

Phone: 27077557, 7073205  
Telefax: 040-27071660  
e-mail: raoandrao@rdiffmail.com

## RAO & RAO

Patents, Trademarks, Designs & Copyright Registration Consultants  
12-10-651/3, Road No.2, Indira Nagar, Warasiguda, Secunderabad 500 061, A.P.

TMC: L: 11141 :2007-08

25.03.2008

The Controller General of Patents, Designs and Trademarks  
Trademarks Registry  
IPO Building, Boudhik Sampada Bhavan  
S.M.Road, antop Hill  
Mumbai 400 037

Sir,

Sub: CDROM – Containing Draft Trademarks Work  
Manual 2008 – reg.

Ref: Your Circular No. CG/F/1491)(21)/2008/97 dt.11.03.2008

In response to your circular cited above on the subject received at our end on 22.03.2008, we express our inability to offer our suggestions on all the aspects within a short span of three days time i.e., before 25.03.2008. We hope, you will take care to see that such CDROMs are sent well before the stipulated date to enable the advocates to offer their suggestions in time. Though we are not in a position to offer our suggestions covering all the aspects contained in the working manual, we would like to place hereunder some of our experiences/difficulties faced in various branches of the Registry, so as to enable you to incorporate the remedial directions in the manual.

- (1) The Presiding Officers at various branches of the Registry in the country are not pronouncing orders in opposition/rectification proceedings even after several months/years have lapsed after the orders are reserved. At times, the Presiding Officers are reopening the matters without assigning any reasons therefor. That apart, when the Presiding Officers are transferred before pronouncing the orders in the reserved matters, those matters are being posted again for hearing, thereby causing not only inconvenience to the advocates but also forcing the clients to incur additional expenditure. Necessary directions may, therefore, be incorporated in the Manual fixing certain period for pronouncing orders in reserved matters as in the case of civil courts which are allowed 14 days time to pronounce orders in the reserved matters.

*Ans. The order to be pronounced within 3 months, Contd... P/2.  
Failure which the reasons to be recorded by the hearing officer and  
matter to be referred only after approval of the Registrar &  
T. P. ...*

- (2) Necessary directions be incorporated in the Manual to pass reasoned or speaking orders when an objection based on the interpretation of the provisions of the Act relating to adjournment of hearing is taken to enable the aggrieved party to prefer an appeal as against the impugned order.
- (3) Necessary instructions should be incorporated in the Manual not to post matters, either show cause or oppositions or rectifications in which the advocates staying at a far of place from the Registry represent the parties with days gap but to take care to see that they are posted atleast with two weeks gap. This procedure will be practicable only when the concerned sections dealing with show cause matters and the sections dealing with oppositions/rectification proceedings work in coordination with each other.
- (4) When an application on form TM-60 is received, the Registry forgetting the fact that NOC sought for is in respect of the **artistic work**, refusing to issue such NOCs simply because the title of the work/trademark is phonetically identical with, similar or deceptively similar to the marks already registered or the marks in pending applications, thereby giving a good bye to the intention of the legislature. Necessary directions be incorporated in the Manual to take into consideration only the artistic work when an application on form TM-60 is received for the issuance of NOC. The Registry while issuing NOC, may, if it thinks fit, incorporate a clause in the certificate to the effect that NOC is only in relation to the artistic work and not in respect of the trademark or the artistic script of the trademark.
- (5) It is reliably learnt that administrative directions were issued to all the branch offices not to accept the marks, if an identical mark is already registered. We are afraid that this direction runs contrary to the provisions of Sec.34 of the Act besides the power given to the Registrar by the Act to accept the marks with "**limitations**" which include geographical limitations. Such administrative directions, if given, may be reconsidered in view of the relevant provisions contained in the Act.
- (6) It is also reliably learnt that administrative directions were also issued not to allow amendment of mistakenly mentioned class or the specification of goods in applications on form TM-1. We are afraid that these administrative directions also run contrary to the right given to the applicant to amend any clerical or typographical mistake that took place while preparing the application on form TM-1. That apart, such administrative directions will undoubtedly result in hardship to the applicant and therefore the said directions may be reconsidered.
- (7) Needless to mention that there is a duty cast on the Registrar to send a notice before the expiration of last registration to the registered proprietor of the date of expiration under sec.25(3). But, the Registry is not adhering

*speaking  
order to  
be passed  
in the matter*

to the said provision with the result, some of the marks, though the registered proprietor is very interested in renewing it but could not do so due to oversight, are being removed from the Register. Necessary directions be incorporated in the Manual to strictly follow the said provision of the Act. In this connection we may bring it to your notice that where the renewal fees is mistakenly paid earlier to six months is not being refunded by the office. Necessary directions may be given not to accept payments made before six months and if they are received by mistake they should be directed to refund the amount forthwith.

