

**P.C.N.RAGHUPATHY,B.Com.,B.L.,
Advocate**

**No.38, Adithanar Salai,
Pudupet,
Chennai-600 002.
M.no. 9283135468
Phone No.28551968
Fax : 044- 28586153**

To

Date: 29-12-2011

Ministry of Commerce and Industry,
Department of Industrial Policy & Promotion,
New Delhi-110 001.

Sir,

Sub: Suggestions and comments - Discussion paper for review
of organization structure of office of CGPDTM - Reg.

I am herewith attaching suggestions and comments on the above said discussion paper. I am having 36 years bar experience as an Advocate mainly practicing on Civil side and Appellate Side of Madras High Court. But I am having main practice before the Trade Marks Registry from the year of 1980 in which year I filed first trade mark application on behalf of my client and till this date I have filed more than 6000 trade mark applications before the Chennai Trade Marks Registry. Therefore I send this suggestions and comments after having gained much more practical experience while appearing before the Trade Marks Tribunal both at the stage of Application Hearing and Opposition matters.

Thanking you,

**P.C.N.RAGHUPATHY
Advocate
Chennai**

Encl: Suggestions and Comments

**Suggestions and Comments on Discussion Paper of DIPP on
functioning of CGPDTM**

1. Given the radically different skill requirements of trade mark and patent office staff, the operational difficulties and the present challenges being faced by the O/o CGPDTM, is it desirable to establish an independent office for the Trade Marks and GI registry?

i) Due to operational and administrative difficulties in day-to-day administration of IPR offices, it is better to establish independent office for the trade marks and GI Registry under the administrative guidance and supervision of the Joint Controller (Trade Marks) who will be incharge of Head Office and other branch offices of the Trade Marks Registry and G.I. Registry and such Joint Controller (Trade Marks) should be vested with the powers of the 'Registrar' under the provisions of the Act and the Joint Controller (Trade Marks) may delegate his powers to his sub-ordinates. Simultaneously, Joint Controller (Patents) may be incharge of Patent office and Design Cell or the CGPDTM himself. There is no need for amending the Trade Marks Act and Patents Act for such establishment of independent office for the Trade Marks and G.I. Registry.

ii) But the 'Registrar' and the 'Controller General' will be one and the same person under Sec.3(1) of the Trade Marks Act. Therefore the Joint Controller (Trade Marks) for the independent Trade Mark office should be under the control of Controller General (CGPDTM) who will

have administrative superintendence over both patent office and independent Trade Mark office. The CGPDTM will be responsible for filing Reports to be placed before Parliament under Sec.149 of the Trade Marks Act and under Sec.155 of Patents Act.

iii) The term 'controller general' is described under sec.73 of the Patents Act by referring Sec.3(1) of the Trade Marks Act. Therefore there is no necessity for amendment of Trade marks Act to establish the independent office for Trade Marks Registry by appointing Joint Controller (Trade Marks).

2. If so, what should be the organizational and reporting structure for each office?

The present organizational structure may be continued with the appointment of Joint Controller (Trade Marks) but more personnel to be appointed in the cadre of Examiner of Trade Marks and Asst.Registrar of Trade Marks in each and every branch registry. The Independent Trade Mark Office may be divided into various sections for disposing the pending matters in each and every branch registry in order to clear the back-log.

i) Disposal of Trade Mark Applications (Separate Section)

One or two Asst.Registrar may be incharge of Hearing matters under Rule 111 of the Trade Marks Rules, 2002 to dispose the applications and Asst.Registrar should be assisted by one or two Examiners of Trade Marks and with one stenographer. Such Examiners

will get much more experience during the course of hearing conducted by the Asst.Registrar and it will be helpful to them while get promotion as Asst.Registrar.

ii) Disposal of Opposition or Rectification (Separate Section)

Deputy Registrar or Senior Asst.Registrar may be incharge of disposal of Opposition Hearings or Rectification under Rule 56 of the said Rules and he should be assisted by one Senior Examiner of Trade Marks with one stenographer. Senior Examiner will get much more experience during the course of opposition hearing and it will be helpful to him while get promotion as Asst.Registrar. This Section may be in additional charge for hearing under Sec.19 (withdrawal of acceptance) of the Act.

iii) Disposal of (Assignment) FORM TM-23 or FORM TM-24 matters (Separate Assignment Section)

