



**THE NEED FOR REFORMATION: A
REALISTIC ANALYSIS OF THE
OPPOSITION PROCESS UNDER
INDIAN LAW**

**(Under the Trade Marks Act, 1999 read-
with
Trade Marks Rules, 2017)**

*By Shivram Ganesan
From Anand College of Legal Studies,
Sardar Patel University*

ABSTRACT

An evaluation of the governing rules pertaining to the opposition proceeding(s) in India under the Trade Marks Act, 1999, and global standpoint of the opposition procedures in the United States of America, Switzerland and EUIPO. The Author has

suggested three propositions for remodelling a realistic and analytic approach in structure thereto.

PREAMBLE:

In India, during the process of registration of a trade mark, one encounters two instances where the rejection or refusal of the trade mark can be invoked. The two instances can be either objection and/or opposition. The former entails the examination of the applied trade mark of the person for the registration by the examiner(s) appointed under the Trade Marks Act, 1999 (Act) who examines whether the said applied trade mark meets the requirements of the Act and the Rules made there-under namely the Trade Marks Rules, 2017 (Rules) and may also raise objections upon the scrutinize of the said applied trade mark on any ineligibility under section 9¹ of the Act (absolute grounds for refusal of registration) or section 11² of the Act

¹ Absolute grounds for refusal of registration.— The trade marks—

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;
(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, shall not be registered: Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

(2) A mark shall not be registered as a trade mark if—
(a) it is of such nature as to deceive the public or cause confusion;

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;

(c) it comprises or contains scandalous or obscene matter;

(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).

(3) A mark shall not be registered as a trade mark if it consists exclusively of—

(a) the shape of goods which results from the nature of the goods themselves; or

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods. Explanation.—For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.

² Relative grounds for refusal of registration.—

(1) Save as provided in section 12, a trade mark shall not be registered if, because of—

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or



(relative grounds of refusal of registration), whereas the latter is the process initiated by the brand-owner/third party (Opponent), who may be registered proprietor /right holder or prior user of the trade mark, using as enforcement remedy or strategy to protect their trade mark by opposing the said applied trade mark. An Opponent may be able to put into effect of such enforceability approach within a predetermined time when the applied trade mark (Impugned Mark) of the person (Applicant) is identical or deceptively similar (having phonetic/ aural elements and/or, structural/ visual appearance or conceptually) or is likely deceive the public and cause confusion among the general public so as to the Opponent's trade mark or filed the Impugned Mark by the Applicant with bad faith and with the intention to trade upon the goodwill of the Opponent. Alternatively, there are instances where the Opponent are simply using their rights by filing frivolous and vexatious oppositions for the purpose for claiming exclusivity and to harass/create an obstacle to the registration of the Applicant's Trademark, when on comparison the two marks may seem to be poles apart and dissimilar.

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(2) A trade mark which—

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered, if or to the extent, the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

It is therefore imperative for the Applicant to choose their trade mark/ brand name carefully and should seek the opinion and advise from an IP attorney before filing it. It usually takes 6 to 15 months for registration subject to the Examination Report issued by the examiner i.e. regarding the objection raised thereto and no Notice of Opposition is filed against the Applicant by any Opponent. By this way, the Applicant will avoid unnecessary obstacles and would be able to accelerate their application/registration process and obtain statutory rights and trademark protection as a result.

Governing Rules under the Trade Marks Act of 1999:

On a flow chart, the trademark registry has described the steps³ for processing trademark registration applications and they are listed as follows

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

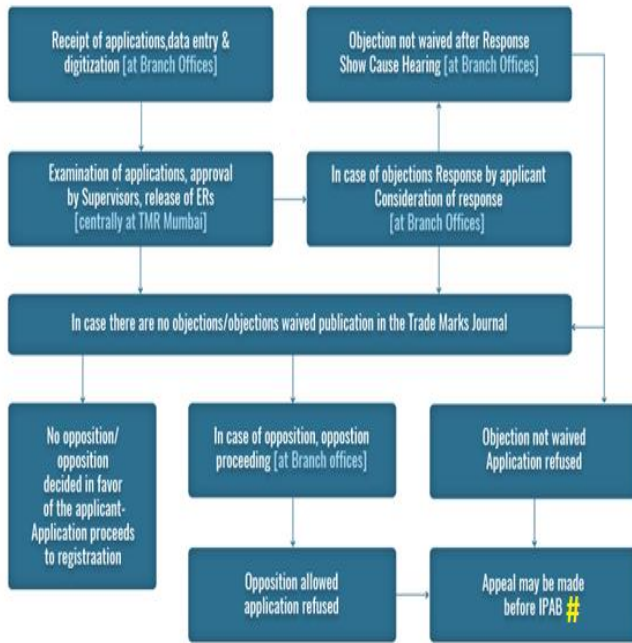
(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or

