

The Trade Marks Act, 1999¹

[Act 47 of 1999]

[30th December, 1999]

*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*

Be it enacted by Parliament in the Fiftieth Year of the Republic of India as follows:—

Statement of Objects and Reasons.—The Trade and Merchandise Marks Act, 1958 has served its purpose over the last four decades. It was felt that a comprehensive review of the existing law be made in view of developments in trading and commercial practices, increasing globalisation of trade and industry, the need to encourage investment flows and transfer of technology, need for simplification and harmonization of trade mark management systems and to give effect to important judicial decisions. To achieve these purposes, the present Bill proposes to incorporate, *inter alia* the following, namely:—

- (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 for defensive registration of trade marks are proposed to be omitted;
- (c) amplification 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 for registration of "Collective Marks" owned by associations, etc.;
- (g) providing an Appellate Board for speedy disposal of appeals and rectification applications which at present lie before High Court;
- (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 Organisations;
- (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

1. Received the assent of the President on December 30, 1999 and published in the Gazette of India, Extra., Part II, Section 1, dt. 30th December, 1999, pp. 1-52, No. 60.

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.

2. In view of the extensive amendments necessitated in the Trade and Merchandise Marks Act, 1958, it has been thought fit to repeal and re-enact the said Act incorporating the necessary changes.

3. The Bill seeks to achieve the above objects. The Notes on clauses explain the various provisions of the Bill.

Statement of Objects and Reasons of Amendment Act 40 of 2010.—At present, a person desirous of obtaining registration of his trade mark in other countries has to make separate applications in different languages and pay different fees in the respective countries. There is no provision under the Trade Marks Act, 1999 (hereinafter referred to as the Trade Marks Act) to facilitate Indian nationals as well as foreign nationals to secure simultaneous protection of trade marks in other countries.

2. The Madrid Protocol, administered by the International Bureau of the World Intellectual Property Organisation, a specialised agency of the United Nations, was adopted in 1989. The Madrid Protocol is a simple, facilitative and cost-effective system for international registration of trade marks. It enables the nationals of the member countries of the protocol to obtain protection of trade marks within the prescribed period of 18 months by filing a single application with one fee and in one language in their country of origin, which in turn is transmitted to the other designated countries through the International Bureau.

3. Accession to the Madrid Protocol entails amendments to the Trade Marks Act. For this purpose, it is proposed to suitably amend the Trade Marks Act and to incorporate therein a new Chapter IV-A containing special provisions relating to protection of international registration of trade marks under the Madrid Protocol. It is sought to empower the Registrar of Trade Marks to deal with international applications originating from India as well as those received from the International Bureau and maintain record of international registrations. Definitions of new terms are being given. It is further proposed to provide for the effect of international registration, duration and its renewal.

4. It is also proposed to remove the discretion of the Registrar to extend the time for filing notice of opposition of published applications and provide for a uniform time limit of four months in all cases. Further, with a view to simplify the law relating to transfer of ownership of trade marks by assignment or transmission and to bring the law generally in tune with international practice and modern business needs, Section 45 is proposed to be modified. It is also proposed to omit Chapter X of the Trade Marks Act dealing with special provisions for textile goods, as it has now become redundant.

5. The Bill seeks to achieve the above objects.

CASE LAW ► Object of the Act.—The history of legislation is more than a century old. The first legislation brought on the statute-book was the Indian Merchandise Marks Act, 1889 (Act 4 of 1889). This was followed by the Trade Marks Act, 1940 (Act 5 of 1940). Both these Acts were repealed by the Trade and Merchandise Marks Act, 1958. This Act follows the pattern of the Trade Marks Act, 1938 of the United Kingdom. Prior to the enactment of the Trade Marks Act, 1940, the disputes or problems, specially those relating to infringement of trade marks or passing off were decided in the light of Section 54 of the Specific Relief Act, 1877, while the registration problem was tackled by obtaining a declaration as to ownership of a trade mark under the Indian Registration Act, 1908. Section 129 of the 1958 Act provides that any document declaring or purporting to declare the ownership or title of a person to a trade mark other than a registered trade mark, shall not be registered under the Indian Registration Act, 1908, *Whirlpool Corpn. v. Registrar of Trade Marks*, (1998) 8 SCC 1.

Object of the Act, was to amend and consolidate the law relating to trade marks, to provide for registration and better protection of trade marks and for prevention of the use of fraudulent marks, *Meghraj Biscuits Industries Ltd. v. CCE*, (2007) 3 SCC 780.

► **Applicability.**—Applicability of the Act, over the trade mark law is a special Act meant to protect trade marks from misuse, confusion and deception. Action taken in the special Act and remedies sought which are mentioned therein which otherwise are not in derogation to the general law are not barred unless the general law expressly or impliedly excludes the applicability of the said law. Thus, special law applies over the general law, *Chartered Financial Analysis Institute v. Institute of Chartered Financial Analysts of India*, (2010) 169 DLT 691 (Del).

CHAPTER I PRELIMINARY

1. Short title, extent and commencement.—(1) This Act may be called the Trade Marks Act, 1999.

(2) It extends to the whole of India.

(3) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint:

Provided that different dates may be appointed for different provisions of this Act, and any reference in any such provision to the commencement of this Act shall be construed as a reference to the coming into force of that provision.

Date of Enforcement.—All the provisions of the said Act came into force, w.e.f. September 15, 2003 [*Vide* Noti. No. S.O. 1048(E), dated September 15, 2003].

2. Definitions and interpretation.—(1) In this Act, unless the context otherwise requires,—

- (a) “Appellate Board” means the Appellate Board established under Section 83;
- (b) “assignment” means an assignment in writing by act of the parties concerned;
- (c) “associated trade marks” means trade marks deemed to be, or required to be, registered as associated trade marks under this Act;
- (d) “Bench” means a Bench of the Appellate Board;
- (e) “certification trade mark” means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are 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;

Old Act S. 2(1)(c).—“certification trade mark” means a mark adapted in relation to any goods to distinguish, in the course of trade, goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified and registrable as such under the provisions of Chapter VIII in respect of those goods in the name as proprietor of the certification trade mark, of that person;

- (f) “²[Chairperson]” means the ³[Chairperson] of the Appellate Board;
 - (g) “collective mark” means a trade mark distinguishing the goods or services of members of an association of persons [not being a partnership within the meaning of the Indian Partnership Act, 1932 (9 of 1932)] which is the proprietor of the mark from those of others;
 - (h) “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;
 - (i) “false trade description” means—
 - (I) a trade description which is untrue or misleading in a material respect as regards the goods or services to which it is applied; or
 - (II) any alteration of a trade description as regards the goods or services to which it is applied, whether by way of addition, effacement or otherwise, where that alteration makes the description untrue or misleading in a material respect; or
 - (III) any trade description which denotes or implies that there are contained, as regards the goods to which is applied, more yards or meters than there are contained therein standard yards or standard metres; or
 - (IV) any marks or arrangement or combination thereof when applied—
 - (a) to goods in such a manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are;
 - (b) in relation to services in such a manner as to be likely to lead persons to believe that the services are provided or rendered by some person other than the person whose services they really are; or
- Old Act S. 2(1)(f)(iv).**—any marks or arrangement or combination thereof applied to goods in such manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are; or
- (V) any false name or initials of a person applied to goods or services in such manner as if such name or initials were a trade description in any case where the name or initials—
 - (a) is or are not a trade mark or part of a trade mark; and
 - (b) is or are identical with or deceptively similar to the name or initials of a person carrying on business in connection with goods or services of the same description or both and who has not authorised the use of such name or initials; and

2. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

3. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

- (c) is or are either the name or initials of a fictitious person or some person not bona fide carrying on business in connection with such goods or services, and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being a false trade description within the meaning of this Act;
- (j) “goods” means anything which is the subject of trade or manufacture;
- (k) “Judicial Member” means a Member of the Appellate Board appointed as such under this Act, and includes the ⁴[Chairperson] and the ⁵[Vice-Chairperson];
- (l) “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;

Old Act S. 2(1)(i).—“limitations” (with its grammatical variations) means any limitations 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 of use as to use, in relation to goods to be sold or otherwise traded in within India, or as to use in relation to goods to be exported to any market outside India;

- (m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

CASE LAW ► Colour as a registered Mark.—The description of the mark as including not just the colour purple as a sign, but other signs, in which the colour purple predominates over other colours and other matter, means that the mark described is not “a sign”. There is wrapped up in the verbal description of the mark an unknown number of signs. That does not satisfy the requirement of “a sign” within the meaning of article 2 of the Parliament and Council Directive 2008/95/EC of 22 October, 2008, as interpreted in the rulings of the Court of Justice of the European Union, nor does it satisfy the requirement of the graphic representation of “a sign”, because the unknown number of signs means that the representation is not of “a sign”. The mark applied for thus lacks the required clarity, precision, self-containment, durability and objectivity to qualify for registration, *Cadbury UK Ltd v. Société des Produits Nestlé SA*, [2014] Bus LR 134 : [2013] EWCA Civ 1174 (CA)

Old Act S. 2(1)(j).—“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof;

- (n) “Member” means a Judicial Member or a Technical Member of the Appellate Board and includes the ⁶[Chairperson] and the ⁷[Vice-Chairperson];
- (o) “name” includes any abbreviation of a name;
- (p) “notify” means to notify in the Trade Mark Journal published by the Registrar;
- (q) “package” includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper and cork;

4. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

5. Subs. for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

6. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

7. Subs. for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

(r) "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;

Old Act S. 2(1)(m).—"permitted use", in relation to a registered trade mark, means the use of a trade mark—

(i) by a registered user of the trade mark in relation to goods—

- (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

(ii) which complies with any conditions or restrictions to which the registration of the trade mark is subject;

(s) "prescribed" means prescribed by rules made under this Act;

Old Act S. 2(1)(n).—"prescribed" means, in relation to proceedings before a High Court, prescribed by rules made by the High Court, and in other cases, prescribed by rules made under this Act;

(t) "register" means the Register of Trade Marks referred to in sub-section (1) of Section 6;

Old Act S. 2(1)(o).—"register" means the Register of Trade Marks referred to in Section 6;

(u) "registered" (with its grammatical variations) means registered under this Act;

(v) "registered proprietor", in relation to a trade mark, means the person for the time being entered in the register as proprietor of the trade mark;

(w) "registered trade mark" means a trade mark which is actually on the register and remaining in force;

Old Act S. 2(1)(r).—"registered trade mark" means a trade mark which is actually on the register;

(x) "registered user" means a person who is for the time being registered as such under Section 49;

(y) "Registrar" means the Registrar of Trade Marks referred to in Section 3;

Old Act S. 2(1)(t).—"Registrar" means the Registrar of Trade Marks referred to in Section 4;

(z) "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;

(za) "trade description" means any description, statement or other indication, direct or indirect,—

(i) as to the number, quantity, measure, guage 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 recognised in the trade; or

(iii) as to fitness for the purpose, strength, performance or behaviour 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

Old Act S. 2(1)(u)(iv).—as to the place or country in which or the time at which any goods were made or produced; 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

Old Act S. 2(1)(u)(v).—as to the name and address or other indication of the identity of the manufacturer or of the person for whom the goods are manufactured; or

(vi) as to the mode of manufacture or producing any goods or providing services; or

Old Act S. 2(u)(vi).—as to the mode of manufacture or producing any goods; 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;

- (zb) "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; and—
- (i) in relation to Chapter XII (other than Section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and
 - (ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

Old Act S. 2(1)(v).—"trade marks" means—

- (i) in relation to Chapter X (other than Section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and
- (ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;

CASE LAW ▶ "Trade mark".—The concept of a trade mark is distinct from that of a property mark. A mark, as defined by Section 2(1)(f) of the Trade and Merchandise Marks Act, 1958, includes a device, brand, heading, label, ticket, name, signature, word, letter or numerical or any combination thereof. A trade mark means a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use that mark. The function of a trade mark is to give an indication to the purchaser or a possible purchaser as to the manufacture or quality of the goods, to an indication to his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market.

"Trade mark" includes both registered and unregistered mark, *State of U.P. v. Ram Nath*, (1972) 1 SCC 130: 1972 SCC (Cri) 74.

A descriptive trade mark is entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or being from a particular source, *Godfrey Philips India Ltd. v. Ginnar Food & Beverages (P) Ltd.*, (2004) 5 SCC 257.

Mark (phrase) not unique and not showing any relation with the party concerned could not be treated as brand name. Hence, phrase "new improved quick frozen french fries", could not be treated as a brand name, *Tarai Food Ltd. v. CCE*, (2007) 12 SCC 721.

The expression "trade mark" includes the shape of goods. A manufacturer who markets a product may assert the distinctive nature of the goods sold in terms of the unique shape, *Gorbatschow Wodka Kg v. John Distilleries Ltd.*, (2011) 4 Mah LJ 842 (Bom).

Trade mark should normally have attributes of a new creation to claim exclusivity of the user. If it is an existing word, it should not bear descriptive characteristics so far as the product is concerned, nor should it be of an extolment or laudation, *Neon Laboratories Ltd. v. Medical Technologies Ltd.*, (2016) 2 SCC 672 : (2016) 2 SCC (Civ) 190.

"Brand name" or "Trade name" is a mark, symbol, design or name, etc. that is used with purpose to associate a manufacturer using the same with the goods. What is necessary is that the said mark is of the nature that it establishes connection between the product and the person, *CCE v. Stangen Immuno Diagnostics*, (2015) 11 SCC 761.

► **Property mark.**—A property mark, as defined by Section 479 of the Penal Code means a mark used for denoting that a moveable property belongs to a particular person. The distinction between a trade mark and a property mark is that whereas the former denotes the manufacture or quality of the goods to which it is attached, the latter denotes the ownership in them. In other words, a trade mark concerns the goods themselves, while a property mark concerns the proprietor. A property mark attached to the moveable property of a person remains even if part of such property goes out of his hands and ceases to be his, *Sumat Prasad Jain v. Sheojanam Prasad*, (1973) 1 SCC 56 : 1973 SCC (Cri) 186.

► **Domain names.**—Domain names, are not merely internet website addresses but also identify specific websites. They are business identifiers, serving to identify and distinguish the business itself, or its goods or services and to specify its corresponding online location. As an address they must be unique and peculiar and where they are used in connection with a business, the value of maintaining an exclusive identity is critical. Domain names pertaining to the provisions of goods and services are words or names capable of distinguishing the subject of trade and services made available to potential users of the internet, *Satyam Infoway Ltd. v. Sifynet Solutions (P) Ltd.*, (2004) 6 SCC 145.

(zc) "transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment;

(zd) "Technical Member" means a Member who is not a Judicial Member;

(ze) "tribunal" means the Registrar or, as the case may be, the Appellate Board, before which the proceeding concerned is pending;

Old Act S. 2(1)(x).—"tribunal" means the Registrar or, as the case may be, the High Court, before which the proceeding concerned is pending.

CASE LAW ► High Court and Registrar.—Section 2(1)(x) of the Trade and Merchandise Marks Act, 1958 indicates that the High Court and the Registrar of Trade Marks, on their own, are not "Tribunal". In view of the provisions of Sections 56, 107, 3 and 109, the phrase "before which the proceeding concerned is pending", occurring in Section 2(1)(x) conveys the idea that if the proceeding is pending before the "Registrar", it becomes the "Tribunal". Similarly, if the proceeding is pending before the "High Court", then

the High Court has to be treated as the "Tribunal". Thus, the jurisdiction of the Registrar and the High Court, though apparently concurrent in certain matters, is mutually exclusive.

That is to say, if a particular proceeding is pending before the Registrar, any other proceeding, which may, in any way, relate to the pending proceeding, will have to be initiated before and taken up by the Registrar and the High Court will act as the appellate authority of the Registrar under Section 109. If the proceedings are pending before the High Court, the Registrar will keep his hands off and not touch those or any other proceedings which may, in any way, relate to those proceedings, as the High Court, which has to be the High Court having jurisdiction as set out in Section 3, besides being the appellate authority of the Registrar, has primacy over the Registrar in all matters under the Act. Any other interpretation of the definition of "Tribunal" would not be in consonance with the scheme of the Act or the contextual background set out therein and may lead to conflicting decisions on the same question by the Registrar and the High Court besides generating a multiplicity of proceedings, *Whirlpool Corpn. v. Registrar of Trade Marks*, (1998) 8 SCC 1.

► **Definition of "Tribunal".**—Since "Tribunal" is defined in Section 2 which, in its opening part, uses the phrase "Unless the context otherwise requires", the definition, obviously, cannot be read in isolation. The phrase "Unless the context otherwise requires" is meant to prevent a person from falling into the whirlpool of "definitions" and not to look to other provisions of the Act which, necessarily, has to be done as the meaning ascribed to a "definition" can be adopted only if the context does not otherwise require.

(zf) "8[Vice-Chairperson]" means a ⁹[Vice-Chairperson] of the Appellate Board;

(zg) "well-known trade mark", in relation to any goods or 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 during the mark in relation to the first-mentioned goods or services.

(2) In this Act, unless the context otherwise requires, 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;

Old Act S. 2(2)(b).—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;

8. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

9. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

- (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.

(3) For the purposes of this Act, goods and services as associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business and so with descriptions of goods and descriptions of services.

(4) For the purposes of this Act, "existing registered trade mark" means a trade mark registered under the Trade and Merchandise Marks Act, 1958 (43 of 1958) immediately before the commencement of this Act.

CHAPTER II

THE REGISTER AND CONDITIONS FOR REGISTRATION

3. Appointment of Registrar and other officers.—(1) The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.

(2) The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as he may from time to time authorise them to discharge.

CASE LAW ▶ Validity of statement by subordinate.—Where a statement is submitted by a subordinate to the Registrar, a copy of the notification of the Central Government under Section 3(2) appointing such officer for the purpose, and the authorization of the Registrar permitting him to appear and make a statement, ought to be appended to the statement. In the absence of notification and authorization under Section 3(2), an officer of the Trade Marks Registry cannot be asked to file a statement for the purposes of Section 98(2), *Mount Everest Mineral Water Ltd. v. Bisleri International (P) Ltd.*, (2010) 171 DLT 298 (Del).

4. Power of Registrar to withdraw or transfer cases, etc.—Without prejudice to the generality of the provisions of sub-section (2) of Section 3, the Registrar may, by order in writing and for reasons to be recorded therein, withdraw any matter pending before an officer appointed under the said sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer so appointed who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

5. Trade Marks Registry and offices thereof.—(1) For the purposes of this Act, there shall be a Trade Marks Registry and the Trade Marks Registry established under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall be the Trade Marks Registry under this Act.

(2) The head office of the Trade Marks Registry shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration

of trade marks, there may be established at such places as the Central Government may think fit branch offices of the Trade Marks Registry.

(3) The Central Government may, by notification in the Official Gazette, define the territorial limits within which an office of the Trade Marks Registry may exercise its functions.

(4) There shall be a seal of the Trade Marks Registry.

6. The Register of Trade Marks.—(1) For the purposes of this Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and description of the proprietors, notifications of assignment and transmissions, the names, addresses and descriptions of registered users, conditions, limitations and such other matter relating to registered trade marks as may be prescribed.

(2) Notwithstanding anything contained in sub-section (1), it shall be lawful for the Registrar to keep the records wholly or partly in computer floppies diskettes or in any other electronic form subject to such safeguards as may be prescribed.

(3) Where such register is maintained wholly or partly on computer under sub-section (2) any reference in this Act to entry in the register shall be construed as the reference to any entry as maintained on computer or in any other electronic form.

(4) No notice of any trust, express or implied or constructive, shall be entered in the register and no such notice shall be receivable by the Registrar.

(5) The register shall be kept under the control and management of the Registrar.

(6) There shall be kept at each branch office of the Trade Marks Registry a copy of the register and such of the other documents mentioned in Section 148 as the Central Government may, by notification in the Official Gazette, direct.

(7) The Register of the Trade Marks, both Part A and Part B, existing at the commencement of this Act, shall be incorporated in and form part of the register under this Act.

Old Act S. 6.—The Register of Trade Marks.—(1) For the purposes of this Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and descriptions of the proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of registered users, disclaimers, conditions, limitations and such other matters relating to registered trade marks as may be prescribed.

(2) No notice of any trust, express or implied or constructive, shall be entered in the register and no such notice shall be receivable by the Registrar.

(3) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Registrar.

(4) There shall be kept at each branch office of the Trade Marks Registry a copy of the register and such of the other documents mentioned in Section 125 as the Central Government may, by notification in the Official Gazette, direct.



7. Classification of goods and services.—(1) The Registrar shall classify goods and services, as far as may be, in accordance with the International classification of goods and services for the purposes of registration of trade marks.

(2) Any question arising as to the class within which any goods or services falls shall be determined by the Registrar whose decision shall be final.

8. Publication of alphabetical index.—(1) The Registrar may publish in the prescribed manner an alphabetical index of classification of goods and services referred to in Section 7.

(2) Where any goods or services are not specified in the alphabetical index of goods and services published under sub-section (1), the classification of goods or services shall be determined by the Registrar in accordance with sub-section (2) of Section 7.

9. Absolute grounds for refusal of registration.—(1) The trade marks—

- (a) 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) 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 service;
- (c) 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,

shall not be registered:

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.

(2) A mark shall not be registered as a trade mark if—

- (a) it is of such nature as to deceive the public or cause confusion;
- (b) it contains or comprises of 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 matter;
- (d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).

