

Government of India
TRADE MARKS REGISTRY
Boudhik Sampada Bhavan, S.M. Road, Antop Hill,
Mumbai-400 037, India.

NOTIFICATION OF PROVISIONAL REFUSAL OF PROTECTION OF AN INTERNATIONAL REGISTRATION DESIGNATING INDIA
Rule 17(1) of the Common Regulations.

I.	Office making the notification:	TRADE MARKS REGISTRY, GOVERNMENT OF INDIA														
II.	Number of the international registration: 1455136 (Reference IRDI No allotted to this international registration by the TMR India) 4217449															
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed): Barilla G. e R. Fratelli - Società per Azioni															
IV.	Provisional refusal based on an <i>ex officio</i> examination															
V.	Provisional refusal for all the goods and/or services															
VI.	Grounds for refusal [(where applicable)]: 9(1)(a) - The objection is raised under S 9(1) (a) of the Trade Marks Act 1999, as the mark is a non-distinctive and as such it is not capable of distinguishing the services of one person from those of others., 9(1)(b) - The objection is raised under S 9(1) (b) of the Trade Marks Act 1999, as the mark consists exclusively of words or indications which may serve in trade to designate the kind intended purpose of the goods or rendering of the service or other characteristics of the goods or service. In India, priority is granted on the basis of single priority application covering all classes, goods and services applied for in the birth notification. In the present Madrid application designating India, we note that, the goods/services are claimed from both priority applications. Accordingly, to process further, either claim single priority for all the goods/services mentioned in birth notification or disclaim the priority rights over all the goods/services in the present application by way of filling TM-M															
VII.	Information relating to an earlier mark															
	APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE								
	GOODS SERVICES															
VIII.	Corresponding essential provisions of the applicable law [(see text XII)]: Section : 9(1)(a) ,9(1)(b) ,11(1) , of Trade Mark 1999.															
IX.	Information relating to subsequent procedure : <table border="1"> <tr> <td>(i)</td> <td>Time limit for response or for a request to reconsider the provisional refusal: one month from the date of receipt of provisional refusal by the holder of international registration.</td> </tr> <tr> <td>(ii)</td> <td>Authority to which such request for review or appeal should be made: The response to, or a request for reconsideration of, the provisional refusal must be sent by email at madrid.tmr@nic.in addressing to the Registrar of Trade Marks, Trade Marks Registry Mumbai</td> </tr> <tr> <td>(iii)</td> <td>Indications concerning the appointment of a representative: The response to, or a request for reconsideration of, the provisional refusal must be filed through an agent or a representative whose address is within the territory of India. The said agent may submit on behalf of the owner of the international registration the response or a request for reconsideration of the provisional refusal, submit the evidence of prior use of the trademark in India by the way of owner's affidavit or may agree to limit the scope of protection, or request for personal hearing.</td> </tr> <tr> <td>(iv)</td> <td>In further communication with respect to the aforesaid International Registration, the IRDI No written should always be mentioned</td> </tr> </table>								(i)	Time limit for response or for a request to reconsider the provisional refusal: one month from the date of receipt of provisional refusal by the holder of international registration.	(ii)	Authority to which such request for review or appeal should be made: The response to, or a request for reconsideration of, the provisional refusal must be sent by email at madrid.tmr@nic.in addressing to the Registrar of Trade Marks, Trade Marks Registry Mumbai	(iii)	Indications concerning the appointment of a representative: The response to, or a request for reconsideration of, the provisional refusal must be filed through an agent or a representative whose address is within the territory of India. The said agent may submit on behalf of the owner of the international registration the response or a request for reconsideration of the provisional refusal, submit the evidence of prior use of the trademark in India by the way of owner's affidavit or may agree to limit the scope of protection, or request for personal hearing.	(iv)	In further communication with respect to the aforesaid International Registration, the IRDI No written should always be mentioned
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X.	Date of the notification of provisional refusal: 29/07/2019															

XI.	Signature or official seal of the Office making the notification: FOR REGISTRAR OF TRADEMARK Florina S. Almeida Designation: EXAMINER Mumbai
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XII.	Corresponding essential provisions of the applicable law: Trade Marks Act, 1999 Sec 9: Absolute grounds for refusal of registration: 1. 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. (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. Section 11: 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 (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. Section 12: Registration in the case of honest concurrent use, etc. In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose. Section 13: Prohibition of registration of names of chemical elements or international non-proprietary names No word – (a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or (b) which is declared by the World Health Organization and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name, shall be registered as a trade mark and any such registration shall be deemed for the purpose of section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require. Section 14: Use of names and representations of living persons or persons recently dead Where an application is made for the registration of a trade mark which falsely suggests a connection with any living person, or a person whose death took place within twenty years prior to the date of application for registration of the trade mark, the Registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnishes the registrar with such consent. Section 16: Registration of trade, marks as associated trade marks (1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods or services is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may, at any time, require that the trade marks shall be entered on the register as associated trademarks. (2) Where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration in the name of the same proprietor, in respect of goods and in respect of services which are associated with those goods or goods of that description and with those services or services of that description, sub-section (1) shall apply as it applies as where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services. (3) Where a trade mark and any part thereof are, in accordance with the provisions of sub-section (1) of section 15, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade
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marks.

