

PREFACE

The draft Trade Marks Work Manual herein set out describes the various procedures and practice in the administration of the Trade Marks Act, 1999 which will serve as a useful guide to the officers of the Trade Marks Registry (particularly new incumbents) and also users of the system and in ensuring uniformity of practice. 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 Appellate Board. For greater transparency the draft manual attempts to explain the practices of Trade Marks Registry in all the areas of administration of the system.

The draft Manual is in the nature of a guide for the users and obviously if any of the statements in this document are at variance, or in any way inconsistent, with the provisions of the Act or Rules, the latter will prevail. Wherever appropriate, reference to case laws, representing decisions of Court in India and other countries have been indicated to facilitate better understanding of the law. This draft manual is evolutionary and 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.

Informed comments are invited from interested members of the public, stakeholders, attorneys, trade marks agents etc.to suggest improvements in the draft within 30 days

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DRAFT TRADE MARKS WORK MANUAL

UNDER

THE TRADE MARKS ACT, 1999 AND TRADE MARKS RULES, 2002

CHAPTER I

1. Introduction

The Trade Marks Act, 1999 and the Trade Marks Rules, 2002 (as amended) govern the law relating to trade marks in India.

The legislation, as indicated in the Preamble to the Act, is an “Act to amend and consolidate the law relating to trade marks, to provide for registration and better protection of trade marks for goods and services and for the prevention of the use of fraudulent marks.”

The salient features of this Act briefly are as set out in the Statement of Objects and Reasons annexed to the Trade Marks Bill:

- (a) providing for registration of trade mark for services, in addition to goods;
- (b) registration of trade marks, which are imitation of well known trade marks, not to be permitted, besides enlarging the grounds for refusal of registration mentioned in clauses 9 and 11. Consequently, the provisions of defensive registration of trade marks are proposed to be omitted;
- (c) amplifications of factors to be considered for defining a well known mark;
- (d) doing away with the system of maintaining registration of trade marks in Part A and Part B with different legal rights, and to provide only a single register with simplified procedure for registration and with equal rights;
- (e) Simplifying the procedure for registration of registered user and enlarging the scope of permitted use;
- (f) Providing enhanced punishment for the offences relating to trade marks on par with the present Copyright Act, 1957, to prevent the sale of spurious goods;

- (g) Providing an Appellate Board for speedy disposal of appeals and rectification applications which at present lie before High courts;
- (h) Transferring the final authority relating to registration of certification trade marks to the Registrar instead of the Central Government;
- (i) Providing enhanced punishment for the offences relating to trade marks on par with the present Copyright Act, 1957, to prevent the sale of spurious goods;
- (j) Prohibiting use of someone else's trade marks as part of corporate names, or name of business concern;
- (k) Extension of application of convention country to include countries which are members of Group or union of countries and Inter-Governmental Organizations;
- (l) Incorporating other provisions, like amending the definition of "trade marks", provisions for filing a single application for registration in more than one class, increasing the period of registration and renewal from 7 to 10 years; making trade mark offences cognizable, enlarging the jurisdiction of Courts to bring the law in this respect on par with the copyright law, amplifying the powers of the Court to grant *ex parte* injunction in certain cases and other related amendments to simplify and streamline the trade mark law and procedure.

All the provisions of the Trade Marks Act, 1999 and the trade Marks Rules came into effect w.e.f. 15.9.2003 as per notification No. S.O. 1048(E) dated 15.9.2003.

1.1 HISTORICAL

Trade Marks Act, 1940 (5 of 1940) was the first statute law on trade marks in India. Prior to that protection of trade marks was left to the governed by Common Law. Cases concerning trade marks were decided in the light of section 54 of Specific Relief Act, 1877, while registration was secured by obtaining a declaration as to ownership under the Indian Registration Act, 1908 (See Whirlpool Corporation vs. Registrar of Trade Marks 1998 (Suppl.) Arb. LR 553).

Some of the provisions of the first Trade Marks Act, 1940 came into force on 11.3.1940 and the rest became effective on 1.6.1942 (Gazette of India Extraordinary, 1942. p.684) For statement of

objects & reasons, see Gazette of India 1939, Part V, p. 249-Report of Select Committee, Gazette of India, 1940, Part V. p. 51.

The said enactment was amended by the Trade Marks Amendment Act, 1941 (27 of 1941) and later by two other amendments. By the Trade Marks Amendment Act, 1943, the Trade Marks Registry, which was formerly a part of the Patent Office, Calcutta(now Kolkata) was separated from the Patent Office to constitute a separate Trade Marks Registry under a Registrar of Trade Marks at Bombay (now Mumbai). Thereafter, the Act was amended by the Trade Marks Amendment Act, of 1946, to give effect to the reciprocal arrangements relating to trade marks between the Government of India and the then Indian States and further amendments introduced by Part B States Laws Act, 1951.

The Trade Marks Enquiry Committee, which was constituted by the Government of India in November 1953, recommended some changes, but since the report showed some divergence of opinion among the members, Mr. Justice Rajagopala Ayyangar, then a Judge of the Madras High Court, who later served and retired as a judge of the Supreme Court, was appointed by the Government of India to examine the Trade Marks Act, 1940, with reference to the report of the Trade Marks Enquiry Committee and to recommend as to what changes in the then existing law were necessary. On the basis of the report of Mr. Justice Ayyangar, the Trade Marks Act, 1940 was replaced by the Trade & Merchandise Marks Act, 1958. The 1958 Act consolidated the provisions of the Trade Marks Act, 1940, the Indian Merchandise Marks Act, 1889(which was in force since 1.4.1889) and the provisions relating to trade marks in the Indian Penal Code. The Trade & Merchandise Marks Act, 1958 (Act 43 of 1958) was brought into force on 25th November 1959. Certain minor amendments were carried out by the Repealing & Amending Act, 1960 (58 of 1960) and the Patents Act, 1970 (39 of 1970). Thus the history of legal protection to trade marks in India is more than a century old.

1.2 Revision of the 1958 Act

The Trade & Merchandise Mark Act, 1958 has been revised and replaced by the Trade Mark Act, 1999. The process started, when it was felt that a comprehensive review of the 1958 Act be made in view of new developments in trading and commercial

practices, increasing globalization of trade and industry, the need to encourage investment flows and transfer of technology and need for simplification and harmonization of trade mark management system.

The Trade Marks Bill, 1993 was introduced in the Lok Sabha on 19.5.1993, which was passed by the Lok Sabha on the lines recommended by the Standing Committee. However, as the Bill failed to get through the Rajya Sabha, it lapsed on the dissolution of the Lok Sabha. A new Bill titled as Trade Marks Bill, 1999 (Bill No.33 of 1999) was introduced in Rajya Sabha and eventually passed by both the Houses of Parliament. The Bill received the assent of the President on 30.12.1999 and became an Act.

1.3 Harmonization with International norms and standards

The current law of trade marks contained in the Trade Marks Act, 1999 is in harmony with two major international treaties on the subject, namely, Paris Convention for Protection of Industrial Property and TRIPS Agreement, both of which India is a signatory.

Chapter II

Examination of Trade Mark applications

1. Objective of this chapter

The objective of this chapter on examination of trade mark application is to explain the important considerations to be applied during examination and to give guidelines on registrability by:

- setting down the definitions of important expressions used in the Act, which have a bearing on examination of a trade mark application, and giving guidance on how this is interpreted in practice;
- referring to the Sections of the Act which deal with the registrability of marks and giving guidance on the legislative intent and scope of those sections;
- indicating when and the manner in which objections are to be raised; and giving guidance as to how objections are overcome;
- setting out the circumstances when evidence may assist an application;
- setting out the type of information normally required in evidence, and giving (where possible) guidance about what to look for in deciding whether a case may proceed on the basis of evidence.

It is obvious that there should be uniformity of practice in the Registry and its branch offices in the administration of the Act.

1.2 Important considerations during examination

- The examination of marks for acceptability under the Trade Marks Act 1999 must be by reference to the provisions of that Act, and Rules framed there under, taking into account,

the established practice of the Registry and the law as laid down or endorsed by the Intellectual Property Appellate Board (IPAB) and by Courts in India which is binding on the Registrar.

- Since the law in India is in tune with the International Convention for Protection of Intellectual Property and TRIPS Agreement, the administration of the Act will need to be in harmony with international practice. Accordingly, as is already being followed by the TMR and the Indian courts, the development of law as reported in recognized international law reports such as Reports of Patent Cases (RPCs), European Trade Mark Reports (ETMRs), Fleet Street Reports (FSRs), US Trade Marks Reports will continue to be followed as being of persuasive value. To a large extent, the practice of the TMR in India broadly corresponds with the practice prevailing in the U.K.
- While the individual circumstances surrounding each application are paramount, it is to be noted that 'Precedents' are of great value, though not decisive.
- Section 91 of the Trade Marks Act, provides for an appeal against an order or decision of the Registrar to the Intellectual Property Appellate Board (IPAB). In some cases, parties may also invoke the writ jurisdiction of High Courts. It is obvious, therefore, that whenever the Registrar or any officer acting for him passes an order as a tribunal under the Act, it should be a reasoned and speaking order.[See Rule 40 of TM Rules, 2002].
- In this connection, the principle laid down by the Supreme Court is to be kept in mind: "The Court insists upon disclosure of reasons in support of the order on two grounds – one, that the party aggrieved in a proceeding before the High Court or this Court has the opportunity to demonstrate that the reasons which persuaded the authority to reject its case were erroneous; the other, that the obligation to record reasons operates as a deterrent against possible arbitrary actions by the executive authority invested with judicial power" (Travancore Rayon v. Union of India AIR 1971 SC 862, at p.866)

2 Applications to be examined against current standard of registrability under the new law

Examiners should be careful to ensure that they do not assume that a mark is not registrable prima facie just because one or more earlier applications of a similar nature have been either refused under old law (as not adapted to distinguish, in spite of evidence) or were allowed to proceed only on the basis of evidence of acquired distinctiveness.

The test of registrability under the current law is very different from the old law. The law is greatly simplified so that many marks are registrable today that would have been refused registration under the old law. Therefore applications must be judged against the current standard of registrability under new law.

3 Definition provisions which have a bearing on examination:

3.1 "trade mark" *means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours;...*
(Sec.2(1)(zb))

3.2 "mark" *is defined to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof*.
[Sec.2(1)(m)].

Being an inclusive definition, it will thus include any mark within the definition of trade mark, so long as the mark is –

- capable of being represented graphically; and
- capable of distinguishing the goods or services of one person from those of others.

The word "mark" is thus intended to be interpreted broadly and no type of sign is automatically excluded from registration. Marks which will require special consideration are colours, shape of goods, sounds and smells.

The expression is a positive requirement that a sign must possess a capacity or ability to distinguish goods or services of one person from those of others before it is elevated to the status of trade mark. For registration, it must possess a distinctive character. Kerley 13th edition, EDM, para 2.34 states that the words "capable of distinguishing" must be construed by reference to the essential function of a trade mark. In this connection, this is what ECJ said:

"...to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfill its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...." Philips case [2003] RPC 2 paragraph 30.

3.3 "goods" is defined to mean anything which is the subject of trade or manufacture. **[Sec. 2(1)(j)]**

3.4 "package" includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule cap, lid, stopper and cork; **[Sec.2(1)(q)]**

3.5 "service" means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of

electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising **[Sec.2(1)(z)]**

3.6 “limitations” *(with its grammatical variations) means any limitation of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode or area of use within India or outside India;* **[Sec.2(1)(l)]**

3.7 “deceptively similar” – *A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion;* **[Sec.2(1)(h)]**

3.8 “associated mark” *means trade marks deemed to be, or required to be, registered as associated trade marks under this Act;* **(Sec.2(1)(c))**

3.9 “permitted use” *in relation to a registered trade mark, means the use of 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 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; –

[Sec.2(1)(r)]

3.10 **“trade description”** means any description, statement or other indication, direct or indirect- **[Sec.2(1)(za)]**

- (i) as to the number, quantity, measure, gauge or weight of any goods or
- (ii) as to the standard of quality of any goods or services according to a classification commonly used or recognized in the trade; or
- (iii) as to fitness for the purpose, strength, performance or behavior of any goods, being “drug”, as defined in the Drugs and Cosmetics Act, 1940(23 of 1940), or “food”, as defined in the Prevention of Food Adulteration Act, 1954(37 of 1954);or
- (iv) as to the place or country in which or the time at which any goods or services were made, produced or provided, as the case may be; or
- (v) as to the name and address or other indication of the identity of the manufacturer or of the person providing the services or of the person for whom the goods are manufactured or services are provided or
- (vi) as to the mode of manufacture or producing any goods or providing services; or
- (vii) as to the material of which any goods are composed; or
- (viii) as to any goods being the subject of an existing patent, privilege or copyright,

and includes –

- (a) any description as to the use of any mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters;
- (b) the description as to any imported goods contained in any bill of entry or shipping bill;
- (c) any other description which is likely to be misunderstood or mistaken for all or any of the said matters;

3.11: **Well-known trade mark”**, in relation to goods services, means a mark which 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. [Sec.2(1)(zg)]

Section 2(2) clarifies that any reference –

- (a) to “trade mark” shall include reference to “collective mark” or “certification trade mark”
- (b) to the use of a mark shall be construed as a reference to the use of printed or other visual representation of the mark;
- (c) to the use of a mark, -
 - (i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;
 - (ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services;
- (d) to the Registrar shall be construed as including a reference to any officer when discharging the functions of the Registrar in pursuance of sub-section (2) of section 3;
- (e) to the Trade Marks Registry shall be construed as including a reference to any office of the Trade Marks Registry

4. Manner of filing

There are two methods by which applications for trade marks can be filed which are accepted by the Registry –namely

1. Paper filing on prescribed form and in the prescribed manner
2. E-filing

4.1 Examination of a trade mark application involves examination as to compliance with –

- (1) the rules of procedure prescribed under the Act and Rules; and
- (2) substantive requirements for registrability of the mark.

4.2 Section 18(1) enacts 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.”

4.2.1 “Prescribed manner”

See the detailed provisions contained in rules 25 to 31 and 33 to 36 of the Trade Marks Rules, 2002. The Examiner should be familiar with these provisions.

The application should be made in the prescribed form and manner (in triplicate), accompanied by the prescribed fees and filed at the ‘appropriate office’.

4.2.2 Who may apply

Any person “claiming to be the proprietor” of the trade mark ‘used’ or ‘proposed to be used’ by him may make an application in the prescribed manner for registration of his trade mark.

“Any person” – is wide enough to include any individual, company, or association of persons or body of individuals, society, HUF, partnership firm, whether registered or not, Government, trust etc. [Section 3(42) General Clauses Act 1897]

Company

A company may make an application for registration of a trade mark in its own corporate name. In the case of a company incorporated outside India, the country of incorporation and the nature of registration, if any, is to be mentioned.

Firm

A partnership firm shall make the application in the names of all partners trading as XYZ. When including the name of a minor in the partnership, the name of guardian representing the minors should also be mentioned. If there is omission of the name of any partner in TM-1, omission can be corrected when supported by necessary documents. Such corrections will not constitute change in the proprietorship of the mark. (Vivekananda Match company Vs. Jupiter Match Works (1991 PTC 61). However, any new addition or deletion of name of a partner subsequent to the date of application will mean change in the partnership.

Trust

Application may be made in the name of the trust, represented by its managing trustee/chairman etc trading as XYZ.

Government

A Department of Government , Central or State/or a Government owned or controlled company may also make application for registration of trade mark like any other person.

Joint Applicant

Section 24 enables registration of two or more persons to be registered as joint proprietors of the trade mark, where the mark is used or proposed to be used in relation to goods or services connected with the joint applicants.

4.2.3 Jurisdiction for filing application (Sec.18(3))

As per rule 4, the trade mark application is to be filed at the 'appropriate office' of the Registry, within whose territorial limits, the principal place of business in India of the applicant is situate. In the case of joint applicants, the principal place of business in India of the applicant will be that of the person whose name is first mentioned as having a place of business. If the applicant has no principal place of business in India, he should file the application in that office within whose territorial jurisdiction, the address for service in India given by him (as per mandatory provision in Rule 18) is located. See Rule 3, which deals with 'Principal Place of business'.

No change in the principal place of business in India or in the address for service in India, shall affect the jurisdiction of the appropriate office, once entered. See Rule 5. Thus, a principal place of business once disclosed in the first application, will remain applicable for all subsequent applications by the same person or entity.

The application which should be filed in triplicate, *inter alia*, will include the following particulars:

4.2.4 Graphic representation

A graphic representation of the trade mark is to be given in the space provided on the application form for that purpose (size 8 cm x 8 cm). In any case, the size of such representation shall not exceed 33 cm x 20 cm with the margin of 4 cm on the left hand side. (Rule 28 read with Rule 30) [See the definition of “trade mark” and rule 2 (1)(k) which defines “graphic representation”].

4.2.5 Acceptable forms of graphical representation

Section 2(1)(zb) of the Act states that a “trade mark” means a mark capable of being represented graphically.

- In the Registrar’s view a mark is graphically represented when:

- a) the representation of a trade mark is in paper form
- b) it is possible to determine from the graphical representation precisely what the mark is that the applicant uses or proposes to use without the need for supporting samples etc;
- c) the graphical representation can stand in place of the mark used or proposed to be used by the applicant because it represents the mark and no other;
- d) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.

4.2.6 Additional representations - Rule 29

Five Additional representations are to be provided corresponding exactly with one another. In all cases it should contain the specification of goods/services and the class in which the registration is sought, with the name and address of the applicant together with the name and address of the agent (if any), the period of user(if any). It shall be signed by the applicant or his agent, indicating the name and status of the signatory.

4.2.7 Three dimensional mark- Rule 29(3).

In the case of three dimensional mark, the reproduction of the mark shall consist of a two dimensional or photographic reproduction as required in Rule 29(3).

Where appropriate, the applicant must state on the application form that the application is for a shape trade mark. Where the trade mark application contains a statement to the effect that it is a three dimensional mark, the requirement of Rule 29(3) will have to be complied with.

Rule 29(3) runs thus:

“Where the application contains a statement to the effect that the trade mark is a three dimensional mark, the reproduction of the mark shall consist of a two dimensional graphic or photographic reproduction as follows, namely:-

- (i) The reproduction furnished shall consist of three different view of the trade mark;
- (ii) Where, however, the Registrar considers that the reproduction of the mark furnished by the applicants does not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish within two months up to five further different views of the mark and a description by words of the mark;
- (iii) Where the Registrar considers the different views and/or description of the mark referred to in clause (ii) still do not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish a specimen of the trade mark

4.2.8 Transliteration and Translation - Rule 33

Where the trade mark contains a word or words in scripts other than Hindi or English, a transliteration and translation of each word in English or in Hindi should be given indicating the language to which the word belongs, at the time of filing the application to facilitate completion of data entry at the initial stage itself.

An endorsement must be entered on the Register for all trade marks containing words in a language other than English/Hindi and/or characters other than Roman/Devnagiri characters

An application will be liable to be refused unless the translation/transliteration is provided in support of the application.

Where an applicant has given the translation/transliteration, an endorsement will be entered on the system.

Where no translation/transliteration has been provided, the Examiner should request one and enter the appropriate endorsement on the system when the information has been received. Where Chinese or Japanese characters appear in the trade mark the applicant should be requested to provide their transliteration in the Pinyin system in the case of Chinese characters and the Hepburn system in the case of Japanese characters as per UK practice.

4.2.9 Priority date - Rule 26

The application may contain a declaration claiming priority , as per the Paris Convention. In such cases, it should contain the following information's.

1) Date of the earlier application

2) Number of earlier application

3) State or country in which the earlier application was filed; or where the earlier application is regional or an international application, the office with which it was filed and the country or countries for which it was filed. If the number of the earlier application is not known to the applicant at the time of filing of the application, the applicant may furnish the same within two months from the date of filing of application in India. The Registrar may extend the period if he is satisfied that due to the

circumstances beyond control, the applicant could not furnish the particulars within the initial two months period, on a request made on Form TM-56 for the purpose.

Under section 154(2) where a person has made an application for the registration of the trade mark in the convention country, makes an application for registration of the trade mark 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. That date shall be deemed to be the date of registration for the purpose of the Act. Under sub-section (3) where applications are made in two or more convention countries, the period of six months will be reckoned from the date on which the earlier or earliest of those applications was made.

The above period of six months which is the statutory requirement is to be strictly complied with for giving the benefit of priority date. Where the application is not filed within six months only the actual date of filing in India will be given and no priority date will be admissible.

4.2.10 Other mandatory requirements as stipulated in the Application Form:

Name of the applicant in full (Rule 16)

Nationality & address of applicant

Signature of the Applicant or his agent with name and status of signatory

Power of Attorney (as per Form TM-48) including the name and status of the executants

Address for service where applicable (Rule 18). In case of an application from a convention country, and persons having no principal place of business in India, their addresses in their

home country shall be given, in addition to their address for service in India (Rule 16(3)) No address for service of the agent /advocate is to be stated, where the applicant has his principal place of business in India.

Statement of user (Rule 27).- An application to register a trade mark shall, unless the trade mark is proposed to be used, contain a statement of the period during which, and the person by whom it has been used in respect of the goods or services mentioned in the application. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

Specification of goods/service- For purpose of registration, goods and services are classified in class 1 to 42, in the IV Schedule to the Rules. (Rule 22)

Single application may cover more than one class (Section 18(2))

Fees as prescribed (Rule 11).

4.2.11 Abandonment for “deficiencies”

The procedure prescribed by the Act and Rules will have to be complied with. Subject to rule 11 concerning payment of fees, non-compliance with or contravention of the procedural requirement will constitute “deficiencies” . In such cases the Registrar will send notice to the applicant to remedy the deficiencies within one month of the date of notice. If the applicant fails to remedy the same, the application may be “treated as abandoned”. See rule 36

Where a fee is payable the document will be deemed not to have been filed at the Registry until full fee has been paid. Section 105(3).

5. Substantive examination for registrability

Substantive examination will cover the following aspects :

1) **Under section 9** which prescribes “**absolute grounds for refusal**” Marks 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) Under section 11, which sets out “**relative grounds for refusal**” by reason of conflict with prior trade marks and well known marks).

3) Under section 12 to check whether mark could be registered on the basis of “honest concurrent user” when supported by evidence to that effect

4) Under section 13 to see whether the registrability of the mark is prohibited on the ground that the mark consists of name of a chemical element or an international non-proprietary name

5) To see that the mark does not offend against section 14

6) Under section 15, which governs registration of a trade mark as “a series”.

7) Under section 16, regarding registration as “associated marks”.

8) In a case where the applicant does not use or propose to use the mark, whether the case comes under section 46, read with Rule 79.

Absolute grounds

5.1 Section 9(1) of the Act enacts as follows, setting down the following absolute grounds for refusal of registration:

(a) trade marks 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) trade marks 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) trade marks 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:

Provided that, a trade mark shall not be refused registration if, before the date of application for registration, it has acquired a distinctive character as a result of the use made of it or is a well known trade mark.”

5.2 Basic objective of section 9(1)

The basis of section 9(1) is that a trader should not obtain a statutory monopoly through registration in a word which another trader might legitimately wish to use. A competitor should be of course be entitled to make *bona fide* use of the word , to describe his goods or the place of manufacture. Section 9(1) is thus to be read with section 30 , (Limits on effect of registered trade mark) Section 34 ,(Saving for vested right), Section 35 (saving for use of name, address or description of goods or services) and section 36(saving for words used as name or description of an article or substance or service) of the Act.

5.3 If a word, however, through use has become clearly associated in public mind with the goods/service of a particular trader, then it could not be legitimately used as a trade mark by a competitor. For this purpose the onus is on the applicant to show by cogent evidence that the trade mark, by reason of use has acquired distinctiveness in relation to his goods or services.

5.4 Section 9(1)(a)

Section 9(1)(a) prohibits (prima facie) the registration of trade marks which are

devoid of any distinctive character. Unlike Sections 9(1)(b) and (c), it does not give any clear definition as to the nature of the objection. Its purpose is to prohibit generally registration of marks which do not fall foul of the definition of 'trade mark' and do not fulfil the function of a trade mark; that is, they do not identify and distinguish goods or services of one person from those of others.

In the TREAT case (1996) RPC 28] Mr. Justice Jacob provided a definition of what is "devoid of any distinctive character" He said:-

What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other mark) which cannot do the job of distinguishing without first educating the public that it is a trade mark?

Objection under this section should therefore be raised in conjunction with the provisions in 9(1)(b) or (c) or both.

5.5 "Capable of distinguishing the goods or services"

A mark which has a direct reference to the character or quality of the goods/service is considered as inherently not capable of distinguishing. If the reference to the character or quality is only indirect or suggestive, the mark may be considered as possessing sufficient degree of inherent capacity to distinguish. As under the old law in determining whether a trade mark is capable of distinguishing, the tribunal should have regard to the extent to which the mark is inherently capable of distinguishing and also the extent to which it is in fact capable of distinguishing by virtue of use of the mark or of other circumstances. The fundamental principle is that "traders should not obtain any monopoly in the use of words as trade marks to the detriment of the members of the public, who, in the future and in connection with their goods, might desire to use them". York Trade Mark 1982 FSR 101(House of Lords)

5.6 How to communicate objections

All substantive objections to an application must be raised together. For this purpose, the mark as a whole must be considered. Objection must be clear and understandable. Reproducing the words of section is not accepted by courts, unless reasons are also given.

The Trade Marks Act, 1999 sets out the absolute and relative grounds for refusal. It is necessary to state the section and subsection of the Act being relied upon to support any objection, and to clearly set out the grounds for objection so that the applicant or his agent know the reason for the objections(s).

Section 2(1)(zb) of the Act will provide the basis for objection where the trade mark is not graphically represented on the application form or appears to be incapable of functioning as a trade mark at all. In the latter case there are certain to be additional grounds for objection under section 9 and 11 which should set out the reasons why the mark is considered to be incapable of distinguishing the applicant's goods or services.

Where the objection is under section 9(1)(a) of the Act (only) it is not normally sufficient simply to indicate that the mark is devoid of any distinctive character. The applicant should be given sufficient information so as to allow him to understand the reason for that objection.

The explanation may be fairly general, e.g. that Common surnames or 2 letter marks are regarded as inherently devoid of any distinctive character.

In other cases a more specific explanation is required, e.g. that -

“the mark consists of a 3 dimensional shape of a container which does not appear to be one that the public will take as a mark of origin until they have been educated to do so”.

If the objection is under section 9(1)(b) of the Act – that is the mark consists exclusively of a mark or indication which may serve in trade to designate characteristics of the goods or services – the TMR will indicate what (which) characteristic(s) of the goods or services the mark appears to designate, nothing more is required.

If a mark consists of two or more words, or a word and a device, the objection will explain whether the objection is to both(or all) elements of the mark, as well as the combination. If one word of a two or three word mark is acceptable the mark as a whole will normally be accepted. It cannot be devoid of distinctive character.

Section 9(1)(c) is somewhat different because it deals with mark or indications which “have become customary in the current language or in the bonafide and established practices of the trade” and as such they are actually believed to be in use in the trade. Where a mark consists exclusively of descriptive matter which may be used in trade, the objection will be under section 9(1)(b). Where a mark or indication is devoid of any distinctive character, the objection will be under section 9(1)(a).

It would be clear, therefore, that Section 9(1)(c) will be invoked where the mark or indication, which does not appear to describe characteristics of the goods or services, and does not appear to be devoid of any distinctive character, has in fact become customary in the trade. In those circumstances the applicant is entitled to know the basis of the objections. For this purpose, reference to any publication or advertisement may be given to support the objections.

5.7 Section 9(1)(b)- “which consist exclusively of”

As per section 9(1)(b), trade marks “which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services” shall not be registered

The scope of Section 9(1)(b) is distinct and independent of Section 9(1)(c).

Section 9(1)(b) applies to trade marks “which consist exclusively of marks or indications which may serve in trade”, to designate a characteristic of the goods or services for which registration is sought, e.g. the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of goods or rendering of service or other characteristics of the goods or service.

In order to determine whether a trade mark is excluded from registration, it is necessary to ascertain whether the mark in question is capable of being used by other traders to describe a characteristic of their goods and services. In the Double mint case, [2004 RPC 18, 327] the European Court indicated that the test is NOT whether the mark is exclusively descriptive; it is sufficient if one of the meanings of the mark designates a characteristic of the goods/services.

The same court confirmed its earlier judgment in *Windsurfing Chiemsee* to the effect that it is not necessary for a sign to be in current use as a description before it is susceptible to an objection under Article 7(1)(c). It is sufficient that the sign is capable of being used as a designation of the goods/services. Article 7(1)(c) of the Community Trade Mark Regulation corresponds to Section 9(1)(b) of the Trade Marks Act 1999 and the court's findings may therefore be taken as a guiding principle in the application of section 9(1)(b) of the Act.

When examining marks consisting of unusually juxtaposed words and marks which consist of only part of a natural description for the goods/services, the court's judgment in *Baby-Dry* [2002 RPC 17] provides guidance. *Baby-Dry* also assists in an assessment of whether a trade mark consisting of two or more words consists *exclusively* of a descriptive term, when the words in question are juxtaposed in a manner which renders the mark resistant to natural descriptive uses. Although the court stated in *Doublemint* that it is sufficient if the sign in question is "capable" of being used as a description of the goods/services, this must be taken as applying only where there is a reasonable likelihood that the sign in question will serve a descriptive purpose in the ordinary course of trade. What must be considered is whether third parties are likely to use signs corresponding to the trade mark applied for in order to describe characteristics of the goods/services covered by the application.

This assessment will consider the position as at the date of the application, but it will also take account of new uses that were reasonably foreseeable as at that date. It is important to take account of distinctions between a trade mark and a description of the goods/services arising from the *omission* from the trade mark of words or other components that would be essential in order for

the sign to work as a description. For example, compare “Keeps Your Baby Dry.” with “Baby-Dry”. It must be borne in mind that an abbreviation of, a longer descriptive term may itself be a term which “may serve, in trade, to designate the goods/services or their characteristics”. Shortening a longer descriptive phrase will not therefore *automatically* result in a trade mark free from objection under Section 9(1)(b).

In determining whether a trade mark consists *exclusively* of a designation of the goods/services, differences of a kind which may go unnoticed by an average consumer, will be disregarded entirely. The presentation of a descriptive trade mark in a graphical form which corresponds to common forms of presenting descriptions in trade, such as the use of a colour or a simple border, is not sufficient to resist an objection under Section 9(1)(b).

It is well established that each of the sub-sections of Section 9(1) of the Act operate independently of one another. However, a mark which consists exclusively of a sign which may serve, in trade, to designate the goods/services or their essential characteristics is liable to be devoid of any distinctive character. Consequently, the grounds which give rise to an objection under Section 9(1)(b) are also likely to support a further objection under Section 9(1)(a). However, the *absence* of a Section 9(1)(c) objection does not preclude the possibility of a Section 9(1)(b) objection being raised on grounds other than that the mark is descriptive of the goods/services covered by the application.

5.8 “may serve”

The Registrar considers that the expression “may serve in trade” means that there exists a reasonable likelihood that other honest traders will wish to use the mark in question to designate characteristics of the goods/services. It should not be interpreted as meaning that other traders must use the mark in question (in the sense that there are no/few alternatives). On the other hand a theoretical possibility will not be enough if there is no real likelihood.

The expression “may serve” is to be interpreted “as it does or is liable to serve” . The formulation shows that a sign or indication must be refused registration if it may serve in trade to designate

characteristics of goods /service without its being necessary to show that the sign or indication is actually used or needed by the trade in question. [See Kerly para 7.67 (13th edition)]

5.9 'kind'

The expression "kind" would include the name of the goods or services claimed and any words recognized as indicating size or type. Obviously generic descriptions of the goods or words which are the only available method of description of the goods, would not be found to be capable of distinguishing, eg. words such as "Extra large" or "Large" or "Small" would fall in this category and as such not allowable in respect of any goods or service.

