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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: 1672527 (Reference IRDI No allotted to this international registration by the TMR India) 5538434																									
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed): IOTA Stiftung																									
IV.	Provisional refusal based on an <i>ex officio</i> examination Provisional refusal based on an opposition Provisional refusal based on both an <i>ex officio</i> examination and an opposition																									
V.	Provisional refusal for all the goods and/or services Provisional refusal for some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected]																									
VI.	Grounds for refusal [(where applicable)]: 11(1) - The objection is raised under S 11 (1) of the Trade Marks Act, 1999, as the mark is identical with or similar to earlier marks in respect of identical or similar description of goods or services and because of such identity or similarity there exists a likelihood of confusion on the part of the public.,																									
VII.	Information relating to an earlier mark																									
<table border="1"> <thead> <tr> <th>APPL NO</th> <th>CLASS</th> <th>CONFLICTING MARK</th> <th>JOURNAL No</th> <th>PROPRIETOR NAME</th> <th>PROPRIETOR ADDRESS</th> <th>STATUS</th> <th>TM IMAGE</th> </tr> </thead> <tbody> <tr> <td colspan="8">GOODS SERVICES</td> </tr> <tr> <td>2980973</td> <td>9</td> <td>SHIMMER 1895</td> <td>FALLYN LLC</td> <td>103 Foulk Road, Suite 202, Wilmington, Delaware 19803 USA</td> <td>Registered</td> <td></td> <td></td> </tr> </tbody> </table>			APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	TM IMAGE	GOODS SERVICES								2980973	9	SHIMMER 1895	FALLYN LLC	103 Foulk Road, Suite 202, Wilmington, Delaware 19803 USA	Registered		
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APPLICATION USER DATE : Priority Claimed : DATE : 09/06/2015 19:04:04 GOODS/SERVICE : Electronic publications, including downloadable electronic publications in the nature of books, magazines and periodicals in the field of fiction and non-fiction and television entertainment; audio books in the field of fiction and non-fiction and television entertainment; cinematic and television programmes recorded on disc, tape and electronic form; apparatus for electronic distributing, electrical apparatus for use in television programme creation; portable electronic devices for receiving, transmitting and reading text, images and sound through wireless internet access; audio books; electronic books; downloadable MP3 files, MP3 recordings, MP4 files, MP4 recordings, digital audio files, digital multimedia files and podcasts featuring music and audio books; electronic publications featuring images, photographs, magazines, newspapers, periodicals, newsletters, and journals all relating to television entertainment; video cameras; DVD players; DVD recorders; remote controllers for DVD recorders and players; remote controllers for video disc recorders and players; remote controllers for recording devices; digital audio players; audio recorders; digital video players; portable apparatus for recording, transmission and reproduction of music; portable apparatus for recording, transmission and reproduction of video; other apparatus for recording, transmission and reproduction of video; monitors for television receiver; television receivers [TV sets] and television transmitters; remote controllers for television receiver [TV set]; television tuners; remote controllers for radio set; computer, electronic and video games equipment; electronic instructional and teaching apparatus and instruments; television and radio signal transmitters and receivers; game controllers; cinematographic machines and apparatus; set-top boxes; television receivers and transmitters; electronic controllers; electronic controllers to impart sensory feedback, namely, sounds and vibrations that are perceptible to the user; motion sensitive interactive video game remote control units; interactive video game remote control units;																										

parental control software; headphones and earphones; remote controls for portable and handheld electronic devices and computers; software for use in connection with electronic publications in the nature of television entertainment; software tool in the nature of television entertainment exploration guide; computer and electronic publishing software; downloadable audio works, visual works and audiovisual works featuring books, magazines, newspapers, periodicals, newsletters, guides, quizzes, tests, journals, manuals and television entertainment on a variety of topics; parts and fittings for all the aforesaid goods; personal digital assistants, electronic organizers, electronic notepads; magnetic data carriers; telephones, mobile phones, videophones, cameras; radio receivers; radio transmitters; video cameras; computer hardware and software; computer software and firmware, namely, operating system programs, data synchronization programs, in the nature of application development tool programs for personal and handheld computers and mobile digital electronic devices; character recognition software, telephony management software, mobile telephone, smartphone and tablet software; telephone-based information retrieval software and hardware; software for the redirection of messages; computer application software for mobile phones, smart phones and tablet devices featuring mobile phone functionality; computer application software and embedded computer application software for mobile phones, smart phones and tablet devices namely, software that enables photos and videos from cameras found on mobile phones, smart phones and tablet devices to be shared in social media for social networking purposes; computer programs for accessing, browsing and searching online databases; computer hardware and software for providing integrated telephone communication with computerized global information networks; parts and accessories for handheld and mobile digital electronic devices; parts and accessories for mobile telephones, smartphones and tablets in the nature of covers, cases, cases made of leather or imitations of leather, covers made of cloth or textile materials, batteries, rechargeable batteries, chargers, chargers for electric batteries, data cables, power cables, headphones, stereo headphones, in-ear headphones, stereo speakers, audio speakers, audio speakers or home, headsets for wireless communication apparatus; personal stereo speaker apparatus; microphones; car audio apparatus; apparatus for connecting and charging portable and handheld digital electronic devices; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; parts and fittings for all the aforesaid goods; downloadable software for accessing and managing of computer applications over a global computer network: character recognition software; voice recognition software; electronic mail and messaging software.

