

SUGGESTIONS ON OPPOSITION PROCEEDINGS

at the

INDIAN TRADE MARKS REGISTRY

(October 2015)

The India IP Office Subcommittee of the Trademark Office Practices Committee of the International Trademark Association (INTA) greatly appreciates the opportunity to share with the Controller General of Patents, Designs and Trade Marks (CGPDTM) suggestions on improving opposition procedures at the Trade Marks Registry. INTA highly values its relationship with the Office and makes the following suggestions in the interest of increasing the efficiency of the procedures at the Indian Trade Marks Registry. We would welcome an ongoing dialogue with the CGPDTM on these suggestions.

General comments

- 1) There should be detailed scrutiny of trademark applications prior to their publication in the Trade Marks Journal. Similar marks must not be easily allowed to be advertised. This will help to reduce the number of oppositions filed by third parties. We recommend that guidelines be framed for examination of applications to cover goods/services in different but related classes. Further, such applications/marks that are identical to well-known marks should be refused.
- 2) The Trade Marks Registry should seek to efficiently implement suggestions in the Draft Manual of Trademarks Practice and Procedure for digitization and storage of documents and exhibits submitted in relation to an opposition proceeding in soft copy in form of CDs etc. Opponents and Applicants should be directed to provide all evidence in CD Rom and also serve them upon each other to avoid delays (specifically in cases where exhibits are voluminous).
- 3) The online records for Opposition matters should be completely digitized. Further, online filing should be encouraged by offering incentives such as discount on fees.
- 4) The Opposition documents should be separately filed in the online database and a naming convention agreed upon to label the documents so that they can be easily tracked.
- 5) There are two different time calculations for filing the opposition. If one files online, the system calculates the days (120 days) whereas the Act provides for four months. Thus, an Opponent gets extra days by doing a physical filing. This variance needs to be harmonised to mirror the intent of the statute, i.e., four months.

- 6) Authorization of Agent (AoA)-If an Opponent files the opposition online, he is required to upload the AoA at the time of filing. On the other hand, an Opponent can undertake to file it later in case of physical filing. Again, this needs to be harmonised.
- 7) The Trade Marks Registry should launch a special drive in cases where-
 - The Applicant has withdrawn the application and an express request has been filed to withdraw the said application.
 - The counterstatement has not been filed within the prescribed period.
 - No formal opposition has been filed and the parties have arrived at a settlement- There are many cases that are waiting to be concluded as the Trade Marks Registry has not changed the status of such matters that are settled at the pre-opposition stage.
 - The counterstatement has been served on the Opponent and there is no record of him having either filed evidence in support of opposition or relied on facts stated in the notice of opposition within the prescribed period.

Service

There is a huge backlog of opposition cases waiting to be served. Rule 47(7) stipulates a timeline of three months for the service of a notice of opposition and Rule 49(1) similarly stipulates a timeline of two months for the service of a counter statement, both of which are not being followed. To remedy the situation, INTA makes the following suggestions:

- 1) The Trade Marks Registry should link the fee module with the opposition deadline calculator so that a fee receipt is generated only if the opposition is filed within the four-month period. Further, it should be made mandatory for all Applicants to provide email addresses so that the system serves the notice of opposition automatically to the Applicant and updates the online platform for service. Essentially, the online platform should be made to scrutinize the opposition deadline and to serve the notice of opposition automatically.
- 2) For the counterstatement, again, the fee module should be linked to the deadline calculator so that no fee receipt is generated if the counterstatement is filed beyond the two-month deadline. In case the counterstatement is not filed or filed beyond the statutory period, an email order abandoning the application should be sent automatically and the system updated.

Hearing and Order of Examiner

- 1) There is also a considerable backlog of opposition cases where pleadings have been completed and hearings have not been appointed. The hearing notice is required to be served within three months from the completion of evidence. (Rule 56(1)). This is not being followed.
- 2) The Trade Marks Registry may require the parties to opposition proceedings to mandatorily file written submissions along with case law pursuant to or during opposition hearings. This will make it easier for the Trade Marks Registry to pass an order on the opposition proceedings.

- 3) The hearing officer should be required to pass an order on hearing within six weeks of completion of hearing. There are many cases that have been heard and awaiting formal orders.
- 4) There should be a limit to the number of adjournments of hearing in case of non-appearance of a party.

Miscellaneous Recommendations on Opposition

- 1) It is observed that certain opposition proceedings which have subsequently been settled among parties, are still reflecting as “Opposed” in the Trade Marks Registry’s database/record. The Registry may please try to close all the settled matters by clearance drives. Software opposition lock removal powers may be given to designated clearance officers.
- 2) In relation to pending opposition hearings and orders, the Trade Marks Registry may invite stakeholders/public to submit a list of matters which have been adjourned at the hearing stage or for which no orders have been passed. Pursuant to clearance of settled matters, these matters can be taken up and expeditiously disposed of.
- 3) The Trade Marks Registry may set up a mediation cell so that all opposition cases that can be settled are expeditiously disposed of once the mediator records consent of both parties and makes his recommendations/report.
- 4) The Trade Marks Registry may consider offering internship to fresh law graduates to seek their assistance for hearing officers in research and clearing backlog of opposition cases.

Conclusion

The Subcommittee hopes that these suggestions are useful and will help to reduce the pendency of opposition cases, bringing operational efficiency at the same time. We will be grateful for a meeting with the Controller General to discuss them in more detail.

ABOUT INTA: INTA is a global association of trade mark owners and professionals dedicated to supporting trademarks and related intellectual property in order to protect consumers and to promote fair and effective commerce. INTA’s members are more than 6,500 organizations from 190 countries. The Association’s member organizations represent some 30,000 trade mark professionals and include brand owners from major corporations as well as small- and medium-sized enterprises, law firms and nonprofits. There are also government agency members as well as individual professor and student members. Currently INTA has 158 member companies and firms in India. In addition to our India members, INTA has many members globally who are active in protecting and enforcing their intellectual property rights in India.