

TRADE AND MERCHANDISE MARKS ACT, 1958

43 of 1958

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SCHEDULE 1 :- Schedule

TRADE AND MERCHANDISE MARKS ACT, 1958

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An Act to provide for the registration and better protection of trade marks and for the prevention of the use of fraudulent marks on merchandise. BE IT ENACTED BY PARLIAMENT IN THE NINTH YEAR OF THE REPUBLIC OF INDIA AS FOLLOWS -

CHAPTER 1
PRELIMINARY

1. Short title, extent and commencement :-

- (1) The Act may be called the Trade and Merchandise Marks Act, 1958.
- (2) It extends to the whole of India.
- (3) It shall come into force on such date as the Central Government may, by notification in the Official Gazette, appoint.

2. Definitions and interpretation :-

- (1) In this Act, unless the context otherwise requires,-
 - (a) "assignment" means an assignment in writing by act of the parties concerned;
 - (b) "associated trade marks" means trade marks deemed to be, or required to be, registered as associated trade marks under this Act;
 - (c) "certification trade mark" means a mark adapted in relation to any goods to distinguish, in the course of trade, goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified

and registrable as such under the provisions of Chapter VIII in respect of those goods in the name as proprietor of the certification trade mark, of that person;

(d) "deceptively similar" :- A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark is to be likely to deceive or cause confusion;

(e) "District Court" has the meaning assigned to it in the Code of Civil Procedure, 1908 (5 of 1908);

(f) "false trade description" means-

(i) a trade description which is untrue or misleading in a material respect as regards the goods to which it is applied; or

(ii) any alteration of a trade description as regards the goods to which it is applied, whether by way of addition, effacement or otherwise where that alteration makes the description untrue or misleading in a material respect; or

(iii) any trade description which denotes or implies that there are contained, as regards the goods to which it is applied, more yards or meters than there are contained therein standard yards or standard meters; or

(iv) any marks or arrangement or combination thereof applied to good in such manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are or

(v) any false name or initials of a person applied to goods in such manner as if such name or initials were a trade description in a case where the name or initials-

(a) is or are not a trade mark or part of a trade mark; and

(b) is or are identical with or deceptively similar to the name or initials of a person carrying on business in connection with goods of the same description and who has not authorised the use of such name or initials; and

(c) is or are either the name or initials of a fictitious person or of some person not bona fide carrying on business in connection with such goods; and the fact that a trade description is a trade mark or part of a trade mark shall not prevent such trade description being

a false trade description within the meaning of this Act;

(g) "goods" means anything which is the subject of trade or manufacture;

(h) "High Court*" means the High Court having jurisdiction under section

(i) "limitations" (with its grammatical variations) means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold or otherwise trade in within India, or as to use in relation to goods to be exported to an market outside India;

(j) "mark" includes a device, brand, heading, label, ticket, name, signature word, letter or numeral or any combination thereof;

(k) "name*" includes any abbreviation of a name;

(1) "package" includes any case, box, container, covering, folder, receptacle, vessel, casket, bottle, wrapper, label, band, ticket, reel, frame, capsule, cap, lid, stopper and cork;

(m) "permitted use", in relation to a registered trade mark, means the use of a trade mark-

(i) by a registered user of the trade mark in relation to goods -

(a) with which he is connected in the course of trade; and

(b) in respect of which the trade mark remains registered for the time being; and

(c) for which he is registered as registered user; and

(ii) which complies with any conditions or restrictions to which the registration of the trade mark is subject;

(n) "prescribed" means, in relation to proceedings before a High Court, prescribed by rules made by the High Court, and in other cases, prescribed by rules made under this Act;

(o) "register" means the Register of Trade Marks referred to in section 6 ;

(p) "registered" (with its grammatical variations) means registered under this Act;

- (q) "registered proprietor", in relation to a trade mark, means the person for the time being entered in the register as proprietor of the trade mark;
- (r) "registered trade mark" means a trade mark which is actually on the register;
- (s) "registered user" means a person who is for the time being registered as such under section 49 ;
- (t) "Registrar" means the Registrar of Trade Marks referred to in section 4 ;
- (u) "trade description" means any description, statement or other indication, direct or indirect,-
- (i) as to the number, quantity, measure, gauge or weight of any goods; or
- (ii) as to the standard of quality of any goods, according to a classification commonly used or recognised in the trade; or
- (iii) as to fitness for the purpose, strength, performance or behaviours of any goods, being "drug" as defined in the DRUGS AND COSMETICS ACT, 1940 , or "food" as defined in the Prevention of Food Adulteration Act, 1954 ; or
- (iv) as to the place or country in which or the time at which any goods were made or produced; or
- (v) as to the name and address or other indication of the identity of the manufacturer or of the person for whom the goods are manufactured; or
- (vi) as to the mode of manufacture or producing any goods: or
- (vii) as to the material of which any goods are composed; or
- (viii) as to any goods being the subject of an existing patent, privilege or copyright, and includes-
- (a) any description as to the use of any mark which according to the custom of the trade is commonly taken to be an indication of any of the above matters;
- (b) the description as to any imported goods contained in a bill or entry of shipping bill;
- (c) any other description which is likely to be misunderstood or

mistaken for all or any of the said matters;

(v) "trade mark" means-

(i) in relation to Chapter X (other than section 81), a registered trade mark or a mark used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right as proprietor to use the mark; and

(ii) in relation to the other provisions of this Act, a mark used or proposed to be used in relation to goods for the purpose of indicating or so as to indicate a connection in the course of trade between the goods and some person having the right, either as proprietor or as registered user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark registered as such under the provisions of Chapter VIII;

(w) "transmission" means transmission by operation of law, devolution on the personal representative of a deceased person and any other mode of transfer, not being assignment;

(x) "tribunal" means the Registrar or, as the case may be, the High Court, before which the proceeding concerned is pending.

(2) In this Act, unless the context otherwise requires, any reference-

(a) to the use of a mark shall be construed as a reference to the use of a printed or other visual representation of the mark;

(b) to the use of a mark in relation to goods shall be construed as a reference to the use of the mark upon, or in any physical or in any other relation whatsoever, to such goods;

(c) to a registered trade mark shall be construed as including a reference to a trade mark registered in Part A of the register or Part B of the register, as the case may be;

(d) to the Registrar shall be construed as including a reference to any officer when discharging the functions of the Registrar in pursuance of sub- section (2) of section 4 ;

(e) to the Trade Marks Registry shall be construed as including a reference to any office of the Trade Marks Registry.

3. High Court having Jurisdiction :-

The High Court having jurisdiction under this Act shall be the High Court within the limits of whose appellate jurisdiction the office of the Trade Marks Registry referred to in each of the following cases is situate, namely:-

(a) in relation to a trade mark on the Register of Trade Marks at the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor of the trade mark as entered in the register at such commencement is situate;

(b) in relation to a trade mark for which an application for registration is pending at or is made on or after the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant as disclosed in his application is situate;

(c) in relation to a trade mark registered in the names of joint proprietors before the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor whose name is entered first in the register at such commencement as having such place of business is situate;

(d) in relation to a trade mark for which an application for registration in the names of joint proprietors is pending at or is made on or after the commencement of this Act, the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the proprietor whose name is first mentioned in the said application as having such place of business is situate;

(e) where the registered proprietor or the applicant for registration as aforesaid has no place of business in India or where none of the jointly registered proprietors or none of the joint applicants as aforesaid has any place of business in India, the office of the Trade Marks Registry within whose territorial limits-

(i) in relation to trade mark on the Register of Trade Marks at the commencement of this Act, the place mentioned in the address for service in India as entered in the register at such commencement;

(ii) in relation to a trade mark for which an application for registration is pending at or is made on or after such

commencement, the place mentioned in the address for service in India as specified in the application, is situate.

CHAPTER 2

THE REGISTER AND CONDITIONS FOR REGISTRATION

4. Registrar of Trade Marks :-

(1) The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.

(2) The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction, of the Registrar, such functions of the Registrar under this Act as he may from time to time authorise them to discharge.

5. Trade Marks Registry and offices thereof :-

(1) For the purpose of this Act there shall be established a Registry which shall be known as the Trade Marks Registry.

(2) The head office of the Trade Marks Registry shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of trade marks, there may be established at such places as the Central Government may think fit branch offices of the Trade Marks Registry.

(3) The Central Government may, by notification in the Official Gazette, define the territorial limits within which an office of the Trade Marks Registry may exercise its functions.

(4) There shall be a seal of the Trade Marks Registry.

6. The Register of Trade Marks :-

(1) For the purposes of this Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and descriptions of the proprietors, notifications of assignments and transmissions, the names, addresses and descriptions of registered users, disclaimers, conditions, limitations and such other matters relating to registered trade marks as may be prescribed.

(2) No notice of any trust, express or implied or constructive, shall

be entered in the register and no such notice shall be receivable by the Registrar.

(3) Subject to the superintendence and direction of the Central Government, the register shall be kept under the control and management of the Registrar.

(4) There shall be kept at each branch office of the Trade Marks Registry a copy of the register and such of the other documents mentioned in section 125 as the Central Government may, by notification in the Official Gazette, direct.

7. Part A and Part B of the register :-

(1) The register referred to in section 6 shall be divided into two parts called respectively Part A and Part B.

(2) The Register of Trade Marks existing at the commencement of this Act shall be incorporated with and form part of Part A of the register, and this Part shall comprise all trade marks entered in the Register of Trade marks existing at the commencement of this Act and all trade marks which after such commencement may be entered in Part A of the register

(3) Part B of the register shall comprise all trade marks which after the commencement of this Act may be entered in Part B of the register.

8. Registration to be in respect of particular goods :-

(1) A trade mark may be registered in respect of any or all of the goods comprised in a prescribed class of goods.

(2) Any question arising as to the class within which any goods fall shall be determined by the Registrar whose decision in the matter shall be final.

9. Requisites for registration in Parts A and B of the register :-

(1) A trade mark shall not be registered in Part A of the register unless it contains or consists of at least one of the following essential particulars, namely:-

(a) the name of a company, individual or firm represented in a special or particular manner;

(b) the signature of the applicant for registration or some

predecessor in his business;

(c) one or more invented words;

(d) one or more words having no direct reference to the character or quality of the goods and not being according to its ordinary signification, a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India;

(e) any other distinctive mark.

(2) A name, signature or word, other than such as fall within the descriptions in clauses (a), (b), (c) and (d) of sub-section (1) shall not be registrable in Part A of the register except upon evidence of its distinctiveness.