(3) A mark shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape of goods which results from the nature of the goods themselves; or
- (b) the shape of goods which is necessary to obtain a technical result; or
- (c) the shape which gives substantial value to the goods.

Explanation.—For the purposes of this section, the nature of goods services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.

CASE LAW ▶ Scope of the section.—The Section 9 does not bar the registrar from registration of marks which would be likely to deceive or cause confusion, *Khoday Distilleries Limited v. Scotch Whisky Association*, (2008) 10 SCC 723.

▶ **Registration of trade mark.**—Registration of phonetically similar mark "NANDHINI" to the earlier registered/in use mark "NANDINI" is permissible when such latter mark is used for different goods/nature of business and visual appearance of two marks is so different that average person of ordinary intelligence would not be deceived or confused between goods concerned. Further, registration of trade mark qua certain goods falling under one class does not vest monopoly over the entire class of goods with the proprietor of registered mark, *Nandhini Delux v. Karnataka Cooperative Milk Producers Federation Ltd.*, (2018) 9 SCC 183.

▶ **Refusal of registration.**—Trade mark "skyline", devoid of any distinctive character and already being used in India, USA and UK as trade name by various companies/organisations/business concerns and also for describing different types of institutes/institutions cannot get protection by way of temporary injunction against respondents in using this word for an Institute of Engineering and Technology set up by them, *Skyline Education Institute (India) (P) Ltd. v. S.L. Vaswani*, (2010) 2 SCC 142 : (2010) 1 SCC (Civ) 345.

Registration of trade mark is prima facie evidence of its validity and registered trade mark cannot be held invalid in legal proceedings on ground that it was not registrable under Section 9, *Consim Info (P) Ltd. v. Google India (P) Ltd.*, (2010) 6 CTC 813 (Mad).

Expression "Rehydrate Replenish Refuel" is prima facie suspect, as words forming said expression are an intrinsic part of the "current language" commonly used in the trade for describing the character, quality and attributes of an isotonic drink. Thus no protection can be guaranteed, *Stokely Van Camp, Inc. v. Heinz India (P) Ltd.*, (2010) 171 DLT 16 (Del).

▶ **Absolute grounds for refusal.**—"Ramayan", a name of holy scripture of Hindus, was sought to be registered as trade mark for incensed sticks and other fragrance spreading products. Registration opposed inter alia on the ground that mark was a religious word and lacked distinctiveness. On facts, it was found that "Ramayan" was projected as prominent feature of trade mark. In addition, three main characters of the epic, namely, Rama, Sita and Lakshman, were also incorporated in the mark. Registrant intended to encash popularity of "Ramayan". It was not a distinctive mark and was non-registrable. While arriving at this conclusion, Report of the Parliamentary Standing Committee on the subject was also taken into consideration. It was also held, it would have been a different matter if "Ramayan" had been prefixed or suffixed with some other word or words so that "Ramayan" was not the sole feature of the mark, *Lal Babu Priyadarshi v. Amritpal Singh*, (2015) 16 SCC 795 : (2016) 3 SCC (Civ) 649.

10. Limitation as to colour.—(1) A trade mark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Old Act S. 10.—Limitation as to colour.—(1) A trade mark may be limited wholly or in part to one or more specified colours and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

11. Relative grounds for refusal of registration.—(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.

(2) 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 well-known 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.

(3) 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.

(4) 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.

Explanation.—For the purposes of this section, earlier trade mark means—

- ¹⁰[(a) a registered trade mark or an application under Section 18 bearing an earlier date of filing or an international registration referred to in Section 36-E 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.

10. Subs. by Act 40 of 2010, S. 2 (w.e.f. 8-7-2013). Prior to substitution it read as:

“(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;”

(5) A trade mark shall not be refused registration on the grounds specified in sub-sections (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.

(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;
- (v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account—

- (i) the number of actual or potential consumers of the goods or services;
- (ii) the number of persons involved in the channels of distribution of the goods or services;
- (iii) the business circles dealing with the goods or services,

to which that trade mark applies.

(8) Where a trade mark has been determined to be well-known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:—

- (i) that the trade mark has been used in India;
- (ii) that the trade mark has been registered;
- (iii) that the application for registration of the trade mark has been filed in India;
- (iv) that the trade mark—
 - (a) is well-known in; or
 - (b) has been registered in; or
 - (c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or
- (v) that the trade mark is well-known to the public at large in India.

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

- (i) protect a well-known trade mark against the identical or similar trade marks;
- (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

(11) Where a trade mark has been registered in good faith disclosing the material informations to the Registrar or where right to a trade mark has been acquired through use in good faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark.

12. Registration in the case of honest concurrent use, etc.—In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

CASE LAW ▶ Concurrent use.—When initial adoption of a trade mark itself is malafide and tainted, continued adoption and use does not undo illegality or bestow legality. Common law protects freedom of choice and rejects claim of monopoly in large public interest but in a given case keeping in view nature and type of goods, area of business, extent of goodwill to protect interest of consumers and to avoid possibility of confusion, request for registration can be rejected. (A party which has developed and nurtured a mark to make it household name and associate the name with products of high quality, is entitled to protection from third persons who to claim benefit of its reputation, *Kunj Aluminium (P) Ltd. v. Koninklijke Philips Electronics Nv*, ILR (2010) 2 Del 215.

13. Prohibition of registration of names of chemical elements or international non-proprietary names.—No word—

- (a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or
- (b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name,

shall be registered as a trade mark and any such registration shall be deemed for the purpose of Section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.

Old Act S. 13.—Prohibition of registration of names of chemical elements.—(1) No word which is the commonly used and accepted name of any single chemical element or single chemical compound (as distinguished from a mixture) shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration shall, notwithstanding anything in Section 32, be

deemed for the purposes of Section 56 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.

(2) This section shall not apply to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

14. Use of names and representations of living persons or persons recently dead.—Where an application is made for the registration of a trade mark which falsely suggests a connection with any living person, or a person whose death took place within twenty years prior to the date of application for registration of the trade mark, the Registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnishes the registrar with such consent.

15. Registration of parts of trade marks and of trade marks as a series.—(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trade marks.

(2) Each such separate trade mark shall satisfy all the conditions applying to and have all the incidents of, an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of—

- (a) statement of the goods or services in relation to which they are respectively used or proposed to be used; or
- (b) statement of number, price, quality or names of places; or
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

seeks to register those trade marks, they may be registered as a series in one registration.

16. Registration of trade marks as associated trade marks.—(1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods or services is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may, at any time, require that the trade marks shall be entered on the register as associated trade marks.

(2) Where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration in the name of the same proprietor,

in respect of goods and in respect of services which are associated with those goods or goods of that description and with those services or services of that description, sub-section (1) shall apply as it applies as where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services.

(3) Where a trade mark and any part thereof are, in accordance with the provisions of sub-section (1) of Section 15, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(4) All trade marks registered in accordance with the provisions of sub-section (3) of Section 15 as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person in relation to any of the goods or services or both in respect of which it is registered, and may amend the register accordingly.

17. Effect of registration of parts of a mark.—(1) 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.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character,

the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

CASE LAW ▶ Registration of part of a mark.—When a part of plaintiff's exclusive word mark in the same class of goods is incorporated in the defendant's mark, it is for the defendant to establish that their use of one or more words in addition to the plaintiff's word mark would remove the defendant's mark from the prohibited umbra of what is deceptively similar, *R.R. Proteins and Agro Ltd. v. Hari Shankar Singhania*, (2010) 3 CHN 912 (Cal).

▶ **Degree of resemblance between the marks.**—The substance of the tests in a passing off action appears to be the court's perception of the degree of resemblance between the marks.

The registration of a device or label would entitle the proprietor to protection against the use of such device or label by a rival in trade if the rival's use is identical or similar to the registered trade mark and the

use is in connection with identical or similar goods or services covered by such registered trade mark and it appears to court that the rival's mark is likely to cause confusion or is likely to have an association with the registered mark. If the two marks are identical and the goods and services covered by either mark are also identical, there is a presumption that arises in favour of the proprietor of the registered mark and, for interlocutory purposes, it may be enough to earn the plaintiff its injunction. If the two marks are identical and the goods and services are similar or if the two marks are similar and the goods and services are identical, the court has to weigh the likelihood of confusion or assess whether the defendant's mark is likely to have an association with the plaintiff's registered mark.

The identity or similarity of the marks has to be assessed on the basis of the entirety of the mark as registered.

The right that the owner of a device or label mark obtain is, loosely speaking, somewhat similar to copyright. It is as much the writing or etching in a device or label, and the design and colour combination thereof, over which the registered proprietor gains rights as the manner of depiction thereof. It is possible that a registered mark is made up of several components which are distinctive and notwithstanding separate registrations in respect of such distinctive parts not having been obtained by the owner of the registered mark, such proprietor is entitled to cite one distinctive part as being inseparable from the registered whole or such distinctive part being the most outstanding attribute of the mark and thus assert a right over the distinctive part. But in view of Section 17(2)(a) of the 1999 Act, such assertion has to be as in passing off and may not be made in aid of a case of infringement. Section 17(2) and the word beyond the statute that is recognised in Section 27 of the 1999 Act has a combined effect of permitting the registered owner to claim exclusivity of a part of the whole of the registered mark, but only on a cause of action of passing off.

The expression "the registration thereof shall not confer any exclusive right" towards the end of Section 17(2) have to be understood in the context. The import of such words is that the registration of the composite mark will not ipso facto confer any exclusive right as to the parts of the composite mark. But if the owner can establish exclusivity aliunde, the owner can assert the exclusivity. The registered owner is entitled to protection of its goodwill in such prominent feature as in an action for passing off unless the registered owner seeks to rely on Section 17(2)(b) of the Act in respect of a distinctive matter not common to the trade, *Three-N-Products (P) Ltd. v. Emami Ltd.*, (2008) 4 CHN 608.

CHAPTER III

PROCEDURE FOR AND DURATION OF REGISTRATION

18. Application for registration.—(1) 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.

(2) A single application may be made for registration of a trade mark for different classes of goods and services and fee payable therefor shall be in respect of each such class of goods or services.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first mentioned in the application as having a place of business in India, is situate:

Provided that where the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India as disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(5) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision.

Old Act S. 18.—Application for registration.—(1) 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 either in Part A or in Part B of the register.

(2) An application shall not be made in respect of goods comprised in more than one prescribed class of goods.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first-mentioned in the application, as having a place of business in India, is situate:

Provided that where the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India is disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(5) In the case of an application for registration of a trade mark (other than a certification trade mark) in Part A of the register, the Registrar may, if the applicant so desires instead of refusing the application, treat it as an application for registration in Part B of the register and deal with the application accordingly.

(6) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision.

CASE LAW ► Registration of marks.—The right to have a mark registered is not dependent upon the actual use of the mark at the time of registration, *Drums Food International (P) Ltd. v. Euro Ice Cream*, (2011) 5 Mah LJ 166 (Bom).

19. Withdrawal of acceptance.—Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied—

- (a) that the application has been accepted in error; or
- (b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted,

the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

20. Advertisement of application.—(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner:

Provided that the Registrar may cause the application 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, or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do.

(2) Where—

- (a) an application has been advertised before acceptance under sub-section (1); or
- (b) after advertisement of an application,—
 - (i) an error in the application has been corrected; or
 - (ii) the application has been permitted to be amended under Section 22,

the Registrar may in his discretion cause the application to be advertised again or in any case falling under clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or amendment made in the application.

21. Opposition to registration.—¹¹[(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.]

(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any,

11. Subs. by Act 40 of 2010, S. 3 (w.e.f. 8-7-2013). Prior to substitution it read as:

“(1) Any person may, within three months from the date of the advertisement or re-advertisement of an application for registration or within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration.”

the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

(6) Where a person giving notice of opposition or an applicant sending a counter statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter statement on such terms as he thinks just.

CASE LAW ▶ Grant of injunction.—The action for infringement is a statutory remedy conferring on the registered proprietor of a registered trade mark for the indication of exclusive right to the use of trade mark in relation to those goods. The use by the defendant of the trade mark of the plaintiff is not essential in an action for passing off, but is the sine qua non in action for infringement. Mere delay in bringing action is not sufficient to defeat grant of injunction, *Pankaj Jaiswal v. Virendra Prasad Jaiswal*, (2007) 2 ICC 192 (Cal) (DB).

▶ **Special Acts.**—Trade Marks Act is a special Act, hence the provisions of Sections 4 to 24 of the Limitation Act will apply only so far as and to the extent to which, they are not expressly excluded by such special or local law to the suits, appeals or applications under the special law, *Allied Blenders and Distillers (P) Ltd. v. Intellectual Property Appellate Board*, (2010) 2 ICC 403 (Mad) (DB).

▶ **Extension of limitation.**—Registrar of trade marks cannot receive a notice of opposition to the registration of a trade mark given beyond the period prescribed under Section 21 of the Trade Marks Act, 1999. Trade Marks Act prescribes procedure for registration of Trade Mark Act confers certain rights on person desirous of opposing registration of trade mark. Such right has to be exercised vigilantly. Registrar cannot extend time for sending notice of opposition, *Allied Blenders And Distillers (P) Ltd. v. Intellectual Property Appellate Board*, (2010) 2 ICC 403 (Mad) (DB).

▶ **Notice of opposition.**—Trade Marks Act prescribes procedure for registration of trade mark. The Act confers certain rights on person desirous of opposing registration of trade mark. Such right has to be exercised vigilantly. Registrar cannot extend time for sending notice of opposition as period prescribed by section cannot be extended, *Allied Blenders And Distillers (P) Ltd. v. Intellectual Property Appellate Board*, (2010) 1 CTC 129 (DB).

▶ **Extension of time.**—It is a ministerial act which requires only Registrar's satisfaction. Hence, Registrar need not pass a separate order in every case if he wishes to extend the time. *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board*, (2016) 4 SCC 381 : (2016) 2 SCC (Civ) 606.

▶ **Appeal to Supreme Court.**—Refusal of Registration of trade mark "Royal Orchid" to the petitioner in Class 42, when the mark/logo "Orchid" was being used by Respondent 1 from an anterior date, affirmed, *Royal Orchid Hotels Ltd. v. Kamat Hotels (India) Ltd.*, (2018) 1 SCC 728.

22. Correction and amendment.—The Registrar may, on such terms as he thinks just, at any time, whether before or after acceptance of an application for registration under Section 18, permit the correction of any error in or in connection with the application or permit an amendment of the application:

Provided that if an amendment is made to a single application referred to in sub-section (2) of Section 18 involving division of such application into two or more applications, the date of making of the initial application shall be deemed to be the date of making of the divided applications so divided.

Old Act S. 22.—Correction and amendment.—The Registrar may on such terms as he thinks just—

- (a) at any time, whether before or after acceptance of an application for registration under Section 18, permit the correction of any error in or in connection with the application or permit an amendment of the application; or
- (b) permit correction of any error in, or an amendment of a notice of opposition or a counter statement under Section 21.

23. Registration.—(1) Subject to the provisions of Section 19, when an application for registration of a trade mark has been accepted and either—

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark ¹²[within eighteen months of the filing of the application] and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of Section 154, be deemed to be the date of registration.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

(4) The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

Old Act S. 23.—Registration.—(1) Subject to the provisions of Section 19, when an application for registration of a trade mark in Part A or Part B of the register has been accepted and either—

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant;

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark in Part A or Part B of the register, as the case may be, and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of Section 131, be deemed to be the date of registration.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

12. Ins. by Act 40 of 2010, S. 4 (w.e.f. 8-7-2013).

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

(4) The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

24. Jointly owned trade marks.—(1) Save as provided in sub-section (2), nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

(2) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them; or
- (b) in relation to an article or service with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

CASE LAW ▶ Origin of trade marks.—In law of trade mark there can be only one mark, one source and one proprietor. It cannot have two origins, *Power Control Appliances v. Sumeet Machines (P) Ltd.*, (1994) 2 SCC 448.

25. Duration, renewal, removal and restoration of registration.—(1) The registration of a trade mark, after the commencement of this Act, shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.

Old Act S. 25(1).—**Duration, renewal and restoration of registration.**—The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

Old Act S. 25(2).—The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of seven years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

(3) At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the

expiration of the time prescribed in that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register:

Provided that the Registrar shall not remove the trade mark from the register if an application is made in the prescribed form and the prescribed fee and surcharge is paid within six months from the expiration of the last registration of the trade mark and shall renew the registration of the trade mark for a period of ten years under sub-section (2).

(4) Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

Old Act S. 25(4).—(4) Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar may, within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of seven years from the expiration of the last registration.

26. Effect of removal from register for failure to pay fee for renewal.—Where a trade mark has been removed from the register for failure to pay the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of another trade mark during one year, next after the date of the removal, be deemed to be a trade mark already on the register, unless the tribunal is satisfied either—

- (a) that there has been no bona fide trade use of the trade mark which has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

CHAPTER IV

EFFECT OF REGISTRATION

27. No action for infringement of unregistered trade mark.—(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.

(2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

CASE LAW ► Remedy for infringement.—The Trade Marks Act, 1999 incorporates specific provisions for the consequence of registration. The remedy of infringement is available upon registration. Under sub-section (1) of Section 27 no person is entitled to institute any proceeding to prevent, or to recover

damages for the infringement of an unregistered trade mark. Sub-section (2), however, saves the right of action for passing off of goods or services and the remedies in respect thereof. Under sub-section (1) of Section 28, the registration of a trade mark, if valid, furnishes to the registered proprietor the exclusive right to the use of the mark "in relation to the goods or services in respect of which the trade mark is registered" and to obtain relief in respect of infringement in the manner provided by the Act, *Kamat Hotels (India) Ltd. v. Royal Orchid Hotels Ltd.*, (2011) 4 Mah LJ 71 Bom).

Section 27(2) is a statutory recognition of the principle that the remedy of passing off lies and is founded in common law. It is not restricted only in relation to goods of a particular nature or quality but across the spectrum of trade and business, *Gorbatschow Wodka Kg v. John Distilleries Ltd.*, (2011) 4 Mah LJ 842 (Bom).

Cause of action for first suit is passing off, cause of action for second suit is infringement. Action for passing off is common law remedy, action for infringement is statutory remedy. Registration of trade mark gives to registered proprietor, exclusive right to use of trade mark and to obtain relief in respect of infringement, *Thalappakatti Naidu Ananda Vilas Biriyani Hotel v. Thalapakattu Briyani and Fast Food*, (2011) 4 CTC 541 (Mad).

► **Grant of injunction.**—Passing-off actions in respects of unregistered trade marks permissible in light of Section 27, Trade Marks Act, 1999. Grant of interim injunction is permissible in case plaintiff can show prima facie case that it was prior user of its mark, and balance of convenience was in its favour, *Dhariwal Industries Ltd. v. M.S.S. Food Products*, (2005) 3 SCC 63.

► **Passing off action, Scope and meaning.**—Passing off action is essentially an action in deceit where common law rule is that no person is entitled to carry on his or her business on pretext that said business is of that of another. Three ingredients of passing off are: (i) goodwill owned by trader, (ii) misrepresentation, and (iii) damage to goodwill. Passing off in common law is considered to be a right for protection of goodwill in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of said misrepresentation, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

28. Rights conferred by registration.—(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of those persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

CASE LAW ▶ Registration with retrospective effect.—The Registrar, Trade Marks, can issue registration certificate under Section 28 of the Trade Marks Act with retrospective effect. But the effect of making the registration certificate applicable from retrospective date is based on the principle of deemed equivalence to public user of such mark. This deeming fiction cannot be extended to the excise law. It is confined to the provisions of the Trade Marks Act, *Meghraj Biscuits Industries Ltd. v. CCE*, (2007) 3 SCC 780.

▶ **Effect of registration.**—Rights of action under Section 27(2) are not affected by Sections 28(3) and 30(1)(d). Therefore, registration of a trade mark would be irrelevant in an action for passing off. Registration of a trade mark in fact does not confer any new right on the proprietor thereof than what already existed at common law without registration of the mark, *Bharat N. Parikh and Rajen A. Kamdar v. Ashok Tripathy*, (2006) 4 LW 842 (Mad) (DB).

▶ **Rights conferred through registration.**—Right to sue for infringement of trade mark accrues only after a trade mark has been registered, proposed registration or application for registration does not confer such a right, *K. Narayanan v. S. Murali*, (2008) 10 SCC 479.

Action for passing off is common law remedy, action for infringement is a statutory remedy. Registration of trade mark gives to registered proprietor, exclusive right to use of trade mark and to obtain relief in respect of infringement, *Thalappakatti Naidu Ananda Vilas Biryani Hotel v. Thalapakattu Biryani and Fast Food*, (2011) 4 CTC 541 (Mad).

So long as the mark continues to be on the register the proprietor is entitled to the benefit of every statutory protection that is available, *Kores (India) Ltd. v. Whale Stationery Products Ltd.*, (2008) 3 Mah LJ 523.