5.10 "Quality"

Laudatory words such as GOOD or BEST are unacceptable for any goods or services since all traders should be equally free to use them in the course of advertising their products. Some words may be unacceptable for a vast range of items, but may be acceptable for others e.g. HIGH TECH would not be acceptable for use in connection with any technical items, such as computer, but it may be accepted for other goods e.g. foodstuff. CLASSIC would not be acceptable for furniture or cars, but may be acceptable for medical apparatus like scanners .

5.11 "Quantity"

Numeral 12 would not , for e.g. be acceptable for wine (12 bottles = one case of wine) or 20 or numeral 200 as a pack of cigarettes. Similarly "1000" would not be acceptable for butter (1000 gm – 1 Kg)

5.12 "Intended purpose"

Words which refer directly to the use to which the goods are put or which describe the consequences of providing the service are not acceptable. Example are : KETTLE CLEAN for preparations for cleaning kettles ; TWIST AND CURL for hand implements

operated by a twisting action for curling the hair ; SLIM AND FIT for slimming preparations . Words which describe the effect of the goods / services would also be open to objection as a characteristic of the goods /services, for example RUSTFREE for paints; and articles made of steel.

5.13 "Value"

Words or symbols which merely serve to indicate the worth, merit or importance of the goods or services are not acceptable . Examples are "TWO FOR ONE; WORTH THEIR WEIGHT IN GOLD.

5.14 "Geographical names" – Registry practice

The name of a place applied in relation to goods/services will prima facie be taken to indicate their origin, and hence non-distinctive . The principles applied to registration of geographical names are the same as those applicable for registration of descriptive words(See Shredded wheat case 1940 RPC 137)(HL)

However, it may be considered for registration on the basis of evidence of acquired distinctiveness by reason of use - proviso to section 9(1) of the Act.

- Name of places with populations of less than 5000 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 is considered more important than size.
- In the case of Industrialized countries such as U.S.A., Japan, or Europe, while population size of 100,000 is considered reasonable for acceptability, it is to be borne in mind if the location has reputation for the type of goods or services, the size of the

location or its remoteness will not help acceptability of the geographical name as a trade mark.

- Name of rivers, mountains, seas, lakes, etc will be considered prima facie acceptable in respect of goods, not associated with the geographical feature. For example, in respect of “fish” in class 29 the names of rivers or seas will not be acceptable. “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, Dalal street which have strong links with financial services such as stocks and investments will entail objections in respect of such services or related goods.

Proviso to section 9(1), however would enable marks to be accepted, if before the date of application, it is shown to have acquired a distinctive character as a result of the use made of it or it is a well known mark.

5.15.1 Names of Small Geographical Locations

Names of places with populations lower than 5,000 in India will normally be acceptable prima- facie. In such cases it is thought that the likelihood of traders wishing to use place names in relation to their goods is so remote that it does not represent *a reasonable likelihood* of the mark being used in trade to designate geographical origin.

Nevertheless, where there are 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 trade mark[55 RPC 253, page 260(HL)]

In the case of overseas names the location is quite often more important than size. In the case of industrialized areas such as the USA. Japan and Europe , 100,000 population size is a reasonable

measure. In the case of names in China or South America , populations of up to 250,000 could be considered . It is also important to bear in mind that these are guideline figures and particular circumstances may justify different levels . For example, if a location has a particular reputation for the type of goods or services involved , then the remoteness, size of the location or population will not justify acceptance of the application.

5.15.2 Geographical names used fancifully

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.

5.15.3 Names of rivers, seas & deserts etc.

The names of rivers, seas , lakes and mountains etc. are usually accepted prima-facie for goods which are not associated with these geographical features . However, "Ganga" or "Kaveri", the name of rivers, which are also better known personal names, can be registered only on the basis of acquired distinctiveness. **Names of rivers, seas and lakes would not normally be acceptable as marks for fish or fish products. The names of mountains would not be acceptable as marks for agricultural produce. Some rivers flow through heavily industrialized areas and they would not be acceptable , for example, "Treated with Ganges water " is a common expression . As regards oceans , the practice is to accept ATLANTIC and PACIFIC, for goods / services which are not directly relevant, and used in a fanciful manner.** *See Dan River TM case (1962) RPC 157, where the name was refused for textiles.*

In the case of deserts, care needs to be exercised as the development of desert areas for agricultural or industrial

use has increased significantly in recent years. However, for a wide range of heavy and sophisticated goods acceptance is possible, though the circumstances of each application must be considered on its merits. Again reputation is a factor to be taken into account. SAHARA would not be accepted for dates, or 'Surat' and "Kalahari" for diamonds.

5.15.4 Natural produce

In respect of natural produce, population figures are not as reliable a guide to acceptability. Natural produce would include fresh vegetables, fruits, eggs, milk, cream, water and minerals, but not processed foods or beverages.

Where the geographical location covers a large area (even if sparsely populated) and/or has a reputation in the goods the application will face an objection

It will usually be possible to accept the name of a small locality provided that the place has no reputation for the goods (particularly if the location is also remote).

5.15..5 The names of streets & roads

These are generally acceptable unless the geographical name is associated with the goods/service. For example, DALAL STREET which is well known for stock market would not be acceptable for Stock Market Services, nor names of popular roads for a wide range of consumer goods.

Well known names of foreign streets, roads etc are similarly dealt with: 2nd avenue etc is almost be on par with Dalal street for fashion goods, and Wall Street for example would be objectionable for services connected with stocks and shares or investments.

5.15.6 Names of Districts

Generally, the districts carry the name of headquarters of concerned town/city, and as such use of such names will attract the same objections applicable to geographical locations. Acceptance of such names will depend upon the extent of reputation of the place for such goods /services.

Where the names do not correspond with precise geographical areas or administrative units e.g. SWISS COTTAGE, will be less objectionable unless they are well known for particular goods or services.

5.15.7 Names of suburbs of big cities

In India, many suburbs of Mumbai, such as Andheri, Borivali or Bhendi Bazar etc., are as large and well known as many towns. They should be considered as per a town with comparable population figures. In the case of an application to register the name of a district of Mumbai, examiners should consider whether the name is likely to be seen as fanciful use of the name or as a plausible indication of geographical origin.

In deciding whether the name is likely to be seen as fanciful examiners should consider

- a) Whether the goods/services are likely to be generally sold/provided from the area concerned; and if so;
- b) whether the use of such name in relation to the goods/services are likely to indicate the origin of goods/services.

5.15..8 Towns with company names

In some rare instances, applicants may be able to show that they established their business at a particular location and that subsequently a town grew up around the

business and adopted the same name. Any reputation which the town has in respect of the products concerned originates from the business . In such cases prima facie acceptance is normally possible for such goods. For example TATANAGAR for steel.

5.15.9 Different approach for service marks consisting of geographical names

The Registrar in India takes the view that there is a significant difference between the use of geographical names as trade marks for services , as opposed to trade marks for goods and that there is much more scope for acceptance in relation to services . Goods are almost invariably transported from the area and sold elsewhere in India, whereas a service may be provided generally in a particular locality. Accordingly, while geographical limitations will not usually overcome objections under Section 9(1)(b) in respect of goods; in the case of service marks, there could be a more liberal approach.

5.15.10 Local services with geographical names-Entry of geographical limitations to overcome objections .

Where geographical name used as a trade mark in respect of service has acquired a secondary signification and a distinctive character by reason of such use, it may be register able, e.g. BURDWAN for plumbing services, with a territorial restriction as “not including any services provided in Burdwan or within a 50 km radius of that location”. It is extremely unlikely that the public would recognize Burdwan as being an indication of geographical origin of a local service in places outside of Burdwan and the surrounding area. If unrestricted national registration rights are required, evidence of factual distinctiveness to justify such claim by a single entity must be provided.

In all cases there should at least be a "buffer" zone of approximately 50 km between the name of the mark and the location where the services are provided. For example, in the case of Mumbai Dry Cleaners it would be necessary to exclude services provided in Mumbai. The exclusion should extend to a 50 km radius of the location(s).

In respect of local services for single Indian geographical place names, where the population is very small, i.e. under 5,000, such marks may normally be accepted prima facie and without entering a geographical limitation. The likelihood that more than one service provider would wish to distinguish services by using a place name in such small locations is very remote.

5.15. 11 National and International services for Indian geographical names

5.15.11.1 Under 5,000 population

In respect of National and International services for Indian geographical names, if the population is under 5,000 accept prima facie and without any geographical limitation or exclusion. For example, allow the mark for village VALIV (pop. less than 5000) in respect of" travel agency services'.

5.15.11.2 Over 5000 population

In respect of National and International services for marks consisting of well known geographical locations with populations over 5,000 e.g. ASALFA cannot be accepted prima facie since they are likely to indicate a geographical origin of the services. Such marks may be acceptable on proof of factual distinctiveness and without a geographical exclusion of the named location and surrounding area.

5.15.12 Two or more Indian geographical names combined

Regardless of population size these combination names may be acceptable prima facie (and for any type of service) provided the combination of location has no reputation for the services, e.g. VASAI - WADALA for "building society services". Where the combination of locations does have a reputation e.g. MUMBAI - PUNE for "information technology or financial services", objection will arise under section 9(1)(a) and the application should not be accepted without evidence of factual distinctiveness under proviso to section 9(1).

5.15.13 Foreign geographical names

Regardless of population size or type of service, these must be considered on the basis of whether the name of the location has a reputation for the service and whether other traders with a business in India are reasonably likely to wish to use the name to indicate the geographical origin *or other characteristics* of their own such services. In many cases the use of foreign geographic locations as trade marks for services would be fanciful, e.g. KARACHI for "shoe repairs"; as would KANSAS FRIED CHICKEN for **restaurant services**. **Prima facie objections would arise if the place name has a connection or reputation for the service claimed e.g. PARIS for fashion design**", MADRAS for "Masala Dosa" or "Italian" **for restaurant services (indicates type of food served)**.

6. Registrability of Geographical Indications

The law governing registration of geographical indications in India is governed by a separate legislation namely the Geographical Indications of Goods (Registration & Protection) Act, 1999. Geographical Indication is defined section 2(1)(e) as follows:

“Geographical indication”, in relation to goods, means an indication which identifies such goods as agricultural goods, natural goods or manufactured goods as originating, or manufactured in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of such goods is essentially attributable to its geographical origin and in case where such goods are manufactured goods one of the activities of either the production or of processing or preparation of the goods concerned takes place in such territory, region or locality, as the case may be .

Explanation – For the purposes of this clause, any name which is not the name of a country, region or locality of that country shall also be considered as the Geographical Indication if it relates to a specific geographical area and is used upon or in relation to particular goods originating from that country, region or locality, as the case may be”.

6.1 Prohibition of registration of geographical indication as trade mark:

Section 25 of the GI Act prohibits registration of “geographical indication” as trade mark or invalidate the registration of a trade mark either *suo moto* or at the request of a interested party. The basic intention of section 25 is to prevent appropriation of a public property in the nature of a GI by an individual as a trade mark leading to confusion in the market.

Section 26 of the GI Act however protects the trade mark consisting of a geographical indication which has been applied for or registered in good faith before the commencement of the GI Act. Application form TM-73 prescribes the manner in which request for refusal or invalidation of registration of a trade mark under section 25(a) read with rules 74(2) of the GI Act and Rules is to be filed. Such an application is to be filed in triplicate along with the statement of case accompanied by an affidavit .

7. Other characteristics of goods or services

Under this category will come marks which are apt to describe any character or quality of the goods/services, other than those specified. Straightforward representations of cars, for example, cannot be distinctive **in respect of** car cleaning preparations because traders in such goods use illustrations of cars in their advertisements.

Marks which describe the subject matter of publication, e.g. **computer programmes, etc.**, in respect of computers would be open to objection under this heading.

8. Section 9(1)(c)

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” which is concerned with the goods or services covered by the application. The question is whether the mark is used in the sense described above to designate goods or services of the relevant kind. Use of the mark by consumers **in the course of trading in the goods or services** is just as relevant as use by traders in the goods/services. The use does not have to be for the purpose of designating characteristics of the goods/services in order to fall within the prohibition.

The basis of law in section 9(1)(c), which corresponds to section 3(1)(d) of U.K. Trade Marks Act, 1994, is the recognition of the well established principle that the true meaning of ‘trade mark’ is the association of the mark with one person’s goods or services. If it is found that a large number of people have been using the same mark in the relevant trade, then it becomes a practical impossibility to say that the mark is associated with any one person’s goods. [See 24 RPC 697, p.716.]

When a mark is in common use in the trade or when it is open to the trade to use, the mark is said to be ‘common to trade’ [See *Reckitt & Colman v. Borden* (1990) RPC 341 (HL)] and it ceases to be a trade mark 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, star devices for brandy, etc.

However, in the case of a composite mark, “A man may have used characteristics or factors, in no single one of which he could claim a monopoly, but which, in combination, create a result in which he can claim a monopoly when once it is proved that it is distinctive as identifying his goods”. [45 RPC 36, page 46]. For this purpose, the mark must be considered as a whole.

9. UNCONVENTIONAL TRADE MARKS

The following types of marks will come under the category:

- Colour trade marks
- Sound marks
- Shape of goods, packaging,
- Smell trade marks
- Holograms

9.1 Color trade marks

In order to constitute a trade mark, a color or combination of colors must be capable of distinguishing the goods or services of one trader from those of other traders. If a particular color 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 would lend distinctiveness as a badge of origin.

9.2 Single Colours

A single colour may be register able 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. See Dyson Ld's Trade Mark Application 2003 RPC 47.

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.

In some cases single colours may also attract additional objections under Section 9(1)(b) and (c) of the Act if the colour sends a descriptive message or the colour is customary in the trade i.e. the colour RED for fire fighting services, or the colour GREEN for ecological goods/services. There may be occasions where colour applied to the goods themselves may be inherently more distinctive than when the colour is applied to the packaging; for example, GREEN beer may be quite distinctive, yet the colour GREEN applied to a beer bottle or can would be non-distinctive.

The examination of single colour marks requires careful analysis, because there is a public interest in not limiting the availability of colours for other traders. Each case must be assessed individually.

In the UK, a practice has been established to allow marks consisting of colour alone to be graphically represented if they are filed in the form of a written description of the colour(s) (eg dark blue) and are accompanied by the relevant code(s) from an internationally recognised colour identification system, in existence e.g. Pantone®, RAL and Focoltone®. The law or practice in India does not provide for such interpretation. In this connection, the following view expressed in the official practice of U.K. TMR is more relevant to our practice.

“There are limits to what can reasonably be expected of third parties. It must be reasonably practicable for persons inspecting the register, or reading the Trade Mark Journal, to be able to gain an understanding from the graphical representation of what the trade mark is. Representations which are precise but impossible to interpret without costly specialist equipment or services, place too high a burden on third parties and are likely to be rejected because they are not “easily accessible.” Accordingly, a mark defined as “a blue bottle of optical characteristics such that if the wall thickness is 3mm the bottle has, in air, a dominant wavelength of 472 to 474 nanometers, a purity of 44 to 48%, an optical brightness of 28 to 32%” was rejected by Appellate authority in Ty Nant Spring Water Ltd’s Application [2000] RPC 55, because it would require third parties to use a spectrophotometer to ascertain whether a particular colour was or was not

covered by the description, and in fact served to veil the identity of the sign (cobalt blue).

The views of TMR in India are no different from what is quoted above. Strong evidence should therefore, be required to demonstrate factual distinctiveness for registrability of colour marks in India.

9.3 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 what they are applied to. 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.

As has been made clear by the European Court of Justice, there is no reason why, in principle, colour(s) cannot be registered in the abstract, as opposed to specific applications of colour such as being applied to the exterior of the goods themselves, or to their packaging.

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 recognized 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 centers, it may be advisable to define the mark in this way and establish claim for registration of mark limited to colours under section 10 of the Act.. It is not permissible to amend the trade mark application after it has been made in ways which substantially affect the identity of the mark.

9.4 Word Marks constituted by names of colours

Word marks, which consist solely of names of single colors, are likely to lack the required inherent distinctiveness for registrability unless the particular colour is **unusual** or unlikely to be needed for use by competitors for the goods concerned. Names of some combination of colours can appear fanciful in relation to goods, or more probably services, and may be inherently registrable, for example, PEA-GREEN for travel services, or “Red and White” for cigarettes.

10. Sound marks

10.1 Graphical representation

The law does not explicitly exclude “sound marks” from registration nor does it say that a trade mark must be visually perceptible. It only provides that the trade mark must be “capable of being represented graphically” besides capable of distinguishing. Sound marks, in a trade mark sense, are extremely rare.

Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words. According to British practice, sound marks, like smell marks, are not in themselves capable of being perceived visually, but they must nevertheless fulfill the requirements of being represented graphically on the application form. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. It is sufficient that the sign is easily intelligible. To this end-

1) applications for sound marks must clearly state that they are sound marks. Otherwise the application will be examined 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 staff divided into measures and showing, in particular, a clef, musical notes and rests, indicating relative value, and sharps, flats and naturals (accidentals).

10.2 Assessing distinctive character of sound marks:

The acceptability of a sound mark must, like words or other types of trade marks, depend upon whether the sound is or has become a distinctive sign; that is, whether the average consumer will perceive the sound as meaning that the goods or services are exclusively associated with one undertaking. Consideration should also be given as to whether other economic operators are likely, without improper motive, to wish to use the sound in the ordinary course of their business. However, it is difficult to see how more than a few bars of classical music can function as a trade mark. Consequently applications to register whole or large sections of classical pieces are likely to face objection on the grounds that they are not likely to be taken as a trade mark. Where the mark consists of a non-distinctive sound but includes other distinctive elements, such as words, it will be considered as a whole.

Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness. In particular, the following will fall in this category :

- a. very simple pieces of music consisting only of only 1 or 2 notes;
- b. songs commonly used as chimes;
- c. well known popular music in respect of entertainment services, park services;
- d. children's nursery rhymes, for goods or services aimed at children;
- e. music strongly associated with particular regions or countries for the type of goods/services originating from or provided in that area.

11. 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.

As has been held by the European Court of Justice, an olfactory (smell) mark does not satisfy the requirements of graphical representation if it is presented in the form of a chemical formula, by a description in written words, or by the deposit of the odour sample or by a combination of those elements.

Although the ECJ Court found that an olfactory mark was, in principle, capable of registration, in practice it is going to be difficult to represent such marks graphically. The definition of 'trade mark' in the Indian law requires the mark to be "capable of being represented graphically". So unless this requirement is satisfied, it does not constitute 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". The purpose of graphic representation has been explained thus: "it is essential for traders to be able to identify with clarity what the registered trade mark is. The first question that arises when infringement is in issue is whether or not the alleged infringing mark is identical to the trade mark registered. If it is, and is used in relation to the same goods, the trade mark has an absolute monopoly. Where, however, the mark is not identical but merely similar, the monopoly is restricted to uses, which create the necessary likelihood of confusion on the part of the public. This is the fundamental aspect of the law and it is for this reason that the graphical representation, being the means by which the trade mark is defined, must be

adequate to enable the public to determine precisely what the sign is that is the subject of registration.” 1999 RPC 879, page 885.

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)] An application which does not meet this requirements will face an objection under this section and in the case of “smell mark” the greatest handicap will be the inability of traders to meet the requirements for graphical representation.

12. Holograms

12.1 There is nothing, in principle, to prevent holograms from operating as trade marks, provided they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

For multiple feature hologram marks, to meet the graphical representation requirements it will be necessary for the application form to contain representations of each of the various views depicted in the hologram. This will ensure that third parties can clearly see all the material features of the mark. For a very simple image, where the essential features do not change according to the angle at which it is viewed, multiple views may not be necessary and a single representation may be acceptable.

The distinctive character of a hologram mark will be assessed in the same manner as applicable to the assessment of a word mark or a device mark.

13. Shape of goods - Section 9(3)

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

13.1 Section 9(3)(a)- “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. However, it is important to bear in mind that there may be more than one such basic shape, or several usual variations, e.g. door handles may be round or lever style. To this extent, there is some overlap with Section 9(3)(b). See 1999(E.T.M.R).816, Phillips case.

13.2 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. In this connection the ECJ ruled, in *Philips*, that this subsection must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result.” This does not automatically mean that a shape is unregistrable even when all its features serve some functional purpose. If 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 Court also explained that “necessary” does not mean “the only”; “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. This prevents a limited amount of economic operators in a given trade area permanently monopolizing shapes which achieve a particular technical result. It is in the public's interest that legal protection of pure functionality is confined to patent rights, which are subject to demarcation in length of time.

13.3 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. This provision is intended to prevent the securing of a permanent monopoly in the type of design of goods which should be protected under Designs legislation, limited in length of time. However, shapes which are, or have been, the subject of registered designs are not excluded from registration unless the shape adds substantially to the value of the goods. It is therefore appropriate to consider whether a substantial proportion of the value of the product to the consumer is attributable to its shape. In many cases this will require a comparative evaluation of the value of the shape in question as compared to those used on competing products. However, this approach may not assist where purely ornamental products are concerned, such as jewellery, where the shape of the product will inevitably also account for a substantial part of the value of competing products.

There is no distinction in law between different types of marks with regard to the test for distinctiveness. As was found by the European Court of Justice [2003] E.T.M.R. 78, the assessment for distinctiveness under section 9(1)(a) must take account of the public interests underlying that provision, which is to keep characteristic shapes free from the constraints of a statutory monopoly.

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 trade marks. 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”. Consequently, it would appear that in deciding which shapes are the “norm” for the sector, account is also to be taken of shapes which are likely to become the norm. It may be easier to show that a shape has the necessary distinctive character where there is evidence that, contrary to the normal assumption made about consumers habits, consumers in the relevant sector do in fact rely upon the appearance of the shape of the product or its packaging as a means of identifying the origin of the product. An example of this is the use of vehicle radiator grilles, which are used by manufacturers as means to differentiate their products, in a trade mark sense. This formed the basis for the European Court of First Instance judgment in the *Daimler Chrysler “Jeep” grille* case (T-128/01) where it was found that the appearance of the grille did have the necessary capacity to distinguish the product of that vehicle manufacturer from those of other economic operators in that trade.

13.4 Shape of packaging

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.

13.5 Practice

To sum up-

Section 9(3) is intended to prevent permanent monopolies being created under the Trade Marks Act, by reason of trade marks constituted by the shape of goods giving the proprietor a permanent and substantial advantage over his potential competitors. It is considered that will create unacceptable distortions in the market.

In order to avoid an objection, a mark constituted by a shape must be sufficiently different from a shape which is -

- a) characteristic of the product;
- b) the norm or customary in the sector concerned

In other words the shape should not be descriptive, must stand out from the crowd and in the case of new product development, must not be a shape likely to be taken for the product concerned

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.

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)

13.6. “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 trade marks. However, besides distinctiveness, functionality aspect as per section 9(3) will also arise.

See “Swizels case” 1999 RPC 879 where the Appellate court held “ it is essential for traders to be able to identify with clarity what the registered trade mark is This is fundamental aspect of the law and it is for this reason that the graphical representation being the means by which the trade mark is defined, must be adequate to enable the public to determine precisely what the sign is that is the subject of registration.... I cannot accept that the description as it stands on the form is sufficient to enable a trader to determine precisely what the sign is.... The description must stand on its own to identify the trade mark”.

14. Nature of goods /services irrelevant for refusal:

The explanation under sub-section (3) of section 9 enacts “the nature of goods or services in relation to which a trade mark is used or proposed to be used shall not be a ground for refusal of registration”

The above provision brings the law in harmony with Article 15(4) of the TRIPS Agreement and Article 7 of the Paris Convention for protection of Industrial Property. The effect of this provision is that protection of industrial properties should be independent of the question whether the goods covered by registration may or may not be sold in the country concerned. For instance the food and drug law may prescribe norms concerning the ingredients of the food products or the effect of a pharmaceutical product and allow the same only after prior marketing approval of the competent authority.

Registration of trade mark for such goods is independent and cannot be refused on the ground that marketing approval for such goods has not been obtained or refused by government under the law. Non-use of the registered trade mark under such circumstance is explicitly protected under section 47(3) of the Act.

15 “Notional and fair use”

Section 2(2)(c) enacts that “any reference to the use of a mark in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods.” Similar is the law in relation to services. There is no reason to limit the user to use on goods or to sale of goods bearing the trade mark. See AIR 2003 SC 3377.

The concept “Notional and fair use” refers to how a trade mark may be used in the market-place and, consequently, will have a bearing on how distinctive the mark will be in its various modes of use. This will include use on business papers, on packaging and in advertising, i.e. not just on mere conventional means of use . A mark may lose trade mark significance when encountered in a promotional context rather than physically used on the goods. Care must be taken when examining a mark which “reads” into the goods or services.

“Notional and fair use” of a mark registered in block capitals will also include use in differing typefaces and in upper and lower case letters.

Section 29 of the Act recognizes as “use” for purposes of infringement the use of trade mark in the following circumstances:

- a) When the mark is affixed to goods or the packaging thereof;
- b) When goods are offered or exposed for sale or put on the market, or stocked for those purposes under the registered trade mark,
- c) When goods are imported /exported under the mark; or
- d) When registered trade mark is used on business papers or in advertising.

16. Basis and justification of objections:

Section 18(4) of the Act empowers the Registrar to ‘refuse the application or’ ‘accept it absolutely or subject to such amendments,

modifications, conditions or limitations, if any, as he may think fit.’ Applicants and their representatives are entitled to expect the basis and justification of any objections to be clearly explained – see section 18(5). Consequently, Examiners will provide the factual and legal basis so that applicants can understand the objection(s) being taken against them and, if they wish, challenge the Examiner’s findings . There cannot be any hard and fast rules about the wording to use when objecting to a mark under any of the sections of the Act.

Each case will need to be adapted to meet specific requirements and it should not look to be stereotyped.

17. Devoid of distinctive character - Section 9(1)(a)

The fact that a mark strongly *alludes* to characteristics of the goods/services is NOT a proper basis for a Section 9(1)(a) objection. Applicants can therefore expect an objection that the mark will be seen as a description of the goods/services listed in the application to be raised under Section 9(1)(b) or (c) or not at all.

A Section 9(1)(a) objection may arise when the mark consists of, for example:

- a) a description of the goods/services combined with some other noticeable but non-distinctive element; eg. words ending with “master” eg. “Lawn Master” for lawn mover; “Coldmaster” for refrigerators etc. However where the word is deemed to have no direct reference (including a covert and skilful allusion) may be acceptable – eg. “Globemaster” for cycles.
- b) a mark which appears to serve a merely decorative purpose in relation to the goods/services concerned;
- c) the shape of goods which does not stand out sufficiently from the norm to be distinctive, or does so in a way which fails to counter on the mark with a trade mark character, e.g because the unusual features of the shape serve an aesthetic or functional purpose;

- d) a mark which is simply too insignificant to constitute or be taken to be a trade mark for the goods/services concerned, eg colours, very simple geometrical shapes, such as a circle;
- e) a description or slogan of an undertaking or its policies which could equally apply to any undertaking in the field, eg “The ones you want to do business with”;
- f) a description of goods/services *not* included in the application but which are so similar to the goods/services covered by the application as to deprive the trade mark of any distinctive character for those goods/services.
- g) A word, which according to its ordinary significance, is a surname/personal name
Where the word has a better known meaning, other than as a surname (eg. “Bull”, “Jury” etc) it may be regarded as a non-ordinary one for being accepted for registration as a trade mark.

18. Name marks:

The expression “mark” is defined to include inter alia “name”. See section 2(1)(m). See also the definition of trade mark in section 2(1)(zb) to mean “ a mark capable of” A name mark may consist of personal names, surnames, full names, trade names, famous names, geographical names, domain names, name of sect, caste or tribe.

Though the Act does not preclude any person from adopting his own name as a trade mark in connection with his trade, prima facie such a trade mark will not be considered as “capable of distinguishing of goods or services of the applicant from those of others” having the same name . Indeed section 35 explicitly recognizes right of a person to trade in his own name by enacting that nothing in the Act shall interfere with any bonafide use by a person of his own name .

19.1 Trade Marks consisting of surnames

A surname is prima facie non-distinctive as a trade mark . A surname used with a laudatory word will also attract objection. See Fantastic Sam's Case (1990) RPC 531, which was refused registration for hair dressing service. Also see Laura Ashley TM case (1990) RPC 539. Where a surname has a better known dictionary meaning (eg. Brown) the surname objection is diluted.

However, the trade mark BROWN would face an objection under Section 9(1)(a) & (b) of the Act if applied for in relation to 'sauces' or 'sugar' because it is a word which may serve, in trade, to designate the kind of goods. Similarly, the same word would not be acceptable as a trade mark for 'paints' because it designates a characteristic of those goods (colour).

Where, in its ordinary significance, it is a surname and also a non-descriptive word, objection may be taken . See Cannon TM (1980) RPC 519, 1981 IPLR 121 where mark was refused registration.

19.2 Surnames with initials and full personal names

Full names and surnames with initials will be treated in the same way as surnames alone. The full names have, by their nature, a greater capacity to distinguish the goods/services of one undertaking than a surname per se. A more practical and liberal approach may be adopted in such cases for acceptance. Subject to section 14, names of famous persons of historical significance may qualify for acceptance. e.g. Julius Caesar.

19.3 Mis-spelt surname

Mis-Spelt surname or their phonetic equivalent are not to be treated differently. They will be on par in terms of objection as a surname properly spelt.

20 Famous Names

Where a famous name is concerned (and where the reputation does not stem from a trade in the goods/services applied for) it is possible that, when used in relation to certain goods/services, the name may appear to the average consumer as an indication that the goods/services are *about* the person whose name it is rather than as an indication that the goods/services are supplied by, or

under the control of, one undertaking. However, provisions of section 14 will have to be applied.

The Court of Appeal decided that “Elvis Presley” was not registrable under the 1938

Act for memorabilia products in Class 3: see [1997] RPC 543.

See also Arsenal v Reed [2001] RPC .

20.1 Media.

The names of famous persons or groups may serve as trade marks for printed publications, recorded sounds, films, videos, TV programs, musical or live performances etc as use of the mark on such goods or services would be likely to imply some form of connection control of, or guarantee from, the holder. Such cases will be considered subject to section 14..

20.2 Mere Image Carriers

The name of a famous person or group is likely to be perceived as merely descriptive of the subject matter of posters, photographs, transfers and figurines. Names of famous persons or groups are therefore unlikely to be accepted by consumers as trade marks for these goods because they will usually be seen as mere descriptions of the subject matter of the product. Objections will arise under Section 9(1)(a) & (b) read with section 14 of the Act.

20.3 Objection under section 18(1)read with section 11(10) and 14 – Bad Faith

Where third parties apply to register the name of a famous individual or a recently deceased famous individual an objection under Section 18(1), read with section 14 and 11(10) of the Act may be appropriate, regardless of the goods and/or services with which the famous individual is associated. For example, an application to register the name of a famous fashion model for “clothing” or “cosmetics” would be liable to an objection because it is an obvious attempt to take unfair advantage of the person’s reputation. Conversely, an application to register a name [which corresponded to that] of a famous fashion model for “agricultural machinery” would not, *prima facie*, be liable to a bad faith

objection. However, the application may still be open to objection under section 14.

Applications to register the names of famous musical groups will not normally at the examination stage face an objection. This is because to firmly establish who are the rightful owners of the names of musical groups often requires evidence and is therefore best left to be determined in opposition proceedings.

Bad faith objections can be overcome if permission to the registration of the mark is obtained from the individual or his/her legal representative.

