

By Email

January 13, 2022

Shri Rajendra Ratnoo, IAS
The Office of Controller General of Patents Designs and Trade Marks
Boudhik Sampada Bhavan
S. M. Road, Antop Hill, Mumbai – 400037

Dear Sir,

Re.: Suggestions on SOP to clear backlog in Opposition/Rectification matters; Meeting with INTA on September 20, 2021

On behalf of INTA and its members, a very Happy New Year.

This is with reference to our virtual meeting with your esteemed office on September 20 last year and our discussions concerning an SOP for clearing the backlog for Trademark opposition/rectification matters. I am pleased to submit for your consideration the following comprehensive suggestions in this regard formulated by **INTA's Trademark Office Practices Committee – India Subcommittee**.

The various drives undertaken by the Trade Marks Office in the past to reduce backlog have been very effective. For clearing the Opposition/Rectification backlog, the last drive was initiated in 2015 wherein matters that were settled, withdrawn, or abandoned were taken up for disposal. While such drive was mostly successful, there were instances where orders were reserved but eventually not passed. For your reference, the notification of 2015 issued by your office is **enclosed**.

With the digitization of records, the office has been working on timely disposal of settled and/or withdrawn opposition/rectification matters. However, we believe there is a need for a similar drive to expedite identification of matters to clear the opposition/rectification backlog in a systematic manner and even perhaps as a standard practice.

In this context, we have the following suggestions for an SOP which is likely to give a permanent structure to disposal of contentious opposition/rectification matters that are settled, withdrawn, or abandoned.

Suggestion 1. Creation of a submission link in the existing e-filing module for settled/withdrawn matters

We recommend that a permanent and separate submission link on the e-filing module be created where Parties or their Agents can enter particulars of proceedings where they have (as an Applicant/Opponent/Applicant for Rectification/Registered

Proprietor) withdrawn their application/opposition/application for rectification or are not willing to defend their registered trademark in a Rectification and where the other party has consented to such withdrawal/abandonment with no order as to costs. A permanent/separate submission link in this regard would give the Registrar the benefit of downloading a list of such matters by the click of a button and further management.

Suggestion 2. Automatic Disposal of withdrawn/abandoned opposition/rectification matters where there is consent from the other party

In respect of matters that have been entered through the proposed submission link in the e-filing module in respect of withdrawn/abandoned opposition/rectification matters, subject to the availability of such withdrawal letters and consent letters for passing necessary orders without costs on the e-Register, the Registrar can proceed to pass appropriate orders without any formal hearing simply based on the digital records available on the e-Register and the requests made using the proposed submission link. The Trade Marks Registry could arrange the submitted matters chronologically through digital means. This can be a permanent process that will not only reduce the backlog by removing dead rubber matters from the docket but will also ensure that valuable quasi-judicial time is only invested in contentious matters. In this regard, since the orders would not require merits to be discussed, the Trade Marks Registry could create a simple module for hearing officers to pass template orders with only few fields to be entered, without the need for elaborate orders.

We recommend that the steps set out in Suggestions 1 and 2 above be taken up in the first phase as a pilot project to examine:

- i. Whether this exercise is effective and affects the present bandwidth of the officers, and
- ii. Whether the Parties have grievances following such a process

If this exercise is successful, several matters may be cleansed from the backlog in the first phase itself.

Suggestion 3. Hearing in respect of withdrawn/abandoned opposition/rectification matters where there is NO express consent from the other party in periodic disposal drives

In matters where a consent letter of passing appropriate orders with no orders as to costs in withdrawn/abandoned contentious matters is NOT found on the e-Register or the physical opposition/rectification file, such matters may be listed chronologically for disposal in the proposed disposal drive. The Trade Marks Registry could arrange the submitted matters chronologically through digital means. It has been found that while orders were reserved in such matters in the past, no orders were eventually passed by the concerned officer and some of such matters were scheduled again for hearing in due course. Therefore, immediate orders in all matters taken up during the proposed disposal drive is an absolute necessity to make

the drive successful. Again, in this regard, since the orders would not require merits to be discussed, the Trade Marks Registry could create a simple module for hearing officers to pass template orders with only few fields to be entered, without the need for elaborate orders.

Suggestion 4. Hearing in respect of SETTLED opposition/rectification matters

The following matters can be taken up in a disposal drive through proper hearings:

Matters where the parties have entered into a settlement by way of

- An agreement
 - Court order(s) or
 - Alternate dispute resolution mechanism such as arbitral award(s)
- pursuant to which a request for amendment (such as on earlier Form TM 16/TM 58 or current Form TM M/ TM P) has been filed towards amendment of the specification of goods/services or of inclusion of any condition/limitation in the application/registration, as the case may be, and there is a requirement of passing orders thereon before disposal of the opposition/rectification proceedings.

For these matters, we recommend the following process:

- The Trade Marks Registry could arrange the submitted matters chronologically through digital means.
- New fields may be created for uploading documents such as Settlement Agreement/Court Order(s)/Arbitral Award, which can be uploaded by the system-assigned descriptor of the document. This will allow the Trade Marks Registry to identify such documents.
- Hearings should be appointed chronologically and by grouping matters of same firm/applicant/opponent.
- The hearing officers should be provided access to the online module so that amendments could be carried out during the hearing itself, opposition lock removed, and the mark shown as registered (covered below as well). Presently, orders are being passed but amendments and registrations are not being effectuated pursuant to the orders.

General Note: For effective categorization of matters, there could be different submission modules/upload links for different types of matters based on complexity. For instance, there could be one submission portal for matters set out in Suggestions 1 and 2, and separate submission portals for matters set out in Suggestion 3 and Suggestion 4 respectively. This way, the simpler matters could be eliminated faster than the complex ones which may require more assessment.

Suggestion 5. Removal of Opposition Lock/Change of Status on the e-Register

It is also essential that in cases where oppositions are withdrawn, the Registrar passing such orders is empowered to remove the 'opposition lock' so that the application can immediately proceed to registration as per the Trade Marks Rules. Similarly, in cases where rectifications have been withdrawn and necessary orders have been passed, the Registrar should be empowered to change the status on the e-Register from 'Rectification filed' to 'Registered'.

Suggestion 6. Matters to be disposed of in a chronological manner during a disposal drive by any designated officer empowered by the Hon'ble CGPDTM

It is recommended that as was done in the past, opposition matters should be taken up chronologically based on the application number, i.e., in an ascending order to ensure that oppositions against older applications are disposed of earlier. For rectification matters, the disposal may be done chronologically based on the rectification number, i.e., in an ascending order to ensure that rectifications filed earlier are disposed of prior to the ones filed later. Further, to speed up disposal and ensure that all stakeholders get a fair opportunity to get their matters heard, the adjudicating officers may be based out of any jurisdiction and a specific Registrar needn't be bound to his/her specific jurisdiction, as is being done in TLA matters. For e.g., while stakeholders in Mumbai have the benefit of getting their contentious matters listed before more than one Deputy/Assistant Registrar of TM & G.I., those in Kolkata have recourse to only one such officer.

We request that your office initiates steps to consider the aforementioned suggestions to tackle significant pendency in trade mark opposition and rectification matters. These drives will give all applicants/ agents an opportunity to come forward and conclude such matters, bringing down the backlog considerably. Depending on the success of the proposed mechanism, your office may also consider holding such settlement drives every quarter or bi-annually.

Yours sincerely,



Gauri Kumar

India Consultant
International Trademark Association (INTA)

Enclosed: Public Notice issued in 2015 for liquidation of Opposition Backlog