One Senior Examiner may peruse the pending matters (Assignment) and if the documents are in order, the Senior Examiner y himself may pass necessary order and in case of dispute between parties with regard to assignment, the matter may be posted before the Deputy or Asst.Registrar for orders or for Hearing under Rule 111.

iv) Issuance of Trade Mark Registration Certificate (Separate Section)

One Asst.Registrar may be incharge of the Section and he should be assisted by one Senior Examiner and while issuing the certificates, the concerned records file should be verified and to be signed by Asst.Registrar or Senior Examiner.

v) Issue of Renewal Certificates and disposal of FORM TM-34 and FORM TM-50 matters (Separate Section)

One Senior Examiner may be incharge of the Section and Renewal Certificates may be issued by the concerned branch office only within 15 or 30 days time either by verifying the e-Registrar or by the required copies of the documents produced by the proprietor of the mark.

vi) Compilation of accepted Trade Mark Applications for the purpose of advertisement in Trade Marks Journal (Separate Section)

One Senior Examiner may be incharge of this Section for compiling the trade mark applications which are to be advertised on the basis of the direct examination or on the basis of the quasi-judicial order passed by the Asst.Registrar.

vii) Display Boards should be installed at each and every branch registry to enable the Attorneys or public to contact the required section in order to make enquiry for pending matters or post of Public Relation Officers may be created for each Registry.

viii) FORM TM-60

Since the Trade Marks Search is free, it is better to drop this FORM TM-60 and procedure for issuing No Objection Certificate on the basis of FORM TM-60 by making suitable amendment in Sec.45(1) of the Copyrights Act and deleting Rule 24(3) and 32 of the Trade Marks Rules, 2002. The copyright office may be advised to launch a Artistic Work Gazette or Journal for the purpose of advertisement of artistic work to invite the opposition if any.

ix) Miscellaneous Matters (Separate Section)

One Senior Examiner of Trade Marks may be incharge of other miscellaneous matters to be dealt with under various provisions of Trade Marks Act, 1999 such as issuing certified copies, certificate for FORM TM-46 etc.

3. Given the sensitivity of Patent law and practice in India and also the experience in other major IP Offices such as the USPTO, would it be appropriate to consider making the Office of CGPDTM autonomous? Is it possible to bifurcate the two offices and make the Trade Marks Registry and the Patent and Design Office two autonomous organizations?

The office CGPDTM may be bifurcated by giving independent freedom to the Joint Controller (Trade Marks) to deal with the quasi-judicial matters arise under the Trade Marks Act, 1999 but Joint Controller (Trade Marks) should be under the administrative

guidance and superintendence of CGPDTM. Hence it is better to bifurcate. Since the Joint Controller (Trade Marks) is being vested with quasi-judicial powers under the Trade Marks Act, it will be better that the major qualification for appointment of Joint Controller (Trade Marks) should be a Law Graduate. Therefore the independent Trade Marks Registry and the Patent office may function as two autonomous organizations vested with administrative and financial autonomy.

4. What legal changes are required? What changes are required to the rules?

There is no need for changes in the relevant Act and Rules under the above said circumstances but such bifurcation will increase the efficient functions of both the Patent office and independent Trade Marks Registry.

5. Can the reorganization of the office of CGPTDM be taken up within the existing framework without seeking any amendments to the law? If so, what can be an ideal model ?

Reorganization in the office of the CGPDTM may be taken up within the existing provisions of the relevant Acts and without seeking any amendment. Answer to Question No.2 may be considered as ideal model for such reorganization for Independent Trade Marks Registry.

6. How should the office of the Controller be strengthened?

By recruiting more permanent staff for Independent Trade Marks Registry and by abolishing the appointment of temporary

employees as likes that of present one. We could not expect efficiency and talent from such temporary staff.

7. The Department had taken an initiative to outsource some part of the prior art search of the Patent office to CSIR. This project is proving to be beneficial. Which other organizations could be tapped for the purpose. Are there likely pitfalls that the department must take precautions against? What could be such precautions?

As per the suggestions already made by the other stakeholders particularly by Dr.Rajendra Prasad.

8. Is a similar outsourcing (including employment of temporary but qualified personnel) exercise possible in case of trademarks where more than 400000 trademark applications are pending at various stages? If so, what could be the safeguards that should be put in place?