▶ **Purpose of expression "if valid".**—The expression "if valid" has been inserted for the purpose that post registration an aggrieved person is entitled to apply for cancellation under Section 57 of the Act even if no suit is filed alleging infringement of the registered trade mark. In case a suit is instituted, the court, once there is already a pending action seeking cancellation of the trade mark, will stay the suit till the final disposal of the cancellation/rectification proceedings. The court however is still entitled to, in spite of registration, pass any interlocutory order as it deems fit, including but not limited to, granting the injunction or dismissing the prayer for injunction. If no cancellation proceedings are pending as on the date of filing of a suit for infringement if the court is satisfied with regard to the plea of invalidity of registration (this language of Section 124(1)(a)(i) co-relates to the expression "if valid" as occurring in Section 28) then the court may raise an issue in the suit and adjourn the case for three months after framing the issues in order to enable the defendant to apply to the Appellate Board for rectification of the register. Even in the circumstances where the court stays the suit for three months and permits a party to apply for cancellation/rectification, the court can pass any interlocutory order as it thinks fit under sub-section (5) of Section 124. In view of the co-relation between Section 28 and different sub-sections of Section 124, it becomes clear that the entitlement to claim invalidity of registration on the ground of the expression "if valid" as found under Section 28 only arises if the defendant in his written statement in a suit alleging infringement of a registered trade mark takes up the plea with respect to registration of trade mark being "invalid" or has already applied for cancellation of the registered trade mark before the suit alleging infringement is filed, *Marico Ltd. v. Agro Tech Foods Ltd.*, (2010) 174 DLT 279 (Del)(DB).

▶ **Rights of registered user.**—Registration merely recognises rights which are already pre-existing in common law and does not create any new rights. Registration of trade mark, therefore, is no defence to passing off action as Act of 1999 does not bar passing off action. Registered proprietor of trade mark has: (i)

exclusive right to use trade mark, and (ii) to obtain relief in case of infringement of trade mark. However, such a right is not absolute but subject to rights of prior user for passing off that are available to him under common law, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

► **Conflict between two registered owners.**—Between two registered owners of same or similar trade mark, exclusive right to use trade mark is not available to one registrant against the other registered owner (the other registered owner has the same rights against third persons). Hence, plaintiff cannot say that its registered trade mark is infringed only on the ground of registration of its trade mark, when defendant is also enjoying registration of the trade mark and such registration also gives right to defendant to use the same, as provided in Section 28(1), unless plaintiff can establish a superior right at common, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

► **Right of prior user vis-à-vis prior registrant.**—It is to find which proprietor has generated goodwill by way of use of the mark/name in the business. Examination of rights in common law based on goodwill, misrepresentation and damage are independent to that of registered rights. Use of the mark/carrying on business under the name confers rights in favour of the person and generates goodwill in the market. Hence, latter user of the mark/name or in the business cannot misrepresent his business as that of business of prior right holder, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

► **Non-exclusive trade marks.**—Exclusive use of, trade mark, registered with the disclaimer that registration shall not give exclusive right of use, not permitted, *Parakh Vanijiya (P) Ltd. v. Baroma Agro Product*, (2018) 16 SCC 632.

29. Infringement of registered trade marks.—(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

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

is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or
- (c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

Old Act S. 29.—Infringement of trade marks.—(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user thereof using by way of permitted use, uses in the course of a trade mark which is identical with, or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) In an action for infringement of a trade mark registered in Part B of the register an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods in respect of which the trade mark is registered and some person having the right, either as registered proprietor or as registered user, to use the trade mark.

CASE LAW ▶ Aim and object of this provision.—Object of this provision is to protect value and goodwill of trade marks. The expression “without due cause” requires defendant to show that not merely use of infringing mark is in connection with defendant’s services but “with due cause”. Adding one “l” to word “Luxura” and displaying same on bus in same position cannot be said to be “with due cause”.

Section 29(4)(C) enacts that “use of the mark without due cause” takes unfair advantage of or is detrimental to the distinctive character or reputation of the registered trade mark.

Section 11(2) enacts that “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”. In cases where the public are confused into thinking that there is a commercial connection between the suppliers of the goods or services supplied under the earlier trade mark and the mark the subject of the application, then it is to be anticipated that the prohibition will apply. Such confusion as to origin (origin association) is likely to take unfair advantage of and be damaging to the distinctive nature of reputation of the earlier trade mark, *Blue Hill Logistics (P) Ltd. v. Ashok Leyland Ltd.*, (2011) 4 CTC 417 (Mad)(DB).

▶ **Deceptively similar.**—In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character as to prevent one design from being mistaken for the other. It would be enough if the impugned mark bears such an overall similarity, to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him, *Parle Products (P) Ltd. v. J.P. and Co.*, (1972) 1 SCC 618.

30. Limits on effect of registered trade mark.—(1) Nothing in Section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—

- (a) is in accordance with honest practices in industrial or commercial matters, and
 - (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.
- (2) A registered trade mark is not infringed where—
- (a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
 - (b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available or acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;
 - (c) the use by a person of a trade mark—
 - (i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those

goods or a bulk or which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or

- (ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;
- (d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;
- (e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

(3) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of the goods in the market or otherwise dealing in those goods by that person or by a person claiming under or through him is not infringement of a trade by reason only of*—

- (a) the registered trade mark having been assigned by the registered proprietor to some other person, after the acquisition of those goods; or
- (b) the goods having been put on the market under the registered trade mark by the proprietor or with his consent.

(4) Sub-section (3) shall not apply where there exists legitimate reasons for the proprietor to oppose further dealings in the goods in particular, where the condition of the goods, has been changed or impaired after they have been put on the market.

CASE LAW ► Effect of registration.—The registration under one class, in any event, does not extend to goods or services under another class.

* **Ed.:** Should be read as "... not infringement of a trade mark by reason only of" as clarified by the Delhi High Court in *Kapil Wadhwa v. Samsung Electronics Co. Ltd.*, 2012 SCC OnLine Del 5172 in the following terms:

"32. We may highlight that there is an apparent printing error in sub-section (3), even the Gazette Notification issued by the Central Government contains the same. 'Not infringement of a trade by reason only of' should read 'Not infringement of a trade mark by reason only of'. The reason is obvious. After being lawfully acquired by a person of goods bearing a registered trade mark, the further sale may be debatable as infringement of a trade mark, but there can be no further debate whether there is an infringement of a trade."



A suit by a registered proprietor of a trademark against another registered proprietor of the same trademark cannot be declined to be entertained at the threshold because of Section 30(2)(e). Such a suit can lie but may have to be stayed depending upon the defence raised by the defendants that cancellation petition for removal of registered trademark pending before Registrar of Trade Marks, *Singer Co. Ltd. v. Chetan Machine Tools*, ILR (2009) 3 Del 802.

► **Passing off.**—Passing-off action for a mark having goodwill and reputation in jurisdictions other than India, as in the present case for the mark “Prius”, Cannot be successfully maintained in the absence of such mark having sufficient goodwill or reputation in India, *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.*, (2018) 2 SCC 1.

31. Registration to be prima facie evidence of validity.—(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under Section 57), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be *prima facie* evidence of the validity thereof.

(2) In all legal proceedings, as aforesaid a registered trade mark shall not be held to be invalid on the ground that it was not a registrable trade mark under Section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, if it is proved that the trade mark had been so used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

32. Protection of registration on ground of distinctiveness in certain cases.—Where a trade mark is registered in breach of sub-section (1) of Section 9, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration, acquired a distinctive character in relation to the goods or services for which it is registered.

33. Effect of acquiescence.—(1) Where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years in the use of a registered trade mark, being aware of that use, he shall no longer be entitled on the basis of that earlier trade mark—

- (a) to apply for a declaration that the registration of the later trade mark is invalid, or
- (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,

unless the registration of the later trade mark was not applied in good faith.

(2) Where sub-section (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark, or as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark may no longer be invoked against his later trade mark.

34. Saving for vested rights.—Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to

goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior—

- (a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or
- (b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;

whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

CASE LAW ► Scope.—Where a mark is registered without opposition from a party filing an action for passing off, the order of the Registrar does not and cannot affect the party nor bind the court from considering the question of passing off. To hold otherwise would be contrary to the provisions of the Act. It would render Section 34 redundant. Section 34 can be availed of in an application for registration as well as a defence to an infringement action, *Hindustan Unilever Ltd. v. Ashique Chemicals*, (2011) 5 Mah LJ 836 (Bom).

Section 34 provides for saving of vested rights in a registered trademark, even though the Defendant has not taken any step to challenge registration by Plaintiff, *Wheels India v. S. Nirmal Singh*, ILR (2010) 2 Del 252.

► **Overriding provision.**—Section 34 of the Trade Marks Act carves out an exception and creates an overriding provision which within the sphere of its operation prevents a proprietor or registered user of a registered trade mark from interfering with the use of an identical trade mark or a mark which nearly resembles the registered mark. Section 34 in consequence provides for a defeasance of the statutory entitlement which flows from the registration of a trade mark. Before such a consequence ensues the conditions which Parliament has enacted must be fulfilled. The most fundamental requirement is fourfold. Firstly, the use by a person of a mark which is identical to or nearly resembles a registered trade mark must be in relation to those goods and services for which the first mentioned mark has been registered. Secondly, the use that is postulated by Section 34 is a continuous use of the trade mark. Thirdly, in order to avail of the protection the trade mark must be used by the proprietor or by his predecessor-in-interest. Fourthly, the mark in respect of which protection is sought must have been used from a date prior to the use of the registered trade mark or the date of registration of the registered trade mark whichever is earlier. Section 34 thus provides for specific requirements which relate to, (i) the nature of the goods or services in relation to which the mark is used; (ii) the nature and character of use; (iii) the person who must use; and (iv) the date from which the mark should have been used, *Kamat Hotels (India) Ltd. v. Royal Orchid Hotels Ltd*, (2011) 4 Mah LJ 71 (Bom).

► **Expression “date of registration”.**—The expression “date of registration” in Section 34(b) must mean the date of the application for registration for, that is, the date to which the registration, when granted, will relate, *Drums Food International (P) Ltd. v. Euro Ice Cream.*, (2011) 5 Mah LJ 166 (Bom).

► **Defence of Pendency of Rectification.**—Pendency of Rectification Proceedings under Section 124 cannot be a valid defence for the infringement action initiated by the proprietor of the trade mark and for obtaining an order of interim injunction, *Nakoda Dairy (P) Ltd. v. Kewal Chand Vinod Kumar*, (2009) 3 LW 221 (Mad).

► **Advertisement.**—Mere issuance of advertisement does not constitute prior user. The advertisement must be concurrent with placing of goods in market, *Pioneer Nuts and Bolts (P) Ltd. v. Goodwill Enterprises*, ILR (2010) 1 Del 738 (DB).

► **Passing off action.**—Passing off right, held, is a broader remedy for it being based on the common law principle which offers protection against exploitation of business goodwill which is attached to both registered and unregistered trade marks, *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

► **Prior registration and prior user.**—Prior user's rights will override those of a subsequent user even though subsequent user had been accorded registration of its trade mark. Proprietor of a trade mark does not have the right to prevent use by another party of an identical or similar mark where that user commenced prior to the user or prior to date of registration of proprietor. Such user gets rights when its user is prior to the user of registered proprietor or prior to the date of registration of the proprietor, whichever is earlier, *Neon Laboratories Ltd. v. Medical Technologies Ltd.*, (2016) 2 SCC 672 : (2016) 2 SCC (Civ) 190.

► **Rights of prior user vis-à-vis prior registrant of trade mark.**—Registered proprietor of trade mark has right to use said trade mark to the exclusion of others but the same is subject to right of prior user of trade mark under common law. Thus, prior user has superior right over registered owner. Further held, in case of conflict between two registered proprietors, evaluation of better rights in common law is essential to enable court to determine whose rights are better and superior in common law which have been recognised in the form of registration. Owner of registered trade mark has right to use said trade mark to the exclusion of others but such right is subject to common law remedies available under passing off action. Registration merely recognises rights which are already pre-existing in common law and does not create any new rights. Registration of trade mark, therefore, is no defence to passing off action as Act of 1999 does not bar passing off action. However, between two registered owners of same or similar trade mark, exclusive right to use trade mark is not available to one registrant against the other registered owner (the other registered owner has the same rights against third persons). Hence, plaintiff cannot say that its registered trade mark is infringed only on the ground of registration of its trade mark, when defendant is also enjoying registration of the trade mark and such registration also gives right to defendant to use the same, as provided in Section 28(1), *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 SCC 683 : (2016) 2 SCC (Civ) 201.

► **Hoarding of a trade mark.**—Hoarding of or appropriation, without utilisation of a trade mark is not permitted. Mere registration of a trade mark does not vest permanent right on owner of said trade mark. Such a right is lost if it is not exercised within a reasonable time, *Neon Laboratories Ltd. v. Medical Technologies Ltd.*, (2016) 2 SCC 672 : (2016) 2 SCC (Civ) 190.

35. Saving for use of name, address or description of goods or services.—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods or services.

CASE LAW ► Distinctiveness.—The word "Goenka" being a common surname per se is not distinctive and to acquire distinctiveness in such a common surname is not possible. Defence under Section 35 of Act will only apply to a full name and that also by a natural person and not by a legal entity which can choose

a separate name. Also once distinctiveness is achieved or secondary meaning acquired with respect to a surname then another person cannot use that surname for an artificial person or entity, *Goenka Institute of Education and Research v. Anjani Kumar Goenka*, ILR (2009) 6 Del 415 (DB).

► **Low absorb technology.**—Expression “low absorb technology” in relation to edible oil product amounts to passing off the goods which uses the unregistered trade mark “low absorb”, *Marico Ltd. v. Agro Tech Foods Ltd.*, (2010) 174 DLT 279 (Del) (DB).

36. Saving for words used as name or description of an article or substance or service.—(1) The registration of a trade mark shall not be deemed to have become invalid by reason only of any use after the date of the registration of any word or words which the trade mark contains or of which it consists as the name or description of an article or substance or service:

Provided that, if it is proved either—

- (a) that there is a well-known and established use of the said word as the name or description of the article or substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) in relation to goods or services certified by the proprietor; or
- (b) that the article or substance was formerly manufactured under a patent that a period of two years or more after the cesser of the patent has elapsed and that the said word is the only practicable name or description of the article or substance,

the provisions of sub-section (2) shall apply.

(2) Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then,—

- (a) for the purposes of any proceedings under Section 57 if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, or of the services or of any services of the same description, as the case requires, shall be deemed to be an entry wrongly remaining on the register;
- (b) for the purposes of any other legal proceedings relating to the trade mark,—
 - (i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark; or
 - (ii) if the trade mark contains such words and other matter, all such right of the proprietor to the use of such words,

in relation to the article or substance or to any goods of the same description, or to the service or to any services of the same description, as the case requires, shall be deemed to have ceased on the date on which the use mentioned in clause (a)

of the proviso to sub-section (1) first became well known and established or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

Old Act S. 35(2).—Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then—

(a) for the purposes of any proceedings under Section 56—

- (i) if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed to be an entry wrongly remaining on the register;
- (ii) if the trade mark contains such words and other matter, the tribunal in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any exclusive right to the use in relation to that article or substance and any goods of the same description, of such words:

Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made;

(b) for the purposes of any other legal proceeding relating to the trade mark,—

- (i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark in relation to the article or substance in question or to any goods of the same description; or
- (ii) if the trade mark contains such words and other matter, all such rights of the proprietor to the use of such words, in such relation as aforesaid;

shall be deemed to have ceased on the date at which the use mentioned in clause (a) of the proviso to sub-section (1), first became well known and established, or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

¹³[CHAPTER IV-A

SPECIAL PROVISIONS RELATING TO PROTECTION OF TRADE MARKS THROUGH INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL

36-A. Application of Act in case of international registration under Madrid Protocol.—The provisions of this chapter shall apply to international applications and international registrations under the Madrid Protocol.

36-B. Definitions.—In this chapter, unless the context otherwise requires,—

- (a) “application”, in relation to a Contracting State or a Contracting Organisation, means an application made by a person who is a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organisation, as the case may be.

Explanation.—For the purposes of this clause, “real and effective industrial or commercial establishment” means and includes any establishment where some bona fide industrial or commercial activity takes place and need not necessarily be the principal place of business;

13. Chapter IV-A ins. by Act 40 of 2010, S. 5 (w.e.f. 8-7-2013).

- (b) "basic application" means an application for the registration of a trade mark filed under Section 18 and which is used as a basis for applying for an international registration;
- (c) "basic registration" means the registration of a trade mark under Section 23 and which is used as a basis for applying for an international registration;
- (d) "common regulations" means the regulations concerning the implementation of the Madrid Protocol;
- (e) "contracting organisation" means a Contracting Party that is an inter-governmental organisation;
- (f) "contracting party" means a Contracting State or Contracting Organisation party to the Madrid Protocol;
- (g) "contracting state" means a country party to the Madrid Protocol;
- (h) "international application" means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;
- (i) "international bureau" means the International Bureau of the World Intellectual Property Organisation;
- (j) "international registration" means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;
- (k) "Madrid Agreement" means the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on the 14th day of April, 1891, as subsequently revised and amended;
- (l) "Madrid Protocol" means the Protocol relating to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time.

36-C. Trade Marks Registry to deal with international applications.—Notwithstanding anything contained in sub-section (3) of Section 5, an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.

36-D. International application originating from India.—(1) Where an application for the registration of a trade mark has been made under Section 18 or a trade mark has been registered under Section 23, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

(2) A person holding an international registration may make an international application on the form prescribed by the Common Regulations for extension of the protection resulting from such registration to any other Contracting Party.

(3) An international application under sub-section (1) or sub-section (2) shall designate the Contracting Parties where the protection resulting from the international registration is required.

(4) The Registrar shall certify in the prescribed manner that the particulars appearing in the international application corresponding to the particulars appearing, at the time of the certification, in the application under Section 18 or the registration under Section 23, and shall indicate the date and number of that application or the date and number of that registration as well as the date and number of the application from which that registration resulted, as the case may be, and shall within the prescribed period, forward the international application to the International Bureau for Registration, also indicating the date of the international application.

(5) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the application under Section 18 or the registration under Section 23, as the case may be, has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration shall cease to have effect:

Provided that where an appeal is made against the decision of registration and an action requesting for withdrawal of application or an opposition to the application has been initiated before the expiry of the period of five years of an international registration, any final decision resulting into withdrawal, cancellation, expiration or refusal shall be deemed to have taken place before the expiry of five years of the international registration.

(6) The Registrar shall, during the period of five years beginning with the date of international registration, transmit to the International Bureau every information referred to in sub-section (5).

(7) The Registrar shall notify the International Bureau the cancellation to be effected to an international registration keeping in view the current status of the basic application or the basic registration, as the case may be.

36-E. International registrations where India has been designated.—(1) The Registrar shall, after receipt of an advice from the International Bureau about any international registration where India has been designated, keep a record of the particulars of that international registration in the prescribed manner.

(2) Where, after recording the particulars of any international registration referred to in sub-section (1), the Registrar is satisfied that in the circumstances of the case the protection of trade mark in India should not be granted or such protection should be granted subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the international registration has been accepted, he may, after hearing the applicant if he so desires, refuse grant of protection and inform the International Bureau in the prescribed manner within eighteen months from the date on which the advice referred to in sub-section (1) was received.

(3) Where the Registrar finds nothing in the particulars of an international registration to refuse grant of protection under sub-section (2), he shall within

the prescribed period cause such international registration to be advertised in the prescribed manner.

(4) The provisions of Sections 9 to 21 (both inclusive), 63 and 74 shall apply *mutatis mutandis* in relation to an international registration as if such international registration was an application for registration of a trade mark under Section 18.

(5) When the protection of an international registration has not been opposed and the time for notice of oppositions has expired, the Registrar shall within a period of eighteen months of the receipt of advice under sub-section (1) notify the International Bureau its acceptance of extension of protection of the trade mark under such international registration and, in case the Registrar fails to notify the International Bureau, it shall be deemed that the protection has been extended to the trade mark.

(6) Where a registered proprietor of a trade mark makes an international registration of that trade mark and designates India, the international registration from the date of the registration shall be deemed to replace the registration held in India without prejudice to any right acquired under such previously held registration and the Registrar shall, upon request by the applicant, make necessary entry in the register referred to in sub-section (1) of Section 6.

(7) A holder of international registration of a trade mark who designates India and who has not been extended protection in India shall have the same remedy which is available to any person making an application for the registration of a trade mark under Section 18 and which has not resulted in registration under Section 23.

(8) Where at any time before the expiry of a period of five years of an international registration, whether such registration has been transferred to another person or not, the related basic application or, as the case may be, the basic registration in a Contracting Party other than India has been withdrawn or cancelled or has expired or has been finally refused in respect of all or some of the goods or services listed in the international registration, the protection resulting from such international registration in India shall cease to have effect.

36-F. Effects of international registration.—(1) From the date of the international registration of a trade mark where India has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trade mark to India, the protection of the trade mark in India shall be the same as if the trade mark had been registered in India.

(2) The indication of classes of goods and services given by the applicant shall not bind the Registrar with regard to the determination of the scope of the protection of the trade mark.

36-G. Duration and renewal of international registration.—(1) The international registration of a trade mark at the International Bureau shall be for a period of ten years and may be renewed for a period of ten years from the expiry of the preceding period.

(2) Subject to payment of a surcharge prescribed by the rules, a grace period of six months shall be allowed for renewal of the international registration.]

CHAPTER V ASSIGNMENT AND TRANSMISSION

37. Power of registered proprietor to assign and give receipts.—The person for the time being entered in the register as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment.

38. Assignability and transmissibility of registered trade marks.—Notwithstanding anything in any other law to the contrary, a registered trade mark shall, subject to the provisions of this Chapter, be assignable and transmissible, whether with or without the goodwill of the business concerned and in respect either of all the goods or services in respect of which the trade mark is registered or of some only of those goods or services.

