority claim should be filed within two months of the filling of the aplications*	
2.10		**Examination of application as to classification of goods and services**	
2.10.1	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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.10.2	Concept	An application for registration of a 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. For the purpose of registration of a trademark, the goods or services are classified, in accordance with the current edition of the International Classification of Goods and Services (NICE Classification) published by the WIPO. Section 8 of the Trade Marks Act, 1999 authorises, and Rule 20 of the Trade Marks Rules, 2017 requires, that the Classification of Goods and Services for the purpose of registration of a trademark be published by the Registrar of Trade Marks. Accordingly, the Classification of Goods and Services for the purpose of registration of a trademark has been published class wise and with an alphabetic index of such goods and services including goods and service of Indian origin and put up on the office website. An application is filed for registration of a 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 Trade Marks. Under Section 18(2) of the Trade Marks Act, 1999, a single application can, however, be filed for registration of a trademark in respect of goods and/or services falling in more than one of such classes.	Section 7, Section 18 (2) Rule 20
2.10.3	Office action	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 Trade Marks, 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	Rule 23(6)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		services and require the applicant to correct the class through a request on form TM-M. For example, if an application for registration of a trademark in respect of 'cosmetics' is filed in class 34, the Examiner shall require the applicant to correct the class to '3' by a request on form TM-M. If some of the items of goods or services mentioned in the application fall outside the relevant class of the International Classification of Goods and Services, as published by the Registrar of Trade Marks, but some items, 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 for and confine the goods or services to those which fall in that class, through a request on form TM-M. For example, if an application for registration of a trademark in respect of 'cosmetics', 'medicines' and 'readymade garments' is filed in class 3, the Examiner shall require the applicant to delete the items 'medicines' and 'readymade garments' from the specification of goods by a request on form TM- M. However, if the application is made for registration of a trademark in respect of goods or services falling in more than one class, and some items mentioned in the specification of one particular class do not fall in that class but fall in some other class, the applicant may amend the application to add an additional class or classes on payment of the appropriate class fee and divisional fee.	
2.10.4	Office action	In case the specification of goods or services mentioned in the application is too wide or vague, the Examiner shall raise an objection to this effect.	
2.10.5	Concept	An application for registration of a trademark in respect of all goods or services, or a large variety of	Rule 23(5)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		goods and services in a class, may be refused registration unless the Registrar of Trade Marks is satisfied that the specification is justified by the use of the mark, or that the applicant intends to make such use in respect of all such goods/services. Accordingly, goods or services in respect of which an application for registration of a trademark is made should be specific and should not be wide or vague. Some examples of wide and vague specifications are as follows: In Class 7, claims to 'machines' without further qualification should be objected to. The following gives examples of description which are acceptable, since in each case the end use of the machine has been identified. *Machines for agricultural purposes;* *Machine for use in manufacturing processes;* *Machines for the 42 woolen industry* *Or other specific machines e.g washing machines* 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. 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 23(5). The class heading to Class 45 reads	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		"*Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.*" The first part of the heading is considered too vague and a Rule 23(5) objection should be raised against applications containing this description, including where specifications contain either 'personal services' or 'social services' as individual elements. The second part of the heading, 'security services for the protection of property and individuals', is sufficiently precise and will not attract an objection. The objection to this effect should be raised as follows: *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-M*	
2.11		**Examination of application as to relative grounds for refusal of registration**	
2.11.1	Office action	The Examiner shall make a search of same or similar earlier trademarks in respect of the 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 an objection to acceptance of the application for registration on relative grounds. The search of same/similar trademarks is performed through the Trade Marks System. The system enables the examiner to search using three modes – word mark search, phonetic search and	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		device mark search. 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. In the word mark mode, the examiner can search of earlier marks on the basis of selected characters as prefix or suffix. In the phonetic search, the Examiner may specify one or two phonetic variants of the trademark, and the system will fetch all earlier trademarks having phonetic similarity with the applied trademark. In device mark search, the system enables the examiner to find earlier trademarks having the same/similar features. All trademarks consisting of any figurative elements are codified as per the International Classification of the Figurative Elements of Marks (commonly referred to as the 'Vienna Codification'). The examiner, in this mode, enters the correct Vienna code(s), and the system fetches all trademarks bearing that Vienna code(s). 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, who 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Advance Magazine Publishers & Anr. v. M/S. Just Lifestyle Pvt Ltd, MANU/MH/1892/2016; Corona Remedies Private Limited v. USV Limited, MANU/SCOR/01168/2016; Sony Kabushiki Kaisha v. Shamroa Maskar And Ors, Natures Essence Private Limited v. Protogreen Retail Solutions, 2021 SCC OnLine Del 1538; Geep Flashlight Industries Ltd. v. The Registrar Of Trade Marks, AIR 1972 Delhi 179; M/s. Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd, Civil Appeal No. 2943-2944 of 2018; Vishnudas Trading v. Vazir Sultan Tobacco Co. Ltd., 366 1996 SCALE (5) 267; Sarda Plywood Industries Ltd. v. Tac Construction Materials Ltd., 107 (2003) DLT 687; Unitech Biotech Pvt. Ltd v. Orchid Chemicals Pharmaceutical Ltd., 2012 (50) PTC 433 (Del); ;	
2.11.2	Concept	According to Section 11(1) of the Trade Marks Act, 1999, a trade mark shall not be registered if, because **of its identity or similarity with an earlier trade mark(s), and because of the identity or similarity of goods or services covered by such trademarks,**	Section 11(1), Explanation to Section 11(4),

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark. Explanation to Section 11(4) of the Trade Marks Act, 1999 defines an earlier trade mark. Under this provision, "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." Thus an earlier trademark will include an earlier registered mark and a prior pending application. ***Identical trademark*** A mark is identical with the trade mark where it reproduces, without any modification or addition, 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. ***Similarity of marks*** The term similarity of trademarks is to be construed as "deceptively similar", which expression is defined as "so nearly resembling that other mark as to be likely to deceive or cause confusion". Manu Garg and Ratan Behari Agarwal v. Registrar of Trade Marks, C.A. (COMM.IPD-TM) 143/2021 ***Likelihood of confusion***	Section 2(1)(h)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		For likelihood of confusion to exist it must be probable; it is not necessary that actual confusion has arisen or should arise in the mind of the public, i.e. the average consumer. The three most relevant factors in examination of trade mark applications by the Office will usually be (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. Rules of comparison as developed over the years and as laid down by Parker J. in the Pianotist case (1906) 23 RPC 774 at page 777 should continue to be followed: *"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, by the respective owners of the mark. If there is likely to be confusion, the application must be refused."* ***General rules for comparison of marks*** • 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		• Comparison should be made from the point of view of a person of average intelligence and of imperfect recollection. • The overall structural, visual and phonetic similarity, and similarity of the idea in the two marks, and whether there is a reasonable likelihood of causing confusion, should be taken into account. Parle Products v. J.P. & Co. Mysore, Amritdhara Pharmacy v. Satyadeo Gupta, S.M. Dyechem Ltd. v. Cadbury (India) Ltd., 2000 5 SCC 573 Griffith v. Vick Chemicals, AIR 1959 Cal 654 Gillette v. A.K. Stationaries, 2002 CTMR 16 ***Additional precautions required where the goods are medicinal preparations*** *"Exacting judicial scrutiny is required if there is a 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." – Cadila Healthcare Limited vs. Cadila Pharmaceutical Limited, AIR 2001 SC 1952.* Ciba-Geigy Ltd. v. Sun Pharmaceutical Industries	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		PTC (Supplement)(1) 575 (Guj); USV Limited v. IPCA Laboratories Limited; Macleods Pharmaceuticals Ltd v. Swisskem Healthcare (02.07.2019); Himalaya Drug Co. v. SBL Limited, CS (OS) No. 111 of 2006; Sun Pharmaceutical Industries Ltd. v. Anglo French Drugs and Industries Ltd. (OXETOL v. EXITOL), decided 12.09.2014; Torrent Pharmaceuticals Ltd. v. The Wellcome Foundation Ltd. ***Where a composite trade mark comprises different distinctive elements*** In the case of composite marks comprising 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, marks consisting of 'Alexander' or 'Morgan' alone will not be conflicting with the composite mark, even if the respective goods are the same. The same principle is recognized in Section 17(1) of the Act, which provides that the mark must be considered as a whole. Reckitt & Colman of India Limited v. Medicross Pharmaceuticals, 1992 (3) Bom CR 408	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Pluto Travels India Private Limited v. PTW Holidays Private Limited, CS(COMM) 334/2024 However, if the prominent and distinctive portion of two trademarks is identical, the earlier mark may be regarded as conflicting with the later mark. For example, CROCIN PLUS may be conflicting with CROCIN FORTE for medicines. It is possible for a word to be subsumed within a multi-word slogan mark even though the words do not combine to form a totality with an obvious meaning. For example, the word 'targets' in the composite mark 'Fashion Week Targets Friday' (for clothing) is not likely to be considered as having an independent and distinctive role, and accordingly should not be cited as conflicting with the trademark 'Targets' alone. In a different case, e.g. the mark CAREAID included in a two-word composite mark such as SPINESPAN CAREAID (for medical services), where the two elements appear to the consumer to be normally distinctive and entirely independent of each other, if the respective goods/services are also identical, it is quite likely that the relevant consumer will assume 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. M/s. Johann A. Wulfing v. Chemical Industrial & Pharmaceutical Laboratories Limited, AIR 1984 Bom 281 Mount Mettur v. Ortha Corporation, AIR 1975 Mad 74	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.11.3	Office action	In case same or similar earlier trademarks of different persons are found on records in respect of the same or similar description of goods or services, the Examiner should raise an objection as follows: *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 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.*	
2.12		**Examination of application as to absolute grounds for refusal of application for registration**	
2.12.1	Office action	The examiner shall examine the application to see whether the trademark applied for registration is capable of distinguishing the goods or services of one person from those of another, and whether its registration is liable to be refused under Section 9 of the Trade Marks Act, 1999.	
2.12.2	Concept	Section 9(1) of the Act sets down the following absolute grounds for refusal of registration: i) 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 ii) 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 rendering of services, or other characteristics of goods or services;	Section 9(1)(a), 9(1)(b), 9(1)(c)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		iii) 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. ***Devoid of distinctive character*** The expression 'distinctive', in relation to goods in respect of which a trademark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trademark is or may be connected in the course of trade, from goods in the case of which no such connection subsists. Hindustan Unilever Ltd. v. The Registrar of Trade Marks, IPAB, 07.08.2020 Disruptive Health Solutions Pvt. Ltd. v. Registrar of Trade Marks, C.A.(COMM.IPD-TM) 133/2022 M/s. ITC Limited v. Nestle India Limited, AIRONLINE 2020 MAD 914 Muneer Ahmad v. Registrar of Trade Marks, 2023 SCC OnLine Del 7345 Cross Fit LLC v. Mr Renjith Kunnumal & Anr., I.A. 6927/2021 Nestles Products (India) Ltd. v. P. Thankaraja and Anr., AIR 1978 Mad 336; Pearl Retail Solutions Pvt Ltd v. Pearl Education Society, MANU/DE/0839/2013	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Caterpillar Inc. v. Mehtab Ahmed and Ors., 99 (2002) DLT 678 Kirorimal Kashiram Mktg. & Agencies Pvt. Ltd. v. Shree Sita Chawal Udyog Mill Tolly Vill, 2010 (44) PTC 293 (Del.) (DB) Distinctiveness has been understood to mean some quality in the trademark which marks the goods so marked as distinct from those of others. In the 1999 Act, 'distinctive' and 'capable of distinguishing' have been made synonymous. A mark which is inherently distinctive, or which has become capable of distinguishing the goods/services of an applicant from those of others, can be considered for registration. A mark which has a direct reference to the character or quality of the goods/services is considered inherently incapable of distinguishing. Marks consisting of a common surname, name, name of place, section of society, or 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 members of the public who, in future, in connection with their own goods, might wish to use them. 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, value, geographical origin or the time of production of goods, or rendering of the service, or other characteristics of the goods or services, shall not be registered.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		The expression '**may serve in trade'** means there exists a reasonable likelihood that other honest traders will wish to use the mark in question to designate characteristics of the goods/services. ***'Kind'*** 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**', '**Large**' or '**Small**', would fall in this category and be objectionable in respect of any goods or services. ***'Quality'*** Laudatory words such as **GOOD** or **BEST** are not registrable for any goods or services since all traders should be equally free to use them in advertising their products. ***'Quantity'*** **Numeral 12** would not, for example, be acceptable for wine (12 bottles = one case of wine), nor would **20** or **numeral 200** for cigarettes, nor 1000 for butter (1000 gm = 1 kg). ***'Intended purpose'*** Words which refer directly to the use of the goods or which describe the consequences of providing the service are not acceptable, for example **KETTLE CLEAN** for kettle-cleaning preparations, **TWIST AND CURL** for hair-curling implements, **SLIM AND FIT** for slimming preparations. Words which describe the effect of the goods/services would also be open to objection, for example **RUSTFREE** for paints and articles made of steel. ***'Value'*** Words or symbols which merely serve to indicate the worth, merit or importance of the goods or services	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		are not acceptable, for example '**TWO FOR ONE' or 'WORTH THEIR WEIGHT IN GOLD'**. ***'Geographical origin'*** Names of places with populations of less than **5,000 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. In the case of overseas names, the location's reputation is considered more important than its population size. For industrialised countries such as the USA, Japan or those in Europe, a population size of 100,000 is generally considered reasonable for acceptability, subject to the location's reputation for the relevant goods or services. Names of rivers, mountains, seas and lakes will be considered prima facie acceptable in respect of goods not associated with the geographical feature; for example, the names of rivers or seas will not be acceptable for 'fish' in class 29. 'Mediterranean' for transport services may be objectionable. Likewise, names of mountains in respect of agricultural produce will be considered non-distinctive. Names of streets such as Wall Street and Dalal Street, which have strong links with financial services, will entail objections in respect of such services or related goods. Where there is 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. 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Names of rivers, seas and lakes are usually accepted prima facie for goods not associated with these geographical features. However, names such as 'Ganga' or 'Kaveri', being also well-known personal names, can be registered only on the basis of acquired distinctiveness, and would not normally be acceptable for fish or fish products. The names of mountains would not be acceptable for agricultural produce. As regards oceans, the practice is to accept **ATLANTIC** and **PACIFIC** for unrelated goods/services 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. Names of districts generally carry the same objections applicable to geographical locations, depending on the extent of their reputation for relevant goods/services. Names of well-known suburbs of large cities (for example, Andheri or Borivali in Mumbai) should be considered as towns in their own right with comparable population figures, having regard to whether the goods/services are likely to be sold/provided from that area and whether such use is likely to indicate origin. In rare instances, where a town has grown up around an established business and adopted the same name, prima facie acceptance is normally possible for the relevant goods, for example **TATANAGAR** for steel. Because goods are generally transported and sold across India, while services may be provided only in a particular locality, a more liberal approach to geographical names may be taken in the case of service marks as compared to goods.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Where a combination of two or more Indian geographical names refers to a particular region, this will be prima facie objectionable, for example **VASAI-VIRAR** for building construction services, and similarly where the combination has acquired reputation, such as **MUMBAI-PUNE** for information technology or financial services. Foreign geographical names must be considered on the basis of whether the location has a reputation for the goods/service and whether other traders are reasonably likely to wish to use the name to indicate geographical origin. Fanciful use, such as **KARACHI** for shoe repairs or **KANSAS FRIED CHICKEN** for restaurant services, may be acceptable, whereas names with a genuine connection or reputation for the goods/services, such as **PARIS** for fashion design, **MADRAS** for '**Masala Dosa'**, or 'Italian' for restaurant services, would attract objection. Dubai Islamic Bank v. Union of India & Ors., W.P. (C) 12749/2019; Hi-Tech Pipes Ltd. v. Asian Mills Pvt. Ltd., 2006 (32) PTC 192 (Del.); Geepee Ceval Proteins & Investment Pvt. Ltd. v. Saroj Oil Industry, 2003 (27) PTC 190 (Del.); ARMASUISSE v. The Trade Mark Registry & Anr., C.A.(COMM.IPD-TM) 158/2022; Imperial Tobacco Co. of India Ltd. v. Registrar of Trade Marks, AIR 1968 Cal 582;	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Abu Dhabi Global Market v. Registrar of Trademarks, 2023 SCC OnLine Del 2947	
2.12.3	Concept	***Prohibition of registration of geographical indication as trademark*** Section 25 of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (GI Act) prohibits registration of a 'geographical indication' as a trademark, or invalidates the registration of a trademark, either suo motu or at the request of an interested party. The basic intention of section 25 is to prevent misappropriation of public property in the nature of a GI by an individual as a trademark, leading to confusion in the market. Section 26 of the GI Act, however, protects a trademark consisting of a Geographical Indication which has been applied for or registered in good faith before the commencement of the GI Act.	Sections 25 & 26, GI Act 1999
2.12.4	Concept	**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 concerned with the goods or services covered by the application. When a mark is in common use in the trade, or when it is open to the trade to use the mark, it is said to be '**common to trade'** and ceases to be the 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, and star devices for brandy or tobacco products.	Section 9(1)(c)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Cadila Healthcare Ltd. v. Gujarat Co-operative Milk Marketing Federation Ltd. & Ors., 2009 (41) PTC 336 (Del.) 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.	
2.12.5	Concept	***Acquired distinctiveness*** A trademark which offends 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. ***Evidence of use*** In any proceeding before the Registrar, evidence is to be given by way of affidavit; the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence. Rule 120 prescribes the manner in which affidavits are to be executed. Where evidence of use of the trademark, in conformity with the user statement mentioned in the application, has already been given by affidavit (with exhibits), the examiner may take this into account while raising objections under Section 9(1) of the Act. In assessing the distinctive character of a mark on the basis of evidence of use, the following factors shall be taken into account: (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;	Rule 116