- (8) In cases where the oppositions are decided either subject to amendment of the mark or where the oppositions are filed, in cases where the marks are mistakenly published in part and when this fact is brought to the notice of the Presiding Officer and re-advertisement of the whole of the label was ordered, such marks are not being re-advertised even after several years. Necessary directions be incorporated in the Manual in that regard.
- (9) So far as the mis-spelt words referred to in the CDROM are concerned, needless to mention that very often the Presiding Officers are allowing such marks to go on the Register. We feel that at any rate, this attitude of the Presiding Officers should not be allowed to continue in the interest of purity of the Register. In this connection it may not be out of place to quote an instance where XTRA, the mis-spelt word of "EXTRA" was allowed to go on the Register in spite of the grounds taken on the basis of registrability of the said mark in the notice of opposition and also in the grounds of appeal before IPAB. The opponent was therefore constrained to challenge the order of IPAB in a writ petition which is pending consideration. Though the matter is sub-judice we send herewith the relevant extract taken from the written arguments submitted before IPAB as Annexure-A. In such cases the Registry in exercise of its inherent powers should cancel such registrations *suo motto*. The Presiding Officer should also be given specific directions not to allow such marks to go on the Register.
- (10) Though, it is not appropriate to incorporate in the present suggestions a lacuna in the Act relating to the issuance of NOC for use under sec.45(2) of the Copyright Act, we feel it essential to point out the said lacuna so as to enable you to take necessary steps whenever there is an occasion or proposal to amend any of the provisions of the Act.

Thanking you,

Yours faithfully  
RAO & RAO

(K.Hemaprakasa Rao)  
Advocate & Attorney

Encl: as above

## ANNEXURE - A

Extract from the written arguments submitted in appeal No. 31 of 2005 preferred to the IPAB as against the orders passed in opposition MAS-130959 to application No.1039973-B in class 3

### **Registrability of the mark**

- (1) The lower tribunal while dealing with provisions of sec.9, failed to consider the primary requisite i.e., “**registrability of the mark**” under the “absolute grounds for refusal of registration”.

### **Applicability of objection to registration of the properly spelt word applies to phonetic equivalent:**

- (2) It is submitted that it cannot be denied that the mark, “XTRA” is a phonetic equivalent to the word, EXTRA.
- (3) As pointed out by Dr.S.Venkateswaran in his book “The law of Trademarks and Passing off” (Reprint of 1999) at page 127 “if a given word is for any reason unregistrable in its proper spelling then, the objection to the registration of the properly spelt word applies equally to a word which is merely its phonetic equivalent: It is submitted that the word “XTRA” (which is equivalent to “extra”) is unregistrable for the following reasons.

### **Dictionary meaning of “extra” and “more”**

- (4) The meaning given to “**extra**” in THE OXFORD ENGLISH REFERENCE DICTIONARY 1995 edition at page 495 is as

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### **Dictionary meaning of “extra” and “more”**

- (4) The meaning given to “**extra**” in THE OXFORD ENGLISH REFERENCE DICTIONARY, 1995 edition at page 405 is as

**extra**: adj.adv. & n.

**adj**: additional., more than usual or necessary or expected

**adv**: 1 more than usually: 2 additionally (was charged extra)

**n**: (i) An extra thing (ii) a thing for which an extra-charge is made; such a charge.

- (11) Since “**more**” is also given as one of the meanings of “extra”, its meaning as found at page No.939 of the Oxford dictionary is reproduced hereunder:

**more**: adj. adv. & noun

**adj**: (i) existing in a greater or **additional quantity**,  
amount or degree (more\_problems than last time)

(ii) greater in degree (more's the pity, the more fool you)

**n**: A **greater quantity**, number or amount (eg.more than 3 people)

- (12) In view of the meaning given to “more” as an adjective or a noun it possess the same characteristics of the word “EXTRA” (as an adjective) when it is used in conjunction with the other words “SUPER” and/or “Big detergent bar” and noun when it is used as a Single word.

likely to be used by traders in the course of their business without any improper motive stated (basing on the decisions rendered in Liverpool Electric Cable Co.Ltd.'s Appln.(1929) 46 RPC 99, Yorkshire Copper Works Ltd.'s Appln. (1954) 71 RPC 150 H.L., and Electric Ltd.'s Appln. (1958) RPC 176 C.A., (1959) RPC 283., H.L.) stated that these marks are incapable of becoming adapted to distinguish or of acquiring the capacity of distinguish, no matter how long they are used, and no trader should be allowed to acquire a monopoly in the use of such marks.