(b) by virtue of law of copyright. (10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

(i) protect a well-known trade mark against the identical or similar trade marks;

(ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

³ <https://ipindia.gov.in/workflow-chart.htm>



#4: Appeal procedure has been transferred to the respective High Court(s). There has been no direction by the respective High Court(s) except the Hon'ble Delhi High Court⁵ which has established Intellectual Property Division to deal with intellectual property matters.

An Opponent may initiate opposition(s), cancellation(s) and rectifications against the applied trade mark, as provided by the Act. Oppositions refer to the situation where the applied trademark is published in the trademark journal while cancellations and rectifications refer to the situation where the applied trademark has been received the registration.

A Report of Opposition/Rectification Applications filed at the various offices in India for the Last three years and disposal thereof is reproduced below:

Year	2018-19 ⁶		2017-18 ⁷		2016-17 ⁸	
	Opposition/Rectification filed	Cases disposed	Opposition/Rectification filed	Cases disposed	Opposition/Rectification filed	Cases disposed
Ahmedabad	5774	4737	6228	6161	3078	2561
Chennai	9773	7356	7414	7361	5498	1776
Delhi	18176	24965	17065	16633	16885	7914
Kolkata	3419	1964	2421	2406	1695	4002
Mumbai	13692	11741	9591	8970	6726	7649
IR Division	1141	65	731	4	Not available	Not available

⁴ <https://egazette.nic.in/WriteReadData/2021/226364.pdf>

⁵ https://delhihighcourt.nic.in/writereaddata/Upload/PublicNotices/PublicNotice_4W1UGE3WNT9.PDF

⁶ https://ipindia.gov.in/writereaddata/Portal/Images/pdf/IP_India_Annual_Report_2019_Eng.pdf

⁷ https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_110_1_Annual_Report_2017-18_English.pdf

⁸ https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_94_1_1_79_1_Annual_Report-2016-17_English.pdf



Under section 21⁹ of the Act read-with Rule 42 to 51 of the Rules, specifically, the process of opposition is outlined, together with the detailed time-period pertaining to the opposition proceedings. The process is outlined below:

Rule 42: Notice of Opposition: *To be filed within four months from the date of advertisement in the trademark journal where the Impugned Mark is advertised by way of Notice of Opposition in Form TM-O by the Opponent.*

Rule 44: Counter Statement: *To be filed within two months from the receipt of the notice of opposition by the Applicant in Form TM-O. If the Applicant does not opt to file the Counter Statement within said two months, the Applicant is deemed to have abandoned the applied trade mark.*

Rule 45 Evidence in Support of Opposition: *If the Applicant files the Counter-Statement, within 2 months (Extendable by One Month¹⁰) of the receipt of the counter-statement the Opponent can file evidence, by way of an Affidavit. The Opponent can also opt to write to the Registrar stating that they do not desire to file evidence but instead intends to rely on the facts stated in the Notice of Opposition (Reliance Letter by the Opponent).*

Rule 46: Evidence in Support of Application: *Upon receipt of the evidence of the Opponent or the Reliance Letter by the Opponent, the Applicant shall within 2 months (Extendable by One Month¹¹) file evidence, by way of an Affidavit. The Applicant can also opt to write to the Registrar stating that they do not desire to file evidence but instead intends to rely on the*

⁹ Opposition to registration.—

(1) Any person may, within three months from the date of the advertisement or re-advertisement of an application for registration or within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration.

(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar,

and the Registrar shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just.

10 Sahil Kohli v. The Registrar of Trade Marks & Anil Verma (IPAB – OA/6-8/2018/TM/DEL)

11 Sahil Kohli v. The Registrar of Trade Marks & Anil Verma (IPAB – OA/6-8/2018/TM/DEL)



facts stated in the Counter Statement (Reliance Letter by the Applicant).