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		(d) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and (e) statements from Chambers of Commerce and Industry or other trade and professional associations. ITC Limited v. Philip Morris Products SA, CS (OS) 1894/2009 J.L. Mehta v. Registrar of Trademarks, AIR 1962 Bom 82; Info Edge (India) Pvt. Ltd. v. Shailesh Gupta, 2002 (24) PTC 355 (Del.) Laxmikant V. Patel v. Chetanbhat Shah and Ors., Mahendra and Mahendra Paper Mills Ltd. v. Mahindra and Mahindra Ltd., (2002) 2 SCC 147 Jagan Nath Prem Nath Bhartiya Dhoop Karyalaya, 1975 SCC OnLine Del 79; GTZ India Pvt. Ltd. v. Artek Surfins Chemicals Ltd. & Anr., 2024 SCC OnLine Del 4211	
2.12.6	Concept	***Distinctiveness in various types of trademarks*** Marks consisting of single letters or two letters will generally be regarded as devoid of distinctive character for goods, owing to the tendency in trade to use letters as models or catalogue references, or as abbreviations of names; two-letter marks may be acceptable for services having regard to trade practice. Single numbers involving little or no stylisation will often face objection, as such numbers are commonly	Section 9(1), Section 35

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		used in trade to designate quantity, quality or characteristics of goods (e.g. 6 = cylinders in an engine, 2 = litres of milk), and two-digit numerals may similarly be devoid of distinctive character. Carlsberg India Pvt. Ltd. v. Radico Khaitan Ltd., 2011 SCC OnLine Del 5756; Shine Chem Laboratories v. Standard Reagents Private Limited, 2016 SCC OnLine Hyd 198 Numbers/letters which may be used in trade to designate ● The **date** of production of goods/provision of service (e.g. 1996, 2000) ● **size** (e.g. XL, 1600, 34R, 185/65) ● **quantity** (e.g. 200 for cigarettes), ● **telephone codes**, time of service provision (e.g. 24/7) ● **power** (e.g. 115 BHP), ● **speed** (e.g. 486, 586) ● **strength** (e.g. 8.5% for lager) will be subject to objection under Section 9(1)(b) and 9(1)(c) of the Act. ***Common names/surnames*** 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, since Section 35 of the Trade Marks Act, 1999 protects the bona fide use of name, address and description of goods or services. Objections under Section 9(1)(a) should be raised for	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		such marks unless it is established that the mark has acquired a distinctive character by prior use. ***Mis-spelling of descriptive words*** Mis-spellings of descriptive words are also excluded from registration where the correctly spelled word would have been objectionable, for example **XTRA** instead of **EXTRA**, or **KOMMUNIKATION** instead of **COMMUNICATION**. Commonly used mis-spellings or abbreviations in the trade, such as **CUT 'N BLOW DRY**, D**RIVE THRU/DRIVE** I**N, STARTER PAK, FRESHLY PREPARED 2 GO, or BEST 4 YO**U, would still be open to objection. ***Descriptive words in foreign languages/little-known languages*** If a foreign word is in a language not likely to be known to a significant proportion of the public in India, there is no ground for objection on descriptiveness. However, if a word is descriptive in a local Indian language, the objection under Section 9 must be raised, since the goods/services would be sold/rendered in that locality. ***Domain names*** A domain name is a written representation of a website address. It is common practice for traders to use their website address 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 registrable. Elements such as **'.com'** or '**co.in**' are considered totally non-distinctive, much like 'Ltd' and '**Plc**'; if the remainder of the mark is descriptive or	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		non-distinctive, an objection under Section 9 will arise. ***Trademarks consisting of a number of non-distinctive features*** When a trademark consists of several elements, registration confers exclusive right to use of the trademark taken as a whole. If the combination of descriptive elements was unusual and created an impression sufficiently removed from a simple composite description of the goods/services, the trademark might be registrable; however, a purely descriptive phrase **(e.g. HIGH TECH HOME COMPUTING SYSTEM** for computer software) would not be permitted registration. F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd., AIR 1970 SC 2620 Sky Enterprise Private Ltd. v. Abaad Masala and Co., [2020 (5) ABR 500] Kapil Goyal v. The Registrar of Trademarks, C.A.(COMM.IPD-TM) 15/2025 ***Slogans*** One or more words constituted as a slogan mark may be registrable, provided it is distinctive per se or has	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		acquired distinctiveness. Slogans serving a purely promotional function will be objectionable, as average consumers do not assume origin from such slogans. A plain descriptive slogan, such as **NEVER CLEAN YOUR SHOWER AGAIN (Class 3)**, is objectionable, while a non-commonplace mark such as **THE BEST WAY TO PREDICT THE FUTURE IS TO CREATE** IT (for technology-related services) can be accepted. Procter & Gamble Manufacturing (Tianjin) Co. Ltd. v. Anchor Health & Beauty Care Pvt. Ltd. (Del HC, 2014) Dubai Islamic Bank v. Union of India & Ors., W.P. (C) 12749/2019 Reebok India Company v. Gomzi Active, 2007 (34) PTC 164 (Karnataka) ***Combination of colours*** Where a statement has been made that the trademark consists of a combination of colours only, the trademark will be regarded as a colour trademark. 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 it should not be protected by registration. Marks consisting of a single colour will usually be liable to objection under Section 9(1)(a) of the Act, as they inherently lack the capacity to distinguish, and weighty evidence will be necessary to overcome such objection wherever exclusive right to a colour is sought. ***Sound marks***	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		A trademark may consist of a sound, represented graphically by a series of musical notes, with or without words. Applications for sound marks must clearly state that they are sound marks, failing which the application will be examined as if it were a word and/or device mark. The acceptability of a sound mark depends on whether it is or has become a distinctive sign, that is, whether the average consumer will perceive the sound as exclusively associated with one undertaking. Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness.	
2.12.7	Concept	Section 9(2) prohibits registration of a trademark: (a) if the mark is of such a 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 matter; (d) if its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950. ***Deceptive marks*** 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. 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	Section 9(2)(a)-(d), Emblems and Names (Prevention of Improper Use) Act, 1950, Section 23(1)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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. 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. That objections under this Section at first examination stage should be taken where there is prima facie misrepresentation as to “nature or quality of goods/services, geographical origin” etc: 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** 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Deception as to Quality 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) **Deception as to Geographical origin** 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. So also **SWISSTEX** for "watches", because Switzerland is famous for high quality watches. 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.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Practice regarding the Olympic Symbol or Word 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, and protection extends to marks sufficiently similar so as to create an association with those signs in the public mind. An objection under Section 9(1)(a) should be raised where an application is made consisting of or containing the Olympic symbol or words. ***Marks likely to hurt religious susceptibilities*** It is a common trade practice in India to use names and pictures of Gods and Goddesses or religious symbols as trademarks, and such use per se is not regarded as offending religious sentiments. However, such use in relation to certain goods may offend religious sentiments, for example the use of names/devices of deities or religious heads on footwear, or the use of Hindu Gods in respect of beef/meat products, or names of Muslim saints for pork products. Certain names and pictures of Gods, Goddesses and religious heads are prohibited from registration as trademarks in terms of directions issued under section 23(1) of the Trade & Merchandise Marks Act, 1958, which continue to remain valid. Use of religious symbols **(like OM)** or names **(e.g. Jesus)** as trademarks is likely to undermine or offend religious sentiment; names of Gods/Goddesses also used as personal names may be considered as personal names for registration purposes unless accompanied by the device of such God/Goddess. Sri Vishnu Cement Ltd. v. BS Cement Private Ltd., 2004 (28) PTC 314 (IPAB)	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Marks containing scandalous or obscene matter Scandalous marks are those likely to offend accepted principles of morality, induce public disorder, or incite criminal or other offensive behaviour. The applicability of the objection must be decided objectively and non-discriminately: 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 significantly undermine religious, family or social values, an objection must be raised. The outrage must be amongst an identifiable section of the public. 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. A vulgar mark not may be acceptable on any goods 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. Objections should be raised against explicit full frontal nudes and offensive (scandalous) back views.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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. Examples of marks which may considered to be objectionable under this Section – **WHITE DOVE YOU DON'T NEED WINGS TO FLY** Contrary to public policy as it would be seen as promoting drugs (White Dove is a nickname for a type of drug) **SNUFF MOVIES** Obscene and scandalous, promoting pornography and murder.This is contrary to accepted principles of morality in view of bad language. ***Prohibition under the Emblems and Names (Prevention of Improper Use) Act, 1950*** Capital Ventures Pvt Ltd v. Registrar of Trademarks, C.A.(COMM.IPD-TM) 5/2022, decided 29.04.2025	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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). Section 4(b) of the Emblems Act prohibits generally registration as a 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 Government or of a department of any Government or the President, or Union of India. Item 7 of the Schedule expressly includes "any name which may suggest or may calculate to suggest – 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. 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 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 inforce;	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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. **The Central Government has issued directions not to register following trademarks.** These trademarks are therefore not registrable in view of Section 23 (1) of the Trademarks Act, 1999 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."	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		7. Words "ASHOK CHAKRA" or DHARMA CHAKRA" or the device of Asoka Chakra or any other colourable limitation thereof. 8. The British Royal Arms, The British Crown or the Union jack or any colourable limitation thereof. 9. Letters "I.S.O." if applied by any person or body other than the Indian Standards Institution. 10. Words "Lord Buddha" or the device of Lord Buddha or any colourable imitation thereof. 11. Words "Shree Sai Baba" or the device of Shree Sai Baba or any colourable imitation thereof. 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. 13. Words "National", and "Panchsheel", 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	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		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 ● Nabam ● Parathion-methyl ● Proxan-Na or proxan-sodium ● Tecnazene ● TEPP ● Ziram ● Captan sulfotep] 15. Following Letters “IR” 16. Names and pictures of Sikh Gurus, viz. Guru Nanak, guru Angad, Guru Amar das, Guru Ram Das, Guru Arjun dev, Guru Hargobind,	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		guru Har Raj, Guru Har Krishnan, Guru Teg Bahadur and Guru Govind Singh 17. Name and picture of Chhatrapati Shivaji Maharaj 18. Letters "STC". 19. Name and/or picture of the deity of Lord Venkateswara and/or Balaji 20. Representation of the Election Symbol of any political party in India. ***Practice with regard to the Red Cross*** Marks consisting of the words **"Red Cross"** or **"Geneva Cross"**, or any cross device in red or in any closely resembling colour, are not accepted for registration; applications made in black and white containing the device of a cross, crescent moon, or lion and sun, will not attract objection on this ground. Green crosses on a white background are generic for pharmacy and medical goods/services, and white crosses on a green background are generic for first-aid goods/services (based on EU legislation establishing this as the First Aid sign); use of these as trademarks is not to be permitted. Applicants using a cross device generally will be required to comply with a condition not to use the cross device in red or a similar colour, or in the manner prohibited under the Geneva Convention Act, 1960.	
2.12.8	Concept	Under Section 9(3), a mark is not registrable as a trade mark if it consists exclusively of: (a) the shape of goods which results from the nature of the goods themselves; (b) the shape of goods which is necessary to obtain a technical result; or (c) the shape which gives substantial value to the goods. The Explanation to this section clarifies that the nature of goods or services in relation to which the	Section 9(3)(a)-(c)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		trade mark is used or proposed to be used shall not be a ground for refusal of registration. ***Shape of goods*** A distinctive 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. However the trademark shall not be registered if it consists exclusively of – 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 The purpose of Section 9(3) (a) is to keep free, basic shapes of goods that should be available for use by the public. Levi Strauss & Co. v. Imperial Online Services Pvt. Ltd., 2022/DHC/001222 Lilly ICOS LLC and Anr. v. Maiden Pharmaceuticals Ltd., 2009 (39) PTC 666 (Del.) Gorbatschow Wodka KG v. John Distilleries Ltd., 2011 (47) PTC 100 (Bom) Zippo Manufacturing Company v. Anil Moolchandani and Ors., CS(OS) 1355/2006 Ferrero Rocher v. Ruchi International, CS(COMM) 76/2018 ***Shape necessary to obtain a technical result***	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		This sub-clause prohibits registration where the shape of the goods is necessary to obtain a technical result, meaning a mark consisting exclusively of a shape is not registrable if its essential functional features are attributable only to the technical result. This does not automatically render a shape unregistrable merely because all its features serve some functional purpose; if an essential feature is not attributable only to a technical result, it will not be caught by Section 9(3)(b). Shapes which consist exclusively of functional features attributable only to the technical result are deemed incapable of acquiring distinctive character, and filing evidence will not overcome the objection. ***Shape which gives substantial value to the goods*** This subsection deals with shapes which add substantial value to the goods, disregarding the source-identification function of a trademark. The legal test for distinctiveness is the same for shape marks as for other marks, but recognition must be given to the fact that average consumers are not in the habit of making assumptions about the origin of products based on their shape or packaging shape, absent any graphic or word element. 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 distinctive character. The shape of packaging is to be treated as the shape of the goods themselves where the goods are traded in packaged form, for example beverages and cleaning fluids.	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.12.9	Concept	***Prohibition of registration of names of chemical elements or International Non-Proprietary Names*** **Under Section 13**, registration of a word which is the commonly used and accepted name of any single chemical element or compound, in respect of chemical substances or preparations, is prohibited. The law also prohibits registration of a word declared by the World Health Organization **(WHO)** and notified by the Registrar as an international non-proprietary name, or any word deceptively similar to such a name. This means that any word deceptively similar to a WHO non-proprietary name is also prohibited from registration; for example, the word **CYLOVIR** was refused as confusingly similar to the non-proprietary name **ACYCLOVIR**. This prohibition is only in respect of chemical elements or compounds, and does not extend to other goods. For example, the word "Radium" may be registered in respect of readymade garments or any services.	Section 13
2.13		**Draft for communication of objections to acceptance of application for registration, which are liable to be refused on absolute grounds**	
2.13.1	Office action	The Examiner shall communicate objections to acceptance of an application for registration, which are liable to be refused on absolute grounds, as far as applicable, as follows: *The mark applied for registration is liable to be refused registration under Section 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*	Rule 33(2)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		from those of another person, because it is a common surname/personal name/... *The mark applied for registration is liable to be refused registration under Section 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, value, geographical origin or the time of production of the goods or rendering of the service, or other characteristics of the goods or service.* *The mark applied for registration is liable to be refused registration under Section 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.* *The mark applied for registration is liable to be refused registration under Section 9(2) of the Trade Marks Act, 1999, as it is likely to deceive the public or cause confusion in the mind of the public; or it contains or comprises any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or it comprises or contains scandalous or obscene matter; or its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950); or the mark applied for registration is prohibited under the Central Government instructions issued under Section 23(1) of the Trade Marks Act, 1999.*	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		The mark applied for registration is liable to be refused registration under Section 9(3) of the Trade Marks Act, 1999, as it consists exclusively of the shape of goods which results from the nature of the goods themselves; or the shape of goods which is necessary to obtain a technical result; or the shape which gives substantial value to the goods. *The mark applied for registration is liable to be refused registration under Section 13 of the Trade Marks Act, 1999, as it is in respect of a chemical substance or chemical preparation, and it is the name of a chemical element or compound; or it is a word similar to the name of a chemical element or compound; or it is a word declared as an international non-proprietary name; or it is a word similar to an international non-proprietary name.*	
2.14		**Examination of series marks**	
2.14.1	Office action	In case an application has been filed on form TM- A 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.	
2.14.2	Concept	Where a person claiming to be the proprietor of several trademarks in respect of the same goods or services, which, while substantially resembling each other in their material particulars, 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.	Section 15(3)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Where a group of marks is applied for registration as a series in one registration, and the examiner does not consider any or some of them eligible for 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. 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.	
2.14.3	Office action	The Examiner shall communicate objections to acceptance of the application for series marks as follows: *The trademarks xxx, yyy applied for registration as series marks do not resemble the other remaining trademark(s) aaa, bbb mentioned in the application. You should therefore delete the trademarks xxx, yyy from the application by making a suitable request on form TM- M. You may, however, divide the application by making a suitable request on form TM-M.*	
2.15	Office action	**Proposing appropriate condition of acceptance of the application or limitation of use of the trademark**	
2.15.1	Concept	In case the examiner considers that the application may be accepted for registration subject to any condition or limitation, or that it may be proceeded with for advertisement subject to any condition or limitation, the examiner shall propose such condition or limitation in clear terms.	Section 18(4), Rule 33