(3) For the purposes of this Act, the expression "distinctive" in relation to the goods in respect of which a trade mark is proposed to be registered, means adapted to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists either gradually or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(4) A trade mark shall not be registered in Part B of the register unless the trade mark in relation to the goods in respect of which it is proposed to be registered is distinctive, or is not distinctive but is capable of distinguishing goods with which the proprietor of a trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(5) In determining whether a trade mark is distinctive or is capable of distinguishing as aforesaid, the tribunal may have regard to the extent to which-

(a) a trade mark is inherently distinctive or is inherently capable of distinguishing as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact so adapted to distinguish or is in fact capable of distinguishing as aforesaid.

(6) Subject to the other provisions of this section, a trade mark in respect of any goods-

(a) registered in Part A of the register may be registered in Part B of the register; and

(b) registered in Part B of the register may be registered in Part A of the register; in the name of the same proprietor of the same trade mark or any part or parts thereof.

10. Limitation as to colour :-

(1) A trade mark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by the tribunal having to decide on the distinctive character of the trade mark.

(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

11. Prohibition of registration of certain marks :-

A mark-

(a) the use of which would be likely to deceive or cause confusion; or

(b) the use of which would be contrary to any law for the time being in force; or

(c) which comprises or contains scandalous or obscene matter; or

(d) which comprises or contains any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; or

(e) which would otherwise be disentitled to protection in a court, shall not be registered as a trade mark.

12. Prohibition of registration of identical or deceptively similar trade marks :-

(1) Save as provided in sub-section (3), no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of different proprietor in respect of the same goods or description of goods.

(2) Where separate applications are made by different persons to

be registered as proprietors respectively of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, the Registrar may defer the acceptance of the application or applications bearing a later date until after the determination of the proceedings in respect of the earlier application, and may dispose of such application or applications in the light of the evidence tendered in relation to earlier application and the oppositions thereto, if any.

(3) In 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 trade marks which are identical or nearly resemble each other (whether any such trade mark is already registered or not) in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

13. Prohibition of registration of names of chemical elements :-

(1) No word which is the commonly used and accepted name of any single chemical element or single chemical compound (as distinguished from a mixture) shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration shall, notwithstanding anything in section 32, be deemed for the purposes of section 56 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.

(2) This section shall not apply to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

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.

15. Registration of parts of trade marks and of trade marks as a series :-

(1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to registrar the whole and the part as separate trade marks.

(2) Each such separate trade mark shall satisfy all the conditions applying to, and have all the incidents of, an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks in respect of the same goods or description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of-

(a) statement of the goods in relation to which they are respectively used or proposed to be used; or

(b) statements of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour, seeks to register those trade marks, they may be registered as a series in one registration.

16. Registration of trade marks as associated trade inarks :-

(1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods 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 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 trade marks.

(2) Where a trade mark and any part thereof are, in accordance

with the provisions of sub-section (1) of section 15 , registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(3) All trade marks registered in accordance with the provisions of sub-section

(3) of section 15 as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

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

17. Registration of trade marks subject to disclaimer :-

If 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 tribunal, in deciding whether the trade mark shall be entered or shall remain on the register, may require as a condition of its being on the register, that the proprietor shall either disclaim any right to the 'exclusive use of such part or of all or any portion of such matter, as the case may be, to the exclusive use of which the tribunal holds him not to be entitled, or make such other disclaimer as the tribunal may consider necessary for the purpose of defining the rights of the proprietor under the registration : Provided that no disclaimer shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

CHAPTER 3

PROCEDURE FOR AND DURATION OF REGISTRATION

18. Application for Registration :-

(1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark either in Part A or in Part B of the register.

(2) An application shall not be made in respect of goods comprised in more than one prescribed class of goods.

(3) Every application under sub-section (1) shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India or the applicant whose name is first mentioned in the application as having a place of business in India, is situate : Provided that where the applicant or any or the joint applicants does not carry on business in India, the application shall be filed in the office of the Trade Marks Registry within whose territorial limits the place mentioned in the address for service in India as disclosed in the application, is situate.

(4) Subject to the provisions of this Act, the Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(5) In the case of an application for registration of a trade mark (other than a certification trademark) in Part A of the register, the Registrar may, if the applicant so desires, instead of refusing the application, treat it as an application for registration in Part B of the register and deal with the application accordingly.

(6) In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the grounds for such refusal or conditional acceptance and the materials used by him arriving at his decision.

19. Withdrawal of acceptance :-

Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied-

(a) that the application has been accepted in error; or

(b) that in the circumstances of the case the trade mark should not

be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted; the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

20. Advertisement of application :-

(1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner : Provided that the Registrar may cause the application to be advertised before acceptance if it relates to a trade mark to which sub-section (2) of section 9 applies or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do.

(2) Where-

(a) an application has been advertised before acceptance under sub-section (1); or

(b) after advertisement of an application-

(i) an error in the application has been corrected ; or

(ii) the application has been permitted to be amended under section 22 : the Registrar may in his discretion cause the application to be advertised again or in any case falling under clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or amendment made in the application.

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 so 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 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.

22. Correction and amendment :-

The Registrar may on such terms as he thinks just-

(a) at any time, whether before or after acceptance of an application for registration under section 18 , permit the correction of any error in or in connection with the application or permit an amendment of the application; or

(b) permit correction of any error in, or an amendment of, a notice of opposition or a counter-statement under section 21 .

23. Registration :-

(1) Subject to the provisions of section 19 , when an application for registration of a trade mark in Part A or Part B of the register has been accepted and either-

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has not been opposed and the opposition has been decided in favour of the applicant, the Registrar shall, unless the Central Government otherwise directs, register the said trade mark in Part A or Part B of the register, as the case may be, and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 131 , be deemed to be the date of registration.

(2) On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

(3) Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

(4) The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

24. Jointly owned trade marks :-

(1) Save as provided in sub-section (2), nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

(2) Where the relations between two or more persons interested in a trade mark are such 'that no one of them is entitled as between himself and the other or others of them to use it except-

(a) on behalf of both or all of them; or

(b) in relation to an article with which both or all of them are connected in the course of trade; those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

25. Duration, renewal and restoration of registration :-

(1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with the provisions of this section.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of seven years from the date of expiration of the original registration or of the last renewal of registration, as the case may be (which date is in this section referred to as the expiration of the last registration).

(3) At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register.

(4) Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar may, within one year from the expiration of the last registration of trade mark, on receipt of an application in the prescribed form, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of seven years from the expiration of the last registration.

26. Effect of removal from register for failure to pay fee for renewal :-

Where a trade mark has been removed from the register for failure to pay the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of another trade mark during on year, next after the date of the removal, be deemed to be a trade mark already on the register, unless the tribunal is satisfied either

(a) that there has been no bona fide trade use of the trade mark which has been removed during the two years immediately preceding its removal; or

(b) that no deception or confusion would be likely to arise from the

use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

CHAPTER 4

EFFECT OF REGISTRATION

27. No action for infringement of unregistered trade mark :-

(1) No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark.

(2) Nothing in this Act shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof.

28. Rights conferred by registration :-

(1) Subject to the other provisions of this Act, the registration of a trade mark in Part A or Part B of the register shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

(2) The exclusive right to the use of a trade mark given under subsection (1) shall be subject to any conditions and limitations to which the registration is subject.

(3) Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trade marks shall not (except so far as their respective rights are subject to any conditions or limitations entered on the register) be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trade marks but each of these persons has otherwise the same rights as against other persons (not being registered users using by way of permitted use) as he would have if he were the sole registered proprietor.

29. Infringement of trade marks :-

(1) A registered trade mark is infringed by a person who, not being the registered proprietor of the trade mark or a registered user thereof using by way of permitted use, uses in the course of a trade

mark which is identical with, or deceptively similar to, the trade mark, in relation to any goods in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2) In an action for infringement of a trade mark registered in Part B of the register an injunction or other relief shall not be granted to the plaintiff if the defendant establishes to the satisfaction of the court that the use of the mark of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods in respect of which the trade mark is registered and some person having the right, either as registered proprietor or as registered user, to use the trade mark.

30. Acts not constituting infringement :-

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered trade mark:-

(a) where a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;

(b) the use by a person of a trade mark in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark;

(c) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods are so adapted, and neither the purpose nor the effect of the use of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and

the goods;

(d) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

(2) Where the goods bearing a registered trade mark are lawfully acquired by a person, the sale of or other dealings in those goods by that person or by a person claiming under or through him is not an infringement of the trade mark by reason only of the trade mark having been assigned by the registered proprietor to some other person after the acquisition of those goods.

31. Registration to be prima facie evidence of validity :-

(1) In all legal proceedings relating to a trade mark registered under this Act (including applications under section 56), the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark shall be prima facie evidence of the validity thereof.

(2) In all legal proceedings as aforesaid a trade mark registered in Part A of the register shall not be held to be invalid on the ground that it was not a registrable trade mark under section 9 except upon evidence of distinctiveness and that such evidence was not submitted to the Registrar before registration, in all legal proceedings as aforesaid, if it is proved that the trade mark had been used by the registered proprietor or his predecessor in title as to have become distinctive at the date of registration.

32. Registration to be conclusive as to validity after seven years :-

Subject to the provisions of section 35 and section 46 , in all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 56) the original registration of the trade mark shall, after the expiration of seven years from the date of such registration, be taken to be valid in all respects unless it is proved-

(a) that the original registration was obtained by fraud; or

(b) that the trade mark was registered in contravention of the provisions of section 11 or offends against the provisions of that section on the date of commencement of the proceedings; or

(c) that the trade mark was not, at the commencement of the proceedings, distinctive of the goods of the registered proprietor.

33. Saving for vested rights :-

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior-

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his; whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second-mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

34. Saving for use of name, address or description of goods

:-

Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name or the place of business, or any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods.

35. Saving for words used as name or description of an article or substance :-

(1) The registration of a trademark shall not be deemed to have become invalid by reason only of any use after the date of the registration of any word or words which the trade mark contains or of which it consists as the name or description of an article or substance : Provided that, if it is proved either-

(a) that there is a well-known and established use of the said words as the name or description of the article or substance by a person or person carrying on a trade therein, not being used in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark or (in the case of a certification trade mark) goods certified by the proprietor; or

(b) that the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed, and that the said word is the only practicable name or description of the article or substance; the provisions of sub-section (2) shall apply.