21. Pictorial representations or names of well known buildings

It will NOT be generally necessary to take an objection under Section 18 read with 11(10) except in the case of applications to register the names or pictures of well known buildings in respect of films and videos, printed matter and photographs falling within Classes 9 and 16 and tourist services within Classes 35, 39 and 42 on the ground of lack of distinctiveness under section 9(1)(a), especially for goods in class 9 & 16..

22. Names of well known fictional stories/characters

The names of fictional characters/stories may be accepted *prima facie* for any goods/services *provided that they are likely to be taken as a sign indicating the goods/services of one trader*. See the Tarzan case 1970 RPC 450 for useful guidance.

If the name in question is **both long established and well known** it may have passed into the language. In that case its primary signification is likely to be viewed as the name of the story/character concerned. In such instances, the name should be regarded as a sign which may serve in trade to designate a characteristic of goods/services featuring the story/character concerned and objection should be raised under Sections 9(1)(a) & (b) of the Act.

For example, SHERLOCK HOLMES is a name that has been used by many traders over the years in order to describe a story and a character who appears therein. As such it is non-distinctive for

books, films etc. featuring that character. In other cases, such as SPIDERMAN, where the name appears to have been used by one party as a trade mark for magazines, the name may be capable of identifying the goods of one trader notwithstanding that it is also the name of a well known fictional character. The question who coined the name is not decisive if it has subsequently come to be seen *purely* as the name of a character/story. Similarly, the question whether the applicant has copyright or some other exclusive right to publish the printed material commonly associated with the title/character concerned is to be seen. The question is whether the sign is likely to be taken as a badge of origin.

Where it appears that the fictional name applied for is unable to distinguish the goods/services of one trader the application is likely to face objections under Section 9(1)(a) & (b) of the Act. Depending upon the nature of the mark in question, this objection may be taken in respect of printed matter; posters; photographs; figurines; films; videos; TV programs; organization of plays and shows; toys, badges and fancy dress costumes (this is not an exhaustive list).

In deciding whether a fictional character, is 'well known and long established' to the extent that it has entered the language, care should be taken to avoid taking into account the applicant's own efforts to promote the name after the date of application. On the other hand, if the name in question had entered the language prior to the date of application, subsequent concerted promotional activity by the applicant should not benefit the applicant even if it has brought about a temporary high level of association with the applicant.

23. Representations of well known fictional characters

Similar considerations apply to representations of well known fictional characters. However, it should be borne in mind that (unlike with a name) there are many ways of depicting the same character and a representation of even a widely used fictional character may be acceptable if it is shown to have acquired distinctiveness by reason of use.

24. Letters and Numerals

In section 2(1)(m) the definition of the expression “mark” includes inter alia “letter” and “numeral”. The definition of “trade mark” means “a mark capable of” The law therefore recognizes a trade mark may be constituted by a letter or letters or a numeral or numerals. Whether a letter or numeral mark can be registered prima facie will depend upon whether the average consumer of the goods/services at issue would expect all such goods/services offered for sale under the sign to originate from a single undertaking. If the sign does not possess the character necessary to perform this essential function of a trade mark it is "devoid of any distinctive character."

Marks consisting of single letters or two letters will be generally regarded as “devoid of distinctive character” for goods because of tendency in trade , to use letters as models or catalogue references , unless otherwise shown as evidence of the trade practice. Two letter marks may be acceptable in respect of services having regard to the trade practice.

Four digit numbers per se which are current such as 2007 or shortly forth coming dates such as 2008 or 2009 etc signifying a year of production or their expiry period will be considered as devoid of distinctive character.

See AD 2000 TM cases (1997 RPC 168)

The mark consisting of letters “P. R.E. P.A.R.E. was refused registration as being devoid of distinctive character and appeal was dismissed. (1997 RPC 884)

25. Combination of letters and numerals:

Combination of letters and numerals will be considered differently as a composite mark and such unique combination may qualify for registration. The registration of such marks would give right only for the use of composite mark and not for separate integers. See Section 17 (2).

Letters and numerals presented with additional features or which are intertwined, conjoined etc having a trade mark character , may qualify for acceptance.

The distinctiveness of the mark must be assessed with reference to the goods /service in issue.

26. Descriptive letters or numerals and those customary in the trade

Letters or numerals which designate characteristics of the goods/services, and/or which are customary in the trade, are excluded from registration by Section 9(1)(b) and/or (c).

Numbers/letters which may be used in trade to designate:

- * the **date** of production of goods/provision of services (eg 1996, 2000)
- * **size**, eg XL for clothes, 1600 for cars, 34R for clothing, 185/65 for tyres
- * **quantity**, 200 for cigarettes
- * **dates** eg 1066 for history books, 1996 for wines
- * **telephone codes** eg 0800 or 0500
- * the **time** of provision of services, eg 8 – 10, 24/7
- * the **power** of goods, eg 115 (BHP) for engines or cars or
- * **speed**, eg 486, 586, 686 & 266, 333, 500, 550 for computers
- * **strength**. eg "8.5%" for lager

Such signs will be subject to objection under Section 9(1)(b) and 9(1)(c) of the Act.

27. Three letter marks :

Three letter marks constituting a pronounceable word should be accepted in the prima facie case unless they are objectionable as descriptive words, acronyms , etc. If a letter mark consists of letters with dots in between, like P.E.N. , it will be regarded only as a letter mark and objected as such. Similarly, objection will prevail when all the three letters are in capital letters, unless the word is a dictionary word. Applicant may overcome objection by amending the mark, such as "KEEK, PIV" etc. as "Kel", Piv", "KEL" where the first letter is in capital and the other two letters in small type.

28. Two letter marks:

Where two letters form a non-descriptive pronounceable (such as OX) word, it may be acceptable, unless there is specific reason to believe that the particular letters will not be taken by the average consumer as a trade mark. The test is whether the letters are likely to be taken as a word by the public. The well known practices in the concerned trade will be considered in assessing the distinctive character of such marks. The letters XL, indication of 'Extra large' is an abbreviation of descriptive phrase. The distinctive character of a mark will be assessed by reference to the mark as a whole.

29. Single letter marks:

Single letter marks are generally non-distinctive and not registrable except upon acquired distinctiveness. However, in some cases e.g. letter 'A' which may signify "A quality", goods/services may not qualify for registration, without overwhelming evidence. For example, the letter "K" may appear to be a registrable trade mark for footwear, but the letter "H" which is a customary indication of a width fitting for shoes, would not be distinctive. Particular care is required where the goods are technical items such as computers, machines, motors and tools, where particular letters often have a descriptive meaning or have become customary in the language or in the bona fide and established practices of the trade. Where a letter is not distinctive, a plain rectangular or oval border is unlikely to make the mark distinctive. Representation with combination of colours may assist in providing the mark as a whole with the necessary power to individualise the goods/services of one undertaking.

30. Numerals & Letter/number combinations

Numerals and letter/number combinations will be accepted as trade marks provided that they appear sufficiently random to individualize the goods/services of one undertaking. The distinctiveness of the mark must be assessed in respect of the goods/services at issue.

30.1 Five digit numbers & letter/number combinations

Five digit numbers, and combinations of numbers and letters will be regarded as having the necessary distinctive character unless the examiner is able to identify a specific reason why a particular combination would not be taken as a trade mark.

30.2 Four digit numbers & letter/number combinations

Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers, eg 1560, 8787 and not round numbers eg 1000, 2400 - which are commonly used in trade as mere model or product numbers for goods. Even round numbers may be distinctive for some services and goods not usually sold under a model or product number such as food & drink. Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character.

30.3 Combinations of 4 numbers and letters, in any order, (eg F120) may be regarded as having the necessary distinctive character, unless otherwise considered objectionable in any particular case.

30.4. Three digit numbers & letter/number combinations

Random three digit numbers, such as 159 or 343 may be regarded as having the necessary distinctive character. Round numbers (eg 100 or 120) will normally be regarded as devoid of any distinctive character as trade marks for goods.

Combinations of two letters and one number (eg EK5) may be acceptable. One letter and two numerals (eg W70) when used in an arbitrary manner, may also have some distinctive character.

30.5 Combinations of one letter and one numeral

Combinations of one letter and one numeral like A1 may signify superior quality of goods/service and will be open to objections Others may have distinctive character. So combinations, such as "Z7" for motor cars may be accepted and other straightforward combinations, such as "C6", may be distinctive for goods (like soft drinks) which are not frequently sold under a model code.

Combinations of one letter and one number may also be acceptable for many services.

30.6 Two digit numbers

Two digit numerals may be devoid of any distinctive character because they are commonly used in trade as descriptions or else have become customary in the language or in the bona fide and established practices of the trade. However, they may be capable of distinguishing for certain goods and services (eg 77 for estate agents services or soft drinks).

30.7 Single digit numbers

Single numbers which involve little or no stylization will often face an objection because many such numbers are used in trade to designate a characteristic of many goods (eg 6 = cylinders in an engine, 2 = litres of milk). However, each case must be considered individually. There may be occasions when a single digit number in relation to some services may possess the necessary degree of distinctiveness, eg '9' appears to be distinctive for recruitment services.

31. General approach to be adopted under section 9(1)

Raising an objection under Section 9(1)(c) does not preclude the possibility of a separate objection being taken under Section 9(1)(b).

When an objection is taken under Section 9(1)(a) *alone OR* for reasons which *differ* from those given to justify an objection under another sub-section of Section 9(1), the Examiner will provide the factual basis for his or her finding under Section 9(1)(b), eg the trade mark "The ones you want to do business with" is devoid of any distinctive character because it consists of a mark which is merely a description of the customer friendly and high quality nature of a commercial undertaking.

31.1 Section 9(1)(b)

An objection raised under Section 9(1)(b) of the Act, will identify the characteristic(s) of the goods/services designated by the trade mark. The Examiner will also provide an example illustrating how

the trade mark could be used, in trade, as a description of the characteristic of the goods/services identified in the objection. For example, “the trade mark [TOP VALUE] is excluded from registration by Section 9(3)(c) of the Act because it consists exclusively of a sign which may serve, in trade, to designate the value for money e.g “This is a top value product.”

31.2 Section 9(1)(c)

Section 9(1)(c) is somewhat different because [unlike sub-sections (a) & (b)] it deals with marks which are actually believed to be *in use* in trade. Where a mark consists exclusively of descriptive matter which *may be* used in trade, the objection will be under section 9(1)(b). Where a mark is devoid of any distinctive character the objection will be under section 9(1)(a).

A Section 9(1)(c) objection therefore need only be raised where the examiner is in doubt as to whether the mark is inherently capable of designating a characteristic of the goods or services, or is devoid of any distinctive character, but there is evidence that the mark has nevertheless become customary in the current language or in the established and bona fide practices of the relevant trade.

Under similar provision of law, in UK it was found that evidence of two uses of the sign in question by third parties prior to the date of the application for registration, did not amount to ‘customary’ use. It was held that in order to show that the use of a sign has become ‘customary’ or ‘established’ it will be necessary for the Registrar to have evidence which is consistent with those descriptions.

In this connection it should be noted that:

- a) use of the mark in widely read publications offering the goods/services to the relevant public may carry more weight than limited uses on obscure web sites;
- b) journalistic use, whilst not irrelevant (because it leads to use by the public), is less relevant than use in the course of trade;
- c) private use (in ‘chat rooms’ and the like) is of little relevance;

d) the size and nature of the market for the goods/services is a relevant factor: the amount of use required to show that a mark has become 'customary' or 'established' in a specialised market is liable to be less than that which is required to show the same thing in relation to a much bigger market for general products or services.

e) evidence must normally be prior to the date of the application;

f) evidence which post dates the application, but which shows what was happening prior to the date of the application is also relevant.

31.3 Possibility of "future use" would be sufficient

Section 9(1)(b) of the Act prohibits registration of trade marks -

*(c) which consist exclusively of marks or indications which **may** serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering services, or other characteristics of goods, or service."*

As already mentioned above, the European Court of Justice said [*Doublemint* case] that it is not necessary that a sign is actually in descriptive use at the time of application but that it is sufficient that the sign **could** be used descriptively.

The presence of the word "may" indicates that an assessment of descriptiveness is not confined to what is already in common usage at the relevant date: this is the focus of section 9(1)(c). The word "may" should be construed as meaning "reasonably likely to" come into descriptive use in the foreseeable future.

31.4 New products

The possibility of "future" use of mark will be particularly relevant, when examination of an application suggests that the mark applied for may become the accepted description of a new type of product or service. The applicant may, for example, be the first to use or invent a product and have coined a term as a brand which may, or may not, be something by which the product will become known. Similarly, in relation to shapes of new products, account should be taken not only of shapes which are already the "norm" for the

relevant sector, but also of which shapes are likely to become the normal shape of the product: “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.” (*Proctor and Gamble*)

For example, frozen potato chips which were cooked in domestic ovens instead of deep fat fryers were, at one time, a new product. The manufacturer branded them “Oven Chips”, but although they were the first to coin the term, the term was an apt description and it was reasonable to assume that it would become the natural description in trade for that category of goods.

Conversely, the inventor of a revolutionary new type of temporary plastic mesh fencing also invented a trade mark to brand the new product. The mark was inspired by the names of the inventor’s children, Catherine and Nicholas, *Catnic*. It would be unreasonable to assume that this mark would be the natural description of the goods because it is an invented word and is distinctive. Unless allowed by the proprietor to pass into generic usage, it would be unreasonable to assume that it would be used by others, as a description, in the natural course of trade.

Thorough research will be prudent particularly in fast-changing fields such as technology and scientific research, where the consultation of patent examiners and/or trade bodies may yield results which the Internet may not.

If the product is entirely new to INDIA, it is more likely that we will also adopt the foreign descriptive name because it is commercially convenient. In addition, the appeal to the average consumer in foreign clothing or food may also extend to the ethnic description, which may then become the accepted description in India, e.g. cappuccino for coffee or yogurt for curd.

31.5 Relevant dates

The “relevant date” is the date of application but

a) with regard to Section 9(1)(b), it is appropriate to consider what was reasonably foreseeable at that date and

b) the fact that the mark has not been used by third parties by the relevant date does not automatically mean that it has distinctive character.

32. Use of the Internet by Examiners and Hearing Officers

Examiners and Hearing Officers will observe the following practice concerning use of Internet/Dialog references to support objections taken under Section 9.

32.1 When are Internet searches are done?

Web-wide searches may not be carried out as a matter of routine. Searches may be done either where the Examiner has identified a descriptive meaning from the usual references (i.e. technical dictionaries or subject-specific websites identified by the Registry as suitable reference sources) but is unclear about whether the word(s) are really apt for use in trade as a description, or because the Examiner has suspicions that an apparently non-descriptive word(s) has come to be used in trade as a description. The latter will usually only be justified in fast moving fields, such as information technology where it is often difficult to keep up with the current language of the trade. However, the same point could apply wherever the goods/services appear to be of a new type or are highly specialized.

The Registrar is required to observe principles of natural justice. See section 128. This means that applicants or their representatives, are entitled to know the case against them, and be given an opportunity to respond to any material that has influenced the Examiner or Hearing Officer in coming to a view of the application which is adverse to the applicant. Accordingly, where an Internet search has been conducted any *relevant* results should be sent to the agent or applicant with the examination report. If a search is conducted later any relevant results should be disclosed to the attorney/applicant.

When a file leaves for a hearing, no search report should be on the file which have not been disclosed to the attorney/applicant. If a search reveals no relevant hits , note to that effect in the file is to be recorded by the Examiner .

32.2 Relevancy

Section 9(1)(c)

Every trader has a right to use for his trade the terminology common in his trade, provided always he does this in a fair and honest way. Marks which are common to trade cannot be distinctive of goods/services of any particular enterprise and will not be register able.

Before an objection is taken under Section 9(1)(c) it is necessary to pinpoint sufficient use of the sign by third parties prior to the date of the application to show that it was in use in the 'customary language' or 'established practices of the trade' at the relevant date. It is not possible to lay down a minimum number of uses required to show this as much depends upon the nature of the hits (e.g. use in an advertisement for the goods/services in a popular daily newspaper would carry much more weight than an instance of journalistic use of the sign in an article on a web site). In order to be relevant the use must be in this country (e.g. India website or extract from publications circulating in India). The references must show use that occurred *before* the relevant date. Extracts showing use on overseas websites (unless they include relevant extracts from Indian publications) should *not* be used to support a Section 9(1)(c) objection.

32.3 Section 9(1)(b)

A limited number of examples of use of the mark in the course of trade in India as a designation of characteristics of the goods or services **may** support a Section 9(1)(b) objection (and a consequential section 9(1)(c) objection) where a descriptive meaning can be adduced from the ordinary meaning of the sign and the purpose of citing examples of use is therefore to illustrate the capacity of the sign to function as a description in trade.

Examples of use of words in other jurisdictions are *not* usually conclusive without more. This is because the same word can be descriptive in one country and distinctive in another. However, overseas use *may* be relevant where:-

a) the *ordinary meaning* of the word(s) identified in the usual reference works suggests that the sign may serve in trade in this

country as a description and the use made of the mark in other English speaking countries is merely confirmation that the mark is apt for such use here, or

b) the hits suggest that the sign in question had, *at the date of the application*, been adopted in other English speaking countries as the name of (or an abbreviation for) a new sort of product or service.

32.4 Use in trade

It should be borne in mind that objections under Section 9(1)(b) can only be based upon the existence or likelihood of the sign being used for descriptive purposes *in trade in the goods/services*. One or two isolated examples of journalists using a word as a description will not, without more, serve to show that an apparently meaningless or inapt word is apt for use in trade as a description. On the other hand, a persistent pattern of descriptive use by journalists (particularly in trade papers) is sufficient to establish that the sign is liable to be used in trade as a description.

32.5 Use after date of application

Use after the date of the application is *usually* irrelevant. However, if an objection is raised under Section 9(1)(b) which is based primarily upon the descriptive meaning of the word(s) identified in the usual reference works, then examples of descriptive use in trade after the date of application may be relevant. This is because such examples confirm that the word(s) had descriptive potential at the date of application. In the absence of any other indication, we should take the date that the web-page was last updated as the date of the article for examination purposes.

32.6 Applicant's own web site

Evidence of the applicant using the sign in an *obviously* descriptive manner *may* be relevant.

33. “Acquired distinctive character”- proviso to section 9

Section 9(1) proviso implies the possibility that certain words, although primarily descriptive of the character or quality of the goods or service, may – by reason of use – lose their descriptive

meaning and acquire a secondary distinctive meaning so that they indicate that the goods/service in connection with which they are used are goods made by a particular manufacturer.

A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so consumers must rely on it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative

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]

34. Vague specifications hiding descriptive significance

The Registrar is entitled to require the applicant in particular cases, to clarify the goods or services in relation to which he/she proposes to register the mark. The applicant is not entitled to hide the descriptive nature of a mark within a broad or vague specification of goods/services - the reasoning behind this is as set out in *HOLD AND DRAW* case 1964 RPC 142. under the U.K. Trade Marks Act, 1938. The Registrar has power to require such additional information and documents as he deems necessary.

An objection will always be raised where it appears that the specification includes goods/services for which the mark would not be acceptable. The applicant will be invited to clarify or limit the goods/services of interest in his response.

34.1 Misspellings of descriptive and other words

Misspellings of descriptive words excluded from registration by section 9(1)(c) of the Act cannot normally be said to consist *exclusively* of marks that may be used in trade to designate characteristics of the goods/services. However, misspellings commonly used in trade, such as XTRA instead of EXTRA, may be excluded from registration. Similarly, mis-spelt words RYS for “Rice” is equally objectionable as phonetic equivalent of the objectionable word.

At the other end of the spectrum are fanciful mis-spellings, has a strong identity of its own. The Registrar takes the view that this is not a mark that may be used in trade to designate the geographical origin of the goods.

In between these two extremes are mis-spellings which may not be common but which do little to disguise the descriptive words at the heart of the mark. The mark FROOT LOOPS in U.K. was refused registration because it was an obvious mis-spelling of FRUIT LOOPS being an apt description of fruit flavoured cereal sold in loop form. The refusal was upheld by Simon Thorley QC acting as the Appointed Person. The applicant conceded that FROOT LOOPS was no more registrable than FRUIT LOOPS and the phonetic point was not contested.

In this regard the practice is set out as below:

- a. In the case of common mis-spellings of descriptive words (as in the XTRA example above) there will be an objection;
- b. In the case of fanciful misspellings with skilful allusion, there will be no objection, when it is shown to have acquired a distinctive character by reason of use.

- c. In the case of mis-spellings which fail to disguise the descriptive words which comprise the mark, there will usually be an objection on grounds that the words are still likely to be seen as a description (FROOT LOOPS) and the trade mark therefore lacks any distinctive character;
- d. In the (relatively rare) circumstances where the mis-spelling effectively disguises descriptive words and creates a significant "surplus" (eg PNEUSTILE - new style), there will be no objection;
- e. Misspellings of words which, in the true spelling, would be excluded - such as surnames and other non-distinctive (but not descriptive) words - will not normally face an objection, eg LUWIS (Lewis).
- f. Words which have their own (non-objectionable) meaning, but which are phonetically the same as a descriptive word (such as STERLING/STIRLING) will not normally face an objection.

34.2 Common misspellings

Whilst obvious misspellings of words may be acceptable because the average consumer would perceive the difference between the trade mark and the descriptive word, this may not be true when considering applications to register words which are commonly misspelt, or where the public are not used to seeing the word written down.

For example, KOMMUNIKATION is clearly misspelt and the average consumer would immediately recognize the difference between this mark and the descriptive word COMMUNICATION.

When confronted with words which are often misspelt, the difference may not be perceptible as a matter of first impression. For example, MILLENNIUM is often misspelt with either one "l" or one "n". The average consumer is therefore less likely to see any perceptible difference between the word and the mark MILENNIUM.

This may often be true where "double" letters appear in the middle of the word. Informal words may be more often heard than written down, eg, CUPPA for tea. The average consumer may therefore be unsure of the correct spelling of the word because they will be unused to seeing it written down. Arguments that the word is spelt will not assist in these circumstances.

Similarly, use of the "American" spelling of a word is less likely to be perceived as different to a normal presentation of the word. e.g. colour.

Even if the difference is noticeable, the average consumer is unlikely to suppose that the difference is on account of the fact that the American spelt version of the word is a trade mark.

Where there is a perceptible difference between the trade mark and those descriptive or non-distinctive terms, the trade mark will be generally acceptable. For example, the following examples of obviously misspelt are no different from descriptive words .

NOWAX for ear drops (In this case the conjoining of the two words NO and WAX, the individual words are simply combined without lending any distinctiveness. On the other hand if the resulting merger of the two words become NOVAX it may be taken as an invented word.

‘SERIAL’ for breakfast cereals

‘DIETETIX’ for dietician services or which do not readily convey the descriptiveness of the words, may qualify for acceptance.

34.3 Misspellings generally used in trade

Care should be taken however where misspellings are commonly used, for example "XTRA" instead of EXTRA and ‘N’ instead of AND. Such variations will not lend distinctiveness.

Where mis-spellings or abbreviations are commonly used in the trade, the marks would still be open to objection. For example :

CUT ‘N BLOW DRY for hairdressing.

DRIVE THRU /DRIVE IN for restaurant services.

STARTER PAK for beginner packages.

FRESHLY PREPARED 2 GO for takeaway pizzas.

BEST 4 YOU

34.4 Text messaging abbreviations

With the growing practice of sending text messages via mobile phones, a completely new language is evolving using abbreviations rather than the full word. Indeed there are dictionaries available which detail the meanings of such abbreviations. Further, goods and services are now commonly promoted through advertisements in the form of text messages delivered through mobile phones. The average consumer will, or it is reasonably foreseeable that they will in future, see direct descriptions in the form of text messages as being a usual way of designating goods or services provided to the general public. Consequently applications consisting of this abbreviated version are equally open to objection in the same manner as the full word(s) would be objectionable.

For example: LRN 2 TXT for telecommunications or education services would be objectionable as it directs the consumer to the subject matter, namely, “Learn to Text”.

35 Registrability of non-English descriptive words

The following practice will be adopted in dealing with applications to register non-English words as trade marks where, if words with the same meaning were applied for in English, the application would be subject to an objection on the grounds that the words are descriptive and/or non-distinctive.

The U.K. TMR has established a practice that there are no grounds for refusing registration of trade marks on the basis that they are descriptive or non distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question. The same practice will be followed by the Trade Marks Registry in India.

Accordingly if the foreign word is in a language that is not likely to be known to a significant proportion of the public in India, there will not exist any ground for objection that the mark is descriptive.

Consequently, the Examiner will only object to the registration of word marks which are likely to be recognised as a descriptive of the characteristic of the goods or services. The relevant trade in India consists of those in this country who trade in the goods or services in question.

35.1 Non English Descriptions which are most likely to be Understood

Again in general, the average consumer is far more likely to be familiar with the non-English name of a product or service, or the local name for its geographical origin, than he is with the non-English words which describe other characteristics of the product or service. For example, the average English speaking consumer of wine would know that 'Bourgogne' is the French word for the region known as 'Burgundy' and would also be likely to know that 'vin rouge' means 'red wine.' Consequently, such names would be objectionable. This English practice could be well followed in India, if necessary by reference to internet.

35.2 Non-English Words which resemble English Descriptive Words

The more closely a non-English descriptive word resembles its English equivalent, the more likely it is that its descriptive significance will be understood by the consumer. So, for example, the Italian words 'Caffe Fresco' should be rejected as a trade mark for coffee because the average consumer of coffee would be likely to see that it simply means 'fresh coffee'.

35.3 Non-English Words which have become customary in the Current Language or in the bona fide and Established Practices of the Trade.

Non-English words which have become generic in the trade in the goods or services (by customers or traders) are excluded from registration under Section 9(1)(c) of the Act. So the German word

'auto' is not registrable for motor cars or their parts and fittings, or related services.

35.4 Well known Indian languages

The following language are likely to be known to a reasonable (and increasing) number of Indian public. As such, descriptive use in any of these languages will be equally objectionable.

Punjabi, Tamil, Bengali, Urdu, Hindi, Telugu, Oriya, Assamee, Rajasthani, Malyalam, Karnatak. Marathi, Gujarathi and English and scheduled languages under the constitution.

Languages such as French, German, Italian, Spanish and Japanese are hardly known in India. Accordingly marks in such languages will be less objectionable.

36 Domain names and Section 9(1)

A domain name is a written representation of an Internet electronic address, e.g. www.ipindia.nic.in, which is the Office's web site address. It is common-place for traders to have their electronic mail address and use the same in respect of their goods /services as trade name. In other words the domain name is being used as a trade name or trade mark, and the Registrar will, subject to the usual criteria of the Act, permit domain names to be registered as trade marks if otherwise registerable.

Elements of the domain name such as ".com" or ".co.in" are considered to be totally non-distinctive, much in the same way as "Ltd" and "Plc". As a general rule, one should consider whether the remainder of the mark is descriptive or non-distinctive; if so, there is likely to be an objection under Section 9(1)(a) of the Act.

There may be exceptions. For example TWIST AND SEAL would be liable to an objection for storage jars on the basis that it describes a characteristic of the goods, whereas the addition of ".COM" gives to the sign a trade mark character, when ued as one whole word.

37 Names of Organizations

Words which describe the nature of an organization are not excluded from registration under Section 9(1)(b) of the Act, unless the words may also serve in trade to describe characteristics of the goods/services.

For example, “National Institute for the Disabled” describes an organisation for the services provided by it. Consequently, there is no objection under Section 9(1)(b). In contrast “National Breakdown Service” would be taken to describe not only the organization but also the characteristics of the services, ie. breakdown services with national coverage. Consequently, these words would be barred from registration under Section 9(1)(b).

Further, the presence of the word “national” would give the impression of government patronage, participation or connection with any local authority or body constituted under any law. Therefore, it will be also objectionable under section 9(2)(d) of the Act.

38 Trade marks made up of a number of features each of which is non-distinctive.

Section 17(1) enacts that when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole. This brings the statute law in accordance with the judicial decision evolved by the case of *Diamond T. Motor Company’s Appln. (1921)*, 38 RPC 373. In this case a mark consisting of a diamond border device, the word Diamond and a single letter ‘T’ inside the device was allowed registration, without exclusive right to each separate component. The mark as a whole was considered capable of distinguishing, while the individual elements were not.

In an European case [*Campina Melkunie BV v Benelux-Merkenbureau*], similar approach was adopted where a trade mark was composed of a number of elements, each of which was descriptive of the goods/services in the application. The trade mark as a whole was considered perceptibly more than the sum of the meanings of its descriptive parts. If the combination of descriptive elements was unusual and created an impression that was sufficiently far removed from being simply a composite

description of the goods/services, the trade mark might be registrable.

The mark EUROLAMB was found to be unregistrable (for lamb) under the UK Act on the ground that the element EURO is commonly used to indicate “European” and conjoining EURO and LAMB therefore results in nothing more than a composite description of the kind and geographical origin of the goods, which is no more registrable than the term “European Lamb”. See (1997) RPC 279.

Similarly while the mark MULTIBLADE, for example may not be registrable for razors, the mark MULTICLOSE may be registrable (for razors). Although razors commonly have multiple blades (and ‘Multi’ is therefore descriptive) which are designed to provide the user with a close shave (and ‘close’ is therefore descriptive of the intended purpose of the product), the terms ‘Multi’ and ‘Close’ would be an unusual combination and not a natural one to use as a description of these characteristics of the product.

If the mark is constituted by purely descriptive phrase (e.g. HIGH SPEC HOME COMPUTING SYSTEM for computer software) it would not be permitted registration

In contrast, the word ‘AUTOMOTIVE NETWORK EXCHANGE’ in UK was found to be registrable (for business information for the automotive industry provided by means of a private network) because although each of the words was individually considered unregistrable, the amount of effort and analysis required to interpret the composite phrase as a description of the services was more than an average consumer was likely to undertake.

However, it would appear that in the Indian context the phrase as a whole being no less equally descriptive it would be register able, only upon evidence of acquired distinctiveness under proviso to section 9(1).

39 Slogans

Under section 9(1) proviso , any trade mark which is demonstrated to be distinctive in fact, will be regarded as distinctive in law and therefore qualify for registration. One or more words , constituted as a slogan mark may be registrable but the onus is on the applicant for registration to show acquired distinctiveness.

In “Have a Break Trade Mark”, (1993) the applicant sought to register the mark “HAVE A BREAK” in class 30. Evidence was provided that the applicant had been using the slogan “HAVE A BREAK..... HAVE A KIT KAT” as a registered trade mark but the words, “HAVE A BREAK” alone had not been used as a trade mark in relation to chocolate, chocolate products, confectionery, candy, biscuits. Therefore the application for registration refused. It was held that the criteria for registrability of slogan is no stricter than for other types of mark.

The European Court of Justice observed that Slogans serving a promotional function will be objectionable because “average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans”. At the same time, the ECJ took the view that there is no justification for applying a stricter examination criteria to slogan marks and that such slogan marks may be considered as a non-conventional trade mark where the relevant public is slower to recognize them as indicating the product of an undertaking.

Slogans will face the same objection under Section 9(1)(b) of the Act, if they are comprised of a word combination that an average consumer would regard as a normal way of referring to the goods or services or of representing their essential features. The intended purpose of the goods or services should be regarded as an essential characteristic of the goods or services for the purposes of this assessment.

40. Slogan when used in plain descriptive language

Plain descriptive phrase of a slogan is always considered non-distinctive. For example the UK Registrar objected to the registration of slogan:

NEVER CLEAN YOUR SHOWER AGAIN (Class 3)

– because it describes in plain language the intended purpose of the goods. It is considered that the fact that the statement might not be literally true was not decisive. Consumers are accustomed to a certain amount of overstatement in advertisements. On the other hand, the slogan “THE SHOES YOUR FEET HAVE BEEN

ACHING FOR”, was considered to be an unusual way of putting a descriptive phrase.