(4) All trade marks registered in accordance with the provisions of sub-section (3) of section 15 as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person in relation to any of the goods or services or both in respect of which it is registered, and may amend the register accordingly.

Section 17: Effect of registration of parts of a mark

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trademark-

(a) contains any part –

(i) Which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

Section 44: Assignability and transmissibility of associated trade marks

Associated trade marks shall be assignable and transmissible only as a whole and not separately, but, subject to the provisions of this Act, they shall, for all other purposes, be deemed to have been registered as separate trade marks.

Section 131: Extension of time

(1) If the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act (not being a time expressly provided in this Act), whether the time so specified has expired or not, he may, subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly.

(2) Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties before disposing of an application for extension of time, and no appeal shall lie from any order of the Registrar under this section.

Section 145: Agents

Where, by or under this Act, any act, other than the making of an affidavit, is required to be done before the Registrar by any person, the act may, subject to the rules made in this behalf, be done instead of by that person himself, by a person duly authorised in the prescribed manner, who is-

(a) a legal practitioner, or

(b) a person registered in the prescribed manner as a trade marks agent, or

(c) a person in the sole and regular employment of the principal.

SEC 154: Special provisions relating to applications for registration from citizens of convention countries:

(1) With a view to the fulfilment of a treaty, convention or arrangement with any country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation outside India which affords to citizens of India similar privileges as granted to its own citizens, the Central Government may, by notification in the Official Gazette, declare such country or group of countries or union of countries or Inter-Governmental Organisation to be a convention country or group of countries or union of countries, or Inter-Governmental Organisations as the case may be, for the purposes of this Act.

(2) Where a person has made an application for the registration of a trade mark in a convention country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation and that person, or his legal representative or assignee, makes an application for the registration of the trade mark in India within six months after the date on which the application was made in the convention country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisations the trade mark shall, if registered under this Act, be registered as of the date on which the application was made in the convention country or country which is a member of a group of countries or union of countries or Inter-Governmental organisations and that date shall be deemed for the purposes of this Act to be the date of registration.

(3) Where applications have been made for the registration of a trade mark in two or more convention countries or country which are members of group of countries or union of countries or Inter-Governmental Organisation the period of six months referred to in the last preceding sub-section shall be reckoned from the date on which the earlier or earliest of those applications was made.

(4) Nothing in this Act shall entitle the proprietor of a trade mark to recover damages for infringement which took place prior to the date of application for registration under this Act.

Trade Marks Rules, 2017

Rule 21: Agency.

The request for incorporating the address for service of the applicant in India pursuant to the letter of authorization/ Power of attorney in favour of the agent should be filed on form TM-M with requisite fees.

Rule 20: Classification of goods and service –

(1) Classification of goods and service for the purpose of registration of trade mark, the goods and services shall be classified as per current edition of the "International Classification of goods and services (NICE classification)" published by the World Intellectual Property Organisation (WIPO).

Rule 23 (5): In the case of an application for registration in respect of all the goods or services included in a class or of a large variety of goods or services in a class, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made or intends to make if and when it is registered;

Rule 26 (3): Representation of Trade Mark:

Where the application contains a statement to the effect that the trade mark is a three dimensional mark, the reproduction of the Trade Mark shall consist of a two dimensional graphic or photographic reproduction as follows, namely:-

(i) The reproduction furnished shall consist of three different view of the trade mark;

(ii) Where, the Registrar considers that the reproduction of the Trade Mark furnished by the applicants does not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish within two months up to five further different views of the mark and a description by words of the mark;

(iii) Where the Registrar considers the different views or description of the Trade Mark referred to in clause (ii) still do not sufficiently show the particulars of the three dimensional Trade Mark, he may call upon the applicant to furnish a specimen of the trade mark.

Rule 109: Extension of time.

(1)An application for extension of time under section 131 (not being a time expressly provided in the Act or prescribed by Rule 85 or by sub-rule (3) of Rule 86 or a time for the extension of which provision is made in the rules) shall be made on Form TM-M.

(2)Upon an application made under sub-rule (1) the Registrar, if satisfied that the circumstances are such as to justify the extension of the time applied for, may, subject to the provisions of the rules where a maximum time limit is prescribed and subject to such conditions as he may think fit to impose, extend the time and notify the parties accordingly and the extension may be granted though the time for doing the act or taking the proceeding for which it is applied for has already expired.

*** end of the report ***