CASE LAW ▶ Transmissibility of trade mark.—Traditionally, a trade mark has always been considered a vital and inseparable part of the goodwill of the business. In fact, the sale of a trade mark without the sale of the goodwill to the same buyer is considered null and void. However, the trade mark can be assigned with or without the goodwill of business though subject to certain conditions, *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel*, (2006) 8 SCC 726.

▶ **Entitlement to exemption under Notification No. 1/93 dated 28-2-1993.**—One of the conditions in the exemption notification provided that exemption would not apply to the specified goods, bearing a brand name or trade name (registered or not) of another person. Assessee was using the brand name of a foreign company, which had assigned the trade mark in its favour under an agreement with right to use the trade mark in India exclusively. It was held, because of the assignment, the assessee was using the trade mark in its own right as its own trade mark and therefore, it could not be said that it was using the trade mark of "another person". Assessee held entitled to avail the benefit of exemption notification, *CCE v. Otto Bilz (India) (P) Ltd.*, (2016) 13 SCC 559.

39. Assignability and transmissibility of unregistered trade marks.—An unregistered trade mark may be assigned or transmitted with or without the goodwill of the business concerned.

Old Act S. 38.—Assignability and transmissibility of unregistered trade marks.—(1) An unregistered trade mark shall not be assignable or transmissible except along with the goodwill of the business concerned.

(2) Notwithstanding anything contained in sub-section (1), an unregistered trade mark may be assigned or transmitted otherwise than along with the goodwill of the business concerned if—

- (a) at the time of assignment or transmission of the unregistered trade mark, it is used in the same business as a registered trade mark; and
- (b) the registered trade mark is assigned or transmitted at the same time and to the same person as the unregistered trade mark; and

- (c) the unregistered trade mark relates to goods in respect of which the registered trade mark is assigned or transmitted.

40. Restriction on assignment or transmission where multiple exclusive rights would be created.—(1) Notwithstanding anything in Sections 38 and 39, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to—

- (a) same goods or services;
- (b) same description of goods or services;
- (c) goods or services or description of goods or services which are associated with each other,

of trade marks nearly resembling each other or of identical trade mark, if having regard to the similarity of the goods and services and to the similarity of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion:

Provided that an assignment or transmission shall not be deemed to be invalid under this sub-section if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within India otherwise than for export therefrom, or in relation to goods to be exported to the same market outside India or in relation to services for use at any place in India or any place outside India in relation to services available for acceptance in India.

Old Act S. 39(1).—Restrictions on assignment or transmission where multiple exclusive rights would be created.—Notwithstanding anything in Section 37 and Section 38, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks if having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion:

Provided that an assignment or transmission shall not be deemed to be invalid under this sub-section if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within India otherwise than for export therefrom, or in relation to goods to be exported to the same market outside India.

(2) The proprietor of a registered trade mark who proposes to assign it may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods or services and of the trade marks referred to in the case, the proposed assignment would or would not be invalid under sub-section (1), and a certificate so issued shall, subject to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under sub-section (1) of the assignment in so far

as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under Section 45 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

41. Restriction on assignment or transmission when exclusive rights would be created in different parts of India.—Notwithstanding anything in Sections 38 and 39, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law—

- (a) an exclusive right in one of the persons concerned, to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in, in any place in India, or in relation to services for use, or services available for acceptance in any place in India; and
- (b) an exclusive right in another of these persons concerned, to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to—
 - (i) the same goods or services; or
 - (ii) the same description of goods or services; or
 - (iii) services which are associated with those goods or goods of that description or goods which are associated with those services or services of that description,

limited to use in relation to goods to be sold or otherwise traded in, or services for use, or available for acceptance, in any other place in India:

Old Act S. 40.—Restrictions on assignment or transmission when exclusive rights would be created in different parts of India.—Notwithstanding anything in Section 37 and Section 38, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in any place in India and an exclusive right in another of these persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in any other place in India:

Provided that in any such case, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or by a person who claims that a registered trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest may approve the assignment or transmission, and an assignment or transmission so approved shall not, unless it is shown that the approval was obtained by fraud or misrepresentation, be deemed to be invalid under this section or Section 40 if application for the registration under Section 45 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

42. Conditions for assignment otherwise than in connection with the goodwill of a business.—Where an assignment of a trade mark, whether registered or unregistered is made otherwise than in connection with the goodwill of the business in which the mark has been or is used, the assignment shall not take effect unless the assignee, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, not exceeding three months in the aggregate, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment, and advertises it in such form and manner and within such period as the Registrar may direct.

Explanation.—For the purposes of this section, an assignment of a trade mark of the following description shall not be deemed to be an assignment made otherwise than in connection with the goodwill of the business in which the mark is used, namely:—

- (a) an assignment of a trade mark in respect only of some of the goods or services for which the trade mark is registered accompanied by the transfer of the goodwill of the business concerned in those goods or services only; or
- (b) an assignment of a trade mark which is used in relation to goods exported from India or in relation to services for use outside India if the assignment is accompanied by the transfer of the goodwill of the export business only.

43. Assignability and transmissibility of certification trade marks.—A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Registrar, for which application shall be made in writing in the prescribed manner.

44. Assignability and transmissibility or associated trade marks.—Associated trade marks shall be assignable and transmissible only as a whole and not separately, but, subject to the provisions of this Act, they shall, for all other purposes, be deemed to have been registered as separate trade marks.

¹⁴**[45. Registration of assignments and transmissions.**—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall

14. Subs. by Act 40 of 2010, S. 6 (w.e.f. 8-7-2013). Prior to substitution it read as:

“45. *Registration of assignments and transmissions.*—(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register:

Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court.

(2) Except for the purpose of an application before the Registrar under sub-section (1) or an appeal from an order thereon, or an application under Section 57 or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the register in accordance with sub-section (1), shall not be admitted in evidence by the Registrar or the Appellate Board or any court in proof of title to the trade mark by assignment or transmission unless the Registrar or the Appellate Board or the court, as the case may be, otherwise directs.”.

apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of such assignment or transmission to be entered on the register.

(2) The Registrar may require the applicant to furnish evidence or further evidence in proof of title only where there is a reasonable doubt about the veracity of any statement or any document furnished.

(3) Where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court and in all other cases the Registrar shall dispose of the application within the prescribed period.

(4) Until an application under sub-section (1) has been filed, the assignment or transmission shall be ineffective against a person acquiring a conflicting interest in or under the registered trade mark without the knowledge of assignment or transmission.]

CASE LAW ► Assignment of trade mark.—Title of mark exists in assignee even before registration. A dispute about assignment can be raised by the assignor or by a person claiming prior assignment. Dispute cannot be raised by stranger or persons claiming adversely to assignor, *Sun Pharmaceuticals Industries Ltd. v. Cipla Ltd.*, (2009) 108 DRJ 207.

CHAPTER VI

USE OF TRADE MARKS AND REGISTERED USERS

46. Proposed use of trade mark by company to be formed, etc.—(1) No application for the registration of a trade mark in respect of any goods or services shall be refused nor shall permission for such registration be withheld, on the ground only that it appears that the application does not use or propose to use the trade mark if the Registrar is satisfied that—

- (a) a company is about to be formed and registered under the Companies Act, 1956 (1 of 1956) and that the applicant intends to assign the trade mark to that company with a view to the use thereof in relation to those goods or services by the company, or
- (b) the proprietor intends it to be used by a person, as a registered user after the registration of the trade mark.

(2) The provisions of Section 47 shall have effect, in relation to a trade mark registered under the powers conferred by this sub-section, as if for the reference, in clause (a) of sub-section (1) of that section, to the intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to the intention on his part that it should be used by the company or registered user concerned.

(3) The tribunal may, in a case to which sub-section (1) applies, require the applicant to give security for the costs of any proceedings relating to any opposition

or appeal, and in default of such security being duly given, may treat the application as abandoned.

(4) Where in a case to which sub-section (1) applies, a trade mark in respect of any goods or services is registered in the name of an applicant who, relies on intention to assign the trade mark to a company, then, unless within such period as may be prescribed or within such further period not exceeding six months as the Registrar may, on application being made to him in the prescribed manner, allow, the company has been registered as the proprietor of the trade mark in respect of those goods or services, the registration shall cease to have effect in respect thereof at the expiration of that period and the Registrar shall amend the register accordingly.

Old Act S. 45(1).—Proposed use of trade mark by company to be formed.—No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark, if the Registrar is satisfied that a company is about to be formed and registered under the Companies Act, 1956 (1 of 1956), and that the applicant intends to assign the trade mark to that company with a view to the use thereof in relation to those goods by the company.

47. Removal from register and imposition of limitations on ground of non-use.—(1) A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either—

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of Section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or
- (b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being:

Provided that except where the applicant has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of the goods or services in question, or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application under clause (a) or clause (b) in relation to any goods or services, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to—

- (i) goods or services of the same description; or
- (ii) goods or services associated with those goods or services of that description being goods or services, as the case may be, in respect of which the trade mark is registered.

Old Act S. 46(1).—Removal from register and imposition of limitations on ground of non-use.—Subject to the provisions of Section 47, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved on the ground either—

- (a) that the trade mark was registered without any *bona fide* intention on the part of the applicant for registration that it should be used in relation to those goods by him or, in a case to which the provisions of Section 45 apply, by the company concerned, and that there has, in fact, been no *bona fide* use of the trade mark in relation to those goods by any proprietor thereof for the time being up to a date one month before the date of the application; or
- (b) that up to a date one month before the date of application, a continuous period of five years or longer had elapsed during which the trade mark was registered and during which there was no *bona fide* use thereof in relation to those goods by any proprietor thereof for the time being:

Provided that, except where the applicant has been permitted under sub-section (3) of Section 12 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application under clause (a) or clause (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, *bona fide* use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods or services in respect of which a trade mark is registered—

- (a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; or in relation to services for use or available for acceptance in a particular place in India or for use in a particular market outside India; and
- (b) a person has been permitted under Section 12 to register an identical or nearly resembling trade mark in respect of those goods, under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or in relation to services for use or available for acceptance in that place or for use in that country, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark,

on application by that person in the prescribed manner to the Appellate Board or to the Registrar, the tribunal may impose on the registration of the first-mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub-section (1) or for the purposes of sub-section (2) on any non-use of a trade

mark which is shown to have been due to special circumstances in the trade, which includes restrictions 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 the goods or services to which the application relates.

CASE LAW ▶ Rationale for.—Intention is a state of mind. Court can deduce the existence of a particular state of mind from the facts of a case. It can look at events prior to the relevant date viz. the date of the application for registration as well as at the events subsequent thereto for ascertaining the intention. However, whether subsequent events are relevant or not would depend upon the facts and circumstances of each case and the question at issue therein. Where a trade mark is proposed to be used, the manufacture and marketing of goods in relation to which such trade mark is proposed to be used must of necessity take time; and not to look at the subsequent events would result in great injustice, *American Home Products Corp. v. Mac Laboratories (P) Ltd.*, (1986) 1 SCC 465.

▶ **"Person aggrieved".**—The expression "person aggrieved" has been liberally construed in trade mark law except for trade mark merely consisting of a name, *Kabushiki Kaisha Toshiba (Toshiba Corp.) v. Toshiba Appliances Co.*, (2006) 1 CHN 487.

▶ **Validity of the registration of the trade mark.**—In a case where the issue of invalidity is raised or arises independent of a suit, the prescribed statutory authority will be the sole authority to deal with the matter. However, in a situation where a suit, inter alia, raising the issue of validity of the trade mark is pending (whether instituted before or after the filing of a rectification application) the exercise of jurisdiction by the prescribed statutory authority is contingent on a finding of the civil court as regards the prima facie tenability of the plea of invalidity, *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*, (2018) 2 SCC 112.

▶ **Jurisdiction of civil court.**—All issues relating to and connected with the validity of registration have to be dealt with by the Tribunal and not by the civil court. Once an issue connected with the validity of registration is framed by the civil court, the matter will have to go to the Tribunal and the decision of the Tribunal will thereafter bind the civil court, *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*, (2018) 2 SCC 112.

48. Registered users.—(1) Subject to the provisions of Section 49, a person other than the registered proprietor of a trade mark may be registered as a registered user thereof in respect of any or all of the goods or services in respect of which the trade mark is registered.

Old Act S. 48(1).—Registered users.—Subject to the provisions of Section 49, a person other than the registered proprietor of a trade mark may be registered as the registered user thereof in respect of any or all of the goods in respect of which the trade mark is registered otherwise than as a defensive trade mark; but the Central Government may, by rules made in this behalf, provide that no application for registration as such shall be entertained unless the agreement between the parties complies with the conditions laid down in the rules for preventing trafficking in trade marks.

(2) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used 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.

CASE LAW ▶ Grant of licence to registered user.—Use of a registered trade mark can be permitted to a registered user in accordance with provisions of the Act and for that purpose the registered proprietor has to enter into an agreement with the proposed registered user. The use of the trade mark can also be

permitted de hors the provisions of the Act by grant of licence by the registered proprietor to the proposed user. Such a licence is governed by common law. Such licensing of trade mark is permissible provided (i) the licensing does not result in causing confusion or deception among the public; (ii) it does not destroy the distinctiveness of the trade mark, that is to say, the trade mark, before the public eye, continues to distinguish the goods connected with the proprietor of the mark from those connected with others; and (iii) a connection in the course of trade consistent with the definition of trade mark continues to exist between the goods and the proprietor of the mark, *Gujarat Bottling Co. Ltd. v. Coca Cola Co.*, (1995) 5 SCC 545.

► **Terms of licence.**—A common law licence cannot result in dilution of the trade mark. A licence has to be interpreted to prevent the mischief which is deceptive since trafficking in trade marks is not permitted, *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel*, (2006) 8 SCC 726.

► **Use by permissive user.**—Once a licence or permissive user arrangement is terminated, unless the erstwhile licence can set up another permission, or authorization (for use) by the trade mark owner, estoppel operates against the permissive user, *Marie Stopes Int. v. Parivar Seva Sanstha*, (2010) 169 DLT 414 (Del).

49. Registration as registered user.—(1) Where it is proposed that a person should be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall jointly apply in writing to the Registrar in the prescribed manner, and every such application shall be accompanied by—

- (a) the agreement in writing or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark; and
- (b) an affidavit made by the registered proprietor or by some person authorised to the satisfaction of the Registrar to act on his behalf,—
 - (i) giving particulars of the relationship, existing or proposed, between the registered proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
 - (ii) stating the goods or services in respect of which registration is proposed;
 - (iii) stating the conditions or restrictions, if any, proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter;
 - (iv) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof; and
- (c) such further documents or other evidence as may be required by the Registrar or as may be prescribed.

(2) When the requirements of sub-section (1) have been complied with, the Registrar shall register the proposed registered user in respect of the goods or services as to which he is so satisfied.

Old Act S. 49(2).—When the requirements of sub-section (1) have been complied with to his satisfaction, the Registrar shall forward the application together with his report and all the relevant documents to the Central Government.

(3) The Registrar shall issue notice in the prescribed manner of the registration of a person as a registered user, to other registered users of the trade mark, if any.

(4) The Registrar shall, if so requested by the applicant, take steps for securing that information given for the purposes of an application under this section (other than matters entered in the register) is not disclosed to rivals in trade.

Old Act S. 49(5).—The Central Government and the Registrar shall, if so requested by the applicant, take steps for securing that information given for the purposes of an application under this section (other than matters entered in the register) is not disclosed to rivals in trade.

50. Power of Registrar for variation or cancellation of registration as registered user.—(1) Without prejudice to the provisions of Section 57, the registration of a person as registered user—

- (a) may be varied by the Registrar as regards the goods or services in respect of which it has effect on the application in writing in the prescribed manner of the registered proprietor of the trade mark;
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark;
- (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, namely:—
 - (i) 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;
 - (ii) 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;
 - (iii) that the circumstances have changed since the date of registration in such a way that at the date of such application for cancellation they would not have justified registration of the registered user;
 - (iv) 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;
- (d) may be cancelled by the Registrar on his own motion or on the application in writing in the prescribed manner by any person, on the ground that 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;

(e) may be cancelled by the Registrar in respect of any goods or services in relation to which the trade mark is no longer registered.

(2) The Registrar shall issue notice in the prescribed manner in respect of every application under this section to the registered proprietor and each registered user (not being the applicant) of the trade mark.

Old Act S. 52(2).—The Registrar shall, before varying any registration under clause (a) of sub-section (1) or cancelling any registration on any of the grounds mentioned in sub-clause (ii) or sub-clause (iii) or sub-clause (iv) of clause (c) of that sub-section, forward the application made in that behalf for the consideration of the Central Government, and the Central Government may, after making such inquiry as it thinks fit, issue such directions to the Registrar as it thinks fit, and the Registrar shall dispose of the application in accordance with such directions.

(3) The procedure for cancelling a registration shall be such as may be prescribed:

Provided that before cancelling of registration, the registered proprietor shall be given a reasonable opportunity of being heard.

Old Act S. 52(3).—The Registrar shall issue notice in the prescribed manner of every application under this section to the registered proprietor and each registered user (not being the applicant) of the trade mark.

51. Power of Registrar to call for information relating to agreement in respect of registered users.—(1) The Registrar may, at any time during the continuance of the registration of the registered user, by notice in writing, require the registered proprietor to confirm to him within one month that the agreement filed under clause (a) of sub-section (1) of Section 49 continues to be in force.

(2) If the registered proprietor fails to furnish the confirmation within one month as required under sub-section (1), the registered user shall cease to be the registered user on the day immediately after the expiry of the said period and the Registrar shall notify the same.

52. Right of registered user to take proceedings against infringement.—(1) Subject to any agreement subsisting between the parties, a registered user may institute proceedings for infringement in his own name as if he were the registered proprietor, making the registered proprietor a defendant and the rights and obligations of such registered user in such case being concurrent with those of the registered proprietor.

(2) Notwithstanding anything contained in any other law, a registered proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

53. No right of permitted user to take proceeding against infringement.—A person referred to in sub-clause (ii) of clause (r) of sub-section (1) of Section 2 shall have no right to institute any proceeding for any infringement.

54. Registered user not to have right of assignment or transmission.—Nothing in this Act shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

Explanation I.—The right of a registered user of a trade mark shall not be deemed to have been assigned or transmitted within the meaning of this section in the following cases, namely:—

- (a) where the registered user being an individual enters into a partnership with any other person for carrying on the business concerned; but in any such case the firm may use the trade mark, if otherwise in force, only for so long as the registered user is a member of the firm;
- (b) where the registered user being a firm subsequently undergoes a change in its constitution; but in any such case the reconstituted firm may use the trade mark, if otherwise in force, only for 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.

Explanation II.—For the purposes of *Explanation I*, “firm” has the same meaning as in the Indian Partnership Act, 1932 (9 of 1932).

55. Use of one of associated or substantially identical trade marks equivalent to use of another.—(1) Where under the provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and, so far as it shall think right, accept use of a registered associated trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall, for the purpose of this Act, be deemed to be also use of any trade mark being a part thereof and registered in accordance with sub-section (1) of Section 15 in the name of the same proprietor.

(3) Notwithstanding anything in Section 32, the use of part of the registered trade mark in sub-section (2) shall not be conclusive as to its evidence of distinctiveness for any purpose under this Act.

CASE LAW ► Applicability.—Section 55 confers the discretion contained therein upon the Tribunal. It does not apply to a court and would only apply to proceedings before the Tribunal i.e. the Registrar or the Appellate Board, *Hindustan Unilever Ltd. v. Ashique Chemicals*, (2011) 5 Mah LJ 836 (Bom).

56. Use of trade mark for export trade and use when form of trade connection changes.—(1) The application in India of trade mark to goods to be exported from India or in relation to services for use outside India and any other act done in India in relation to goods to be so exported or services so rendered outside India which, if done in relation to goods to be sold or services provided or otherwise traded in within India would constitute use of trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods or services for any purpose for which such use is material under this Act or any other law.

(2) The use of a registered trade mark in relation to goods or services between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods or services

between which and the said person or a predecessor in title of that person a different form of connection in the course of trade subsisted or subsists.

CHAPTER VII

RECTIFICATION AND CORRECTION OF THE REGISTER

57. Power to cancel or vary registration and to rectify the register.—(1) On application made in the prescribed manner to the Appellate Board or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of 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, may apply in the prescribed manner to the Appellate Board or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.

(3) The tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).

(5) Any order of the Appellate Board rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

Old Act S. 56(5).—Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

CASE LAW ► Jurisdiction of Registrar.—Suo motu power of rectification of register under Section 57(4) can only be exercised by Registrar of Trade Marks himself being one of the authorities who are "tribunal" as per Section 2(1)(ze) r/w Section 3, and as there is only one such Registrar for the entire country having registered office in Bombay assisted by Assistant Registrars in other parts of the country, including Delhi, *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board*, (2016) 4 SCC 381 : (2016) 2 SCC (Civ) 606.

Suo motu power of Registrar to rectify register, held, not affected or curtailed by Section 125. Reasons for, explained. Position contrasted with position that had obtained under Sections 107/47 of the Trade and Merchandise Marks Act, 1958, *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board*, (2016) 4 SCC 381 : (2016) 2 SCC (Civ) 606.