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		Provided that the applicant shall be afforded a reasonable opportunity to contest, amend or comply with the proposed condition, restriction, limitation or disclaimer before any final determination is made. No condition, restriction, limitation or disclaimer shall be imposed without recording reasons in writing.	
2.15.2	Concept	Section 18(4) of the Trade Marks Act, 1999 states that, subject to the provisions of the 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. 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 observations, or apply for a hearing. Failure to do so within the prescribed period of one month (unless extended) will result in the application being deemed abandoned. Accordingly, if it appears to the examiner that the application, if accepted, should be accepted subject to any condition or limitation, the examiner should propose such condition or limitation in the Examination Report. In any situation, the condition proposed should not substantially alter the particulars of the trademark application; it should only confine the scope of registration to a limited extent. If the application can be accepted by slightly modifying the trademark without substantial alteration, or by confining/deleting some items in the specification of goods or services, the examiner should suggest such modification/deletion by filing a request on form TM-16, rather than proposing to accept or advertise the application subject to such condition. For example, the Examiner should not impose a condition such as	Section 18(4)

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		'the application may be accepted for registration subject to deleting the picture of an elephant appearing on the trademark'.	
2.15.3	Office action	***Variation condition governing the use of the mark*** *"In actual use of the mark, 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."*	Rule 35
2.15.4	Office action	***Blank space condition*** Where blank space appears in a label, the condition may read: *"The blank space appearing on the label shall be accepted only by way of matter that is wholly descriptive and non-trademark in character."*	
2.15.5	Office action	***Condition as to joint use*** In the case of a jointly owned trade mark, the condition should be: *"The mark shall be used jointly by all the applicants mentioned in the application", or* *"The mark shall be used only in relation to goods or services with which all the applicants mentioned in the application are connected in the course of trade, and it shall not be used against each other."*	Section 24
2.15.6	Office action	***Condition as to association*** *"The mark is associated with T.M. No. ……"*	Section 16
2.15.7	Office action	***Limitation as to area of use or mode of use***	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		"Bidis for sale in the states of ……" (or "except for sale in the state of ……"), or "Bidis solely for export."	
2.15.8	Office action	In case the use of the mark is limited to certain colours, the condition should be imposed as: *"The use of the mark is limited to the colours blue and red in stripes as appearing in the label."*	Section 10
2.15.9	Office action	***Condition as to disclaimer*** Since the provision for requiring a disclaimer has been omitted in the present Act, where the examiner considers that some condition should be imposed to clearly specify the rights of the proprietor, he may suitably word the condition as follows: *"Registration of the trademark shall give no right to the exclusive use of the word …… appearing in the mark."*	
2.16		**Communication of Examination report to the applicant**	
2.16.1	Office action	The Examiner shall prepare a consolidated examination report through the system, containing, as far as applicable: (i) all objections relating to formality requirements as to filing of the application; (ii) objections to acceptance of the application for registration of the trademark under Section 9, 11 and other Sections of the Trade Marks Act, 1999; and (iii) proposals for conditions of acceptance or limitation of use of the mark, in case the application is accepted for registration, and shall change the status of the application accordingly.	

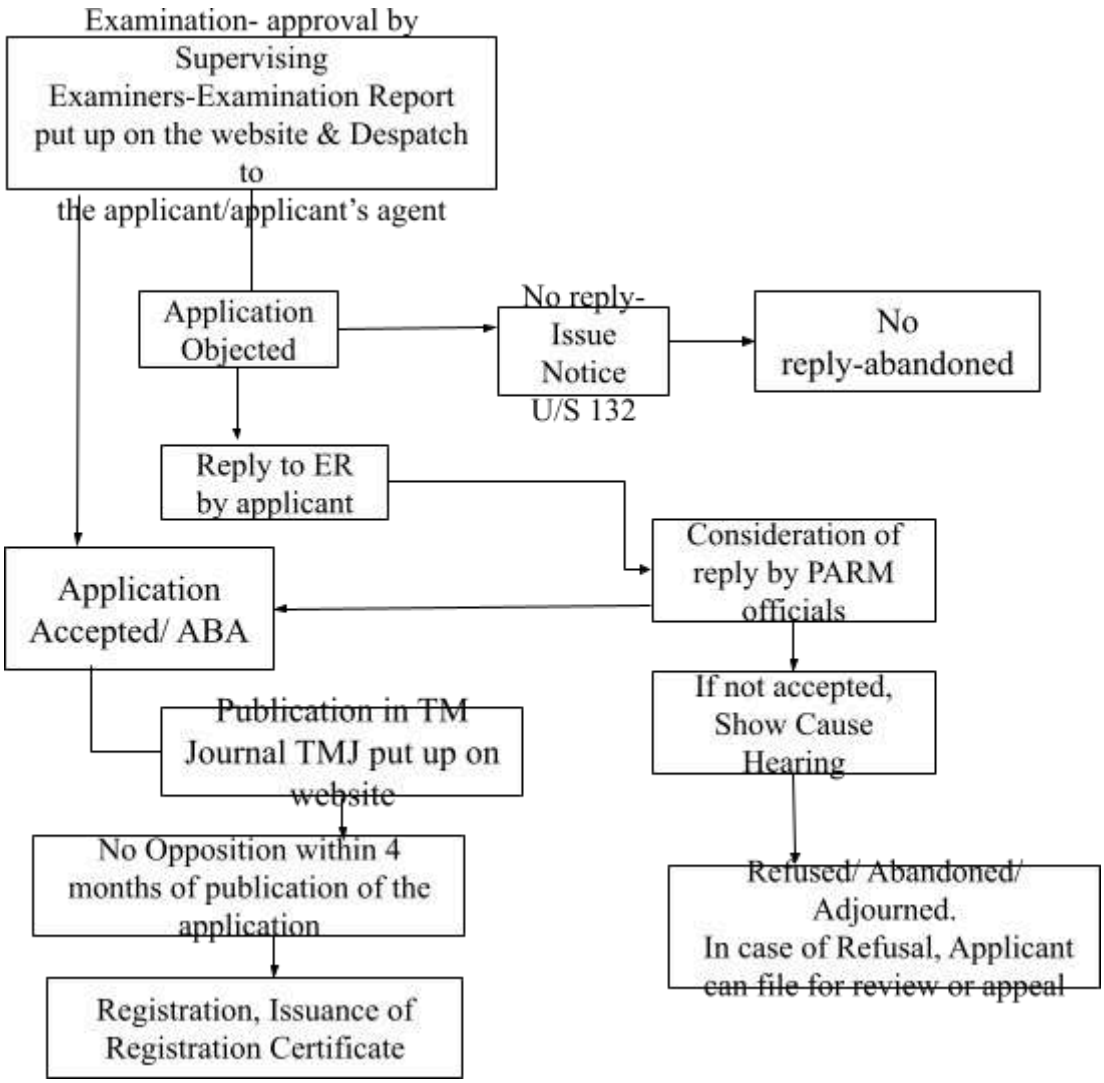
Sr. No.	Type	General Description	Relevant provision of the Act & Rules
2.16.2	Office action	The Examination report shall be transmitted to the Supervising Examiner through the system, who would either approve the Report or send it back to the Examiner for re-examination of the case, through the system, along with his clear remarks.	
2.16.3	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.	
2.16.4	Office action	In case the examination report is sent back to the Examiner for re-examination, the Examiner shall re-examine the application in light of the remarks of the Supervising Examiner and shall resend it to the Supervising Examiner through the system.	
2.16.5	Office action	All examination reports approved by the Supervising Examiner shall be released on the date of such approval and made available on the office website https://ipindia.gov.in with the status of the relevant application. The examination reports are also to be communicated by email to the applicant/agent. However, the examination reports in respect of applications examined expeditiously due to a request filed on form TM-M shall be released only after approval of the Supervising Controller and the overall in-charge of the EPR Section, who may also send back the case for re-examination, if required.	
2.16.6	Office action	The examination report so released shall be sent to the applicant, or his authorised agent, on the email address registered with this office.	
2.16.7	Office action	The examination report shall also be sent to the applicant, or his authorised agent, by post, unless a	

Sr. No.	Type	General Description	Relevant provision of the Act & Rules
		reply to the examination report on the basis of the report available on the website has already been received.	

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 a published application is received or if received, the same is disposed in favour of the applicant, the application is moved for registration.



The above 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
3.1		Consideration of applicant's reply to examination report	
3.1.2	Require ments 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).	
3.1.3	Require ments from the applicant	Mode of replying 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 through Comprehensive eFiling mode. 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. 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. The Reply to Examination Report may also be submitted at the Head Office/appropriate office of the Trade Marks Registry, personally or by post.	

		Any affidavit and supporting documents may also be submitted along with the Reply to Examination Report.	
3.1.4	Require ments from the applicant	In case of objections as to formality requirement(s), the applicant should comply with the requirements as desired by the office. The applicant may however submit to establish that as per the Trade Marks Act and Rules, the formality requirement(s) called for by the office are not necessary. For example, if the office has called for consent of the person whose portrait appears on the trademark, the applicant may state that the portrait appearing on the trademark is not of a particular person, but is a general picture of a man or woman.	
3.1.5	Require ments from the applicant	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 the classification of goods or services 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 on Form TM- M of the application by deleting items that do not fall in the relevant class. The applicant may however submit that as per the classification of goods or services published by the Registrar, all items fall in the class mentioned in the application.	
3.1.6	Require ments	In case of objections as to non distinctiveness of the trademark, the applicant's has to	

	from the applicant	submit a response to show 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.	
3.1.7	Require ments from the applicant	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, 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	
3.1.8	Office action	Once the reply to the 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 33 (4) to (8)
3.1.9	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 2017 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 condition(s) and impose limitation(s) as the case may be, depending upon the application, office objections and applicant's reply. 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" 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.	
3.1.10	Office action	In case an application for amendment/correction of the application on form TM-M is filed by the applicant, the designated officer shall at first dispose of the TM-M and communicate such orders via email to the Applicant's- agent and take appropriate action through the system and then take appropriate decision about the acceptability of the trademark for registration. In case the TM-M 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. In case the TM-M for amendment/correction of an application is Refused, in such a case, the order recording reason for the refusal should be recorded in the 'Correspondences and Notices' head in e-register.	
3.1.11	Office action	If the designated officer considers that even after the applicant's response the office's objections cannot be waived, he shall move	

		the case for hearing through the system.	
3.1.12	Concept	Under Section 3(1) of the Trade Marks Act 1999, the controller General of Patents, Designs and Trade Marks is the Registrar of Trade Marks 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. 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.	Section 3, 2
3.1.12		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)
3.1.13		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	Rule 33 (1) to (3)

		designated officer.	
3.2		**Treating the application as abandoned, if no reply to examination report is received**	
3.2.1	Office action	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. 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. 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. Prakash Corporates v. Dee Vee Projects Limited, Appeal No(s). 1318 of 2022;	Section 132 Rule 33(4)
3.2.2	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 applicant may or may be required to furnish, the Registrar has any objection to the acceptance of the application or proposes to	Rule 33(2), 33(4), 38(5) Section 132

		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. 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. 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.	
3.3		**Show Cause Hearing**	
3.3.1		In case the office objections to acceptance of the application for registration cannot be waived even after considering the applicant's response to the examination report, the matter is set down for hearing through the system. This hearing commonly known as show cause hearing is scheduled and conducted at the appropriate office of the Trade Marks Registry	
3.3.2		All matters set for hearing are automatically moved to TLA module of the Trade Marks System.	

3.3.3		The Show Cause Hearing section of the respective office of the TMR shall schedule hearing for all such cases in order of their seniority and as per availability of hearing officers.	
3.3.4		A hearing notice shall be sent to the applicant/agent/attorney concerned by email, intimating him about the application No & date of hearing. The hearing notice shall be sent approximately 30 days before the date of hearing. Disposafe Health and Life Care Limited v. Registrar of Trade Marks, C.A.(COMM.IPD-TM) 15/2024	
3.3.5		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	
3.3.6		After allocation of cases to specific hearing officers, the cause list with the name of the Hearing Officer shall be put up on the office website.	
3.3.7		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. Any other documents which need to be uploaded may be done by way of the option under Documents for Show cause Hearing by the Applicant.	
3.3.8		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 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 . Further in the hearing, the Hearing Officer should endeavour to communicate to the applicant or applicant's authorized agent if any further information/documents are required to pass an order (wherever expedient). In case the Hearing Officer wishes to reserve the order or adjourn the hearing to afford another opportunity to the applicants or applicant's authorized agent, the Hearing Officer should clearly inform the same to the applicants or applicant's authorized agent.	
3.3.9		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.	
3.3.10		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	
3.3.11		In case a request for amendment of application is made on form TM-M the Hearing Officer concerned shall dispose of 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.	