The mark “AN EYE FOR DETAIL” (for clothing) was refused because it is a common phrase which, considered in relation to clothing, designates not just a characteristic of the consumer, but also the quality of the goods, i.e. clothing of such quality that it will be appreciated by those consumers with an eye for detail.

The mark “HOW TECHNOLOGY SHAPED THE WORLD” would not be acceptable for publications, information or exhibition type goods or services.

The UK Registrar accepted the mark “THE BEST WAY TO PREDICT THE FUTURE IS TO CREATE IT” (for technology related services in classes 35, 38 & 42) because this was not considered to be a normal way of designating these services, nor to be a commonplace phrase.

Similar approach may be adopted by the Registrar in India.

40.1 Normal use in advertising to be considered

Some allowance must be made for the fact that, in advertising, it is customary to use shortened phrase when promoting the goods or services. The UK Registrar’s refusal to register the trade mark ‘WHERE ALL YOUR FAVOURITES COME TOGETHER’ for chocolate confectionery was upheld on the ground that it was a natural abbreviation for the longer expression ‘THIS IS WHERE ALL YOUR FAVOURITES COME TOGETHER IN ONE BOX’.

By contrast the mark FROM THOUGHT TO FINISH has been accepted for goods and services in classes 9, 16, 35, 41 & 42 because it is not a normal means of designating goods and services in the development field, the mark being a play on the well known phrase "From start to finish".

40.2 Ambiguity

In the U.K. the view is ambiguity may enhance the prospects of registrability, and based on that the UK Registrar accepted the mark NATURE’s REAL THING for foodstuffs in classes 29 and 30

because the reference to natural products is sufficiently allusive. However, it is possible to take a view that ambiguity in a sense may render the mark misleading and deceptive as to its characteristics to entail objection.

The mark BEST BUY (on a coloured background resembling a price tag) was refused registration by the European Court of First Instance despite the applicant's argument that it had no precise descriptive meaning to consumers. A slogan which has two meanings will not be registrable if one of them is a description of the goods or services. The mark WE SET THE HIRE STANDARD was refused (for car hire services) despite the possible phonetic alternative meaning, and this would have been the case even if the other meaning had not also been a description of the services.

Slogan mark- guidelines

Based on U.K. practice generally, we may adopt the following guidelines in the application of section 9(1) of the Act in respect of slogan marks.

An illustrative list of the areas where an objection might be relevant, and the types of areas covered is given below:.

40.3 Value statements

Straightforward value statements that could apply to any undertaking are devoid of any distinctive character, e.g., CARING FOR THE PLANET.

40.4 Inspirational or motivational statements

These types of slogans are considered to be non-distinctive particularly for services, e.g., YOU CAN DO IT WITH US for driving schools, or GO FOR IT for training courses.

40.5 Customer service statements

Similarly, straightforward statements about customer service that could apply to any undertaking are also devoid of any distinctive character, e.g., PUTTING CUSTOMERS FIRST; as are natural abbreviations for such statements, e.g., PUTTING YOU FIRST.

40.6 Purely promotional statements

The mark SAY IT WITH CHAMPAGNE is composed of a well known advertising strap line "Say it with..." followed by the name of the goods (Champagne). This mark therefore fulfils a purely marketing function, i.e., an invitation to the public to send a message through the gift of champagne. Similarly, the European Court of First Instance said that "REAL PEOPLE, REAL SOLUTIONS", whilst not having a directly descriptive connotation, nevertheless has nothing about it to displace its purely promotional message.

40.7 Statements by/about the user of goods/wearer of clothing

Slogans such as "I ♥ My Boy Friend" or "Here comes Trouble" are often used to decorate goods, particularly clothing – T-shirts, sweatshirts or baseball caps. In this context, consumers are unlikely to perceive this type of slogan as a sign of trade origin. When seen they seem to be as a personal statement by/about the wearer/user rather than indicating the trade origin of the product. Slogans which are likely to be seen as such will therefore be open to objection under Section 9(1)(c) of the Act.

The Examiner should see whether the phrase applied for is indeed used as a trade mark by calling for evidence.

40.8 Retail services- Class 35 of International Classification

There was a view earlier that 'retail services' did not constitute a business in the provision of 'services' in respect of which a trade mark may be registered. However the services provided by retailers have come to be recognised by the Court as being "...all activity carried out by the trader for the purpose of encouraging the conclusion of a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the above mentioned transaction with the trader in question rather than with a competitor".

Accordingly, these are the services covered by a "retail services" type registration. The Court stated that it is not necessary to specify in detail the retail services for which registration is sought. Rather general wording may be used. In that connection the Court

cited with approval the wording in the explanatory note to Class 35 of the International Classification, namely, “the bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods.”

Having recognized that there is no barrier to the registration of services connected with the retail trade in goods, the Court did not draw any distinction between the various forms of retail services (for example, supermarkets, department stores, specialist retail outlets, mail order, electronic shopping etc). Whereas in the past it was a requirement in the UK to specify the precise nature of the retail services being provided, the Court made it clear that this is not required and that the emphasis is to be placed on the nature of the goods supplied in connection with the services.

Consequently, it is necessary to specify the goods or types of goods in all cases.

An indication of the types of goods concerned with the services will be sufficient, although applicants may list the associated goods in more detail if they so wish. Note that a registration for retail services does not cover the sale of goods themselves and therefore if applicants require protection for their marks to include the transaction that occurs between the customer and the retailer at the point of sale, it will be advisable to file in the appropriate goods classes in respect of those items that are being sold under the trade mark.

40.9 What is acceptable- U.K. Practice to be followed in India

Based on the UK practice, we may adopt the following guidelines on what is (and what is not) acceptable

Acceptable form of specification- class 35

The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods;

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];

Retail services connected with **[indicate goods or types of goods]**;

Retail services connected with the sale of [indicate goods or types of goods];

Retail store services in the field of [indicate goods or types of goods];

Department store retail services connected with [indicate goods or types of goods] as in, for example:

Department store services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, cameras, domestic electrical and electronic equipment, including white goods, jewellery, clocks, watches, stationery, publications, leather goods, luggage, furniture, household containers and utensils, furnishings, textiles, clothing, footwear, headwear, haberdashery, toys and games, sports equipment, foodstuffs, drinks and tobacco products;

Shop retail services connected with [indicate goods or types of goods];

Mail order retail services connected with [indicate goods or types of goods];

Electronic shopping retail services connected with [indicate goods or types of goods];

Retail clothing shop services;

Stationery shop retail services connected with the sale of stationery, printed matter, computer equipment and peripherals and home entertainment products;

The bringing together, for the benefit of others, of a variety of goods enabling customers to conveniently view and purchase those goods from a clothing and clothing accessories catalogue by mail order or by means of telecommunications.

Not acceptable form of specification – class 35

Sale of electrical and electronic goods for industrial use [the sale of goods is not a service];

Trade in building products [trading in goods is not a service];

Retailing [retailing goods is not a service per se];

Retailing of cars [retailing of goods is not a service];

Retail services for the sale of foods [sale of goods is not a service];

Retail off licences specialising in the sale of alcoholic beverages [sales are not a service];

Shops [not a service per se];

Factory shops [not a service per se];

Shop keeping [not a service per se];

Merchandising [not a service per se];

Distributorship [not a service per se];

Sales services [not a service per se];

Direct selling [not a service per se];

Mail order [not a service per se];

Television shopping [not a service per se];

Electronic shopping [not a service per se];

Computer shopping [not a service per se];

E-commerce [not a service per se] ;

Retail services [unqualified] ;

Retail store services [unqualified];

Department store services [unqualified];

Mail order catalogue services [unqualified];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those [unqualified] goods;

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store

["department store" does not identify the types of goods];

The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a general merchandise internet web site ["general merchandise" does not identify the types of goods];

Retail services connected with the sale of electrical and electronic goods [the terms

"Electrical" and/or "Electronic" are too vague without further indication to define types of goods];

Retail services connected with stationery products and the like goods ["and the like goods" fails to identify the goods or types of goods];

40.10 Wholesale services

The Court's judgment did not include any observations concerning the acceptability of services provided by wholesalers. However, the same practice will apply as for retail services and it will be necessary to specify the goods or types of goods, as in, for example: Wholesale services connected with the sale of [indicate goods or types of goods]

40.11 Where the specification is deficient

For descriptions which identify retail services but which do not clearly indicate the goods or types of goods connected with the services, an objection will be raised because such claims do not clearly identify “services”. Similarly, specifications which include descriptions that adequately identify the goods, but fail to define the retail services, (for example, “sale of clothing”) will face similar objections.

41. Effect of using letter ® etc : Section 107 of the Act:

41.1 Section 107 provides penalty for falsely representing a trade mark as ‘registered’. If the Registrar finds that if a person states in terms, or otherwise represents, that a trade mark is registered in India and this is proved to be untrue, then the person will be at risk for criminal action under Section 107 of the Act. What the law prohibits a person from doing is the following :

- (a) to represent a trade mark, which is not registered, to the effect that it is a registered trade mark; or
- (b) to represent a part of a registered trade mark, not being a part separately registered, to the effect that it is separately registered; or
- (c) to represent a registered trade mark as registered in respect of any goods or services in respect of which it is not in fact registered; or
- (d) to represent that registration of a trade mark given an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not in fact give that right.

However, if a person makes a statement or representation that a mark is registered, without implying that it is registered in India, then the Registrar will not seek to invoke Section 107 if he is satisfied that the mark is in fact registered in another country and that the reference to registration is a reference to such registration in that country.

41.2 Refusal of application:

Misrepresentation of an unregistered mark as 'registered' may be a ground for refusal of application. See *Burcombe & Co. Ltd Appln.* 1948 65 RPC 179 where application was refused on the ground of use of the abbreviation "Regd", without any explanation for misuse. See also 52 RPC 137 for a similar finding. It was held that such use was enough to conclude that the user was tainted with dishonesty to hold that the applicants were not entitled to discretionary relief under section 12. See 1981 PTC 269 BOM.

42. Applications to register trade marks "as series"

Section 15 (3) makes provision for registration of trade mark as series in respect of the same or similar goods /services where the marks, while resembling each other in the material particulars thereof, yet differ in respect of -

1. Statement of goods or services in relation to which they are respectively used or proposed to be used; or
2. Statement of number, price, quality or names of places; or
3. Other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
4. Colour

It is an essential condition of registration that the differences in the 'series marks' should be only in respect of non-distinctive matters, such as size, (8 ½" size), description of the goods, (bleached, khaki shades etc), price, quality etc.

To qualify for registration as series, the mark should resemble each other in the material particulars but differ only in matters of non-distinctive characters which do not substantially affect or alter the identity of the mark.

The test is NOT simply whether the marks in the series would be regarded as confusingly **similar** to each other if used by unrelated undertakings. Any variation in the non-distinctive features in the marks must leave the visual, aural and conceptual identity of each of the trade marks substantially the **same**.

Further, it is not enough for marks to share the same conceptual identity if there are

substantial differences in the visual or aural identities of the marks. The matter must be assessed by reference to the likely reaction to the marks of an average consumer of the goods/services in question.

42.1 Series marks with letters / numerals /colours

Marks constituted by 3 letters or numeral marks consisting of 5 digits are regarded as capable of distinguishing per se. Accordingly such group of marks is to be registered only as independent marks and not as series.

Each of the trade mark in the series must be in respect of the goods or description of goods or services.

Section 15(3)(d) provides for registration of trade marks in series, where the mark differs only in respect of colours.

42.2 Procedure relating to series registration

Application for registration of series marks is to be on form TM-8 or TM-37 as the case may be. Though it is permissible to file a single application for registration of trade mark in more than one class, it is to be noted that each series marks must be in respect of the same goods or services or description of goods/services. Where a group of marks are applied for registration as series in one registration and the Registrar does not consider them eligible for registration of series marks under section 15 the applicant will be required to delete any of the mark which is under objection.

It is also open to the applicant to apply on form TM-53 for division of the application to conform to the provision of section 22.

All trade marks registered as series in one registration are deemed to be registered as associated trade mark, under section 16(4) of the Act. Therefore, the examination report should make this clear for the applicant

43. Application for Registration of Collective marks

Special provisions have been made for registration of collective marks in section 61 to 68 of the Act. "Collective mark" is defined to mean a trade mark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of Indian Partnership Act, 1932) which is the proprietor of the mark from those of others"- section 2(1)(g).

To be registerable, the collective mark must be capable of being represented graphically and meet other requirements as are applicable to registration of trade marks in general. The points to be noted by the Examiner in such cases are –

- (1) The collective mark is owned by an association of persons , not being a partnership.
- (2) The collective marks belong to a group and its use thereof is reserved for members of the group .
- (3) The association may not use itself the collective mark but it ensures compliance of certain quality standards by its members who may use the collective mark.
- (4) The primary function of a collective mark is to indicate a trade connection with the association or organization, who is the proprietor of the mark.

Procedure:

Application for registration as collective mark will be made on form TM-3. Where appropriate, form TM-66 , 64 or TM-67 will be used. The draft regulations governing the use of the collective mark is to be submitted with the application on form TM-49. It shall include –

- a) the name and object of association
- b) the persons authorized to use the mark and the nature of control the applicant would exercise over the use
- c) The condition of membership of association
- d) Conditions of use of the mark
- e) Sanctions against mis-use

f) Procedure for dealing with appeals against the use of collective marks

The rules 127 to 133 of the Trade Marks Rules, 2002 make special provision in this context. It is expressly provided that provisions of the Trade Marks Act will apply to collective marks subject to the special provisions contained in Chapter 8. Accordingly the examination of an application for registration of collective mark will also be subject to the same standards as applicable to registration of trade mark in general subject to the additional requirements to scrutinize the draft regulations governing use of the collective mark and statement of case filed under rule 129.

In the case of acceptance of the application subject to conditions or limitations the provisions of rule 38(4), 39, 40, 41 and 42 will be applicable.

44. Certification trade mark

Sections 69 to 78 of the Act deal with registration of certification trade mark. 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

Section 2(1)(e) defines certification trade mark to mean “a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which is certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name as proprietor of the certification trade mark, of that person”.

Section 70 of the Act makes it clear that the proprietor of a certification trade mark should not himself carry on a trade in the goods of the kind certified or a trade of the provision of services of the kind certified. Besides, the certifying authority who may be an individual or a company or association of persons should be competent to certify the goods in respect of origin, material, mode

of manufacture or performance of services , quality , accuracy or other characteristics.

44.1 Procedure

- a) Application for registration will be made on form TM-4 or TM-65, TM-68 or TM-69 as the case may be accompanied by prescribed fee.
- b) Draft regulation in triplicate to be deposited under section 64 along with TM-49.
- c) Statement of case in triplicate under rule 136

44.2 Distinction between “trade mark” and “certification mark”

Trade Marks in general serve to distinguish the goods or services of one person from those of others.

The function of a certification trade mark is to indicate that the goods or services comply with certain objective standards in respect of origin, material, mode of manufacture of goods or performance of services as certified by a competent person .

44.3 Scope of applicability of Act and Rules to certification trade marks

Under section 69, the following provisions of the Act are not applicable to certification trade marks:

- a) Clauses (a) and (c) of sub-section (1) of section 9;
- b) Sections 18, 20, and 21, except as expressly applied by the Chapter;
- c) Sections 28, 29, 30, 41, 42, 47, 48, 49, 50, 52, 54 and sub-section (2) of section 56;
- d) Chapter XII, except section 107.

44.4 Examination Procedure for certification marks:

The general rules of examination as to formality as are applicable to ordinary trade marks will be applicable also to certification trade marks.

In view of the express provisions in section 69 of the Act, the rules governing in examination as to substantive requirements are slightly different in the case of certification trade mark.

The exclusion of the requirement in section 9(1) (a) would mean that the criteria of distinctiveness of a trade mark is not applicable to certification trade mark. For example, the words “Woolmark” in respect of articles of wool with the device of wool yarns would be considered descriptive for registration as ordinary mark, and would not be register able as an ordinary trade mark. Since the function of certification mark is different from an ordinary mark, the applicable law for register ability is also different. Accordingly “Woolmark” which is not register able as an ordinary mark may be registered as a certification trade mark. Also “Agmark” in respect of agricultural products is a registered certification trade mark.

In the context of an application for registration of certification trade mark under section 71 the provisions of section 18 as to making of an application will apply. Rule 134 provides that Part I, Part IV and Part VII of the Rules will apply subject to the provisions of Part III of the Rules.

The substantive examination of an application for certification trade mark will include –

- examination of the draft regulation,
- statement of case and more particularly about the competency of the applicant to certify the goods in respect of which the mark is to be registered and **whether in the circumstances of the case , the registration applied for would be to public advantage.**
- The proprietor should be an independent competent certifying agency without itself being engaged in dealing with those goods or provision of services.

- The draft of the regulation should meet the requirements of Act and Rules and the contents should include matters set out in rule 135(5), namely-

- a) A description of the applicant
- b) Nature of applicant's business
- c) Particulars of infrastructure like R & D, technical manpower support
- d) Applicants' competence to administer certification scheme
- e) The applicant's financial arrangement
- f) An undertaking from the applicant that there will be no discrimination between parties if they meet the requirement set down in the regulation.
- g) The characteristic the mark will indicate in the certified goods or services
- h) The manner of monitoring the use of the mark

45 Prohibition of registration of certain marks – section 9(2)

Section 9(2) prohibits registration as a trade mark if the mark –

- a) is of such nature as to deceive the public or cause confusion
- b) it contains or comprises any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India.
- c) it comprises or contains scandalous or obscene matters
- d) its use is prohibited under the Emblems and Names (Prevention of Improper use) Act, 1950

45.1 “Deceive” Section 9(2)(a)

In Collins Dictionary the verb "to deceive" is defined as "to mislead by deliberate misrepresentation or lies".

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 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.

45.2 Nature

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 trade mark 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 “strawberry jam” 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 the word “Jam”. If the mark is used deceptively contrary to the condition, the registration will become liable for rectification under section 57.

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 should reconsider whether the mark has now become free from objection of such a nature as to deceive the public.

For example no objection under Section 9(2)(a) may have been raised at the examination stage to the mark FINANCIAL WORLD for "magazines". It is against any trader's own interests to use such a phrase on anything other than magazines about finance. However, if the applicant seeks to exclude such goods simply to overcome official objection on the ground of descriptiveness to get his mark on the register, it will at once give rise to a Section 9(2)(a) objection since the use of the phrase 'financial world' in respect of magazines not dealing with finance will be deceptive.

Where, because of the nature of the mark, it appears obvious that it will only ever be used on one item within a broad specification,

the examiner should consider whether an objection under Section 9(2)(a) is appropriate. For example, a trade mark containing such terms as " Bitter beers with alc 4.7% vol" for "beers, stout, lager, porter, ale: non-alcoholic drinks; mineral and aerated waters" 'Kingfisher' is clearly not going to be used in relation to "non-alcoholic drinks; mineral and aerated waters". Prima facie the applicant has applied to register the mark for all those goods not in good faith. Accordingly objection should be raised where it is manifestly clear that the applicant's claim is broader than that which could possibly be justified.

45.3 When to raise an objection under Section 9(2)(a):

In the main, therefore, Section 9(2) (a) objections (deceptive nature) at first examination stage should be taken where there is prima facie misrepresentation as to "nature or quality of goods/services, geographical origin" etc:

45.4 Quality

ORLWOOLA for "suits", because the public would expect the goods to be made of all wools and to pay more for suits containing wool; Each word would be open to objection either on ground of descriptiveness or deceptiveness. Descriptiveness objection will arise where the word is (page 71)_____ on "woolen goods" and deceptiveness objection will only when used on non-woolen goods.

STAINLESS SUREFIT for "exhausts", because stainless steel exhausts are exposed to be of better quality, being more durable. Similar objection would arise.

45.5 Overcoming Section 9(2)(a) objections

Where a mark is prima facie capable of distinguishing, objections under Section 9(2)(a) **may be overcome** by a restriction of the specification. Objections raised under this Section of the Act generally result in the narrowing of the rights in the mark by means of imposing a limitation to the specification of goods/services. For example:

Mark applied for: Woolpoint

Specification: *Suits*

Limitation required: "...; *all made wholly or principally from wool.*"

Where a specification is being restricted to overcome a deceptiveness objection based upon the origin of the goods/services the specification should be restricted to goods *manufactured in* the appropriate place for manufactured goods or *produced in* for other goods.

46 Deceptiveness – Geographical origin and Section 9(2)(a)

46.1 Section 9(2)(a) objections should only be taken at first examination stage to place names or figurative marks indicating **geographical origin** where the place has a reputation for the goods or services, 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 trade marks 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.

46.2 Overcoming Section 9(2)(a) objections

Objection under Section 9(2)(a) **may be overcome** by a restriction of the specification of goods. Objections raised under this Section of the Act generally result in the narrowing of the rights in the mark by means of imposing a limitation to the specification of goods/services.

Where a specification is being restricted to overcome a deceptiveness objection based upon the origin of the goods/services the specification should be restricted to goods *manufactured in* the appropriate place for manufactured goods or *produced in* for other goods, for example:

SWISSTEX: “Watches and horological instruments; all manufactured in Switzerland”;

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.

47 “Marks likely to hurt religious susceptibilities” - Section 9(2)(b) -

Section 9(2)(b) mandates that a mark shall not be registered as a trade mark if it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India.

It is to be noted that it is a common trade practice in India to use names and picture of Gods and goddesses or religious symbols as trade mark. Accordingly such use per se is not regarded by public as offending religious sentiments of any class or section of public. However, such use in relation to certain goods may offend the religious sentiments of the people.

For Example, use of names/device of deities or religious heads on footwear may be considered distasteful and will be open to objection. Similarly use of Hindu gods in respect of Beef or meat products or use of names of Muslim saints for pork products would offend the religious feeling of respective sections of the public, to attract the objection under section 9(2)(b).

Registration of mark consisting of Goddess Meenakshi in respect of fertilizers and manures was rectified under section 11(b) of the 1958 Act (1976 IPLR 144).

The word “Vishnu” was treated only as a personal name in the absence of the device of Lord Vishnu, attaching no religious significance. See Sri Vishnu Cement Ltd vs. B.S. Cement Pvt. Ltd 1998 (18) PTC 130

The word “Ramayan” was refused registration. See Amritpal Singh vs. Lal Babu Priyadarshi 2005 (30)PTC 94(IPAB)

47.1 List of marks prohibited from registration by virtue of directions of Central government

Certain names and pictures of God and Goddess and also religious heads are prohibited from being registered as trade marks in terms of directions issued by the Central Government under section 23(1) of the Trade & Merchandise Marks Act, 1958. These directions continue to remain valid. The list which includes the following should therefore be checked in all cases to ensure compliance.

(Insert List)

48. “Mark containing scandalous or obscene matter”- Section 9(2)(c)

Section 9(2)(c) of the Act prohibits registration as a trade mark if the mark “comprises or contains scandalous or obscene matter”.

Whether a mark is obscene is a question of fact and it is for the applicant to demonstrate that it is not so when faced with objections under this provision.

Scandalous marks are those likely to offend accepted principles of morality. A mark which on its face appears to be offensive shall be refused. In this category will fall marks which could induce public disorder, or incite the criminal or other offensive behaviour.

The applicability of the objection must be decided objectively and non-discriminately.

49. The term “accepted principles of morality” is somewhat harder to define and the general principles applied in U.K. may be relevant

Is the mark likely to cause offence which amounts only to distaste or is it likely to cause offence which would justifiably cause outrage?

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 would

be likely significantly to undermine religious, family or social values, then an objection will be appropriate.

How much outrage is enough to raise an objection?

The outrage must be amongst an identifiable section of the public. A higher degree of outrage amongst a small section of the public will be sufficient to raise an objection, just as a lesser degree of outrage amongst a larger section of the public will also suffice.

Is it enough that the Examiner finds the mark offensive?

No, but the fact that the Examiner is offended will alert him or her to the need for caution. They may find it helpful to seek the views of others; for example, women may find some marks offensive, whilst men may find them distasteful, at the most. Similarly, the Examiner may not be offended, but must have regard to the likelihood of an identifiable section of the public being offended.

How should the assessment be made?

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.

Does it make a difference what the goods or services are?

Examiners are entitled to rely upon their own knowledge of words and their own perception of how they may be used; for example, some goods are traditionally used as message carriers, e.g. T-shirts, caps, banners, badges, mugs, stationery items and bags.

The nature of the goods or services can influence the degree of likely offence. For example, 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.

Objection should be taken under Section 9(2)(b) or 9(2) (c) to any mark which is likely to be offensive to religious susceptibilities or to public decency. Objections should be raised against explicit full frontal nudes and offensive (scandalous) back views.

Registration of trade marks in respect of contraceptive is not considered to be obscene. AIR 1959 CAL 56 (DB) Also AIR 1963 SC 1882.

Each case must be decided on its own facts. The dividing line is to be drawn between offence which amounts only to dis-taste and offence which would justifiably cause outrage or would be the subject of justifiable censure as being likely to undermine current religious, family or social values. See Ghazilian's TM Appln. (2002)RPC 628.

50 Examples of marks which may considered to be objectionable - Section 9(2)(b) or 9(2)(c)

Religious symbols

Use of religious symbols (like OM) or names (eg. Jesus) as trade marks is likely to undermine/offend religious value and sentiments. Names of Gods/goddesses which are also used as personal names may be considered as personal names unless accompanied by the device of such God/Goddess for registration purpose.

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. Contrary to accepted principles of morality in view of bad language.

Under Article 7(1)(f) of the EC Regulations brief guidelines laid down are as follows:

“Words or images which are offensive or rationally derogatory images, or which are blasphemous are not acceptable. There is a dividing line between this and trade mark which might be considered in poor taste. The later do not offend”.

51. Prohibition under Emblems and Names (Prevention of Improper Use) Act, 1950-Section 9(2)(d)

Section 9(2)(d) bars registration as a trade mark 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 trade mark 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 department of any Government , or the President, Government 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 in force;
- 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. Here it should be kept in view whether any other body carrying same kind of activities with similar name is in existence.
- 4) It connotes government's participation or patronage unless circumstances justify it. Certain words in a name may give the impression of Government's patronage. Such words are "National, National Institute of, National Council, of University, Indian Institute of, Indian Council of, etc.

This list is illustrative and not exhaustive.

51.1 Practice with regard to Red Cross

Marks consisting of words "Red Cross" or "Geneva Cross" or any cross device in red or in any closely resembling colour is not accepted for registration – See Geneva Convention Act, 1960(Act 6 of 1960).

However, applications made in black and white, which contain the device of a cross, or a crescent moon or lion and sun, will not attract objection.

Green crosses on a white background are generic for pharmacy and medical goods and services. Use of such emblems as trades mark is not to be permitted.

White crosses on green backgrounds are generic for first aid goods and services, and are based on European Union legislation establishing a white cross on a green background as the first aid sign. Objection must be raised for registration of such devices as trade marks

In respect of mark generally consisting of cross device, applicant is required to comply with the condition not to use the cross device in red or in any similar colour. Where the cross device is confusingly similar to the prohibited cross device, a condition is imposed that :-

“the mark will not be used with cross device appearing thereon in red or in which or silver on a red ground or with the cross device and ground in or of any similar respective colour or colours”.

51.2 Practice regarding 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 trade marks, except under the authority of the Olympic committee.

Protection extends to signs which are sufficiently similar to the Olympic Symbol or the Olympic Motto as to be likely to create in the public mind an association with those signs. Where an application is made consisting of or containing the Olympic symbol or words, object under Section 9(1)(a) of the Trade Marks Act.

52. Prohibition of registration of names of chemical elements or international Non-Proprietary Names- Section 13

Under section 13, the registration of a word as a trade mark, which is commonly used and accepted name of any single chemical element or compound in respect of chemical substances or preparation is prohibited. It is to be noted that such prohibition is only in respect of chemical element or compound and does not extend to other goods. For example, the word “Radium” may be registered in respect of readymade garments or any services.

Also the law prohibits registration of a word which is declared by the WHO and notified by the Registrar as international non-proprietary name, or which is deceptively similar to such name. This will mean that not only a word which is declared to be non-

proprietary by WHO but also any word which is deceptively similar to such word is prohibited from registration

CYLOVIR was refused, as being confusingly similar to the non-proprietary name ACYCLOVIR Cadila Laboratories vs. Burroghs Wellcome 2005 30 PTC 349 IPAB

The TMR should have a collection of alphabetical list of names as received from British Standards Institute (BSI) or World Health Organization (WHO) which are declared as non-proprietary names. All applications for registration of trade mark in class 5 should be subject to a search through this list to give effect to the provisions of section 13 of the Act. Non-proprietary names are generic names for specific substances in the fields of (a) Veterinary substances (b) Pesticides and (c) Pharmaceuticals.

Applications in Class 5 which **consist of**, a mark identical with or a trivial variation of a non-proprietary name in this category are open to objection under Section 9(1)(a) read with section 13.

Where the use of such name is in generic sense, there will be no objection. Also where the word is used in combination with a house mark or another distinctive trade mark the application would be *prima facie* acceptable.

52.1 Wording of objections

The mark in the application is open to objection under Section 13 read with Section 9(1) of the Act because the mark consists exclusively of the word “paracetamol” being a non-proprietary generic term for a pharmaceutical product.

Where the application consists exclusively of such prohibited name in this category, the objection cannot be overcome, and the application will be refused..

SPECIFICATION OF GOODS/SERVICES

53 Wide and Vague specifications

Rule 22 provides that for purpose of registration of trade marks, goods and services are to be classified in the manner specified in

the Fourth Schedule, which follows the system of international classification of goods and services.

Objection will be raised **under Rule 25(15)** in cases where registration is sought for 'All goods' or 'All services' in a Class - these descriptions are too vague and do not constitute a proper list of goods or services. See Rule 25(15) which explicitly states that in the case of an application for registration in respect of all goods or services or large variety of goods and services in a class, Registrar may refuse to accept the application, unless satisfied that the specification is justified by the use of the mark or the applicant intends to make in respect of all such goods/services.

From the Journal advertisement, it is noticed that in a large number of cases, apart from listing the goods/services, a further phrase is added as “and all other included in the class”. This amounts to allowing registration of the mark for “all goods or services” in a class, contrary to the specific provision in Rule 25(15). This should be strictly avoided.

Similarly, applications filed in respect of specifications that are drafted in the form of specific headings given in the 8th edition of the International Classification, such as musical instruments in class 15 will not be subject to an objection.

Classes 7 and 45.

The following U.K. practice may be adopted:

Class 7

In Class 7, claims to 'machines' without further qualification will be objected to. The following gives examples of descriptions which are acceptable, since in each case the end use of the machine has been identified:

Machines for agricultural purposes;

Machines for use in manufacturing processes;

Machines for the woolen industry

Or other specific machines, eg washing machines.

Class 9

Applications filed in Class 9 which continue to make vague and generalized reference to 'electric, electrical and/or electronic apparatus, devices, equipment and instruments' will be objected to

–

whether listed separately or in combination.

Classes 42, 43 and 44

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 25(15)**.

Class 45

The class heading to Class 45 is:

“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, 'Personal and social services rendered by others to meet the needs of individuals' is considered too vague and consequently a **Rule 25** objection will be raised against applications containing this description. Objections will also be taken against applications where specifications contain either 'personal services' or 'social services' as individual elements, eg, 'personal services rendered by others to meet the needs of individuals' or the like descriptions. The second part of the heading, 'security services for the protection of property and individuals' is sufficiently precise and will not attract an objection.