- (18) Again, P.Narayanan in his book, Trade Mark, Trade Name & Passing off Cases (second edition) at page 425 at 427 quoted the following passage from the judgment of Lord Parker in 30 RPC 660 HL (W & G Ducross Ltd., application) page 671-673:

“ in \*my opinion, in order to determine whether a mark is distinctive it must be considered quite apart from the effects of registration. The question, therefore, whether the mark itself, if used as a trademark, is likely to become actually distinctive of the goods of the person so using it. The applicant for registration in effect says, “I intend to use this mark as a trademark, i.e.,for the purpose of distinguishing my goods from the goods of other persons”, and the Registrar as the court has to determine, before the mark be admitted to registration, whether it is of such a kind that the applicant, quite apart from the effective of registration is

largely depend upon **whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark or some mark nearly resembling it, upon on or in connection with their own goods.** It is apparent from the history of trademarks in this country that **both the legislature and the courts have always shown a natural disinclination to allow any person to obtain by registration under the Trademarks Act a monopoly in what others may legitimately desires to use**". (emphasis supplied)

In view of the settled principles of law, the word X-tra (equivalent to the word extra) being devoid of any distinctive character is not registrable under sec.9(1)(a) "no matter how long it is used" as observed by Dr.Venkatesan in his book at page 124.

22.2.2008.

In response to meeting held on 18<sup>th</sup> February, 2008 in Mumbai chaired by Shri M.S. Dhakad, Director, Ministry of Industry & Commerce, DIPP, New Delhi regarding finalisation of Trade Mark Manual, the undersigned discussed the matter with other officers in Trade Marks Registry relating to post registration chapter. It was felt that the following should be incorporated in the manual as the present Manual is silent on this issue which may lead to unnecessary litigation, inconvenience and perhaps amounts to act which are not authorized by the provisions of the Act and, therefore, may be interpreted as illegal, incorrect and without jurisdiction.

Section 6 of the Trade Marks Act reads as under:

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

According to the aforesaid section, the Register of Trade Marks which has been kept at Head Office only wherein or therein all entries relating to post registration (assignment, transmission, registered user, renewal etc.) shall be entered.

In case of assignment or transmission of registered trade mark as per Sl. No.28 of the First Schedule, application under Section 45 to register a subsequent proprietor in respect of more than one registered trade mark could be filed if the assignor and assignee is same in all the cases. As per Section 44 of the Act all the associated marks must be assigned together only. In the cases where TM-23 or TM-24 is filed as envisaged in Sl. No.28 of the First Schedule, there is every possibility that appropriate office of one registered trade mark is different from the appropriate office of another registered trade mark. The work of one appropriate office based on the territorial limits in terms of Section 5(3) of the Act cannot be carried out by another appropriate office. If the post registration work such as TM-23/TM-24, TM-28, TM-33, TM-34 and TM-50 is decentralized it will bring a situation that the work pertaining to one office is done by another office which will be liable to be set aside by the courts in the writ jurisdiction.

Furthermore in case of assignment or transmission of registered trade mark, for example, take the case of a company like Nestle, U.S.A. who have 10 marks registered out of which 5 are registered through attorney at Calcutta in which case the appropriate office will be TMR, Kolkata and subsequently on the change of attorney to a Delhi Advocate, the appropriate office shall now be entered as Delhi and when this company wants to assign 10 marks which are also associated by one assignment, the difficulty will come as to in which office the request is to be filed. Further Registrar of TMR Delhi or Kolkata cannot record such assignment. Thus recording of assignment of all the trade marks at one place by one Registrar at Delhi or at Kolkata may be beyond jurisdiction in respect of marks which do not belong to that appropriate office and this can be struck down by the Hon'ble High Court by writ jurisdiction and this may also give rise to unnecessary filing of writ petition in the High Courts at Delhi and Kolkata. Similar situation can arise in case the recording of assignment is refused by one appropriate office in respect of all 10 marks.

Also, in case of registration of registered user (TM-28) and variation of registration as registered user (TM-29), all such cases should be dealt with and disposed off by the Head Registry or wherever the Office of Registrar of Trade Marks is situated. It may not be out of place to mention here that the powers of granting of registration of registered user or variation were earlier with the Central Government which has now been given to the Registrar of Trade Marks. Thus, it is seen that these powers are very important powers and cannot be further delegated to all the Branch officers who are exercising powers of Registrar of Trade Marks. The seriousness in such cases requires that these powers or these cases should be disposed off only by the Registrar of Trade Marks and not other officers empowered under Section 3(2) of the Act.

According to Section 6 of the Act as given above, covers maintenance of registration of registered users only by the Registrar at the Head Office. As in the case of assignment given above, one application for registration of registered user may contain more than one registered trade mark having different appropriate office as jurisdiction and therefore it will be difficult to allow these cases by different Registrars having different territorial jurisdiction.