		In case the TM-M is allowed, amendment in the details of the application shall be incorporated accordingly by the Hearing Officer concerned and the case is considered taking into account the amendment.	
3.3.12	Concept	Applications for registration of trademarks are normally objected for registration on following main provisions of the Trademarks Act 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 governs provisions relating to association of trademarks.	
3.3.13		Section 9 (1) of the Act sets down the following absolute grounds for refusal of registration: It states that 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. **distinctive character** "The expression 'distinctive' in relation to goods in 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." **Acquired distinctiveness** 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.	
3.3.14		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 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 120 prescribes the manner in which the affidavits are to be executed. 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: 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." 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] Acquired distinctiveness cannot therefore be shown to exist solely 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.	
3.3.15		**Examination of evidence of use as a Trade Mark** In Windsurfing Chiemsee (C108&109/97)	

		[1999] ETMR 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." 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 extent and effect of the use. In this regard, ECJ provided guidance as follows: "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: 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". In the affidavit submitted as evidence of use of 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. The use of trademark must be before the date of filing. Any use after that date should not be taken into account. 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. 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 the affidavit. In case figures are not available for earlier years, the deponent should make a statement to this effect. 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. The words "acquired a distinctive character as a result of the use made of it" therefore mean the use made of the mark in relation to the goods/services for which it is proposed to	

		be registered 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 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 wouldlend 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". 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, prima facie, 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, prima facie, 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. Wherever the exclusive right to color is sought, weighty evidence should be necessary to overcome objection under Section 9(1)(a) of the Act. 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. **Sound marks** The law does not explicitly exclude "sound marks" from registration. Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words. To this end- 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 particular, a clef, musical notes and rests,	

		indicating relative value, and sharps, flats and naturals (accidentals). **Assessing distinctive character of sound marks:** 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. 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- • very simple pieces of music consisting only of only I or 2 notes; • songs commonly used as chimes: • well known popular music in respect of entertainment services, park services; • children's 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. **Smell trade marks** 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. 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. 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 of a trade mark for goods or services in paper form". 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. **Shape of goods** The expression "trade mark" is defined to mean "a mark capable of being represented graphically ……." and "may include shape of goods and their packaging". Section 9(3) provides that the trade mark shall not be registered if it consists exclusively of – 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 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 **"Shape which results from the nature of the goods"** The purpose of Section 9(3)(a) is to keep free basic shapes of goods that should be available for use by the public. **Section 9(3)(b)- Shape necessary to obtain a technical result".** This sub-clause prohibits registration as a trade mark where the shape of goods is necessary to obtain a technical result. 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 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. **Section 9(3)(c)- "Shape which gives**	

		substantive value to the goods". 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. 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". [Procter and Gamble v OHIM] In Procter and Gamble, 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 Henkel 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". 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. As European Court of Justice Ruled in the Henkel case for the purposes of Sections 9(1), 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. The shape of an ornamental lamp , for example would appear to add substantial value to the goods by making it attractive. This would attract objection under section 9(3)(c) and also 9(3)(a) **Three dimensional mark** With a view to distinguish a three dimensional representation from two dimensional marks depicting containers etc., Rule 25(12) mandates the applicant to make a specific statement in the application that the mark sought for registration is a three dimensional trade mark. As and when the mark is accepted and advertised, suitable entry to that effect will be made below the mark in the journal publication and later in the registration certificate, when the mark is registered. The requirement of distinctiveness for the three dimensional mark is the same as for other trademarks. However, besides distinctiveness, functionality aspect as per section 9(3) will also arise.	
3.3.16		**Overcoming objections as to Section 9 (2) and 13,** 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. 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-M, to avoid prohibitions. The TM-M then shall be disposed.	
3.3.17		**Overcoming objection regarding the relative grounds for refusal** Objections raised under Section 11 can be overcome by the applicant by : • removing the conflicting goods/services by way of amendment. • obtaining consent from the proprietor of the cited mark(s) under Section 11(4) • showing proof of executed co -existence agreement entered into with the proprietor of the cited mark . • filing evidence to establish honest concurrent use to secure registration under section 12; • By filing / 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. Kentucky Fried Chicken International Holding LLC v. The Registrar of Trademarks, Satilila Charitable Society v. Skyline Educational Institute; Vranjilal Manilal & Co v. Bansal Tobacco Co, (2001) PTC 99 (Del) **By removing the conflicting goods/services.** 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. 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. 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 providing electric supply in building premises". Or "Electric cables not for use in relation to speakers" **By obtaining consent from the proprietor of the cited mark(s)** 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 "special circumstances" Consent letter from the proprietor of the earlier mark must contain the following particulars: 1. Assertion of proprietorship over the same/similar trademark(s) by virtue of registration under particular N0(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. **Considering evidence to establish honest concurrent use** 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. If Hearing Officer is convinced that the applicant 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. **By dividing the application and allowing the objections-free apart of the application to proceed further** In the Trade Marks Act 1999, a facility for division of application is provided to the applicant. 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. A request to divide his application is made on behalf of the applicant, on form TM-M. 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. 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.	
3.3.18		**Attending to request made in form TM-M for change in the application details** A correction of any error in the application or any amendment in the application is permitted by the Trade Marks Act. An applicant for registration of a trade mark may, before the registration of the mark, apply in Form TM-M accompanied by the prescribed fee for the correction of any error in his application or any amendment of his application. 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, shall not be permitted in the name of correction. 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	Section 22 & Rule 41

		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.	
3.3.19	Office action	**Adjournment of hearing** 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.	
3.3.20	Office action	**Acceptance of the application** 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. In certain circumstances the application may be advertised before acceptance. The provision for Advertisement Before Acceptance, is invoked in "exceptional circumstances"	

		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"	
3.3.21	Office action	**Allowing division of the application** On a request made on form TM-M 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.	Proviso to Section 22 of the Trade Marks Act 1999 and Rule 108 of the Trade Marks Rules 2017
3.3.22	Office action	**Withdrawal of application** 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.	
3.3.23	Office action	**Refusal of application** 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.	
3.3.24	Office action	**Communication of decision** 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.	
3.3.25		**Communication of grounds of decision** On request made by the applicant on form TM-M 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.	Section 18(5)
3.3.26	Require ment 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 as application for adjournment as per the Trade Marks Act & Rules.	
3.3.27		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 Authorization of Agent in his favour along with a request on form TM-M to record his	
3.3.28		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 Authorisation of Agent and wants to prosecute the application himself, he should necessarily file an amendment application on form TM-M , for recordal of	
3.3.29		An application on form TM-M 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-M, which are still pending and should insist on their disposal.	
3.3.30		The applicant or applicant's authorised agent should file proper requests/application with proper fee in accordance with the Trade Marks Act & Rules.	
3.3.31		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 High court , as per relevant provisions of the Trade Marks Act & Rules	
3.4		**Publication of applications in the trademarks journal**	
3.4.1.1	Office action	When an application for registration of a trade mark has been accepted whether absolutely or	Section 20, Rule 39

		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. 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.	
3.4.1.2		The advertisement of application in the trademark journal should contain details of the 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.	
3.4.1.3		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.	
3.4.1.4		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.	
3.4.1.5		The trademark journal contains -	

		• 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	
3.4.1.6		Other matters to be published in the journal are collected from different Sections of the TMR.	
3.4.2		The Section 20 of the Trade Marks Act 1999 states that 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: 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 rea	

3.5		**Withdrawal of acceptance** 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.	
3.5.1.1	Office action	Where it is found that an application for registration of trademark has been accepted in error; or the trade mark should not be registered subject to conditions or limitations subject to which the application has been accepted; or 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, 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. 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 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.	

3.5.1.2		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.	
3.5.1.3		The Show Cause Hearing Section shall issue a notice under Rule 42 of the Trade Marks Rules 2017, 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
3.5.1.4		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.	
3.5.1.5		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.	
3.5.2	Concept	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. In such cases, rule 42 provides for the following procedure − 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	Section 19, Rule 38

		it had not been accepted	
3.5.3.1	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.	
3.5.3.2		On the said date of hearing, the Hearing Officer will pass such orders as he may deem fit under the Trade Marks Act & Rules.	
3.5.3.3		The Hearing officer shall accordingly move the application further through the System but putting his appropriate remarks.	
3.6		**Registration of trademarks**	
3.6.1.1	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.	
3.6.1.2		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.	
3.6.1.3		All such applications are taken up for registration process in order of seniority of their advertisement or re-advertisement in the trademarks journal.	
3.6.1.4		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.	
3.6.1.5		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 & 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. 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 Authorisation of Agent 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 the application shall proceed for registration only after compliance of requirements.	
3.6.2.1	Concepts	The Registrar of Trade Marks has a Register	Section 6

		of Trade Marks as mentioned in Section 6 of the Trade Marks Act 1999, which has all details of registered trademarks. Once a trademark is registered, it is entered in the Register or its entry is made on the Register.	
3.6.2.2		Under Section 23(1) of the Trade Marks Act 1999 when an application for registration of trade mark has been accepted and either- a) the application has not been opposed and the time for notice of opposition has expired; or b) the application has been opposed and the opposition has been disposed of in favour of the applicant, 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. 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 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.	Section 23
3.6.2.3		Rule 53 provides the manner as to how the entry in the Register of trademarks is made. Under this Rule 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. 2) The entry of a trade mark in the register shall specify the date of filing of application, the 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 – 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 subsection 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. The Registrar may from time to time, in consultation with computer experts, formulate guidelines for keeping official records in electronic form.	

Sr. No.		General Description	Relevant provision of the Act & Rules
4.1		**How an opposition proceeding can be started**	
4.1.1	Concept	**Introduction:** The Tribunal Section is constituted for dealing with contested matters- namely oppositions filed against applications for registration of trademarks, applications filed for rectification of trademarks, and other contested matters assigned to this section. This Chapter is divided into three Sections – Section A deals with Opposition Proceedings, Section B deals with Rectification Proceedings and Section C deals with proceedings related to review petitions. **Section A: Opposition** After advertisement of a trade mark in the Trade Marks Journal, section 21 (1) provides a period of 4 months within which registration of a trade mark may be opposed by any person. An opposition can be filed only before the Registrar. If the opposition is successful, the trade mark will be refused. If the opposition is dismissed, the mark will be registered. **How an opposition proceeding can be started** *Who may oppose the Application:* "Any person" may file a notice of opposition to the registration of a trade mark. Notes: The person filing the opposition need not have any commercial or personal interest in the matter or be a prior registered trade mark owner. Section 11(10) (ii) provides that in the opposition, the	Section 21 (1)

		Registrar shall take into account bad faith involved either of the Opponent and the Applicant affecting the right relating to the trademark.	
4.1.2	Concept	Grounds of opposition: Section 21 doesn't specify the grounds of opposition. However, an opposition is ordinarily based on any one or more of – - 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 11(4); objection U/s 18 (1) with regard to the proprietorship of the mark under opposition. - absence of honest concurrent use in section 12. Satilila Charitable Society v. Skyline Educational Institute; Vranjilal Manilal & Co v. Bansal Tobacco Co, (2001) PTC 99 (Del)	Section 9, 11, 13, 14 and 18(1)
4.1.3	Requirement from the Opponent	Limitation Period for filing Notice of opposition: Within four months from the date of advertisement or re-advertisement of an application for registration in the Trademarks Journal.	Section 21(1)
4.1.4	Requirement from the Opponent	Prescribed Form: Opposition required to be fined as per prescribed form i.e. TM-O	Section21(1) & Rule 42 (1)
4.1.5	Requirement from the Opponent	Prescribed Fee: To file an opposition against any advertised mark prescribed fee is Rs. 2700/- for online filing and Rs. 3000 for physical filing.	First Schedule entry No. 2 of the Trade Marks Rules 2017

4.1.6	Requirement from The Opponent	Place of filing: To be filed in the appropriate office (of application under opposition)	Rule 4 (1) of the Trade Marks Rules 2017 and Rule 4(A) and (B) of Trademark Rules 2017.

4.1.7	Requirement from the Opponent	Contents of TM-5: Notice of opposition to contain- (a) In respect of an application against which opposition is entered – (i) Impugned application no.; (ii) Indication of the goods or services in the trade mark application; and (iii) Name of the applicant for the trade mark sought to be opposed. (iv) Details regarding publication of the application opposed i.e. journal number, date of the Journal and the date on which the Journal was made available to the public. (v) Address of the applicant of the application opposed. (b) in respect of the earlier mark or the earlier right on which the opposition is based ,- (i) where the opposition is based on an earlier mark, a statement to that effect and an indication of the status of earlier mark along with the user details; (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-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; (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; (v) a representation of the mark of the opponent and where appropriate, a description of the mark or earlier right; and (vi) where the goods or services in respect of which earlier mark has been 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	Rule 43 (1) of the Trade Marks Rules 2017

		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 (iv) Where the opposing party has no place of business in India, the name of the opponents and his address for service in India.	
4.1.8	Requirement from the Opponent	Verification of the notice of opposition: The notice of opposition shall be verified at the foot by the opponent or by an authorized person who is acquainted with the facts of the case. 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. 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.	Rule 48 43(2), (3) & (4) of the Trade Marks Rules 2017
4.1.9	Requirement from the Opponent	Filing of counter statement by the applicant: The applicant shall file a counter statement in Form TM-6 at the appropriate office. The prescribed fee is Rs. Rs. 3000 for physical filing and Rs. 2700 for online filing. The limitation to file counter statement is within two months from the date of receipt of the copy of the notice of opposition. "The requirement of service of copy of the notice of opposition to the applicant shall be dispensed with if the applicant has already filed the counter statement on the basis of electronic records."	Section 21(2), Rule 44 & Entry 2 of First Schedule of the Trade Marks Rules 2017 Rule 43 (2) of the Trade Marks Rules 2017
4.1.10	Office Action	<u>Abandonment of application for not filing of counter Statement</u> 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	Section 21 (2) of the Trademarks Act 1999

		abandoned his application and an order to the effect shall be issued.	
4.2	Office Action	After receiving of the notice of opposition, the office required to check documents and other formalities its compliance with procedural formalities eg. filing of POA.	
4.2.1	Office Action	Formality Check The notice of opposition is received by the Trademarks Registry. The Trademarks Registry 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. The Tribunal Section shall attach the notice of opposition with physical file of the application opposed and arrange the same in order.	
4.2.2	Office Action	Service of notice of opposition upon the applicant: The entry as to the notice of opposition shall be made in the 'Tribunal' module of the Trade Marks Automation System (TMAS). 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 or its address for service by post or email. Coaster Shoes Company Pvt. Ltd. v. Registrar of Trade Marks, COM Misc. Petition No. 4309 of 2023	Section 21(2) of the Trademarks Act 1999 Rule 18

4.2.3	Office Action	Service of counter statement upon the opponent The entry as to the counter statement shall be made in the 'Tribunal' module of the Trade Marks Automation System (TMAS). 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 or its address for service by post or email within two months of the receipt of the counter statement.	Section 21 (3) of the Trademarks Act 1999 Rule 44(1)
4.3	Requirement from the Applicant/ Opponent in respect of Evidence	<u>Mode of evidence</u> Evidence to be given on affidavits. The Registrar may, in his discretion, allow oral evidence also. Affidavits The Affidavits shall – -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. Every affidavit shall – - 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. 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.	Section 129 of the Trade Marks Act, 1999
4.3.1		Affidavits shall be taken - - in India, before any court or person having by law authority to receive evidence, or before any officer empowered by to administer oaths or to take affidavits; - in any country or place outside India, before a	Rule 120 of The Trade Marks Rules 2017

