March 31, 2016

Shri O P Gupta, IAS
Controller General of Patents, Designs & Trade Marks
Boudhik Sampada Bhavan,
Antop Hill, S.M. Road, Mumbai-400037,
Email: cgoffice-mh@nic.in

Re: Recent erroneous abandonment of trademark applications although service of examination reports is not completed

Dear Shri Gupta,

We refer to the meeting held at Boudhik Sampada Bhawan, Mumbai on March 2, 2016 where INTA’s Annual Delegation had met with your representatives, namely Shri Tiwari, Shri Ojha and Shri Sharma.

As you are already aware, one of the topics of discussion during this meeting was Examiners’ Seminars, which INTA is desirous of conducting for the newly recruited examiners to minimize issues faced in the examination of applications. This proposal has received support from you, your officers, as well as DIPP.

During the same discussion, our delegation had also pointed out instances of random service of examination reports through different modes without completion of actual physical service as prescribed under the Act. Further, it was also pointed out that, although the online database of the Trade Marks Registry (TMR) mentions that the physical copy of the examination report has been dispatched, the same is not received by either the attorneys or trademark owners. At that time, your officers had assured the delegation that the TMR would give suitable opportunity to applicants before passing any adverse orders abandoning the applications. Reassuringly, your officers had expressed TMR’s readiness to reflect on feedback and suggestions related to any arbitrary actions affecting stakeholders.

It is pursuant to such reassurance that we are writing this letter to you.

We have been informed by several members, both practitioners and trademark owners, that recently the TMR has erroneously passed orders under Section 132 of the Trade Marks Act, 1999 (the Act) abandoning numerous trademark applications on the ground that a response to the examination report has not been filed. This, in spite of no physical service being effected on the applicant’s address for service and in multiple cases, in spite of the filing of a written response. Further, such abandonment is in contravention of Section 128 of the Act as no opportunity has been granted to the applicants to be heard. Alarmingly, this has affected a mammoth number of trademark applications across various branches of the TMR. Relevant extract of such orders has been set out in Annexure A to this letter.
In this regard, we would also like to highlight the decision of the Division Bench of the Bombay High Court dated March 1, 2013 in the matter of *The Institute of Cost Accountants of India v The Registrar of Trade Marks (Writ Petition No 2088 of 2012)*, which in effect sets out that a trademark application cannot be abandoned unless the examination report is specifically communicated to the applicant at the specified address for service (which is not the case in the present abandonments, as pointed out above). The said orders abandoning the applications are therefore clearly also not in line with this decision.

In view of the above explanation and to avoid unwarranted disarray that we anticipate intensifying in the coming days, INTA and its membership seek your urgent intervention in relation to this issue and request you to reverse these abandonment orders with immediate effect. INTA is also open to scheduling a meeting in your office with our Association’s deputed members at a time convenient to you in order to resolve this issue.

As you know, INTA is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. This letter is being written to protect the legitimate interests of trademark owners, which is ultimately in the spirit of the said objective.

We appreciate your consideration of this issue and hope for a positive resolution.

Please contact INTA’s India Representative, Gauri Kumar (gkumar.consultant@inta.org) if you have any question.

Sincerely yours,

Etienne Sanz de Acedo
CEO

Encl: As above
Annexure A

Content of the impugned orders

The abovementioned application was examined and the examination report mentioned therein the objection(s) to acceptance of the application for registration of the trademark was posted on the official website and was also sent on [●] to the applicant/applicant’s authorized agent. The response to the examination report was required to be submitted on behalf of the applicant within one month from the date of receipt of the examination report.

It was clearly mentioned in the examination report that if no reply is received or a request for a hearing is applied for within the above mentioned stipulated time, the said application shall be treated to have been abandoned for lack of prosecution under Section 132 of the Trade Marks Act, 1999 and thereafter the status of the application in the computer database shall reflect the factual position. However no response to the examination report has been received so far either mentioning the applicant’s comments on office objections or requesting for hearing.

The abovementioned application is therefore deemed to have been abandoned under Rule 38(5) of the Trade Marks Rules, 2002 and the status of the application is changed accordingly in the records of the Trade Marks Registry.