3358938 9 SHIMMER REALTIME TECHNOLOGIES LIMITED Clonsaugh Technology Park Dublin 17 Ireland Objected

SHIMMER

APPLICATION USER DATE Priority Claimed :
DATE :
11/03/2016

GOODS/SERVICE : Wireless measurement and temperature sensors; shock sensors; sensors used in meteorology and oceanography.

2980973 42 SHIMMER 1895 FALLYN LLC 103 Foulk Road, Suite 202, Wilmington, Delaware 19803 USA Registered

APPLICATION USER DATE : Priority Claimed :
DATE :
09/06/2015
19:04:04

GOODS/SERVICE : Scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware and software, computer services, namely remote hosting of operating systems and computer applications, hosting operating systems and computer applications through the Internet, providing a virtual computing environment accessible via the Internet, rental of computing and data storage facilities of variable capacity, providing software, non-downloadable, accessible over a global computer network, for managing computer applications, constructing an Internet platform for electronic commerce, designing, managing and monitoring on-line forums for discussion, creating electronically stored web pages for on-line services and the Internet, data warehousing, elaboration and maintenance of web sites for third parties, managing web sites for others, rental of web servers, web site maintenance, creation and hosting services, application service provider, namely, providing, hosting, managing, developing and maintaining applications, software, websites and databases in the fields of e-commerce, on-line payments, order queuing, website design, data storage, shared computing capacity scaling, messaging services and calculation of website ranking based on user traffic, computer programming, consultancy services relating to multimedia applications management, presentation and control, computer programming, hardware, software and computer system design, specification and selection and electronic communication, editing, updating, maintenance and support services for hardware, software and computer systems, computer services relating to multimedia applications management, presentation and control, research, database management, facilities management and outsourcing, computer services, namely hosting a computerized on line search