Rule 47 Evidence in reply: *Thereafter, the Opponent is allowed by 1 month from the receipt of evidence filed by the Applicant to give rebuttal on the evidence filed by the Applicant or the Reliance Letter by the Applicant (commonly known as the rejoinder in the principle of pleading).*

Rule 50: Hearing: *Based on the notice of opposition, counter statement, and evidences/ Reliance Letter by the Opponent, Reliance Letter by the Applicant filed by the parties, the Registrar shall call for a hearing. Within fourteen days of receipt of the notice of hearing, the parties are required to notify the Registrar of their intention to appear in the matter. Finally, the matter is heard by the Registrar and decided upon merits.*

Registration or rejection: *If the registrar decides in favour of the Applicant, the Impugned Mark will be registered and registration certificate will be issued. If the*

registrar decides in favour of the Opponent, then the Impugned Mark shall be rejected.

It is evident to note from the above that the entire pleading to be completed in the opposition proceeding by the Opponent and Applicant takes about 9-11 months and the adjudication of the proceeding also takes years to reach a conclusion. Thus, the underlying question is whether the opposition serves as an effective remedy for the Opponent if they are the registered proprietor of the trademark or prior user.

Opposition proceedings have been hampered by the following factors:

Nonetheless, the opposition proceeding primarily gives the Opponent an advantage by giving them a legal right to oppose against the Applicant who applied for the Impugned Mark based on legitimate grounds (absolute grounds under section 9 of the Act or relative grounds of refusal as provided under section 11 of the Act or infringement of registered trade marks of the Opponent as provided under section 29¹² of the Act) after the

¹²Infringement of registered trade marks.—

(1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair



Impugned Mark is published in the Trade Mark Journal. The pleas, claims and contentions in the Notice of Opposition must be in accordance with Rule 43 of the Rules.

However, upon the Impugned Mark been opposed there are several ways to categorize for the setbacks:

Factors encountered			
Opponent	Applicant	Trademark Registry/ Judicial process	General Public
<ul style="list-style-type: none"> Multiple proceeding to be initiated by the Opponent to safeguard their lawful right by filing civil suit or criminal complaint; 	<ul style="list-style-type: none"> Aggrieved with frivolous and malicious proceeding and to wait for the statutory rights of the trademark; Uncertainty and clarity of the future of the trademark 	<ul style="list-style-type: none"> Lack of adequate officers to adjudicate the opposition; The same is only required to adjudicated either by Assistant Registrar/ Deputy Registrar or the Registrar Excess backlog of the pending matter 	<ul style="list-style-type: none"> Confusing in the market when the Opposition proceeding is sub judice

advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material

intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or
- (c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.



<ul style="list-style-type: none"> • Increased cost of litigation • Relief under opposition do not give ad-interim injunction for unfair usage of the Impugned Mark by the Applicant • No cooling period to stop the unfair usage of the Impugned Mark by the Applicant and the same continuously to be in the market 	<p>and to alternative remedy except by way of settlement with the Opponent</p> <ul style="list-style-type: none"> • Fear of losing the trademark and amount time, money, energy and hard work wasted in creating the brand • To defend generic trademark registered by the Opponent and the same may lack inherent inherently distinctive and being common to trade. 	<ul style="list-style-type: none"> • Limited power to the Registrar for adjudication¹³. • Right to appeal from the decision of the Registrar (accepting/rejecting the opposition is to be transferred to the respective High Court(s) or to appropriate forum, in view of abolishment of the Intellectual Property Appellate Board¹⁴ • Excessive burden to be faced by the respective High Court(s) • Requires judicial mind by necessity of 	
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¹³ Section 127 In all proceedings under this Act before the Registrar,—

(a) the Registrar shall have all the powers of a civil court for the purposes of receiving evidence, administering oaths, enforcing the attendance of witnesses, compelling the discovery and production of documents and issuing commissions for the examination of witnesses;

(b) the Registrar may, subject to any rules made in this behalf under section 157, make such orders as to costs as he considers reasonable, and any such order shall be executable as a decree of a civil court:

Provided that the Registrar shall have no power to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or provision of services or to authorise the use of the mark;

(c) the Registrar may, on an application made in the prescribed manner, review his own decision

¹⁴ *ibid*: <https://egazette.nic.in/WriteReadData/2021/226364.pdf>



<ul style="list-style-type: none"> No cost for damages are awarded 		technical member(s) be appointed	
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Global perspective:

There is no standard procedure for opposition set out under the agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) member countries are free to have their national laws pertaining to the opposition procedure. However, in the Opposition procedures are shall be impliedly governed by the general principles set out in paragraphs 2 and 3 of Article 41 wherein it is obligated to the member countries to give fair and equitable procedure and the same not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delay in the enforcement of the intellectual property rights.

