

Parties wait six years for a trademark decision in India? Not so fast...

26
FEB 15

The headline in last Sunday's *Times of India* certainly caught our attention: "[Verdict in trademark row delivered 6 years after the order is reserved](#)". The story had a hapless American company waiting a whopping six years for a ruling (unfavourable, as it turned out) from India's Intellectual Property Appellate Board (IPAB), then, incensed by the delay, appealing to the High Court in Madras, alleging anti-foreign bias.



Jacob Schindler

The account played to a widespread perception of India's courts (opening with "Even by the snail pace of Indian judicial machinery...") and looked embarrassing for the IPAB – a body that has attracted a fair bit of controversy. On closer inspection, however, it turned out the story was not quite accurate. While the matter in question has faced long delays, the blame belongs at the feet of the trademark registry, not IPAB. It is far from the first time mainstream media have [misreported a trademark story](#), but we would like to set the record straight and offer foreign brands some advice from practitioners on efficiently navigating the Indian trademark system.

To get the full story, it is worth going back to this mark's beginnings. The original application was filed all the way back in March 1994 by Vishnu Priya Hosiery Mills. It then took seven years for the registry to advertise the mark, which it did in March 2001 – at which point it was opposed by US company Jones Investment Co, presumably within the four-month window following advertisement. It is not until March 8 2004 that the opposition is heard before the registry, and – this is the now-infamous six-year gap – the parties wait until March 9 2010 for the ruling (in favour of the applicant) to be handed down. It is only *after* this that IPAB becomes involved, at which point the fate of the application has hung in the balance at the registry for a full 17 years.

[Vikram Grover of Groverlaw says that the six-year wait after the opposition hearing for the registry's decision is the most startling aspect of this case. "We have had cases where it takes a fair amount of time, but in my experience a registrar could reasonably take three to four months". On whether it is closer to exception or rule, he says there are](#)

elements of both: "It is a rare case – not a one-off, but it's not a widespread problem." However, he points out that the backlog for oppositions across the system is "colossal", standing at over 126,000 cases.

As mentioned, Jones Investment Co decided to appeal against the decision dismissing its opposition, and only then did the case enter the IPAB's jurisdiction. The appeal was dismissed on February 24 2014. In Grover's analysis: "IPAB took about three and a half years to hand down the decision, which is not so bad – two would be reasonable". Jones appealed yet again, this time to the Madras High Court, and this was apparently the first time it raised the issue of the six-year delay. Dr Mohan Dewan of [RK Dewan & Co](#) told *WTR* "It is strange that Jones Investment is protesting [the delay] in 2015 when it kept quiet for five years. I cannot fault the IPAB in any way".

As to the American company's claim that it has being disadvantaged due to its status as a foreigner, it does not seem to pass muster for Grover, who points out that a delayed outcome does no favours for either party. After all, the applicant has been forced to wait over 20 years and counting to secure its trademark: "Even if this were to be defused tomorrow, imagine the time and effort that have been expended for the mark to succeed".

Moreover, both lawyers *WTR* spoke with felt that the American company's case was weak on the merits. According to Grover, "It appears that the right kind of evidence was not put forth before either body", while Dewan explains: "Although it claimed to have adopted the mark in 1966... there was no evidence filed by Jones Investment to establish adoption of the mark prior to 1993 either in India or anywhere else in the world. On these facts both the registrar and the IPAB had no choice but to hold that Vishnupriya was entitled to registration".

In terms of takeaways, Grover adds that the best way to avoid a delay is to do your homework and come prepared: "India is not as bad as is being made out in the report. If foreign companies are going to entangle themselves in these issues, they must make sure they are armed with the right kind of evidence".

WTR recently heard from the chief IP officer of a Fortune Global 500 company, who mirrored Grover's sentiment about India's IP system when remarking: "We have been rather impressed with the courts in India; we have a number of cases and they are

moving along in a good and efficient manner.”

Procedures in India are by no means perfect, but it is an important market for foreign companies, and it would be a shame if any were put off by scare stories. “Matters before the Registrar of Trademarks are far from satisfactory and do need to be addressed urgently”, concludes Dewan. “But articles like this in *The Times of India* create a distraction from the real problem in hand”.

Channels

[Private practice issues](#)

[In-house issues](#)

Comments

Please [log in](#) or [register](#) to leave a comment.

There are no comments on this article