

## **Intellectual Property Appellate Board (Procedure) Rules, 2012**

### CONTENTS

1. Short title and commencement
2. Definitions
3. Application or appeal to be in writing
4. (1) Evidence to be filed along with application
5. Payment of fee
6. Authorisation
7. Appearance by Parties themselves
8. Verification of the appeal or application
9. Presentation and scrutiny
10. Notices of application or appeal to the respondent
11. Filing of counter statement and evidence by the respondent in an application
12. Exhibits
13. Filing of Additional Documents in appeal
14. Opinion of experts
15. Extension of time
16. Intervention by third parties
17. Application by more than one person
18. The place of hearing
19. Date of hearing to be notified
20. Hearing of application or appeal
21. Adjournment of hearing
22. Award of costs by the Appellate Board
23. Order of the Board
24. Communication of orders
25. Publication of the orders
26. Review petitions
27. Continuation of proceedings after the death of a party, merger, assignment, acquisition or transmission
28. Supply of Certified Copy of Order
29. Fee for inspection of records and obtaining copies thereof
30. Functions of the Deputy Registrar
31. Additional functions and duties of the Deputy Registrar
32. Dress regulations for the Chairman, Vice-Chairman, Technical Member of the Appellate Board and for the representatives of the parties
33. Seal and emblem
34. Repeal

## 2012

In exercise of the powers conferred by section 92 of the Trade Marks Act, 1999 (47 of 1999), section 117H of the Patents Act, 1970 (39 of 1970), and section 33 of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (48 of 1999), the Appellate Board hereby makes the following rules, namely :-

### **1. Short title and commencement :-**

(1) These rules may be called The Intellectual Property Appellate Board (Procedure) Rules, 2012.

(2). They shall come into force on the date of their publication in the Official Gazette. The provisions of the Rules with reference to the Geographical Indications of Goods (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2012 shall come into force on such date as the Central Government may, by notification in the Official Gazette, publish the Geographical Indications of Goods (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2012.

### **2. Definitions :-**

In these rules, unless the context otherwise requires, -

(a) "Act" means the Trade Marks Act, 1999 (47 of 1999 ); the Patents Act, 1970 (39 of 1970) or the Geographical Indications of Goods (Registration and Protection) Act, 1999 (48 of 1999), as the context requires.

(b) "address for service" means the address furnished by an applicant or appellant or respondent or his authorised agent or his legal practitioner at which service of summons, notices or other processes may be effected;

(c) "appeal" means an appeal:

(i) under section 91 of the Trade Marks Act, 1999 or

(ii) under section 117A of the Patents Act, 1970 or

(iii) under section 31 of the Geographical Indications of Goods (Registration and Protection) Act, 1999, as the context requires, and includes Transferred Appeal (T.A.);

(d) "appellant" means,

(i) a person making an appeal to the Appellate Board under section 91 of the Trade Marks Act, 1999; or

(ii) a person making an appeal to the Appellate Board under section 117A of the Patents Act, 1970; or

- (iii) a person making an appeal under Section 31 of the Geographical Indication of Goods (Registration and Protection) Act, 1999, as the context requires.
- (e) "application" means,
- (i) an application for removal of a registered trade mark from the register under section 47 and/or for rectification and correction of the register under section 57 or section 125 of the Trade Marks Act, 1999;
- (ii) an application for revocation of a patent under Section 64 and/or an application for rectification of the register under Section 71 of the Patents Act, 1970;
- (iii) an application for rectification of the register under section 27 of the Geographical Indications of Goods (Registration and Protection) Act, 1999, as the context requires,
- (f) "Deputy Registrar" means the Deputy Registrar of the Appellate Board and includes any officer to whom the powers and functions of the Deputy Registrar may be delegated;
- (g) "fee" means the fee prescribed under the Second Schedule of these rules;
- (h) "form of pleadings" means Forms in First Schedule, which shall be used for all pleadings when applicable and where they are not applicable, forms of like character as nearly as may be;
- (i) "legal practitioner" shall have the same meaning as is assigned to it in the Advocates Act, 1961 (25 of 1961);
- (j) "legal representative" means a person who in law represents the estate of the deceased person;
- (k) "Miscellaneous Petition" means any petition, in any way relating to the main case, made to the Appellate Board not being an application or an appeal or review petition or petition to condone the delay;
- (I) "Original order copy" means the copy of the order sent by the Registry free of cost upon pronouncement of the same, and shall not include the certified copy furnished upon application and payment of requisite fee;
- (m) "Place of hearing" shall be at the Principal seat in Chennai or at Delhi/ Mumbai/Kolkata/Ahmedabad, as the case may be, where the Head Office or Branch Offices of the Trade Marks Registry, Patent Office or Geographical Indications Registry being established under the Trade Marks Act, 1999, the Patents Act, 1970 and the Geographical Indications of Goods (Registration and Protection) Act, 1999 having jurisdiction to exercise their functions under the respective Acts.