However, in a working document on trademark opposition procedures prepared by the Secretariat for Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has following observation¹⁵ were made:

- in addition to the publication of a trademark application or a trademark registration in paper form, the application may be published in electronic form;
- the opposition may be examined by an examination officer, a collegial body of examiners or a board including a trademark judge;

- the opposition system may permit any person to lodge an opposition, limit the entitlement to file an opposition to persons having a legitimate interest, or specifically define the circle of persons entitled to bring an opposition;
- the opposition period may consist of one single, non-extendable term, or of an initial term and several extensions;
- the different procedural steps may be as follows:
 - notice of opposition submitted by the opponent;
 - formal examination of the notice of opposition by the Office;
 - notification of the opposition to the applicant or holder;
 - exchange of further evidence;
 - final decision by the Office;
 - settlement negotiations may take place between the parties during the time the initial opposition period is extended, while the opposition proceedings are suspended on joint request of both parties, or during a so-called “cooling-off” period starting after the opposition has been notified to the applicant or holder;

¹⁵ https://www.wipo.int/edocs/mdocs/sct/en/sct_17/sct_17_4.pdf



– an extension of time limits may particularly be available in the period during which the parties exchange arguments and evidence;

– against the final decision of the opposition body, an appeal to a specific board of appeals at the Office, a specific government commission, an appointed appellate tribunal, the courts in general, or a specific trade or patent court may be possible.

India has ranked 48th in the list of top 50 innovative countries in the World Intellectual Property Organization (WIPO) global ranking¹⁶ for 2020. In view of the above an analysis and comparison on the opposition procedure adopted by the United States of America, Switzerland and European Union Intellectual Property Office (EUIPO) are set out forth:

USA

USA has ranked 3rd in the list of top 50 innovative countries in the World Intellectual Property Organization (WIPO) global ranking¹⁷ for 2020

Upon the applied trademark is published in the Official Gazette, the Opponent can file a notice of opposition on relevant grounds (Absolute grounds; non-compliance of formal requests; Abandonment of mark; Fraud; Dilution), within 30 days (extendable up to 30 days and maximum up to 180 days) before the Trademark Trial and Appeal Board (TTAB) of the USPTO. If no

opposition is filed within the prescribed period, the application proceeds for registration.

If a notice of opposition is filed, the TTAB issues an institution order and the same is duly served upon the applicant and the applicant is required to file an answer within the prescribed period of 40 days (extendable upon request)¹⁸. If no response is filed, a Notice of Default is issued and the applicant is required to show cause for the same, failing which the application is abandoned.

Afterwards, the parties are required to enter a Discovery Conference within 30 days, wherein the parties discuss their respective claims and evidences and subsequently are required to file their respective evidences within the prescribed period of 30 days and 15 days for the opponent to file a rebuttal to the applicant's evidence.

Once the pleadings are complete, the matter proceeds ahead for hearing with the TTAB, which can be reconsidered upon request of any party within 30 days. An appeal against the decision of the TTAB may be filed by any party in the Court of Appeals for the Federal Circuit or request a new trial before the U.S. District Court within the prescribed period of 2 months¹⁹.

India has almost identical procedure when compared to the procedure adopted by the USA.

Switzerland: Switzerland has ranked 1st in the list of top 50 innovative countries in the World Intellectual Property Organization

¹⁶ Ibid:
https://www.wipo.int/edocs/pubdocs/en/wipo_pub_gi_i_2020.pdf

¹⁷ https://www.wipo.int/edocs/pubdocs/en/wipo_pub_gi_i_2020.pdf

¹⁸https://ipo.org/wp-content/uploads/2015/02/Trademark-Oppositions-in-the-United-State_CKrechevsky_Final_As-Published-by-ECTA_052714.pdf

¹⁹https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_1.pdf



(WIPO) global ranking²⁰ for 2020. In Switzerland, trade marks are protected by the Federal Act on the Protection of Trade marks and Indications of Source ("Swiss Trade Mark Protection Act") as well as the Trade mark Protection Ordinance. The Swiss Institute of Intellectual Property (IPI) issues guidelines on opposition proceedings.

