

# Revalidation of trademark orders passed by contractual officers

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## 1 Background

The High Court of Calcutta has recently held<sup>1</sup> that officers appointed to the Indian Trade Marks Registry through the Quality Council of India, i.e., contractual officers, are not competent to pass orders relating to the processing of trademark applications as they cannot perform quasi-judicial functions. These officers have been engaged by the Trade Marks Registry at least since 2022 and have handled and passed orders in a large volume of trademark applications. Their orders are now under scrutiny and must be revalidated by designated officers of the Trade Marks Registry.

Therefore, trademark applicants and registered proprietors who have had any activity (acceptance orders, formalities checks, issuance of examination reports, hearings, amendments, etc.) on their applications in the last two years by such contractual officers must remain vigilant of their portfolios and identify which of their applications may require revalidation.

The Controller General of Patents, Designs and Trade Marks has laid down a process for revalidation in its order dated 13 August 2024 (**Order**). This process is discussed below.

A recent ruling of the Calcutta High Court has triggered revalidation of all trademark applications processed by contractual officers of the Trade Marks Registry in the past two years. This update discusses the revalidation process and its impact on trademark applicants and proprietors.

## 2 Revalidation process

The revalidation process will involve a review of each decision passed by a contractual officer. This review will be conducted by a group of 27 officers segregated into two levels: Level 1 officers who hold positions of Examiners/Senior Examiners, and Level 2 officers who hold positions of Assistant Registrars. The designated officers will revisit all final decisions passed by any contractual officer in relation to any of the following:

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<sup>1</sup> *Visa International Ltd. v Visa International Service Association & Anr.*, order dated 2 August 2024.

## UPDATES

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- a. Applications at the examination stage;
- b. Applications at the PARM (Pending Applications Record Management) stage;
- c. Applications at the show cause hearing stage;
- d. Applications at the opposition stage; and/or
- e. Applications at the post-registration stage;

The Order directs Level 1 officers to review all such applications, check conformity with the provisions of the Trade Marks Act, 1999 (**Act**) and the Trade Marks Rules, 2017 (**Rules**) and validate the decisions. If the Level 1 officer finds a decision to not conform with the provisions of the Act and Rules, it may refer the application to a Level 2 officer, stating reasons and proposing suitable action such as withdrawal of acceptance of the application (under Section 19 of the Act) or cancelling or modifying the registration (under Section 57(4)). The Level 2 officer must then review this recommendation and either accept it or validate the contractual officer's decision with reasons recorded in writing. The Order also instructs designated officers to process 250 applications per day, to the extent possible, to not make this a long-drawn process.

### 3 Way forward

Procedural matters, such as abandonment orders (under Section 21(2) of the Act) for non-compliance with statutory timelines, may be resolved relatively quickly, but substantive decisions passed by contractual officers are likely to undergo rigorous scrutiny. At present, it appears that the Trade Marks Registry will not provide applicants an opportunity to submit additional representations during the revalidation process. However, appeals against revalidation orders passed by the designated officers will lie before the relevant High Court (under Section 91 of the Act). More clarity on the process and timelines can be expected in the coming weeks through consultations and weekly open-house sessions held by the Trade Marks Registry.

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