and ordering service featuring the wholesale and retail distribution of music, books, movies, motion pictures, television programs, games, toys, sporting goods, electronics, multimedia presentations, videos and DVDs, and other household and consumer goods, hosting an online service for analysing personal preferences and generating recommendations, computer services, namely hosting an online database featuring a wide range of general interest information via the Internet, computer services, namely, providing search engines for obtaining general interest information, hosting an interactive database for transmission of messages among computer users and subscribers concerning music, books, movies, motion pictures, television programs, games, toys, sporting goods, electronics, multimedia presentations, videos and DVDs, and other household and consumer goods, product reviews and purchase information on the internet, providing on-line non-downloadable internet browser software, providing non-downloadable mobile communications device software for enhancing mobile access to the internet via computers, mobile computers, and mobile communications devices, technical support, namely, troubleshooting of computer hardware and software problems and mobile computer and mobile communications device hardware and software problems, computer hardware and software consultation and design, computer software design for others, mobile computer and mobile communications device hardware and software consultation and design, mobile computer and mobile communications device software design for others, hosting of third party content, photos, videos, text, data, images, web sites and other electronic works, providing search engines, providing search platforms to allow users to request and receive photos, videos, text, data, images and electronic works, interactive hosting services which allow users to publish and share their own photos, videos, text, data, images online, computer services, namely, creating virtual communities for users to participate in discussions, obtain feedback, form virtual communities, and engage in social networking, maintenance and updating of software relating to computer, Internet and password security and prevention of computer, Internet and password risks, providing information in the field of astronomy, weather, the environment, interior design, technology, computers, software, computer peripherals, computer hardware, geology, engineering, architecture, medical research, and product research and testing via the internet or other computer or communications networks, computer software installation and maintenance, providing a website featuring technical information relating to computer software and hardware, computer hardware, software, application, and network consulting services, computer consulting, computer programming, document data transfer from one computer format to another, hosting of digital content on global computer networks, wireless networks, and electronic communications networks, providing search platforms to allow users to request and receive, content, text, visual works, audio works, audiovisual works, literary works, data, files, documents and electronic works, providing temporary use of non-downloadable computer software and online facilities to enable users to access and download computer software, providing temporary use of online non-downloadable computer software that generates customized recommendations of software applications based on user preferences, monitoring of computerized data and computer systems and networks for security purposes, hosting, scaling and maintaining on-line databases for others, cloud computing featuring software for use in database management, cloud hosting of electronic databases, application service provider (ASP) featuring software for use in database management, platform as a service (PAAS) featuring computer software platforms for use in database management, software as a service (SAAS) services featuring software for use in database management, computer services, namely, providing database servers of variable capacity to others, providing a website featuring nondownloadable software for database management, computer services, namely remote hosting of operating systems and computer applications, providing hosted operating systems and computer applications through the internet, rental of computing and data storage facilities of variable capacity, providing, developing and designing software, non-downloadable, accessible over a global computer network, for managing computer applications, constructing an internet platform for electronic commerce, designing, managing and monitoring online forums for discussion, creating electronically stored web pages for online services and the internet, data warehousing, elaboration and maintenance of web sites for third parties, managing web sites for others, rental of web servers, web site maintenance, creation and hosting services, application service provider, namely, providing, hosting, managing, developing and maintaining applications, software, websites and databases in the fields of ecommerce, online payments, order queuing, website design, data storage, shared computing capacity scaling, massaging services and calculation of website ranking based on user traffic, hosting a website that gives users the ability to review various print, photographic, graphic image, and audio and video content and utilize a custom template to provide input, likes, dislikes, edits, changes, modifications, opinions, suggestions, and comments and engage in social, business and community networking, computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking all in the field of entertainment and the entertainment industry, providing temporary use of on-line non-downloadable software and applications for accessing streaming audio and video files, games, social networks, text files and multimedia files, design and development of computer game software, video and computer game design and development services, providing temporary use of on-line nondownloadable software development tools for the design and development of electronic games, providing temporary use of on-line non-downloadable software and applications for accessing streaming audio and video files, games, social networks, text files and multimedia files, video game development services, technical support services, namely, troubleshooting of computer game software problems, application service provider (ASP) featuring

software for use in relation to visual images, namely, software for digital animation and special effects of images, video games, and motion pictures, application service provider (ASP) featuring application programming interface (API) software including such software for the streaming, storage, and sharing of video games, content, data and information, providing nondownloadable software applications, providing temporary use of on-line nondownloadable cloud computing software for use in electronic storage of data, computer software development in the field of mobile applications, application service provider, namely, hosting, managing, developing, and maintaining applications, software, and web sites, in the fields of personal productivity, wireless communication, mobile, providing technical support services regarding the usage of communications equipment, production of video and computer game software, creating an on-line community for registered users to participate in discussions, to share content, photos, videos, text, data, images and other electronic works, and engage in social networking, provision of information, consultancy and advisory services relating to the aforesaid.

VIII. Corresponding essential provisions of the applicable law [(see text XII)]:
Section : 9(1)(b) , 11(1) , of Trade Mark 1999.

IX. Information relating to subsequent procedure :

- (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

X. Date of the notification of provisional refusal:
28/07/2022

XI. Signature or official seal of the Office making the notification:
FOR REGISTRAR OF TRADEMARK

Designation:

XII. Corresponding essential provisions of the applicable law:
Trade Marks Act, 1999

Section 36E (4) International Registration where India has been designated

The Provisions of section 9 to 21 (both inclusive), 63 and 74 shall apply mutatis mutandis in relation to an international registration as if such international registration was an application for registration of a trade mark under section 18.

Section 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.
- (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 course would take unfair advantage of or be detrimental to the distinctive character or repute of 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 trademarks.

(4) All trademarks 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 trademarks.

(5) On application made in the prescribed manner by the registered proprietor of two or more trademarks registered as associated trademarks, 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: 21 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.

Section 63. Application to be accompanied by regulations governing use of collective marks

(1) An application for registration of a collective mark shall be accompanied by the regulations governing

the use of such collective mark.