It is better to appoint permanent staff instead of temporary staff because permanent staff only will get frequent training from the department and permanent staff alone will be responsible for maintaining records and register properly and therefore missing of files may be avoided in future. The appointment of Contract Examiners in Trade Marks Registry has totally been failed to increase the efficient functions. Hence, the recommendations made in para 5.73 and 5.74 of 88th Report of Parliamentary Standing Committee may be taken into consideration.

9. What other measures can be used to improve the base of examination of applications within the framework of the existing legislation?

- i) Trade Mark Manual should be introduced first.

ii) Permanent Examiner should be appointed and they should be given training by a committee of retired officials from Trade Marks Registry with regard to the manner how to examine the applications.

iii) As far as pharmaceutical products are concerned, exact similar mark should be searched during examination and examining the application on the basis of prefix and suffix in drug brand names should be avoided because most pharmaceutical brand names contain prefix or suffix from the ingredients of the drug. Such suffix or prefix may be common to pharmaceutical trade.

iv) Conditional acceptance may be granted under Sec 18(5) by confining the registration to a particular region and to a particular goods in a particular class.

v) For examination of patent applications, the recommendation made in 88th Report of the Parliamentary Standing Committee may be taken into consideration.

10. In spite of e-filing for patents etc. and streamlining of the examination process, is there a need for setting up additional offices?

No need for additional offices.

11. The National Institute of Intellectual Property and Management, which is housed in Nagpur, is at present under the supervision of the CGPDTM. This institute needs to be developed into a world class institution for research and training in the field of IP. Would it be better

for such an institution to be directly controlled by the Ministry or should it continue as one of the offices of CGPDTM?

It may be independent but under the supervision of the Ministry or DIPP directly but not under the supervision of CGPDTM.

12. The recruitment of officers has been delayed inordinately by the complicated, prolonged procedures involving interdepartmental approval. What could be the options to address this problem? Should a special dispensation be sought to address this issue. If so, what could be the possible course of action?

The completed prolonged procedures may be avoided by properly consulting the Law Ministry. But the Ministry may make an attempt to explore the possibility of appointing Retired District Judges for the purpose of establishing Mediation Centres by referring various oppositions to such Mediators on the line of High Court or District Court. But while recruiting such retired persons, proper guidelines and consultation from the Law Ministry should be followed. Otherwise, High Court may interfere under Art. 226 of the Constitution.

13. Since Trademark registration is a quasi judicial process involving opposition cases and hearings, what can be done to address the large number of vacancies for the post of Assistant Registrar and above? If it is not possible to select new officers immediately, what can be done to remedy the situation?

i) Temporary or Ad-hoc Asst.Registrars may be appointed in each and every branch from among the law graduates with not less than 7 or 8 years bar experience in civil matters and

these temporary officers should be on contract basis for 2 or 3 years subject to extension but such temporary officers should be recruited locally. For example the law graduates from Southern states may be considered for Chennai Registry posts and this may be followed in other branch registries. Otherwise, it will not attract the Law Graduates. The temporary Asst. Registrars should be employed with a condition that they should not practice before the Registry where he was employed after his termination of Contractual Service.

ii) In case of complicated technical difficulties in recruiting either permanent or temporary or Ad-hoc Asst. Registrars, the Chief Justice of the concerned High Courts may be requested to send the list of qualified Mediators in order to mediate the opposition matters by conducting sitting in the Office of the branch registry once or twice in a week.

14. Considering the importance of trademarks in India and the fact that a majority of the application are made by Indian applicants, should the size of the Registry be addressed in the XII Plan? What could be an appropriate structure?

Yes, the size of the Registry should be addressed in XII Plan because of Government of India approval for entering into the International Trade Mark Registration Sector by WIPO and further recommendations made in para 5.68 of the Eighty Eighth

Parliamentary Standing Committee Report may be taken into consideration.

15. In view of the fact that some innovations can qualify for different kinds of IPRs, would it be better to have a single window at the front end for applicants for all kind of IPRs while the specific IPR issues could be handled by different offices at the back-end ?

