

WITHDRAWAL OF ACCEPTANCE OF TRADEMARK APPLICATIONS UNDER SECTION 19 OF TRADE MARKS ACT 1999: AN ANALYSIS

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Introduction

The Trademarks Act, 1999, is a foundation of trademark law in India, safeguarding the protection of intellectual property. **A trademark is any word, phrase, symbol, design, or combination thereof used in trade to identify and distinguish the goods or services of one enterprise from others.** As per *Section 2(1)(zb)* of the Trade Marks Act, 1999, “*A Trademark is a graphically representable and capable of distinguishing goods or services, including shapes, packaging, and colour combinations*”.

In India the registration of Trademark is granted and protected under Trade Marks Act, 1999. The process of trademark registration involves multiple stages, including application filing, examination, publication, and registration. As per *Section 18* of the Trademarks Act, 1999, “*Individuals or joint applicants can apply for trademark registration at the Trade Marks Registry within the jurisdiction of their principal place of business*”.

But sometimes during this process, the Registrar may identify grounds for refusal or conditional acceptance, the application to amendments or modifications. To address such cases *Section 19* comes into play which empowers **the Registrar to withdraw the acceptance of a trademark application before the trademark is officially registered, if it was accepted in error or if circumstances necessitate the imposition of additional conditions, limitations, or refusal.** Together, these provisions ensure that only valid trademarks are registered, maintaining the integrity of the trademark system¹.

Section 19 of The Trade Marks Act, 1999:

Section 19² enables the Registrar to withdraw the acceptance of an application if it was accepted:

1. In error or
2. Without proper consideration of the circumstances in which the trademark should not have been accepted or
3. Without imposing the necessary conditions, limitations, or additional restrictions.

The Registrar may, after hearing the Applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

Office Action and Initiation of Withdrawal:

¹ Compliance Calendar. (n.d.). *Withdrawal of acceptance under Section 19 of the Trade Marks Act, 1999*. Retrieved from <https://www.compliancecalendar.in/learn/withdrawal-of-acceptance-under-section-19-of-the-trade-marks-act-1999>

² The Trade Marks Act, 1999, *Section 19: Withdrawal of acceptance of application*.

The withdrawal³ process typically begins with an office action, as outlined below:

1. **Identification of Error:** The concerned officer, particularly the officer in charge of EPR (*Examination of Proprietary Rights*) or PRAS (*Pre-registration Action System*), identifies that the trademark application was accepted:
 - In error.
 - With incorrect conditions or limitations.
 - Due to data entry mistakes (*e.g., incorrect trademark representation, goods/services specification, or classification*).
 - For prohibited or non-registrable marks (*e.g., marks resembling International Non-Proprietary Names for medicinal products*).
2. **Proposal for Withdrawal:** A note is prepared and submitted to the CGPDTM (*Controller General of Patents, Designs, and Trade Marks*), who serves as the Registrar of Trademarks, recommending the withdrawal of acceptance.
3. **Referral to the Show Cause Hearing Section:** Once the CGPDTM approves the proposal, the matter is forwarded to the Show Cause Hearing Section, which initiates the formal withdrawal process under **Rule 42** of the Trade Marks Rules, 2017.

Process for Withdrawal of Acceptance:

The step-by-step procedure for withdrawal of acceptance⁴ under **Section 19** and **Rule 38** is as follows:

- **Issuance of Notice:** A notice is issued to the applicant, communicating the Registrar's objections and specifying the grounds for withdrawal or modification of acceptance.
- **Response from the Applicant:** The applicant is given 30 days to respond to the notice. The applicant may:
 - (i) Amend the application to comply with the Registrar's requirements.
 - (ii) Apply for a hearing.
 - (iii) Withdraw the application voluntarily.
- **Deemed Withdrawal:** If the applicant fails to respond within the stipulated 30 days, the acceptance is deemed to be withdrawn, and the application reverts to the pre-acceptance stage.

³ Draft manual for trademarks registry (TMR) process. Retrieved from https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf

⁴ The Trade Marks Rules, 2017, Rule 38: Withdrawal of application. Ministry of Commerce and Industry, Department for Promotion of Industry and Internal Trade. Retrieved from <https://ipindia.gov.in>

- **Hearing Process:** If the Applicant requests a hearing, the Registrar schedules a hearing. The Applicant may attend the hearing or submit written submissions to present their case.
- **Registrar's Decision:** After reviewing the applicant's submissions, the Registrar may:
 - (i) Withdraw the acceptance of the application.
 - (ii) Impose new conditions or limitations on the application.
 - (iii) Allow the application to proceed with necessary amendments.
- **Implementation of the Decision:** The decision is implemented, and the application proceeds accordingly. If acceptance is withdrawn, the process continues as though the application had not been accepted initially.