(2) Where the facts mentioned in clause (a) or clause (b) of the proviso to sub-section (1) are proved with respect to any words, then-

(a) for the purposes of any proceedings under section 56 -

(i) if the trade mark consists solely of such words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed to be an entry wrongly remaining on the register;

(ii) if the trade mark contains such words and other matter, the tribunal in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may, in case of a decision in favour of its remaining on the register, require as a condition thereof that the proprietor shall disclaim any exclusive right to the use in relation to that article or substance and any goods of the same description, of such words : Provided that no disclaimer shall affect any rights of the proprietor of trade mark except such as arise out of the registration of the trade mark, in respect of which the disclaimer is made;

(b) for the purposes of any other legal proceeding relating to the trade mark,-

(i) if the trade mark consists solely of such words, all rights of the proprietor under this Act or any other law to the use of the trade mark in relation to the article or substance in question or to any goods of the same description ; or

(ii) if the trade mark contains such words and other matter, all such rights of the proprietor to the use of such words, in such relation as aforesaid; shall be deemed to have ceased on the date at which the use mentioned in clause (a) of the proviso to sub-section (1) first became well-known and established, or at the expiration of the period of two years mentioned in clause (b) of the said proviso.

36. Power of registered proprietor to assign and give receipts :-

The person for the time being entered in the register as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment.

37. Assignability and transmissibility of registered trade marks :-

Notwithstanding anything in any other law to the contrary, a registered trade mark shall, subject To the provisions of this Chapter, be assignable and transmissible, whether with or without the goodwill of the business concerned and in respect either of all the goods in respect of which the trade mark is registered or of some only of those goods.

38. Assignability and transmissibility of unregistered trade marks :-

(1) An unregistered trade mark shall not be assignable or transmissible except along with the goodwill of the business concerned.

(2) Notwithstanding anything contained in sub-section (1), an unregistered trade mark may be assigned or transmitted otherwise than along with the goodwill of the business concerned if-

(a) at the time of assignment or transmission of the unregistered trade mark, it is used in the same business as a registered trade mark; and

(b) the registered trade mark is assigned or transmitted at the same time and to the same person as the unregistered trade mark ; and

(c) the unregistered trade mark relates to goods in respect of which the registered trade mark is assigned or transmitted.

39. Restrictions on assignment or transmission where multiple exclusive rights would be created :-

(1) Notwithstanding anything in section 37 and section 38 , a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the

circumstances subsist, whether under this Act or any other law, exclusive rights in more than one of the persons concerned to the use, in relation to the same goods or description of goods, of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods and of the trade marks, the use of the trade marks in exercise of those rights would be likely to deceive or cause confusion: Provided that an assignment or transmission shall not be deemed to be invalid under this sub-section if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to goods to be sold, or otherwise traded in, within India otherwise than for export therefrom, or in relation to goods to be exported to the same market outside India.

(2) The proprietor of a registered trade mark who proposes to assign it may submit to the Registrar in the prescribed manner a statement of case setting out the circumstances and the Registrar may issue to him a certificate stating whether, having regard to the similarity of the goods and of the trade marks referred to in the case, the proposed assignment would or would not be invalid under sub-section (1), and a certificate so issued shall, subject to appeal and unless it is shown that the certificate was obtained by fraud or misrepresentation, be conclusive as to the validity or invalidity under sub-section (1) of the assignment in so far as such validity or invalidity depends upon the facts set out in the case, but, as regards a certificate in favour of validity, only if application for the registration under section 44 of the title of the person becoming entitled is made within six months from the date on which the certificate is issued.

40. Restrictions on assignment or transmission when exclusive rights would be created in different parts of India

:-

Notwithstanding anything in section 37 and section 38, a trade mark shall not be assignable or transmissible in a case in which as a result of the assignment or transmission there would in the circumstances subsist, whether under this Act or any other law, an exclusive right in one of the persons concerned to the use of the trade mark limited to use in relation to goods to be sold, or otherwise traded in, in any place in India and an exclusive right in another of these persons to the use of a trade mark nearly resembling the first-mentioned trade mark or of an identical trade

mark in relation to the same goods or description of goods limited to use in relation to goods to be sold, or otherwise traded in, in any other place in India : Provided that in any such case, on application in the prescribed manner by the proprietor of a trade mark who proposes to assign it, or by a person who claims that a registered trade mark has been transmitted to him or to a predecessor in title of his since the commencement of this Act, the Registrar, if he is satisfied that in all the circumstances the use of the trade mark in exercise of the said rights would not be contrary to the public interest, may approve the assignment or transmission, and an assignment or transmission so approved shall not, unless it is shown that the approval was obtained by fraud or misrepresentation, be deemed to be invalid under this section or section 39 if application for the registration under section 44 of the title of the person becoming entitled is made within six months from the date on which the approval is given or, in the case of a transmission, was made before that date.

41. Conditions for assignment otherwise than in connection with the goodwill of a business :-

Where an assignment of a trade mark, whether registered, or unregistered, is made otherwise than in connection with the goodwill of the business in which the mark has been or is used, the assignment shall not take effect unless the assignee, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, not exceeding three months in the aggregate, as the Registrar may allow, applies to the Registrar for directions with respect to the advertisement of the assignment, and advertises it in such form and manner and within such period as the Registrar may direct.

42. Assignability and transmissibility of certification trade marks :-

A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Central Government, for which application shall be made in writing in the prescribed manner through the Registrar.

43. Assignability and transmissibility of associated trade marks :-

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

registered as separate trade inarks.

44. Registration of assignments and transmissions :-

(1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register : Provided that where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court.

(2) Except for the purpose of an application before the Registrar under sub-section (1) or an appeal from an order thereon, or an application under section 56 or an appeal from an order thereon, a document or instrument in respect of which no entry has been made in the register in accordance with sub-section (1), shall not be admitted in evidence by the Registrar or any court in proof of title to the trade mark by assignment or transmission unless the Registrar or the court, as the case may be, otherwise directs.

CHAPTER 6

USE OF TRADE MARKS AND REGISTERED USERS

45. Proposed use of trade mark by company to be formed :-

(1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark, if the Registrar is satisfied that a Company is about to be formed and registered under Companies Act, 1956 , and that the application intends to assign the trade mark to that company with a view to the use thereof in relation to those goods by the company.

(2) The tribunal may, in a case to which sub-section (1) applies, require the applicant to give security for the costs of any proceedings relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(3) Where in a case to which sub-section (1) applies, a trademark in respect of any goods is registered in the name of an applicant who relies on intention to assign the trade mark to a company, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may, on application being made to him in the prescribed manner, allow, the company has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

46. Removal from register and imposition of limitations on ground of non-use :-

(1) Subject to the provisions of section 47 , a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved on the ground either -

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him or, in a case to which the provisions of section 45 apply, by the company concerned, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to a date one month before the date of the application ; or

(b) that upto a date one month before the date of the application, a continuous period of five years or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being: Provided that, except where the applicant has been permitted under sub- section (3) of section 12 to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark, the tribunal may refuse an application under clause (a) or clause (b) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the trade mark by any proprietor thereof for the time being in relation to goods of the same description, being goods in respect of which the trade mark is registered.

(2) Where in relation to any goods in respect of which a trade mark is registered-

(a) the circumstances referred to in clause (b) of sub-section (1) are shown to exist so far as regards non-use of the trade mark in relation to goods to be sold, or otherwise traded in, in a particular place in India (otherwise than for export from India), or in relation to goods to be exported to a particular market outside India; and

(b) a person has been permitted under sub-section (3) of section 12 to register an identical or nearly resembling trade mark in respect of those goods under a registration extending to use in relation to goods to be so sold, or otherwise traded in, or in relation to goods to be so exported, or the tribunal is of opinion that he might properly be permitted so to register such a trade mark, on application by that person in the prescribed manner to a High Court or to the Registrar, the Tribunal may impose on the registration of the first- mentioned trade mark such limitations as it thinks proper for securing that that registration shall cease to extend to such use.

(3) An applicant shall not be entitled to rely for the purpose of clause (b) of sub- section (1) or for the purposes of sub-section (2) on any non-use of a trade mark which is shown to have been due to special circumstances in the trade and not to any intention to abandon or not to use the trade mark in relation to the goods to which the application relates.

47. Defensive registration of well-known trade marks :-

(1) Where a trade mark consisting of any invented word has become so well-known as respects any goods in relation to which it is registered and has been used, that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first mentioned goods, then, notwithstanding that the proprietor registered in respect of the first mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 46 , the trade mark may, on application in the prescribed manner by such proprietor, be registered in his name in respect of those other goods as a defensive trade mark, and while so registered, shall not be liable to be taken off the register in respect of those goods under the said section.

(2) The registered proprietor of trade mark may apply for the

registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and' that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be and shall be registered as, associated trade marks.

(4) On application made in the prescribed manner to a High Court or to the Registrar, by any person aggrieved, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of sub-section (1) are no longer satisfied in respect of any goods in relation to which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in relation to which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in sub-section (1).

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

48. Registered users :-

(1) Subject to the provisions of. section 49 , a person other than the registered proprietor of a trade mark may be registered as the registered user thereof in respect of any or all of the goods in respect of which the trade mark is registered otherwise than as a defensive trade mark; but the Central Government may, by rules

made in this behalf, provide that no application for registration as such shall be entertained unless the agreement between the parties complies with the conditions laid down in the rules for preventing trafficking in trade marks.

(2) The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor, for the purposes of section 46 or for any other purpose for which such use is material under this Act or any other law.

49. Application for registration as registered users :-

(1) Where it is proposed that a person should be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall jointly apply in writing to the Registrar in the prescribed manner, and every such application shall be accompanied by-

(i) the agreement in writing or a duly authenticated copy thereof, entered into between the registered proprietor and the proposed registered user with respect to the permitted use of the trade mark; and

(ii) an affidavit made by the registered proprietor or by some person authorised to the satisfaction of the Registrar to act on his behalf,-

(a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;

(b) stating the goods in respect of which registration is proposed;

(c) stating the conditions or restrictions, if any, proposed with respect to the characteristics of the goods, to the mode or place or permitted use, or to any other matter;

(d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof; and

(iii) such further documents or other evidence as may be required by the Registrar or as may be prescribed.

(2) When the requirements of sub-section (1) have been complied with to his satisfaction, the Registrar shall forward the application together with his report and all the relevant documents to the Central Government.

(3) On receipt of an application under sub-section (2), the Central Government, having regard to all the circumstances of the case and to the interests of the general public, and the development of any industry, trade or commerce in India, may direct the Registrar-

(a) to refuse the application; or

(b) to accept the application either absolutely or subject to any conditions, restrictions or limitations which the Central Government may think proper to impose: Provided that no direction for refusing the application or for its acceptance conditionally shall be made unless the applicant has been given an opportunity of being heard.

