
India - FAQ's on trade mark oppositions

Who can file the Notice of Opposition?

Under Indian law, 'any person' can file the notice of opposition. This includes individuals, companies, partnership firms and trusts. Two or more persons can be joined as opponents in the same notice of opposition provided the issues are the same.

What is the time period for filing the Notice of Opposition?

The notice of opposition can be filed within three months, extendable by one month (3+1) of the date the Trade Marks Journal is made available to the public. If the notice of opposition is filed after three months but before the expiry of four months, then it must be accompanied by a request for an extension of time of one month, giving sufficient reasons for the delay in filing the opposition.

Out of the five Trade Mark Registry(s) in India, where can I file the Opposition?

The notice of opposition should be filed at the trade mark registry where the application for the conflicting mark has been filed. For instance, if the application is filed at the Delhi office of the Trade Mark Registry, then the opposition proceedings would be initiated in Delhi only.

Do I need to submit a Power of Attorney at the time of filing the Notice of Opposition?

Generally, a Power of Attorney should be submitted at the time of filing the notice of opposition. If the Power of Attorney is not available at the time of filing the opposition, it can be filed at a later date.

My mark is not registered in India; can I file an opposition based on my pending application and use?

Yes, it is possible to file the opposition on the basis of the pending application or use. The Trade Marks Act, 1999 recognises common law rights.

What is the next stage once I file the Notice of Opposition?

Once the Notice of Opposition is filed, the Registrar takes it on record and serves a copy on the Applicant (with an official intimation to the Opponent) inviting their attention to file a Counter Statement. The Applicant is required to file the Counter Statement within two months of the receipt of the Notice of Opposition. If the Applicant fails to file the Counter Statement within the stipulated time, the Applicant is deemed to have abandoned his application.

What are the timelines to be followed for adducing evidence by the parties?

The Opponent is required to adduce evidence by way of affidavit in support of the opposition within two months of receipt of the Counter Statement. The period is extendable by one month. The Opponent is required to deliver to the Applicant a copy of any evidence filed at the Registry and tell the Registrar that he has done so. Similarly, the Applicant is required to file any evidence in support of the application within two months of the receipt (by the Applicant) of the copy of the affidavit/evidence filed by the Opponent. This period is also extendable by one month.

Thereafter, the Opponent is required to file evidence in reply within one month of the receipt of the evidence filed by the Applicant. The said period is extendable by one month.

If I am not able to file the evidence within the time frame, are there provisions to file evidence at a later stage?

If the evidence is not filed within the prescribed time it can be filed later as 'further evidence'. However this needs to be accompanied with an interlocutory petition explaining the reasons for delay in filing of the said evidence and asking for Registrar's permission to condone the delay.

Once evidence is submitted by both parties, what is the next stage of proceeding?

Once the evidence is filed by both the parties, the matter is listed for hearing at the Trade Marks Registry enabling the parties to submit oral submissions. The Registrar must give prior notice to the parties informing them of the hearing. Within 14 days from receipt of the first notice, the parties must notify the Registrar indicating their intention to attend the hearing.

The Registrar after examining the evidence and hearing both the parties passes a written order. If any party is aggrieved by the order, he/she can file an appeal at the Intellectual Property Appellate Board (IPAB) within three months of its receipt.

What is the time period for an opposition to be decided?

Considering the tremendous backlog at the Trade Marks Registry, it would be difficult to estimate the exact time period for conclusion of the opposition proceeding. Roughly, it takes 3-4 years for a contested opposition to be decided.

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