Case Laws dealing with Section 19 of The Trademarks Act, 1999:

1. *Torrent Drugs And Chemicals Private vs The Registrar Of Trade Marks*⁵

In this case, Section 19 of the Trade Marks Act, 1999 played a crucial role as it addresses the Registrar's power to withdraw acceptance of a trademark application before registration. The trademark "RANITIN" was initially advertised in 1991, but its advertisement was later cancelled by the Registrar without notifying the Appellant, in violation of the principles of natural justice. The Senior Joint Registrar subsequently passed an order in 1994 withdrawing this cancellation, affirming that the appellant was not given an opportunity to be heard. Despite this, the Assistant Registrar later issued a notice under *Section 56(4)* and removed the mark, ignoring the earlier order under *Section 19*. The IPAB ruled that since the cancellation of the advertisement was already withdrawn under *Section 19*, the grounds for further action no longer survived. The IPAB emphasized that procedural safeguards under *Section 19* are crucial and remanded the case back to the Assistant Registrar to hear the pending oppositions and decide in accordance with the law.

2. *EIH Ltd & Oberoi Hotels Pvt Ltd vs Sahana Realty Pvt Ltd & Ors*⁶

In this case, the Delhi High Court addressed the application of *Section 19* of the Trade Marks Act, 1999, which allows a suit for trademark infringement to be instituted in a court within the local limits of whose jurisdiction the defendant resides or carries on business, or where the cause of action arises. The Plaintiffs, part of the Oberoi Group, claimed that the Defendants' use of the marks 'THREE SIXTY WEST' and 'OBEROI THREE SIXTY WEST' infringed upon their registered trademarks, leading to consumer confusion. The Plaintiffs argued that inquiries from consumers in Delhi regarding the Defendants' project established a cause of action within the jurisdiction of the Delhi High Court. On the other hand, the Defendants contended that the entire cause of action arose in Mumbai, where their project was located, and accused the Plaintiffs of engaging in forum shopping. The court ultimately found that the Plaintiffs had sufficiently demonstrated that a part of the cause of action arose in Delhi, given the consumer inquiries and the defendants' marketing efforts targeting Delhi customers. Consequently, the court ruled that the Plaintiffs were entitled to invoke the jurisdiction of the Delhi

⁵ *Torrent Drugs And Chemicals Private vs The Registrar Of Trade Marks*, 2007(34)PTC728(IPAB).

⁶ *EIH Ltd & Oberoi Hotels Pvt Ltd vs Sahana Realty Pvt Ltd & Ors*, AIRONLINE 2018 DEL 707.

High Court under *Section 19*, allowing them to proceed with their claims for trademark infringement and related reliefs. This case highlights the importance of *Section 19* in enabling trademark owners to seek legal recourse in jurisdictions where they can show evidence of consumer confusion and potential harm to their brand.

3. *Kores (India) Ltd. vs. Khoday Eshwarsa & Sons*⁷

This case revolved around a trademark dispute concerning the “Typist Girl” device. Kores applied for trademark registration in 1969 for stationery goods under Class 16. Khoday Eshwarsa & Sons opposed the application, claiming prior registration of a similar mark in 1944 and extensive use since 1937-38. They argued that Kores’ mark was deceptively similar to theirs and could confuse consumers. Additionally, they questioned the honesty of Kores’ claim of concurrent use since 1959. Despite Kores submitting affidavits, advertisements, and sales data to establish goodwill and honest use, the Assistant Registrar ruled in favour of the opposition, finding that Kores’ evidence was insufficient and that their mark risked creating confusion due to its similarity. The relevance of *Section 19* of the Trade Marks Act, 1999, lies in the Registrar’s authority to withdraw or amend the acceptance of a trademark application if the acceptance was based on misrepresentation, error, or incomplete information. In this case, the initial acceptance of Kores’ application was effectively revisited during the opposition proceedings. The Assistant Registrar scrutinized Kores’ claims and evidence, finding that Kores failed to prove honest concurrent use and had not used the mark in the precise form they sought to register. This aligns with the principles of *Section 19*, which safeguards the trademark registration process by allowing the Registrar to reassess an application when new evidence or opposition reveals inaccuracies in the initial acceptance. Although *Section 19* was not explicitly invoked, the Registrar’s decision demonstrates the application of its underlying principles to ensure the integrity of the trademark system.

End Note

Section 19 of the Trade Marks Act, 1999, combined with *Rule 38* of the Trade Marks Rules, 2017, plays a fundamental role in safeguarding the robustness of the trademark registration process. The withdrawal process outlined in these provisions prevents the registration of erroneous or prohibited trademarks, preserving the integrity of the trademark system and safeguarding public interest. It adheres to the principles of natural justice by providing applicants with adequate notice and an opportunity to respond, ensuring fairness and transparency. The involvement of key officers, such as the EPR/PRAS team and the Controller General of Patents, Designs, and Trademarks (CGPDTM), ensures the accountability and thorough evaluation of errors, allowing the Registrar to make informed decisions and uphold the credibility of the trademark registry.

⁷ *Kores (India) Ltd. vs. Khoday Eshwarsa & Sons*, AIR 1975 SC 223.