53.1 Lack of clarity of Individual in specifications

Although it is unlikely to happen very often, individual descriptions of goods or services sometimes fail to clearly describe the nature of the goods or services, even when read in conjunction with the class of the

application. In these circumstances an objection will be raised under **Rule 25**.

53.2 Misleading Specifications

The Registrar is entitled to require the applicant, in particular cases, to clarify the goods or services in relation to which he/she proposes to register the mark. The applicant is not entitled to hide the descriptive nature of a mark within a broad or vague specification of goods/services - the reasoning behind this is as set out in the HOLD AND DRAW case under the 1938 Act (1964) RPC 142. The Registrar has power to require such additional information and documents as he deems necessary.

Under rule 35, where the name or description of any goods appears on a trade mark the Registrar may refuse to register such mark in respect of goods or services other than those so named or described. Alternatively the Registrar may permit registration subject to the applicant giving an undertaking that the name will be varied where the trade mark is used upon goods or services covered by the specification other than the named goods or services. Such an undertaking will be included as a condition in the advertisement of the application in the Trade Marks Journal.

53.3 Evidence of distinctiveness acquired through use

The proviso to Section 9(1) makes it clear that a trade mark which offends against 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.

53.4 Requirement for registration

In *Windsurfing Chiemsee (C108&109/97) [1999] ETMR 585*, the ECJ provided guidance as to the conditions which should result in a finding that a trade mark has acquired a distinctive character through use. The court found 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."

53.5 Mark must have been used distinctively – as a trade mark

In the *Philips* case, the ECJ found that the fact that an undertaking is the only known supplier of a kind of goods/services does not preclude a finding that a mark has acquired a distinctive character for the goods/services. However, the court pointed out that such a finding was only possible where reliable evidence shows that recognition of the mark as indicating the goods/services of one undertaking is as a result of its use *as a trade mark*. According to the ECJ this means “use of the mark for the purposes of the identification, by the relevant class of persons, of the product or services as originating from a given undertaking.” In principle, this applies whether or not the applicant is the only supplier of a kind of goods/services to the market. The significance of the monopoly is that its effect may make it difficult to gauge whether the public has come to recognize the sign as a trade mark or whether they merely recognize the sign as characteristic of a particular kind of goods or services, and associate that kind of goods/services with the applicant because it is the only known (or the best known) supplier of goods/services of that kind.

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. Such a consumer is reasonably well informed, observant and circumspect. Such a consumer is unlikely to have come to recognize a sign as being one that identifies the trade source of the goods/services, unless the proprietor has educated the consumer to that perception.

The less plausible it appears on the face of it that consumers would take the mark in question as serving a trade mark function the more important it is to consider what, if anything, the proprietor has done to nurture the mark into a trade mark. Or to put it another way, the more descriptive or non-distinctive the mark appears, the more work the proprietor will have to put in to educate consumers that it is a trade mark. Where the mark has been used on a substantial scale as the sole or principal means of identifying the trade source of the goods it will often be quite easy to conclude from the context of the use that the public have been educated to see the mark as a trade mark.

53.6 Secondary trade mark

Where a trade mark consists of several features, the exclusive right of registration is in respect of the mark as a whole. (Section 17). However, a mark may acquire a distinctive character as a result of its being used as part of, or in conjunction with, another mark. There is no requirement for a non-distinctive mark to have been used alone before it can be registered on the basis of acquired distinctiveness, but where such a mark is used alongside another distinctive sign the burden on the applicant to show that the non-distinctive mark has come to be seen as a secondary trade mark will be greater. See TREAT case, [1997] E.T.M.R. 118.

Non-traditional marks, particularly colours and the appearance of the goods or their packaging, often pose particular problems. Such marks are seldom used as the principal means of distinguishing the trade source of the goods or services. Nevertheless, they are capable of being used as secondary trade marks. The key issue will usually be whether the proprietor has used the mark distinctively to educate the public that it is a trade mark. The most obvious way of educating the public that such a mark is a trade mark is for the proprietor to indicate this in its advertising by the use of statements such as “look for the one with the [blue] wrapper” or “you can rely on the [description of appearance of goods or packaging] to tell you its a [brand name]”. Evidence of such use is required.

In this connection, it should be noted that the use of small letters “TM” in relation to a mark with no trade mark character is not relevant. It can make an impression more on a lawyer than on an average consumer.

One means of signifying the trade mark significance of colours is to use them as a livery, i.e. as a consistent colour scheme applied to a range of products of the same general kind so as to designate the trade source. The use of such liveries for buses, trains and vehicle service stations are good examples of such use in relation to services. On the other hand, evidence that an applicant uses a wide range of colour schemes in relation to goods or services of the same kind tends to point away from the trade mark significance of any one such colour scheme.

Where there is doubt as to whether the proprietor has done enough to educate the relevant public that at least one of the functions of the sign in question is to identify the product or services as those of a single undertaking, evidence that the relevant public has come to rely upon the sign in question for the purpose of distinguishing between goods/services of different undertakings may be sufficient to show that the sign is recognized as serving a trade mark function. The best evidence of reliance is that which shows that (and in what way) those making selection decisions between competing products or services have come to rely upon the sign in the course of the selection process.

53.7 Use of the Mark as Part of another Trade Mark

In the light of the ECJ's judgement in *Societe des produits Nestle SA v Mars UK Ltd*, it is clear that, as a matter of law, there is no bar on a mark acquiring a distinctive character as a result of its use as part of another trade mark. Word marks are often used with device marks but that does not mean that the consumer could not look upon the use as being of two trade marks used together.

The rights of the registered proprietor are very clearly defined in section 17(1) which state that the exclusive right is in respect of the use of the trade mark taken as a whole . If the proprietor desires statutory protection to the exclusive use of any part of the trade mark, he has to apply to register not only the whole of the mark but also each such part as separate trade mark. Obviously any part , which is common to trade or is otherwise of a non-distinctive character will not be allowed registration, unless the applicant is able to adduce evidence of acquired distinctiveness for such part to claim exclusive right .

It is apparent that there would be no difficulty for the proprietor to obtain separate registration in respect of a part of trade mark if such part is inherently distinctive

The use of "HAVE A BREAK, HAVE A KIT KAT" was not accepted as use of HAVE A BREAK as a trade mark because that approach was found (as in the example above) to represent an artificial dissection of the used trade mark, contrary to the likely reaction of an average consumer to the use in question.

53.8 Evidence – Pure colour marks

Evidence filed to support a claim of factual distinctiveness for a mark consisting of colour as such will need to be very strong and persuasive. It will need to clearly demonstrate that the colour mark exclusively designates the applicant's goods or services to the relevant consumer. There is more likelihood of establishing factual distinctiveness where the goods or services are very restricted and the relevant market very specific.

As was held by the ECJ in examining the potential distinctiveness of colour sign, regard has to be had to the general public interest of not unduly restricting the availability of colours for other traders. It was held that colour could serve as badge of origin of an undertaking and might be capable of distinguishing the goods or services of an undertaking . However it was emphasized that the competent authority should consider the matter on case by case basis, the circumstances of each, including the use of the trade mark in question. See the reported case in (2004) FSR 65.

54. Evidence

Under section 129, 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 116 prescribes the manner in which the affidavits are to be executed. Rule 109 empowers the Registrar to require the filing of a document or produce such evidence as he may specify in the notice. This provides the legal basis for calling for information and other evidence from the applicants as part of the examination process.

However, it will normally be more efficient to raise an objection and then to give the applicant an opportunity to file information, documents and/or evidence in order to overcome the objection.

54.1 Practice

Where Examiners have reasonable grounds for believing that an application is open to objection he or she will raise an objection outlining the grounds for prospective refusal. Where the Examiner

considers that evidence of the mark in use may assist the application, he or she will invite the applicant to submit such evidence. There may be a few cases where the Examiner is unable to complete his or her *prima facie* examination of the application without further information from the applicant. For example, if the list of goods or services is highly technical or particularly obscure it may be necessary to seek further information about the exact nature of the goods or services before an assessment of distinctiveness can be made.

The Registrar therefore reserves the right to seek further information under Rule 109 in those cases where a full and stringent examination cannot be undertaken without it.

54.2 Thorough examination required

Examination of trade mark application has to be reasonably thorough, so that registration does not prejudicially affect the legitimate interest of honest traders and the general public. In this connection the following statement by Geoffrey Hobbs QC in relation to an appeal against the refusal of an application for the mark 'AD 2000' (1997) RPC 168, in the context of UK Act is relevant.

“ Although Section 11 of the Act contains various provisions designed to protect the legitimate interests of honest traders, the first line of protection is to refuse the registration of signs which are excluded from registration by the provisions of Section 3 (corresponding to section 9 of the Indian Act). See Yorkshire TM (1954) RPC 150 at 154 lines 20-25 per Viscount Simonds LC.” the privilege of a monopoly should not be conferred where it might require honest men to look for a defence.”

The ECJ in *Libertel Group BV and Benelux-Merkenbureau* confirmed that:

“...examination carried out at the time of application must not be a minimal one. It must be a stringent and full examination, in order to prevent trade marks from being improperly registered. As the Court has already held, for reasons of legal certainty and good

administration, it is necessary to ensure that trade marks whose use could successfully be challenged before the courts are not registered [2003] E.T.M.R . 63, Para 21).

54.3 Examination of evidence of use as a Trade Mark

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:

- 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;
- d) the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;
- e) statements from chambers of commerce and industry or other trade and professional associations”.

54.4 Market share

The “**market share**” question will generally arise in the case of marks owned by large corporations. In India in a competitive business environment trade marks are used by also small traders in connection with small business. It is impracticable to require them to show “market share” held by the mark.

However where claims are made for recognition of a trade mark as wellknown trade mark, it will be appropriate to require details of market share held by the applicant under the mark applied for.

54.5 Turnover, commencement of use and Period of Use

Evidence should be in respect of the user of the mark, when first commenced and the period of use 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.

Turnover figures should normally be given for the sales of goods/services under the mark over a period of about five years before the date of application. 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.

Ideally, the turnover figures should be broken down to give the turnover relating to each class of goods/services. However, industry does not group its products according to the WIPO system of classification, so this may not be a practical proposition. There should however be sufficient breakdown of the goods/services to support a finding that the relevant public has been repeatedly

exposed to the mark in use as a trade mark for all the goods/services for which acceptance is proposed.

In the case of financial services, turnover figures may not always be the appropriate means to gauge the extent of use of the trade mark. For example, turnover figures which are merely the total amount loaned or insured by the applicant will give an inflated picture in relation to how well-known the mark is in terms of exposure to the relevant public. However, a clear indication of the extent of use is required if the applicant is relying on this to demonstrate that the mark has acquired a distinctive character. In the case of financial services the number of account holders or investors and, if appropriate, the number and geographical spread of branches, could be used to demonstrate the extent of the use.

54.6 Area of use

Registration of trade mark is made generally on All India basis, unless otherwise the registration is limited to particular territory such as “for use in the state of” or “for use in the district of” . Such territorial restriction may be applied generally in the case of perishable goods such as milk products or vegetable products and not in the case of other consumer durables/FMCG.

For export: Occasionally, turnover figures also include goods for export. These figures may also be taken into account when considering the strength of the evidence. If turnover relates to goods manufactured in this country which are **only** for export, the applicant stands in the same position as a proprietor with a purely local reputation. The evidence will not normally be sufficient to demonstrate that the mark has acquired a distinctive character amongst a significant proportion of the relevant public in India. In such cases, application may be accepted as “only for export”.

If the use of the mark is only outside India, such use is irrelevant in the country.

54.7 Expenditure on advertisement of trade mark

Expenditure on advertisement of trade mark are normally provided for a period of 3 years or more prior to the date of filing of the application. The nature of the advertising should be given where

possible e.g. television, radio, newspapers, trade magazines, etc. The TMR should see whether the advertising was nationwide or restricted to local areas. The figures should be broken down to show costs in relation to each class of goods/services *where this is feasible*.

The importance to be attached to advertising figures will very much depend on the goods/services at issue. For example, the advertisement expenditure between highly sophisticated goods or fast moving consumer goods would be totally different. There may be little or no advertisement expenditure for highly specialized products with a special market. e.g. air craft market As against that the expenditure in relation to the promotion of toothpaste or cosmetics may be very high. In the case of some products of small value the company's promotion of their products may be through catalogue informing the existing clients of their updated products,. It is therefore important to assess the circumstances of each case in assessing the quantum of expenditure on advertisement on trade marks.

54.8 Exhibits

Exhibits are required to show how the mark has been used and in relation to which goods/services. They may be, for example, brochures, catalogues, price lists, invoices, area of sales, advertisements, etc. All exhibits should be dated prior to the date of application.

55. Evaluating the effect of the use of the trade mark

55.1 Average consumer to be considered.

Who is the average consumer depends on the nature of goods. If the goods are consumer goods/services then it will be the general public who are relevant. This will not be the case for specialist goods/services where the average consumer may be in a trade and is likely to have a higher level of knowledge when buying.

55.2 Nature of goods/services

The cost of the items should be considered in the context of the turnover figures. Are they expensive, specialized goods or cheap everyday item? The wider the market the more traders will be in it. Consequently, it will be harder for a trade mark to acquire a

distinctive character for common inexpensive goods/services than would be the case with an equivalent scale of use on expensive, specialized goods/services sold in a small market.

55.3 Goods/services in respect of which registration is sought

The specification of goods/services should normally reflect the goods/services shown in the exhibits to the applicant's declaration, affidavit or witness statement, and not the more general claims often used in the latter.

However, a wider specification of goods/services may be allowed where:

1. Prima facie objections do not apply to the goods/services not shown in the evidence;

or

2. the exhibits show use on a range of goods or services (e.g. "Pencils, pens, rulers, wall charts, staples, ink, deskpads") within the general term applied for (e.g. "Stationery").

Where use is shown on a specific item only (e.g. "magazines") the specification should reflect that item rather than the general term "printed matter", which includes books.

56 Retail Services - examination of evidence

There has been a doubt about whether retailers, including the emerging super markets, marketing goods of several manufacturers, could properly register their trade mark in respect of any goods /services. In other words the question is whether use of a mark under a retail trade name can be regarded as "use in relation to goods"

Section 2(2)(c) defines "the use of a mark,-

- (i) in relation to goods, shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

- (ii) in relation to services, shall be construed as a reference to the use of the mark as or as part of any statement about the availability, provision or performance of such services

In *Euro market Designs Inc v Peters and Crate & Barrel Ltd* [2001] FSR, the Court remarked *"If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but doubt whether the reader would regard the use of the shop name as really being "in relation" to the goods. I think that this is an issue worthy of trial itself..... . For instance, if you buy Kodak film in Boots and it is put into a bag labeled "Boots", only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too."*

It would appear that use of a shop name can be use in relation to the goods, if it distinguishes the goods of one undertaking from those of another. However, if goods are sold under the mark of another party, and are also available at other retailers, it is difficult to see how the use of the shop name serves a trade mark function for the goods. On the other hand if the goods do not carry another party's trade mark, the use of a shop name may be perceived as use of the retail name in relation to the goods, for example the name of a "fruit and vegetable" shop.

It is well settled that a selector of goods could own a trade mark. e.g. Akbarallys, a well known marketing agency of well known products in Mumbai.

As a rule of thumb therefore, the answer to the question "can use of a mark as a retail name be regarded as use in relation to the goods", will usually be "no" where the goods carry a trade mark of another party. However, every case must be considered on its own facts. As indicated above, the expression "use of the mark" is given a wide import so that the use is to be construed as a reference to the use of the mark upon, or in physical or in any other relation whatsoever to such goods. This will cover use of the mark in advertisement, in invoices, in orders and so on. See *Hermes TM(1982) IPLR January 7, page 13*

The position of specialist retailers may be difficult to assess, particularly where the producer's mark is not prominently applied to the goods. In such cases the average consumer may well perceive the specialist retailer as having more than just the usual retail relationship with the goods

It is not that only manufacturers can register marks for goods. The party whose name is used in relation to the goods may be a manufacturer or a selector, or a retailer selling his own goods or goods of others. Though the Registrar will not generally seek to look behind applications from retailers seeking registration of their marks for goods, retailers will not be able to register their marks for goods on the basis of distinctiveness acquired through use, if all they can show is use in relation to a service in Class 35.

57 Domain Names – Examination of evidence of distinctiveness

It has been fairly well settled that domain names are neither automatically eligible nor ineligible for registration as trade marks. The key question is whether the designation put forward for registration has the ability to function not simply as a domain name, but also as a trade mark for goods or services of the kind specified by the applicant. See *Digeo Broadband INC's TM Appn.* (2004) RPC 32.

For assessing distinctiveness of such trade marks, where the mark is not prima facie distinctive, the applicant may submit evidence of factual distinctiveness. If such evidence shows goods or services being offered for sale under the mark is likely to constitute trade mark use, and may (subject to the usual considerations) be sufficient to show that the same has acquired a distinctive character as a trade mark.

Use of the mark as a domain name will not assist unless the evidence shows that the relevant goods/services have been offered for sale under the domain name. Prominent use of the domain name (or at least the distinctive element(s) of it) on web pages offering goods or services for sale may constitute trade mark use, but each case should be considered on its own merits taking account of the way that the domain name has been used.

57.1 Examination of Evidence of Use –

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. However, in a few cases doubt may remain either about the nature of the use (whether the mark has been used and perceived as a trade mark) or about the extent and effect of the use (the extent of the reputation acquired under the trade mark).

58 Trade evidence & survey evidence

More than the declaratory affidavit by the applicant himself, trade evidence may be useful. Thus, the applicants may submit evidence from others in the same trade attesting to the distinctive character of the trade mark. These statements may come from chambers of commerce or other trade and professional associations, or from consumers. Such evidence may assist where there is doubt about the whether the trade mark has been used to a sufficient extent in the market place so as to have acquired a distinctive character in the eyes of a significant proportion of the relevant class of consumers.

Trade evidence may also assist where the goods or services are highly specialized. Trade evidence of this type is less likely to assist where the doubt is not about the extent of the use of the mark, but whether the nature of the use is such as to have educated an average consumer to regard the mark as an indication of the trade source of the goods/services. Where trade evidence is intended to fulfill this function, it will probably only be of assistance where it comes from traders with direct contact with ordinary consumers of the goods/services, who can give evidence of consumers reaction to, and reliance upon, the mark in question **in the course of trade.**

A public survey will usually be superfluous, seldom adding anything of materiality.

Survey evidence may , show that (contrary to what might be expected from the primary facts) a significant proportion of the relevant consumers do in fact look upon the applicant's mark as

serving a trade mark function. A survey is only likely to be of assistance if it is conducted in accordance with the guidelines set out below, and is directed to a matter in respect of which there is room for doubt.

58.1 TMR not to suggest type of evidence required

Examiners and Hearing Officers should avoid giving the impression that they are *requiring or requesting* evidence in support of trade mark applications. In letters, the Registrar will instead aim to say what needs to be proved. He will leave the applicant or his representative to decide what kind of evidence might prove it. The usual formula is to put it like this-

"In the absence of evidence that [eg the relevant public perceive the mark as designating trade source] the objection is maintained."

This is not to say that the Registrar will not help in advising the applicant the kind of evidence which might assist an application. The Registrar will make it clear that all evidence will be considered on its merits . Registrar **cannot commit himself before the applicant marshals his own evidence and files it before Registrar.**

58.2 Sworn Statements and Others - Weight

Since section 129 provides for evidence before Registrar to be by way of affidavit. As such unsworn statements are not admissible. The stronger the objection to the application is, the more important it will be for the applicants to provide trade evidence. Evidence in the form of a witness statement is acceptable and the Registrar will also take account of unsworn exhibits, e.g. letters, which have been submitted alongside, and as part of an affidavit.

58.3 Statements from the Trade

Where the person making the statement is a representative of a trade association or the editor of a trade journal this evidence may be considered provided it forms part of an affidavit by the applicant. In other cases it should be disclosed how the parties were selected.

Such evidence normally includes:

- the status of the person within the trade or service industry (this will assist in estimating the weight to be given to the trade evidence);
- that the person concerned either has no relationship with the applicant, or details of what the relationship is;
- the specific goods/services that the witness knows are traded in under the mark;
- how long the witness has known of the mark (this must be prior to the application date otherwise it is of no assistance);
- whether the person concerned regards the mark as indicating goods/services originating from a single source, ie the applicant;

This evidence may also include:

- a statement that the person concerned would regard use of the sign by other traders as likely to cause confusion, and why;
- any first hand experience the witness has about consumers' reaction to, and reliance upon, the mark in question **in the course of trade.**

Evidence from any party under the control of the applicant, or in respect of whom the applicant is likely to be able to apply commercial pressure to for supporting statements, should be given little weight. Examples of this may be those who manufacture, distribute or provide the goods or services on the applicant's behalf (other than independent retailers), or those with a vested interest in securing registration, such as a licensee.

58.4 Trade Experts seeking to Speak for the Public

Where the goods or services are not specialized, the fact that trade experts (who are likely to be much more familiar than the general public with the signs used in the trade) regard the applicant's sign as a trade mark may not be representative of the public at large. However, such evidence may still assist an

application to the extent that it establishes that the applicant's mark is known in the trade.

If the applicant has provided evidence from traders with direct contact with relevant consumers, appropriate weight should be attached to any direct experience they can provide of consumers reacting to the mark as a trade mark and relying upon that mark **in the course of trade**.

58.5 Survey evidence

Where the applicant submits responses to questionnaires filed as a result of a survey (whether of the general public or of the trade), the following guidelines should be considered:

- it should be stated how the interviewees have been selected (the survey will carry more weight if they have been selected so as to represent a cross section of the relevant public or trade);
- the 'relevant public' is comprised of actual or potential customers of the **kind** of goods/services in respect of which registration is sought – it is not appropriate to restrict the survey only to the class of persons who might purchase the applicant's goods/services;
- the number of persons issued with questionnaires or otherwise invited to take part in the survey should be disclosed;
- the total of those responding should be disclosed and should equal those responses submitted to the Registrar;
- the name of the applicant should not be disclosed in the questionnaire or in the covering letter;
- a representation of the sign(s) (if any) shown to interviewees should be included;
- the exact answers should be disclosed by providing copies of the actual response sheets;
- where the survey is conducted by professional interviewers, the place where the survey was conducted should be disclosed,

together with the exact instructions given to interviewers, including any coding instructions if the results were recorded on a computer.

The value of 'survey evidence' depends on how best it is able to demonstrate that the deponents recognize the mark in particular source.

58.6 Timing of Survey

Care is needed because a survey will most likely be conducted after the date of application. If the mark has had a long period of use before the date of application, and the survey is conducted reasonably soon after the material date, the perception of the average consumer will probably not differ greatly during that time. However, if the mark has not had much use before application and/or there is much more use and publicity etc after the material date, this could negate the value of a public survey: the public's perception of the mark will be as a result of education post-application date.

58.7 Questions in the survey

Obviously questions must not be leading. For example, if the question to be answered is "is the sign regarded as the applicant's trade mark" the questionnaire should not refer to the expression "trade mark" but use more open questions such as "What, if anything, does this picture signify to you?" It is legitimate to probe those that directly or indirectly mention the applicant in order to test the nature of any association using questions like "what would your reaction be if I told you that this is not a product of [the applicant]?"

58.8 Control Sample

It will often be helpful to include one or more other marks (fictitious or third party) in the survey to act as a control sample. This can assist in isolating recognition resulting simply from guesswork from more concrete identification.

However particular care is required where the applicant has been the only or best known (perhaps first) supplier of a category of goods/services to the market and the association is the result of the applicant's

monopoly in the goods/services rather than because of use of the sign in question as a trade mark. In this sort of case the views of the average consumer who is reasonably well informed etc must be established.

58.9 Surveys which do not meet the requirements

Failure to comply with these requirements does not necessarily mean that the evidence should be given no weight, (although it may do if the defects suggest that the survey has not been conducted fairly). However, it will mean that reduced weight should be given to the outcome of the survey.

In cases where there is big doubt about whether a sign is a distinctive trade mark, it will be particularly important that any survey evidence is valid before it can form the basis for accepting the application. Where the case for acceptance is otherwise more debateable, a technically defective survey may still carry enough weight to justify acceptance, provided that it has been conducted honestly and the defects do not appear to seriously undermine the result.

The survey evidence essentially will have to clearly show that the deponents recognize the applicant's mark as a trade mark of a particular source.

The relevant date for judging the matter is the date of application . Any attempt to rely upon the survey for the purposes of establishment of public attitude few years earlier is unsafe. See Brookebond Tm (2004)FSR 15.

59 Relevance of prior registration

59.1 General Principles

In the case of a mark which has been accepted on the basis of factual distinctiveness, the Registrar will not routinely require applicants to prove that the mark is distinctive for the purposes of a subsequent application to register a later mark, incorporating the earlier mark, for the **same** goods/services.

In cases, where the applicant applies to register a mark which consists of, or contains, a mark which is **similar** to an existing

registered trade mark in its name for the same goods/services, or where the applicant applies to register an existing registered mark for goods/services which are **similar** to those for which it is already registered, the earlier registration will have whatever value it provides as a precedent.

They may be accepted subject to the condition of association in terms of section 16 of the Act.

60. Association of trade mark - when required

Association of trade mark may be required where a trade mark applied for is –

- Identical with another trade mark registered or is the subject of an application for registration in the name of same proprietor; or
- the mark so nearly resembles as to be likely to deceive or cause confusion, if used by a person other than the proprietor
- In respect of the same goods or description of goods or same services or description of services

Condition of association should not be imposed if the goods/services are of different description. For example, if even though the mark may be same, which is registered for “small arms” in class 19 should not be required to be associated, when identical mark is sought to be registered by the same proprietor for say, cycles in class 12.

60.1 When evidence of distinctiveness be required for associated marks

The proviso to Section 9(1) of the Act makes it clear that a trade mark which is excluded from *prima facie* registration by Section 9(1)(a) - (c), may nevertheless be registered if:-

"....before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it"

The final words of the proviso make it clear that the question of factual distinctiveness must be determined by reference to the *use made* of the trade mark. In the TREAT case (1996 RPC 281)

Jacob J [as he then was] criticized the registration of the TREAT mark for 'dessert sauces and syrups' when the evidence of use filed only showed use of the mark on 'ice cream toppings'.

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. In this connection it should be noted that the infringement rights extend to the use of the same or similar marks in respect of similar goods/services, provided that there exists a likelihood of confusion.

The existence of a previously registered trade mark with which the new mark is to be associated, will not automatically facilitate its registration without compliance with the provisions of Section 9(1)

60.2 When applicant relies on earlier evidence

Under section 148, the register and any document upon which any entry in the register is based, among others are open to public inspection

Where the applicant desires to rely on the evidence filed in connection with an earlier application/registration in the applicant's name, the applicant will have to file an affidavit annexing therewith a copy of the evidence already filed in the earlier case on which he relies.

61. When New trade mark includes existing registered mark - same goods/services

A later trade mark which is *prima facie* objectionable under Section 9 of the Act will

not normally face an official objection where the trade mark proposed for registration

includes:

- an earlier trade mark which is already registered in India in the applicant's name **and which proceeded on the basis of distinctiveness acquired through use;**

AND

- which is registered in respect of ALL the goods/services covered by the later application;

PROVIDED THAT the earlier trade mark is *not*:

(i) *de minimis* in the later mark; OR

(ii) included in the later mark in such a way as to take away any distinctive character the earlier mark had when viewed alone.

Accordingly, as per U.K. practice, for example, if an applicant already has a registration of EXETER (for ties) it would be appropriate to accept a subsequent application to register EXETER TIES or EXETER'S TIES (for ties).

However, it would not follow that CHOICE COMPUTERS has acquired a distinctive character (for computers) because an applicant had established that PC CHOICE had acquired a distinctive character (also for computers) through use. Where all the elements in a trade mark are non distinctive, the distinctive character is to be found in the specific combination of the elements. CHOICE COMPUTERS is not therefore a minor variation on PC CHOICE.

Nor would it be appropriate to accept an application to register KEEPS YOUR BABY DRY on the basis that the applicant had an existing registration of BABY-DRY because any distinctive character that BABY-DRY has is lost when incorporated into the longer phrase, though the applicant may agree to associate the earlier mark.

62. Same mark for goods/services which are similar to those listed in the new application

In all cases the applicant must file evidence showing use of the mark applied for, before the date of the application, **in relation to the goods/services listed in the application.**

However, it is recognized that marks that are factually distinctive for one range of goods/services can more quickly become distinctive for similar goods/services. Accordingly, in assessing whether the evidence the applicant has filed on the application under examination is sufficient to show that the mark has acquired a distinctive character for the goods/services listed in the application, account may also be taken of any evidence filed on earlier applications for the same or closely similar trade mark for the same or similar goods/services.

It does *not* follow that a trade mark will *automatically* be accepted for additional goods/services simply because they are similar to the goods/services for which the mark is already registered. Every case should be decided on its own merits taking particular account of the strength of the *prima facie* objection to the latest application. Where the mark is *even less* distinctive for the goods or services in the latest application compared to those goods/services for which it is already registered, evidence of factual distinctiveness filed in respect of the earlier registration will not assist the latest application.

For example, an application to register TAX ADVISOR as a trade mark for 'financial advisory services' will not be assisted by evidence from an earlier case showing that the mark had become distinctive as a trade mark for 'periodical publications relating to finance' - even if these goods are similar to 'financial advisory services.'

63 Journal Entries

Where the later mark incorporates, or differs only in ways which do not alter the distinctive character of, the earlier mark and the goods/services are the same as, or more restricted than, those of the earlier mark, the Registrar will publish entries in the Journal advertising acceptance indicating "associated with T.M. No....."

Where evidence from an earlier registration is taken into account, the Journal may indicate thus:

"Proceeding on the basis of evidence of distinctiveness acquired through use".

64 Restricting the specification by amendment

Restricting the specification involves amending the description of goods or services applied for in order to limit their scope and thereby overcome an objection that has been raised because of the inclusion in the specification of particular goods or services. Specifications are usually restricted as a result of agreement by the applicant to meet the objection requirement of the TMR

Although Examiners and Hearing Officers should endeavor to assist the applicant/attorney to overcome the objection by amending the specification, there will be occasions when it will be impossible to do this. The responsibility for overcoming the objection remains with the applicant or his attorney. Accordingly, if an Examiner's suggestions are adopted, they become the applicant's proposal and accordingly, a request on Form TM-16 for amendment of specification of goods/services, should be filed in all cases.

65 Types of specification restriction

There are two ways to restrict a specification in order to overcome an objection-

- **a deletion**
- **a positive limit**

65.1 Deletions

Deleting is a simple removal of the goods or services which are causing the problem. This is an option if the mark faces objections only in relation to specific items in the specification, but is clearly distinctive for the rest of the specification. It is important to ensure that if specific terms have been deleted, the same goods or services are not still included elsewhere in the specification, for example within a broad term. For instance, a deletion of a specific inclusion of "computer software for financial management" would still be covered by the broader term "computer software for business purposes", elsewhere in the specification. When undertaking deletion of a broad term and substituting individual items, care must be taken not to widen the original scope of the specification. This is especially relevant when the original specification was filed as the class heading.

Once a specification has been limited by deletion, the deleted goods or services cannot be reinstated as it will amount to widening the specification.

65.2 Positive Limitations

These restrict the scope of the specification by more clearly defining the goods or services. This may be done either by a simple listing of specific items, or by saying specifically, for example, “all relating to...” or “all of the aforesaid goods being for use in...”. Commonly, a limitation of this type will be placed at the end of a specification, but in the case of a lengthy specification, may also be appropriate elsewhere in the text. Wherever it appears, it is very important to ensure that the punctuation is correct. The use of commas or semi-colons can make all the difference to the meaning of a specification. A semi-colon means that the limitation covers all the preceding wording, whilst a comma only covers the wording as far back as the preceding semi-colon.

