



Suggestions/Comments on A Draft of Manual of Trade Marks Practice and Procedure

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Background

The Office of the Controller General of Patents, Designs, and Trademarks (hereinafter referred to as “CGPDTM” or “IP Office”) issued a notification calling for comments and suggestions on existing intellectual property (IP) manuals and Guidelines on August 20, 2023. In furtherance of the said notification, Trademark attorneys at BananaIP Counsels (“BananaIP”) are hereby submitting their views and suggestions with respect to the Draft of Manual of Trademark Office Practice and Procedure (“Manual”) for the CGPDTM’s consideration. These comments are being submitted with the bonafide and honest intent of enabling the IP Office improve the Manual based on experiences of different stakeholders.

The comments and suggestions in this document are divided into five (5) parts. They are:

- I. Consonance with the Amended Rules
- II. Accessibility of the IP Process/Systems to Persons with Disabilities
- III. Filing Process
- IV. Examination and Hearing Process
- V. Opposition Process
- VI. Withdrawal Option



Comments/Suggestions

I. Consonance with Amended Rules

The Trade Mark Rules have been amended in the year 2017, which resulted in changes of Forms and Fees for Trademark Prosecution/Oppositions/Records, etc. The current Manual incorporates the rules that were in force when it was issued, and not the current rules.

Suggestion:

The Manual may be modified to bring it in consonance with the Trade Marks Rules, 2017. Along with the latest provisions and rules, the new forms and fees, and recent judicial pronouncements interpreting the provisions may also be included in the Manual for the reference of Trademark Agents and Officers.

II. Accessibility of the IP Process/Systems to Persons with Disabilities

Owing to the advantages offered by the IP profession that makes it possible for persons with disabilities to practise independently, and earn a dignified livelihood, the number of IP attorneys and agents with disabilities is increasing. Additionally, many persons with disabilities are not only entrepreneurs and applicants, but also use the website and the online systems of the IP Office for trademark, GI, and related information. To facilitate the accessibility of information, systems, and the IP process, the IP Office has taken the much-needed step of issuing Guidelines for Accessibility and Reasonable Accommodations in March, 2022. However, many officers in the IP Office are not fully aware of these guidelines, and the need to facilitate accessibility and reasonable accommodations. To address this issue, and to integrate accessibility into IP processes and systems, a section on accessibility may be included in the Manual of Trade Marks and other forms of IP.

Proposed Language for Inclusion in the Manual

The following para may be considered for inclusion in the Manual:

“Accessibility to Persons with Disabilities

The IP Office recognizes the need to facilitate accessibility of its website, processes, and systems to persons with disabilities, and is committed to taking accessibility steps and providing reasonable accommodations. Towards this end, the Office of CGPD TM has issued ‘Guidelines for Accessibility and Reasonable Accommodations on 4th March 2022. To implement the same, all controllers, examiners, and other officers shall:

- i. Provide the requisite accessibility measures and reasonable accommodations as stated in the guidelines for accessibility and reasonable accommodations, and as required under the Rights of

Persons with Disabilities Act, 2016, and rules/guidelines framed thereunder;

- ii. Provide the reasonable accommodations recommended by the nodal officer appointed to address accessibility issues of persons with disabilities.
- iii. Acknowledge communications from persons with disabilities relating to accessibility within twenty-four (24) hours, and confirm if a requested accessibility measure and/or accommodation will be provided or not;
- iv. Give reasons in writing if a requested/recommended accessibility measure or accommodation cannot be provided without undue delay, and bearing in mind the statutory timelines applicable for a given case/file; and
- v. Not require the person with a disability to pay fee for processing an accessibility request, or to provide a reasonable accommodation such as adjournment or time extension to address accessibility issues.”

III. Filing Process

The moving of trademark filing, search, and processes online has significantly contributed to ease of trademark filing, prosecution, and other activities before the Trademark Registry. To its credit, the Registry has proactively shifted all the documents, filing process, prosecution process, opposition process, renewal process and other processes relating to trademarks to an online portal. The filing process of the Manual explains the offline filing process in great detail. However, it lacks a detailed explanation of the online filing process. Also, there is no clarity about the process regarding sound marks.

Suggestions:

In the context of the online facilities and related activities, the IP Office may consider the following suggestions:

1. The IP Office may consider including specific guidelines with respect to the approach, format, requirements, and digital signature for the online filing of applications and other forms; and
2. With respect to sound marks, it would be helpful if the Manual explains the process, requirements and format for filing Sound Marks and the process of their examination.

IV. Examination and Hearing Process

While the examination process has significantly improved over the years, certain issues with the process continue to subsist. Some of these issues are responsible for delays in processing trademark applications. The issues are as follows:

- a. Although the Manual includes the mandate to serve the Examination Report to the applicant, the proper service of the Examination Report is not carried out efficiently, and in certain situations, the examination reports are not served at all;
- b. Some examination reports lack clarity, and raise objections not covered under any provision of the Trademarks Act or Rules, which makes it difficult for applicants and agents to respond appropriately; and
- c. Some scrutiny reports seek payment of stamp duty that exceeds the duty that is provided under statutes of different states.

Suggestions:

The IP Office may consider including specific guidelines with respect to the approach, format, and analysis of statutory provisions and similar marks that may form part of examination reports. The manual may also include specific and clear guidance on the mechanism to be adopted for raising reasoned objections. This would help the applicant understand objections and respond appropriately.

Additionally, the IP Office may consider providing clarity on stamp duty, and establish a process for addressing situations where notices, examination reports, and other documents are not served after being uploaded online.

V. Opposition Process

The opposition process is well-defined and laid out in the Manual and is generally conducted in an organized manner. However, some oppositions have been served on applicants though no grounds have been submitted. Additionally, though the pace of opposition proceedings has significantly improved, many old oppositions have been kept pending for a long period of time.

Suggestions:

The IP Office may consider incorporating the step of formalities check for oppositions within the Manual. The same may also be provided online for the benefit of attorneys and agents. Additionally, it will be helpful if the IP Office can provide some guidance in the Manual on expediting oppositions that have been pending for more than seven (7) years.



VI. Withdrawal Option

At present, the Manual does not include a process for withdrawal of trademark applications and attorney representation of applications/registrations.

Suggestion:

The IP Office may consider including guidelines and processes for withdrawing trademark applications as well as for withdrawal of attorney representation.



Disclaimer

The comments, suggestions, and opinions provided in this document are based on the experience and understanding of trademark attorneys at BananaIP counsels. They may not be considered as generalizations of any particular aspect or matter addressed in this document. It is understood that attorneys and experts within and outside BananaIP may have differing opinions, and that the suggestions provided are not the only ways of resolving issues expounded in the document.

The views expressed in this document do not reflect the views of BananaIP's clients.

These comments, suggestions, and opinions with respect to the Manual of Trade Marks have been submitted with the bonafide and honest intent of aiding the Office of Controller General of Patents, Designs, and Trademarks improve the Manuals, and make the IP process more transparent, accessible, certain, and efficient.

About BananaIP:

BananaIP's Attorneys have been filing and prosecuting trademark applications over the last 20 years. The comments in this document are based on their experience in the field, ongoing research activities, and expertise in Trademark Law.

Contact information:

Given the opportunity, we will be happy to give a presentation regarding the comments in this document. For any questions/clarifications regarding the document, please feel free to contact us on: ip@bananaip.com and/or on +91-7625-093765/+91-80-26860414/24/34.