Opposition Procedure at IPI, Switzerland

The opposition proceeding must be initiated in writing within three months. From this point on, the formal opposition is filed with the IPI. The IPI subsequently carries out an examination and, in this context, evaluates the identification of the opponent, the register or application number of the relevant trade marks, and the legal scope and the grounds of the opposition. In addition, the IPI checks whether the required opposition fee has been paid by the opponent in due time.

In the event all requirements are met, the IPI sets a time limit for the counterparty to submit a written response. The counterparty's statement is usually followed by a second exchange of correspondence. The opposition proceedings are thus exclusively conducted in writing and are terminated at the latest after the second exchange of correspondence by means of a decision of the IPI, resulting in rejection or approval.

Requirement of the Opposition: The owner of an earlier trade mark may file an opposition against the registration of a later trade mark with the IPI on the basis of so-called relative grounds for refusal. In this case, the opposition must be filed within three months after the publication of the registration, stating the legal grounds for the

opposition. An extension of the time limit for filing an opposition is not provided for by law. Within the same period, the opponent must also pay the official opposition fee. In the case of an international registration designating Switzerland, the opposition period begins on the first day of the month following the month of publication in the IR-register. In addition to an earlier registered trade mark, a well-known trade mark is also considered to be an earlier trade mark. Furthermore, the owner of a filed – but not yet registered – trade mark is authorised to file an opposition. Hence, owners of unregistered trade marks (in Switzerland) are entitled to file an opposition against a later trade mark, provided that the trade mark either qualifies as a notorious or well known trade mark in Switzerland or has at least been applied for with the IPI.

India has almost identical procedure when compared to the procedure adopted by Switzerland.

European Union Intellectual Property Office (EUIPO)

From the date of publication onwards, third parties i.e. Opponent who believes the trade mark should not be registered have three months to object. The underline motive for objecting can be earlier right or absolute ground.

Earlier right: The Opponent has an earlier right (or more than one) and believes that Impugned Mark will, if registered, conflict with it

Absolute Ground: The Opponent considers that mark s Impugned Mark should not have

²⁰

Ibid:
https://www.wipo.int/edocs/pubdocs/en/wipo_pub_gi_i_2020.pdf

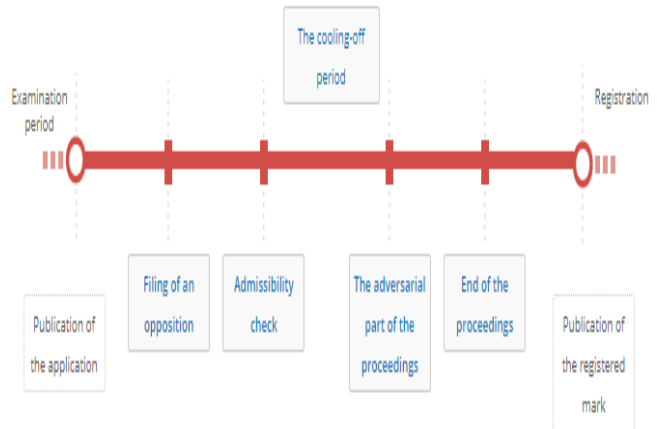


been accepted, then they can invoke any 'absolute ground' that they deem see fit. Absolute grounds are requirements that Impugned Mark needs to satisfy like being distinctive, non-descriptive of the business the Applicant are in and clearly represented. To oppose Impugned Mark, they should send a corresponding communication to the Office explaining why they believe the trade mark should not be registered. This method is called 'third party observation' and it is free of charge. However, it should only be used when a serious reason for contesting the trade mark exists. Once the observations are received, the Office will issue a receipt to the person making the observations (the 'observer'), and the observations will be communicated to the Applicant. Thereafter, the observer will not receive any further communication from EUIPO. In particular, the observer will not be informed about the outcome of any re-examination of the application.

Opposition procedure in EUIPO²¹

As a matter of fact, one in five applications for EU trade marks is opposed by the owners of trade marks that are already on the market. Decisions on these disputes are made after both parties, the applicant and the opponent, have submitted evidence and arguments. The applicant can minimise the risk of opposition by searching for potential conflicts before they apply.