A restriction in this way is a positive statement by the applicant, affirming exactly what they have cover for. It is therefore a desirable way to amend the specification, making for clarity of the Register, in the interests both of the applicant and of third parties.

Wherever it is considered necessary to amend the specification of goods by exclusion of certain goods/services regard may be had whether the exclusion will render the mark deceptive . For example , where the trade mark is **ROSE**, the specification of goods cannot be amended as “Cosmetics, perfumes, toiletries, but not including any such goods scented to smell like roses.” This exclusion, intended to overcome the descriptiveness of objection will render the mark deceptive when used on perfumes not smelling rose.

Similarly, in a trade mark consisting of the word **BROADBAND GLOBAL** the descriptiveness objection cannot be overcome by requiring amendment to exclude “services provided by internet”.

66 Section 11: Relative Grounds for Refusal of registration

This Section of the Act deals with the comparison between later marks and earlier marks. The Sections relevant to examination and searching are 11(1) and 11(2).

Section 11(1) reads as follows:

1) “Save as provided in section 12, a trade mark shall not be registered if, because of-

- (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
- (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

This section is concerned with examination for conflicting marks where the marks are identical or similar and the goods or services covered by the trade mark are either identical or similar. Because of these there exists a likelihood of confusion on the part of the public including likelihood of association with the earlier trade mark.

The ECJ, in its judgment in the *LTJ Diffusion SA v. Sadas Vertbaudet SA* case, said that “ a sign is identical with the trade mark where it reproduces, without any modification or addition, all the 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.”

This approach was followed by the English Court of Appeal in the *Reed v. Reed* case, [2004] EWCA 159.

66.1 Search for identical or similar mark

The search for identical or similar mark is confined to a particular class in which registration is applied for. Schedule IV to the Trade Marks Rules contains the classification of goods or services .

As prescribed in Rule 22, goods and services in the Fourth Schedule provide only a means by which the general content of the numbered international class can be quickly identified. For determining the classification of particular goods and services the alphabetical index of goods published by the Registrar or the current edition of international classification of goods and services published by WIPO should be consulted. It is settled law that classification of goods is not the criteria for deciding the question whether the two sets of goods or services are of the same description. The question has to be determined by taking into account several factors. Goods comprised in the same class may include goods of different description. Therefore the search may, in some cases extend to the class in which the goods/services fall and where necessary cross search in other related class.

The cases in which objection may arise are, where-

- (a) rival marks (namely the proposed mark and the earlier mark) are identical and the goods/services covered by them are also identical;
- (b) rival marks are identical, but goods/services covered by them are not identical but similar;
- (c) rival marks are not identical but similar and the goods/services covered by them are either identical or similar;

By reason of any of the above, there exists a likelihood of confusion.

66.2 Identical trade marks

A mark is identical with the trade mark where it reproduces without any modification or additions 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. This interpretation laid down by ECJ was followed by the court of appeal in Reed vs. Reed (2004) EWCA 159.

66.3 Similarity of marks

The terms similarity of trade marks is to be construed as “deceptively similar” which expression has been defined “as so nearly resembling that other mark as to be likely to deceive or cause confusion”. Section 2(1)(h)

66.4 Similarity of goods or services

For determining the similarity of goods/services (namely whether the goods/services are of the same description) the UK Registry follows the guidelines given in the Jellinex case (1946) 63 RPC 59 and the Floridex case(1974) RPC 583) . For the goods to be of the same description, the following considerations may be taken into account.

- the nature of the goods is the same
- purpose of the goods is the same
- channels of trade for the goods are the same or coincide at some stage

In respect of marks in relation to services the following criteria may be adopted to determine whether the services are to be regarded of the same description.

- the nature of services is the same
- purpose of the service is the same
- user of the services are the same
- and normal business relation are the same

Whether the goods/services are in competition or whether they are complimentary:

In recognizing that “ a service provider of one sort is apt to provide a range of particular services some of which will be common to those provided by a service provider of another sort”, is important to identify what are the core activities of the provider, rather than giving a wide interpretation of the specification of the registered mark. When performing a relative grounds search for conflicting marks, an earlier mark will be considered identical if:

a) all the elements are the same, or the differences between the two are so minor that the average consumer is unlikely to notice them;

and

b) the specifications cover identical goods or services. In deciding the meaning of particular terms in the specifications, examiners should not “stretch” the meaning of the terms to cover all eventualities, but should give the terms their ordinary natural meanings.

The question to be answered in each case is, would the public be led to think the goods/services have a common source? If the answer is yes, the goods/service must be regarded as similar within the meaning of the Act.

Further, if the goods perform the same function, then use of similar marks on both sets of goods may result in the marks being “associated” in the minds of the public. For example, the public may associate similar marks used on clocks and watches, audio tape and tape recorders, calculators and personal computers, banking services and magnetic cash cards.

66.5 Likelihood of confusion

For likelihood of confusion to exist, it must be *probable*, not merely *possible* that confusion will arise in the mind of the average consumer. Likelihood of association is not an alternative to likelihood of confusion, “but serves to define its scope”. Mere association, in the sense that the later mark brings the earlier mark to mind is insufficient to find a likelihood of confusion, unless the average consumer, in bringing the earlier mark to mind, is led to expect the goods or services of both marks to be under the control of one single trade source. “The risk that the public might believe that the goods/services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion” (*Canon*).

66.6 Global assessment

The main emphasis in *Sabel* is the idea that no single factor will lead to a conclusion that there is or is not a likelihood of confusion between marks, a theme shared by the judgments which followed. In *Sabel*, the Court decided that:

“The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case.”

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 trade marks,
- ii) how distinctive the earlier mark is, and
- iii) the degree of similarity between the respective goods or services.

Once an initial assessment of the individual factors has been undertaken, all three factors must be considered together in order to assess the overall likelihood of confusion. These factors are interdependent. “A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa” (*Canon*). And, “...the more distinctive the earlier mark, the greater will be the likelihood of confusion.” (*Sabel*).

The weight given to visual, aural and/or conceptual similarities and differences between the marks will vary depending upon the goods or services at issue. For example, purchase of clothing is likely to be on the basis of visual selection, whilst over-the-counter medication may be purchased orally, rendering the aural comparison paramount (*Lloyd*).

“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular the similarity between the trade marks and between these goods/services. Accordingly, a lesser degree of similarity between these goods/services may be offset by a greater degree of similarity between the marks and vice versa. *Canon Case* (1999) RPC 117.

66.7 “Earlier trade mark”

Section 11 of the Act refers to “*earlier* marks” which are given a fuller definition in explanation in sub-section (4).

An earlier trade mark means-

- a) a registered trade mark 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 trade marks;
- b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well known trade mark

Thus it will include an earlier registered mark and a prior pending application

67. Where composite trade mark comprises different distinctive element

In the case of composite marks comprised of 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 sent by the composite sign, which therefore depends upon the presence of both elements. Accordingly, the view is that the UK Registrar would not normally regard the marks ‘Alexander’ or ‘Morgan’ as being in conflict with the mark comprised of the full name, even if the respective goods are the same. The same principle is recognized in Section 17(1) of the Act which enacts that the mark must be considered as a whole.

It is possible for a word to be subsumed within a multiple slogan mark even though the words do not combine to form a totality with an obvious meaning. For example, it would be difficult to say that the word ‘targets’ has an independent and distinctive role in the

composite mark 'Fashion Week Targets Friday' (for clothing). Consequently, it is not likely that it would be held to be in conflict with the mark 'Targets' solus (again assuming same goods) because it is not the dominant element of that mark, and neither is it an independent and distinctive element of the composite mark.

In a different case eg the mark CAREAID is included in a two word composite mark such as SPINESPAN CAREAID (for medical services) where the two elements would appear to the consumer to be a) normally distinctive, and b) entirely independent of each other. If the respective goods/services are also identical, it is quite likely that the relevant consumer will assume that the inclusion of the CAREAID mark as an element in the composite mark SPINESPAN CAREAID is indicative of 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.

68. The average consumer

The global appreciation of the likelihood of confusion must be made through the eyes and the ears of the "average consumer". The average consumer will depend upon the type of goods or services in question, so that this may include members of the trade as well as of the general public. He/she is "deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind" (*Lloyd*).

The consumer's level of attention is likely to vary according to the category of goods or services, e.g. closer attention will be paid to the purchase of engineering equipment than is likely for everyday items such as foodstuff.

69. Notional and fair use

This refers to use across the range of goods/services claimed in any way that would be considered to be normal use of the trade mark in relation to the goods or services in question. Section 11 objections should not be waived on the basis that the goods/services will only be sold in a certain environment, or in a specific price range, or that the mark will only appear in a certain

way in connection with the goods/services. Trade Mark proprietors are free to change the way they market goods/services and they can assign marks which may then be used by the new proprietor as he considers fit.

70. Scope of Section 11(2)

Sub-section (2) is directed specifically to cases where the proposed mark is identical with or similar to the earlier trade mark but where the goods/services are not similar. Reputation of the earlier mark is an essential requisite in the context of sub-section (2), which is not called for in respect of section 11(1).

Section 11(2) incorporates the principles of law of unfair competition. The following considerations would arise in the application of the prohibitory provision in section 11(2)

- the distinctiveness of the earlier trade mark
- the extent to which the earlier trade mark is a well known mark in India
- the range of goods or services for which the earlier trade mark is well known
- whether the mark applied for is identical or similar to the earlier trade mark
- whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets
- whether the use of the later mark is without due cause and such use would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

Sub-section (5) of section 11 however specifically enacts “a trade mark shall not be refused registration on the grounds specified in sub-section (2) and (3) unless objection on any one or more of the grounds is raised in opposition proceedings by the proprietor of the earlier trade mark. It would thus imply that though the examination of the trade mark application may cover the aspects mentioned above, refusal of the application under section 11(2) should not be done ex officio by the TMR but only on the basis of an opposition.

71. Section 11(3)

This provision seeks to prevent registration of a trade mark whose use in India is liable to be prevented by virtue of any law in particular, the law of passing off protecting an unregistered trade mark used in the course of trade; or by virtue of law of copyright. Section 11(3) can only be determined on the basis of evidence filed in opposition or rectification proceedings – by virtue of the law contained in section 11(5). Nevertheless, the Examiner should examine the case with reference to Section 11(3) so as to enable the applicant to file his submissions or evidence in support of the application. The ultimate refusal under sub section (3) will be based only on objection being raised in opposition proceedings

72. Well known trade mark

Sub-sections (6) to (10) of section 11 deal with matters concerning protection of well-known trade marks. See also definition of the expression “well-known trade mark” in section 2(1)(zg). All these provisions will have to be read together for proper interpretation of the phrase.

Sub-section (6) lays down factors which the Registrar should take into account in determining whether the trade mark is well-known. The onus is on the proprietor to establish by evidence that the mark is well-known.

On the other hand, sub section (9) mandates that the Registrar shall not require as a condition, for determining that a trade mark is well-known any of the following factors.

1. that the trade mark has been used in India;
2. that the trade mark has been registered;
3. that the application for registration of the trade mark has been filed in India;
4. that the trade mark is well known in, or has been registered in, or in respect of which an application for registration has been filed in any jurisdiction other than India; or
5. that the trade mark is well known to the public at large in India

Sub-section (10) casts an obligation on Registrar to protect a well-known mark against identical or similar trade mark and to take

into account “the bad faith of either the applicant or the opponent in respect of the rights relating to the trade mark”.

Mark already registered in good faith protected

Sub-section (11) protects prior use in “good faith” or prior registration in good faith, made before the commencement of the Act.

73. Family of Marks(with common prefix)

If a search reveals a number of marks in the same ownership with common identical elements, they should not be regarded as confusingly similar to the mark being examined on this count alone; to do so, would be to assume a degree of reputation in the common feature of the earlier marks. Reputation cannot be considered at the *ex parte* stage because this is only appropriate as a matter for consideration under opposition. It cannot be assumed in the *prima facie* that any or all of the marks are even in use at the date of application. Consequently, where similar marks in the name of the same party are identified in a search, they should be compared with the later mark sequentially, not collectively.

Of course, there may be a case for raising all or some of the earlier marks as citations on other grounds. For example, company A has registered marks including "Portakabin", "Portaloo", "Portahouse", "Portatank" and "Portasafe", and company B has applied for "Portahome". The Registrar would not cite all the registered marks but only those, if any, that are individually confusing, i.e. Portahouse, on the grounds of visual and conceptual similarity.

74. Retail Services: search of the Register

Where there is likelihood of confusion by reason of identity of marks in respect of ‘services’ and related products objection based on official examination will be raised where:

- a mark is registered (or proposed to be registered) for retail services (or similar descriptions of this service) connected with the sale of specific goods or types of goods;

- another mark is registered (or proposed to be registered) by a different undertaking for goods of the type expressly mentioned in the specification of the retail services trade mark;
- the later trade mark is not just similar to the earlier mark but is identical or virtually identical to it, or contains a dominant and/or independently distinctive feature of it.

The reputation of the earlier trade mark and (unless it is obvious) the practices of the trade will only be taken into account on the basis of evidence in opposition or rectification proceedings.

For this purpose a search for earlier trade marks as per cross searching procedure, may be made.

75. General rules for comparison of marks

Rules of comparison as developed over the years and as laid down Parker J. in Pianotist case should continue to be followed- (1906) 23 RPC 774 page 777.

“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 trade marks is used in the normal way as a trade mark for the goods, the respective owners of the mark. If there is likely to be confusion, the application must be refused.”

The general well settled principles are:-

- It is not right to take part of the word and compare it with part of the other word
- The word must be considered as a whole
- Approach it from the point of view of a person of average intelligence and of imperfect recollection
- the over all structural and phonetical similarity and similarity of the idea in the two marks, whether reasonably likely to cause confusion

- No meticulous or letter by letter comparison required
- side by side comparison is not the correct test

76. ADDITIONAL PRECAUTIONS REQUIRED WHERE THE GOODS ARE MEDICINAL PREPARATIONS (CLASS 5)

In *Cadila Healthcare Limited vs. Cadila pharmaceutical Limited* (AIR 2001) SC 1952, the Supreme Court has laid down that -

“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 confusion over ordinary consumer products”.

In the above case, the apex court recommended “keeping in view the provisions of Section 17 B of the Drugs and Cosmetics Act, 1940 which *inter alia* indicates an imitation or resemblance of another drug in a manner likely to deceive being regarded as a spurious drug, it is but proper that before granting permission to manufacture a drug under a brand name the authority under that Act is satisfied that there will be no confusion in the market, the authorities should consider requiring such an applicant to submit an official search report from the Trade Mark office pertaining to the trade mark in question which will enable the drug authority to arrive at a correct conclusion”..

Thus, greater care is required to be taken where the goods involved are pharmaceutical preparation

77. Priority date claims

A person who has filed an application for protection of a trade mark in a country party to the Paris Convention can claim a right of priority during a period of six months from the date of filing of the foreign application. The effect is that if, within that period, he files an application to register the same trade mark in India, his application takes precedence over another application which has an earlier filing date, but a later priority date. (See para 4.2.9 above)

77.1 Marks with the same priority/filing date

If it is found that an application was filed on the same day (or has the same priority date) as the application being searched, the applicant should be notified of the potential conflict in the examination report.

They should also be informed that the Registrar does not intend to take any further action - both marks will be advertised in the Journal and the two parties will have to determine any conflict by way of opposition proceedings. If there is no opposition to either application, mutual consent will be presumed and both will proceed to registration.

Similar considerations will apply where two parties have the same priority date by virtue of an International Convention (I.C.) date. However, if the I.C. claim does not cover all the goods/services it is likely that the applicant with the earliest filing date will have priority in respect of at least some of the goods/services. The application with the earliest filing date will be raised as a cite in these circumstances.

78 Where marks are removed for non-renewal

Section 26 states that where a trade mark has been removed from the register for failure to pay the renewal fee, it shall nevertheless for the purpose of any application for registration of another trade mark during one year next after the date of renewal, be deemed to be a trade mark already on the register.

Therefore in examining an application under section 11, the examiner will take into account for a period of one year a trade mark which has been removed. In other words, even though technically the mark is removed for purpose of citation of conflicts, the mark will be deemed to be on the register for the period of one year after the date of removal subject to the two exceptions mentioned in the section namely:

- 1) There has been no bona fide use of the removed mark during two years preceeding its removal.
- 2) That no deception or confusion would be likely to arise from the use of the applicant's trade mark .

79. Consent of the earlier proprietor- Section 11(4)

Section 11(4) 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 or other earlier right consents to the registration. In such case the Registrar will proceed to register the mark under “special circumstances” in terms of section 12.

Consent letter from the proprietor of the earlier mark must contain the following particulars:

1. Application number of the mark
2. goods/services to which the proprietor of the cited mark is consenting
3. 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
4. The letter of consent should be from the same company whose name appears in the citation, with the details of the cited mark including the application/registration number of the mark.
5. Letters of consent should be in English or, if in a foreign language, be accompanied by a certified translation.

Just as provided under section 12, the Registrar, when allowing registration of a trade mark on the basis of a consent, he may impose such conditions and limitations, if any, as he may think fit.

79.1 Consent between Companies in the Same Ownership

The Registrar accepts the following simplified procedure in such cases:

- (i) A general letter of consent may be provided between the two companies setting out the relationship between the two companies and confirming that they are prepared to consent to any trade mark applications made by the other party.

(ii) On each occasion that a copy of the general letter of consent is filed, the applicant, or his agent, must supply a covering letter certifying that the general consent is still valid.

80. Overcoming the Registrar's objections

Objections raised under Section 11 can be overcome by:

- removing the conflicting goods/services; however it is not the function of the Registrar to state what goods/services should be excluded from the cited registration (Optimol TM) 1977 RPC 163 page 167
- obtaining consent from the proprietor of the cited mark(s);- section 11(4)
- filing evidence to establish honest concurrent use to secure registration under section 12;
- By 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 part of the application to proceed further .

81 Removing of conflict of 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/offer all the goods/service which could be covered by such wide specification and therefore may be able to be more specific about his intended activities. It may then be possible to identify whether a clash remains when more detail is available. Such a limitation could take the form of a shorter list of the goods/services for which protection is required, or it could consist of a more precise description of the kinds of goods/services named in the original list.

The Registrar may allow the deletion or limitation of goods/services; but in no case he should allow enlargement, addition or substitution of goods/services .

For example:

(a) Class 7 application: Spraying machines

(b) Class 7 citation: Agricultural machines and parts and fittings therefor

Limitation required of (a): "...; all for use on vehicle construction lines."

For example:

(a) Class 9 application: Electric cables

(b) Class 9 citation: Speakers and parts and fittings therefor.

Limitation required of (a): "...all for use in providing an electricity supply to properties".

A positive limitation should always be suggested where the applicant has used wide or vague terms in the specification of the application.

82 Exclusions

When using an 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. Previously, where the respective goods or services fell in the same class, it was acceptable to express the exclusion in the following way: "...; but not including x or any goods/services similar to x".

However, as it is now established that the similarity of goods/services is a somewhat elastic concept and but one factor in the global appreciation of all the relevant factors in the interests of legal certainty and proper administration, it will no longer be appropriate to deal with conflicts involving similar goods/services simply by excluding the identical conflicting good/service (X) from the specification of the later application and further excluding "... any goods/services **similar** to X".

Instead, 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.

Exclusions must be added to the specification of the relevant class of the application. If an exclusion is applied to resolve a conflict which arises because the applicant's description of goods/services (whilst relatively specific) still encompasses a product in the specification of an earlier conflicting mark, the exclusion applied to the applicant's specification of goods/services will have to exclude not only identical goods/services, but also similar goods/services (insofar as the similarities give rise to a likelihood of confusion on the part of the public).

For example:

(a) Class 9 application: Electrical machines for use in the Office

(b) Class 9 citation: Modems

Exclusion required of (a): "...but not including modems or telecommunications or computing apparatus."

Where the clash is only in respect of similar goods/services, the conflict needs to be identified and only those (named) similar goods/services excluded.

(a) Class 12 application: Cycles

(b) Class 12 citation: Motor land vehicles

Exclusion required of (a): "...; but not including motor cycles."

To strike out goods or services covered by the registered mark (TM-36)

It is possible for registered proprietor of trade mark to apply on form TM-36 to strike out goods or services covered by the registered trade mark under section 58(1)(d) read with rule 97 . Such an action is carried out by the proprietor of the cited mark, if he/she can be persuaded to do so by the applicant. The Registrar does not get involved in such negotiations. The specification of goods/services covered by the registered mark is then amended to

ensure it does not include the goods/services specified in the new application for registration.

83. Honest concurrent use - examination of evidence under Section 12

This provision means that the Registrar will allow an application, which conflicts with an earlier mark under Section 11(1) or 11(2) to be published for the purposes of opposition if the applicant can demonstrate that they have built up a sufficient amount of goodwill, or common-law right, in their mark. It is a practical means of consolidating that goodwill into a registered trade mark.

The important point about honest concurrent use is that common-law rights have accrued by reason of honesty of adoption and use of the trade mark, **without dishonest intention and without the owner of the earlier right having taken any prohibitive action against the applicant.**

To demonstrate honest concurrent use, the applicant's mark must have had sufficient visibility or exposure for the owner of the earlier right to have become aware of that mark so that a challenge could have been mounted. For this reason, a period of less than five years before the date of application is not usually viewed by the Registrar as being a sufficient length of time for such exposure to have occurred. Exposure will also normally be dependant on the extent of the use in this period. However, each case will turn upon its own facts.

If an application which has been accepted on the basis of honest concurrent use is then opposed, the mere fact of honest concurrent use will not save the application from refusal; see *ROADRUNNER Trade Mark [1996] FSR 805*.

The format and content of evidence presented to overcome conflicting citations is thus basically the same as that for overcoming Section 9 objections. Both pending or registered citations can be overcome only on the basis of consent under Section 11(4) for registration under section 12 under special circumstances. The Registrar's practice is to focus on the claim of honest concurrent use that has been made of the mark.

83.1 Points for consideration in examining evidence for registration under Section 12

When examining the evidence, certain aspects need to be dealt with particularly carefully. These are:

Length of use:

As a starting point, the mark should have been in use for a reasonable period, usually five years, prior to the application date. This means the other party, in respect of whose mark the applicant is claiming honest concurrent use, has had a reasonable time in which to become aware of the applicant, and to make any challenge. It must be stressed, however, that this period is only a guideline. Where circumstances dictate otherwise, this period can be reduced (or indeed, increased). It may be possible to reduce this period if e.g. the applicant has spent a massive amount on advertising his product and/or has had a very good turnover, even though his use only predates his application by a couple of years. Conversely, the period of use may need to be substantially more than five years, if the turnover is so small that it diminishes the weight that can be given to the length of use.

Form of use:

The exhibits must show the mark has been used as applied for or that any difference is negligible and will not affect the likelihood of confusion with the earlier trade mark.

Specification:

Insofar as the goods/services conflict with earlier trade marks, the specification **must** be limited to those goods/services for which the mark is actually used, as shown by evidence. There is no need to limit goods and services which are not in conflict.

Geographic limitation:

Depending upon the nature of goods, this may be appropriate if the applicant's use is limited to a **region** and the conflict with the earlier mark is significant, for example, when both marks are

identical and cover identical goods and/or services. Territorial limitation may be purposeful only in cases where the trading is local/regional.

Changes in ownership:

Changes in ownership of the mark from time to time is to be given where appropriate. Where affidavit declaration makes it clear that the user has been by the applicant or a predecessor in business or with the consent of the proprietor of the earlier mark, it should assist the applicant's case.

Balance of convenience:

In considering the question of registration on the basis of section 12, balance of convenience is a relevant consideration and in this the tribunal will take into account whether the hardship that may be caused to the applicant will be out of proportion to the hardship that will be caused to opponent or the interest of the public.

In *Gloy & Empire Adhesives Ltd.'s Application*, where the trade of the applicants and their predecessors in business under the mark in question was very small and was confined to certain narrow areas, the application for concurrent registration was refused by the Registrar on the ground that registration on the strength of such user would give the applicants rights extending to the whole of the UK, that protection in such extended user would be likely to cause very considerable deception to the public and seriously injure the opponents, and that there was no way in which their registration could be limited so as to protect them in the use of the mark to the small extent to which it had recently been used, without running the risk of deceiving and confusing the public and injuring the opponents.

83.2 Clauses which should appear in the advertisement

When applications proceed on the basis of honest concurrent use, it is desirable that the Journal advertisement should refer to the number(s) of one or more of those citations which have been overcome by the filing of evidence to substantiate the claim to honest concurrent use, together with the words "and others" if several citations have been overcome in this way identify cases where their clients may wish to file opposition.

The journal entry will read as :

Honest concurrent use, with Registered Trade Mark No.....
or

Honest concurrent use with Application No.....

84. Single application covering goods/services in more than one class (Section 18(2))

Section 18(2) provides that a single application may be made for registration of trade mark for different classes of goods and services . However, fee payable therefor shall be in respect of each such class of goods or services.

Under Rule 25(19) where an applicant files a single application, for more classes than one and the Registrar determines that the goods or services applied for fall in classes in addition to those applied for, the applicant may be required –

(a) to restrict the specification of goods or services to the class or classes specifically applied for; or

(b) amend the application to add additional class or classes on payment of appropriate class fee and divisional fee.

The new class created through the division will retain benefit of the original filing date. In the case of an application from convention country, the convention application date under section 154(2) can be maintained.

Where the applicant or the agent failed to comply with the requirement, the goods/services which fall outside the classes specified in the application will be removed from the list and the application will be proceeded with for examination only in respect of remainder of the goods/services

Amendment of specification which will have the effect of widening the specification will not be permitted. Therefore if particular goods/services are not included within the class listed by the applicant the inclusion of such goods /services or addition to any additional class will not be allowed.

To avoid lengthy specification of goods/services, rule 125(16) provides that specification of goods or services shall not ordinarily exceed 500 characters for each class. Otherwise, payment of excess fee will be necessary.

85. Amendments

Section 22 permits correction of any error in or in connection with the application or amendment of the application either before or after acceptance. The practice of the Trade Marks Registry will continue to be what it was under the 1958 Act. The expression “amendment” would mean something more than mere correction of error. The following types of amendments would be permissible.

- Where a label is in colour, it may be substituted by a black and white label.
- If the label contains letter ‘R’ in a circle as per trade practice or the word Regd./registered, the amendment of label by deletion of such signs and by substitution of a fresh representation would become necessary.
- Amendment of the label where there is a change in the name of the company becomes necessary where the label contains the name of the company. Such an amendment was held by the IPAB to be permissible. See the case reported in 2005(30) PTC 321.

Amendment of the mark which affects substantially the identity of the mark should not be allowed if the mark has been already advertised. However where an amendment to the mark is permitted, the amendment must be readvertised and procedure governing opposition etc should be followed afresh.

86. Division of Application

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. The division of application may arise in the following cases:

1. Pursuant to an objection on examination of the application by Registrar and before advertisement; or
2. During any opposition proceedings, or during any appeal proceedings regarding the case.

Rule 104 provides the procedure for division of application. Each divided application will be treated as separate application, with the same filing date. The Registrar will assign a separate new serial number to the divided application and they will be linked by cross reference with the initial application.

87. Advertisement of “Application before acceptance”

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 reason of any exceptional circumstances so to do”

It is felt that this provision is being routinely used by the Examiner to advertise almost all trade marks even in cases where there is strong objection to the registration of the mark under section 9 or 11. After advertisement if there is no opposition the mark generally proceeds to registration. This may lead to two serious anomalies:

- (a) The mark, the registration of which falls fairly within the prohibitory clause of section 9 may proceed to registration setting a bad precedent for other claimants for registration.
- (b) It may embarrass the proprietor of an earlier registered trade mark or proprietor of a prior pending application, by diluting the vested rights, and by forcing them to enter into avoidable litigation, through opposition or rectification proceedings..

It may lead to the necessity to right to withdrawal of acceptance , much to the inconvenience to the party and the TMR.

Unless, therefore, the Examiner is fully convinced by reason of evidence or otherwise that the trade mark qualifies for registration on the basis of material made available to him by the applicant or before the Hearing Officer where the matter goes for hearing, the application should not be ordered to proceed for advertisement as “before acceptance”.

The provision for advertisement before acceptance, as the law itself enacts, should be invoked only in “exceptional circumstances”. Where the Examiner 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”. In all such cases, it is essential that a cross notice must be issued to the registered proprietor or the prior applicant drawing his attention to the mark in question and inform him of the journal number in which the mark is proposed to be advertised. This will enable him to oppose the registration, if he chooses to do so.

If the applicant’s mark is considered to conflict with the same or similar mark of a prior pending application, the action on the later application should be deferred till a decision is taken on the same or similar mark covered by the earlier application. Otherwise both the marks should be advertised simultaneously giving cross notice to each other.

88. Conditions or limitations

Section 18(4) empowers the Registrar to accept an application subject to conditions or limitations. The Registrar may impose generally following types of conditions and limitations.

Variation condition governing the use of the mark:

“In actual use of the marks 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.”

Blank space condition

Where blank space appears in a label, the condition may read as “The Blank space shall be accepted only by a matter of wholly descriptive and non-trade mark character

Condition as to joint use:

In a case of jointly owned trade mark, the condition will be “that the mark will be used only in relation to goods connected in the course of trade with all the joint applicants”.

Condition as to association:

The Registrar may require the association of trade marks, where necessary, in terms of section 16 of the Act and make entry to that effect in the Register as “mark is associated with T.M. No.”

Limitations

The expression “limitation” has been defined in section 2(1)(l) as “any limitation of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode or area of use within India or outside India;”

Limitation by Agreement:

The parties may by mutual agreement limit the mode and area of use of their marks to avoid deception and confusion, and where the Registrar agrees, limitation may be entered in suitable manner.

Limitation as to area of use or mode of use:

Limitation may be entered as e.g. “Bidis for sale in the states of(or as “except for sale in the state of”), or “solely for exports”.

Limitation as to colour

Registration may be limited to colour e.g. “Registration is limited to the colours, blue and red in stripes as appearing in the label” This will ensure that the mark when limited to such colours will be distinctive and will not cause confusion in actual use.

The conditions or limitations should be worded in such a way as to make is reasonably clear to third parties, what its effects are. Since the provision for requiring disclaimer has been omitted in the present Act, where the Registrar requires some conditions should be imposed to clearly specify the rights of the proprietor, he may suitably word the condition to say that “registration shall give no right to the exclusive use of” In respect of purely descriptive matters which are so obvious , there is no need to enter such conditions.

89. Conditional acceptance

Under Section 18(4) Registrar has a discretion to refuse or accept an application subject to such modification, conditions and limitations as the Registrar may require or impose,. However 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 his observation or apply for a hearing . Failure to do so within the prescribed period of one month, (unless the period is extended) will result in the application being deemed to have been abandoned.

90. Amendments/modifications

Amendments or modifications may arise in respect of specification of goods/services or classification of goods / services as per international classification . Rule 25(15) lays down that the Registrar may refuse an application unless he is satisfied that the specification of goods/services is justified by the use of the mark which the applicant has made or intends to make when the mark is registered. Where the application seeks to cover all the goods included in particular class there may be strong suspicion about the applicant’s intention to use the mark in connection with all goods or services. The application may also become open to objection under section 11(10) namely bad faith in making the application. In such cases amendment/modifications may be required .

91. Withdrawal of acceptance

The power of withdrawal of acceptance of an application for registration of a trade mark before its registration is an enabling provision and therefore it should be exercised very rarely in

unavoidable circumstances. If the acceptance of an application has been properly made after thorough examination of the case in all its aspects, the need for withdrawal of acceptance will not ordinarily arise.