► Cancellation of registration.—When registration cancelled due to a clerical error on the part of the Trade Marks Registry in the details of the published application and not as a result of any decision of the rights of the plaintiff in the impugned mark, injunction cannot be vacated, *Chartered Financial Analysis Institute v. Institute of Chartered Financial Analysts of India*, (2010) 169 DLT 691 (Del).

► **Rectification of register.**—The power of registrar to rectify the register is wide and discretionary jurisdiction, and, in a given case, he may refuse to exercise it. Although the discretionary jurisdiction of a statutory authority has to be considered on objective criteria, delay in filing of rectification application leading to acquiescence or waiver or abandonment is not totally irrelevant, *Khoday Distilleries Limited v. Scotch Whisky Association*, (2008) 10 SCC 723.

58. Correction of register.—(1) The Registrar may, on application made in the prescribed manner by the registered proprietor,—

- (a) correct 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) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or classes of goods or services from those in respect of which a trade mark is registered,

and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

(2) The Registrar may, on application made in the prescribed manner by a registered user of a trade mark, and after notice to the registered proprietor, correct any error, or enter any change, in the name, address or description of the registered user.

59. Alteration of registered trade marks.—(1) The registered proprietor of a trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted under this section, the trade mark as altered shall be advertised in the prescribed manner, unless the application has already been advertised under sub-section (2).

60. Adaptation of entries in register to amended or substituted classification of goods or services.—(1) The Registrar shall not make any amendment of the register which would have the effect of adding any goods or classes of goods or services to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made or of antedating the registration of a trade mark in respect of any goods or services:

Provided that this sub-section, shall not apply when the Registrar is satisfied that compliance therewith would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods or services and would not substantially prejudice the rights of any person.

Old Act S. 59(1).—Adaptation of entries in register to amended or substituted classification of goods.—The Registrar shall not, in exercise of any power conferred on him by rules made with reference to clause (a) of sub-section (2) of Section 133, make any amendment of the register which would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made or of antedating the registration of a trade mark in respect of any goods:

Provided that this sub-section shall not apply when the Registrar is satisfied that compliance therewith would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(2) A proposal so to amend the register shall be brought to the notice of the registered proprietor of the trade mark affected and advertised in the prescribed manner, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1).

CHAPTER VIII COLLECTIVE MARKS

61. Special provisions for collective marks.—(1) The provisions of this Act shall apply to collective marks subject to the provisions contained in this Chapter.

(2) In relation to a collective mark the reference in clause (zb) of sub-section (1) of Section 2 to distinguishing the goods or services of one person from those of others shall be construed as a reference to distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others.

62. Collective mark not to be misleading as to character or significance.—A collective mark shall not be registered if it is likely to deceive or cause confusion on the part of public in particular if it is likely to be taken to be something other than a collective mark, and in such case the Registrar may require that a mark in respect of which application is made for registration comprise some indication that it is a collective mark.

63. Application to be accompanied by regulations governing use of collective marks.—(1) An application for registration of a collective mark shall be accompanied by the regulations governing the use of such collective mark.

(2) The regulations referred to in sub-section (1) shall specify the persons authorised to use the mark, the conditions of membership of the association and, the conditions of use of the mark, including any sanctions against misuse and such other matters as may be prescribed.

64. Acceptance of application and regulations by Registrar.—If it appears to the Registrar that the requirements for registration are satisfied, he shall accept the application together with the regulations, either unconditionally or subject to

such conditions including amendments of the said regulations, if any, as he may deem fit or refuse to accept it and if accepted shall notify the regulations.

65. Regulations to be open to inspection.—The regulations referred to in sub-section (1) of Section 63 shall be open to public inspection in the same way as the register as provided in Section 148.

66. Amendment of regulations.—Any amendment of regulations referred to in sub-section (1) of Section 63 shall not be effective unless the amended regulations are filed with the Registrar, and accepted and published by him in accordance with Section 64.

67. Infringement proceedings by registered proprietor of collective mark.—In a suit for infringement instituted by the registered proprietor of a collective mark as plaintiff the court shall take into account any loss suffered or likely to be suffered by authorised users and may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such authorised users.

68. Additional grounds for removal of registration of collective mark.—The registration of a collective mark may also be removed from the register on the ground—

- (a) that the manner in which the collective mark has been used by the proprietor or authorised user has caused it to become liable to mislead the public as a collective mark; or
- (b) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.

Explanation I.—For the purposes of this Chapter, unless the context otherwise requires, “authorised user” means a member of an association authorised to use the registered collective mark of the association.

Explanation II.—For the purposes of this Act, use of a collective mark by an authorised user referred to in *Explanation I* shall be deemed to be the use by the registered proprietor thereof.

CHAPTER IX

CERTIFICATION TRADE MARKS

69. Certain provisions of this Act not applicable to certification trade marks.—The following provisions of this Act shall not apply to certification trade marks, that is to say,—

- (a) clauses (a) and (c) of sub-section (1) of Section 9;

Old Act S. 60(a).—Section 9;

- (b) Sections 18, 20 and 21, except as expressly applied by this Chapter;
- (c) Sections 28, 29, 30, 41, 42, 47, 48, 49, 50, 52, 54 and sub-section (2) of Section 56;

Old Act S. 60(c).—Sections 28, 29, 30, 39, 40, 41, 45, 46, 47, 48, 49, 51, 52, 53 and sub-section (2) of Section 55;

- (d) Chapter XII, except Section 107.

Old Act S. 60(d).—Chapter X, except Section 81;

70. Registration of certification trade marks.—A mark shall not be registrable as a certification trade mark in the name of a person who carries on a trade in goods of the kind certified or a trade of the provision of services of the kind certified.

Old Act S. 61.—Registration of certification trade marks.—(1) A certification trade mark shall be registrable only in Part A of the register.

(2) A mark shall not be registrable as a certification trade mark in the name of a person who carries on a trade in goods of the kind certified.

(3) In determining whether a certification trade mark is adapted to distinguish in accordance with the provisions of clause (c) of sub-section (1) of Section 2, the tribunal may have regard to the extent to which—

- (a) the mark is inherently so adapted to distinguish in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact so adapted to distinguish in relation to the goods in question.

71. Applications for registration of certification trade marks.—(1) An application for the registration of a mark as a certification trade mark shall be made to the Registrar in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft of the regulations to be deposited under Section 74.

(2) Subject to the provisions of Section 70, the provisions of Sections 18, 19 and 22 shall apply in relation to an application under this section as they apply in relation to an application under Section 18, subject to the modification that references therein to acceptance of an application shall be construed as references to authorisation to proceed with an application.

(3) In dealing under the said provisions with an application under this section, the tribunal shall have regard to the like considerations, so far as relevant, as if the application were applications under Section 18 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is a certification trade mark.

72. Consideration of application for registration by Registrar.—(1) The Registrar shall consider the application made under Section 71 with regard to the following matters, namely:—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft of the regulations to be filed under Section 74 is satisfactory;
- (c) whether in all the circumstances the registration applied for would be to the public advantage,

and may either—

- (i) refuse the application; or
- (ii) accept the application and approve the said draft of the regulations either without modification and unconditionally or subject to any conditions

or limitations, or to any amendments or modifications of the application or of the regulations, which he thinks requisite having regard to any of the said matters.

(2) Except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide any matter under sub-section (1) without giving the applicant an opportunity of being heard.

Old Act S. 63.—Consideration of applications for registration by Central Government.—(1) When authorisation to proceed with an application under Section 62 has been given, the Registrar shall forward the application to the Central Government.

(2) The Central Government shall consider the application so forwarded with regard to the following matters, namely:—

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft of the regulations to be deposited under Section 65 is satisfactory;
- (c) whether in all the circumstances the registration applied for would be to the public advantage;

and may either—

- (i) direct that the application shall not be accepted; or
- (ii) direct the Registrar to accept the application and approve the said draft of the regulations either without modifications and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which it thinks requisite having regard to any of the said matters.

(3) Except in the case of a direction for acceptance and approval without modification and unconditionally, the Central Government shall not decide any matter under sub-section (2) without giving to the applicant an opportunity of being heard.

(4) Notwithstanding anything contained in this section, the Central Government may, at the request of the applicant made through the Registrar, consider the application with regard to any of the matters referred to in sub-section (2) before authorisation to proceed with the application is given, but the Central Government shall be at liberty to reconsider any matter on which it has given a decision under this sub-section if any amendment or modification is thereafter made in the application or in the draft of the regulations.

73. Opposition to registration of certification trade marks.—When an application has been accepted, the Registrar shall, as soon as may be thereafter, cause the application as accepted to be advertised in the prescribed manner, and the provisions of Section 21 shall apply in relation to the registration of the mark as they apply in relation to an application under Section 18.

Old Act S. 64.—Opposition to registration of certification trade marks.—(1) When an application has been accepted, the Registrar shall, as soon as may be thereafter, cause the application as accepted to be advertised in the prescribed manner, and the provisions of Section 21 shall apply in relation to the registration of the mark as they apply in relation to an application under Section 18.

(2) In deciding any matter relating to opposition proceedings under the provisions aforesaid the tribunal shall have regard only to the considerations referred to in sub-section (3) of Section 62, and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Central Government under sub-section (3) of this section of any opposition relating to any of the matters referred to in Section 63.

(3) When notice of opposition is given relating to any of the matters referred to in Section 63, the Central Government shall after hearing the parties, if so required by them, and considering any evidence and having regard to the matters aforesaid, direct the Registrar—

- (a) to refuse registration; or

- (b) to register the mark either absolutely or subject to such conditions or limitations, or amendments or modifications of the application or of the regulations to be deposited under Section 65, as the Central Government may think proper to impose or make;

and the Registrar shall dispose of the matter in accordance with the directions issued by the Central Government under this sub-section.

74. Filing of regulations governing use of a certification trade mark.—(1)

There shall be filed at the Trade Marks Registry in respect of every mark registered as a certification trade mark regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the certification trade mark, and may contain any other provisions which the Registrar may by general or special order, require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations); and regulations so filed shall be open to inspection in like manner as the register as provided in Section 148.

(2) The regulations so filed may, on the application of the registered proprietor, be altered by the Registrar.

(3) The Registrar may cause such application to be advertised in any case where it appears to him expedient so to do, and where he does so, if within the time specified in the advertisement any person gives notice of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

Old Act S. 65.—Deposit of regulations governing the use of a certification trade mark.—(1)

There shall be deposited at the Trade Marks Registry in respect of every mark registered as a certification trade mark regulations approved by the Central Government for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the certification trade mark, and may contain any other provisions which the Central Government may, by general or special order, require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations); and regulations so deposited shall be open to inspection in like manner as the register.

(2) The regulations so deposited may on the application of the registered proprietor be altered by the Registrar with the consent of the Central Government.

(3) The Central Government may cause such application to be advertised in any case where it appears to it expedient so to do, and where it does so, if within the time specified in the advertisement any person gives notice of opposition to the application, the Central Government shall not decide the matter without giving the parties an opportunity of being heard.

75. Infringement of certification trade marks.—The right conferred by Section 78 is infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorised by him in that behalf under the regulations filed under Section 74, using it in accordance therewith, uses in the course of a trade, a mark, which is identical with, or deceptively similar to the certification trade mark in relation to any goods or services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken as being a use as a trade mark.

76. Acts not constituting infringement of certification trade marks.—(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered certification trade mark—

- (a) where a certification trade mark is registered subject to any conditions or limitations entered on the register, the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place, country or territory or in any other circumstances, to which having regard to any such limitations, the registration does not extend;
- (b) the use of a certification trade mark in relation to goods or services certified by the proprietor of the mark if, as to those goods or services or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the mark;
- (c) the use of a certification trade mark in relation to goods or services adapted to form part of, or to be accessory to, other goods in relation to which the mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods or services are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods or services are certified by the proprietor.

(2) Clause (b) of sub-section (1) shall not apply to the case of use consisting of the application of a certification trade mark to goods or services, notwithstanding that they are such goods or services as are mentioned in that clause if such application is contrary to the regulations referred to in that clause.

(3) Where a certification trade mark is one of two or more trade marks registered under this Act, which are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

77. Cancellation or varying of registration of certification trade marks.—The Registrar may, on the application in the prescribed manner of any person aggrieved and after giving the proprietor an opportunity of opposing the application, make such order as he thinks fit for expunging or varying any entry in the register to a certification trade mark, or for varying the regulations, on any of the following grounds, namely—

- (a) that the proprietor is no longer competent, in the case of any of the goods or services in respect of which the mark is registered, to certify those goods or services;
- (b) that the proprietor has failed to observe any provisions of the regulations to be observed on his part;

- (c) that it is no longer to the public advantage that the mark should remain registered;
- (d) that it is requisite for the public advantage that if the mark remains registered, the regulations should be varied.

Old Act S. 69.—Cancellation or varying of registration.—The Central Government may, on the application in the prescribed manner of any person aggrieved or on the recommendation of the Registrar, and after giving the proprietor an opportunity of opposing the application or recommendation, make such order as it thinks fit for expunging or varying any entry in the register relating to a certification trade mark, or for varying the deposited regulations, on any of the following grounds, namely:—

- (a) that the proprietor is no longer competent in the case of any of the goods in respect of which the mark is registered, to certify those goods;
- (b) that the proprietor has failed to observe any provision of the deposited regulations to be observed on his part;
- (c) that it is no longer to the public advantage that the mark should remain registered;
- (d) that it is requisite for the public advantage that, if the mark remain registered, the regulations should be varied;

and neither a High Court nor the Registrar shall have any jurisdiction to make an order under Section 55 on any of those grounds.

78. Rights conferred by registration of certification trade marks.—(1) Subject to the provisions of Sections 34, 35 and 76, the registration of a person as a proprietor of certification trade mark in respect of any goods or services shall, if valid, give to that person the exclusive right to the use of the mark in relation to those goods or services.

(2) The exclusive right to the use of a certification trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

CHAPTER X

15[* * *]

15. Chapter X omitted by Act 40 of 2010, S. 7 (w.e.f. 8-7-2013). Prior to omission it read as:

"CHAPTER X

SPECIAL PROVISIONS FOR TEXTILE GOODS

79. Textile goods.—The Central Government may prescribe classes of goods (in this Chapter referred to as textile goods) to the trade marks used in relation to which the provisions of this Chapter shall apply; and subject to the said provisions, the other provisions of this Act shall apply to such trade marks as they apply to trade marks used in relation to other classes of goods.

80. Restriction on registration of textile goods.—(1) In respect of textile goods being piece goods—

- (a) no mark consisting of a line heading alone shall be registrable as a trade mark;
- (b) a line heading shall not be deemed to be capable of distinguishing;
- (c) the registration of trade mark shall not give any exclusive right to the use of a line heading.

(2) In respect of any textile goods, the registration of letters or numerals, or any combination thereof, shall be subject to such conditions and restrictions as may be prescribed.

81. Stamping of piece goods, cotton yarn and thread.—(1) Piece goods, such as are ordinarily sold by length or by the piece, which have been manufactured, bleached, dyed, printed or finished in premises which are a factory, as defined in the Factories Act, 1948 (63 of 1948), shall not be removed for sale from the last of such premises in which they underwent any of the said processes without having conspicuously stamped in international form of Indian numerals on each piece the length thereof in standard yards, or in standard yards and a fraction of such a yard, or in standard metres or in standard metres and a fraction of such a metre, according to the real length of the piece, and, except when the goods are sold from the factory for export from India, without being conspicuously marked on each

CHAPTER XI

APPELLATE BOARD

83. Establishment of Appellate Board.—The Central Government shall, by notification in the Official Gazette, establish an Appellate Board to be known as

piece with the name of the manufacturer or of the occupier of the premises in which the piece was finally processed or of the wholesale purchaser in India of the piece.

(2) Cotton yarn such as is ordinarily sold in bundles, and cotton thread, namely, sewing, darning, crochet or handicraft thread; which have been manufactured, bleached, dyed or finished in any premises not exempted by the rules made under Section 82 shall not be removed for sale from those premises unless, in accordance with the said rules in the case of yarn—

- (a) the bundles are conspicuously marked with an indication of the weight of yarn in English or the metric system in each bundle; and
- (b) the count of the yarn contained in the bundles and in the case of thread each unit is conspicuously marked with the length or weight of thread in the unit and in such other manner as may be required by the said rules; and
- (c) except where the goods are sold from the premises for export from India, unless each bundle or unit is conspicuously marked with the name of the manufacturer or of the wholesale purchaser in India of the goods:

Provided that the rules made under Section 82 shall exempt all premises where the work is done by members of one family with or without the assistance of not more than ten other employees, and all premises controlled by a cooperative society where not more than twenty workers are employed in the premises.

82. Determination of character of textile goods by sampling.—(1) For the purposes of this Act, the Central Government may make rules—

- (a) to provide, with respect to any goods which purport or are alleged to be of uniform number, quantity, measure, gauge or weight, for the number of samples to be selected and tested and for the selection of the samples;
- (b) to provide, for the manner in which for the purposes of Section 81 cotton yarn and cotton thread shall be marked with the particulars required by that section, and for the exemption of certain premises used for the manufacture, bleaching, dyeing or finishing of cotton yarn or cotton thread from the provisions of that section; and
- (c) declaring what classes of goods are included in the expression "piece goods such as are ordinarily sold by length or by the piece" for the purpose of Section 81, of this Act or clause (n) of sub-section (2) of Section 11 of the Customs Act, 1962 (52 of 1962).

(2) With respect to any goods for the selection and testing of samples of which provision is not made in any rules for the time being in force under sub-section (1), the court or officer of customs, as the case may be, having occasion to ascertain the number, quantity, measure, gauge or weight of the goods, shall, by order in writing, determine the number of samples to be selected and tested and the manner in which the samples are to be selected.

(3) The average of the results of the testing in pursuance of rules under sub-section (1) or of an order under sub-section (2) shall be *prima facie* evidence of the number, quantity, measure, gauge or weight, as the case may be, of the goods.

(4) If a person having any claim to, or in relation to, any goods of which samples have been selected and tested in pursuance of rules under sub-section (1), or of an order under sub-section (2), desires that any further samples of the goods be selected and tested, such further samples shall, on his written application and on the payment in advance by him to the court or officer of customs, as the case may be, of such sums for defraying the cost of the further selection and testing as the court or officer may from time to time require, be selected and tested to such extent as may be permitted by rules made by the Central Government in this behalf or as, in the case of goods with respect to which provision is not made in such rules, the court or officer of customs may determine in the circumstances to be reasonable, the samples being selected in the manner prescribed under sub-section (1), or in sub-section (2), as the case may be.

(5) The average of the results of the testing referred to in sub-section (3) and of the further testing under sub-section (4) shall be conclusive proof of the number, quantity, measure, gauge or weight, as the case may be, of the goods."

the Intellectual Property Appellate Board to exercise the jurisdiction, powers and authority conferred on it by or under this Act ¹⁶[and under the Copyright Act, 1957].

84. Composition of Appellate Board.—(1) The Appellate Board shall consist of a ¹⁷[Chairperson], ¹⁸[Vice-Chairperson] and such number of other Members, as the Central Government may deem fit and, subject to the other provisions of this Act, the jurisdiction, powers and authority of the Appellate Board may be exercised by Benches thereof.

(2) Subject to the other provisions of this Act, a Bench shall consist of one Judicial Member and one Technical Member and shall sit at such place as the Central Government may, by notification in the Official Gazette, specify.

(3) Notwithstanding anything contained in sub-section (2), the ¹⁹[Chairperson]—

- (a) may, in addition to discharging the functions of the Judicial Member or Technical Member of the Bench to which he is appointed, discharge the functions of the Judicial Member or, as the case may be, the Technical Member, of any other Bench;
- (b) may transfer a Member from one Bench to another Bench;
- (c) may authorise the ²⁰[Vice-Chairperson], the Judicial Member or the Technical Member appointed to one Bench to discharge also the functions of the Judicial Member or the Technical Member, as the case may be, of another Bench.

(4) Where any Benches are constituted, the Central Government may, from time to time, by notification, make provisions as to the distribution of the business of the Appellate Board amongst the Benches and specify the matters which may be dealt with by each Bench.

(5) If any question arises as to whether any matter falls within the purview of the business allocated to a Bench, the decision of the ²¹[Chairperson] shall be final.

Explanation.—For the removal of doubts, it is hereby declared that the expression “matter” includes an appeal under Section 91.

(6) If the Members of a Bench differ in opinion on any point, they shall state the point or points on which they differ, and make a reference to the ²²[Chairperson] who shall either hear the point or points himself or refer the case for hearing on such point or points by one or more of the other Members and such point or points shall be decided according to the opinion of the majority of the Members who have heard the case, including those who first heard it.

16. *Ins.* by Act 7 of 2017, S. 161(b) (w.e.f. 26-5-2017).

17. *Subs.* for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

18. *Subs.* for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

19. *Subs.* for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

20. *Subs.* for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

21. *Subs.* for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

22. *Subs.* for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

85. Qualifications for appointment as ²³[Chairperson], ²⁴[Vice-Chairperson], or other Members.—(1) A person shall not be qualified for appointment as the ²⁵[Chairperson] unless he—

- (a) is, or has been, a Judge of a High Court; or
- (b) has, for at least two years, held the office of a ²⁶[Vice-Chairperson].

(2) A person shall not be qualified for appointment as the ²⁷[Vice-Chairperson], unless he—

- (a) has, for at least two years, held the office of a Judicial Member or a Technical Member; or
- (b) has been a member of the Indian Legal Service and has held a post in Grade I of that Service or any higher post for at least five years.