(2) The regulations referred to in sub-section (1) shall specify the persons authorised to use the mark, the conditions of membership of the association and, the conditions of use of the mark, including any sanctions against misuse and such other matters as may be prescribed.

Section 69 Certain provisions of this Act not applicable to certification trade marks

The following provisions of this Act shall not apply to certification trademarks, that is to say,-

- (a) clauses (a) and (c) of sub-section (1) of section 9;
- (b) sections 18, 20 and 21, except as expressly applied by this Chapter;
- (c) sections 28, 29, 30, 41, 42, 47, 48, 49, 50, 52, 54 and sub-section (2) of section 56;
- (d) Chapter XII, except section 107.

Section 70. Registration of certification trademarks

A mark shall not be registrable as a certification trade mark in the name of a person who carries on a trade in goods of the kind certified or a trade of the provision of services of the kind certified.

Section 71. Applications for registration of certification trade marks

(1) An application for the registration of a mark as a certification trade mark shall be made to the Registrar in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft of the regulations to be deposited under section 74.

(2) Subject to the provisions of section 70, the provisions of sections 18, 19 and 22 shall apply in relation to an application under this section as they apply in relation to an application under section 18, subject to the modification that reference therein to acceptance of an application shall be construed as reference to authorisation to proceed with an application.

(3) In dealing under the said provisions with an application under this section, the tribunal shall have regard to the like considerations, so far as relevant, as if the application were applications under section 18 and to any other considerations relevant to applications under this section, including the desirability of securing that a certification trade mark shall comprise some indication that it is a certification trade mark.

Section 72. Consideration of application for registration by the Registrar

(1) The Registrar shall consider the application made under section 71 with regard to the following matters, namely:-

- (a) whether the applicant is competent to certify the goods in respect of which the mark is to be registered;
- (b) whether the draft of the regulations to be filed under section 74 is satisfactory;
- (c) whether in all the circumstances the registration applied for would be to the public advantage, and may either-
 - (i) refuse the application; or
 - (ii) accept the application and approve the said draft of the regulations either without modification and unconditionally or subject to any conditions or limitations, or to any amendments or modifications of the application or of the regulations, which he thinks requisite having regard to any of the said matters.

(2) Except in the case of acceptance and approval without modification and unconditionally, the Registrar shall not decide any matter under sub-section (1) without giving the applicant an opportunity of being heard.

Section 73. Opposition to registration of certification trade marks

When an application has been accepted, the Registrar shall, as soon as may be thereafter, cause the application as accepted to be advertised in the prescribed manner, and the provisions of section 21 shall apply in relation to the registration of the mark as they apply in relation to an application under section 18.

Section 74. Filing of regulations governing the use of a certification trade mark

(1) There shall be filed at the Trade Marks Registry in respect of every mark registered as a certification trade mark regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the certification trade mark, and may contain any other provisions which the Registrar may by general or special order, require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations); and regulations so filed shall be open to inspection in like manner as the register as provided in section 148.

(2) The regulations so filed may, on the application of the registered proprietor, be altered by the Registrar.

(3) The Registrar may cause such application to be advertised in any case where it appears to him expedient so to do, and where he does so, if within the time specified in the advertisement any person gives notice of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

Section 77. Cancellation or varying of registration of certification trade marks

The Registrar may, on the application in the prescribed manner of any person aggrieved and after giving the proprietor an opportunity of opposing the application, make such order as he fit for expunging or varying any entry in the register to a certification trade mark, or for varying the regulations, on any of the following grounds, namely:-

- (a) that the proprietor is no longer competent, in the case of any of the goods or services in respect of which the mark is registered, to certify those goods or services;
- (b) that the proprietor has failed to observe any provisions of the regulations to be observed on his part;
- (c) that it is no longer to the public advantage that the mark should remain registered;
- (d) that it is requisite for the public advantage that if the mark remains registered, the regulations should be varied.

Section 107: Penalty for falsely representing a trade mark as registered

(1) No person shall make any representation—

- (a) with respect to a mark, not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark, not being a part separately registered as a trade mark, to the effect that it is separately registered as a trade mark; or
- (c) to the effect that a registered trade mark is registered in respect of any goods or services in respect of which it is not in fact registered; or
- (d) to the effect that registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitation entered on the register, the registration does not in fact give that right.