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 it had not been accepted

-Where the applicant desires a hearing, Registrar will issue notice appointing a hearing atleast 15 days after the notice . Alternatively, the applicant may make such submissions stating that he does not desire to be heard . Thereafter the Registrar may, after hearing the applicant or after considering the submission, pass such orders as he may deem fit.

Where an order for withdrawal of acceptance is passed, in case it is felt that the application should be refused or accepted only subject to certain conditions, a show cause notice should be issued and where required, an opportunity of hearing should be given, before final orders of refusal or conditional acceptance are passed.

92. Refusal of application:

Section 18(4) empowers Registrar to refuse an application or he may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any as he may think fit.

In case of refusal or conditional acceptance the Registrar shall record in writing the grounds for such refusal. See Section 18(5). The requirement under section 18(5) is mandatory and should be complied with on the file of the application.

Under rule 40, the decision of the Registrar must be communicated to the applicant in writing. Since the said rule 40 provides for a procedure to apply to the Registrar requiring him to state the grounds of decision, while communicating the decision as per first part of Rule 40, the Registrar should draw attention of the affected party to the later part of Rule 40 and the procedure for obtaining the grounds of decision. The letter should clearly indicate that the grounds of decision will be communicated on receipt of a request on form TM-15 to be filed within 30 days.

With the establishment of IPAB to facilitate speedy disposal of appeals against decisions of Registrar, the aggrieved party may be expected to appeal against order of refusal by registration in almost all cases. Therefore a one line communication to the party that the application is refused, coupled with non-recordal in the file of grounds of decision for refusal is not a good practice and is liable for challenge. See the ruling of the Supreme court in Travancore Rayon vs. Union of India AIR 1971 SC 862, p. 866 (quoted in para 1 above page 2)

It cannot be assumed by the hearing officer that the grounds of refusal need to be prepared only when the party applies for it. It should be on the file, to be supplied when the requirement of Rule 40 is met by filing an application on form TM-15.

Similarly, if the objection is based on section 13 or 9(2)(d), there is no way it can be overcome and refusal become inevitable. In such cases, if there are no other objections, the report should only highlight the objection.

Examination Report

A model examination report is annexed, for use by the Examiners with such variations as may be considered appropriate, depending upon the requirements in each case. The wordings and nature of objections cannot be the same in all cases and should be suitably modified. It is necessary that the report should not look stereotyped. Every examination report should be application specific. For example, if an application is free from any objection, either on formality or substantive grounds, the report should contain an indication of acceptance of the application, stating that it is proceeding to advertisement in the TMJ. If possible specify the journal number. If acceptance of the application is subject to any conditions (including association), state that also.

CHAPTER III

Rules of Procedure in opposition proceedings

After advertisement of a trade mark in the Trade Marks Journal, section 21 provides a period of 3 months (which may be extended by a period not exceeding 1 month) within which the registration of the trade mark may be opposed by any person.

This opposition proceeding can be filed only before the Registrar and cannot be taken direct either to the Court or the Appellate Board (IPAB). If the opposition is successful, the registration of the trade mark will be refused. If it fails, the mark will be registered.

Who may oppose:

Section 21 provides that “any person” may give notice of opposition to the registration of a trade mark, whether he has or has not any commercial or personal interest in the matter.

The person need not be a prior registered trade mark owner. He can be a customer, a purchaser or member of the public likely to use the goods. The question of bona fides of the opponent does not arise. The opponent is considered to represent not only his own interest but also to some substantial extent, that of the public. See Pharmedica GMBH’S TM Appln. 2000 RPC, 536, page 542. The opposition must, none the less, be started within a strict and generally non-extendable time limit because, regardless of the public interest in having the issues decided, the person otherwise entitled to the benefit of the grant or registration which is opposed should not be subject to an unreasonable delay in the decision of the opposition.

Essential requirements for filing notice of opposition:

- In all cases (whether an ordinary trade mark, collective mark or certification mark), the notice of opposition should be on the prescribed form TM-5, accompanied by the prescribed fee.
- It should be filed at the appropriate office – see rule 8

□ The provisions of rule 18 regarding 'address for service' must be complied with, where necessary.

□ The notice of opposition should contain particulars as prescribed in Rule 48, which runs as follows:

A Notice of opposition shall contain,-

a) in respect of an application against which opposition is entered-

(i) the application number against which opposition is entered;

(ii) an indication of the goods or services listed in the trade mark application against which opposition is entered; and

(iii) the name of the applicant for the trade mark.

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;

(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 that 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 whether appropriate, a description of the mark or earlier right, and
 - (vi) Where the goods or services in respect of which earlier mark has been registered or applied for an in respect of which the earlier mark is well known within the meaning of sub-section (2) of section 11 or has a reputation within the meaning of that section, the opponent shall when indicating all the goods or services for which the earlier mark is protected, also indicate those goods or services on which the opposition is based.
- (c) in respect of the opposing party-
- (i) where the opposition is entered by the proprietor of the earlier mark or of the earlier right, his name and address and an indication that he is the proprietor of such mark or right;
 - (ii) where opposition is entered by a licensee not being a registered user, the name of the licensee and his address and an indication that he has been authorized to enter the opposition.
 - (iii) where the opposition is entered by the 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 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.
- (d) the grounds on which the opposition is based.

(2) A notice of opposition shall be verified at the foot by the opponent or by some other person who is acquainted with the facts of the case.

(3) 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.

(4) 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.

It should be noted that Section 150 expressly enacts that 'where a fee is payable in respect of the filing of a document at the Registry, the document shall be deemed not to have been filed at the registry until the fee has been paid.'

Grounds of opposition:

Section 21, which provides for filing notice of opposition, does not refer to any ground on which the opposition may be filed. The opponent is thus at liberty to set up any ground which may support his opposition against the registration of the trade mark under any of the provisions of the Trade Marks Act, 1999 and the Rules prescribed there under. However, under section 11(5), a trade mark shall not be refused registration on the grounds specified in sub-section (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

In this connection, it is to be noted that section 9 contains 'absolute grounds for refusal of registration' and section 11 contains provision for 'relative grounds for refusal of registration'. See also section 12, section 13, section 14 and section 18, which may form grounds of opposition.

Further procedure on receipt of opposition:

- A copy of the notice of opposition is to be served on the applicant, as early as possible – ordinarily within 3 months – see rule 47(7), drawing attention of the applicant to the time limit requirement prescribed in section 21(2) and

indicating that non-compliance to file the counterstatement within the prescribed period will be fatal to the application.

- The counter statement is to be filed by the applicant in the manner prescribed in Rule 49 on Form TM-6 together with the prescribed fee at the appropriate office, within 2 months from the date of receipt by the applicant of the copy of notice of opposition. There is no provision in the law for extension of this period. Section 21(2) enacts that if the opponent does not do so, he shall be 'deemed to have abandoned his application'.
- Rules 50, 51 and 52 govern the procedure for filing of evidence in support of opposition, evidence in support of application and evidence in reply by opponent.
- No further evidence may be filed, except with the leave of the Registrar subject to costs or otherwise, as the Registrar may think fit, vide Rule 53. For this purpose, the party seeking leave of Registrar should file an interlocutory petition and the matter may become subject matter of hearing, if the other party contests the petition – see section 128.
- If there are exhibits to affidavits a copy of the same shall be sent to the other party on his request and at his expense. Where it cannot be conveniently done, the original shall be left with the Registrar so that they may be open to inspection. The original exhibits are required to be produced at the time of hearing before Registrar. Evidence may refer to exhibits to support the case. They may be conveniently numbered sequentially for easy identification.
- In case of documents, which are in languages other than English/Hindi and relied on by any of the parties, an attested translation in Hindi/English shall be furnished in duplicate – Rule 55.
- Any act which is required to be done before the Registrar by any person may be done by a legal practitioner, a registered trade mark agent or by his employee when such person is “duly authorized in the prescribed manner”. See section 145.

Rule 21 prescribes the form TM-48 for the purpose of executing the power of attorney. When an opposition is filed by a legal practitioner on behalf of his client, without the power of attorney, it is necessary to file it subsequently at the earliest. Otherwise the opposition may be treated as void ab-initio. See *Accurate Engineers vs. Alps Engineering Co.* 1993 PTC, 242.

Extension of time

Section 131 empowers the Registrar for extending the time for doing any act (not being a time expressly provided in the Act), whether the time so specified has expired or not, on application made to him in the prescribed manner and accompanied by the prescribed fee, if there is sufficient cause. It is imperative, therefore, that 'sufficient cause' must be shown by giving justifiable reasons for extension of time. The onus is on the person seeking the extension. See 1996 RPC 507.

Substitution of parties to proceedings.

- . The Registrar has power to allow the substitution of an opponent, where it becomes necessary. See *Kirkbi AG's Appl.* (1999) RPC 733.

- . By virtue of section 30, an unregistered trade mark is assignable or transmissible with or without the goodwill of the business. So if there is change in ownership of the mark, which is the subject matter of opposition, the name of the new owner has to be brought on record and the opposition proceedings can be continued, subject to the following: the respective parties stand by the grounds or statements made in the notice of opposition/counterstatement/evidence and confirm that where the name of the original party appears, this should be read as though it is made in their name; and that they are aware of and accept their liability for the whole of the proceedings in the event of the opposition/application being unsuccessful.

For example, where an interest in a mark or marks forming the basis of an opposition is assigned to another party, that party may apply to the Registrar to be substituted for the

original opponent or applicant. It should be noted that this only applies if the transfer takes place after the proceedings have commenced whether or not any inextensible periods for filing pleadings have expired. In cases where proceedings have been launched in the wrong name, the ability to correct the misnomer will depend on the intention of the people responsible for filing the forms which commenced proceedings.

When such a substitution takes place it does not give the new party a right to recommence proceedings based on fresh pleadings and/or evidence. There is a discretion to amend pleadings, withdraw evidence or file fresh evidence, but the substitution of an opponents/applicants gives no additional right to revisit the pleadings and/or evidence.

Any application to substitute a party must be made in writing, supported by copies of any transfer documents (e.g. an assignment). The other party(ies) will be invited to comment before any determination is made.

Security for costs

Section 127(b) empowers Registrar to make such order as to costs, as he considers reasonable, and any such order shall be executable as a decree of a civil court. If the applicant or the opponent does not reside or carries on business in India, the Registrar may require him to give security for costs of the proceedings before him, and in default of such security, may treat the opposition or application, as the case may be, as abandoned. See Section 21(6).

Protection of well known trade mark

Section 11(10) expressly enacts that while considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall protect a well known trade mark against identical or similar trade marks. Accordingly, if the applicant's mark is well known, the Registrar is bound to allow registration of the mark. The contrary will be the position when the opponent's mark is well known and the application is made in bad faith.

Evidence:

In proceedings before the Registrar, evidence shall be by way of affidavit under section 129. The form and manner in which affidavits are to be executed is prescribed in rule 116.

Verification of affidavits is an important requirement. As laid down by Supreme Court, it should be done in the manner prescribed by Order 19, Rule 3 of the Code of Civil Procedure.

In view of the sacred character of sworn affidavits, inaccuracies or false statements will not be taken lightly by the courts and they may reject them on the ground that they are prepared in a careless manner. (31 RPC 501, p.506.) That apart, it may also render the party liable for action – see 1982 PTC 321; 1985 PTC 80.

Section 129 empowers the Registrar to take oral evidence in lieu of or in addition to the evidence by affidavit.

Under Section 148(2), read with section 137(2), certified copies of affidavits filed in proceedings before Registrar are admissible as evidence. See *Ajit Singh v. Charan Singh* AIR 1974 P&H 116, p.119.

Main evidence:

The Registry cannot advise on the content (as distinct from form) of evidence as this is a matter entirely for the parties, these being judicial or quasi-judicial proceedings. Plainly, the parties will be seeking to prove the facts which they have asserted and identified as being in dispute in their statement and counterstatement. Each party has an opportunity to file evidence to support their respective cases, and then the person initiating proceedings has an opportunity to file evidence strictly in reply.

Evidence in support of opposition will be filed in the manner prescribed in Rule 50(1). Thereafter evidence in support of opposition will be filed as per provisions of Rule 51. Rule 52 then provides for filing evidence in reply by opponent.

Evidence in reply:

The question of what is evidence 'strictly in reply' has been discussed in a number of cases (e.g. 'Ford Motor Company Ltd (Nastas's) Application [1968] RPC 220, Ernest Scragg & Sons Ltd's Application [1972] RPC 679 and Peckitt's Application [1999] RPC 337. In Scragg's Application, Graham J. quoted the general position in regard to onus found in Halsbury's Laws of England, volume 15, paragraph 495

When the onus of proof on all issues is on one party, that party must ordinarily, when presenting his case, adduce all his evidence, and may not, after the close of his opponent's case seek to adduce additional evidence to strengthen his own case.

If an opponent has case, Graham J. said that he should straight away state what that case is, to avoid 'skirmishing'.

Clearly, the aim of the 'evidence in reply' rule is to achieve finality in the proceeding; evidence in reply must not involve a departure from a case put in chief, but may consist of comment on the other side's evidence. There is however nothing wrong with repeating elements put in chief, adding emphasis, using different language or posing rhetorical questions.

When bad faith allegation is made:

Evidence to support a claim under section 11(10) of the Act must be particularly focused as this is a very serious claim. Section 11(10) of the Act states that the Registrar shall take into consideration the bad faith involved either of the applicant or the opponent

In *Gromax Plastics Ltd v. Don & Law Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-

short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the court (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances”.

And in Royal Enfield case the Appointed Person, held:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not be lightly made (see Lord Denning M.R. in *Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch.D.473 at 489). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference”

Therefore a claim under section 11(10)) must be supported by evidence of dishonest activities or dealings or at the least commercial behaviour or activities below the standard regarded as acceptable by the community at large.

Section 11(1) objection:

Section 11(1) reads as follows:

(1) Save as provided in section 12, a trade mark shall not be registered, if because of-

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

The following propositions would arise in connection with an objection under section 11(1).

- Are there similarities in terms of marks and goods, which would combine to create a likelihood of confusion if the 'earlier trade mark' and the mark applied for registration are used concurrently in relation to the goods/services for which they are respectively registered or proposed to be registered.
- The 'earlier' mark need not have reputation to benefit from section 11(1).
- Distinctiveness resemblance and proximity of trading are matters of fact and degree which should be given weight and priority they deserve, as part of overall assessment.
- Where people are likely to perceive or assume correctly that similar marks are being used by separate undertakings trading independently of one another registration need not be prevented. See *Naturelle TM* (1999) RPC 320. page 330. Also see *British Sugar vs. James Robertson*(1996) RPC 281, p. 297.

Section 11(2) objection:

Section 11(2) runs thus:

A trade mark which –

- a) is identical with or similar to an earlier trade mark; and
- b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

shall not be registered if or to the extent the earlier trade mark is a wellknown trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

The following considerations are relevant.

- the distinctiveness of the earlier trade mark
- the extent to which the earlier trade mark is a well known mark in India

- the range of goods or services for which the earlier trade mark is wellknown.
- whether the mark applied for is identical or similar to the earlier trade mark
- whether the respective goods/services, although dissimilar, are in some way related or likely to be sold through the same outlets.
- whether the use of the later mark is without due cause and such use would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark

Where objection is raised under section 11(2) as a ground of opposition and the party claims that the mark has a reputation to reinforce their argument, then evidence will need to be provided to prove that the mark has the reputation claimed. The onus is also on the person claiming reputation to prove that the use of the mark applied for without due cause would damage the distinctive character and repute of the mark.

This evidence will have to cover a wide range of factors, such as –

- inherent capacity of the mark to distinguish itself,
- the length of use of the mark and for which goods/services,
- the turnover or intensity of the use and the market share attained
- the geographical spread of the use,
- the amount invested in promotion and advertising, and
- evidence from the public and from the trade of their recognition of the mark.

To counter this the other party would need to provide evidence demonstrating the low distinctive character of the other mark and that there has been honest concurrent use, by showing use of both

marks (as registered and/or applied for) in the market place over a period of time.

Section 11(3) objection-

Section 11(3) provides as follows:

A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented-

a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or

b) by virtue of law of copyright.

Objection under section 11(3) call for evidence of facts from which it could be properly concluded that normal and fair use of the trade mark for the purpose of distinguishing the goods/services of the applicant from those of others was liable to be prevented at the date of application for registration of the later mark by enforcement of rights in a passing of action or under copyright law.

It is an essential element that there be a misrepresentation, which is likely to lead to damage. "In the interests of fair trading and in the interests of all who may wish to buy or sell goods the law recognizes that certain limitations upon freedom of action are necessary and desirable. In some situation the law has had to resolve what might at first appear to be conflicts between competing rights. In solving the problems which have arisen there has been no need to resort to any; abstruse principles but rather, I think, to the straight-forward principle that trading must not only be honest but must not even unintentionally be unfair".

The principles of passing off were restated by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341, at 406. Lord Oliver considered that the tort of passing off is constituted where there is:-

"(1) reputation or goodwill attaching to the goods of a trader in the minds of the buying public that are identified by a distinctive mark; and

(2) a misrepresentation to the public, whether intentional or not, by another trader likely to lead the public to believe his goods were those of the first trader; and

(3) damage or a really serious risk of damage to the first trader as a result of the erroneous belief engendered by the misrepresentation”.

Law of copyright:

Registration of a mark, the use of which would be contrary to law of copyright would be considered to be contrary to law. Even after registration, it may liable for cancellation whether registration is liable to be prevented by virtue of copyright law is one of the fact and a matter of evidence.

Hearing and decision

Ordinarily within 3 months after completion of evidence, the Registrar will appoint a date of hearing and notify the parties. The date of hearing shall be at least 1 month after the date of the notice.

The parties to the hearing are required to notify the Registrar on Form TM-7 their intention to attend the hearing. Failure to do so within 14 days from the date of receipt of the notice, may render the party liable to be treated as not desiring to be heard and the Registrar may act accordingly in the matter – vide Rule 56(1). The Registrar has inherent power to adjourn the date of hearing.

However, requests from parties to the proceedings for adjournment of hearing will be regulated in the light of sub-rules (2) to (7) of Rule 56.

In the context of a proceeding under the Act, the Registrar is a "tribunal", exercising quasi-judicial functions. See section 2(1)(ze) which contains the definition of 'tribunal'. The term "Registrar" includes any officer when discharging the functions of Registrar under section 3(2) of the Act. While functioning as 'tribunal', he adheres to the same principles as are applied in courts in dealing with the cases justly. These include:

- . The parties before him are on equal footing

- Ensuring that the case is dealt with and decided expeditiously and fairly in accordance with law, regardless of whatever 'initial' views might have been expressed or stand taken by the registry on the basis of what the parties would have submitted in the matter earlier. Once the matter becomes subject matter of inter party proceedings, the role of the Registrar changes from administrative to that of a tribunal and the matter would be considered afresh in all its aspects. He is not bound by any earlier ex parte decision given by him. See (1982) PTC 284, p.292.

- . As was held by the Supreme Court 'the procedure by the courts is regularly prescribed...the procedure which the tribunals have to follow may not always be so strictly prescribed, but the approach adopted by both the courts and tribunals is substantially the same.' AIR 1965 SC 1595, p.1599.

Responsibility of one party to the other

In proceedings involving two parties, correspondence addressed to the Registrar must also be copied to the other party to the proceedings. The Registrar will send copies of the forms while commencing the action to the other party and any defense filed, but the registry will not, as a matter of course, copy any other document. In the case of a request for an extension of time, failure to send copy to the other side, has the consequence that the request may not be considered especially when objected to by the other side. It is important therefore for parties to proceedings to clearly indicate that a letter or form addressed to the Registrar has been copied to the other side. Proof of such sending may be relevant where it is contested.

Correction of error or amendment:

Sub-section (7) of section 21 empowers the Registrar to permit, on request correction of any error in, or any amendment of, a notice of opposition or a counterstatement on such terms as he thinks just. The Registrar has powers to allow amendment of

the notice of the opposition, including introduction of new ground. It has been held that the power is wide and must be construed liberally. See *Aminchand vs. Sohanlal* 1977 2 IPLR 160(DEL).

Where the goods /services are shown by mistake in a wrong class it may be allowed to be amended . Where the goods /services and the class number are consistent with each other , amendment of the class will not be allowed. *Altecnic Ltd Appln.* 2001 RPC, 227.

It is the practice of the Registry to require party to file an interlocutory application when any amendment of notice of opposition or counterstatement is sought. In all such cases, the petition will be disposed of only after affording an opportunity of a hearing to the parties to the proceedings, except where there is a written consent to allow the interlocutory application by the other party without a hearing.

As it is a discretionary matter the Registrar may seek or may be given an undertaking that no further evidence is to be filed

Where amendment is allowed, the Registrar will give further directions as to amendment of the counterstatement and any further evidence if it has been occasioned by amendment of the pleadings.

Correction of errors:

A party wishing to correct a genuine error in their forms or pleadings should apply to the Registrar for correction. Comments from the other side will be invited and the Registrar will then determine the matter

Compromise between the parties :

Section 11(4) of the Act expressly enacts that “nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under section 12”

When there is compromise between the opponent and the applicant, the Registrar may pass orders on the basis of the agreement between the parties and allow registration of the trade mark, either absolutely or subject to conditions or limitations as may be considered necessary. See Jacques Jaunet S.A vs. New Man, 2004(29) PTC 594(IPAB).

Consolidation of case:

Instances of where consolidation may occur are:

- Cross-opposition, where the applicant in one case is the opponent in another and the marks are similar
- Cross opposition/rectification, where the proprietor of one mark opposes a mark he believes to be too close to his own mark and the applicant has applied to rectify or cancel registration in response.

In ordering consolidation, the Registrar will take into account the following:

- are the parties the same?
- are the cases susceptible to having the same evidence filed: in other words, are the legal bases on which they are founded the same?
- at what stage are the proceedings? Ideally they should be at the same stage or close in order to avoid suspension of one set of proceedings to enable the other to catch up.
- Will the issue of a single decision covering all proceedings cause complications in the event of an appeal?

Even if consolidation is not considered appropriate by the Registrar, it would be appropriate that the cases are heard on the same day, one following the other, and by the same Heading Officer.

Stay of proceedings before Registrar:

As a Tribunal under the Trade Marks Act , 1999, the Registrar has inherent powers to stay the proceedings before him wherever necessary, particularly in cases where court proceedings are pending concerning the same matters and issues. See Christine Holden v. Johnson, (1981) PTC 201 (TMR).

The Registrar has a discretion to stay proceedings. Application for this purpose has to be made by the party desiring stay and comments will be invited from the other side if they have not already indicated their opposition or consent. A decision to stay will not automatically follow if there is consent as all relevant circumstances, including any public interest, will have to be considered.

There are a number of factors to consider before the Registrar grants a stay including the balance of convenience. If, for example, a higher authority such as the Court, has before it questions which substantially overlap those before the Registrar it is likely that a stay in the Registrar's proceedings will follow. This is because final determination is closer if the Court is involved. Whilst resolution of the case before the Registrar may be less expensive or quicker than the court, one should also consider potential costs of successive appeal from a decision of the Registrar.

A stay is a matter of discretion and the Registrar may impose conditions in connection with granting a stay and may require the parties to keep Registrar informed of the progress of related proceedings.

Power of review of decision by Registrar :

Section 127 (c) empowers the Registrar on an application made in prescribed manner, to review his own decision. Rule 115 provides that an application to the Registrar for the review of his decision shall be made on form TM-57 within one month from the date of such decision or within such further period not exceeding one month thereafter as the Registrar may, on request allow. The review application is to be accompanied by a statement setting out the grounds on which the review is sought. If the decision sought to be reviewed concerns any other person, the review application and the statement should be filed in triplicate. The Registrar will transmit a copy of the application and statement to the other person concerned. The Registrar will dispose of the review application after giving the parties an opportunity of hearing.

It is a well established practice before the Registrar to follow the provisions in section 145 of the Civil Procedure Code, read with

rule 1 under Order 47, which limits the review to the following classes:

- a) where there is discovery of new and important matter or evidence;
- b) where there is a mistake or error apparent on the face of the record; and
- c) for any other sufficient reason.

While the circumstance in (a) above would obviously justify a review, 'an error apparent on the face of record' must be such an error which must strike one on merely looking at the record and would not require any long drawn process of reasoning on points where there may be conceivably two opinions. See *Meera Bhanja vs. Smt. Nirmala Kumari Chaudhary*, AIR 1995 SC 455: (1995) 1 SCC 170: (1995) 1 Mah LJ 825.

The words "any other sufficient reason" have been interpreted as "reason sufficient on grounds atleast analogous to those specified immediately previously" i.e. excusable failure to bring to the notice of the court new and important matters or error apparent on the face of the record. See *Maranmar vs. Mar Paulose*, AIR 1954 SC 526.

Who can consider a review application?

An application for review of decision issued by the Registrar is generally considered by the same officer who issued the detailed decision. This is subject to the specific provision contained in section 4 which has been newly introduced in the present Act empowering the Registrar to transfer a case to another hearing officer.

An "order as to costs" which is a procedural order and is not a speaking order or a judgment or a decision is not based on any hearing. More often such orders are of self executory nature to give effect to the provisions of section 21(2) (where an applicant is deemed to have abandoned his application for failure to file counterstatement within the statutory period) or rule 50(2) which provides that an opponent shall be deemed to have abandoned his opposition if he takes no action under sub-rule (1) of rule 50 within the time mentioned therein. In these cases, the scope of scrutiny of the basis of the order is very

limited, whether such an order has been issued by mistake without considering an application for extension of time under rule 50(1) already pending at the Registry. In those cases it is not necessary that the same officer who signed the order for costs should alone consider the review application. See *Hind Azad Factory v. Azad Factory* (1986) IPLR 133. Under section 21(2) where the prescribed period is non-extendable, the limited question to consider is whether the particular order was correctly made.

Role of H.O. after hearing:

Having given his decision the Hearing Officer becomes 'functus officio' (Latin- function discharged), that is , he or she can no longer take any role in the matter adjudicated upon. Queries or explanation in relation to the decision reached cannot be entertained, and must be pursued through appeal proceedings. Likewise, it is not possible to pursue substantive issues through channels such as office complaints procedures, although a complaint about handling may be considered.

Corrections of errors in judgment/order:

In the matter of correction of any clerical error or mistakes in the judgments or orders, the Registrar follows the principles contained in section 152 of the Civil Procedure Code, which provides as follows:

“Clerical or arithmetical mistakes in judgments, decrees or orders or errors arising therein from any accidental slip or omission may, at any time, be corrected by the court either of its own motion or on the application of any of the parties” .

Docketing:

The file of an opposition case should have at the beginning an Information Sheet containing the relevant information, viz.

1. Journal No. of date on which the trade mark was advertised, and the date when the Journal was made available to the public (for counting the three months period for filing opposition)
2. Date on which TM-44 filed for grant of extension of time to file notice of opposition

3. Date of filing of notice of opposition
4. P.A. filed and properly stamped/not filed/taken on record
5. Date on which copy of notice of opposition served on applicant
6. Notice of opposition (TM-5) filed beyond time, show cause notice may be issued
7. Any other remarks
8. Counterstatement (TM-6) filed in time
9. P.A. filed on behalf of applicant
10. TM-6 filed beyond time. Show cause notice may be issued.

CHAPTER IV

MANUAL OF PROCEDURE CONCERNING POST REGISTRATION PROCEEDINGS

1. The Register of Trade Marks maintained under section 6 read with rule 59(2) of the Trade Marks Act contain the following particulars:

- All registered trade marks with the names , addresses and description of the proprietors ;
- Notifications of assignment and transmissions ;
- Names, addresses and description of the registered users;
- Conditions, limitations in respect of registered trade marks
- 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;
- 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;
- 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;
- 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;

- particulars affecting the scope of the registration or the rights conferred by the registration;
- the convention application date(if any), to be accorded pursuant to an application from applicants of a convention country made under section 154;
- where the mark is a collective or certification mark, that fact;
- where the mark is registered pursuant to sub-section (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.

Currently the register is maintained in electronic media. Part A and Part B of the register which existed at the commencement of the Act has been incorporated in to form part of the register maintained under the new Act. The register is a statutory document and amendment of any matters entered therein is to be carried out only by the processing of a valid request in the prescribed manner or by the Registrar on his own motion in accordance with the Act and Rules.

2. Post Registration Proceedings

After a trade mark is registered, generally the following proceedings arise:

- renewal of registration
- removal of trade mark for non-renewal and restoration of registration of removed mark
- registration of registered user
- assignment of trade mark
- rectification of register under section 47 by removing the mark for non-use or under section 57 or 58 for rectification of/ correction of register
- Alteration of registered trade mark under section 59
- Issue of certified copies of entries in the register for use in legal proceedings or for obtaining registration abroad

3. Renewals :

The period of registration which was 7 years until recently under 1958 Act, has been increased to 10 years under the present Act. The 10 year period of registration is reckoned from the date of making of the application[section 23(1)], which is deemed to be the date of registration.

3.1 The Registrar issues renewal reminder notice on form O-3 before the expiration of registration of the mark duly indicating the date of expiration and the condition as to payment of renewal fees - section 25(3). Under rule 64, the notice is sent to the Registered Proprietor or in the case of jointly owned mark to each such proprietors and each registered user at the address specified. The notice is issued not more than one month and not less than two months before the expiration of last registration being a statutory requirement. Non-receipt of O-3 notice when established is considered adequate reason for renewal with late fee.

3.2 Registrations may be renewed by payment of prescribed renewal fees in all cases(trade mark/collective marks/certification marks) on form TM-12. The application is filed by the proprietor of the registered trade mark or his agent. If there is any change in the proprietorship of the mark, and it has not been brought on record, proof of title shall be filed in the first instance. See Rule 63(3). Under rule 8, the document and fees may be sent or paid either at the appropriate office or the Head Office of the Trade Marks Registry, in matters of renewals.

3.3 Late registration:

Where an application takes more than 10 years to get registered, namely after the first renewal date, the Registrar allows the payment of standard renewal fees on form TM-12 within a period of 3 months from the date of actual registration. If the mark is not renewed by payment of renewal fee, the provisions of section 25(3) will operate, and the mark becomes liable for removal..

3.4 Grace period:

Proviso to sub-section (3) of section 25 enables the registered proprietor to get the registration renewed for a period of 10 years, on an application made in the prescribed form (TM-10) and

payment of prescribed fee and surcharge within six months from the expiration of last registration. Accordingly the Registrar will not remove the trade mark from the register for a period of six months after the expiration of the last registration.

3.5 Removal of trade mark for non-renewal and its effect:

In all cases the Registrar will delay the actual removal of the mark from the register for non-payment of renewal fee for at least six months from the date of expiry of last registration. [see proviso to section 25(3)]. If still no renewal fee is paid along with the prescribed surcharge within six months, after the expiry of registration, the mark becomes liable to be removed from the register.

Once a trade mark is removed, it is not possible to take any action, such as recordal of assignment, registration of registered user etc on a mark which has already expired. The fact of removal of the mark will be notified in the Trade Marks Journal.

Though the trade mark is removed, under section 26, it shall be deemed to be a trade mark on the register during one year, for the purpose of any application for registration of another trade mark on ground of conflict.

3.6 Restoration of registration of removed mark:

Section 25(4) provides for restoration of removed trade mark to the register and its renewal up to one year after the expiration of the last registration. In such cases, the request has to be made on form TM-13 along with prescribed fees plus the applicable renewal fees. In these cases, the discretion is vested with the Registrar, in that he must be satisfied that it is just so to do before restoring the mark and renewing the registration. He may allow restoration either generally or subject to such conditions or limitation as he thinks fit to impose. For example as a condition of renewal, Registrar may say that no proceedings for infringement be brought in respect of events prior to the date of renewal after the expiration of last registration. (1995 RPC 423) The restoration of trade mark will be published in the Trade Marks Journal.