		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. 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 office to which he is attached thereto and sign his name and description at the end thereof. 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. 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.	
4.3.2	Requirement from the Opponent	Filing evidence in support of opposition: Any evidence in support of opposition must be filed within two months from the date of receipt of a copy of the counterstatement. 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. The copies of any evidence including Exhibits filed or a letter relying on the contents of notice of opposition by the opponent must be delivered by him to the applicant and a written intimation thereof must be given to the Registrar.	Rule 45 (1) of the Trade Marks Rules 2017

4.3.3	Office Action	Abandonment of opposition for not filing of evidence in support of opposition/intimating reliance on the facts stated in the notice: 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.	Rule 45 (2) of the Trade Marks Rules 2017
4.3.4	Requirements From The Applicant	<u>Filing evidence in support of application:</u> 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. 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. The copies of any evidence including exhibits filed or a letter relying on the contents of counter statement relied upon by the applicant must be delivered by the applicant to the opponent and a written intimation thereof must be given to the Registrar	Rule 46 of the Trade Marks Rules 2017
4.3.5	Requirement from the Applicant	<u>Filing evidence in reply by opponent:</u> 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. The copies of evidence in reply, if any filed, must be delivered by the opponent to the applicant and	Rule 47 of the Trade Marks Rules 2017

		intimate the Registrar about delivery in writing.	
4.3.6	Requirement from the Applicant/ Opponent in respect of Evidence	<u>Filing of further evidence</u> 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. Note: Further evidence may be filed by filing an Interlocutory Petition (IP) with fee of Rs. 2700/- for online filing and Rs. 3000 for physical filing. Copies of IP and all supporting documents must be served on the other party and an acknowledgement or proof of delivery be obtained. 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. 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.	Rule 48 of The Trade Marks Rules 2017; entry 15 of First Schedule of Trade Marks Rules, 2017
4.3.7	Requirement from the Applicant/ Opponent	<u>Translation of documents</u> 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.	Rule 49 of the Trade Marks Rules 2017
4.3.8	Requirement from the Applicant/ Opponent	<u>Request for Extension of time:</u> An application for extension of time under section 131 shall be made in Form TM-M with fee of Rs. 1000/. for physical filing and Rs. 900 for online filing 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	Section 131 of the Trade Marks Act 1999 and Rule −109 of the Trade Marks Rules 2017

		time expressly provided in this Act), or prescribed by Rule 85 or by sub rule (3) of Rule 86 or a time for the extension of which provision is made in the Rules 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.	
4.3.9	Office Action	<u>Digitization of record</u> The notice of opposition, 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 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.	
4.4	Office Action in Respect of Hearing	**Fixing Hearing of cases:** After completion of the formality check and submission of the evidence, hearing is fixed to represent their cases by the opponent as well as the applicant.	Rule 50 (1) of the Trade Marks Rules 2017
4.4.1	Office Action	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. The date of hearing shall be for a date at least one month after the date of the first notice. 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. The hearing will be conducted by the Hearing Officer as per the cause list.	Rule 50(1) of the Trade Marks Rules 2017

4.4.2	Office Action	Adjournment/ Abandonment of application for nonappearance at the date of hearing A party to a proceeding may make a request for adjournment of the hearing with reasonable cause in Form TM-M, at least three days before the date of hearing and the Registrar, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly: Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days. If the applicant is not present on the adjourned date of hearing the application may be treated as abandoned under Rule 50(3).	Rule 50 (24) and 50(3) of the Trade Marks Rules 2017
4.4.3	Office Action	Adjournment/Dismissal of opposition on non appearance at the date of hearing: In case the opponent is not present on the adjourned date of hearing, the opposition may be dismissed for want of prosecution under Rule 50(4). No party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.	Rule 50(2) and 50(4) of the Trade Marks Rules 2017
4.4.4	Requirement from the Applicant/ Opponent in respect of Adjournment	Request for adjournment of hearing: A request for adjournment of hearing mentioning the reasonable cause shall be made in Form TM-M with fee of Rs. 1000 for physical filing and Rs. 900 for online filing	Rule 50(2) of Trademarks Rules, 2017
4.4.5	Requirement from the Applicant/ Opponent in respect of	Correction of error or amendment: 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. Substantial amendments shall not be allowed. A request for correction of error in or in connection	Section 21 (7) of the Trade Marks Act 1999 Section 22 of the Trade

	Amendment	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. Any request for amendment shall be filed on form TM-M with a fee of Rs. 1000 for physical filing and Rs. 900 for online filing/-. For division of a multiclass application, request shall be filed on form TM M with fee of Rs 1000/- for physical filing or Rs. 900 for online filing and the divisional fee of Rs. 2000 for physical filing or Rs. 1800 for online filing shall be paid as per number of additional classes being created out of this TM-M. A new class with new items of goods/services is not permissible. Note: 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. 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.	Marks Act 1999;
4.4.6	Office Action	Decision in the matter On the date fixed for hearing the Hearing officer shall hear the submissions of the parties. In case any party desires to file written arguments, the Hearing Officer shall allow the same to be taken on record. 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. 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	Rule 50(1), 50(5) of the Trademark Rules 2017 Rule 50(6) of the Trademark Rules , 2017

		opposition & application opposed shall be updated accordingly.	

Section B: Rectification of Register

Sr. No.		General Description	Relevant provision of the Act & Rules
4.5	B.	A request may be filed before (the Registrar or the High Court) for rectification of register by removing the mark for non-use/registration wrongly remaining on the Register under sections 47, 57 or 58 for rectification of/ correction of register.	
4.5.1		Who may apply for Rectification of a registered Trade Marks	
4.5.1.1	**Concept**	Who may file a rectification Petition Any aggrieved person may make an application before the Registrar of trademarks or before High Court, 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. S. Syed Mohideen v. P. Sulochana Bai, MANU/SC/0576/2015; M/s R. J. Components and Shafts v. M/s Deepak Industries Limited, 2017 (72) PTC 455 (Del); Sancheti Appliances Pvt. Ltd. v. D.K. Electricals, 2011 (45) PTC 553 (Del) Aforesaid rectification of register may arise out of the following procedures under the Trade Marks Act 1999 Under Section 47, a registered trade mark may be	Section 47, 57, 58, 59, 60, 68, 77 of the Trade Marks Act

		taken off the register in respect of the goods or services in respect of which it is registered on application by any person aggrieved on the ground either-	

		(i) that the trade mark was registered without any bona fide intention to use and there has been no bona fide use of the trade mark in relation to those goods or services up to a date three months before the date of the application (ii) a trade mark which has not been used for continuous period of five years and three months from the date on which the trade mark is actually entered in the register either completely or in respect of those goods or services for which the mark has not been in use. (iii) Under Section 57(1) & (2) a "person aggrieved" may make an application for cancelling or varying the registration of a trade mark on the ground of any contravention or failure to observe the condition entered on the register or absence or omission from the register any entry or any entry made in the register without sufficient cause, or any entry wrongly remaining on the register, or any error or defect in any entry in the register. (iv) Under Section 68 a "person aggrieved" may make an application for removing the registration of a collective trade mark (v) Under Section 77 a "person aggrieved" may make an application for cancellation or for varying the registration of a certification trade mark (vi) The Registrar or High Court of its own motion after giving a notice to the parties concerned and giving them an opportunity of hearing, make any order for cancellation or varying a registration and rectify the register as above. – Section 57(4) (vii) 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 of the registered proprietor 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 on 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. (viii) Alteration of the registered trade mark upon application by the registered proprietor– section 59 (ix) Change of classification of goods to align with any revised classification –section 60 An application for removal of the registered trademark or for cancelling or varying the registered trademark and for rectification of the Register of trademarks under Section 47 or 57 are made by an ***aggrieved person*** ordinarily.. These applications are contested matters and the Tribunal Section deals with such matters. ***Person aggrieved :*** "persons who are aggrieved are persons who are in some way or the other substantially interested in having the mark removed from the register or persons who would be substantially affected if the impugned registration remains on the Register	

4.5.1.2	**Requirement from the Applicant** **Office Action**	Application for rectification of register where the validity of registration is questioned Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of section 30 or where in any such suit the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in section 47 or section 57, such application shall be made to the High Court and not to the Registrar . Subject to the provisions of section 125(1) , where an application for rectification of the register is made to the Registrar under sections 47 or 57, the Registrar may refer the application at any stage of the proceedings to the High Court.	Section 125 of theTrade Marks Act 1999
4.5.1.3	**Concept**	Removal of registered trademark for non use, under Section 47 The application for this purpose may be made on either of the following grounds: (a) the trade mark was registered without any bonafide intention that it should be used in relation to those goods/services, and that there has in fact been no bonafide use of the trade mark in relation to those goods or services by any proprietor thereof upto a date three months before the date of application, or (b) A continuous period of five years from the actual date of registration of a trademark or longer has elapsed	Section 46, 47(3) of the Trade Marks Act 1999

		during which there was no bonafide use thereof in relation to those goods or services by any proprietor thereof up to three months before the date of application. "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" 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 However the registration may not be removed under this Section if (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 with a view to the use thereof in relation to those goods or services by the company; or (b) Proprietor intends it to be used by a person to be registered as the registered user, after the registration of the mark. (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. Partial removal of a registered trademark 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 registration shall cease to	

		extend to such use. If the registration of a trade mark covered a wide 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. Hardie Trading Ltd. v. Addisons Paint & Chemicals Ltd., (2003) 11 SCC 92; Cadila Pharmaceuticals Limited v. Sami Khatib, 2011 (47) PTC 69 [Bom (DB)]; Hindware Ltd. v. Grohe India Pvt Ltd & Ors., 2026 DHC 14614; Excitel (P) Ltd. v. Registrar of Trade Marks, 2022 SCC OnLine Del 2097 American Home Products Corporation v. Mac. Laboratories (P) Ltd.; Glaxo Group Ltd and Anr v. Paun and Paum Chemicals, 106 (2003) DLP 176 (Bom); Pioneer Nuts and Bolts (P) Ltd. v. Goodwill Enterprises, 2009 SCC OnLine Del 2851; Revlon Inc. v. Sarita Manufacturing Company, AIR 1998 Delhi 38; Reed Elsevier Properties Inc. v. Best Media Associates (India) (P) Ltd., 2009 SCC OnLine Bom 1742; Durian Industries Ltd. v. Pankaj Rao & Anr, CS(OS) 2609/2011;	

4.5.1.4	**Concept**	<u>Canceling or varying the registration of a trade mark under Section 57 (1)& (2)</u> 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 conditions entered on the register or absence or omission from the register any entry or any entry made in the register without sufficient cause, or any entry walrongly remaining on the register, or any error or defect in any entry in the register. contravention or failure to observe a condition "Contravention or 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). <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. <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	Section 57 (1) & (2) of the Trade Marks Act 1999

		Trademarks Act or the Rules, the registration may be challenged as entry "made without sufficient Cause" wrongly remaining on the register The existence of a registered trademark or its entry on the register can be challenged, if it is established that the registration of trademark continues to exist erroneously. The relevant date in such cases is the date of application for rectification. 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. Neon Laboratories v. Thermis Medicare Ltd., (2014) 60 PTC 621 (Bom); Raman Kwatra & Anr. v. M/s. KEI Industries Limited, FAO (OS)(COMM) 172/2022; Armour, Inc v. Aditya Birla Fashion & Retail Ltd., CS(COMM) 41/2023	
4.5.1.5	Concept	Additional grounds for removal of registration of collective mark The registration of a collective mark may also be removed from the register on the ground- (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 (b) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.	Section 68 of the Trade Marks Act 1999

		Note: "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.	
4.5.1.6	Concept	<u>Cancellation or varying of registration of certification trade marks</u> on the application of any aggrieved person and after giving the registered proprietor an opportunity of opposing the application, an order for expungingor varying any entry in the register to a certification trade mark, or for varying the regulations may be passed by the Regitrar, on any of the following grounds, namely:- (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; (b) that the proprietor has failed to observe any provisions of the regulations to be observed on his part; (c) that it is no longer to the public advantage that the mark should remain registered; (d) that it is requisite for the public advantage that if the mark remains registered, the regulations should be varied.	
4.5.1.7	Requirement from the applicant	<u>Filing application for rectification of register</u> An application under Section 47, 57, 68 or 77 for the making, expunging or varying of any entry relating to a trade mark or a collective mark or certification trade mark, in the register shall be made in Form TM-O ,and shall be accompanied by statement 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	Rule 97 of the Trade Marks Rules 2017

		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 left at the Trade Marks Registry. In case there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered users. 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.	
4.5.1.8	Requirement from the Registered Proprietor	<u>Further procedure</u> 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-O 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 46 to 51 of the Trade Marks Rules 2017 shall thereafter apply mutatis mutandis to the further proceedings on the application for rectification. In any case of doubt any party may apply to the Registrar for directions.	
4.5.1.9	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, shallbe followed.	
4.5.1.10	Office Action	Digitization: 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.	
4.5.1.11	Office Action	<u>rectification of register of trademarks by Tribunal "of its motion under Section 57(4)</u> 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.	Section 57(4) of the Trade Marks Act 1999
4.5.1.12	Office Action	<u>Procedure for rectification of register of trademarks by Tribunal under Section 57(4)</u> 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 Trademarks 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. No notice shall be required to be sent to the registered proprietor in case the registered proprietor has requested or agreed in writing for cancellation of registration 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. 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. On the date fixed for hearing, the hearing officer shall hear the submissions of the parties present and peruse the records.	Rule 100 of the Trade Marks Rules 2017

		The Hearing Officer shall dispose of the notice under Section 57(4) in accordance with the law by giving the grounds of his decision. The decision of the Hearing Officer shall be communicated to the parties concerned. 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.	
4.5.1.13	Office Action	<u>Digitization</u> The notice issued under section 57(4) for rectification of the register, the reply to 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.	

