

All Things IP



Eshwars | House of Corporate & IPR Laws

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Rectification / Removal of a trademark

In our August 20's **All things IP Newsletter**, we had discussed regarding the grounds for filing of trademark cancellation or rectification under Section 47 of the Trademarks Act (the "Act") on account of non-use of a trademark.

In this edition, we will briefly cover the scenarios/provisions which broadly fall under Section 57 of the Act for filing of a rectification or cancellation action against registered trademarks inter-alia on account of:

- Contravention or failure to observe a condition entered in the Register in relation to the registration of a mark.
- A registration that was made without sufficient cause or registration was obtained by fraud or misrepresentation of facts or it was similar to an earlier registered mark.
- Absence or omission of any entry relating to a trademark registration, like any condition or limitation on the registered trademark.
- 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.
- Non-renewal of the trademark.

Any aggrieved person may file a cancellation/rectification action based on any of the aforesaid reasons seeking a rectification of register or cancellation or removal of a registered trademark from the register of trademarks.

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.

Further, in case there is any infringement suit pending before a civil court and where the defendant in the suit is contesting the validity of the plaintiff's trademark, the power to hear applications for rectification of such trademarks vests only with IPAB and not with the Registrar.

How to prevent your trademark from being Rectified from the Trademark Register

- By safeguarding the distinctive character of the mark and avoiding it becoming deceptive.
- By timely renewal of your trademark.
- By continuous and extensive usage of your trademark.
- Taking appropriate legal action in case there is any infringement of your trademark.



Conclusion

Securing registration of your trademark alone is not enough to safeguard your rights in the trademark. As a registered proprietor, it is crucial to preserve the distinctiveness of the trademark by continuous and widespread usage and promotion as well as timely maintenance of your trademark.

We at Eshwars regularly advise our clients on various aspects of filing and defending rectification, cancellation and removal of trademarks related actions and represent our clients before the Trademark Registry and IPAB. For more information, please reach out to us at: saisunder@eshwars.com.