(4) The Registrar shall dispose of the application in accordance with the directions issued by the Central Government under sub-section (3).

(5) The Central Government and the Registrar shall, if so requested by the applicant, take steps for securing that information given for the purposes of an application under this section (other than matters entered in the register) is not disclosed to rivals in trade.

(6) The Registrar shall issue notice in the prescribed manner of the registration of a person as a registered user, to other registered users of the trade mark, if any.

50. Existing registration of registered users not to have effect after three years :-

Notwithstanding anything contained in any law for the time being in force or in any contract or agreement, every registration made before the commencement of this Act of a registered user shall cease to have effect after the expiration of three years from such commencement.

51. Power of registered user to take proceedings against infringement :-

(1) Subject to any agreement subsisting between the parties, a

registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and if the proprietor refuses or neglects to do so within three months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

(2) Notwithstanding anything contained in any other law, a proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

52. Power of registrar to vary or cancel registration as registered user :-

(1) Without prejudice to the provisions of section 56 , to the registration of a person as a registered user-

(a) may be varied by the Registrar as regards the goods in respect of which or any conditions or restrictions subject to which, it has effect on the application in writing in the prescribed manner of the registered proprietor of the trade mark;

(b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark;

(c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, namely:-

(i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause or to be likely to cause, deception or confusion;

(ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for registration, which if accurately represented or disclosed would have justified the refusal of the application for registration of the registered user;

(iii) that the circumstances have changed since the date of registration in such a way that at the date of such application for cancellation they would have justified the refusal of an application for registration of the registered user;

(iv) that the registration ought not to have been effected having

regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested;

(d) maybe cancelled by the Registrar of his own motion or on the application in writing in the prescribed manner of any person, on the ground that any stipulation in the agreement between the registered proprietor and the registered user regarding the quality of the goods in relation to which the trade mark is to be used is either not being enforced or is not being complied with;

(e) may be cancelled by the Registrar in respect of any goods in relation to which the trade mark is no longer registered.

(2) The Registrar shall, before varying any registration under clause (a) of sub-section (1) or cancelling any registration on any of the grounds mentioned in sub-clause (ii) or sub-clause (iii) or sub-clause (iv) of clause (c) of that sub-section, forward the application made in that behalf for the consideration of the Central Government, and the Central Government may, after making such inquiry as it thinks fit, issue such directions to the Registrar as it thinks fit, and the Registrar shall dispose of the application in accordance with such directions.

(3) The Registrar shall issue notice in the prescribed manner of every application under this section to the registered proprietor and each registered user (not being the applicant) of the trade mark.

53. Registered user not to have right of assignment or transmission :-

Nothing in this Act shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof. Explanation 1 : The right of a registered user of a trade mark shall not be deemed to have been assigned or transmitted within the meaning of this section in the following cases, namely :- (a) where the registered user being an individual enters into a partnership with any other person for carrying on the business concerned; but in any such case the firm may use the trade mark, if otherwise in force, only for so long as the registered user is a member of the firm ; (b) where the registered user being a firm subsequently undergoes a change in its constitution; but in any such case the reconstituted firm may use the trade mark, if otherwise in force, only for so long as any partner of the original firm at the time of its registration as registered user, continues to be a partner of the

reconstituted firm. Explanation 2 : For the purposes of Explanation I, "firm" has the same meaning as in Partnership Act, 1932 .

54. Use of one of associated or substantially identical trade marks equivalent to use of another :-

(1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the Tribunal may, if and so far as it shall think right, accept use of a registered associated trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any trade mark being a part thereof and registered in accordance with sub-section (1) of section 15 in the name of the same proprietor.

55. Use of trade mark for export trade and use when form of trade connection changes :-

(1) The application in India of trade mark to goods to be exported from India and any other act done in India in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded within India would constitute use of a trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or any other law.

(2) The use of a registered trade mark in relation to goods between which and the person using the mark any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the mark has been or is used in relation to goods between which and the said person or a predecessor in title of that person a different form of connection in the course of trade subsisted or subsists.

CHAPTER 7

RECTIFICATION AND CORRECTION OF THE REGISTER

56. Power to cancel or vary registration and to rectify the register :-

(1) On application made in the prescribed manner to a High Court or to the Registrar by any person aggrieved, the Tribunal may make such order as it may think fit for cancelling or varying the

registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

(2) Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to a High Court or to the Registrar, and the Tribunal may make such order for making, expunging or varying the entry as it may think fit.

(3) The Tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.

(4) The Tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2) .

(5) Any order of the High Court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

(6) The power to rectify the register conferred by this section shall include the power to remove a trade mark registered in Part A of the register to Part B of the register.

57. Correction of register :-

(1) The Registrar may, on application made in the prescribed manner by the registered proprietor,-

(a) correct any error in the name, address or description of the registered proprietor of a trade mark, or any other entry relating to the trade mark;

(b) enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;

(c) cancel the entry of a trade mark on the register;

(d) strike out any goods or classes of goods from those in respect of which a trade mark is registered;

(e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of the trade mark, and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

(2) The Registrar may, on application made in the prescribed manner by a registered user of a trade mark, and after notice to the registered proprietor, correct any error, or enter any change, in the name, address or description of the registered user.

58. Alteration of registered trade mark :-

(1) The registered proprietor of trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the prescribed manner in any case, where it appears to him that it is expedient so to do, and where he does so, if within the prescribed time from the date of the advertisement any person gives notice to the Registrar in the 'prescribed manner of opposition to the application, the Registrar shall, after hearing the parties if so required, decide the matter.

(3) Where leave is granted under this section, the trade mark as altered shall be advertised in the prescribed manner, unless the application has already been advertised under sub-section (2).

59. Adaptation of entries in register to amended or substituted classification of goods :-

(1) The Registrar shall not, in exercise of any power conferred on him by rules made with reference to clause (a) of sub-section (2) of section 133 , make any amendment of the register which would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made or of antedating the registration of a trade mark in respect of any goods: Provided that this sub-section shall not apply when the Registrar is satisfied that compliance therewith would involve undue complexity and that the addition or antedating, as the case may be, would not

affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(2) A proposal so to amend the register shall be notified to the registered proprietor of the trade mark affected and advertised in the prescribed manner, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes the provisions of sub-section (1).

CHAPTER 8

CERTIFICATION TRADE MARKS

60. Certain provisions of this Act not applicable to certification trade marks :-

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

(a) section 9 ;

(b) section 18 , Section 20 and Section 21 , except as expressly applied by this Chapter;

(c) section 28 , Section 29 , Section 30 , Section 39 , Section 40 , Section 41 , Section 45 , Section 46 , Section 47 , Section 48 , Section 49 , Section 51 , Section 52 , Section 53 and sub-section (2) of section 55 ;

(d) Chapter X, except section 81 ;

(e) any provision the operation of which is limited by the terms thereof to registration in Part B of the register.

61. Registration of certification trade marks :-

(1) A certification trade mark shall be registrable only in Part A of the register.

(2) 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.

(3) In determining whether a certification trade mark is adapted to distinguish in accordance with the provisions of clause (c) of sub-section (1) of section 2 , the Tribunal may have regard to the extent to which -

(a) the mark is inherently so adapted to distinguish in relation to the goods in question; and

(b) by reason of the use of the mark or of any other circumstances, the mark is in fact so adapted to distinguish in relation to the goods in question.

62. 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 writing 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 65 .

(2) Subject to the provisions of section 61 , the provisions of subsections (1), (2), (3), (4) and (6) of section 18 and of section 19 and Section 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 references therein to acceptance of an application shall be construed as references 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 an application under section 18 and to any other considerations (not being matters within the competence of the Central Government under section 63) 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.

63. Consideration of applications for registration by Central Government :-

(1) When authorisation to proceed with an application under section 62 has been given, the Registrar shall forward the application to the Central Government.

(2) The Central Government shall consider the application so forwarded 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 deposited under section 65 is satisfactory;

(i) direct that the application shall not be accepted; or

(ii) direct the Registrar to accept the application and approve the said draft of the regulations either without modification and unconditionally or subject to any conditions of limitations, or to any amendments or modification of the application or of the regulations, which it thinks requisite having regard to any of the said matters.

(3) Except in the case of a direction for acceptance and approval without modification and unconditionally the Central Government shall not decide any matter under sub-section (2) without giving to the applicant an opportunity of being heard.

(4) Notwithstanding anything contained in this section, the Central Government may, at the request of the applicant made through the Registrar, consider the application with regard to any of the matters referred to in sub-section (2) before authorisation to proceed with the application is given, but the Central Government shall be at liberty to reconsider any matter on which it has given a decision under this sub-section if any, amendment or modification is thereafter made in the application or in the draft of the regulations.

64. Opposition to registration of certification trade marks :-

(1) 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 .

(2) In deciding any matter relating to opposition proceedings under the provisions aforesaid the Tribunal shall have regard only to the considerations referred to in sub-section (3) of section 62 , and a decision under the said provisions in favour of the applicant shall be conditional on the determination in his favour by the Central Government under sub-section (3) of this section of any opposition relating to any of the matters referred to in section 63 .

(3) When notice of opposition is given relating to any of the matters referred to in section 63 , the Central Government shall, after hearing the parties, if so required by them, and considering any evidence and having regard to the matters aforesaid, direct the Registrar-

(a) to refuse registration; or

(b) to register the mark either absolutely or subject to such conditions or limitations, or amendments or modifications of the application or of the regulations to be deposited under section 65 , as the Central Government may think proper to impose or make; and the Registrar shall dispose of the matter in accordance with the directions issued by the Central Government under this sub-section.

65. Deposit of regulations governing the use of a certification trade mark :-

(1) There shall be deposited at the Trade Marks Registry in respect of every mark registered as a certification trade mark regulation approved by the Central Government for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the certification trade mark, and may contain any other provisions which the Central Government 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 deposited shall be open to inspection in like manner as the register.

(2) The regulations so deposited may on the application of the registered proprietor be altered by the Registrar with the consent of the Central Government.

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

66. Rights conferred by registration of certification trade marks :-

(1) Subject to the provisions of section 33 , Section 34 and Section 68 , the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the mark in relation to those goods.

(2) The exclusive right to the use of a certification trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

67. Infringement of certification trade marks :-

The right conferred by section 66 is infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorized by him in that behalf under the regulations deposited under section 65 , using it in accordance therewith, uses in the course of trade, a mark which is identical with, or deceptively similar to, the certification trade mark in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark, likely to be taken as being used as a trade mark.