(3) A person shall not be qualified for appointment as a Judicial Member, unless he—

- (a) has been a member of the Indian Legal Service and has held the post in Grade I of that Service for at least three years; or
- (b) has, for at least ten years, held a civil judicial office.

(4) A person shall not be qualified for appointment as a Technical Member, unless he—

- (a) has, for at least ten years, exercised functions of a tribunal under this Act or under the Trade and Merchandise Marks Act, 1958 (43 of 1958), or both, and has held a post not lower than the post of a Joint Registrar for at least five years; or
- (b) has, for at least ten years, been an advocate of a proven specialised experience in trade mark law.

(5) Subject to the provisions of sub-section (6), the ²⁸[Chairperson], ²⁹[Vice-Chairperson] and every other Member shall be appointed by the President of India.

(6) No appointment of a person as the ³⁰[Chairperson] shall be made except after consultation with the Chief Justice of India.

86. Term of office of ³¹[Chairperson], ³²[Vice-Chairperson] and other Members.—The ³³[Chairperson], ³⁴[Vice-Chairperson] or other Members shall hold office as such for a term of five years from the date on which he enters upon his office or until he attains,—

23. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

24. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

25. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

26. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

27. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

28. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

29. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

30. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

31. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

32. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

33. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

34. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

- (a) in the case of ³⁵[Chairperson] and ³⁶[Vice-Chairperson], the age of sixty-five years; and
- (b) in the case of a Member, the age of sixty-two years,
- whichever is earlier.

87. ³⁷[Vice-Chairperson] or senior-most Member to act as ³⁸[Chairperson] or discharge his functions in certain circumstances.—(1) In the event of or any vacancy in the office of the ³⁹[Chairperson] by reasons of his death, resignation or otherwise, the ⁴⁰[Vice-Chairperson] and in his absence the senior-most Member shall act as ⁴¹[Chairperson] until the date on which a new ⁴²[Chairperson], appointed in accordance with the provisions of this Act to fill such vacancy, enters upon his office.

(2) When the ⁴³[Chairperson] is unable to discharge his functions owing to his absence, illness or any other cause, the ⁴⁴[Vice-Chairperson] and in his absence the senior-most Member shall discharge the functions of the ⁴⁵[Chairperson] until the date on which the ⁴⁶[Chairperson] resumes his duty.

88. Salaries, allowances and other terms and conditions of service of ⁴⁷[Chairperson], ⁴⁸[Vice-Chairperson] and other Members.—(1) The salaries and allowances payable to, and other terms and conditions of service (including pension, gratuity and other retirement benefits), of the ⁴⁹[Chairperson], ⁵⁰[Vice-Chairperson] and other Members shall be such as may be prescribed.

(2) Notwithstanding anything contained in sub-section (1), a person who, immediately before the date of assuming office as the ⁵¹[Chairperson], ⁵²[Vice-Chairperson] or other Member was in service of Government, shall be deemed to have retired from service on the date on which he enters upon office as the ⁵³[Chairperson], ⁵⁴[Vice-Chairperson] or other Member.

35. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

36. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

37. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

38. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

39. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

40. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

41. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

42. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

43. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

44. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

45. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

46. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

47. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

48. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

49. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

50. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

51. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

52. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

53. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

54. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

89. Resignation and removal.—(1) The ⁵⁵[Chairperson], ⁵⁶[Vice-Chairperson] or any other Member may, by notice in writing under his hand addressed to the President of India, resign his office:

Provided that the ⁵⁷[Chairperson], ⁵⁸[Vice-Chairperson] or any other Member shall, unless he is permitted by the President of India to relinquish his office sooner, continue to hold office until the expiry of three months from the date of receipt of such notice or until a person duly appointed as his successor enters upon his office or until the expiry of his term of office, whichever is earlier.

(2) The ⁵⁹[Chairperson], ⁶⁰[Vice-Chairperson] or any other Member shall not be removed from his office except by an order made by the President of India on the ground of proved misbehaviour or incapacity after an inquiry made by a Judge of the Supreme Court in which the ⁶¹[Chairperson], ⁶²[Vice-Chairperson] or other Member had been informed of the charges against him and given a reasonable opportunity of being heard in respect of those charges.

(3) The Central Government may, by rules, regulate the procedure for the investigation of misbehaviour or incapacity of the ⁶³[Chairperson], ⁶⁴[Vice-Chairperson] or other Member referred to in sub-section (2).

⁶⁵[89-A. Qualifications, terms and conditions of service of Chairperson, Vice-Chairperson and Member.]—Notwithstanding anything in this Act, the qualifications, appointment, term of office, salaries and allowances, resignation, removal and other terms and conditions of service of the Chairperson, Vice-Chairperson and other Members of the Appellate Board appointed after the commencement of Part XIV of Chapter VI of the Finance Act, 2017, shall be governed by the provisions of Section 184 of that Act:

Provided that the Chairperson, Vice-Chairperson and other Members appointed before the commencement of Part XIV of Chapter VI of the Finance Act, 2017, shall continue to be governed by the provisions of this Act, and the rules made thereunder as if the provisions of Section 184 of the Finance Act, 2017, had not come into force.]

90. Staff of Appellate Board.—(1) The Central Government shall determine the nature and categories of the officers and other employees required to assist the Appellate Board in the discharge of its functions and provide the Appellate Board with such officers and other employees as it may think fit.

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55. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 56. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 57. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 58. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 59. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 60. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 61. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 62. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 63. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 64. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).
 65. Ins. by Act 7 of 2017, S. 161(c) (w.e.f. 26-5-2017).

(2) The salaries and allowances and conditions of service of the officers and other employees of the Appellate Board shall be such as may be prescribed.

(3) The officers and other employees of the Appellate Board shall discharge their functions under the general superintendence of the ⁶⁶[Chairperson] in the manner as may be prescribed.

91. Appeals to Appellate Board.—(1) Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made thereunder may prefer an appeal to the Appellate Board within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.

(2) No appeal shall be admitted if it is preferred after the expiry of the period specified under sub-section (1):

Provided that an appeal may be admitted after the expiry of the period specified therefor, if the appellant satisfies the Appellate Board that he had sufficient cause for not preferring the appeal within the specified period.

(3) An appeal to the Appellate Board shall be in the prescribed form and shall be verified in the prescribed manner and shall be accompanied by a copy of the order or decision appealed against and by such fees as may be prescribed.

92. Procedure and powers of Appellate Board.—(1) The Appellate Board shall not be bound by the procedure laid down in the Code of Civil Procedure, 1908 (5 of 1908) but shall be guided by principles of natural justice and subject to the provisions of this Act and the rules made thereunder, the Appellate Board shall have powers to regulate its own procedure including the fixing of places and times of its hearing.

(2) The Appellate Board shall have, for the purpose of discharging its functions under this Act, the same powers as are vested in a civil court under the Code of Civil Procedure, 1908 (5 of 1908) while trying a suit in respect of the following matters, namely:—

- (a) receiving evidence;
- (b) issuing commissions for examination of witnesses;
- (c) requisitioning any public record; and
- (d) any other matter which may be prescribed.

(3) Any proceeding before the Appellate Board shall be deemed to be a judicial proceeding within the meaning of Sections 193 and 228, and for the purpose of Section 196, of the Indian Penal Code, 1860 (45 of 1860) and the Appellate Board shall be deemed to be a civil court for all the purposes of Section 195 and Chapter XXVI of the Code of Criminal Procedure, 1973 (2 of 1974).

93. Bar of jurisdiction of courts, etc.—No court or other authority shall have or, be entitled to, exercise any jurisdiction, powers or authority in relation to the matters referred to in sub-section (1) of Section 91.

66. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

94. Bar to appear before Appellate Board.—On ceasing to hold office, the ⁶⁷[Chairperson], ⁶⁸[Vice-Chairperson] or other Members shall not appear before the Appellate Board or the Registrar.

95. Conditions as to making of interim orders.—Notwithstanding anything contained in any other provisions of this Act or in any other law for the time being in force, no interim order (whether by way of injunction or stay or any other manner) shall be made on, or in any proceedings relating to, an appeal unless—

- (a) copies of such appeal and of all documents in support of the plea for such interim order are furnished to the party against whom such appeal is made or proposed to be made; and
- (b) opportunity is given to such party to be heard in the matter.

96. Power of ⁶⁹[Chairperson] to transfer cases from one Bench to another.—On the application of any of the parties and after notice to the parties, and after hearing such of them as he may desire to be heard, or on his own motion without such notice, the ⁷⁰[Chairperson] may transfer any case pending before one Bench, for disposal, to any other Bench.

97. Procedure for application for rectification, etc. before Appellate Board.—(1) An application for rectification of the register made to the Appellate Board under Section 57 shall be in such form as may be prescribed.

(2) A certified copy of every order or judgment of the Appellate Board relating to a registered trade mark under this Act shall be communicated to the Registrar by the Board and the Registrar shall give effect to the order of the Board and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

98. Appearance of Registrar in legal proceedings.—(1) The Registrar shall have the right to appear and be heard—

- (a) in any legal proceedings before the Appellate Board in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the Trade Marks Registry is raised;
- (b) in any appeal to the Board from an order of the Registrar on an application for registration of a trade mark—
 - (i) which is not opposed, and the application is either refused by the Registrar or is accepted by him subject to any amendments, modifications, conditions or limitations, or
 - (ii) which has been opposed and the Registrar considers that his appearance is necessary in the public interest,

and the Registrar shall appear in any case if so directed by the Board.

67. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

68. Subs. for "Vice-Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

69. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

70. Subs. for "Chairman" by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

(2) Unless the Appellate Board otherwise directs, the Registrar may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue or of the grounds of any decision given by him affecting it, or of the practice of the Trade Marks Registry in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the proceeding.

CASE LAW ▶ Statement by subordinate officer.—Where a statement is submitted by a subordinate to the Registrar, a copy of the notification of the Central Government under Section 3(2) appointing such officer for the purpose, and the authorization of the Registrar permitting him to appear and make a statement, ought to be appended to the statement. In the absence of notification and authorization under Section 3(2), an officer of the Trade Marks Registry cannot be asked to file a statement for the purposes of Section 98(2), *Mount Everest Mineral Water Ltd. v. Bisleri International (P) Ltd.*, (2010) 171 DLT 298 (Del).

99. Costs of Registrar in proceedings before Appellate Board.—In all proceedings under this Act before the Appellate Board the costs of the Registrar shall be in the discretion of the Board, but the Registrar shall not be ordered to pay the costs of any of the parties.

100. Transfer of pending proceedings to Appellate Board.—All cases of appeals against any order or decision of the Registrar and all cases pertaining to rectification of register, pending before any High Court, shall be transferred to the Appellate Board from the date as notified by the Central Government in the Official Gazette and the Appellate Board may proceed with the matter either de novo or from the stage it was so transferred.

CHAPTER XII

OFFENCES, PENALTIES AND PROCEDURE

101. Meaning of applying trade marks and trade descriptions.—(1) A person shall be deemed to apply a trade mark or mark or trade description to goods or services who—

- (a) applies it to the goods themselves or uses it in relation to services; or
- (b) applies it to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture; or
- (c) places, encloses or annexes any goods which are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture, in or with any package or other thing to which a trade mark or mark or trade description has been applied; or
- (d) uses a trade mark or mark or trade description in any manner reasonably likely to lead to the belief that the goods or services in connection with which it is used are designated or described by that trade mark or mark or trade description; or

Old Act S. 76(d).—uses a trade mark or mark or trade description in any manner reasonably likely to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description; or

- (e) in relation to the goods or services uses a trade mark or trade description in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or other commercial document and goods are delivered or services are rendered to a person in pursuance of a request or order made by reference to the trade mark or trade description as so used.

Old Act S. 76(1)(e).—in relation to the goods uses a trade mark or trade description in any sign, advertisement, invoice, catalogue, business letter, business paper, price list or other commercial document, and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark or trade description as so used.

(2) A trade mark or mark or trade description shall be deemed to be applied to goods whether it is woven in, impressed on, or otherwise worked into, or annexed or affixed to, the goods or to any package or other thing.

CASE LAW ▶ Use of similar trade mark.—The use of a similar name by another to truthfully describe his product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin of its product, *William R. Warner & Co. v. Eli Lilly & Co.*, 265 US 526 (1924).

102. Falsifying and falsely applying trade marks.—(1) A person shall be deemed to falsify a trade mark who, either,—

- (a) without the assent of the proprietor of the trade mark makes that trade mark or a deceptively similar mark; or
- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.

(2) A person shall be deemed to falsely apply to goods or services a trade mark who, without the assent of the proprietor of the trade mark,—

- (a) applies such trade mark or a deceptively similar mark to goods or services or any package containing goods;
- (b) uses any package bearing a mark which is identical with or deceptively similar to the trade mark of such proprietor, for the purpose of packing, filling or wrapping therein any goods other than the genuine goods of the proprietor of the trade mark.

(3) Any trade mark falsified as mentioned in sub-section (1) or falsely applied as mentioned in sub-section (2), is in this Act referred to as a false trade mark.

(4) In any prosecution for falsifying a trade mark or falsely applying a trade mark to goods or services, the burden of proving the assent of the proprietor shall lie on the accused.

103. Penalty for applying false trade marks, trade descriptions, etc.—Any person who—

- (a) falsifies any trade mark; or
- (b) falsely applies to goods or services any trade mark; or

Old Act S. 78(b).—falsely applies to goods any trade mark; or

- (c) makes, disposes of, or has in his possession, any die, block, machine, plate or other instrument for the purpose of falsifying or of being used for falsifying, a trade mark; or

(d) applies any false trade description to goods or services; or

Old Act S. 78(d).—applies any false trade description to goods; or

(e) applies to any goods to which an indication of the country or place in which they were made or produced or the name and address of the manufacturer or person for whom the goods are manufactured is required to be applied under Section 139, a false indication of such country, place, name or address; or

(f) tampers with, alters or effaces an indication of origin which has been applied to any goods to which it is required to be applied under Section 139; or

(g) causes any of the things above mentioned in this section to be done,

shall, unless he proves that he acted, without intent to defraud, be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees:

Provided that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

Old Act S. 78 Proviso.—Provided that where the offence under this section is in relation to goods or any package containing goods which are drugs within the meaning of clause (b) of Section 3 of the Drugs Act, 1940 (23 of 1940) or “food” as defined in clause (v) of Section 2 of the Prevention of Food Adulteration Act, 1954 (37 of 1954), the offender shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.

104. Penalty for selling goods or providing services to which false trade mark or false trade description is applied.—Any person who sells, lets for hire or exposes for sale, or hires or has in his possession for sale, goods or things, or provides or hires services, to which any false trade mark or false trade description is applied or which, being required under Section 139 to have applied to them an indication of the country or place in which they were made or produced or the name and address of the manufacturer, or person for whom the goods are manufactured or services provided, as the case may be, are without the indications so required, shall, unless he proves,—

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of commission of the alleged offence no reason to suspect the genuineness of the trade mark or trade description or that any offence had been committed in respect of the goods or services; or

(b) that, on demand by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things or services; or

(c) that otherwise he had acted innocently,

be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees:

Old Act S. 79(c).—be punishable with imprisonment for a term which may extend to two years, or with fine, or with both:

Provided that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

Old Act S. 79(c).—Provided that when the offence against this section is in relation to goods or any package containing goods which are drugs as defined in clause (b) of Section 3 of the Drugs Act, 1940 (23 of 1940), or “food” as defined in clause (v) of Section 2 of the Prevention of Food Adulteration Act, 1954 (37 of 1954), the offender shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.

105. Enhanced penalty on second or subsequent conviction.—Whoever having already been convicted of an offence under Section 103 or Section 104 is again convicted of any such offence shall be punishable for the second and for every subsequent offence, with imprisonment for a term which shall not be less than one year but which may extend to three years and with fine which shall not be less than one lakh rupees but which may extend to two lakh rupees:

Provided that the court may, for adequate and special reason to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than one year or a fine of less than one lakh rupees:

Provided further that for the purposes of this section, no cognizance shall be taken of any conviction made before the commencement of this Act.

106. Penalty for removing piece goods, etc. contrary to Section 81.—If any person removes or attempts to remove or causes or attempts to cause to be removed for sale from any premises referred to in Section 81 or sells or exposes for sale or has in his possession for sale or for any purpose of trade or manufacture piece goods or cotton yarn or cotton thread which is not marked as required by that section, every such piece and every such bundle of yarn and all such thread and everything used for the packing thereof shall be forfeited to Government and such person shall be punishable with fine which may extend to one thousand rupees.

107. Penalty for falsely representing a trade mark as registered.—(1) No person shall make any representation—

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

(2) If any person contravenes any of the provisions of sub-section (1), he shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.

Old Act S. 81(2).—If any person contravenes any of the provisions of sub-section (1), he shall be punishable with imprisonment for a term which may extend to six months, or with fine which may extend to five hundred rupees, or with both.

(3) For the purposes of this section, the use in India in relation to a trade mark of the word "registered", or of any other expression, symbol or sign referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

- (a) where that word or other expression, symbol or sign is used in direct association with other words delineated in characters at least as large as those in which that word or other expression, symbol or sign is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside India being a country under the law of which the registration referred to is in fact in force; or
- (b) where that other expression, symbol or sign is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a); or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside India and in relation solely to goods to be exported to that country or in relation to services for use in that country.

Old Act S. 81(3)(c).—where that word is used in relation to a mark registered as a trade mark under the law of a country outside India and in relation solely to goods to be exported to that country.

108. Penalty for improperly describing a place of business as connected with the Trade Marks Office.—If any person uses on his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trade Marks Office, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

Old Act S. 82.—Penalty for improperly describing a place of business as connected with the Trade Marks Office.—If any person uses on his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trade Marks Office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

109. Penalty for falsification of entries in the register.—If any person makes, or causes to be made, a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

110. No offence in certain cases.—The provisions of Sections 102, 103, 104 and 105 shall, in relation to a registered trade mark or proprietor of such mark, be subject to the rights created or recognised by this Act and no act or omission shall be deemed to be an offence under the aforesaid sections, if—

- (a) the alleged offence relates to a registered trade mark and the act or omission is permitted under this Act; and

- (b) the alleged offence relates to a registered or an unregistered trade mark and the act or omission is permitted under any other law for the time being in force.

111. Forfeiture of goods.—(1) Where a person is convicted of an offence under Section 103 or Section 104 or Section 105 or is acquitted of an offence under Section 103 or Section 104 on proof that he acted without intent to defraud, or under Section 104 on proof of the matters specified in clause (a), clause (b) or clause (c) of that section, the court convicting or acquitting him may direct the forfeiture to Government of all goods and things by means of, or in relation to, which the offence has been committed, or but for such proof as aforesaid would have been committed.

(2) When a forfeiture is directed on a conviction and an appeal lies against the conviction, an appeal shall lie against the forfeiture also.

(3) When a forfeiture is directed on acquittal and the goods or things to which the direction relates are of value exceeding fifty rupees, an appeal against the forfeiture may be preferred, within thirty days from the date of the direction, to the court to which in appealable cases appeals lie from sentences of the court which directed the forfeiture.

(4) When a forfeiture is directed on a conviction, the court, before whom the person is convicted, may order any forfeited articles to be destroyed or otherwise disposed of as the court thinks fit.

112. Exemption of certain persons employed in ordinary course of business.—Where a person accused of an offence under Section 103 proves—

- (a) that in the ordinary course of his business he is employed on behalf of other persons to apply trade marks or trade descriptions, or as the case may be, to make dies, blocks, machines, plates, or other instruments for making, or being used in making, trading marks; and
- (b) that in the case which is the subject of the charge he was so employed, and was not interested in the goods or other thing by way of profit or commission dependent on the sale of such goods or providing of services, as the case may be; and
- (c) that, having taken all reasonable precautions against committing the offence charged, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark or trade description; and
- (d) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons on whose behalf the trade mark or trade description was applied,

he shall be acquitted.

113. Procedure where invalidity of registration is pleaded by the accused.—(1) Where the offence charged under Section 103 or Section 104 or Section 105 is in relation to a registered trade mark and the accused pleads that

the registration of the trade mark is invalid, the following procedure shall be followed:—

- (a) If the court is satisfied that such defence is *prima facie* tenable, it shall not proceed with the charge but shall adjourn the proceeding for three months from the date on which the plea of the accused is recorded to enable the accused to file an application before the Appellate Board under this Act, for the rectification of the register on the ground that the registration is invalid.
- (b) If the accused proves to the court that he has made such application within the time so limited or within such further time as the court may for sufficient cause allow, the further proceedings in the prosecution shall stand stayed till the disposal of such application for rectification.
- (c) If within a period of three months or within such extended time as may be allowed by the court the accused fails to apply to the Appellate Board for rectification of the register, the court shall proceed with the case as if the registration were valid.

(2) Where before the institution of a complaint of an offence referred to in sub-section (1), any application for the rectification of the register concerning the trade mark in question on the ground of invalidity of the registration thereof has already been properly made to and is pending before the tribunal, the court shall stay the further proceedings in the prosecution pending the disposal of the application aforesaid and shall determine the charge against the accused in conformity with the result of the application for rectification in so far as the complainant relies upon the registration of his mark.

114. Offences by companies.—(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and punished accordingly:

Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of, any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

Explanation.—For the purposes of this section—

- (a) “company” means any body corporate and includes a firm or other association of individuals; and

(b) “director”, in relation to a firm, means a partner in the firm.