Similarly, in the case of renewal of trade mark also, this activity should be confined to the Head Office only. A registered proprietor may have 100 marks and when he wants to renew the marks he has to file the renewal applications in different appropriate offices which may be inconvenient to him and therefore this should be done at the Head office only. Also this will be inconvenient to the attorneys as well as to the proprietor having many marks on the Register and thus will not be convenient to maintain such records by the proprietor or the attorney. In fact, renewal is also one of the post-registration activity and therefore should be confined to one place at the Head Registry only.

Apart from these observations/comments, the manual is prepared by the author keeping in view the practical difficulties and it was well appreciated by one and all in TMR, Chennai. This manual should also contain briefly the practice followed by the Registrar in dealing with such post registration cases.

**(M.C. GUPTA)**  
**DEPUTY REGISTRAR OF TRADE MARKS**  
**HEAD OF OFFICE, TMR, CHENNAI.**



*Manchanda Associates*

INTELLECTUAL PROPERTY LAW HOUSE  
45/1061 (2<sup>nd</sup> floor), NAIWALA, KAROL BAGH,  
NEW DELHI – 110005 (INDIA)

E-mail: manchanda@bol.net.in  
Ph./Fax: Off 011-28758393, 28758595  
Res 011-25886474, 25886575  
Cell 9811087261

To  
SH. V.RAVI, Cont. General  
The Registrar of Trade Marks  
Trade Marks Registry  
Mumbai / Delhi.

05.03.2008

Reg: Suggestion in respect of DRAFT TRADE MARK WORK MANUAL –2008

Sir,

The Trade Marks Registry has recently published Draft Trade Marks Work Manual–2008 through the website of the Trade Marks Registry and seeking suggestion / objection from the public etc.

In the above context, the undersigned would like to suggest that the following changes be made in the Rule 50 and 51 of the Trade Marks Rules, 2002

Rule 50 and 51 respectively state that the opponent and/or applicant shall file evidence by way of affidavit and shall deliver to the applicant and/or opponent copies of any evidence leaves with the Registrar.

It is suggested that the Rule 50 and 51 be amended in the following manner:

“the opponent and/or applicant shall file evidence by way of Affidavit to be supported with annexures or exhibits (if any) and shall deliver to the applicant and/or opponent copies of all the evidence including Affidavit with annexures or exhibits those leaves with the Registrar”.

In view of above, the undersigned request that the rule 54 of the Trade Marks Rules, 2002 be deleted / abolished.

We request your goodself to consider the submissions made hereinabove in the interest of general public at large.

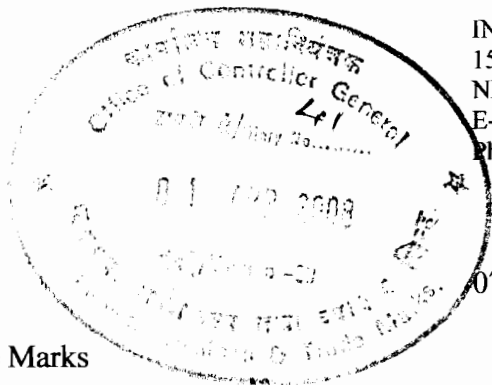
Thanking you  
Yours faithfully

  
N.K.MANCHANDA  
ADVOCATE

*Manchanda Associates*

INTELLECTUAL PROPERTY LAW HOUSE  
15/1061 (2<sup>nd</sup> floor), NAIWALA, KAROL BAGH,  
NEW DELHI – 110005 (INDIA)

E-mail: manchanda@bol.net.in  
Ph./Fax: Off 011-28758393, 28758595  
Res 011-25886474, 25886575  
Cell 9811087261



07.03.2008

To  
The Registrar of Trade Marks  
Trade Marks Registry  
New Delhi.

Sir,

The Trade Marks Registry has recently entered into new Era by commencing the availabilities of certain information through its Website and amongst others one of the important feature is providing **TRADE MARK APPLICATION STATUS** by which one can see the particulars of any application wherein several feature get automatically updated immediately like advertisement of application in the trade marks journal, filing of notice of opposition and registration of trade mark.

No doubt, the efforts in providing of above informations are appreciable in the interest of general public at large but some more information be provided over the website, which includes as under:

1. Date of Application *to be given*
2. Validity / Renewal of trade mark with notification of renewal in the journal. *current status*
3. Any amendment made in the application
4. Subsequent changes made in the proprietorship of trade marks like change of name and address of the proprietor.
5. Any other information which the Ld. Registrar may deem and fit proper in the interest of general public and feasible with the Trade Marks Registry.

We request your goodself to consider the submissions made hereinabove in the interest of general public at large.

Thanking you  
Yours faithfully

*N.K. Manchanda*  
N.K.MANCHANDA  
ADVOCATE