

All **T**hings IP



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Rectification / Removal of a trademark

Have you come across a registered trademark that is similar to your prior mark? And have you missed to oppose such a trademark prior to its registration? Or has any cancellation request been filed against your registered trademark by a third party on the grounds that you have stopped using your trademark after registration or because it is similar to another party's trademark? These are some important questions that brand owners face in relation to their trademarks, the answers to which we have briefly covered in our present newsletter.

What is rectification/cancellation of a trademark?

Any person aggrieved by the registration of another trademark may initiate an action for rectification/cancellation or removal of a trademark from the register of trademarks or to correct or rectify an error or an omission made in the trademark register against a registered trademark.

Unlike in opposition proceedings, in a rectification/cancellation petition, the person filing the petition should have a significant interest and should be able to prove considerable damage if the mark of a third party that has been registered and continues to remain on the register.

Sections 47 and 57 of the Trademarks Act, 1999 contains the provisions relating to the grounds for filing of trademark cancellation or rectification. Broadly, Section 47 contains provisions for filing of a rectification or cancellation application against registered trademarks on account of non-use and Sections 47 and 57 of the Trademarks Act, 1999 contains the provisions relating to the grounds for filing of trademark cancellation or rectification. Broadly, Section 47 contains provisions for filing of a rectification or cancellation application against registered trademarks on account of non-use and Section 57 contains provisions for filing of a rectification or cancellation application against registered trademarks inter-alia on account of:

- i. Contravention or failure to observe a condition entered in the Register in relation to the registration of a mark.
- ii. That the registration was made without sufficient cause or registration was obtained by fraud or misrepresentation of facts or it was similar to an earlier registered mark.
- iii. The Register suffers from the absence or omission of an entry like any condition or limitation on the registered trademark.
- iv. That the mark was wrongly remaining on the register i.e. it is contrary to some of the provisions of the Act or likely to cause confusion in the minds of the public.
- v. Non-renewal of the trademark.

We shall, in this edition briefly discuss the grounds for filing an application for trademark rectification, cancellation or removal under Section 47 of the Trademarks Act, 1999 for non-use. An application for non-use under Section 47 can be filed on the following grounds:

- i. The trademark was registered without any bona fide intention of use on part of the owner.
- ii. The trademark has not been used for a continuous period of 5 years from the date of registration of the mark and three months prior to filing the application for registration.



In view of the above, any trademark which has been registered and not used for a continuous period of 5 years from the date on which the trademark is entered in the register of trademarks (the "Register"), the registration of such trademark may be removed from the Register for non-use, based on an application by a third party. Accordingly, it is pertinent to note that if the trademark is being applied on a proposed to be used basis in India, it is imperative to commence using the trademark at the earliest to avoid such removal from the Register for non-use.

Further, on the other hand, if a brand owner wishes to seek removal of a similar registered trademark which has not been put to use and has been filed without any bona fide intention of use, a rectification application can be filed against the same after thorough market investigation to confirm the non-use of the trademark by the registered proprietor. In this regard, it is essential to understand the principles of what constitutes use of a trademark under the provisions of the Trademarks Act, 1999.

What constitutes use of a trademark in India?

An indicative list of what is considered as usage of trademark is provided hereinbelow:

- Actual usage on goods and services;
- When there is no actual use on goods or its sale, any promotional material can be construed as use;
- Use of one of the associated trademarks equivalent to use of another;
- Use of trademark for export trade as given;
- Use of trademark by a registered user or through licensing;

Common defenses available against non-use of a trademark

Some of the indicative common defenses which are taken by the registered proprietor to justify the non-use of their trademark are as under:

- Sluggish market conditions.
- Lack of demand for the goods or the product becoming absolute.
- Import restrictions on certain goods by the Government.
- Other avoidable situations like pandemic, wartime restrictions, etc.

Procedure for trademark rectification/cancellation:

The procedure, in a nutshell, for filing an application for rectification or cancellation is that such application can be filed either with the Registrar of Trademarks or the Intellectual Property Appellate Board (IPAB) along with the prescribed fee. The application must include a statement of case setting out the facts on which the case is based and the relief that is sought. Upon receipt of the application, the Registrar or IPAB serves notice to the registered proprietor of a trademark against which a rectification action has been filed, to file a counter statement. Subsequently, the parties are required to submit their respective evidences by way of an affidavit in support of their case. Thereafter, hearings will be appointed to decide the case on merits.

Conclusion

It is essential to take certain precautionary measures to prevent rectification or removal of registered trademarks from the register on account of non-use by continuously using the marks and by way of maximizing the promotion and advertisement of the trademark through all platforms. In our next article, we shall discuss regarding the rectification/cancellation of trademarks on other grounds as covered under Section 57 of the Trademarks Act.