Chapter 05

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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**
5.1	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 2017.	Section 22, Rule 37
5.1.2	Requirement from the Applicant	An applicant for the registration of the Trademark may, before the registration of the trade mark, apply in TM-M accompanied by prescribed fee and supporting document, if required,for correction of any errors in his application of amendment in the application. In the event such an application for amendment in the application is being filed in an opposed application, the Applicant shall serve a copy of the Form TM-M and supporting document, if any with the Opponent.	
5.1.3	Office Action	The section in charge shall ensure that the offline requests made on form TM-M 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. The section in charge shall also ensure that such changes are also reflected in the Opposition	

Sr. No.		General Description	Relevant provision of the Act & Rules
		module in cases where the application is under opposition.	
5.1.4	Concept	This provision is made for correction of mere clerical errors in the application. No request for correction / amendment shall be allowed which seeks substantial alteration in the application for registration of trade mark. Any amendment in the applied Trademark which may be considered as substantial alteration, be it in the 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 the following can be allowed: a) request for amendment in the proprietorship of the trade mark on the basis of valid assignment or transmission; b) change in name of the applicant c) change in name or address of the applicant or in the address for service, d) deletion or confinement of any item in the specification of goods/services; e) confinement/limitation in the area of sales of goods/services; f) division of multiclass application, etc. g) request for amendment of the statement of use, including amendment of the user date, may be considered on a case-to-case basis upon examination of the facts and circumstances of the case and supporting documentary evidence filed along with an affidavit. Such a request shall not be allowed as a matter of course and the Registrar shall satisfy himself that the request is bona fide and not intended to overcome	

Sr. No.		General Description	Relevant provision of the Act & Rules
		objections or otherwise abuse the amendment procedure. Titan Industries Limited v. Registrar Of Trade Marks And Anr., 2007 (34) PTC 346 (IPAB); h) Change in the trade mark by way of deletion of the ® symbol or the word REGD/REGISTERED; i) Replace a label mark with a mark limited to the distinctive element consisting of a word per se where the mark is proposed to be used.	
5.1.5	Office Action	The officer assigned this work shall allow / refuse the request for correction / amendment made on Form TM-M 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. The officer assigned shall consider certified true copies, certified extracts, notarized true copies of supporting documents in lieu of relevant to the request while allowing/refusing the request for correction/amendment. 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 after considering the comments of the Opponent, if any, though the same shall be given effect in the system by the PRAS section. In the event, the officer assigned/hearing officer does not permit but rejects a request which has been made on Form TM-M, the same should be intimated to the Applicant or its authorised agent along with the reason for such rejection. In case of any amendment to the user date in an application which is yet to be advertised, if required, the application may be re-advertised. In case of any	

Sr. No.		General Description	Relevant provision of the Act & Rules
		amendment to the mark which in the opinion of the Officer requires re-examination of the application the application shall be marked for re-examination.	
5.1.6	Office Action	**<u>Request for correction of Data Entry Errors</u>**	
		All efforts should be made to avoid data entry errors and correct them based on Form TM A when such data entry errors come to the notice of an officer or upon request by the Applicant/Agent on record. 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.	
5.1.7		**<u>Correction of Data after Advertisement</u>**	
	Office action	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. In case errors complained of not digitized section in-charge shall forward the matter to EDP for digitization	

Sr. No.		General Description	Relevant provision of the Act & Rules
5.1.8		**Issuance of Corrigenda or notification or re-advertisement**	
	Office action	In case of error/s in advertisement considered to be clerical, a corrigendum is published. 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), 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.	
5.1.9		**Correction in the Registration Certificate**	
	Office action	On receipt of complaint regarding erroneous registration certificate, the section in charge shall examine the contents of the grievances on the basis of relevant documents and if the complaint filed is genuine, he/she shall take back the original registration certificate from the applicant / complainant, and will correct the data entry errors by putting his/her remark in the system. 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 while uploading a soft copy of the same on the e-register. 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	

Sr. No.		General Description	Relevant provision of the Act & Rules
		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.	

2. <u>Division of Applications</u>

Sr. No.		General Description	Relevant provision of the Act & Rules
5.2	**Concept**	In the Trade Marks Act 1999, a facility for division of application is provided to the applicant. 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.	Proviso to Section 22, Rule 108
5.2.1	Requirement from the Applicant	An applicant is required to file request for dividing his multi class application in to more than one application as per prescribed form i.e. Form TM-M, and fee.	
5.2.2	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 06

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Renewal, Assignment/Transmission, Registered User and Post-Registration Changes

This chapter deals with renewals, restorations, and 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 the above purposes.

Section 1: Renewal of Trademarks

Sr. No.		General Description	Relevant provision of the Act & Rules
6.1		**Renewal of trademark(s)**	
6.1.1	Concept	**Date of registration & period of registration:** For the purposes of renewal, the effective date of registration is the date of making of the application. The registration of a trade mark is valid for a period of ten years from the date of registration which may be renewed from time to time in accordance with the provisions of the Trade Marks Act & Rules. S. Syed Mohideen v. P. Sulochana Bai, MANU/SC/0576/2015; M/s R. J. Components and Shafts v. M/s Deepak Industries Limited, 2017 (72) PTC 455 (Del); Sancheti Appliances Pvt. Ltd. v. D.K. Electricals, 2011 (45) PTC 553 (Del)	Section 23(1) & 25(1) of the Trade Marks Act, 1999
6.1.2	Office Action	**Prior notice as to renewal of trademarks:** The office shall send a notice to the registered proprietor on Form RG-3 intimating the approaching expiration of the registration of the trade mark and the conditions as to the renewal of the trade mark.	Section 25(3) of the Trade Marks Act, 1999

Sr. No.		General Description	Relevant provision of the Act & Rules
		The RG-3 notice shall be electronically generated from the Trade Mark Automation System (TMAS) and dispatched by registered post and by email communication to the address for service, 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 the last renewal of the trade mark.	Rule 58 of the Trade Marks Rules, 2017
6.1.3	Requirement from the applicant	**Application for renewal:** An application for renewal of registration of trade mark shall be made on Form TM-R at the appropriate office or Head Office of the Trade Marks Registry, at any time not more than one year before the expiration of the last registration of the trade mark. Where the registration of a trade mark takes more than 10 years, namely after the first renewal date, the application for renewal may be made within the period of six months from the actual date of registration.	Rule 57(1) of the Trade Marks Rules, 2017 Rule 58(3) of the Trade Marks Rules, 2017
6.1.5	Requirement from the applicant	**Prescribed fee for renewal:** For the renewal of registration of a trade mark in a class before the expiration of last registration - Rs. 9,000/- for online filing and 10,000 for physical filing. For the renewal of registration of a trade mark consisting of a series of trade marks - Rs. 9000/- for online filing and 10,000 for physical filing. For the renewal of registration of a trade mark in respect of goods or services falling in more than one class (multiclass application) - Rs. 9,000/- for online filing and 10,000 for physical filing. For the renewal of registration of a collective trade mark/certification trade mark - Rs. 9,000/- for online filing and 10,000 for physical filing.	Item No. 3, 4 and 5 of the Schedule - I of Trade Mark Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
6.1.6	Requirementfrom the applicant	**Renewal after expiration of last registration:** 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. 4,500/- for online filing and Rs. 5000/- for physical filing on Form TM-R.	Proviso to Section 25(3) of the Trade Marks Act, 1999 and Proviso to Rule 59 of the Trade Marks Rules, 2017 Item No. 4 of the Schedule - I of Trade Mark Rules, 2017.
6.1.7	Office Action	**Removal & restoration:** 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 the register. The Registrar has the power to restore the trademark, provided an application for restoration is made on Form TM-R with the prescribed fee of INR 10,000 (for physical filing) and INR 9,000 (for online filing) in addition to the renewal fee, accompanied by a renewal application with the prescribed fee and surcharge within one year from the expiration of last registration. 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. In case no request for the renewal of registration has been filed on behalf of the registered proprietor even up to one year after expiration of last registration of the trade mark,	Section 25(4) of the Trade Marks Act, 1999; Rule 57(1) and 60 of the Trade Marks Rules, 2017

Sr. No.		General Description	Relevant provision of the Act & Rules
		the trade mark will be removed from the Register since the date of expiration of its last registration irrespective of the ctual date of removal.	
6.1.8	Office Action	All requests for renewal filed on Form TM-R, payment of surcharge, and requests for restoration filed on Form TM-R, and other documents submitted along with such requests shall be scanned and uploaded in the system. The requests for renewal and/or restoration shall be processed through the 'Renewal' module of the Trade Mark Automated System and as per the provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2017. 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. The intimation as to the renewal will be generated from the system accordingly and sent to the applicant. All renewals done through the system shall be sent through the system for publication in the Trade Marks Journal. In case of any objection to the renewal of a registered 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 to the query letter is received. Any such response can be submitted electronically through online server and would be reflected in the online records of the Trade Marks Office. In case of removal of trademark(s) for non-payment of renewal fees, a letter notifying the removal of the trade mark shall be sent to the registered proprietor by post or email communication to the address for service, in accordance with Rule 18(1) of the Trade Marks Rules, 2017, and all removals done during a particular period shall be sent through the system for publication in the Trade Marks Journal.	Rule 57 and 58(1) of the Trade Marks Rules, 2017

Section 2: Assignment & Transmission of a Registered Trademark

Sr. No.		General Description	Relevant provision of the Act & Rules
6.2		**Assignment & Transmission of a Registered Trademark**	
6.2.1	Concept	**<u>Assignment & transmission:</u>** Assignment or transmission of a trade mark refers to the process by which proprietorship of a registered trade mark, or a trade mark whose registration is being sought, is passed from one party to another / devolves upon another party, as the case may be. 1. The right of the registered proprietor to assign a trade mark for any consideration, monetary or otherwise, is recognised. 2. A registered trade mark is assignable or transmissible, with or without the goodwill, in respect of all goods/services or some only of the goods/services for which the mark is registered. 3. An important change introduced by the Trade Marks Act 1999 is that it enables an unregistered trade mark to be assigned or transmitted with or without the goodwill of the business. 4. 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 a territorial basis and creating right in different persons in different parts of India. However, the Registrar of Trade Marks is empowered to approve such an assignment where he is satisfied that it would not be contrary to public interest. 5. Where there is an assignment without goodwill of business, it will not take effect	Section 37, 38, 39, 41, 42, 43, 44, 45 and Rule 75 of the Trade Marks Rules 2017

Sr. No.		General Description	Relevant provision of the Act & Rules
		unless the assignor obtains directions of the Registrar of Trade Marks and advertises the Assignment as per directions. 6. Assignment of a certification trade mark can only be done with the consent of the Registrar of Trade Marks. 7. Associated trademarks will have to be assigned together. 8. 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. 9. 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.	
6.2.2	Requirement from the Registered Proprietor	**Who can assign:** Registered proprietor of subsisting trademarks can assign his trademarks to subsequent users.	Section 37 of the Trade Marks Act 1999
6.2.3	Requirement from the subsequent Proprietor	**What can be assigned/transmitted:** Any registered trade mark can be assigned or transmitted with or without goodwill.	Section 38 of the Trade Marks Act 1999
6.2.4	Requirement from the Subsequent Proprietor	**Registration of assignments and transmissions:** Any person who becomes entitled by assignment or transmission to a registered trademark should apply for registration of	Section 45(1) of the Trade Marks Act 1999

Sr. No.		General Description	Relevant provision of the Act & Rules
		the assignment/transmission, as the case may be, in the prescribed manner.	
6.2.5	Requirement from the Subsequent Proprietor	**Prescribed form(s):** 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-P.	Rule 75 of the Trade Marks Rules 2017
6.2.6	Requirement from the Subsequent Proprietor	**Prescribed fee for TM-P:** On application to register a subsequent proprietor in a case of assignment or transfer of a single trade mark: 1. If made within six months from the date of acquisition of proprietorship - Rs. 5,000/-. 2. If made after expiration of six months but before 12 months from the date of acquisition of proprietorship - Rs. 7,500/-. 3. If made after 12 months from the 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, where the devolution of title is the same in each case: 1. If made within six months from the date of acquisition of proprietorship: for the first mark - Rs. 5,000/-; for every additional mark - Rs. 1,000/-. 2. If made after expiration of six months but before twelve months from the date of acquisition of proprietorship: for the first mark - Rs. 7,500/-; for every additional mark - Rs. 1,500/-.	Item No. 6, 7, 8 and 9 of the Schedule - I of Trade Mark Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		3. If made after expiration of twelve months from the date of acquisition of proprietorship: for the first mark - Rs. 10,000/-; for every additional mark - Rs. 2,000/-.	
6.2.7	Requirement from the Subsequent Proprietor	**Contents of application:** The 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: (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.	Rule 81 of the Trade Marks Rules 2017
6.2.8	Requirement from the Subsequent Proprietor	**Documents required:** Original or duly certified copy of the instrument or deed of title along with a statement of case. 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-P, if the Registrar so requires.	Rule 76(1) of the Trade Marks Rules 2017
6.2.9	Requirement from the Subsequent Proprietor	**Requirement of directions of Registrar in case of assignment without goodwill:** Assignment of trademark(s) without goodwill shall not take effect unless the assignee, not later than the expiration of six	Section 42 of the Trade Marks Act 1999; Rule 80(1) of the Trade Marks Rules 2017

Sr. No.		General Description	Relevant provision of the Act & Rules
		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 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.	Rule 81(b) of the Trade Marks Rules 2017
6.2.10	Requirement from the Subsequent Proprietor	**Prescribed form(s) for request for direction/extension:** The application for directions of the Registrar of Trade Marks shall be made in Form TM-P and it shall state the date on which the assignment was made. 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. The Registrar may call for any evidence or further information. A request for an extension of the period, within which the application for Registrar's	Section 42 of the Trade Marks Act 1999; Rule 80(1) and (3) of the Trade Marks Rules 2017

Sr. No.		General Description	Relevant provision of the Act & Rules
		direction may be made, shall be made in Form TM-P.	
6.2.11	Concept	**<u>Restrictions against creation of multiple exclusive rights:</u>** 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. 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.	Sections 40 & 41 of the Trade Marks Act 1999
6.2.12	Requirement from the Subsequent Proprietor Office Action	**<u>Registrar's certificate/notification of approval in cases of multiple exclusive rights:</u>** The proprietor of a registered trade mark who proposes to make such assignment shall make an application on Form TM-P together with a statement of case setting out the circumstance and a copy of any instrument or proposed instrument effecting the assignment or transmission. A written approval or disapproval of the proposed assignment will be given after hearing the applicant & any other person considered to be interested in the transfer. Where an approval has been given, application for registration of the title is to	Rule 83 of the Trade Marks Rules 2017

Sr. No.		General Description	Relevant provision of the Act & Rules
		be made within six months from the date of approval.	
6.2.13	Requirement from the Subsequent Proprietor	**Registrar's consent in cases of assignment/transmission of certification trademark:** Certification trademarks can be assigned only after the consent of the Registrar is obtained thereafter follows the normal process for assignment. The application for consent must be made on form TM-P.	Rule 141(2) of the Trade Marks Rules 2017
6.2.14	Requirement from the Subsequent Proprietor	**Prescribed fee for TM-P:** Fee for TM-P: for the first mark - Rs. 2,500/-; for every additional mark - Rs. 500/-. Fee for TM-P for direction of the Registrar for advertisement of assignment without goodwill of trademark in use in respect of devolution of title- Not exceeding one month - Rs. 500/-; not exceeding two months - Rs. 1,000/-; not exceeding three months - Rs. 1,500/-. Fee for TM-P - Rs. 1,000/-.	Item No. 6, 7, 8 and 9 of the Schedule - I of Trade Mark Rules, 2017
6.2.15	Office Action	**Disputes regarding assignment/ transmission:** In case of dispute between the parties as to the validity of the 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.	Section 45(3) of the Trade Marks Act 1999
6.2.16	Office Action	All requests for the recordal of assignment/transmission and other	

Sr. No.		General Description	Relevant provision of the Act & Rules
		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 shall be digitized by A&R Section. The data entry of a request for Recordal of assignment/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 provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2017. The Officer-in-Charge of the A&R Section while disposing of the aforesaid requests shall take into account the following facts: 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.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	

Sr. No.		General Description	Relevant provision of the Act & Rules
		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. 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. 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.	

