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De-Coding Indian Intellectual Property Law

Place the (Trade Marks) Act Before the Rules: Del HC Directs Registry to Record Grounds of Refusal of Applications

by [Latha Nair](#) October 30, 2019



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In a much-lauded [decision](#), Justice J. R. Midha of the Delhi High Court has made it easier and quicker for applicants to appeal a decision of the Registrar of Trade Marks arising from a refusal or partial acceptance of a trademark.

This decision arises from a writ petition (*Intellectual Property Attorneys Association v. Controller General of Patents, Designs, Trade Marks & Anr*) that challenged the non-speaking orders passed by the Registrar of Trade Marks while refusing trademark applications. The petitioner, Intellectual Property Attorneys

Association (IPAA), argued that such orders were in violation of Section 18(5) of the Trade Marks Act, 1999 (“the TM Act”). The said section reads as follows:

“Section 18: – Application for registration:

.....

(5) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decisions.”

IPAA further pointed out that Rule 36 of the Trade Marks Rules, 2017 is inconsistent with Section 18(5) of the TM Act. Rule 36 reads as follows:

“36(1) Decision of the Registrar: The decision of the Registrar under Rules 33, 34 & 41 shall be communicated to the applicant in writing at his address of service and if the applicant intends to appeal from such decision he may within thirty days from the date of such communication apply in Form TM-M to the Registrar requiring him to state in writing the grounds of, and the materials used by him in arriving at his decision.”

The Court accepted the argument of IPAA and held that Rule 36 is arbitrary, unreasonable and inconsistent with the mandatory provision of the statute, namely, Section 18(5) in so far as it empowers the Registry to communicate the decision of the Registrar without the grounds of refusal or conditional acceptance. Accordingly, it observed that Section 18(5) would prevail over Rule 36.

The effect of the decision for an aggrieved applicant is two-fold: *first* is that it reduces one procedural step in the appeal process, namely, applying to the Registrar, seeking the grounds of refusal or conditional acceptance. Secondly, it saves the time of an aggrieved applicant in waiting for the written communication of the Registrar of the grounds of refusal or conditional acceptance before it can file an appeal.

More importantly, this ruling is bound to increase the transparency at the Trade Marks Registry.