

CTRL + ALT = abandoned

The Indian Trademarks Registry has devised a new way to reduce its backlog of trademark applications: abandoning outstanding applications. In an exercise carried out in the last week of March 2016, it is estimated that more than 100,000 applications were abandoned by the Trademark Registry. March 31 2016 was also the deadline set for the Department of Industrial Policy and Promotion, under the Ministry of Industries, to assess efficiency of the Trademark Registry. Thus, the action appears to have been intended to improve the statistics, while its stated objective was to remove from the system all pending applications where the applicant had not replied to the examination report or office action. The action and its execution created chaos that may take months to clear, and put further pressure on a trademark office already struggling under a huge backlog.

The action led to the Trademark Registry abandoning many applications where the applicant had timely filed a response to the examination report. It is unclear exactly how the abandoned applications were identified. From the number of applications abandoned in less than a week, it appears that the Trademarks Registry carried out verification based on a software algorithm to identify applications without a response in the online database. As a result, the software seems to have also picked up all the applications where a response:

- had been filed but not scanned and logged in the database;
- had been filed under the wrong category (eg, correspondence); or
- had been given the incorrect file name.

For all these applications, an automated order abandoning the application was uploaded. Interestingly, no notification was sent to the relevant applicant or agent. Thus, trademark practitioners must audit all of their records to identify whether any applications that they are handling have been abandoned through this action.

As well as practitioners being angry, brand owners – already tired of slow progress at the Trademarks Registry – are throwing their hands up in exasperation. The chief executive office of the International Trademark Association has written to the controller general of trademarks to put brand owners' concerns on record. Many local practitioner associations are planning to approach the courts seeking reversal of the abandonment order.

Amid the furore created by this unprecedented action, the controller general issued a clarification in a circular of April 4 2016, which stated that: "Some complaints have been received claiming that some of the applications have been treated as abandoned even though the reply on behalf of the applicants have been submitted but the same was not considered; some complaints have also been received to the effect that the examination reports containing office objections have not been received by the applicant or their authorised agent concerned as such the same could not be replied and the applications were treated as abandoned." In all such cases the applicant or its authorised agent should send representation to the Trademarks Registry by April 30 2016. Thus, the circular puts the onus on applicants to identify any abandoned marks and apply for



Intellectual Property Attorneys

restoration thereof. Further, until April 30 the registry's records will show marks to be abandoned, thus having a major impact on clearance searches carried out during this period.

Overall, the registry's action was badly planned and executed. Further, the timing is a major setback to the government's efforts to strengthen the Indian IP regime to promote the 'Make in India' programme and attract investment in the manufacturing sector.

Ranjan Narula, RNA Intellectual Property Attorneys, Gurgaon

Vatika Towers
10th Floor Block-B
Sector-54
Golf Course Road
Gurgaon-122002
National Capital Region (Haryana)
India

Tel. +91 124 4655999

Fax. +91 124 4045047

Email info@rnaip.com

Copyright © RNA, IP Attorneys