68. Acts not constituting infringement of certification trade marks :-

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered certification trade mark :-

(a) where a certification trade mark is registered subject to any conditions or limitations entered on the register, the use of any such mark in any mode, in relation to goods to be sold or otherwise traded in any place, or in relation to goods to be exported to any market or in any other circumstances, to which having regard to any such limitations, the registration does not extend;

(b) the use of a certification trade mark in relation to goods certified by the proprietor of the mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the mark;

(c) the use of a certification trade mark in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor

(2) Clause (b) of sub-section (1) shall not apply to the case of use consisting of the application of a certification trade mark to goods, notwithstanding that they are such goods as are mentioned in that clause if such application is contrary to the regulations referred to in that clause.

(3) Where a certification trade mark is one of two or more trade marks: registered under this Act, which are identical or nearly resemble each other the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration, shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

69. Cancellation or varying of registration :-

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

(a) that the proprietor is no longer competent, in the case of any of the good in respect of which the mark is registered, to certify those goods;

(b) that the proprietor has failed to observe any provision of the deposited 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; and neither a High Court nor the Registrar shall have any jurisdiction to make an order under section 56 on any of those grounds.

70. Registrar to give effect to orders of Central Government :-

The Registrar shall rectify the register and the deposited regulations in such manner as may be requisite for giving effect to an order made by the Central Government under section 69 .

CHAPTER 9

SPECIAL PROVISIONS FOR TEXTILE GOODS

71. Textile goods :-

The Central Government may prescribe classes of goods (in this Chapter referred to as textile goods) to the trade marks used in relation to which the provisions of this Chapter shall apply; and subject to the said provisions, the other provisions of this Act shall apply to such trade marks as they apply to trade marks used in relation to other classes of goods.

72. Restriction on registration of textile goods :-

(1) In respect of textile goods being piece goods -

(a) no mark consisting of a line heading alone shall be registrable as a trade mark;

(b) a line heading shall not be deemed to be adapted to distinguish;

(c) the registration of a trade mark shall not give any exclusive right to the use of a line heading.

(2) In respect of any textile goods, the registration of letters or numerals, or any combination thereof, shall be subject to such conditions and restrictions as may be prescribed.

73. Refused Textile Marks List :-

(1) No addition shall, after the commencement of this Act, be made to the Refused Textile Marks List maintained under the Trade Marks Act, 1940 (5 of 1940).

(2) A mark already entered on the Refused Textile Marks List may, however, be continued to be so entered : Provided that an application therefor is made in the prescribed manner and with the prescribed fee within one year after the commencement of this Act, in which case it will be retained in the List for a period of seven years from the date of the application.

74. Stamping of piece goods, cotton yarn and thread :-

(1) Piece goods, such as are ordinarily sold by length or by the piece, which have been manufactured, bleached, dyed, printed or finished in premises which are a factory, as defined in Factories Act, 1948 , shall not be removed for sale from the last of such premises in which they underwent any of the said processes without having conspicuously stamped in international form of Indian numerals on each piece the length thereof in standard yards, or in standard

yards and a fraction of such a yard, or in standard metres or in standard metres and a fraction of such a metre, according to the real length of the piece, and, except when the goods are sold from the factory for export from India, without being conspicuously marked on each piece with the name of the manufacturer or of the occupier of the premises in which the piece was finally processed or of the wholesale purchaser in India of the piece.

(2) Cotton yarn such as is ordinarily sold in bundles, and cotton thread, namely, sewing, darning, crochet or handicraft thread, which have been manufactured, bleached, dyed, or finished in any premises not exempted by the rules made under section 75 shall not be removed for sale from those premises unless, in accordance with the said rules in the case of yarn-

(a) the bundles are conspicuously marked with an indication of the weight of yarn in the English or the metric system in each bundle; and

(b) the count of the yarn contained in the bundle and in the case of thread each unit is conspicuously marked with the length or weight of thread in the unit and in such other manner as may be required by the said rules; and

(c) except where the goods are sold from the premises for export from India, unless each bundle or unit is conspicuously marked with the name of the manufacturer or of the wholesale purchaser in India of the goods : Provided that the rules made under section 75 shall exempt all premises where the work is done by members of one family with or without the assistance of not more than ten other employees, and all premises controlled by a cooperative society where not more than twenty workers are employed in the premises.

75. Determination of character of textile goods by sampling

:-

(1) For the purposes of this Act, the Central Government may make rules,-

(a) to provide, with respect to any goods which purport or are alleged to be of uniform number, quantity, measure, gauge or weight for the number of samples to be selected and tested and for the selection of the samples;

(b) to provide for the manner in which for the purposes of section 74 cotton yarn and cotton thread shall be marked with the particulars required by that section, and for the exemption of certain premises used for the manufacture, bleaching, dyeing or finishing of cotton yarn or cotton thread from the provisions of that section; and

(c) declaring what classes of goods are included in the expression "piece goods such as are ordinarily sold by length or by the piece" for the purpose of section 74 of this Act or S.18 of the Sea Customs Act, 1978.

(2) With respect to any goods for the selection and testing of samples of which provision is not made in any rules for the time being in force under sub-section (1), the court or officer of customs, as the case may be, having occasion to ascertain the number, quantity, measure, gauge or weight of the goods, shall, by order in writing, determine the number of samples to be selected and tested and the manner in which the samples are to be selected.

(3) The average of the results of the testing in pursuance of rules under sub-section (1) or of an order under sub-section (2) shall be prima facie evidence of the number, quantity, measure, gauge or weight, as the case may be, of the goods.

(4) If a person having any claim to, or in relation to, any goods of which samples have been selected and tested in pursuance of rules under sub-section (1) or of an order under sub-section (2), desires that any further samples of the goods be selected and tested, such further samples shall, on his written application and on the payment in advance by him to the court or officer of customs, as the case may be, of such sums for defraying the cost of the further selection and testing as the court or officer may from time to time require, be selected and tested to such extent as may be permitted by rules made by the Central Government in this behalf or as, in the case of goods with respect to which provision is not made in such rules, the court or officer of customs may determine in the circumstances to be reasonable, the samples being selected in the manner prescribed under sub-section (1), or in sub-section (2), as the case may be.

(5) The average of the results of the testing referred to in sub-section (3) and of the further testing under sub-section (4) shall be

conclusive proof of the number, quantity, measure, gauge or weight, as the case may be, of the goods.

CHAPTER 10

OFFENCES, PENALTIES AND PROCEDURES

76. Meaning of applying trade marks and trade descriptions

:-

(1) A person shall be deemed to apply a trade mark or mark or trade description to goods who-

(a) applies it to the goods themselves; or

(b) applies it to any package in or with which the goods are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture; or

(c) places, encloses, or annexes any goods which are sold, or exposed for sale, or had in possession for sale or for any purpose of trade or manufacture, in or with any package or other thing to which a trade mark or mark or trade description has been applied; or

(d) uses a trade mark or mark or trade description in any manner reasonably likely to lead to the belief that the goods in connection with which it is used are designated or described by that trade mark or mark or trade description; or

(e) in relation to the goods uses a trade mark or trade description in any sign, advertisement, invoice, catalogue, business letter, business paper, price list, or other commercial document, and goods are delivered to a person in pursuance of a request or order made by reference to the trade mark or trade description as so used.

(2) A trade mark or mark or trade description shall be deemed to be applied to goods whether it is woven in, impressed on, or otherwise worked into, or annexed or affixed to, the goods or to any package or other thing.

77. Falsifying and falsely applying trade marks :-

(1) A person shall be deemed to falsify a trade mark who, either,-

(a) without the assent of the proprietor of the trade mark makes that trade mark or a deceptively similar mark; or

(b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.

(2) A person shall be deemed to falsely apply to goods a trade mark who, without the assent of the proprietor of the trade mark,-

(a) applies such trade mark or a deceptively similar mark, to goods or any package containing goods;

(b) uses any package bearing a mark which is identical with or deceptively similar to the trade mark of such proprietor, for the purpose of packing, filling, or wrapping therein any goods other than the genuine goods of the proprietor of the trade mark.

(3) Any trade mark falsified as mentioned in sub-section (1) or falsely applied as mentioned in sub-section (2), is in this Act referred to as a false trade mark.

(4) In any prosecution for falsifying a trade mark or falsely applying a trade mark to goods, the burden of proving the assent of the proprietor shall lie on the accused.

78. Penalty for applying false trade marks, trade descriptions, etc :-

Any person who,-

(a) falsifies any trade mark; or

(b) falsely applies to goods any trade mark; or

(c) makes, disposes of, or has in his possession, any die, block, machine, plate or other instrument for the purpose of falsifying, or of being used for falsifying, a trade mark; or

(d) applies any false trade description to goods; or

(e) applies to any goods to which an indication of the country or place in which they were made or produced or the name and address of the manufacturer or person for whom the goods are manufactured is required to be applied under section 117, a false indication of such country, place, name or address; or

(f) tampers with, alters or effaces an indication of origin which has been applied to any goods to which it is required to be applied under section 117; or

(g) causes any of the things above mentioned in this section to be done, shall, unless he proves that he acted without intent to

defraud, be punishable with imprisonment for a term which may extend to two years, or with fine, or with both: Provided that where the offence under this section is in relation to goods or any package containing goods which are drugs within the meaning of clause (b) of section 3 of the DRUGS AND COSMETICS ACT, 1940 or "food" as defined in clause (v) of Section 2 of the Prevention of Food Adulteration Act, 1954 , the offender shall be punishable with imprisonment for a term which may extend to three years, or with .fine, or with both.

79. Penalty for selling goods to which a false trade mark or false trade description is applied :-

Any person who sells, or exposes for sale, or has in his possession for sale or for any purpose of trade or manufacture, any goods or things to which any false trade mark or false trade description is applied or which, being required under section 117 to have applied to them an indication of the country or place in which they were made or produced or the name and address of the manufacturer or the person for whom the goods are manufactured, are without the indication so required, shall, unless he proves,-

(a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark or trade description or that any offence had been committed in respect of the goods; and

(b) that, on demand by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things; or

(c) that otherwise he had acted innocently, be punishable with imprisonment for a term which may extend to two years, or with fine, or with both : Provided that when the offence against this section is in relation to goods or any package containing goods which are drugs as defined in clause (b) of Section 3 of the Drugs and Cosmetics Act, 1940 or "food" as defined in clause (v) of Section 2 of the Prevention of Food Adulteration Act, 1954 , the offender shall be punishable with imprisonment for a term which may extend to three years, or with fine, or with both.