CASE LAW ► Offence by Company.—The company cannot be prosecuted for offences involving mens rea and/or involving compulsory punishment of imprisonment, *A.K. Khosla v. T.S. Venkatesan*, 1992 Cri LJ 448 (Cal). [*Champa Agency v. R. Chowdhury*, 1974 CHN 400; *Sunil Chandra v. Krishna Chandra*, AIR 1949 Cal 689; *Machine India Ltd. v. State*, (1987) 1 CHN 359; *Kusum v. S.K. Sinha*, (1980) 2 CHN 326; *East India Jute and Hessian Exchange Ltd. v. Amulya Krishna Mondal*, 1989 Cri LR 171, followed. *MCD v. J.B. Bottling Co.*, 1975 Cri LJ 1148 (Del FB) dissented from.]

Municipal Corporation can be prosecuted for offences which are only punishable with fine. Imprisonment of Municipal Corporation is out of question, *Girdharilal v. Lalchand*, AIR 1970 Raj 145 : 1970 Cri LJ 987.

A company or body corporate is not a “person” within the meaning of Article 20(3) of the Constitution, *Godrej Soap Co. Ltd. v. State*, 1991 Cri LJ 828 (Cal).

The accused had a domicile of origin in the district of Multan and had to be assigned Pakistani domicile on partition of India. He committed an offence in Pakistan. He cannot be tried for that offence by a Criminal Court of India after his migration to India on his acquisition of the status of a citizen of India, *Central Bank of India Ltd. v. Ram Narain*, AIR 1955 SC 36 : 1955 Cri LJ 152.

There is no dispute that a company is liable to be prosecuted and punished for criminal offences. Although there are earlier authorities to the effect that corporations cannot commit a crime, the generally accepted modern rule is that except for such crimes as a corporation is held incapable of committing by reason of the fact that they involve personal malicious intent, a corporation may be subject to indictment or other criminal process, although the criminal act is committed through its agents.

As in the case of torts, the general rule prevails that the corporation may be criminally liable for the acts of an officer or agent, assumed to be done by him when exercising authorised powers, and without proof that his act was expressly authorised or approved by the corporation. In the statutes defining crimes, the prohibition is frequently directed against any “person” who commits the prohibited act, and in many statutes the term “person” is defined. Even if the person is not specifically defined, it necessarily includes a corporation. It is usually construed to include a corporation so as to bring it within the prohibition of the statute and subject it to punishment. In most of the statutes, the word “person” is defined to include a corporation.

Inasmuch as all criminal and quasi-criminal offences are creatures of statute, the amenability of the corporation to prosecution necessarily depends upon the terminology employed in the statute. In the case of strict liability, the terminology employed by the legislature is such as to reveal an intent that guilt shall not be predicated upon the automatic breach of the statute but on the establishment of the actus reus, subject to the defence of due diligence. The law is primarily based on the terms of the statutes. In the case of absolute liability where the legislature by the clearest intendment establishes an offence where liability arises instantly upon the breach of the statutory prohibition, no particular state of mind is prerequisite to guilt. Corporations and individual persons stand on the same footing in the face of such a statutory offence. It is a case of automatic primary responsibility. Therefore, as regards corporate criminal liability, there is no doubt that a corporation or company could be prosecuted for any offence punishable under law, whether it is coming under the strict liability or under absolute liability, *Standard Chartered Bank v. Directorate of Enforcement*, (2005) 4 SCC 530 : 2005 SCC (Cri) 961.

115. Cognizance of certain offences and the powers of police officer for search and seizure.—(1) No court shall take cognizance of an offence under Section 107 or Section 108 or Section 109 except on complaint in writing made by the Registrar or any officer authorised by him in writing:

Provided that in relation to clause (c) of sub-section (1) of Section 107, a court shall take cognizance of an offence on the basis of a certificate issued by the Registrar to the effect that a registered trade mark has been represented as registered in respect of any goods or services in respect of which it is not in fact registered.

(2) No court inferior to that of a Metropolitan Magistrate or Judicial Magistrate of the First Class shall try an offence under this Act.

Old Act S. 89(2).—No court inferior to that of a sessions judge, presidency magistrate or magistrate of the First Class shall try an offence under this Act.

(3) The offences under Section 103 or Section 104 or Section 105 shall be cognizable.

(4) Any police officer not below the rank of Deputy Superintendent of Police or equivalent, may, if he is satisfied that any of the offences referred to in sub-section (3) has been, is being, or is likely to be, committed, search and seize without warrant the goods, die, block, machine, plate, other instruments or things involved in committing the offence, wherever found, and all the articles so seized shall, as soon as practicable, be produced before a Judicial Magistrate of the First Class or Metropolitan Magistrate, as the case may be:

Provided that the police officer, before making any search and seizure, shall obtain the opinion of the Registrar on facts involved in the offence relating to trade mark and shall abide by the opinion so obtained.

(5) Any person having an interest in any article seized under sub-section (4), may, within fifteen days of such seizure, make an application to the Judicial Magistrate of the First Class or Metropolitan Magistrate, as the case may be, for such article being restored to him and the Magistrate, after hearing the applicant and the prosecution, shall make such order on the application as he may deem fit.

CASE LAW ► Cognizance of Offence.—As to when cognizance is taken of an offence will depend upon the facts and circumstances of each case and it is impossible to attempt to define what is meant by taking cognizance. Issuing of a search warrant for the purpose of an investigation or of a warrant of arrest for that purpose cannot by themselves be regarded as acts by which cognizance was taken of an offence. Obviously, it is only when a Magistrate applies his mind for the purpose of proceeding under Section 200 and subsequent sections of Chapter XVI of the Code of Criminal Procedure or under Section 204 of Chapter XVII of the Code that it can be positively stated that he had applied his mind and therefore had taken cognizance, *Narayandas Bhagwandas Madhavdas v. State of W.B.*, (1960) 1 SCR 93 : AIR 1959 SC 1118 : 1959 Cri LJ 1368, 1373.

116. Evidence of origin of goods imported by sea.—In the case of goods brought into India by sea, evidence of the port of shipment shall, in a prosecution for an offence under this Act or under clause (b) of Section 112 of the Customs Act, 1962 (52 of 1962), relating to confiscation of goods under clause (d) of Section 111 and notified by the Central Government under clause (n) of sub-section (2) of

Section 11 of the said Act for the protection of trade marks relating to import of goods, be *prima facie* evidence of the place or country in which the goods are made or produced.

117. Costs of defence or prosecution.—In any prosecution under this Act, the court may order such costs to be paid by the accused to the complainant, or by the complainant to the accused, as the court deems reasonable having regard to all the circumstances of the case and the conduct of the parties and the costs so awarded shall be recoverable as if they were a fine.

118. Limitation of prosecution.—No prosecution for an offence under this Act or under clause (b) of Section 112 of the Customs Act, 1962 (52 of 1962), relating to confiscation of goods under clause (d) of Section 111 and notified by the Central Government under clause (n) of sub-section (2) of Section 11 of the said Act for the protection of trade marks, relating to import of goods shall be commenced after expiration of three years next after the commission of the offence charged, or two years after the discovery thereof by the prosecutor, whichever expiration first happens.

CASE LAW ► Limitation of prosecution.—The legislature in enacting Section 92 of Act 43 of 1958 has clearly made departure from Section 15 of Act 4 of 1889 in important respects. Whereas under Section 15 prosecution had to be commenced within three years next after the commission of the offence or within one year after the first discovery thereof by the prosecutor, under Section 92 the prosecution must be commenced before the expiration of three years next after the commission of the offence charged or from the date of discovery by the prosecutor of the offence charged. The argument which could be raised under Section 15 and was approved in *Ruppell case*, (1889) ILR 22 Mad 488, that the legislature intended to provide that the period shall commence from the first discovery thereof by the prosecutor is plainly not open to the offender infringing the provisions of the Trade and Merchandise Marks Act under Section 92. The period has to be commuted for the purpose of the first part of the section from the date of commission of the offence charged, and under the second part from the date of discovery of the offence charged, and not from the first discovery of infringement of trade mark by the prosecutor, *Ram Kishore v. State of U.P.*, AIR 1966 SC 1820 : 1966 Supp SCR 68.

119. Information as to commission of offence.—An officer of the Government whose duty it is to take part in the enforcement of the provisions of this Chapter shall not be compelled in any court to say whence he got any information as to the commission of any offence against this Act.

120. Punishment of abetment in India of acts done out of India.—If any person, being within India, abets the commission, without India, of any act which, if committed in India, would, under this Act, be an offence, he may be tried for such abetment in any place in India in which he may be found, and be punished therefor with the punishment to which he would be liable if he had himself committed in that place the act which he abetted.

121. Instructions of Central Government as to permissible variation to be observed by criminal courts.—The Central Government may, by notification in the Official Gazette, issue instructions for the limits of variation, as regards number,

quantity, measure, gauge or weight which are to be recognised by criminal courts as permissible in the case of any goods.

CHAPTER XIII MISCELLANEOUS

122. Protection of action taken in good faith.—No suit or other legal proceedings shall lie against any person in respect of anything which is in good faith done or intended to be done in pursuance of this Act.

CASE LAW ▶ “Good faith”.—Honest intent free from taint of fraud or fraudulent design is a constant element of the connotation of ‘good faith’. Even so, the quality and quantity of the honesty requisite for constituting ‘good faith’ is conditioned by the context and object of the statute in which this term is employed, *Brijendra Singh v. State of U.P.*, (1981) 1 SCC 597.

In order to establish good faith and bona fide it has to be seen first the circumstances under which the letter was written or words were uttered; secondly, whether there was any malice; thirdly, whether the appellant made any enquiry before he made the allegations; fourthly, whether there are reasons to accept the version that he acted with care and caution, and finally, whether there is preponderance of probability that the appellant acted in good faith, *Chaman Lal v. State of Punjab*, (1970) 1 SCC 590.

123. Certain persons to be public servants.—Every person appointed under this Act and every Member of the Appellate Board shall be deemed to be a public servant within the meaning of Section 21 of the Indian Penal Code, 1860 (45 of 1860).

124. Stay of proceedings where the validity of registration of the trade mark is questioned, etc.—(1) Where in any suit for infringement of a trade mark—

- (a) the defendant pleads that registration of the plaintiff’s trade mark is invalid; or
- (b) the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff pleads the invalidity of registration of the defendant’s trade mark,

the court trying the suit (hereinafter referred to as the court), shall,—

- (i) if any proceedings for rectification of the register in relation to the plaintiff’s or defendant’s trade mark are pending before the Registrar or the Appellate Board, stay the suit pending the final disposal of such proceedings;
- (ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff’s or defendant’s trade mark is *prima facie* tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the Appellate Board for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b)(ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient

cause allow, the trial of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trade mark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order in so far as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court from making any interlocutory order (including any order granting an injunction, directing account to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

CASE LAW ▶ Prima facie view.—Under Section 124, the court while hearing an application for grant of interlocutory order can come to a prima facie view about the validity of the mark, *Stokely Van Camp, Inc. v. Heinz India (P) Ltd.*, (2010) 171 DLT 16 (Del).

▶ **Validity of registration of trade mark.**—Proper remedy against, refusal of civil court to refer issue as to validity of registration of trade mark concerned, during pendency of infringement suit, *Patel Field Marshal Agencies v. P.M. Diesels Ltd.*, (2018) 2 SCC 112.

125. Application for rectification of register to be made to Appellate Board in certain cases.—(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (e) of sub-section (2) of Section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register and, notwithstanding anything contained in Section 47 or Section 57, such application shall be made to the Appellate Board and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under Section 47 or Section 57, the Registrar may, if he thinks fit, refer the application at any stage of the proceedings to the Appellate Board.

Old Act S. 107.—Application for rectification of register to be made to High Court in certain cases.—(1) Where in a suit for infringement of a registered trade mark the validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (d) of sub-section (1) of Section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register, and notwithstanding anything contained in Section 46, sub-section (4) of Section 47 or Section 56, such application shall be made to the High Court and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register is made to the Registrar under Section 46 or sub-section (4) of Section 47 or Section 56, the Registrar may, if he thinks fit, refer the application at any stage of the proceeding to the High Court.

CASE LAW ▶ Rectification of register.—Provisions of Section 125(1) are attracted only when an application for rectification of register is filed by a defendant who is pleading that registration of said trade mark itself is invalid in a suit filed for infringement of trade mark, or, by a plaintiff who is questioning validity of registration of defendant's trade mark and by none else. Rectification application before the filing of such suit may be filed either before Registrar or before Appellate Board. However, if rectification proceedings are instituted after filing of such suit, rectification proceedings can only be taken before Appellate Board and not before Registrar. Lastly, Section 125(1) applies only to applications for rectification of the register, and not at all to the exercise of suo motu powers of the Registrar under Section 57(4), *Jagatjit Industries Ltd. v. Intellectual Property Appellate Board*, (2016) 4 SCC 381 : (2016) 2 SCC (Cv) 606.

126. Implied warranty on sale of marked goods.—Where a mark or a trade mark or trade description has been applied to the goods on sale or in the contract for sale of any goods or in relation to any service, the seller shall be deemed to warrant that the mark is a genuine mark and not falsely applied, or that the trade description is not a false trade description within the meaning of this Act unless the contrary is expressed in writing signed by or on behalf of the seller and delivered at the time of the sale of goods or providing of services on contract to and accepted by the buyer.

Old Act S. 96.—Implied warranty on sale of marked goods.—On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller shall be deemed to warrant that the mark is a genuine mark and not falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the buyer.

127. Powers of Registrar.—In all proceedings under this Act before the Registrar,—

- (a) the Registrar shall have all the powers of a civil court for the purposes of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents and issuing commissions for the examination of witnesses;
- (b) the Registrar may, subject to any rules made in this behalf under Section 157, make such orders as to costs as he considers reasonable, and any such order shall be executable as a decree of a civil court:
Provided that the Registrar shall have no power to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or provision of services or to authorise the use of the mark;
- (c) the Registrar may, on an application made in the prescribed manner, review his own decision.

128. Exercise of discretionary power by Registrar.—Subject to the provisions of Section 131, the Registrar shall not exercise any discretionary or other power vested in him by this Act or the rules made thereunder adversely to a person

applying for the exercise of that power without (if so required by that person within the prescribed time) giving to the person an opportunity of being heard.

129. Evidence before Registrar.—In any proceeding under this Act before the Registrar, evidence shall be given by affidavit:

Provided that the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit.

130. Death of party to a proceeding.—If a person who is a party to a proceeding under this Act (not being a proceeding before the Appellate Board or a court) dies pending the proceeding, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

131. Extension of time.—(1) If the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act (not being a time expressly provided in this Act), whether the time so specified has expired or not, he may, subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly.

(2) Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties before disposing of an application for extension of time, and no appeal shall lie from any order of the Registrar under this section.

132. Abandonment.—Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade marks in force prior to the commencement of this Act, the Registrar may, by notice require the applicant to remedy the default within a time specified and after giving him, if so, desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in the notice.

133. Preliminary advice by the Registrar as to distinctiveness.—(1) The Registrar may, on application made to him in the prescribed manner by any person who proposes to apply for the registration of a trade mark, give advice as to whether the trade mark appears to him *prima facie* to be distinctive.

(2) If, on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative made within three months after the advice was given, the Registrar, after further investigation or consideration, gives notice, to the applicant of objection on the ground that the trade mark is not distinctive, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

134. Suit for infringement, etc. to be instituted before District Court.—(1)

No suit—

- (a) for the infringement of a registered trade mark; or
- (b) relating to any right in a registered trade mark; or
- (c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered,

shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

(2) For the purpose of clauses (a) and (b) of sub-section (1), a "District Court having jurisdiction" shall, notwithstanding anything contained in the Code of Civil Procedure, 1908 (5 of 1908) or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding, or, where there are more than one such persons any of them, actually and voluntarily resides or carries on business or personally works for gain.

Explanation.—For the purposes of sub-section (2), "person" includes the registered proprietor and the registered user.

CASE LAW ► Nature of provision.—Provisions of Section 134(2) are mandatory and the plaintiff can bring an action for infringement in a jurisdiction stipulated by the Civil Procedure Code, 1908 or any other law or at its option in a jurisdiction stipulated in Section 134, *Hindustan Unilever Ltd. v. Ashique Chemicals*, (2011) 5 Mah LJ 836 (Bom).

► Territorial jurisdiction.—A corporation, in view of Explanation appended to Section 20, CPC would be deemed to be carrying on business inter alia at a place where it has a subordinate office. Ordinarily, the residence of a company would be where the registered office is. Only because its goods are being sold at a place would evidently not mean that it carries on a business at that place, *Dhodha House v. S.K. Maingi*, (2006) 9 SCC 41.

Section 134 only stipulates the territorial jurisdiction within which an action for infringement can be filed and it is not relevant to the question whether the infringement has taken place or not, *Hindustan Unilever Ltd. v. Ashique Chemicals*, (2011) 5 Mah LJ 836 (Bom).

Legislators want to encourage the victims of violation of Trade Marks to institute suit in their own place, instead of going to the place of the defendant and institute a suit there. Section 134 of the Act should be taken as one recognising the right of the plaintiff, who is having the genuine grievance that he has been wronged in any manner by another person, relating to his right concerning the registered Trade mark, which includes threat, as contemplated under Section 142 of the Act, to file the suit in his own place of residence or place of business, *M.K. Sowbhagyam v. Wipro Ltd.*, (2009) 5 LW 833 (Mad).

► Pari materia provisions.—Section 62, Copyright Act, 1957 and Section 134, Trade Marks Act, 1999 are in pari materia. Sections 62(2) and 134(2) contain the word "include" which means that place where plaintiff is residing, carrying on business, etc. is an additional place and not an exclusive place to institute trade mark or copyright suit/proceedings. Thus, if cause of action, wholly or in part arises at principal or ordinary place where plaintiff resides/carries on business/personally works for gain, and in case of a

corporation, where its principal office/head office/registered office is situate, then copyright/trade mark suit/proceedings can be filed only at such place and not at other places, such as branch/subordinate office or some other place of residence, etc. Section 62(2) and Section 134(2) were never intended to permit the situation wherein even though the cause of action arises wholly or in part at principal place of business or residence of plaintiff, yet plaintiff chooses to file suit/proceedings at a distant place where its subordinate office or other place of business is situated though at such place no cause of action has arisen. This approach is consistent with real purpose for which Sections 62(2) and 134(2) were enacted. Sections 62(2) and 134(2) have to be purposively construed. Purpose of enacting Sections 62(2) and 134(2), held, is to tone down the rigours of Section 20 CPC by providing additional forum which is convenient to plaintiff in a trade mark/copyright dispute. Sections 62(2) and 134(2) though they contain non obstante clause, "notwithstanding anything contained in Code of Civil Procedure, 1908", yet they do not completely override Section 20 CPC. Counter-mischief to the defendant has to be mitigated while ensuring the convenience of the additional forum made available to plaintiff by Section 62(2) and Section 134(2), *Indian Performing Rights Society Ltd. v. Sanjay Dalia*, (2015) 10 SCC 161.

135. Relief in suits for infringement or for passing off.—(1) The relief which a court may grant in any suit for infringement or for passing off referred to in Section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) The order of injunction under sub-section (1) may include and *ex parte* injunction or any interlocutory order for any of the following matters, namely:—

- (a) for discovery of documents;
- (b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;
- (c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case—

- (a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or
- (b) where in a suit for infringement the defendant satisfies the court—
 - (i) that at the time he commenced to use the trade mark complained of in the suit, he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and
 - (ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the

trade mark in relation to goods or services in respect of which it was registered; or

(c) where in a suit for passing off, the defendant satisfies the court—

- (i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and
- (ii) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

136. Registered user to be impleaded in certain proceedings.—(1) In every proceeding under Chapter VII or under Section 91, every registered user of a trade mark using by way of permitted use, who is not himself an applicant in respect of any proceeding under that chapter or section, shall be made a party to the proceeding.

(2) Notwithstanding anything contained in any other law, a registered user so made a party to the proceeding shall not be liable for any costs unless he enters an appearance and takes part in the proceeding.

137. Evidence of entries in register, etc., and things done by the Registrar.—(1) A copy of any entry in the register or of any document referred to in sub-section (1) of Section 148 purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.

(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be *prima facie* evidence of the entry having been made, and of the contents thereof, or of the matter or things having been done or not done.

138. Registrar and other officers not compellable to produce register, etc.—The Registrar or any officer of the Trade Marks Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special cause.

139. Power to require goods to show indication of origin.—(1) The Central Government may, by notification in the Official Gazette, require that goods of any class specified in the notification which are made or produced beyond the limits of India and imported into India, or, which are made or produced within the limits of India, shall, from such date as may be appointed by the notification not being less than three months from its issue, have applied to them an indication of the country or place in which they were made or produced, or of the name and address of the manufacturer or the person for whom the goods were manufactured.

(2) The notification may specify the manner in which such indication shall be applied that is to say, whether to goods themselves or in any other manner, and

the times or occasions on which the presence of the indication shall be necessary, that is to say, whether on importation only, or also at the time of sale, whether by wholesale or retail or both.

(3) No notification under this section shall be issued, unless application is made for its issue by persons or associations substantially representing the interests of dealers in, or manufacturers, producers, or users of, the goods concerned, or unless the Central Government is otherwise convinced that it is necessary in the public interest to issue the notification, with or without such inquiry, as the Central Government may consider necessary.