Section 3: Registered Users

Sr. No.		General Description	Relevant provision of the Act & Rules
6.3		**Registered Users**	
6.3.1	Concept	**Permitted use of a trademark -**	Section 2(1)(r) of the Trade Marks Act 1999

Sr. No.		General Description	Relevant provision of the Act & Rules
		"Permitted use", in relation to a registered trade mark, means the use of the 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 the 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.	
6.3.2	Concept	**Registered user:** 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.	Section 48(2) of the Trade Marks Act 1999
6.3.3	Requirement from the applicant	**Application for registration of a registered user:** An application for registration of a registered user shall be filed by the	Section 49(1) of the Trade Marks Act 1999; Rule 86 of the Trade Marks Rules 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		registered proprietor and proposed user jointly on Form TM-U. An application for registration of a registered user in respect of more than one trademark may be filed in one request.	
6.3.4	Requirement from the applicant	**Documents required:** The application is to be accompanied by the following documents: 1. Agreement in writing between the registered proprietor and proposed user, or a 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 the agreement. 2. Document(s) and correspondence, if any, mentioned in the agreement or authenticated copies thereof. 3. An affidavit of the registered proprietor or by some person authorised, testifying to the genuineness of the documents accompanying the application and containing: (a) the particulars and statements required by clause (b) of sub-section (1) of Section 49; [including the degree of control to be exercised by the proprietor over the permitted use, the fact as to whether the proposed user shall be the sole registered user or whether there shall be any restriction, the terms and duration of the permitted use, and the goods/services in relation to which registration of registered user is proposed]; (b) the precise relationship between the registered proprietor and proposed user, if	Section 49(1) and (4) of the Trade Marks Act 1999 and Rule 86 of the Trade Marks Rules 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		any; and 4. An/The applicant/applicants may be permitted to file a redacted version of the agreement online and also submit the complete agreement either in a sealed cover or produce it at the time of the hearing. 5. Such further or other documents and evidence/information as the Registrar nay call for.	
6.3.5	Requirement from the applicant	**Variation or cancellation as registered user:** The registration of a person as registered user - (a) may be varied by the Registrar of trademarks, as regards the goods or services in respect of which it has effect, on the application on Form TM-U of the registered proprietor of the trade mark; (b) may be cancelled by the Registrar on the application on Form TM-U by the registered proprietor of the mark or by any other registered user; (c) may be cancelled by the Registrar on the application on Form TM-U by any person on any of the following grounds, namely :- (i) that the registered user has used the trade mark otherwise than in accordance with the agreement, or in such a way as to cause or be likely to cause deception or confusion; ii) that the proprietor or 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; (iii) that the circumstances have changed	Section 50 of the Trade Marks Act 1999 and Rules 92, 93 and 95 of Trade Mark Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		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; (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; (d) may be cancelled by the Registrar on his own motion 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; (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.	
6.3.6	Requirement from the applicant	**Prescribed fee : TM-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: Rs. 5,000/-. 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 - Rs. 5,000/-	Item No. 10 of the First Schedule of Trade Mark Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		For every additional mark of the proprietor included in the application, and in the registered user agreement - Rs. 3,000/- 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; For the first mark - Rs. 5,000/- For every additional mark - Rs. 2,500/- For application under Section 50(1)(b) to cancel the entry of a registered user of one trademark - Rs. 2,500/- Where the application includes more than one trademark: For the first mark - Rs. 2,500/- For every additional mark - Rs. 500/- For application under Section 50(1)(c) or (d) to cancel the entry of a registered user of one trademark - Rs. 5,000/- Where the application includes more than one trademark: For the first mark - Rs. 5,000/- For every additional mark Rs. 2,000/-.	
6.3.7	Office Action	All requests for the registration of a registered user, requests for cancellation of registration of a registered user, and documents submitted along with such requests, shall be scanned and uploaded in the system.	Rule 88 of Trade MArk Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		The data entry of a request for registration of registered user shall be made in the 'REGISTERED USER' module of TMAS. Thereafter, a scrutiny of the request and of the existence/non-existence of supporting documents shall be made. The request shall then be examined and disposed of in terms of the relevant provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2017. The Officer-in-Charge of the A&R Section while disposing of such requests shall take into account the following facts: 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 the agreement for registered user as a registered proprietor actually appears as registered proprietor in the Trade Marks Registry records, with the same details as to address, etc.; 4. Whether the registered user agreement is duly stamped and executed; 5. Whether the terms and conditions of the registered user agreement, including the tenure and conditions of permitted use, are in conformity with the registration of the trademarks concerned. 6. A hearing shall be granted to the applicant if the application is to be accepted with any condition or rejected.	

Sr. No.		General Description	Relevant provision of the Act & Rules
		In case of any objection, a query letter will be generated through the system and the same will be sent to the applicant who has made the request, by post. In case an application for registration of a registered user, or an application for variation or cancellation of registration of a registered user, is allowed, the same shall be effected in the system, and communication to this effect shall 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 Marks Journal.	

Section 4: Post-Registration Amendments

Sr. No.		General Description	Relevant provision of the Act & Rules
6.4		**Post-Registration Amendments**	
6.4.1	Concept	**Amendments in the registration details:** The registered proprietor of a trade mark may apply for correction of error or amendment as to the name, address, or description of the registered proprietor, or for cancelling the entry of the trademark on the register, or for striking out any goods or services mentioned in the registered trade mark. In case there are registered users of the trademarks referred to in the application, the copy of such application shall be served by the applicant on the registered user(s).	Section 58 of the Trade Marks Act, 1999; Rule 101 of the Trade Marks Rules 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		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.	
6.4.2	Requirement from the applicant	**Amendment as to the name or description of registered proprietor:** A request for correction of error or for amendment as to the name or description of the registered proprietor shall be made on Form TM-P. The supporting documents (such as a certificate from the Registrar of Companies in case of change of name of the company) shall be attached along with the request for change of name of registered proprietor. The Registrar may require the applicant to furnish such evidence by affidavit The registered proprietor may file a request for correction or amendment in the name or description or address of the registered proprietor in respect of more than one trade mark in one request. In case the address for service of the registered proprietor is sought to be amended on the basis of Power of Attorney shall also be attached along with the request.	Rules 96 & 101 of the Trade Marks Rules 2017.
6.4.3		**Amendment as to the address of the registered proprietor:** The request for correction of error or for change in the address of the registered proprietor shall be made on Form TM-P along with supporting documents.	Rules 96 & 101(1), (2), (3), (4) and (5) of the Trade Marks Rules 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		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.	
6.4.4		**Amendment as to the address for service of the registered proprietor:** An application for amendment in the address for service of a registered proprietor shall be made on Form TM-P along with supporting documents. In case the address for service of the resistered proprietor is sought to be amended on the basis of a 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 for service of the registered proprietor in respect of more than one trade mark.	Rule 96 & 101 of the Trade Marks Rules 2017.
6.4.5	Requirement from the applicant	**Cancellation of registered trade mark:** An application for cancellation of a registered trade mark shall be made on Form TM-P.	Rule 101(6) of the Trade Marks Rules 2017.
6.4.6	Requirement from the applicant	**Application to strike out any or some goods or services:** An application to strike out any or some goods or services for which a trade mark is registered shall be made on Form TM-P.	Rule 101(6) of the Trade Marks Rules 2017.
6.4.7	Requirement from the applicant	**Adaptation after amendment in the Fourth Schedule:**	Rule 105 of the Trade Marks Rules 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		On the classification set forth in the Fourth Schedule being amended, the registered proprietor of a trade mark may apply on Form TM-P 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.	
6.4.8	Requirement from the applicant	**Alteration in registered trademark:** An application for making alteration in the registered trade mark may be made by registered proprietor on Form TM-P along with 5 legible copies of the mark as it will appear after the proposed alteration, shall be attached with the application.	Section 59 of the Trade Marks Act, 1999; Rule 102 of the Trade Marks Rules 2017.
6.4.9	Requirement from the applicant	**Prescribed fee for various amendment applications:** ● On application for change a name and/or description of a registered proprietor or a registered user of a trademark under Section 58 for each trademark: Form TM-P For Physical Filing: INR 2000/- For E- Filing : INR 1800/- ● On application for change in address or address for service in India of	Item No. 6, 7, 8 and 9 of the Schedule - I of Trade Mark Rules, 2017.

Sr. No.		General Description	Relevant provision of the Act & Rules
		Registered Proprietors under Section 58 for each trademark: Form TM-P For Physical Filing: INR 1000/- For E- Filing : INR 900/- ● On application for request for cancellation of an entry in the register or part thereof under Section 58 for each trademark: Form TM-P For Physical Filing: INR 1000/- For E- Filing : INR 900/- ● On application for conversion of specification under Section 60 for each trademark: Form TM-P For Physical Filing: INR 3000/- For E- Filing : INR 2700/- ● On application for adding or altering a registered trademark under Section 59 (1) for each trademark: Form TM-P For Physical Filing: INR 3000/- For E- Filing : INR 2700/-	
6.4.10	Office Action	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. 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 documents shall be made. Then the request shall be examined & disposed of as per	

Sr. No.		General Description	Relevant provision of the Act & Rules
		relevant provisions of the Trade Marks Act, 1999 and Trade Marks Rules, 2017. The Officer-in-Charge while disposing the aforesaid requests for the correction or amendment shall take into account the following facts: 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 the proprietorship of the trade mark, a request should be filed on Form TM-P for assignment or transfer for each trademark. 4. In case of request for alteration of goods or services made on Form TM-P, 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-P, no request which would have the 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.	

Sr. No.		General Description	Relevant provision of the Act & Rules
		In case of any objection, query letter may be generated through the system and the same may be sent to the applicant by post. 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.	

Chapter 07 [Back]

Concept of Claiming Prior User on the Basis of User Evidence and Determination of Marks as Well-Known by the Registrar

Part I — Concept of Claiming Prior User on the Basis of User Evidence

A prior user of a Trade Mark means a person or entity who has created, coined, and adopted the Trade Mark and kept it in commercial use before any other person or entity attempts to adopt, use, and register it. The prior user is the person who introduces the mark in the market first. This prior use gives such a person rights, even against a subsequent adopter, based on the principle of first in adoption and first in right. The law recognises that a prior user has built goodwill and reputation associated with the mark, making it unfair to take that away through later registration. Therefore, a prior user's rights can always be considered superior to those of a subsequent registered user. The use must generally be continuous and not sporadic. The mark must not be used occasionally; it should be used consistently, continuously, and genuinely for commercial purposes.

Sr. No.	General Description	Relevant provision of the Act & Rules
7.1	**Concept — Definition of prior user:** A prior user of a Trade Mark means a person or entity who has created, coined, and adopted the Trade Mark and kept it in commercial use before any other person or entity attempts to adopt, use, and register it. The prior user is the person who introduces the mark in the market first. This prior use gives such a person rights, even against a subsequent adopter, based on the principle of first in adoption and first in right. The law recognises that a prior user has built goodwill and reputation associated with the mark, making it unfair to take that away through later registration. Therefore, a prior user's rights can always be considered superior to those of a subsequent registered user. The use must generally be continuous and not sporadic. The mark must not be used occasionally; it should be used consistently, continuously, and genuinely for commercial purposes.	Section 34 of the Trade Marks Act, 1999 Rule 25(2) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	Trustees of Princeton University v. Vagdevi Educational Society, 2023 SCC OnLine Del 5524	
7.1.1	**Importance of prior and continuous use:** A trademark gains value through continuous and consistent use in the market, as regular usage builds goodwill and reputation among the public. Under the Trade Marks Act, 1999 and Trade Marks Rules, 2017, the person who first introduces and continuously uses a mark, supported by strong documentary evidence such as invoices, advertisements, and sales records, enjoys priority rights over later applicants. Such prior use can secure protection and registration under the Trade Marks Act, 1999 and Trade Marks Rules, 2017, ensuring legal recognition and safeguarding against competitors.	Section 34 of the Trade Marks Act, 1999
7.1.2	**Requirement of supporting documents under Rule 25(2):** Rule 25(2) of the Trade Marks Rules, 2017 provides that where the use of the Trade Mark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents. Supporting documents, for the purposes of Rule 25(2), are those records which prove that a trademark has been in continuous use in the market from the date claimed by the applicant until the date on which he asserts proprietorship. Such documents must clearly show that the mark has been regularly used in trade or is widely known to the public, thereby establishing uninterrupted usage and recognition necessary for securing legal protection and registration under the Trade Marks Act, 1999.	Rule 25(2) of the Trade Marks Rules, 2017
7.1.3	**Types of supporting documents — overview:** Supporting documents for claiming prior user fall into two categories:	Rule 25(2) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	(i) Primary documents (conclusive documents): Primary documents are those records which directly prove the continuous use of a trademark in the market. They are considered the strongest evidence because they come from official or original sources and show that the mark has actually been used in trade. Examples include invoices, bills, sales receipts, purchase orders, advertisements published in newspapers or magazines, and registration certificates with government authorities. These documents conclusively establish that the trademark has been in use from the claimed date and help the applicant prove proprietorship under the Trade Marks Act, 1999 and Trade Marks Rules, 2017. **(ii) Secondary documents (corroborative or miscellaneous documents):** Secondary documents are records that establish the existence of the applicant's Company, Firm, Business, etc., even though they do not directly prove that the trademark itself is in the market. These documents serve as supportive evidence to show that the applicant is a genuine business entity and has been operating during the claimed period. Examples include photographs of exhibitions, social media posts, website screenshots, promotional brochures, awards, testimonials, incorporation certificates, partnership deeds, GST or tax registrations, trade licences, PAN cards, bank account records, or other statutory filings. Unlike primary documents, they do not by themselves conclusively establish trade usage, but they help strengthen the applicant's claim when read together with primary evidence.	
7.1.4	**Concluding principle — continuity of use:** If the applicant is claiming prior user, he should show evidence (user documents) which substantiate that the mark is in the market continuously without interruption. If the applicant is claiming a longer period of use, he should produce continuous user documents which prove	Rule 25(2) of the Trade Marks Rules, 2017 Section 34 of the Trade Marks Act, 1999

Sr. No.	General Description	Relevant provision of the Act & Rules
	that the mark is commercially used. At a minimum, there must be quarterly documents to prove the continuous use of the mark in the market, except in instances of force majeure events such as the Covid-19 pandemic.	

Table A — Primary Documents (Conclusive Documents)

The following table sets out the primary documents that may be submitted as user evidence and the criteria by which the genuineness of each document is to be verified by the office:

S. No.	Primary Document / Conclusive Document	Contention of the document which has to be verified for genuineness
1.	**Sales Invoices**	The sales invoices should contain the 'Trade Mark', 'Description of Goods/Services', name of the Party/Applicant (seller), TIN/GSTIN Number, and date of issuance of the invoice. In case of old invoices, they must contain the TIN Number (Tax Identification Number) which proves that the applicant is paying VAT (Value Added Tax) or CST (Central Sales Tax), thereby proving that the product is available in the market. If the applicant wants the registration of the Trade Mark to be allowed for a particular State, he should preferably produce the VAT Registration Certificate of that State. If the applicant wants the registration to be allowed at the all-India level, he should preferably produce the CST Registration Certificate. In case the sales invoices do not contain the above particulars, or in the absence of even a single detail, such a document will not be considered a genuine document for use of the Trade Mark.
2.	**Purchase Invoices**	The purchase invoices should contain the name of the Party/Applicant, date of issuance of the invoice, and description of goods/services. A connection must be established between the goods/services purchased and the goods/services sold by the applicant. If no connection is found between these two transactions, such a

S. No.	Primary Document / Conclusive Document	Contention of the document which has to be verified for genuineness
		document will not be considered a user document for the impugned mark.
3.	**Registration Certificate of the Trade Mark in the same class for the same mark**	If an applicant submits registration certificates in the same class for the same goods or services and for the same mark, then minor variations such as change of colour, background, or font size, which do not amount to a substantial change, will not affect the continuity of use, and the user documents of the previously registered mark can be treated as conclusive proof of use for the new application. However, if there is a substantial change in the mark itself, even though both marks are applied in the same class for the same goods or services, the user documents of the earlier registered mark cannot be relied upon to prove use of the subsequently applied mark, since the substantial change creates a new and distinct mark in law.
4.	**Well-Known Trade Mark**	If the applicant's mark is declared as Well-Known by the Trade Marks Registry, it should be considered conclusive proof that the applicant's mark is existing in the market. If the applicant's mark is declared as Well-Known by the Hon'ble Court and the applicant has paid the prescribed fees at the Trade Marks Registry to add the same to the list of Well-Known marks maintained by the Registry, it should likewise be considered conclusive proof that the applicant's mark is existing in the market.
5.	**Website pages / App pages**	Creation of webpages, screenshots of webpages, dashboards, customer reviews, application release notes and update logs, and e-commerce listings, containing the date, month, and year, can be considered as user documents.
6.	**Advertisements through websites and newspapers**	The applicant can make advertisement of the product either through a website or through newspapers, press releases, news articles, promotional materials, email campaigns, launch events, seminars, etc. However, such advertisement documents must contain the brand name (i.e., the Trade Mark) with respect to the same goods/services, along with the date of the

S. No.	Primary Document / Conclusive Document	Contention of the document which has to be verified for genuineness
		advertisement and the name of the proprietor, to be considered as conclusive user documents.
7.	**Verification of invoices as user evidence**	The invoices submitted by the applicant as user evidence must correspond to the class in which the registration is demanded, as the Nice Classification System distinguishes between goods and services. For example: If the mark is to be registered in Class 43 (restaurants, cafés, catering, hospitality), the invoices must specify those services. A bill showing "service of one cup of coffee or tea" or "one plate of noodles" proves the provision of dining services. On the other hand, if the mark is to be registered in Class 30 (coffee, tea, noodles, cocoa, rice, pasta, bakery items, confectionery), the invoices must specify those goods. A common mistake arises when the invoices are interchanged by the applicant. If a restaurant bill merely states 'packet of tea or coffee' or 'packet of biscuits or chocolate cake', it shows the sale of goods only and does not establish the provision of restaurant services. Such invoices cannot be accepted as primary evidence of use in Class 43, and invoices showing use in Class 30 cannot be accepted for registration of the mark in Class 43, and vice versa.