80. Penalty for removing piece goods, etc., contrary to section 74 :-

If any person removes or attempts to remove or causes or attempts

to cause to be removed for sale from any premises referred to in section 74 , or sells or exposes for sale or has in his possession for sale or for any purpose of trade or manufacture piece goods or cotton yarn or cotton thread which is not marked as required by that section, every such piece and every such bundle of yarn and all such thread and everything used for the packing thereof shall be forfeited to Government and such person shall be punishable with fine which may extend to one thousand rupees,

81. 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 in respect of which it is not in fact registered; or

(d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations 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 six months, or with fine which may extend to five hundred rupees, 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 referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except

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(a) where that word or other expression is used in direct association with other words delineated in characters at least as large as those in which that word or other expression is delineated and indicating that the reference is to registration as 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 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.

82. Penalty for improperly describing a place of business as connected with the Trade Marks Office :-

If any person uses on his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trade Marks Office, he shall be punishable with imprisonment for a term which may extend to six months, or with fine, or with both.

83. Penalty for falsification of entries in the register :-

If any person makes, or causes to be made, a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

84. No offence in certain cases :-

The provisions of section 77 , Section 78 and Section 79 shall, in relation to a registered trade mark or proprietor of such mark, be subject to the rights created or recognised by this Act, and no act or omission shall be deemed to be an offence-under section 77 or section 78 or section 79 if,-

(a) the alleged offence relates to a registered trade mark and the act or omission is permitted under this Act; and

(b) the alleged offence relates to a registered or an unregistered trade mark and the act or omission is permitted under any other law for the time being in force.

85. Forfeiture of goods :-

(1) Where a person is convicted of an offence under section 78 or section 79 , or is acquitted of an offence under section 78 on proof that he acted without intent to defraud, or under section 79 on

proof of the matters specified in clauses (a), (b) and (c) of that section, the court convicting or acquitting him may direct the forfeiture to Government of all goods and things by means of, or in relation to, which the offence has been committed, or but for such proof as aforesaid would have been committed.

(2) When a forfeiture is directed on a conviction and an appeal lies against the conviction, an appeal shall lie against the forfeiture also.

(3) When a forfeiture is directed on an acquittal and the goods or things to which the direction relates are of value exceeding fifty rupees, an appeal against the forfeiture may be preferred, within thirty days from the date of the direction, to the court to which in appealable cases appeals lie from sentences of the court which directed the forfeiture.

(4) When a forfeiture is directed on a conviction the court, before whom the person is convicted, may order any forfeited articles to be destroyed or otherwise disposed of as the court thinks fit.

86. Exemption of certain persons employed in ordinary course of business :-

Where a person accused of an offence under section 78 proves-

(a) that in the ordinary course of his business he is employed on behalf of other persons to apply trade marks or trade descriptions, or, as the case may be, to make dies, blocks, machines, plates, or other instruments for making, or being used in making trade marks; and

(b) that in the case which is the subject of the charge he was so employed, and was not interested in the goods or other thing by way of profit or commission dependent on the sale of such goods; and

(c) that, having taken all reasonable precautions against committing the offence charged, he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the trade mark or trade description; and

(d) that, on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons on whose behalf the trade mark or trade description was applied; he shall be acquitted.

87. Procedure where invalidity of registration is pleaded by the accused :-

(1) Where the offence charged under section 78 or section 79 is in relation to a registered trade mark and the accused pleads that the registration of the trade mark is invalid, the following procedure shall be followed :-

(a) If the magistrate is satisfied that such defence is prima fade tenable, he shall not proceed with the charge but shall adjourn the proceeding for three months from the date on which the plea of the accused is recorded to enable the accused to file an application before the High Court under this Act, for the rectification of the register on the ground that the registration is invalid.

(b) If the accused proves to the magistrate that he has made such application within the time so limited or within such further time as the magistrate may for sufficient cause allow, the further proceedings in the prosecution shall stand stayed till the disposal of such application for rectification and of the appeal, if any, therefrom.

(c) If within a period of three months or within such extended time as may be allowed by the magistrate the accused fails to apply to the High Court for rectification of the register, the magistrate shall proceed with the case as if the registration were valid.

(2) Where before the institution of a complaint of an offence referred to in sub-section (1), any application for the rectification of the register concerning the trade mark in question on the ground of invalidity of the registration thereof has already been properly made to and is pending before the tribunal, the magistrate shall stay the further proceedings in the prosecution pending the disposal of the application aforesaid and shall determine the charge against the accused in conformity with the result of the application for rectification in so far as the complainant relies upon the registration of his mark.

88. Offences by companies :-

(1) If the person committing an offence under this Act is a company, the company as well as every person in charge of, and responsible to, the company for the conduct of its business at the time of the commission of the offence shall be deemed to be guilty of the offence and shall be liable to be proceeded against and

punished accordingly : Provided that nothing contained in this sub-section shall render any such person liable to any punishment if he proves that the offence was committed without his knowledge or that he exercised all due diligence to prevent the commission of such offence.

(2) Notwithstanding anything contained in sub-section (1), where an offence under this Act has been committed by a company and it is proved that the offence has been committed with the consent or connivance of, or that the commission of the offence is attributable to any neglect on the part of, any director, manager, secretary or other officer of the company, such director, manager, secretary or other officer shall also be deemed to be guilty of that offence and shall be liable to be proceeded against and punished accordingly.

89. Cognizance of certain offences :-

(1) No court shall take cognizance of an offence under section 81, section 82 or section 83 except on complaint in writing made by the Registrar or any officer authorised by him in writing.

(2) No court inferior to that of a sessions judge, presidency magistrate or magistrate of the first class shall try an offence under this Act.

90. Evidence of origin of goods imported by sea :-

In the case of goods brought into India by sea, evidence of the port of shipment shall, in a prosecution for an offence under this Act or under clause (d), clause (dd), clause (e), clause (f), clause (h) clause (i) or clause (j) of S.18 of the Sea Customs Act, 1878, be prima facie evidence of the place or country in which the goods were made or produced.

91. Costs of defence or prosecution :-

In any prosecution under this Act, the court may order such costs to be paid by the accused to the complainant, or by the complainant to the accused, as the court deemed reasonable having regard to all the circumstances of the case and the conduct of the parties. Costs so awarded shall be recoverable as if they were a fine.

92. Limitation of prosecution :-

No prosecution for an offence under this Act or under clause (d) clause (dd), clause (e), clause (f), clause (h), clause (i) or clause (j) of S.18 of the Sea Customs Act, 1878, shall be commenced after

the expiration of three years next after the commission of the offence charged, or two years after the discovery thereof by the prosecutor, whichever expiration first happens.

93. Information as to commission of offence :-

An officer of the Government whose duty it is to take part in the enforcement of the provisions of this Chapter, shall not be compelled in any court to say whence he got any information as to the commission of any offence against this Act.

94. Punishment of abetment in India of acts done out of India :-

If any person, being within India, abets the commission, without India, of any act which, if committed in India, would, under this Act, be an offence, he may be tried for such abetment in any place in India in which he may be found, and be punished therefor with the punishment to which he would be liable if he had himself committed in that place the act which he abetted.

95. Instructions by Central Government as to permissible variations to be observed by criminal courts :-

The Central Government may, by notification in the Official Gazette, issue instructions for the limits of variation, as regards number, quantity, measure, gauge or weight, which are to be recognised by criminal courts as permissible in the case of any goods.

CHAPTER 11
MISCELLANEOUS

96. Implied warranty on sale of marked goods :-

On the sale or in the contract for the sale of any goods to which a trade mark or mark or trade description has been applied, the seller shall be deemed to warrant that the mark is a genuine mark and not falsely applied, or that the trade description is not a false trade description within the meaning of this Act, unless the contrary is expressed in some writing signed by or on behalf of the seller and delivered at the time of the sale or contract to and accepted by the buyer.

97. Powers of Registrar :-

In all proceedings under this Act before the Registrar-

(a) the Registrar shall have all the powers of a civil court for the purposes of receiving evidence, administering oaths, enforcing the

attendance of witnesses, compelling the discovery and production of documents and issuing commissions for the examination of witnesses;

(b) the Registrar may, subject to any rules made in this behalf under section 133 , make such orders as to costs as he considers reasonable, and any such order shall be executable as a decree of a civil court : Provided that the Registrar shall have no power to award costs to or against any party on an appeal to him against a refusal of the proprietor of a certification trade mark to certify goods or to authorise the use of the mark;

(c) the Registrar may, on an application made in the prescribed manner, review his own decision.

98. Exercise of discretionary power by Registrar :-

Subject to the provisions of section 101 , the Registrar shall not exercise any discretionary or other power vested in him by this Act or the rules made thereunder adversely to a person applying for the exercise of that power without (if so required by that person within the prescribed time) giving to that person an opportunity of being heard.

99. Evidence before the Registrar :-

In any proceeding under this Act before the Registrar, evidence shall be given by affidavit: Provided that the Registrar may, if he thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit.

100. Death of party to a proceeding :-

If a person who is a party to a proceeding under this Act (not being a proceeding in a court) dies pending the proceeding, the Registrar may, on request, and on proof to his satisfaction of the transmission of the interest of the deceased person, substitute in the proceeding his successor in interest in his place, or, if the Registrar is of opinion that the interest of the deceased person is sufficiently represented by the surviving parties, permit the proceeding to continue without the substitution of his successor in interest.

101. 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 the 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 notify 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.

102. Abandonment :-

Where, in the opinion of the Registrar, an applicant is in default in the prosecution of an application filed under this Act or any Act relating to trade marks in force prior to the commencement of this Act, the Registrar may by notice require the applicant to remedy the default within a time specified and after giving him, if so desired, an opportunity of being heard, treat the application as abandoned, unless the default is remedied within the time specified in the notice.

103. Preliminary advice by the Registrar as to distinctiveness :-

(1) The Registrar may, on application made to him in the prescribed manner by any person who proposes to apply for the registration of a trade mark in Part A or Part B of the register, give advice as to whether the trade mark appears to him prima facie to be inherently adapted to distinguish, or capable of distinguishing, as the case may be.

(2) If, on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative made within three months after the advice was given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish, or is not capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

104. Procedure before Central Government :-

In all proceedings under this Act before the Central Government, evidence shall be given by affidavit : Provided that the Central Government may, if it thinks fit, take oral evidence in lieu of, or in addition to, such evidence by affidavit, and shall for that purpose

have all the powers of a civil court referred to in clause (a) of section 97 .

