

---

## Shemozzle over abandoned marks

---

Over 190,000 marks have been abandoned by the Indian Trademarks Registry in the last week of March is a fast developing story with many twists and turns. The recent development post writ petition being filed at the Delhi High Court is in the form of a public notice dated 11<sup>th</sup> April, 2016 issued by the Controller General of Trademarks to clarify that in view of Writ Petitions filed before the High Court, Delhi and the order passed by the court to stay the abandonment orders passed by the Registrar of Trade Marks after 20<sup>th</sup> March, 2016, the applications affected are being kept in abeyance. Further, the applicants or their authorised agents concerned can file the reply to examination reports containing office objections either through *comprehensive E-filing services of trademarks* available at the official website or through email at [parm.tmr@nic.in](mailto:parm.tmr@nic.in) and [abhishek.p@nic.in](mailto:abhishek.p@nic.in). Interestingly, no date has been specified until when this window will remain open or will the earlier date of 30<sup>th</sup> April, 2016 will be the cut off date or it will be next date of hearing in writ which is 12<sup>th</sup> May, 2016.

### Background

In the last week of March 2016, it is estimated that more than 190,000 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 wherein 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 wherein the applicant had even 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 an 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.

### **First notice from Controller General (April 4, 2016)**

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 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.

### **Writ filed by Intellectual Property Attorneys Association (IPAA)**

Not satisfied with the above steps, the local practitioners under the aegis of the Intellectual Property Attorneys Association (IPAA) filed a writ petition on 5<sup>th</sup> April, 2016 at the Delhi High Court. In response to the writ, the Delhi High Court passed orders granting a stay against all the abandonment orders passed by the office of the Registrar of Trade Marks on or after March 20, 2016 and totaling to more than 193,000 applications. The Registrar has been further directed not to pass any further orders of abandonment without giving due notice to the affected parties by registered post.

### **Recent notice from Controller General (11<sup>th</sup> April, 2016)**

While the brand owners and practitioners were debating the amplitude of the order a notice has been issued by the Controller General to clarify that in view of "Writ Petitions WP (C) 3043/2016 & 3067/2016 filed before the Hon'ble High Court, Delhi and the Hon'ble Court vide their order dated 5<sup>th</sup> April, 2016, has stayed the orders of abandonment passed by the Registrar on or after 20<sup>th</sup> March, 2016. Thus, it is "notified to the public that abandonment orders passed by the Registrar of Trade Marks after 20<sup>th</sup> March, 2016 are being kept in abeyance and the applicants or their authorised agents concerned can file the reply to examination reports containing office objections either through *comprehensive E-filing services of trademarks* available at the official website or through email at [parm.tmr@nic.in](mailto:parm.tmr@nic.in) and [abhishek.p@nic.in](mailto:abhishek.p@nic.in)"

### **What's next**

It seems the audit and identification of abandoned applications will have to be done by the brand owners or their practitioner even though INTA's CEO in a follow up letter to the Controller General has requested that the list of abandoned marks be made public. Overall, the brand owners are advised to take advantage of 30<sup>th</sup> April, 2016 window to flag their cases by sending details to the specific email address created by the Controller General for this purpose. With the recent public notice issued by the Controller General, one could presume that applications where the response was timely filed are likely to be restored on back up documents being submitted. However the fate of applications where the examination reports or office action was not replied and as per

Trademarks Registry these were dispatched, the fate of such applications will be dependent on the outcome of writ and reply affidavit to be submitted by the Controller General before 12<sup>th</sup> May, 2016 (the next date of hearing in the writ).

Overall, the intent of the Trademarks Registry in carrying out this exercise was good but seems to suffer from poor execution.

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](mailto:info@rnaip.com)

Copyright © RNA, IP Attorneys