STANDARD OPERATING PROCESS OF TRADE MARKS APPLICATIONS

Processing of TM Application in Trade Mark Registry

At present processing of TM application is done completely through TM electronic processing System and filing of application is allowed in hybrid mode, i.e. online as well as offline. Currently online filing has reached around 98%. Moreover, all applications received offline get digitized at its initial stage and movement of the file is done through complete electronic mode thereafter.

A brief description of stage wise processing in TMR

A. Pre-Examination Processing:

Filing of application: A Trade Mark Application may be filed online or offline. After digitization of offline applications, both online and offline applications are merged and proceed further for processing through the TM system.

VIENNA Codification: If applied mark consists of figurative elements, codification of the figurative elements is done as per VIENNA Agreement and then application moves for examination. Trade Marks applied as word *per se* directly proceed for examination.

It is expected that all applications which may require VIENNA Codification or otherwise should be processed expeditiously and serially as per priority based on the date of filing of application.

B. Examination of Applications:

It may be noted that allotment of applications for the examination is done by the automated system serially on the basis of the date of filing. Examination in TMR is done in two stages, first examination report is prepared by an Examiner and then the application and examination report is forwarded to Examination Controller for approval. Examination Controller evaluates the examination report, and if found proper, approves it and thereafter the examination report is issued to applicant. However, if some deficiency is noted by the Controller, the examination report is reverted/referred back to the concerned Examiner with suggestions for resubmission/re-examination.

At this stage, application may be accepted or an objection may be raised as per provisions of the TM Act. In case it is accepted, it will be published in TM Journal, else examination report will be issued to the applicant containing office objections which needs to be replied by the applicant within 30 days from the date of receipt of examination report.

It is expected that examination should be done expeditiously and serially as per priority based on the date of filing of application or if any compliances are required, expeditiously and serially as per priority based the date of last compliance, if any.

C. Post Examination Processing:

(i) Consideration of Reply: After receipt of examination report, applicant needs to submit his reply to the office objections within one month time and if he fails to do so, the application is abandoned for want of reply.

If reply is submitted within the prescribed period, the same is considered by the authorized officers for the purpose. Here also, the application is allotted to the authorized officers through the TM system serially on the basis of the date of filing of the response to the examination report. At this stage, the authorized officer may accept application and the same is to be published in the TM Journal. In other cases, where the office objections cannot be waived or found not met, a hearing opportunity is offered to the applicants in all those cases where a decision can adversely affect the interest of the applicant, a hearing opportunity is given as per law.

It is expected that if reply is submitted against the office objections, the same should be considered by the authorized officers expeditiously and serially as per priority based the date of filing of response to the examination report.

(ii) Show-cause hearing: In case the objection/s raised by the office are not met after consideration of reply to the examination report, the application moves for show cause hearing. In show cause hearing, the hearing notices are issued serially to the applicant/ agent through the system and allotment of the cases to the Hearing officers is also done by the TM system automatically.

The scheduling of applications for hearing should also be done serially based on the date of consideration of reply by the authorized officer.

D. Post Advertisement Processing:

After the acceptance of the mark, trademark is published in TM Journal. If no opposition is filed within four months from the date of publication of the trademark, the published trademark becomes eligible for registration.

The issuance of registration certificate is done through automated TM system. The certificate gets automatically issued if no opposition is filed within the prescribed period or where the application has not already been withdrawn by the Registrar of Trade Marks at the request of the applicant.

The Trade Mark once registered is valid for 10 years. The same can be renewed after every 10 years for an indefinite period by paying the prescribed fee on the prescribed form.

E. Opposition:

If the trademark is opposed by any third party after the publication, the same needs to be disposed of as per rules after giving proper hearing opportunity to both the parties. If the opposition is dismissed, the trade mark proceeds for registration and registration certificate is issued to the applicant. In case opposition is allowed, the application gets refused as per law.

It is expected that if any application is opposed, the same should be disposed serially based on the compliance or non-compliance by the party (i.e. Applicant or Opponent) as per provisions of the Trade Marks Act and Rules.

Procedure for disposal of the Rectification proceedings shall be similar to the opposition procedure subject to the provisions of the Trade Marks Act and Rules.

F. Post Registration Trade Mark Management

It is possible for the registered proprietor to record the post registration changes pertaining to proprietor name, address, address for service, assignment or registered user, etc. in the Register of Trade Marks by filing a request on the prescribed form, with the prescribed fee. In case the concerned officer examining the request raises some objections and requires some compliance on part of the applicant, the same should be processed ordinarily within 30 days from the date of compliance by the applicant. It is also a practice of Registry to send one month notice to previous registered proprietor in case any change in proprietorship by way of assignment or transmission is filed by the applicant. In this case, the request can be processed only after expiry of one month notice period as mentioned above.

It is expected that the post registration request shall be examined and processed serially based on the date of filing of the request and date of compliance of the requirements, if any.

The renewal requests received by the Registry are processed through an automated TM system serially based on the date of filing of the request.