4. Registration of registered user:

4.1 Trade Marks Act, 1999 has simplified the law governing licensing of trade marks.(vide sections 48 to 55) As is mentioned in the notes on clauses in the Amendment Bill “Licensing of trade mark is an important industrial property right” and as such “the procedure for registration be made simple to encourage such registration”.

4.2 Section 48 provides that a person other than the registered proprietor may be registered as registered user thereof in respect of any or all other goods or services in respect of which the trade mark is registered. By registering licensees, the proprietor of the trade mark gives public notice as to who are permitted to use his mark . The licenses can be either exclusive or non-exclusive.

4.3 An exclusive license is the license granted by the registered proprietor to the exclusion of all others including himself. A non-exclusive license is the license granted by the registered proprietor to more than one licensee permitting them to use the same mark. Apart from the names, addresses and description of registered users, particulars regarding whether the license is exclusive , whether the license is for the limited period and if so, the duration of the license, are entered in the Register.

“Permitted use” is deemed to be use by the proprietor .

4.4 Section 48(2) enacts that “the permitted use of a trade mark shall be deemed to be use by the proprietor thereof , and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 47 or for any other purpose for which such use is material under this Act or any other law”

Procedure for registration:

4.5 An Application for registration of registered user will be filed by the registered proprietor and proposed user jointly on form TM-28 along with the prescribed fees together with the following documents.

1. Agreement in writing between the registered proprietor and proposed user or duly authenticated copy thereof with respect to the permitted use of the trade mark. It is to be noted that in terms of sub-rule (4) of Rule 80 no application

will be entertained unless the same has been filed within 6 months from the date of agreement.

2. Document and correspondence, if any mentioned in the agreement or authenticated copies thereof
3. An affidavit of the registered proprietor or by some person authorized, 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 degree of control to be exercised by the proprietor over the permitted use; the duration of the permitted use, etc]
 - b. the precise relationship between the registered proprietor and proposed user, if any, for instance whether the relationship is as principal and subsidiary company or whether there is common control between their business;
 - c. a statement as to the goods or services in which the registered proprietor is dealing, together with details as to whether the trade mark which is the subject of the application has been used by him in the course of trade before the date of the application and if so the amount and duration of such user.
4. Such further or other documents and evidence/information, as the Registrar may call for.

Legal position of licensee:

4.6 Subject to the provisions of the license agreement between the parties, the owner has the right to terminate the license agreement. The only course open to the licensee if he is so aggrieved to file a suit for damages. See *Pepsi Foods vs. Jal Drinks Pvt. Ltd* 1996 PTC, 181 Delhi. The goodwill of business by the use of the licensed trade mark goes only to the licensor. As pointed out by Wadlow in *Law of Passing Off* (Second Edition (1995) at Para 2.62 – “If a valid license of a name or mark is in operation then the goodwill in

respect of the business so carried on accrues to the licensor rather than the licensee.... The licensee acquires no interest in the name or mark, and must cease using it on termination of the license.... Provided the license is valid, it does not matter that the licensee may be held out as the provider of the goods in question and may in fact be primarily responsible for their character or quality”.

Registration as registered user:

4.7 Once the joint application made by the proprietor and the proposed user complies with all the requirements under the Act and the Rules, the Registrar will register the proposed registered user in respect of the goods or services as to which he is so satisfied. The Registrar will then issue a notice in the prescribed manner of the fact of registration to other registered users, if any – See sub-section (3) of section 49.

4.8 The date on which the application was made will be deemed to be the date of registration as registered user. In addition to the particulars and statements mentioned in paragraph (i) to (iv) of sub-clause (b) of clause (1) of section 49, the entry will contain the name, description and principal place of business in India of the registered user and if he does not carry on business in India, his address for service in India will be entered.

Confidentiality of information:

4.9 If so requested by the applicant, the Registrar will take necessary steps to secure that the information provided in connection with the registration of registered user is kept confidential. Accordingly except matters which are entered on the register, the Registrar will not make available other matters to any other person. – See sub-section (4) of section 49.

Variation of entry in the register

4.10 Section 50 enables the registered proprietor to make an application on form TM-29 for variation of the registration of the registered user under section 50. Such application must be accompanied by a statement in triplicate of the grounds on which it is made and where the registered user thereof consents

, by the written consent of the registered user. The variation envisaged is in respect of any entry made in the register relating to registered user which include-

- (a) particulars and statements mentioned in paragraph (1) to (iv) of sub-clause (b) of sub-section (1) of section 49.
- (b) The name, description and principal place of business in India of the registered user and if he does not carry on business in India, his address for service in India
- (c) Any conditions or restrictions relating to the registration of user, such as duration of registration as registered user.

Cancellation of registration as registered user:

4.11 Proceedings for cancellation of registration of the registered user may be initiated as follows:

1. On form TM-30 by the registered proprietor of the mark or by any other registered users
2. On form TM-31 by any person for cancellation of registration on any of the grounds mentioned in section 50(1)(c) (d) read with rule 88(1).
3. Section 50(1)(d) empowers the Registrar to cancel the registration of a registered user of his own motion or on an application of any person on the ground that any stipulation in the agreement regarding the quality of goods/services is either not being enforced or not being complied with.

4.12 Where registration of the registered user is for a particular period, the Registrar shall cancel the entry at the end of the period.

4.13 Where some or all the goods or services are omitted from those in respect of which a trade mark is registered, the Registrar shall at the same time omit them from those specifications of registered users of the trade mark in which they are comprised.

4.14 The Registrar shall notify every cancellation or omission to the registered users whose permitted use is affected thereby and to the registered proprietor of the trade mark.

4.15 It is open to any third party to apply for cancellation of registration on any one or more of the following grounds:

1. that the registered user has used the trade mark otherwise than in accordance with the agreement under clause(a) of sub-section (1) of section 49 or in such a way as to cause or to be likely to cause, deception or confusion;
2. that the proprietor or the 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;
3. that the circumstances have changed since the date of registration in such a way that at the date of such application for cancellation it would not have justified registration of the registered user;
4. 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.
5. 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.
6. In respect of any goods or services in relation to which the mark is no longer registered.

Under section 50(2), the Registrar will issue notice to the registered proprietor and each registered user of the trade mark and before cancellation of registration will afford an opportunity of being heard to the registered proprietor. See Rule 90 which prescribes the procedure to vary or cancel the registration.

4.16 Power of Registrar to call for information in respect of registered users:

With the simplification of procedure for registration of registered user, the Registrar is empowered under section 51 to require the proprietor to confirm at any time whether the agreement on the basis of which the registered user was registered is still in force. If such confirmation is not received within the stipulated time, the registration of registered user shall cease. The Registrar will notify such fact to the parties concerned.

4.17 Rights of registered user:

- a) Subject to the conditions and limitations entered on the register and the registered user agreement. The registered user has the right to use the registered mark in relation to goods or services for which the trade mark remains registered.
- b) If the registered user enters into a partnership with any other person for carrying on the business concerned, the firm may use the trade mark so long as the registered user continues to be a partner of the firm.
- c) If the registered user is a partnership firm and undergoes change in its constitution, the reconstituted firm may use the trade mark only so long as any partner of the original firm at the time of its registration as registered user, continues to be a partner of the reconstituted firm(section 54)
- d) Subject to any agreement between the parties, section 52 recognizes the right of the registered user to take proceedings against infringement. On the other hand section 53 explicitly enacts that an unregistered licensee shall have no right to institute such proceedings

In terms of section 48 the use of the trade mark by the registered user is deemed in law to be use by the proprietor. As such the registered user cannot at any time claim any right or share in the goodwill of the business associated with the trade mark. Since the registered user is merely a licensed user of

the trade mark under a written agreement, he has no assignable or transmissible right in respect of the trade mark.

5. Assignment:

5.1 As distinguished from licensing of a trade mark where the proprietor merely permits the licensee to use the mark for a specified period in relation to certain goods or services, assignment of trade mark involves transfer of ownership of the trade mark to another person or entity.

5.2 The provisions concerning assignment and transmission of trade mark are contained in section 37 to 45 read with rule 68 to 79.

5.3 The following gives a brief summary of the provisions of the law in this respect.

1. The right of the registered proprietor to assign a trade mark for any consideration is recognized – section 37
2. A registered trade mark is assignable or transmissible with or without the goodwill in respect of all goods /services or some only of such goods/services for which the mark is registered- Section 38.
3. An important change introduced by the new law is that it enables an unregistered trade mark to be assigned or transmitted with or without the goodwill of the business- Section 39. This change brings the law in line with the requirement in Article 21 of the TRIPS agreement.
4. The law provides restrictions on assignment or transmission where multiple exclusive rights would be created in more than one person and also to prevent splitting of right on territorial basis and creating right in different persons in different parts of India. However the Registrar is empowered to approve assignment where he is satisfied that it would not be contrary to the public interest- Section 41.
5. Where there is an assignment without goodwill of business, it will not take effect unless the assignor obtains

directions of the Registrar and advertises the assignment as per directions - Section 42.

6. Assignment of certification trade mark can only be done with the consent of the Registrar -Section 43.
7. Associated trade mark will have to assigned together - Section 44.
8. Section 45 provides for registration of assignment and transmission. If the validity of assignment is in dispute, Registrar may refuse to register unless the right of the parties are determined by a competent court. 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- Rule 73.

Assign ability with or without goodwill of business:

5.4 Section 38 of the Act permits assign ability and transmissibility of a registered trade mark, whether with or without the goodwill of business. Section 39 now explicitly permits unregistered trade mark also to be assigned with or without goodwill of business concerned.

Effect of assignment with goodwill:

5.5 The word “goodwill” is to be understood “to include whatever adds to the value to a business by reason of situation, name and reputation, connection, introduction to old customers, and agreed absence from competition, or any of these things, and there may be others. In this wide sense, goodwill is inseparable from the business to which it adds value and, in my opinion, exist where the business is carried on. Where such business is carried on in one place or country or in several and if in several, there may be several businesses each having a goodwill of its own”. See Commissioner of Inland Revenue vs. Mullar & Co. (1901) ASC 217, page 235.

5.6 The transfer of goodwill confers on the transferee the exclusive right to carry on the business transferred, the

exclusive right to represent himself as carrying on such business and as against the transferor the exclusive right to use the name under which the business has been carried on, but such name must not be used so as to expose the transferor to a risk of personal liability owing to his being held out as the owner of or a partner in the business. See Reuter vs. Mulhens (1953)70 RPC 103, page 121.

Effect of assignment on existing licensee :

5.7 In BDA Ltd, vs. State of Uttar Pradesh (1996 IPLR 93), it is held that after assignment of the trade mark, the license agreement stands automatically terminated. This decision was followed in Wonderworld Electrodes (P) Ltd vs. Ahura Welding Electrodes Manufacturing Co. Ltd, (2003) 26 PTC 37 where the court observed that “it is settled law that once there is a transfer of property, the license granted by the owner/transferor for use of the property stands automatically terminated. The said principle is not only applicable to immovable property right, but also apply in respect of movable property as well.

Assignment without goodwill of the business:

5.8 Section 42 stipulates conditions for assignment of a trade mark without goodwill of business,. The law prescribes the following procedure in such cases.

An application is required to be made on form TM-20, stating the date on which the assignment is made and giving particulars of registration in case of registered trade mark.

The Registrar may call for any evidence further information and on being satisfied with regard to assignment he will issue directions in writing with respect to advertisement of the assignment. The object of advertisement is merely to give notice to the public about the transfer of ownership of the mark, without the transfer of the business itself. The law is based on common law principle that the goodwill of business was indivisible in which the mark was used and therefore an assignment of trade mark without the goodwill of the business and stock in trade was bad. The modern view is different. The Trade Marks Act, 1994 in the UK abolished such

requirement as being of little practical effect as a safeguard to the public. The British Govt. also found that the requirement was a “burden to the trade mark owners and the Registry”. It is proposed to amend present section 42 of the Trade marks Act, 1999 with the modern trend.

An application for assignment under section 42 without goodwill of business is to be made within six months from the date on which the assignment is made, with possible extension of the period by request, made on form TM-21. (See rule 74)

After advertisement of the assignment an application to register, the title of the transferee or the assignee is to be made on form TM-24 or TM-23.

Restrictions on assignment where multiple exclusive right would be created. :

5.9 Section 40 makes provisions containing restriction on assignment or transmission where multiple exclusive rights would be created in more than one person, which would be likely to deceive or cause confusion. Nevertheless such assignment is not deemed to be invalid when accompanied by suitable safeguard, with conditions and limitations, so that such exclusive rights are not exercisable by two or more persons within India, otherwise than for export or in relation to goods to be exported to the same market outside India.

In accordance with the prescribed procedure, an application will be made on form TM-17 along with a statement of case with a draft copy of the proposed deed of assignment. The Registrar may call for any additional information or require the case to be verified. The Registrar may also hear the applicant and any other person who may be interested in the assignment. Thereafter the Registrar may issue the certificate as to whether the proposed assignment would or would not be invalid under sub-section(1) of section 40.

5.10 Restrictions / assignment when exclusive rights would be created in different parts of India:

Section 41 lays down restrictions on assignment or transmission so as to prevent splitting of rights of a trade mark on a territorial basis and creating rights on different persons in different parts of India . However, the Registrar has been empowered to approve such assignment, if he is satisfied that it would not be contrary to public interest.

Registrar's prior approval of proposed assignment:

5.11 An application on form TM-19 may be made together with a statement of case setting out the circumstances and a copy of any instrument or proposed instrument effecting the assignment or transmission under proviso to section 41. After hearing the applicant and any other person whom the Registrar may consider to be interested in the transfer, he may issue a written approval or disapproval of the proposed assignment.

Where an approval has been given, application for registration of the title is to be made within six months from the date of approval.

Consideration of the case:

Whether the proposed assignment or transmission would not be contrary to public interest is to be considered from a practical point of view, having regard to the nature of goods and the business. For this purpose, the law empowers the Registrar to approve cases where he is satisfied that the use of the mark would not be contrary to public interest. In this regard, the Registrar adopts a discriminatory approach between business extending throughout the country and local trade without altogether prohibiting the assignment of trade mark resulting in concurrent right being vested in different persons and in different places in India. Such approach is considered to be justified where the trade in relation to which the mark is used is local in character e.g. vegetables, ice cream, bread or similar perishable articles.

Recordal of assignment:

The procedure for recordal of assignment and transmission is contained in section 45 read with rule 68.

An application to register the title of a person who becomes entitled by assignment or transmission to a registered trade mark is to be made on form TM-24 or TM-23 together with prescribed fees depending upon whether the application is made by such person alone or jointly with the registered proprietor.

The application should contain full particulars of the instrument under which the person claims to be entitled to the trade mark together with the certified copy thereof. On proof of title, the Registrar will register him as the subsequent proprietor of the trade mark and cause the particulars to be entered on the register.

After the mark is assigned, the assignor ceases to have any interest or right in the trade mark and the assignee alone comes to possess the exclusive right.

When assignment or transmission is in dispute under proviso to section 45 the Registrar may refuse to register until rights of parties are determined by a competent court.

It is well settled that in the case of a partnership , changes made in the register of trade mark at the instance of some of the partners without any notice to the other partners, is invalid. Accordingly, it is essential that due notice must be given about a request for change in proprietorship of the mark. See Radhakishan Khandelwal vs. Registrar of Trade Marks AIR 1969 DEL 324 where it was held that “there is in the eye of law a necessary implication that the party adversely affected should be heard before an order for removal of his name can be made”.

6. Removal of registered trade mark for non-use:

6.1 A trade mark which is not used within five years of its registration becomes liable for removal either completely or in respect of those goods or services for which the mark has not been used. The object of this provision in section 47 is that a person cannot be permitted to register a trade mark when he has not used it in relation to the goods or services in respect of which it is sought to be registered or does not intend to use it in relation to those goods or services, as the registration

confers valuable rights upon the registered proprietor. This is borne out of section 18 of the Act which enables a trade mark to be registered by “any person claiming to be the proprietor of the trade mark used or proposed to be used by him”. The only two exceptions which are contained in section 46 providing for application for registration to be made by a person who does not use or propose to use the mark are -

a) A company which is about to be formed and registered under the Companies Act and the applicant intends to assign the trade mark to that 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.

An application for removal of registered mark under section 47 may be made to the Registrar or to the Appellate Board .

6.2 The procedure before the Registrar in such cases is prescribed in rule 92. Application will be made on form TM-26 together with prescribed fees and accompanied by a statement in triplicate setting out fully the nature of applicant’s interest (viz. demonstrating as to how the applicant claims to be an “aggrieved person”), the facts upon which he bases his case and the relief which he seeks. Where there are registered users, such application and statements shall be accompanied by as many copies thereof as there are registered users.

6.3 Under rule 92, a copy of each of the application and statement of case will be transmitted by the Registrar to the Registered Proprietor and to the registered users and any other person who appears from the register to have an interest in the trade mark.

6.4 Thereafter within two months from the date of receipt by the registered proprietor of the copy of the application, the Registered proprietor will send his counterstatement on form TM-6 in triplicate setting out the grounds on which the application is contested. The Registrar will serve the copy of the counterstatement on the applicant. Thereafter, the provisions of rule 50 to 57 will apply mutatis mutandis to the

further proceedings on the application. Rule 93 clearly lays down that the Registrar will not however remove the mark merely because the registered proprietor has not filed the counterstatement, unless he is satisfied that the delay in filing the counterstatement is willful and is not justified by the circumstance of the case.

7. Grounds for removal

7.1 Section 47 provides two alternative grounds for removal of mark on ground of non-use. The application for this purpose may be made only by a “person aggrieved” 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 up to a date three months before the date of application, or

b) A continuous period of five years from the actual date of registration or longer has elapsed during which there was no bonafide use thereof upto three months before the date of application.

7.2 As regards the “bonafide intention to use” the fundamental legal proposition is, as was held in *Batt & Co’s TM (1899) 16 RPC 411 page 413*,

“If a man procures a trade mark to be registered for goods in which he does not deal either when he applies for registration or within a reasonable time afterwards, he does so at his peril and he exposes himself to the risk of having his mark expunged or having his registration restricted to his legitimate requirement.”

7.3 In regard to the allegation that there has been no bonafide use of the trade mark in relation to the registered goods/services the onus is on the applicant to establish the same. In the *Gerber TM (2003) RPC 34* it was held that –

“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” .

Court of appeal found that “test marketing” was bonafide use.

7.4 Once a prima facie case is shown by the applicant, the onus shifts to the registered proprietor to repel the allegation. The obligation to demonstrate use is not applicable immediately after registration of the trade mark, instead the registered proprietor has five years following the completion of registration procedure to put the trade mark into use on the goods and /or services for which the trade mark was registered.

7.5 Commencement of period of non-user:

The law has been amended to explicitly provide that 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 date is to be contrasted with the date of registration mentioned in section 23 which relates back to the date of making the application and that date is deemed to be the date of registration. In order to remove ambiguity it is clearly now provided under section 47(1) that the five year period will begin from the date on which the trade mark is actually entered in the register.

It is enacted in section 47(1)(a) and (b), any use of the impugned trade mark just three months before the filing of an application for removal of mark will be disregarded. This is to prevent the owner of the unused mark to frustrate an application for removal of mark by starting use of the mark on sensing that an application for removal is about to be filed and consequently defeat the law in this respect.

7.6 Intervention by third party:

Any person other than the registered proprietor alleging interest in the registered mark may apply on form TM-27 for leave to intervene explaining the nature of his interest in the case. The Registrar may either grant leave or refuse after a hearing if so required.

7.7 Partial rectification:

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. See *Minerva TM (2000) FSR 734*.

7.8 Special circumstances:

Section 47(3) protects the registered trade mark from being removed on ground of non-use, if such non-use is shown to have been “due to special circumstances in the trade”, which include restriction 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 such goods or services.

The onus is on the registered proprietor to establish “special circumstances” for non-user to save the mark from removal

8. Rectification of register:

8.1 As distinct from removal of trade mark for non-use under section 47 as above, rectification of register may arise out of the following procedures under the Act:

- i) Under section 57 a “person aggrieved” may make an application for canceling or varying the registration of a trade mark on the ground of any contravention or failure to observe the conditions entered on the register or by absence or omission from the register any entry or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register. The Tribunal may make such order for making, expunging or varying the entry as it may think fit.

- ii) The Tribunal (the Registrar or the Appellate Board) of its own motion after giving a notice to the parties concerned and giving them an opportunity of hearing, make any order as above. – Section 57(4)
- iii) On application made in the prescribed manner by the registered proprietor, the Registrar may correct any error in the name, address or description 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 in 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.
- iv) Alteration of the registered trade mark – section 59.
- v) Change of classification of goods to align with any revised classification – section 60

8.2 Application for rectification

An application for rectification under section 57 may be made either to the Registrar or the Appellate Board. The procedure before the Registrar is prescribed in rules 92 to 101 of the Trade Marks Rules, 2002. An application under section 57 is to be made in triplicate on form TM-26 or TM-43(in the case of collective mark or certification mark) The application is to be accompanied by a statement of case , in triplicate, setting out the nature of applicant’s interest, facts upon which the case is based and the relief sought for. To enable the Registrar to serve copies of application, the applicant is required to submit as many copies of the application and statement of case as there are registered users.

The provisions of rules 50 to 57 will apply *mutatis mutandis* to further proceedings of the application as regards filing of counterstatement and evidence.

8.3 “Person aggrieved”:

Though the term “person aggrieved” is not defined in the Act or Rules, it has been liberally construed in several cases. In Powell’s trade mark, 10 RPC 195 CA , it was held that

“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 damaged if the mark remained”. “The object of rectification is purifying the register , which is a public purpose. Hence, applicant’s *locus standi* is determined on principles akin to those in public interest litigation”. Toshiba Corporation vs. Toshiba Appliances (1994) PTC 53 page 61.

8.4 Grounds for rectification:

Sections 57(1) and 57(2) refer to the following grounds for rectification:

- a) any contravention, or failure to observe a condition entered on the register in relation thereto (section 57(1))**
- b) absence or omission from the register of any entry (section 57(2))**
- c) any entry made in the register without sufficient cause (section 57(2))**
- d) any entry wrongly remaining on the register (section 57(2))**
- e) any error or defect in any entry in the register (section 57(2)).**

Under section 31(1) in all legal proceedings relating to a trade mark (including application under section 57), the original registration of the trade mark shall be prima facie evidence of the validity thereof.

Therefore, if the grounds contemplated in section 57 for rectification are not shown, the application is liable to be rejected . See Kamaladevi vs. Palani Mudaliar and Co. 2004 (29) PTC 589 IPAB.

8.5 The ground “contravention on failure to observe a condition”, is attracted only if there is non-compliance or violation of any conditions and 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).

8.6 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 and when such registration operates in restraint of any third party’s rights. When registration of a trade mark is made in contravention of any of the provisions of the Act and Rules , the entry could be challenged as one “made without sufficient cause” . For instance the registration of trade mark by an agent or representative , without the authority of the proprietor in his own name is contrary to section 146. Such case would attract objection under section 57(2) and accordingly the entry will be considered as “made without sufficient cause” and as such wrongly remaining on the register.

8.7 Relevant date:

In the context of an allegation that “entry was made in the register without sufficient cause”, the relevant date is the date of registration , which relates back to the date of application under section 23. In its widest sense, if the registration is found to have been made in contravention of any of the provisions of the Act or the Rules, the registration may be challenged as “made without sufficient cause”.

On the other hand, the material date for considering the ground that the entry “is wrongly remaining on the register” is not date of registration but the date on which the application for rectification was made. The attack is not so much as to whether or not the original entry was rightly made , but against the entry wrongly remaining on the register by subsequent events, including the conduct of the registered proprietor . Accordingly the relevant date in such cases is the date of application for rectification –(1950) 68 RPC 168, page 171.

By way of 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.

Another ground of rectification is on account of “any error or defect in any entry in the register” . In these cases, the relevant date for consideration is the date of application for registration. If there is any major defect in the original entry it is difficult to rectify the entry by correction as the registration will be *ab-initio* improper and would require to be expunged. Obviously therefore, error of simple or minor nature in any entry in the register could only be rectified, e.g. correction of error in the name, address or description.

8.8 Nature of orders that may be passed:

In the trade mark administration purity of register of trade marks is significant. The court and the Registrar have always thus balanced the duty of protecting the public as well as conflicting rights of trade marks owners and maintaining the purity of the register in the sense that it should not have upon it marks which are not trade marks or capable of fulfilling the function of trade marks. see GE TM 1969 RPC 418 . Keeping in mind these broad principles, the Tribunal may pass suitable orders either for wholly expunging the entry, varying the entry or by making some suitable entry as it may think fit.

Scope of registration may be ordered to be limited . Obviously the Tribunal cannot make any order for enlarging the scope of registration as it would be a contravention of the Act and Rules to make any entry, which has the effect of enlarging the scope of registration without going through the procedure prescribed by law, namely, advertisement, and notice to public for opposition. See Riviere’s TM 1885 55 LJ CH.545. It is to be remembered that under section 23 the date of registration relates back to the date of making of the application and it is impermissible to enlarge the scope later.

8.9. Power of rectification by Tribunal “of its motion”:

Section 57(4) empowers the Tribunal , of its own motion to make any order for rectification of the Register mentioned in section 57(1) or (2).

As provided in rule 95, the Registrar shall send a notice in writing to the registered proprietor and to each registered user if any, stating the grounds on which the Registrar 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. 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 and the Registrar may act accordingly.

The Registrar’s decision shall be communicated in writing to all concerned.

The proceedings under section 57(4) are by their very nature distinct from the procedure contemplated under section 57(1) and 57(2). Therefore the proceeding under 57(4) should not be regarded or treated as an easy substitute for proceedings under section 57(1) or (2). Ordinarily therefore the Tribunal will not act except on an application by a “person aggrieved” made in the prescribed manner for rectification of register.

In the following types of cases, the Registrar, is justified in initiating proceedings on his own motion under section 57(4).

- **Where a mark is wrongly registered, during the pendency of an opposition proceedings.**
- **Where a mark prohibited from registration under the Emblems and Names (Prevention of Improper Use) Act, 1950, is found to have been registered contrary to section 9(2) of the Act, or where registration is made contrary to section 13 which prohibits the registration of international non-proprietary names , as trade marks .**

- Where the registration is found to have been made in contravention of any of the provisions of Act and Rules, or against the directions of the Central Government.

8.9 Correction of register:

The procedure under section 58 which contemplates correction of the register in respect of the following matters can be invoked only on an application made by the registered proprietor.

- a) any error in the name, address or description of the registered proprietor of a trade mark, or any other entry relating to the trade mark;
- b) any change in the name, address or description of the person who is registered as proprietor
- c) cancellation of the entry of a trade mark;
- d) striking out of any goods or classes of goods or services in respect of which the mark is registered.

Rules 96 and 97 prescribe the procedure in respect of such proceedings. Under clause (a), permissible correction is only correction of any clerical error in the name, address or description of the registered proprietor or any other entry relating to the trade mark. For this purpose a request on Form TM-16 is to be filed. No correction which has the result of affecting the rights conferred by registration is permissible. Also the inclusion of name of any new partner or substitution of the name of the proprietor by a different person is not covered by this provision.

Under Clause (b) will come the recordal of merely a change in the name, such as in the case of a Private Ltd. Company becoming a Ltd. Company. The prescribed form is TM-33. Form TM-34 is to be used in respect of request for alteration of address, or principal place of business or address of home country. The name could include the change and address or description of the person. Recordal of any change in ownership in the trade mark is not envisaged by this clause. It is altogether a different proceeding governed by section 45, read with rules 68 to 79.

Request for cancellation of entry of the trade mark may be made on form TM-35. If there is any registered user, a copy of the application is to be served on him and the fact confirmed in the application.

Clause (d) provides for striking out any goods or classes of goods or services in respect of which the mark is registered. For this purpose request on form TM-36 is to be filed. Such cases may arise where a registered mark covers a wide specification of goods/services and becomes the subject matter of proceedings under section 47 for non-use in respect of certain goods/services. The registered proprietor may take suitable action by filing TM-36 to strike out those goods or services in respect of which there is non-use.

Correction in respect of registered user:

Correction or amendment similar to those envisaged by section 58(1) in respect of registered trade mark is contemplated under sub-section (2) in respect of the registered users. Rule 91 prescribes the procedure for the purpose.

Alteration of registered trade mark:

The Trade Marks Act provides for alteration of registered trade mark under section 59, read with rule 98.

Where the registered proprietor applies under section 59 for leave to add to or alter his registered trade mark he shall make an application on form TM-38 and furnish five copies of the mark as it will appear as so altered. It is also required that a copy of the application and of the trade mark so amended or altered shall be served by the registered proprietor on every registered user, if any.

Section 59(1) expressly prohibits any addition or alteration in a manner substantially affecting the identity of the registered trade mark. Whether or not any proposed amendment substantially affects the identity of the registered trade mark will depend upon the nature of the amendment. There are no general rules in this behalf. However the well established

practice of the Registry will have to be continued to be followed thus –

- **If the proposed alteration is such as would need a fresh search the amendment should not be allowed.**
- **Introduction of any new element in the mark even of a descriptive character is not permissible . See 1955 (72) RPC 66**
- **The addition of a word , describing the device of an already registered trade mark is considered to affect the identity of the mark. Addition of the word “arrow” to the registered mark containing the device of arrow not allowed.- 1958 RPC 335.**
- **Addition of letter “e” to the registered trade mark “Otrivin” to read as “Otrivine” was not permitted-1967 RPC 613.**

Permissible alteration or amendments

When there is a change in the name of the registered proprietor or address in the label, leave is given for alteration of the mark. To make the change in the name of the address in the label is not considered to be an essential particular of the mark. 20 RPC 353.

Addition of the word “Limited” in the name of a company is permissible. However if the name of the company is represented in the form of a signature, alteration is not permitted.

Where the Registrar considers it expedient, he may cause the application to be advertised in the Journal before deciding the matter. Any person may give notice of opposition to the application for amendment on form TM-39 giving a statement of objections A copy of the notice and statement will be sent by the Registrar to the Registered. Proprietor and other interested persons. The Registered,. Proprietor will file his counterstatement contesting the opposition on form TM-6. Thereafter the provisions of rules 50 to 57 will apply to further proceedings on the opposition.

There will be no adverse consequence merely because the Regd. Proprietor has not filed or there is delay in filing of the counterstatement.

If there is no opposition within the time specified, the Registrar will allow or refuse the application if necessary after hearing the Regd. Proprietor. The altered mark will be advertised in the Trade Marks Journal.

Issue of certified copies:

Section 148 provides for inspection of register and following other documents and obtain certified copies thereof:

- **the register and any document upon which any entry in the register is based;**
- **every notice of opposition to the registration of a trade mark, application for rectification before the Registrar, counterstatement thereto, and any affidavit or document filed by the parties in any proceedings before the Registrar**
- **all regulations deposited under section 63 in connection with the registration of collective marks or section 74 governing the use of the certification marks and all applications under section 66 or section 77 for varying such regulations**
- **such other documents as the Central Government may, by notification in the official gazette, specify**

Certified copies:

Whatever documents which are open to public are also available for obtaining certified copies on a request filed on form TM-46 accompanied by the prescribed fees. For obtaining expeditious copies, request on Form TM-70 may be filed.

Section 137 enacts that copy of any entry in the register or of any documents certified by the Registrar with the seal of the Registry constitutes evidence and admissible as such in all courts and in any proceedings without production of the original.

Register in electronic media:

The TMR is maintaining the Register of Trade Marks in electronic media. In view of the important legal nature and value of certified copies of entries in the register it is obvious that the entries in the register are up to date and error free.