105. Suit for infringement, etc., to be instituted before District Court :-

No suit-

(a) for the infringement of a registered trade mark; or

(b) relating to any right in a registered trade mark; or

(c) for passing off arising out of the use by the defendant of any trade mark which is identical with or deceptively similar to the plaintiff's trade mark, whether registered or unregistered; shall be instituted in any court inferior to a District Court having jurisdiction to try the suit.

106. Reliefs in suits for infringement or for passing off :-

(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 105 includes an injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.

(2) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or an account of profits in any case-

(a) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark; or

(b) where in a suit for infringement the defendant satisfies the court-

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and

(ii) that when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods in respect of which it was registered; or

(c) where in a suit for passing off the defendant satisfies the court-

(i) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and

(ii) that when he became aware of the existence and nature of the plaintiff's trade mark, he forthwith ceased to use the trade mark complained of.

107. Application for rectification of register to be made to High Court in certain cases :-

(1) Where in a suit for infringement of a registered trade mark the "validity of the registration of the plaintiff's trade mark is questioned by the defendant or where in any such suit the defendant raises a defence under clause (d) of sub-section (1) of section 30 and the plaintiff questions the validity of the registration of the defendant's trade mark, the issue as to the validity of the registration of the trade mark concerned shall be determined only on an application for the rectification of the register, and notwithstanding anything contained in section 46 , sub-section (4) of section 47 or section 56 , such application shall be made to the High Court and not to the Registrar.

(2) Subject to the provisions of sub-section (1), where an application for rectification of the register made to the Registrar under section 46 or sub- section (4) of section 47 or section 56 , the Registrar may, if he thinks fit, refer the application at any stage of the proceeding to the High Court.

108. Procedure for application for rectification before a High Court :-

(1) An application for rectification of the register made to a High Court under section 46 , sub-section (4) of section 47 or section 56 shall be in- such form and shall contain such particulars as may be prescribed.

(2) Every such application shall be heard by a single Judge of the High Court : Provided that any such Judge may, if he thinks fit, refer the application at any stage of the proceedings for decision to a Bench of that High Court.

(3) Where any such application is heard by a single Judge of the

High Court, an appeal shall lie from the order made by him on application to a Bench of the High Court.

(4) Subject to the provisions of this Act and the rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (5 of 1908), shall apply to applications to a High Court under this section.

(5) A certified copy of every order or judgment of the High Court or of the Supreme Court, as the case may be, relating to a registered trade mark under this section shall be communicated to the Registrar by that Court and the Registrar shall give effect to the order of the Court and shall, when so directed, amend the entries in, or rectify, the register in accordance with such order.

109. Appeals :-

(1) No appeal shall lie from any decision, order or direction made or issued under this Act by the Central Government or from any act or order of the Registrar for the purpose of giving effect to any such decision, order or direction.

(2) Save as otherwise expressly provided in sub-section (1) or in any other provision of this Act, an appeal shall lie to the High Court within the prescribed period from any order or decision of the Registrar under this Act or the rules made thereunder.

(3) Every such appeal shall be preferred by petition in writing and shall be in such form and shall contain such particulars as may be prescribed.

(4) Every such appeal shall be heard by a single Judge of the High Court: Provided that any such Judge may, if he so thinks fit, refer the appeal at any stage of the proceeding to a Bench of the High Court.

(5) Where an appeal is heard by a single Judge, a further appeal shall lie to a Bench of the High Court.

(6) The High Court in disposing of an appeal under this section shall have the power to make any order which the Registrar could make under this Act.

(7) In an appeal by an applicant for registration against a decision of the Registrar under section 17 or section 18 or section 21, it shall not be open, save with the express permission of the court, to

the Registrar or any party opposing the appeal to advance grounds other than those recorded in the said decision or advanced by the party in the proceedings before the Registrar, as the case may be, and where any such additional grounds are advanced, the applicant for registration may, on giving notice in the prescribed manner, withdraw his application without being liable to pay the costs of the Registrar or the parties opposing his application.

(8) Subject to the provisions of this Act and of the rules made thereunder, the provisions of the Code of Civil Procedure, 1908 (5 of 1908), shall apply to appeals before a High Court under this Act.

110. Power of High Courts to make rules :-

The High Court may make rules consistent with this Act as to the conduct and procedure of all proceedings under this Act before it.

111. Stay of proceedings where the validity of registration of the trade mark is questioned, etc :-

(1) Where in any suit for the infringement of a trade mark -

(a) the defendant pleads that the registration of the plaintiff's trade mark is invalid; or

(b) the defendant raises a defence under clause (d) of sub-section (1) of section 30 and the plaintiff pleads the invalidity of the registration of the defendant's trade mark, the court trying the suit (hereinafter referred to as the court), shall, -

(i) if any proceedings for rectification of the register in relation to the plaintiff's or defendant's trade mark are pending before the Registrar or the High Court, stay the suit pending the final disposal of such proceedings;

(ii) if no such proceedings are pending and the court is satisfied that the plea regarding the invalidity of the registration of the plaintiff's or defendant's trade mark is prima facie tenable, raise an issue regarding the same and adjourn the case for a period of three months from the date of the framing of the issue in order to enable the party concerned to apply to the High Court for rectification of the register.

(2) If the party concerned proves to the court that he has made any such application as is referred to in clause (b) (ii) of sub-section (1) within the time specified therein or within such extended time as the court may for sufficient cause allow, the trial

of the suit shall stand stayed until the final disposal of the rectification proceedings.

(3) If no such application as aforesaid has been made within the time so specified or within such extended time as the court may allow, the issue as to the validity of the registration of the trademark concerned shall be deemed to have been abandoned and the court shall proceed with the suit in regard to the other issues in the case.

(4) The final order made in any rectification proceedings referred to in sub-section (1) or sub-section (2) shall be binding upon the parties and the court shall dispose of the suit conformably to such order insofar as it relates to the issue as to the validity of the registration of the trade mark.

(5) The stay of a suit for the infringement of a trade mark under this section shall not preclude the court making any interlocutory order (including any order granting an injunction, directing accounts to be kept, appointing a receiver or attaching any property), during the period of the stay of the suit.

112. Appearance of Registrar in legal proceedings :-

(1) The Registrar shall have the right to appear and be heard-

(a) in any legal proceedings before a High Court in which the relief sought includes alteration or rectification of the register or in which any question relating to the practice of the Trade Marks Registry is raised;

(b) in any appeal to the High Court from an order of the Registrar on an application for registration of a trade mark -

(i) which is not opposed, and the application is either refused by the Registrar or is accepted by him subject to any amendments, modifications, conditions or limitations, or

(ii) which has been opposed and the Registrar considers that his appearance is necessary in the public interest, and the Registrar shall appear in any case if so directed by the court.

(2) Unless the High Court otherwise directs, the Registrar may, in lieu of appearing, submit a statement in writing signed by him, giving such particulars as he thinks proper of the proceedings before him relating to the matter in issue, or of the grounds of any

decision given by him affecting it, or of the practice of the Trade Marks Registry in like cases, or of other matters relevant to the issues and within his knowledge as Registrar, and such statement shall be evidence in the proceeding.

113. Costs of Registrar in proceedings before High Court :-

In all proceedings under this Act before a High Court the costs of the Registrar shall be in the discretion of the High Court, but the Registrar shall not be ordered to pay the costs of any of the parties.

114. Registered user to be impleaded in certain proceedings :-

(1) In every proceeding under Chapter VII or under section 109, every registered user of a trade mark using by way of permitted use, who is not himself an applicant in respect of any proceeding under that Chapter or section, shall be made a party to the proceeding.

(2) Notwithstanding anything contained in any other law, a registered user so made a party to the proceeding shall not be liable for any costs unless he enters an appearance and takes part in the proceeding.

115. Evidence of entries in register, etc., and things done by the Registrar :-

(1) A copy of any entry in the register or of any document referred to in sub-section (1) of section 125, purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Registry, shall be admitted in evidence in all courts and in all proceedings without further proof or production of the original.

(2) A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing that he is authorised by this Act or the rules to make or do shall be prima facie evidence of the entry having been made, and of the contents thereof, or of the matter or thing having been done or not done.

116. Registrar and other officers not compellable to produce register, etc :-

The Registrar or any other officer of the Trade Marks Registry shall not, in any legal proceedings to which he is not a party, be compellable to produce the register or any other document in his custody, the contents of which can be proved by the production of

a certified copy issued under this Act or to appear as a witness to prove the matters therein recorded unless by order of the court made for special cause.

117. Power to require goods to show Indication of origin :-

(1) The Central Government may, by notification in the Official Gazette, require that goods of any class specified in the notification which are made or produced beyond the limits of India and imported into India, or which are made or produced within the limits of India, shall from such date as may be appointed by the notification not being less than three months from its issue, have applied to them indication of the country or place in which they were made or produced, or of the name and address of the manufacturer or the person for whom the goods were manufactured.

(2) The notification may specify the manner in which such indication shall be applied, that is to say, whether to the goods themselves or in any other manner, and the times or occasions on which the presence of the indication shall be necessary, that is to say, whether on importation only, or also at the time of sale, whether by wholesale or retail or both.

(3) No notification under this section shall be issued, unless application is made for its issue by persons or associations substantially representing the interests of dealers in, or manufacturers, producers, or users of, the goods concerned, or unless the Central Government is otherwise convinced that it is necessary in the public interest to issue the notification, with or without such inquiry as the Central Government may consider necessary.

(4) The provisions of Section 23 of the General Clauses Act, 1897, shall apply to the issue of a notification under this section as they apply to the making of a rule or bye-law the making of which is subject to the condition of previous publication.

(5) A notification under this section shall not apply to goods made or produced beyond the limits of India and imported into India, if in respect of those goods, the '[Commissioner of Customs] is satisfied at the time of importation that they are intended for exportation whether after transshipment in or transit through India or otherwise.

118. Power to require information in respect of imported

goods bearing false trade marks :-

(1) Where goods, which are prohibited to be imported into India under clause (d), clause (dd), clause (e), clause (/), clause (h), clause (;) or clause (/) of S.18 of the Sea Customs Act, 1878 and are liable to detention and confiscation on importation under that Act, are imported into India, the ¹[Commissioner of Customs] if, upon representation made to him, he has reason to believe that the trade mark complained of is used as a false trade mark, may require the importer of the goods, or his agent, to produce any documents in his possession relating to the goods and to furnish information as to the name and address of the person by whom the goods were consigned to India and the name and address of the person to whom the goods were sent in India.

(2) The importer or his agent shall, within fourteen days, comply with the requirement as aforesaid, and if he fails to do so he shall be punishable with fine which may extend to five hundred rupees.