(2) If any person contravenes any of the provisions of sub-section (1), he shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.

(3) For the purposes of this section, the use in India in relation to a trade mark of the word "registered", or of any other expression, symbol or sign referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

(a) where that word or other expression, symbol or sign is used in direct association with other words delineated in characters at least as large as those in which that word or other expression, symbol or sign is delineated and indicating that the reference is to registration as a trade mark under the law of a country outside India being a country under the law of which the registration referred to is in fact in force; or

(b) Where that other expression, symbol or sign is of itself such as to indicate that the reference is to such registration as is mentioned in clause (a); or

(c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside India and in relation solely to goods to be exported to that country or in relation to services for use in that country.

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—

(e) a legal practitioner, or

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

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

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

(1) With a view to the fulfillment 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 19: Agency:

(1) The authorization of an agent for the purpose of section 145 shall be executed in Form TM-M

(2) In case of such authorization, service upon the agent of any document relating to the proceeding or matter shall be deemed to be service upon the person so authorizing him; all communications directed to be made to such a person in respect of the proceeding or matter may be addressed to such agent, and all appearances before Registrar relating thereto may be made by or through such agent.

(3) In any particular case, the Registrar may require the personal signature or presence of an applicant, opponent, proprietor, registered user or other person.

(4) In case of withdrawal of the agent from the proceedings or from doing any act for which he has been authorised, in respect of an application or opposition wherein no principle place of business in India mentioned, the applicant and opponent shall, within a period of two months from the date of such withdrawal, provide an address for service in India. If he fails to provide address for service in India within such period, he shall be deemed to have abandoned the application or opposition, as the case may be.

(5) In case of revocation of authorization by the applicant or opponent in respect of an application or opposition wherein no principle place of business in India is mentioned, the applicant or opponent, as the case may be shall provide the address for service in India within a period of two months from such revocation. If he fails to provide address for service in India within such period, he shall be deemed to have abandoned the application or opposition, as the case may be.

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) Form and signing of application:

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 42 Notice of Opposition —

(1) A notice of opposition to the registration of a trademark under sub-section (1) of section 21, with such particulars as specified in Rule 43, shall be filed in form TM-O within four months from the date of publication of the trademark journal in which the application for registration of the trademark was advertised or re advertised.

(2) Where a notice of opposition has been filed in respect of a single application for the registration of a trademark for different classes of goods and services, it shall bear the fee in respect of each class in relation to which the opposition is filed.

(3) Where an opposition is filed only for a particular class or classes in respect of a single application made under sub-section (2) of section 18, the application for remaining class or classes shall not proceed to registration until a request in Form TM-M for division of the application together with the divisional fee is made by the applicant.

(4) Where in respect of a single application for the registration of a trademark no notice of opposition is filed in a class or classes, the application in respect of such class or classes shall, subject to section 19 and sub-section (1) of section 23, proceed to registration after the division of the application in the class or classes in respect of which an opposition is pending.

(5) A copy of notice of opposition shall be ordinarily served by the Registrar to the applicants within three months of the receipt of the same by the appropriate office:

(6) Provided that where the applicant has already filed the counter statement on the basis of the copy of notice of opposition made available in the electronic records on the official website, the requirement of service of copy of the notice of opposition to the applicant shall be dispensed with.

Rule 44 Counterstatement.—(1) The counterstatement required by sub-section (2) of section 21 shall be sent on Form TM-O within two months from the receipt by the applicant of the copy of the notice of opposition from the Registrar and shall set out what facts, if any, alleged in the notice of opposition, are admitted by the applicant. A copy of the counterstatement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same.

(2) The counterstatement shall be verified in the manner as provided in sub-rules (2), (3) and (4) of rule 43.

Rule 45 Evidence in support of opposition.—(1) Within two months from service of a copy of the counterstatement, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver to the applicant copies of any evidence including exhibits, if any, that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.

(2) If an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition.

Rule 46 Evidence in support of application.—(1) Within two months on the receipt by the applicant of the copies of affidavits in support of opposition or of the intimation that the opponent does not desire to adduce any evidence in support of his opposition, the applicant shall leave with the Registrar such evidence by way of affidavit as he desires to adduce in support of his application and shall deliver to the opponent copies thereof or shall intimate to the Registrar and the opponent that he does not desire to adduce any evidence but intends to rely on the facts stated in the counterstatement and or on the evidence already left by him in connection with the application in question. In case the applicant adduces any evidence or relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies of the same, including exhibits, if any, and shall intimate the Registrar in writing of such delivery.