- ( n ) "pleadings" includes applications or appeals, counter statements, replies and evidences supplementing them and other documents permitted to be filed before the Appellate Board ;
- (o) "Registry" means the Registry of the Appellate Board;
- (p) "Schedule" means the Schedule to these rules;
- (q) "section" means a section of the Trade Marks Act, 1999 / the Patents Act, 1970 / the Geographical Indications of Goods (Registration and Protection Act, 1999 Act as the context requires;
- (r) "transferred application or appeal" means an application or an appeal or other proceedings which has been transferred to the Appellate Board:
- (a) under section 100 of the Trade Marks Act, 1999;
- (b) under section 117G of the Patents Act, 1970;
- (s) words and expressions used and not defined in these rules but defined in:
- (a) the Trade Marks Act, 1999 shall have the meanings respectively assigned to them in the Trade Marks Act, 1999;
- (b) the Patents Act, 1970 shall have the meanings respectively assigned to them in the Patents Act, 1970;
- (c) the Geographical Indications of Goods (Registration and Protection) Act, 1999 shall have the meanings respectively assigned to them in the Geographical Indications of Goods (Registration and Protection) Act, 1999;

### **3. Application or appeal to be in writing :-**

- (1) Every application, appeal, counter statement, reply or other document filed before the Appellate Board shall be typed or printed neatly on both sides in green paper or thick white paper (legal size).
- (2) The application or appeal under sub-rule (1) shall be presented in the prescribed form [as found in the Trade Marks (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2003/ the Patents (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2011/ the Geographical Indications of Goods (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2012], in three sets in a paper-book form along with an empty file-size envelope bearing full address of the respondent. In case the respondents are more than one, then, sufficient number of extra paper-books together with empty file-size envelopes bearing full address of each respondent shall be furnished by the applicant or appellant.

(3) An application or appeal sent by post shall be deemed to have been presented before the Registry on the day it was received in the Registry.

#### **4. (1) Evidence to be filed along with application :-**

(i) The applicant shall file along with the application the documents he seeks to rely on together with the affidavit to prove the same. This shall be annexed to the application in paper-book form, and shall be furnished in as many sets as mentioned in Rule 3 above.

(ii) The documents intended to be attached to an affidavit shall be referred to as Exhibits, numbered serially as Applicants exhibits (Ex.A-1, Ex.A-2 etc).

(2) Documents to accompany appeal - (i) The grounds of appeal shall be accompanied by an annexure thereto in paper book form containing the notice of opposition, counter-statement and evidence filed in support thereof, before the Registry.

(ii) The original order copy of the impugned order shall be filed along with the appeal.

(3) Application or Appeal signed by other than applicant or appellant - If an application or appeal, is signed by a person other than the applicant or appellant, then an affidavit stating the competency of such person, shall be filed along with such application or appeal and the affidavit shall state the name and address of such person and shall sufficiently describe the identity of the deponent and shall also state in what capacity he/she is so doing and whether he/she is authorized and if so, by whom and by what instrument and a copy thereof shall be annexed to the affidavit.

#### **5. Payment of fee :-**

(1) The fee for filing application, appeal and the application for condonation of delay shall be as provided

(a) in the Trade Marks (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2003; or

(b) in the Patents (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2011; or

(c) in the Geographical Indications of Goods (Applications and Appeals to the Intellectual Property Appellate Board) Rules, 2012, as the case may be.

(2) The fee for filing counter-statement, petition (i) for extension of time, (ii) for adjournment of hearing, (hi) for review of the order of

the Appellate Board, (iv) for Interim orders, etc. and (v) for leave to intervene and for copy application, shall be as provided in the Second Schedule to these Rules.

(3) The prescribed fee shall be paid by way of bank draft drawn in favour of the Deputy Registrar, Intellectual Property Appellate Board, payable at Chennai.