The following diagram will give an overview of the various steps of the opposition proceedings:



India does not have the pre- registration method for objecting as adopted by EUIPO.

A REFORM OF THE INDIAN OPPOSITION PROCEEDINGS: AN EMERGING NEED:

Opposition rules need reforming, and to consider the proposal to amend the rules to include the following proposition:

Proposition No. 1

Rule 42: Notice of Opposition: To be filed within Three month from the existing Four months from the date of advertisement in the trademark journal where the Impugned Mark is advertised by way of Notice of Opposition in Form TM-O by the Opponent.

Rule 42A: Preliminary maintainability of the Notice of Opposition: The right to object to Preliminary maintainability of the Notice of Opposition should be adjudicated before the Notice of Opposition is served upon the Applicant. The frivolous can be dismissed straight-way and the Applicant Impugned

²¹ <https://euiipo.europa.eu/ohimportal/en/registration-process>



Mark would be get the registration at the earliest.

Rule 44: Counter Statement: Only upon the maintainability, of the Notice of Opposition Applicant to file Counter Statement within One month from the existing Two months from the receipt of the notice of opposition on merits by the Applicant in Form TM-O. If the Applicant does not opt to file the Counter Statement within said two months, the Applicant is deemed to have abandoned the applied trade mark.

• **Proposition No. 1A**

Alternatively,

Merger Rule 42: Notice of Opposition (Initial Notice of Opposition) To be filed within Three month from the date of advertisement in the trademark journal where the Impugned Mark is advertised by way of Notice of Opposition in Form TM-O by the Opponent

Rule 42A: Preliminary maintainability of the Notice of Opposition: To be filed within Fifteen days: The right to object to Preliminary maintainability of the Notice of Opposition should be adjudicated before the Notice of Opposition is served upon the Applicant. The frivolous can be dismissed straight-way and the Applicant Impugned Mark would be get the registration at the earliest.

Rule 45 Evidence in Support of Opposition: within One month to be file evidence, by way of an Affidavit. The concept of Reliance Letter be deleted.

And Merger Rule 44: Counter Statement with Rule 46: Evidence in Support of Application: Applicant to file Counter Statement along-with evidence by way of an Affidavit within One month from the receipt of Notice of Opposition.

Rule 47 Evidence in reply: Thereafter, the Opponent be allowed by 15 days from the receipt of the Counter Statement evidence filed by the Applicant.

Rule 50: Hearing: Based on the notice of opposition, counter statement, and evidences filed, the Registrar shall call for a hearing. Within fourteen days of receipt of the notice of hearing, the parties are required to notify the Registrar of their intention to appear in the matter. Finally, the matter is heard by the Registrar and decided upon merits.

Rule 50A: Expedite Hearing: The parties should be allowed for expedite hearing, in case of urgency by filing application for preponement of hearing and to be heard at the earliest.

The above suggestion would help in reducing the time-line and the process of the pleading would be completed within 3- 5 months as compared to the existing 9-11 months.

Proposition No. 2

For a speedy decision in the Opposition procedure, it is necessary to appoint a Fast Track Redressal Mechanism Forum in addition to the Registrar and technical members

Proposition No. 3

A cooling-off period should be given where the opponents and applicants seek to resolve



their issues through arbitration and the applicant has the fair level of exclusivity over the exploitation of innovation except when there is bad faith or deception or causes confusion among the general public. During this Cooling-off period settlement agreements and no coercive should be taken.

Final thought:

DID YOU KNOW: The number of trademark applications in India has reached over five million, as of June 10, 2021. M/s. Greenstarline Udyog Private Limited has applied to register the trademark "SONALI FOOD" in class 30 under the trademark application number 5000000²² and as on July 15, 2021 a trade mark bearing application 5046500 has be applied to register the trademark ROXXIT in class 21²³. In the interest of stakeholders, the opposition proceeding should be revamped and streamlined. The suggestion would help in better enforceability actions by the Opponent without going to the Courts and the more innovation which will ultimately India's ranking at the global level.

²² <https://ipindiaonline.gov.in/eregister/eregister.aspx>

²³ <https://ipindiaonline.gov.in/eregister/eregister.aspx>