(4) The provisions of Section 23 of the General Clauses Act, 1897 (10 of 1897) shall apply to the issue of a notification under this section as they apply to the making of a rule or bye-law the making of which is subject to the condition of previous publication.

(5) A notification under this section shall not apply to goods made or produced beyond the limits of India and imported into India, if in respect of those goods, the Commissioner of Customs is satisfied at the time of importation that they are intended for exportation whether after transshipment in or transit through India or otherwise.

140. Power to require information of imported goods bearing false trade marks.—(1) The proprietor or a licensee of a registered trade mark may give notice in writing to the Collector of Customs to prohibit the importation of any goods if the import of the said goods constitute infringement under clause (c) of sub-section (6) of Section 29.

(2) Where goods, which are prohibited to be imported into India by notification of the Central Government under clause (n) of sub-section (2) of Section 11 of the Customs Act, 1962 (52 of 1962), for the protection of trade marks, and are liable to confiscation on importation under that Act, are imported into India, the Commissioner of Customs if, upon representation made to him, he has reason to believe that the trade mark complained of is used as a false trade mark, may require the importer of the goods, or his agent, to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to India and the name and address of the person to whom the goods were sent in India.

(3) The importer or his agent shall, within fourteen days, comply with the requirement as aforesaid, and if he fails to do so, he shall be punishable with fine which may extend to five hundred rupees.

(4) Any information obtained from the importer of the goods or his agent under this section may be communicated by the Commissioner of Customs to the registered proprietor or registered user of the trade mark which is alleged to have been used as a false trade mark.

141. Certificate of validity.—If in any legal proceeding for rectification of the register before the Appellate Board a decision is on contest given in favour of the registered proprietor of the trade mark on the issue as to the validity of the

registration of the trade mark, the Appellate Board may grant a certificate to that effect, and if such a certificate is granted, then, in any subsequent legal proceeding in which the said validity comes into question the said proprietor on obtaining a final order or judgment in his favour affirming validity of the registration of the trade mark shall, unless the said final order or judgment for sufficient reason directs otherwise, be entitled to his full cost charges and expenses as between legal practitioner and client.

Old Act S. 119.—Certificate of validity.—If in any legal proceeding for rectification of the register before a High Court a decision is on contest given in favour of the registered proprietor of the trade mark on the issue as to the validity of the registration of the trade mark, the High Court may grant a certificate to that effect, and if such a certificate is granted, then in any subsequent legal proceeding in which the said validity comes into question the said proprietor on obtaining a final order or judgment in his favour affirming the validity of the registration of the trade mark shall, unless the said final order or judgment for sufficient reason directs otherwise, be entitled to his full costs, charges and expenses as between legal practitioner and client.

142. Groundless threats of legal proceedings.—(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for infringement of a trade mark which is registered, or alleged by the first-mentioned person to be registered, or with some other like proceeding, a person aggrieved may, whether the person making the threats is or is not the registered proprietor or the registered user of the trade mark, bring a suit against the first-mentioned person and may obtain a declaration to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the trade mark is registered and that the acts in respect of which the proceedings were threatened, constitute, or, if done, would constitute, an infringement of the trade mark.

(2) The last preceding sub-section does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of sub-section (1) of Section 52 with due diligence commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3) Nothing in this section shall render a legal practitioner or a registered trade marks agent liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4) A suit under sub-section (1) shall not be instituted in any court inferior to a District Court.

143. Address for service.—An address for service stated in an application or notice of opposition shall for the purposes of the application or notice of opposition be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or opponent, as the case may be.

144. Trade usages, etc., to be taken into consideration.—In any proceeding relating to a trade mark, the tribunal shall admit evidence of the usages of the trade

concerned and of any relevant trade mark or trade name or get up legitimately used by other persons.

145. Agents.—Where, by or under this Act, any act, other than the making of an affidavit, is required to be done before the Registrar by any person, the act may, subject to the rules made in this behalf, be done instead of by that person himself, by a person duly authorised in the prescribed manner, who is—

- (a) a legal practitioner, or
- (b) a person registered in the prescribed manner as a trade marks agent, or
- (c) a person in the sole and regular employment of the principal.

146. Marks registered by an agent or representative without authority.—If an agent or a representative of the proprietor of a registered trade mark, without authority uses or attempts to register or registers the mark in his own name, the proprietor shall be entitled to oppose the registration applied for or secure its cancellation or rectification of the register so as to bring him as the registered proprietor of the said mark by assignment in his favour:

Provided that such action shall be taken within three years of the registered proprietor of the trade mark becoming aware of the conduct of the agent or representative.

147. Indexes.—There shall be kept under the direction and supervision of the Registrar—

- (a) an index of registered trade marks;
- (b) an index of trade marks in respect of which applications for registration are pending;
- (c) an index of the names of the proprietors of registered trade marks; and
- (d) an index of the names of registered users.

148. Documents open to public inspection.—(1) Save as otherwise provided in sub-section (4) of Section 49, —

- (a) the register and any document upon which any entry in the register is based;
- (b) every notice of opposition to the registration of a trade mark application for rectification before the Registrar, counter statement thereto, and any affidavit or document filed by the parties in any proceedings before the Registrar;
- (c) all regulations deposited under Section 63 or Section 74, and all applications under Section 66 or Section 77 for varying such regulations;
- (d) the indexes mentioned in Section 147; and
- (e) such other documents as the Central Government may, by notification in the Official Gazette, specify,

shall, subject to such conditions as may be prescribed, be open to public inspection at the Trade Marks Registry:

Provided that when such register is maintained wholly or partly on computer, the inspection of such register under this section shall be made by inspecting the computer printout of the relevant entry in the register so maintained on computer.

(2) Any person may, on an application to the Registrar and on payment of such fees as may be prescribed, obtain a certified copy of any entry in the register or any document referred to in sub-section (1).

149. Reports of Registrar to be placed before Parliament.—The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution by or under the Registrar of this Act.

150. Fees and surcharge.—(1) There shall be paid in respect of ⁷¹[applications, international applications] and registration and other matters under this Act such fees and surcharge as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Registrar, the Registrar shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the Trade Marks Registry, the document shall be deemed not to have been filed at the registry until the fee has been paid.

151. Savings in respect of certain matters in Chapter XII.—Nothing in Chapter XII shall—

- (a) exempt any person from any suit or other proceeding which might, but for anything in that Chapter, be brought against him; or
- (b) entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any suit or other proceeding, but such discovery or answer shall not be admissible in evidence against such person in any such prosecution for an offence under that Chapter or against clause (h) of Section 112 of the Customs Act, 1962 (52 of 1962) relating to confiscation of goods under clause (d) of Section 111 of that Act and notified by the Central Government under clause (n) of sub-section (2) of Section 11 thereof for the protection of trade marks relating to import of goods; or
- (c) be construed so as to render liable to any prosecution or punishment any servant of a master resident in India who in good faith acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master and as to the instructions which he has received from his master.

152. Declaration as to ownership of trade mark not registrable under the Registration Act, 1908.—Notwithstanding anything contained in the Registration Act, 1908 (16 of 1908), no document declaring or purporting to declare the ownership or title of a person to a trade mark other than a registered trade mark shall be registered under that Act.

71. Subs. for "applications" by Act 40 of 2010, S. 8 (w.e.f. 8-7-2013).

153. Government to be bound.—The provisions of this Act shall be binding on the Government.

154. Special provisions relating to applications for registration from citizens of convention countries.—(1) With a view to the fulfilment of a treaty, convention or arrangement with any country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation outside India which affords to citizens of India similar privileges as granted to its own citizens, the Central Government may, by notification in the Official Gazette, declare such country or group of countries or union of countries or Inter-Governmental Organisation to be a convention country or group of countries or union of countries or Inter-Governmental Organisations, as the case may be, for the purposes of this Act.

(2) Where a person has made an application for the registration of a trade mark in a convention country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation and that person, or his legal representative or assignee, makes an application for the registration of the trade mark in India within six months after the date on which the application was made in the convention country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisations, the trade mark shall, if registered under this Act, be registered as of the date on which the application was made in the convention country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation and that date shall be deemed for the purposes of this Act to be the date of registration.

(3) Where applications have been made for the registration of a trade mark in two or more convention countries or country which are members of group of countries or union of countries or Inter-Governmental Organisation, the period of six months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.

(4) Nothing in this Act shall entitle the proprietor of a trade mark to recover damages for infringement which took place prior to the date of application for registration under this Act.

155. Provision as to reciprocity.—Where any country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the registration and protection of trade marks as it accords to its own nationals, no national of such country or country which is a member of a group of countries or union of countries of Inter-Governmental Organisation, as the case may be, shall be entitled, either solely or jointly with any other person,—

- (a) to apply for the registration of, or be registered as the proprietor of, a trade mark;
- (b) to be registered as the assignee of the proprietor of a registered trade mark; or

- (c) to apply for registration or be registered as a registered user of a trade mark under Section 49.

156. Power of Central Government to remove difficulties.—(1) If any difficulty arises in giving effect to the provisions of this Act, the Central Government may, by order published in the Official Gazette, make such provisions not inconsistent with the provisions of this Act as may appear to be necessary for removing the difficulty:

Provided that no order shall be made under this section after the expiry of five years from the commencement of this Act.

- (2) Every order made under this section shall, as soon as may be after it is made, be laid before each House of Parliament.

157. Power to make rules.—(1) The Central Government may, by notification in the Official Gazette and subject to the conditions of previous publication, make rules to carry out the provisions of this Act.

- (2) In particular, and without prejudice to the generality of the foregoing powers, such rules may provide for all or any of the following matters, namely:—

- (i) the matters to be included in the Register of Trade Marks under sub-section (1) of Section 6, and the safeguards to be observed in the maintenance of records on computer floppies or diskettes or in any other electronic form under sub-section (2) of that section;
- (ii) the manner of publication of alphabetical index of classification of goods and services under sub-section (1) of Section 8;
- (iii) the manner in which the Registrar may notify a word as an international non-proprietary name under Section 13;
- (iv) the manner of making an application for dissolution of an association under sub-section (5) of Section 16;
- (v) the manner of making an application for registration of a trade mark under sub-section (1) of Section 18;
- (vi) the manner of advertising of an application for registration under sub-section (1), and the manner of notifying corrections or amendments under sub-section (2), of Section 20;
- (vii) the manner of making an application and the fee payable for such application giving notice under sub-section (1) and sending counter statements under sub-section (2) and submission of evidence and the time therefor under sub-section (4) of Section 21;
- ⁷²[(viii) the manner of giving a notice of opposition and the fee payable for such notice under sub-section (1) and sending counter-statement under sub-section (2) and submission of evidence and the time therefor under sub-section (4) of Section 21;]

72. Subs. by Act 40 of 2010, S. 9(a) (w.e.f. 8-7-2013). Prior to substitution it read as:

“(viii) the form of certificate of registration under sub-section (2), and the manner of giving notice to the applicant under sub-section (3) of Section 23;”

- (ix) the forms of application for renewal and restoration the time within which such application is to be made and fee and surcharge if any payable with each application, under Section 25 and the time within which the Registrar shall send a notice and the manner of such notice under sub-section (3) of that Section;
- ⁷³[(ix-a) the time within which the international application is to be forwarded to the International Bureau and the manner of certifying the particulars by the Registrar under sub-section (4) of Section 36-D;
- (ix-b) the manner of keeping a record of particulars of an international registration under sub-section (1) of Section 36-E;
- (ix-c) the manner of informing the International Bureau under sub-section (2) of Section 36-E;
- (ix-d) the manner of advertising the international registration and the time within which the international registration shall be advertised under sub-section (3) of Section 36-E;]
- (x) the manner of submitting statement of cases under sub-section (2) of Section 40;
- (xi) the manner of making an application by the proprietor of a trade mark under Section 41;
- (xii) the manner of making an application for assignment or transmission of a certification trade mark under Section 43;
- (xiii) the manner of making an application to the Registrar to register title under sub-section (1) of Section 45;
- ⁷⁴[(xiii-a) the period within which the Registrar shall dispose of an application under sub-section (3) of Section 45;]
- (xiv) the manner in which and the period within which an application is to be made under sub-section (4) of Section 46;
- (xv) the manner of marking an application under sub-section (2) of Section 47;
- (xvi) the manner of making an application, documents and other evidence to accompany such application under sub-section (1) and the manner in which notice is to be issued under sub-section (3) of Section 49;
- (xvii) the manner of making an application under sub-section (1), the manner of issuing a notice under sub-section (2) and the procedure for cancelling a registration under sub-section (3) of Section 50;
- (xviii) the manner of making applications under sub-sections (1) and (2), the manner of giving notice under sub-section (4) and the manner of service of notice of rectification under sub-section (5) of Section 57;
- (xix) the manner of making an application under Section 58;

73. *Ins. by Act 40 of 2010, S. 9(b) (w.e.f. 8-7-2013).*

74. *Ins. by Act 40 of 2010, S. 9(c) (w.e.f. 8-7-2013).*

- (xx) the manner of making an application under sub-section (1), the manner of advertising an application, time and manner of notice by which application may be opposed under sub-sections (2) and (3) of Section 59;
- (xxi) the manner of advertisement under sub-section (2) of Section 60;
- (xxii) the other matters to be specified in the regulations under sub-section (2) of Section 63;
- (xxiii) the manner of making an application under sub-section (1) of Section 71;
- (xxiv) the manner of advertising an application under Section 73;
- (xxv) the manner of making an application under Section 77;
- (xxvi) ⁷⁵[* * *]
- (xxvii) ⁷⁶[* * *]
- (xxviii) ⁷⁷[* * *]
- (xxix) the salaries and allowances payable to, and the other terms and conditions of service of, the ⁷⁸[Chairperson], ⁷⁹[Vice-Chairperson] and other Members under sub-section (1) of Section 88;
- (xxx) the procedure for investigation of misbehaviour or incapacity of the ⁸⁰[Chairperson], ⁸¹[Vice-Chairperson] and other Members under sub-section (3) of Section 89;
- (xxxi) the salaries and allowances and other conditions of service of the officers and other employees of the Appellate Board under sub-section (2), and the manner in which the officers and other employees of the Appellate Board shall discharge their functions under sub-section (3), of Section 90;
- (xxxii) the form of making an appeal, the manner of verification and the fee payable under sub-section (3) of Section 91;
- (xxxiii) the form in which and the particulars to be included in the application to the Appellate Board under sub-section (1) of Section 97;
- (xxxiv) the manner of making an application for review under clause (c) of Section 127;
- (xxxv) the time within which an application is to be made to the Registrar for exercising his discretionary power under Section 128;

75. Omitted by Act 40 of 2010, S. 9(d) (w.e.f. 8-7-2013). Prior to omission it read as:

“(xxvi) the classes of goods under Section 79;”

76. Omitted by Act 40 of 2010, S. 9(d) (w.e.f. 8-7-2013). Prior to omission it read as:

“(xxvii) the conditions and restrictions under sub-section (2) of Section 80;”

77. Omitted by Act 40 of 2010, S. 9(d) (w.e.f. 8-7-2013). Prior to omission it read as:

“(xxviii) determination of character of textile goods by sampling under Section 82;”

78. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

79. Subs. for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

80. Subs. for “Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

81. Subs. for “Vice-Chairman” by Act 7 of 2017, S. 161(a) (w.e.f. 26-5-2017).

- (xxxvi) the manner of making an application and the fee payable therefor under sub-section (1) of Section 131;
- (xxvii) the manner of making an application under sub-section (1) and the period for withdrawal of such application under sub-section (2) of Section 133;
- (xxviii) the manner of authorising any person to act and the manner of registration as a trade mark agent under Section 145;
- (xxix) the conditions for inspection of documents under sub-section (1) and the fee payable for obtaining a certified copy of any entry in the register under sub-section (2) of Section 148;
- (xl) the fees and surcharge payable for making applications and registration and other matters under Section 150;
- (xli) any other matter which is required to be or may be prescribed.

(3) The power to make rules conferred by this section shall include the power to give retrospective effect in respect of the matters referred to in clauses (xxix) and (xxxi) of sub-section (2) from a date not earlier than the date of commencement of this Act, but no retrospective effect shall be given to any such rule so as to prejudicially affect the interests of any person to whom sub-rule may be applicable.

(4) Every rule made by the Central Government under this Act shall be laid, as soon as may be after it is made, before each House of Parliament, while it is in session for a total period of thirty days which may be comprised in one session or in two or more successive sessions, and if, before the expiry of the session immediately following the session or the successive sessions aforesaid, both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.

158. Amendments.—The enactment specified in the Schedule shall be amended in the manner specified therein.

159. Repeal and savings.—(1) The Trade and Merchandise Marks Act, 1958 (43 of 1958) is hereby repealed.

(2) Without prejudice to the provisions contained in the General Clauses Act, 1897 (10 of 1897), with respect to repeals, any notification, rule, order, requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request or thing made, issued, given or done under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall, if in force at the commencement of this Act, continue to be in force and have effect as if made, issued, given or done under the corresponding provisions of this Act.

(3) The provisions of this Act shall apply to any application for registration of a trade mark pending at the commencement of this Act and to any proceedings consequent thereon and to any registration granted in pursuance thereof.

(4) Subject to the provisions of Section 100 and notwithstanding anything contained in any other provision of this Act, any legal proceeding pending in any court at the commencement of this Act may be continued in that court as if this Act had not been passed.

(5) Notwithstanding anything contained in this Act, where a particular use of a registered trade mark is not an infringement of a trade mark registered before the commencement of this Act, then, the continued use of that mark shall not be an infringement under this Act.

(6) Notwithstanding anything contained in sub-section (2), the date of expiration of registration of a trade mark registered before the commencement of this Act shall be the date immediately after the period of seven years for which it was registered or renewed:

Provided that the registration of a defensive trade mark referred to in Section 47 of the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall cease to have effect on the date immediately after the expiry of five years of such commencement or after the expiry of the period for which it was registered or renewed, whichever is earlier.

THE SCHEDULE

(See Section 158)

AMENDMENTS

Year	Act No.	Short title	Amendment
1956	1	The Companies Act, 1956	<p>(I) In Section 20, for sub-section (2), the following sub-sections shall be <i>substituted</i>, namely:—</p> <p>“(2) Without prejudice to the generality of the foregoing power, a name which is identical with, or too nearly resembles,—</p> <p>(i) the name by which a company in existence has been previously registered, or</p> <p>(ii) a registered trade mark, or a trade mark which is subject of an application for registration, of any other person under the Trade Marks Act, 1999,</p> <p>may be deemed to be undesirable by the Central Government within the meaning of sub-section (1).</p> <p>(3) The Central Government may, before deeming a name as undesirable under clause (ii) of sub-section (2), consult the Registrar of Trade Marks.”.</p> <p>(II) In Section 22, in sub-section (1),—</p> <p>(i) for the portion beginning with “if, through” and ending with</p>

Year	Act No.	Short title	Amendment
			<p>“the first-mentioned company—” the following shall be <i>substituted</i>, namely:—</p> <p>“If through inadvertence or otherwise, a company on its first registration or on its registration by a new name, is registered by a name which,—</p> <p>(i) in the opinion of the Central Government, is identical with, or too nearly resembles, the name by which a company in existence has been previously registered, whether under this Act or any previous companies law, the first-mentioned company, or</p> <p>(ii) on an application by a registered proprietor of a trade mark, is in the opinion of the Central Government identical with, or too nearly resembles, a registered trade mark of such proprietor under the Trade Marks Act, 1999, such company,—”;</p> <p>(iii) the following proviso shall be <i>added</i>, namely:—</p> <p>“Provided that no application under clause (ii) made by a registered proprietor of a trade mark after five years of coming to notice of registration of the company shall be considered by the Central Government.”.</p>

NOTIFICATIONS

(1)

Ministry of Commerce and Industry (Deptt. of Industrial Policy and Promotion), Noti. No. S.O. 1049(E), dated September 15, 2003, published in the Gazette of India, Extra., Part II, Section 3(ii), dated 15th September, 2003, p. 1, No. 834

[F. No. 9/2//2003-IRS]

In exercise of the powers conferred by Section 83 of the Trade Marks Act, 1999 (47 of 1999), the Central Government hereby establishes the Intellectual Property Appellate Board with effect from the 15th day of September, 2003 to exercise the jurisdiction, powers and authority conferred on it by or under the said Act.

(2)

*Ministry of Commerce and Industry (Deptt. of Industrial Policy and Promotion),
Noti. No. S.O. 1050(E), dated September 15, 2003, published in the Gazette of
India, Extra., Part II, Section 3(ii), dated 15th September, 2003, p. 2, No. 834
[F. No. 8/19/2000/PP&C-IRS]*

In exercise of the powers conferred by sub-section (2) of Section 84 of the Trade Marks Act, 1999 (47 of 1999), the Central Government hereby specifies Ahmedabad, Chennai, Delhi, Mumbai and Kolkata as the places at which a Bench of the Intellectual Property Appellate Board shall sit.

(3)

*Ministry of Commerce and Industry (Deptt. of Industrial Policy and Promotion),
Noti. No. S.O. 1150(E), dated October 1, 2003, published in the Gazette of India,
Extra., Part II, Section 3(ii), dated 1st October, 2003, p. 1, No. 909
[File No. 8/12/03-IRS]*

In exercise of the powers conferred by Section 100 of the Trade Marks Act, 1999 (47 of 1999), the Central Government hereby notifies the 6th day of October, 2003 as the date on for the purposes of the said section.