#### **6. Authorisation :-**

Every appeal, application or counter-statement when not presented by the parties themselves shall

(a) in the case of advocates, be accompanied by a vakalat duly executed in his/her favour;

(b) in the case of Patent/Trade Marks agents, be accompanied by a valid authorization letter containing the registration number signed by the party.

#### **7. Appearance by Parties themselves :-**

If a party is desirous of presenting its case in person, the party shall be asked by the Board to produce a valid identification document.

#### **8. Verification of the appeal or application :-**

Every pleading shall be verified at the foot, by the party or by one of the parties pleading and the person verifying shall specify that what he verifies is of his own knowledge and what he verifies upon information received and believed to be true by reference to the numbered paragraphs of the pleadings and shall be signed by the person making it and shall state the date on which it was signed and the place where it was signed.

Provided that the pleadings when not signed by the party or by one of the parties may be signed by any person duly authorized by the party to sign the same, on showing that by reason of absence or for other good and sufficient cause the party/parties is/are unable to sign the pleadings.

#### **9. Presentation and scrutiny :-**

(1) The Deputy Registrar shall endorse on every application or appeal the date on which it is presented.

(2) If, on scrutiny, the application or appeal is In order, it shall be duly registered and given a serial number.

(3) If an application or appeal is found to be defective and the defect noticed is formal in nature, the Deputy Registrar may allow the applicant or appellant to rectify the same in his presence and if the said defect is not formal in nature, the Deputy Registrar may allow the applicant or appellant fifteen days time to rectify the defect as he may deem fit and if the application or appeal has been sent by post and found to be defective, the Deputy Registrar may communicate the defects to the applicant or appellant and allow the applicant or appellant fifteen days time from the date of receipt of the communication from the Deputy Registrar, to rectify the defects.

(4) If the applicant or appellant fails to rectify the defects within the time allowed in sub-rule (3), the application or appeal shall be deemed to have been abandoned, unless the time is extended by the Deputy Registrar for rectifying the defect.

(5) If a request is made to the Deputy Registrar for extension of time within the fifteen days period, the Deputy Registrar may extend the time by 30 days. And if even after such extension, the applicant or appellant fails to rectify the defects, sub-rule (4) will take effect.

(6) Sub Rules (3) to (5) shall apply to filing of counter statement, miscellaneous petitions as far as applicable.

(7) If the respondent fails to rectify the defects within the time allowed in sub-rule (3) read with sub-rule (5), his defense shall be deemed to have been abandoned unless time is extended by the Deputy Registrar. The provisions of sub-rules (4) & (5) shall apply to the respondent mutatis mutandis. Thereafter the application may be listed for hearing ex parte.

#### **10. Notices of application or appeal to the respondent :-**

A copy of the application or appeal in paper-book form shall be served by the Deputy Registrar on the respondent after the same is numbered.

#### **11. Filing of counter statement and evidence by the respondent in an application :-**

After receipt of the application, the respondent may file two complete sets of counter statement in the prescribed form along with documents relied upon in support of the counter statement together with the affidavit to prove the same. This shall be filed in paper-book form before the Registry within two months of the

service of the notice on him of the filing of the application. A copy of the counter statement shall be served on the applicant by the respondent directly under intimation to the Registry.

## **12. Exhibits :-**

(1) The affidavits for proving the exhibits filed as evidence shall be, as nearly as possible, in accordance with the form given in the First Schedule.

(2) It shall be sworn to whether in India or abroad before a person having by law authority to attest such affidavits and shall state the date and place of execution and the seal of the attesting officer/notary public/commissioner of oaths, as the case may be.

(3) Where there are exhibits to affidavits, a copy each of such exhibits shall be sent to the other party or parties and the originals shall be produced whenever so required at the Registry for inspection of the other party and shall be produced at the time of hearing unless the Appellate Board otherwise directs.

## **13. Filing of Additional Documents in appeal :-**

The parties to an appeal shall not be entitled to produce additional evidence before the Appellate Board except in accordance with the provisions of Order XLI Rule 27 of the Code of Civil Procedure.

## **14. Opinion of experts :-**

(1) The Appellate Board, for deciding an application or appeal or any other matter pending before it under the Patents Act, may call for the opinion of a particular Technical Expert in a given case, either on its own, or at the instance of a party, if the facts of the case warrants the opinion of Technical Expert.

(2) The Appellate Board may maintain a panel of Technical Experts in each discipline for the purpose mentioned in sub-rule (1). Such panel shall be revived once in two years.

