
India - FAQ's on rectification/ cancellation proceedings

Are rectification/cancellation proceedings available under Indian law? If yes, what are the grounds on which such an action can be filed?

Yes, the Indian Trademark Act provides for rectification/cancellation proceedings. Broadly, the grounds available are as follows;

1. The mark was not distinctive at the time of its registration.
2. The mark conflicts with an already existing mark.
3. Use of the mark is likely to cause confusion and deception amongst trade and public.
4. There is no bona fide intention to use the mark.
5. There has been no use of the mark for a period of 5 years.

Who can initiate rectification/cancellation proceedings?

Only a 'person aggrieved' can initiate the rectification/cancellation proceedings. A 'person aggrieved' implies any party whose trading interests are affected by the presence of the registration on the register.

Out of the five (5) Trademarks Registries in India where can I file rectification/ cancellation proceedings?

Rectification/cancellation applications can only be filed at the Trademark Registry (Ahmedabad, Chennai, Delhi, Kolkata or Mumbai) where the trademark was originally filed for attaining its registration.

What is the procedure followed by the TMR for cancellation/rectification proceedings?

On receipt of the application for rectification, official fees and statement of case the Registrar serves the application and the statement of case upon the Registered Proprietor calling upon it to file a Counter Statement (CS). Once the CS is filed, the matter reaches the evidence stage and the parties are required to file their respective evidence in the form of an affidavit/s deposed by their concerned authorised officer/s. Subsequent to both the parties having filed their respective evidence, the matter is set down for a final hearing giving both parties opportunity to make oral submissions on merits and the order is made in due course.

Is the Order passed by the Registrar appealable?

Yes, the Order from the Registrar is appealable before the Intellectual Property Appellate Board (IPAB). Appeals can be filed within 3 months from the date such an Order is communicated.

Can I file the cancellation/rectification action before the IPAB?

Yes, rectification application can be filed before the IPAB office at Chennai. Once the pleadings are completed a hearing is appointed before the IPAB.

What is the procedure followed by IPAB for cancellation/rectification proceedings?

In cancellation proceedings before the IPAB, the party filing the application for rectification is required to submit its statement of case and evidence along with its application. On being served, the registered proprietor is also required to submit its evidence along with its counter affidavit. Subsequently, the IPAB appoints a hearing for oral submissions on merit and the Order is accordingly made in due course.

Is an order of IPAB appealable?

There is no provision for appeal against an order of the IPAB. However, a writ petition under Article 226 and 227 of the Constitution of India can be filed in the High Court against the order of IPAB. A writ is in the nature of a review and is not an appeal. An aggrieved person can also invoke the jurisdiction of Supreme Court of India under Article 136 of the Constitution of India.

When is a particular trademark registration vulnerable to cancellation on the ground of non-use?

A particular trademark becomes vulnerable to cancellation on the ground of non-use as soon as a continuous period of 5 years or more have elapsed from the date on which the said mark was actually placed on the register. In other words, the 5 years non-use period is to be calculated from the sealing date or the date on which registration certificate was issued.

To defend a non-use cancellation action, is the quantum of use made by the trademark in question pertinent?

Indian law does not prescribe any specific quantum of use vis a vis trademarks to defend a non-use cancellation action. It has been accepted that even a token sale of a particular product bearing the mark is sufficient to ward-off non-use cancellation proceedings.

Are there any special circumstances that can be pleaded to defend a non-use cancellation action?

Yes, the courts in India have acknowledged certain special circumstances given below which assist in defending a non-use cancellation action.

1. General glut in the market.
2. Lack of demand for the goods.
3. Import restrictions.
4. Wartime restrictions.

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