
India – Controller prohibits amendments to trade mark Statements of User

A Circular issued by Controller General of Patent and Trade Marks on 8 June, 2012 indicated, among other things, that amendments to Statements of User would not be permitted. This has created a stir amongst trade mark practitioners and is likely to have a considerable impact on IP owners.

Background

The Trade Mark Rules provide that, except where the mark in question has not yet been used, a trade mark application must be accompanied by a Statement of User indicating the person by whom the mark has been used and the period of use.

Rule 41 provides that amendments to trade mark applications are permitted provided they do not have the effect of substantially altering the trade mark applied for or substitute a new specification of goods or services not included in the application as filed.

Although the Circular provides that amendments to Statements of User will not be permitted, it seems clear that, on a plain reading of the provisions, such amendments would not amount to a substantial alteration.

Practical implications

In practice, applicants are often not able to ascertain the exact date of use and, in this situation, may file the application on the basis of an 'intention to use', seeking later to amend the application. Alternatively, they will file a Statement of User, but discover further details of use after filing the application and seek to amend the Statement of User. In such cases, the Registrar has called for affidavit evidence of use and, on receipt of satisfactory evidence, allowed either the filing of a Statement of User or an amendment to the Statement of User already filed. That will no longer be the case.

The Circular effectively overrides both the Registry's established practice and a decision on the issue, *Asim Plast Pvt Ltd V Reliance Industries Ltd*, in which the Assistant Registrar of Trade Marks held that "such an amendment of user information in the application does not amount to a substantial alteration"

Our comment

In issuing the Circular, the Controller's intention may have been to avoid a situation that often arises following a preliminary refusal on the basis of a prior registered mark or pending application. In this situation, applicants will often seek to amend the Statement of User in order to show that they were the first user of the mark, or that they have been using the mark concurrently with another user. A similar situation often arises when a notice of opposition is filed.

There are, however, many other situations in which applicants may seek to amend the Statement of User. A 'blanket ban' on such amendments does not seem an appropriate solution. There is likely to be considerable pressure on the Controller to reconsider.

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