## **15. Extension of time :-**

(1) If the Appellate Board is satisfied, on a petition along with the prescribed fee made to it that there is sufficient cause for extending the time for doing any act, before such time has expired, it may subject to such conditions as it may think fit to impose, extend the time and inform the parties accordingly.

(2) Nothing in sub-rule (1) shall be deemed to require the



Appellate Board to hear the parties before disposing of the petition for extension of time.

**16. Intervention by third parties :-**

(1) Any person, alleging interest in a registered trade mark in respect of which, an appeal has been filed under section 91 of the Trade Marks Act, 1999 against the order or decision of the Registrar or an application has been filed before the Board under section 47 or section 57 or section 125 of the Trade Marks Act, for the removal of a trade mark or to cancel or vary the registration and to rectify the Register, may apply in the prescribed form given in the First Schedule with prescribed fees under these rules for leave to implead/intervene, stating the nature of his Interest. The Appellate Board may refuse or grant such leave after hearing the parties concerned, if so required, upon such terms and conditions as it deems fit.

(2) Any person alleging interest in a granted patent in respect of which an appeal has been filed under section 117A of the Patents Act, 1970 against the order or decision of the Controller or in an application for the revocation of the patent or to rectify the Register, may apply in the prescribed form given in the First Schedule with prescribed fees under these rules for leave to implead/intervene, stating the nature of his interest. The Appellate Board may refuse or grant such leave after hearing the parties concerned, if so required, upon such terms and conditions as it deems fit.

(3) Any person alleging interest in a registered geographical indication in respect of which an appeal has been filed under section 31 of the Geographical Indication of Goods (Registration and Protection) Act, 1999 against the order or decision of the Registrar or in an application for the rectification of the Register, may apply in the prescribed form given in the First Schedule along with prescribed fees under these rules for leave to implead/intervene, stating the nature of his interest. The Appellate Board may refuse or grant such leave after hearing the parties concerned if so required, upon such terms and conditions as it deems fit.

**17. Application by more than one person :-**

(1) In the case of any application filed jointly by two or more persons, the applicant shall file an affidavit stating the reasons for

such joint filing, accompanied by a petition seeking leave to file a single application with necessary fees. The Board may, if satisfied, grant leave to file a single application with or without separate fee. (2) Nothing in sub-rule (1) shall be deemed to require the Appellate Board to hear the parties before disposing of the petition filed under Rule 17(1) of these Rules.

**18. The place of hearing :-**

The place of hearing shall normally be the place of hearing having jurisdiction as per Rule 2(m). The application or appeal may, however, be heard at any other place of hearing, by mutual consent of the parties. Notwithstanding the fact that it was actually heard at such other place of hearing, It shall be always deemed to have been heard at the place of hearing having jurisdiction.

**19. Date of hearing to be notified :-**

The Appellate Board shall notify the parties the date and place of hearing of the application or appeal in such manner as the Chairman may by general or special order direct.

**20. Hearing of application or appeal :-**

(1) On the day fixed or on any other day to which the hearing may be adjourned, the parties shall be heard by the Appellate Board.

(2) In case where the applicant/appellant/respondent does not appear at the hearing, the Board may deal with the matter on merits and dispose of the same.

(3) In case the applicant/appellant remains absent on the date of hearing, the application/appeal may be dismissed for default. This shall be restored on petition filed within 30 days from the date of such order, on such terms as the Board deems fit.

(4) In case the respondent remains absent on the date of hearing, the respondent may be set ex parte and orders passed accordingly. This shall be set aside on petition filed within 30 days from the date of such order, on such terms as the Board deems fit.

**21. Adjournment of hearing :-**

A party to the hearing may make a petition for adjournment of the hearing together with the prescribed fee at least fifteen days before the date of hearing along with the concurrence for the adjournment from the other party. The Appellate Board may consider the

petition and pass such orders as it deems fit.

**22. Award of costs by the Appellate Board :-**

The Appellate Board may award such costs as it deems fit to the parties having regard to all the circumstances of the case.

**23. Order of the Board :-**

(1) Every order of the Appellate Board shall be signed and dated by the Members of the Bench.

(2) The order shall be pronounced in the sitting of the Bench.

**24. Communication of orders :-**

An original order copy of every order passed by the Board shall be communicated to the parties to the proceedings.