Table B — Secondary Documents (Corroborative / Miscellaneous Documents)

The following table sets out the secondary documents that may be submitted as corroborative evidence and the criteria by which the genuineness of each document is to be verified by the office:

S. No.	Secondary Document / Corroborative Document	Contention of the document which has to be verified for genuineness
1.	**Brochures**	Brochures/digital catalogues are proof of advertisement of the product/business, but are not proof that the products are in the

S. No.	Secondary Document / Corroborative Document	Contention of the document which has to be verified for genuineness
		market. They can be used as corroborative evidence of use of the mark, but not as conclusive evidence.
2.	**Photographs of Buildings, Shops, etc.**	Photographs/pictures of buildings, shops, factories, industries, companies, firms, etc. indicate the existence of the Company/Firm but are not conclusive proof that the mark is in the market. They can be used as corroborative evidence only.
3.	**Booklets of the Company**	The booklets of a company contain information such as the launch of products/services under a brand name and proposed marketing, outlet chains, and distribution in the market. They serve as evidence that particular goods or services under a trade mark were launched in a particular year and constitute corroborative evidence of the mark, but not conclusive proof that the products are in the market.
4.	**Annual Report of the Company**	The annual report of a company includes a summary of its important activities such as policy decisions, launching of products and services, conferences, meetings, etc., and provides data on financial transactions including sales, purchases, and marketing. Annual reports evidence that the company has a presence in the market but do not prove that the specific product under the mark is in the market. They serve as corroborative evidence only.
5.	**Various Registration Certificates of the Trade Mark in various classes**	If the applicant submits various registration certificates for the same mark in various classes and also submits user documents for those various classes but not for the applied class, such various registrations can be treated as corroborative evidence of use and can support the conclusive evidence to a certain extent.
6.	**Well-Known Trade Mark (declared by Court without Registry listing)**	If a mark is declared as Well-Known by any Hon'ble Court, but the applicant has not taken steps to add the same to the list maintained by the Trade Marks Registry, then such orders of well-known declaration will be treated as corroborative evidence of use, which can support the conclusive evidence to a certain extent.

Note: If the applicant is claiming prior user, he should show evidence (user documents) which substantiate that the mark is in the market continuously without interruption. If the applicant is claiming a longer period of use, he should produce continuous user documents proving that the mark is commercially used. At a minimum, there must be quarterly documents to prove the continuous use of the mark in the market, except in instances of force majeure events such as the Covid-19 pandemic.

Part II — Determination of Marks as Well-Known by the Registrar and Inclusion of a Mark in the List of Well-Known Marks Maintained by the Trade Marks Registry

This part deals with the provisions related to determination of a mark as well-known by the Registrar and its inclusion in the well-known marks list maintained by the Registrar.

Provisions for determination of a mark as well-known by the Registrar were introduced in the Trade Marks Rules, 2017. Under these provisions, any person may now file a request before the Trade Marks Registry for determination of their mark as well-known. Prior to the said amendment, a mark was determined as well-known in contested proceedings based on orders passed by Courts or Tribunals in India, including orders passed by the Trade Marks Registry in opposition proceedings.

The Trade Marks Registry maintains a list of trade marks that have been declared as well-known in India by various Courts, Tribunals, and the Trade Marks Registry. The said list can be accessed online on the website of the Trade Marks Registry at:
ipindiaservices.gov.in/tmrpublicsearch/wellknownmarks.aspx

This part is divided into two Sections — Section A deals with requests filed with the Trade Marks Registry for determination of a mark as well-known by the Registrar, and the procedure and documentation involved therewith. Section B deals exclusively with cases where marks have already been declared as well-known by Courts or any other judicial body in India, and the procedure to be followed in such cases.

Section A — Determination of a Mark as Well-Known by the Registrar

Sr. No.	General Description	Relevant provision of the Act & Rules
7.2	**Concept — Definition of "well-known trade mark":** "Well-known trade marks" in relation to any goods or services mean a mark that has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.	Section 2(zg) of the Trade Marks Act, 1999

Sr. No.	General Description	Relevant provision of the Act & Rules
7.2.1	**Criteria for determining well-known status — Sections 11(6) to 11(9):** While determining whether a trade mark is well-known, the Registrar shall, in addition to the definition under Section 2(zg), take into account the following factors as specified in Sections 11(6) to 11(9) of the Trade Marks Act, 1999: (a) the knowledge or recognition of that trade mark in the relevant segment of the public, including knowledge obtained as a result of the promotion of the trade mark; (b) the duration, extent and geographical area of any use of that trade mark; (c) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods or services to which the trade mark applies; (d) the duration and geographical area of any registration of, or any application for registration of, that trade mark under this Act, to the extent they reflect the use or recognition of the trade mark; (e) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record. The Registrar shall take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark, including knowledge of the trade mark in relevant sectors of the public.	Section 11(6), 11(7), 11(8) & 11(9) of the Trade Marks Act, 1999 Rule 124(2) and Rule 124(3) of the Trade Marks Rules, 2017
7.2.2	**Requirement from the applicant — Filing of request:** A request for determination of a mark as well-known can be filed only electronically on Form TM-M, by payment of the official fees as mentioned in the First Schedule. Such a request shall be accompanied by a statement of case along with all the evidence and documents relied upon by the applicant in support of the claim. Once such a request is received, the Trade Marks	Rule 124(1) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	Registry shall issue a Well-Known Trademark Application Number to such a request.	
7.2.2 A	**Requirement from the applicant — Documents to accompany statement of case:** Without prejudice to any other evidence that the Registrar may require, the statement of case filed along with the request under Rule 124(1) shall, to the extent available and applicable, be accompanied by the following: (a) evidence of use of the mark in India, including invoices, sales figures, market share data, and business records; (b) evidence of advertisement and promotional activities, including copies of advertisements, marketing materials, and expenditure data; (c) evidence of the duration and geographical extent of use of the mark; (d) evidence of registration or pending applications in India and/or abroad; (e) copies of orders or judgements of Courts, Tribunals, or the Registrar, if any, recognising or acknowledging the mark as well-known or as a mark of repute; (f) evidence of enforcement of rights, including cease-and-desist notices, settlement agreements, or court orders; (g) evidence of consumer recognition, such as surveys, published articles, or industry reports. The list above is indicative and not exhaustive. The Registrar may call for such additional documents as are deemed necessary for the purpose of determination.	Rule 124(1) of the Trade Marks Rules, 2017 Section 11(6) to 11(9) of the Trade Marks Act, 1999
7.2.3	**Office action — Procedural deficiency:** In case, upon scrutiny of the request and documents submitted, the Registrar observes any procedural deficiency or inconsistency, the Registrar shall communicate the said issues to the applicant and	Rule 124 of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	provide a time frame to respond to the same. Further, for the purpose of determination, the Registrar may call such documents as are deemed fit. **Time limit for response to deficiency communication:** Where the Registrar communicates any procedural deficiency or inconsistency to the applicant, the applicant shall respond to such communication within thirty (30) days from the date of such communication, or within such extended time as the Registrar may allow upon a request made prior to the expiry of the said period. Failure to respond within the prescribed or extended period may result in the request being treated as abandoned.	
7.2.4	**Concept — Registrar's evaluation of well-known status:** The Registrar shall consider the relevant provisions of Sections 11(6) to 11(9) of the Trade Marks Act, 1999 in order to determine whether a mark is 'well-known'. The Registrar shall take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark, including the knowledge of the trade mark in relevant sectors of the public. **Proviso — Conditions not required to be satisfied [Section 11(9)]:** Provided that the Registrar shall not require, as a condition for determination of a mark as well-known, that: (i) the trade mark has been used in India; (ii) the trade mark has been registered in India, or that an application for registration of the trade mark has been filed in India; (iii) the trade mark is well-known in, or has been registered in, or that an application for registration has been filed in, any jurisdiction other than India; or	Section 11(6) to Section 11(9) of the Trade Marks Act, 1999 Rule 124(2) and Rule 124(3) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	(iv) the trade mark is well-known to the public at large in India. It shall be sufficient that the mark has become well-known to the relevant segment of the public, including through promotion, advertising, or its reputation in international trade, consistent with India's obligations under the Paris Convention and the TRIPS Agreement. Alfred Dunhill Ltd v. Kartar Singh Makkar, 1999 (19) PTC 294 (Del); Milmet Oftho Industries and Ors. v. Allergan Inc., (2004) 12 SCC 624; H&M Hennes & Mauritz AB Ors. v. HM Megabrands Pvt. Ltd, MANU/DE/2097/2018; Lowenbrau Ag & Another v. Jagpin Breweries Ltd, 2009 (39) PTC 627 (DEL); Neon Laboratories Ltd. v. Medical Technologies Ltd., 2015 AIR SCW 6470; Mac Personal Care Pvt. Ltd. v. Laverana Gmbh and Co. KG, FAO (OS) 194/2015 N. R. Dongre v. Whirlpool Corporation; ConAgra v. McCain Foods, (1992) 23 IPR 193	
7.2.5	**Concept — Publication and objection procedure:** After examining the request, if the Registrar is of the opinion that a mark can be determined as well-known, the said mark shall be published in the Trade Marks Journal for objections, if any, from the general public. The publication shall include the details of the request, including the Well-Known TM Application Number, the	Rule 124(4) of the Trade Marks Rules, 2017 Section 127(b) of the Trade Marks Act, 1999

Sr. No.	General Description	Relevant provision of the Act & Rules
	trade mark considered well-known, and the applicant's details. Any party may file an objection, stating the reasons along with supporting documents, if any, within thirty (30) days from the date of publication to the Registrar of Trade Marks at the Trade Marks Registry, Mumbai, Bouddhik Sampada Bhavan, S.M. Road, Antop Hill, Mumbai – 400037. In case no objections are received within the aforesaid period, the mark shall be declared well-known by way of a journal notification and included in the list of well-known trade marks maintained by the Trade Marks Registry. **Procedure where objections are received:** Where any objection is received within the period of thirty (30) days from the date of publication, the Registrar shall: (a) forward a copy of the objection to the applicant; (b) call upon the applicant to file a reply to such objection within thirty (30) days of receipt thereof, or within such further time as the Registrar may allow; (c) afford both the applicant and the objecting party a reasonable opportunity of being heard before passing any order under this Rule. The Registrar shall pass a reasoned order on the request for determination of a mark as well-known after considering the objections and the applicant's reply thereto, in accordance with the principles of natural justice and Section 127(b) of the Trade Marks Act, 1999.	
7.2.6	**Concept — Removal from the list of well-known trade marks:** If the Registrar, at any time, finds that a trade mark has been erroneously or inadvertently included in the list of well-known trade marks, or is no longer justified in remaining on the list, the Registrar may remove the said	Rule 124(6) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	mark from the list after providing the concerned party a due opportunity of hearing. **The power of the Registrar under this provision may be exercised:** (a) suo motu by the Registrar; or (b) upon a representation made by any person who can demonstrate a legitimate interest, setting out the grounds on which removal is sought. In all cases, the Registrar shall provide the trade mark proprietor a reasonable opportunity of being heard before passing any order of removal. The Registrar shall pass a reasoned order recording the grounds for the decision to remove or retain the mark on the list.	

Section B — Inclusion of the Mark in the List of Well-Known Marks Based on Orders of Any Judicial Body

This section applies to instances where a mark has already been declared as well-known by any competent Court or Tribunal. The Court or the Registrar can determine a trade mark to be a well-known mark.

Sr. No.	General Description	Relevant provision of the Act & Rules
7.3	**Concept — Notification of well-known status in the Trade Marks Journal:** In case the trade mark is determined as well-known, the same shall be notified as well-known in the Trade Marks Journal and included in the list of well-known trade marks maintained by the Registrar.	Rule 124(5) of the Trade Marks Rules, 2017
7.3.1	**Office action — Procedure and documents required for court-declared marks:**	Rule 124(5) of the Trade Marks Rules, 2017

Sr. No.	General Description	Relevant provision of the Act & Rules
	Where a mark has already been declared as well-known by any competent Court or Tribunal, there shall be no re-determination or re-examination of the trade mark. The procedure shall only include making a request on Form TM-M with the prescribed fee, which shall be followed by requisite action under Rule 124(5), after verification of a certified copy of the order or judgement of the Court and other administrative modalities, without resorting to the procedure prescribed under Rule 124(4). **Documents to be submitted with Form TM-M under this Section:** A request filed under this provision shall be accompanied by: (a) a certified copy of the final order or judgement of the competent Court or Tribunal specifically declaring the mark as well-known; (b) an authenticated copy of the certified copy, where the original certified copy is to be retained for record; (c) a copy of Form TM-M duly completed with particulars of the mark, the applicant, and the relevant court proceedings; (d) proof of payment of the prescribed fee. The Registrar shall verify that the court order contains a specific and operative declaration of well-known status and is not merely an observation in passing, an ex parte injunction, or a prima facie finding, before proceeding to include the mark in the list.	
7.3.2	**Concept — Qualifying orders and treatment of foreign court orders:** Where an applicant relies on court orders for determination as a well-known mark, the Registrar shall examine whether the said court order contains a specific declaration of a particular mark as a well-known mark, or whether the reliance is merely on observations in	Rule 124(5) of the Trade Marks Rules, 2017 Section 11 of the Trade Marks Act, 1999

Sr. No.	General Description	Relevant provision of the Act & Rules
	passing, particularly in prima facie observations or any ex parte injunction orders. **For the purposes of this Section, the following shall ordinarily constitute a specific declaration of well-known status:** (a) a final decree or order of a Court expressly declaring the trade mark to be a well-known mark under the Trade Marks Act, 1999; (b) a final order of the Registrar in opposition or rectification proceedings expressly determining the mark to be well-known. **The following shall not ordinarily qualify as a specific declaration of well-known status:** (i) observations made in passing (obiter dicta) in any order or judgement; (ii) prima facie findings in applications for interim or ex parte injunctions; (iii) consent orders or orders passed in uncontested proceedings, unless the Court has expressly applied the criteria for well-known status. **Treatment of foreign court orders:** An order of a foreign court declaring a mark as well-known shall not, by itself, qualify for inclusion under this Section. However, the applicant may rely upon such foreign court order as supporting evidence in a request under Section A, filed pursuant to Rule 124(1), for independent determination of well-known status by the Registrar. This position is consistent with the territorial principle underlying the Trade Marks Act, 1999.	

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