

OPPOSITION OF A TRADEMARK AND RECTIFICATION OF THE TRADEMARK REGISTER

Opposition of a Trademark:

A 'Trademark opposition' means an objection filed by third parties, against registration of a trademark within 4 months of the advertisement of the trademark to be opposed. Any person, natural or legal, may file an opposition with the Registry. This includes any individual person(s), companies, partnership firm(s) and trust(s). Notably, the person filing the opposition need not have any commercial interest in the matter or a prior registered trademark in the Registry.

Following are the grounds under which an opposition may be filed:

- The mark which is devoid of any distinctive characteristic or includes indications which may serve in trade to designate quality, quantity, intended purpose, values, geographical origin or the time of production.
- The mark is likely to deceive the public or cause confusion. This includes any mark which may be identified with an already registered trademark or that have become customary in the practice of trade.
- The mark contain matters which are likely to hurt the religious sentiments of any class or section of people.
- The mark is prohibited under the Emblem and Names Act, 1950.

Following are the steps to file an opposition:

- Filing a Notice of opposition: Any person who wishes to file a notice is required to mention important



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specifics concerning, details of the opposed application, details of the opposing party and grounds for opposition. Such notice must be filed within 4 months of the advertisement of the mark. If the Registry is satisfied with the notice, it will then serve a copy to the concerned applicant. The applicant has 2 months from date of receipt of the notice to file a counterstatement or else the Registry may deem the application of the trademark as abandoned.

- Filing of Evidence: The opponent upon receiving a copy of the counterstatement is required to file evidence by way of affidavit within 2 months (which is extendable by 1 month) from the date of receipt of the counterstatement. If the opponent fails to do so, the opposition will be treated as abandoned and the application may proceed towards registration. Similarly, the applicant is also provided with 2 months for filing similar evidence with the Registrar. The Registrar may, upon request extend the period of filing by 1 month. If applicant does not wish to submit any evidence and wishes to instead rely on facts already stated in the counter statement, should be intimated in writing to the Registrar and the opponent. If required, the parties may file additional evidence subsequently.

- Hearing of the parties: Upon completion of the evidence stage, the Tribunal generates a hearing notice specifying the date on which the parties will be heard. Such a notice must be sent by the Registrar at least 1 month before the date of first hearing. Within 14 days from the receipt of such notice, whoever intends to appear will notify by submitting the relevant form to the Registrar. Any party who fails to do so may be treated as not desiring to be heard and the matter may proceed accordingly. After hearing the opponent and the Applicant, the Registrar is liable to decide whether the concerned application of trademark is refused or has the opposition been cancelled.

Rectification of Trademark Register:

Any 'person aggrieved' by the registration of a trademark, may file for removal, cancellation or rectification of the register of trademarks. Rectification is used to remove a registered trademark from the register which is not used within 5 years from the date of its registration. However, unlike in the opposition proceedings, only a person who has a 'substantial interest' or a person who would be 'substantially damaged' if the mark remained can file for rectification. Moreover, a collective mark may also be removed from the register if the manner in which the mark has been used has caused it to become liable to mislead the public as a collective mark.

Following are the grounds under which an application for rectification can be filed:

- The trademark was registered without any bonafide intention that it should be used in relation to the goods and services for which it was originally registered and there has been no use of the trademark for 3 months before the date of the application.
- The entry made in the register was made without sufficient cause or was obtained by fraud or misrepresentation of facts, or if the mark is deceptively similar to an earlier registered trademark.
- The registered trademark has not been used for a continuous period of 5 years from the date of registration of trademark.
- The Proprietor is no longer competent in case of the goods and the services for which the mark is registered or there is no longer any public advantage for the mark to remain registered.

The law prescribes the following procedure to file an application for rectification:

- An application for rectification of an entry relating to a trademark should be accompanied by a statement. The statement must set out the nature of the Applicant's interest, the facts upon which he basis the rectification and the relief which he seeks.
- Within 2 months (extendable by 1 month) from the receipt of the copy of such application, the Registered Proprietor send to the Office of the trademark Registry a counterstatement stating the grounds on which the application for the rectification is contested and the same be served to the applicant within 1 month from the receipt of the same. The parties may also file evidence which in the digitized form and uploaded in the Trade Mark Automation System and subsequently integrated with the relevant records of the proceedings.
- Afterwards, the Registry will send a notice in writing to the registered proprietor stating the grounds under which the trademark proposes to rectify the register. The notice will specify the time at which the parties will be heard. On the date fixed for hearing, the Hearing Officer communicates to the parties its decision along with the grounds of the same.

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