(2) If an applicant takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his application.

Rule 47 Evidence in reply by opponent. — Within one month from the receipt by the opponent of the copies of the applicant's affidavit the opponent may leave with the Registrar evidence by affidavit in reply and shall deliver to the applicant copies of the same including exhibits, if any, and shall intimate the Registrar in writing of such delivery.

Rule 48 Further evidence.—No further evidence shall be left on either side, but in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit.

Rule 49 Translation of documents.—Where a document is in a language other than Hindi or English and is referred to in the notice of opposition, counterstatement or an affidavit filed in an opposition proceeding, an attested translation thereof in Hindi or English shall be submitted before the registrar and a copy thereof shall be provided to opposite party.

Rule 50 Hearing and decision. —(1) The Registrar, after the closure of the evidence, shall give notice to the parties of the first date of hearing. The date of hearing shall be for a date at least one month after the date of the first notice.

(2) A party to a proceeding may make a request for adjournment of the hearing with reasonable cause in Form TM-M accompanied by the prescribed fee, at least three days before the date of hearing and the Registrar, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly:

Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.

(3) If the applicant is not present at the adjourned date of hearing and at the time mentioned in the notice,

the application may be treated as abandoned.

(4) If the opponent is not present at the adjourned date of hearing and at time mentioned in the notice, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to section 19.

(5) The Registrar shall consider written arguments if submitted by a party to the proceeding.

(6) The decision of the Registrar shall be communicated to the parties in writing at the address given for service.

Rule 51 Security for costs.—The security for costs which the Registrar may require under sub-section (6) of section 21 may be fixed at any amount which he may consider proper, and such amount may be further enhanced by him at any stage in the opposition proceedings.

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.

Special provisions for CERTIFICATION MARKS under

Rule 136. Rules to apply to certification trademarks.—the provisions of Part I, of these rules (Trade Marks Rules 2017) shall, in their application to certification trademarks, apply only subject to the provisions of this Part.

Rule 137. Application for registration and proceedings relating thereto.—

(1) An application for the registration of a certification trade mark for goods or services under sub-section (1) of section 71 shall be made to the Registrar in Form TM A, along with the draft regulations.

(2) References in Part I of the rules to the acceptance of an application for the registration of a trademark, shall, in their application to certification trade mark, be substituted by references to authorisation to proceed with the application.

(3) The address in India, if any, of an applicant to register a certification trade mark shall be deemed to be the address of his principal place of business in India for all the purposes for which such an address is required by the rules.

(4) The regulation governing a certification trade mark shall specify inter alia:-

- (a) a description of the applicant;
- (b) the nature of the applicant's business;
- (c) the particulars of infrastructure like R & D, technical manpower support;
- (d) the applicants competence to administer the certification scheme;
- (e) the applicants financial arrangement;
- (f) an undertaking from the applicant that there will be no discrimination of any party if they meet the requirements set down in the regulations;
- (g) the characteristic the mark will indicate in the certified goods or in relation to the rendering of certified services;
- (h) the manner of monitoring the use of the mark in India; and
- (i) such other relevant particulars as may be called for by the Registrar.

Rule 138. Statement of Case accompanying application- The applicant shall submit to the registrar along with his application a statement of case setting out the grounds on which he relies in support of his application.

Rule 139. Examination, hearing, opposition, registration and renewal- The provisions related to examination, hearing, opposition, registration and renewal of Trade Marks shall apply to mutatis mutandis in respect of certification Trade Marks.

Rule 140. Cancellation or variation of registration of certification Trade Marks – An application for cancellation or variation of registration of a certification Trade Mark on any of the grounds mentioned in Section 77 shall be made in form TM O and shall set forth particulars of the grounds on which the application is made. The provisions of Rule 97 to 100 shall apply mutatis mutandis to further proceedings in the matter.

Rule 141. Alteration of deposited regulations and consent of the Registrar for assignment or transmission of certification trade marks.—

(1) An application by the registered proprietor of a certification trade mark under sub-section (2) of section 74 to alter the deposited regulation shall be made in Form TM-M and where the Registrar decides to permit such alteration it shall be advertised in the Journal and further proceeding in the matter shall be governed by rules 42 to 51.

(2) An application for the consent of the Registrar to the assignment or transmission of a certification trade mark under section 43 shall be made in Form TM-P.

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