

Mandatory to Give Reasons for Refusal of Trade Mark Registration

If you have questions or would like additional information on the material covered herein, please contact:

Mr. Tanmay Mohanty, Associate
(tmohanty@lexcounsel.in)

LexCounsel, Law Offices C-10, Gulmohar Park New Delhi 110 049, INDIA.
Tel.:+91.11.4166.2861
Fax:+91.11.4166.2862

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In a recent judgement delivered by the Delhi High Court vide its order dated October 16, 2019 in the case of *Intellectual Property Attorneys Association vs The Controller General of Patents, Designs & Trade Marks & Anr.* [W.P.(C) 3851/2019], the High Court has observed and clarified that the Registrar of Trade Marks (“**Registrar**”) is duty bound to send a copy of the order containing the grounds for conditional acceptance or refusal of the application for registration of trade marks under the Trade Marks Act, 1999 (“**Act**”).

Relevant Provisions of the Act and the Trade Marks Rules, 2017 (“Rules”)

Section 18(5) of the Act, *inter alia*, provides that:

“Application for Registration

(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”.*

Rule 36(1) of the Rules, *inter alia*, provides that:

“Decision of Registrar

(1) *The decision of the Registrar under rules 33, 34 or 41 shall be communicated to the applicant in writing at his address of service and if the applicant intends to appeal from such decision he may within thirty days from the date of such*



communication apply in Form TM-M to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at, his decision”.

Contentions of the Parties

The grievance of the petitioner was against the non-speaking orders passed by the Registrar while refusing applications for registration of trade marks and the same were violative of the Section 18(5) of the Act, which requires the Registrar to record in writing the grounds for such refusal and the materials used by him in arriving at his decision. Additionally, the petitioner also contended that provisions of Rule 36 of the Rules are violative of Section 18 of the Act to the extent that it provides for sending of the order to an applicant without the grounds for refusal/conditional acceptance.

The respondent (Registrar) while accepting that it has to mandatorily comply with the provisions of Section 18(5) of the Act, submitted that Rule 36 provides for communication, in writing, of the decision to the applicant and if such applicant intends to appeal against the decision, it may apply within thirty (30) days to the Registrar and the grounds of refusal/conditional acceptance will be provided thereafter.

Decision

The High Court observed that the Registrar is duty bound to send a copy of the order passed under Section 18(5) of the Act containing the grounds for refusal/conditional acceptance and material used by in arriving at his decision.

Furthermore, the High Court also held that Rule 36 of the Rules is “*arbitrary, unreasonable and inconsistent with the mandatory provision of the statute insofar as it empowers the Registry to communicate the decision without the grounds for refusal/conditional acceptance. In that view of the matter, Section 18(5) of the Trade Marks Act shall prevail over Rule 36 of the Trade Marks Rules*”.

Feedback

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