It is not possible to have a single window

16. Any other views on the subject.

i) Now the policy of decentralization formulated by the DIPP in the year 2004 has totally been reversed by the present office of CGPD TM by having centralized examination at Mumbai, centralized issue of registration certificate at Mumbai, centralized fixation of hearing (at Mumbai) to be fixed in respect of every branch and therefore A to Z works under the provisions of Trade Marks Act should be decentralized to the respective branch registry to improve the efficiency of the works with a view to clear the back-log of more than 4,00,000/- applications pending for disposal. Therefore the policy of decentralization should be restored as it was prior to 2009.

ii) The present practice of authorizing the Examiner of Trade Marks to conduct the Hearing for applications and oppositions under Rule 111 and 56 should be discontinued because the Examiner has not been vested with quasi-judicial powers as like that of Registrar, Deputy Registrar or Asst.Registrar under the provisions of the Act. Further the definition of 'Tribunal' under Sec.2(ze) of the Act means

the Registrar or Appellate Board. Hence the Registrar could not delegates his quasi-judicial functions to the Examiners except the Executive functions. Otherwise, the Orders of the Examiner can be challenged under Art. 227 of the Constitution.

iii) Trade Mark Manual should be introduced immediately to follow the uniform procedures in all branch registries and thereby the acceptance of applications should be uniformal in all Registries and there should not be any discrimination on the part of the branch registries in accepting or refusing the Trade Marks. If such uniform policy is not properly followed by all the Examiners or Asst.Registrar in disposing the Trade mark Applications, such discrepancy may be brought to the notice of the Joint Controller (Trade Marks) who may delegate his powers to any Deputy Registrar under Sec.19 of the Act for withdrawal of acceptance after noticing the advertisement of unqualified trade marks in the Trade Marks Journal. Accordingly Sec.19 may be invoked to minimize the oppositions.

iv) The Examiner should be trained to examine the applications not by looking into the similar old marks on the Register because the e-Register will display so many dead marks as 'Registered'. Number of examples may be given in this regard if it is requested by DIPP.

v) So many vexatious and frivolous oppositions are being filed before the Trade Marks Registry. Hence it will be better

to establish Mediation Centres to be attached to each and every branch registry and to be presided over by a Retired High Court Judge or a Retired District Judge to be functioned twice or thrice in a week. Suitable amendments may be carried out in the Trade Marks Rules to establish such Mediation Centres on the line of High Court and Supreme Court.

vi) The Opposition filing fee may be doubled in order to discourage the filing of vexatious and frivolous oppositions.

vii) Under Sec.18(5) of the Trade Mark Act, there may be conditional acceptance of application and therefore conditional registration may be granted by confining the registration to a particular kind of goods and to a particular Region or a State or two or more States or a District etc on the basis of evidence produced by the applicant because Indian Economic market consists of 28 States and 7 Union Territories with population over 1.8 billion wherein there are so many regional brands either in a State level or in a District level. Hence a (MSME) trader operating business in one corner of the country could not do the business in all India level except by corporate or MNC companies. Accordingly no confusion or deception will arise in the market between two (MSME) traders operating business in two different regions in the Union of India. Therefore the Registrar may be empowered to apply his

common and general knowledge to find out the regional brands and accordingly conditional acceptance may be granted in case of two similar marks in two different parts of the country under Sec.12 of the said Act on the ground of “..... other special circumstances” Thereby Examiners and Asst.Registrars may be trained in such a way and accordingly suitable guidelines may be incorporated in the Trade Marks Manual to distinguish the Regional Brands as on the date of application.

viii) The Proviso to Sec 115(4) of the Act may be dropped in view of the recommendations made in para 5.78 of the 88th Report of the Parliamentary Standing Committee.

ix) The recommendations made in the para 5.70 and 5.71 of the 88th Report of the Parliamentary Standing Committee may be taken into consideration before amending Sec. 23 of the Trade Marks Act under the Proposed Amendment Bill to facilitate the entry of Madrid Protocol.

x) Proper storage facilities should be provided in all the Registries for proper up-keep of the growing volume of file Records as per recommendations in para 5.75 of the said Report but by considering the appointment of Library Science graduate in Senior Examiner Level or by recruiting the retired Record-Keepers from High Court or Supreme Court on contract basis to train the Trade Mark Registry's

permanent staff with regard to the fact how to maintain such voluminous records.

The above factors may be considered as suggestions to improve the efficient functioning of the Trade Marks Registry which is a 'Tribunal' exercising quasi-judicial powers under the provisions of Trade Marks Act, 1999.

P.C.N.RAGHUPATHY
Advocate
Chennai