Delhi High Court interprets the provision under Indian law relating to Protection of Trademarks through International Registration under the Madrid Protocol

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In a writ petition filed by Bridgestone against an order passed by the Controller General of Patents, Designs and Trademarks, the Hon'ble Delhi High Court passed a notable judgment on 12 October 2022, interpreting Section 36E(5) of the Trade Marks Act under the Madrid Protocol and censuring the inaction of the Registrar of Trademarks. The Hon'ble Judge further directed that a copy of the order as passed be forwarded to the Secretary, Ministry of Commerce and Industry, for issuing necessary instructions / directions to ensure that aberrations like these do not occur in the future as they would only bring ridicule to the Indian system and denude the faith of foreign investors and stake holders in India's capability. This judgment was passed in writ petitions which had been filed by Bridgestone and Allergen impugning identical orders passed by the Controller General of Patents and Trademarks, whereby the oppositions filed by the Petitioners against International Applications seeking registration of certain trademarks (AMBERSTONE – opposed by Bridgestone, JUVEDERM – opposed by Allergan) under the Madrid Protocol had been deemed abated by the Controller as the factum of filing of the oppositions had not be communicated to the International Bureau within 18 months. The reason given for this by the Controller was a glitch in the software of the Trademark Office. The Hon'ble Judge observed the following: That a bare reading of Section 36E(5) of the Trade Marks Act, 1999 shows that where an international application seeking registration in India has been opposed, the deeming provision contained in Sub-section 5 of Section 36 E of the Act shall have no application and that it was applicable only when there is no opposition filed to an international application and the time for filing such a notice of opposition has expired;

1. The Hon'ble Judge also relied on various authorities to support the proposition that a legal fiction like a 'deeming provision' can only be invoked where the preconditions provided for invocation thereof are satisfied;
2. That the offer of the Respondent to convert the Petitioners' oppositions to applications seeking cancellation cannot provide solace to the Petitioners since it is trite law that in the case of a pending trademark application, the onus is on the Application seeking registration, as opposed to a Rectification where the onus is on the Applicant seeking rectification;
3. That from a reading of the impugned orders it is apparent that the Trademark Office had applied the Madrid Protocol strictly without appreciating the difference between the Protocol and the Act. The International Applications were to be dealt in accordance with the Act only since there was no ambiguity in its wording;
4. That the amendment made in the Indian Trademarks Act pursuant to India signing the Madrid

> Protocol is not in strict conformity with the Protocol. While in the Madrid Protocol, it is the failure to communicate the "refusal" within the time prescribed, which results in the deemed extension of protection to the Trade Mark, under Section 36E(5) of the Act, it is the failure to convey "acceptance" that leads to such deemed extension of protection.

The Hon'ble Judge accordingly set aside the orders as passed by the Respondent and restored the oppositions filed by the Petitioners. The Hon'ble Judge further directed that the protection extended to the international trademark applications would remain suspended till the oppositions of the Petitioners are decided and that the Applicants in respect of the said trademarks shall abide by the same. Bridgestone was represented by Anand and Anand (Team comprising: Pravin Anand, Safir Anand, Dhruv Anand, Swati Sharma, Udita Patro and Nimrat Singh).

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