**25. Publication of the orders :-**

The orders of the Board as are deemed fit for publication in any authoritative report or the press may be released for such publication on such terms and conditions as the Chairman may lay down.

**26. Review petitions :-**

(1) A petition in triplicate for review of an order of the Appellate Board may be made to the Registry in the form prescribed in the First Schedule with prescribed fee, accompanied by a statement setting forth the grounds on which the review is sought within one month from the date on which the order is communicated. Where the order in question concerns more than one respondent, sufficient extra copies of such petition and statement shall be filed.

(2) The Registry shall forward the petition and statement to the respondents to the review petition.

(3) The respondents may file counter statement in Form 2 under these rules within one month from the date of receipt of the review petition and shall forward a copy of the counter statement to the petitioner directly under intimation to the Registry.

(4) The review petition shall be posted for hearing before the same Bench or the Bench consisting of anyone of the Members who passed the order under review.

**27. Continuation of proceedings after the death of a party,**

## **merger, assignment, acquisition or transmission :-**

On the death of a party or by merger, assignment, acquisition or transmission if a new party becomes entitled for continuation of the proceedings, the proceeding would be continued subject to filing a petition with evidence in support therefor.

## **28. Supply of Certified Copy of Order :-**

A certified copy of every order passed by the Board may be issued on the party filing copy application prescribed in the First Schedule, on payment of fees prescribed in the Second Schedule.

## **29. Fee for inspection of records and obtaining copies thereof :-**

(1) A fee of Rs.150/- for every hour or part thereof shall be charged for inspecting the records of a pending application or appeal or decided case.

(2) A fee of Rs.5/- shall be charged for providing photostat copy of each page of the record.

## **30. Functions of the Deputy Registrar :-**

(1) The Deputy Registrar shall discharge the functions under the general superintendence of the Chairman. He shall discharge such other functions as are assigned to him under these rules or by the Chairman by a separate order in writing.

(2) He shall have the custody of the records of the Appellate Board.

(3) The official seal of the Appellate Board shall be kept in the custody of the Deputy Registrar.

(4) Subject to any general or special directions of the Chairman, the official seal of the Appellate Board shall not be affixed to any order, summons or other process save under the authority in writing from the Deputy Registrar.

(5) The official seal of the Appellate Board shall not be affixed to any certified copy issued by the Appellate Board save under the authority in writing of the Deputy Registrar.

## **31. Additional functions and duties of the Deputy Registrar :-**

In addition to the functions and duties assigned under rule 30, the Deputy Registrar shall have the following functions and duties

subject to any general or special orders of the Chairman, namely:-

- ( i ) to receive all applications, appeals, petitions, counter statements, replies and other documents;
- (ii) to decide all questions arising out of the scrutiny of the appeals and applications and petitions before they are registered;
- (iii) to require any application, appeal, petition, counter statement, reply presented to the Appellate Board to be amended in accordance with the rules;
- (iv) subject to the directions of the Chairman, to fix date of hearing of the applications or appeals or other proceedings and issue notices therefor;
- (v) direct any formal amendment of records;
- (vi) to order supply of copies of documents to parties to proceedings;
- (vii) to grant leave to inspect the record of the Appellate Board;
- (viii) to requisition records from the custody of any court. Registrar of Trade Marks or other authority;
- (ix) to decide questions relating to extension of time in respect of filing of counter statement, reply, etc.

**32. Dress regulations for the Chairman, Vice-Chairman, Technical Member of the Appellate Board and for the representatives of the parties :-**

(1) The dress for the Chairman, Vice-Chairman and other Members shall be white pant and white shirt with black coat and black tie or a buttoned-up black coat, in the case of men and white or sober coloured saree, in the case of women.

(2) The dress for the professionals who appear before the Appellate Board shall be the professional dress, if any, and in case of other authorised representatives of the parties, it shall be the following :-

(a) In the case of male, a black coat with a black tie or buttoned-up black coat over a white pant.

(b) In the case of female, a black coat over white or any other sober coloured saree.

(c) All other persons appearing before the Appellate Board shall be properly dressed.

**33. Seal and emblem :-**

The official seal and emblem of the Appellate Board shall be such as the Central Government may specify.

#### **34. Repeal :-**

The Intellectual Property Appellate Board (Procedure) Rules, 2003 and the Intellectual Property Appellate Board (patents Procedure) Rules, 2010 are hereby repealed without prejudice to anything done under such rules before coming into force of the rules.