(3) Any information obtained from the importer of the goods or his agent under this section may be communicated by the ¹[Commissioner of Customs] to the registered proprietor or registered user of the trade mark which is alleged to have been used as a false trade mark.

1. Substituted by the Delegated Legislation Provisions (Amendment) Act, 1986.

119. Certificate of validity :-

If in any legal proceeding for rectification of the register before a High Court a decision is on contest given in favour of the registered proprietor of the trade mark on the issue as to the validity of the registration of the trade mark, the High Court may grant a certificate to that effect, and if such a certificate is granted, then in any subsequent legal proceeding in which the said validity comes into question the said proprietor on obtaining a final order or judgment in his favour affirming the validity of the registration of the trade mark shall, unless the said final order or judgment for sufficient reason directs otherwise, be entitled to his full costs, charges and expenses as between legal practitioner and client.

120. Groundless threats of legal proceedings :-

(1) Where a person, by means of circulars, advertisements or otherwise, threatens a person with an action or proceeding for

infringement of a trade mark which is registered, or alleged by the first-mentioned person to be registered, or with some other like proceeding, a person aggrieved may, whether the person making the threats is or is not registered proprietor or the registered user of the trade mark, bring a suit against the first-mentioned person and may obtain a declaration as to the effect that the threats are unjustifiable, and an injunction against the continuance of the threats, and may recover such damages (if any) as he has sustained, unless the first-mentioned person satisfies the court that the trade mark is registered and that the acts in respect of which the proceedings were threatened constitute, or, if done, would constitute, an infringement of the trade mark.

(2) The last preceding sub-section does not apply if the registered proprietor of the trade mark, or a registered user acting in pursuance of sub-section (1) of section 51, with due diligence commences and prosecutes an action against the person threatened for infringement of the trade mark.

(3) Nothing in this section shall render a legal practitioner or a registered trade marks agent liable to an action under this section in respect of an act done by him in his professional capacity on behalf of a client.

(4) A suit under sub-section (1) shall not be instituted in any court inferior to a District Court.

121. Address for service :-

An address for service stated in an application or notice of opposition shall, for the purposes of the application or notice of opposition, be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relation to the application or notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or opponent, as the case may be.

122. Trade usage, etc., to be taken into consideration :-

In any suit or other proceeding relating to a trademark, the tribunal shall admit evidence of the usage of the trade concerned and of any relevant trade mark or trade name or get up legitimately used by other persons.

123. Agents :-

Where, by or under this Act, any act, other than the making of an affidavit, is required to be done before the Registrar by any person,

the act may, subject to the rules made in this behalf, be done, instead of by that person himself, by a person duly authorised in the prescribed manner, who is-

- (a) a legal practitioner, or
- (b) a person registered in the prescribed manner as a trade marks agent, or
- (c) a person in the sole and regular employment of the principal.

124. Indexes :-

There shall be kept under the direction and supervision of the Registrar,-

- (a) an index of registered trade marks,
- (b) an index of trade marks in respect of which applications for registration are pending,
- (c) an index of the names of the proprietors of registered trade marks, and
- (d) an index of the names of registered users.

125. Documents open to public inspection :-

(1) Save as otherwise provided in sub-section (5) of section 49 , -

- (a) the register, and any document upon which any entry in the register is based;
- (b) every notice of opposition to the registration of a trade mark, application for rectification before the Registrar, counter-statement thereto, and any affidavit or document filed by the parties in any proceedings before the Registrar;
- (c) all regulations deposited under section 65 , and all applications under section 69 for varying such regulations;
- (d) the indexes mentioned in section 124 ; and
- (e) such other documents as the Central Government may, by notification in the Official Gazette, specify, shall, subject to such conditions as may be prescribed, be open to public inspection at the Trade Marks Registry.

(2) Any person may, on application to the Registrar and on payment of such fees as may be prescribed, obtain a certified copy

of any entry in the register or any document referred to in sub-section (1).

126. Reports of Registrar to be placed before Parliament :-

The Central Government shall cause to be placed before both Houses of Parliament once a year a report respecting the execution by or under the Registrar of this Act.

127. Fees :-

(1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by the Central Government.

(2) Where a fee is payable in respect of the doing of an act by the Registrar, the Registrar shall not do that act until the fee has been paid.

(3) Where a fee is payable in respect of the filing of a document at the Trade Marks Registry, the document shall be deemed not to have been filed at the Registry until the fee has been paid.

128. Savings in respect of certain matters in Chapter X :-

Nothing in Chapter X shall-

(a) exempt any person from any suit or other proceeding which might, but for anything in that Chapter, be brought against him,

(b) entitle any person to refuse to make a complete discovery, or to answer any question or interrogatory in any suit or other proceeding, but such discovery or answer shall not be admissible in evidence against such person in any such prosecution for an offence under Chapter X or against clause (d), clause (dd), clause (e), clause (f), clause (h), clause (i) or clause (j) of S.18 of the Sea Customs Act, 1878, or

(c) be construed so as to render liable to any prosecution or punishment any servant of a master resident in India who in good faith acts in obedience to the instructions of such master, and, on demand made by or on behalf of the prosecutor, has given full information as to his master and as to the instructions which he has received from his master.

129. Declaration as to ownership of trade mark not registrable under the Indian Registration Act, 1908 :-

Notwithstanding anything contained in the Registration Act, 1908 ,

no document declaring or purporting to declare the ownership or title of a person to a trade mark other than a registered trade mark shall be registered under that Act.

130. Government to be bound :-

The provisions of this Act shall be binding on the Government.

131. convention countries :-

(1) With a view to the fulfilment of a treaty, convention or arrangement, with any country 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 to be a convention country 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 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, 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 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 trade mark in two or more convention countries, 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.

132. Provisions as to reciprocity :-

Where any country specified by the Central Government in this behalf by notification in the Official Gazette does not accord to citizens of India the same rights in respect of the registration and protection of trade marks as it accords to its own nationals, no national of such country shall be entitled, either solely or jointly with any other person-

(a) to apply for the registration of, or be registered as the proprietor of, a trade mark in Part A or Part B of the register,

(b) to be registered as the assignee of the proprietor of a registered trade mark, or

(c) to apply for registration or be registered as a registered user of a trade mark under section 49 .

133. Power of Central Government to make rules :-

(1) The Central Government may, by notification in the Official Gazette and subject to the condition of previous publication, make rules to carry out the purposes of this Act.

(2) In particular, and without prejudice to the generality of the foregoing power, such rules may provide for all or any of the following matters, namely:-

(a) the classification of goods for the purposes of the registration of trade marks, and the empowering of the Registrar to amend the register so far as may be necessary for the purpose of adapting the entries therein to any amended or substituted classification;

(b) the making of duplicates of trade marks and other documents connected therewith;

(c) the securing and regulating the publication, sale or distribution of copies of trade marks and other documents connected therewith;

(d) the additional matters to be entered in the register;

(e) the conditions and restrictions subject to which the register, the Refused Textile Marks List and other documents may be inspected;

(f) the form of certificates of registration;

(g) the further documents, information or evidence which should accompany an application under sub-section (1) of section 49 ;

(h) the prescribing of classes of goods as textile goods for the purposes of section 71 ;

(i) the awarding of cost by the Registrar under section 97 ;

(j) the conditions subject to which a person may be registered as a trade marks agent, and the conditions subject to which an agent referred to in section 123 may act;

(k) the fees to be paid under this Act;

(l) the establishment of Offices of the Trade Marks Registry for facilitating the working of this Act, the territorial jurisdiction of each office of the Trade Marks Registry and the preparation of the copies of the register to be kept at such offices;

(m) the transfer of applications and proceedings pending at the commencement of this Act in any office of the Registry to the appropriate office of the Registry;

(n) the manner in which, in proceedings under this Act before the Central Government or the Registrar, applications shall be made, notices given and matters advertised;

(o) the times or periods required by this Act to be prescribed;

(p) the regulation generally of the business of the Trade Marks Registry and of the offices established under clause (l) and the regulation of all things by this Act placed under the direction or control of the Central Government or the Registrar;

(q) the number of samples to be selected and tested and for the selection of the samples for the purposes of section 75 ;

(r) the manner in which cotton yarn and cotton thread shall be marked with the particulars required by section 74 , and the exemption of certain premises from the provisions of that section;

(s) the classes of goods included in the expression "piece goods, such as are ordinarily sold by length or by the piece" for the purposes of S.74 of the Sea Customs Act, 1878;

(t) any other matter which is required to be or may be prescribed.

134. Laying of rules before Parliament :-

Every rule made under this Act shall be laid, as soon as may be after it is made, before each House of Parliament; while it is in session, for a total period of thirty days which may be comprised in one session or in two or more successive sessions, and if, before the expiry of the session immediately following the session or the successive sessions aforesaid, both Houses agree in making any modification in the rule or both Houses agree that the rule should not be made, the rule shall thereafter have effect only in such modified form or be of no effect, as the case may be; so, however, that any such modification or annulment shall be without prejudice to the validity of anything previously done under that rule.]

135. Amendments :-

The enactments specified in the Schedule shall be amended in the manner specified therein.

136. Repeals and savings :-

(1) Merchandise Marks Act, 1889, and the Trade Marks Act, 1940, are hereby repealed.

(2) Without prejudice to the provisions contained in the General Clauses Act, 1897 (10 of 1897), with respect to repeals, any notification, rule, order requirement, registration, certificate, notice, decision, determination, direction, approval, authorisation, consent, application, request, or thing made, issued, given or done under Indian Merchandise Marks Act, 1889, or the Trade Marks Act, 1940, shall, if in force at the commencement of this Act, continue in force, and have effect as if made, issued, given or done under the corresponding provision of this Act.

(3) The provisions of this Act shall apply to any application for registration of a trade mark pending at the commencement of this Act and to any proceedings consequent thereon and to any registration granted in pursuance thereof.

(4) Notwithstanding anything contained in this Act, any legal proceeding pending in any court at the commencement of this Act may be continued in that court as if this Act had not been passed.

SCHEDULE 1

Schedule

year	No.	Short title	Amendment
1	2	3	4
1860	45	The Indian Penal Code.	(i) In the heading to Chapter XVIII, the words "TRADE OR" shall be omitted :
			(ii) in the heading above section 478, the word "trade" , shall be omitted;
			(iii) sections 468 and 480 shall be omitted:
		(iv) in section 482, the words "any false trade mark or" shall be omitted;
	\\- ..^		(v) in section 483, the words "trade mark or" shall be omitted: