

The TRADE MARKS ACT, 1999

Section 36 - Saving for words used as name or description of an article or substance or service.—

1) Theregistration of a trade mark shall not be deemed to have become invalid by reason only of any use afterthe date of the registration of any word or words which the trade mark contains or of which it consists asthe name or description of an article or substance or service: Provided that, if it is proved either (a) that there is a well known and established use of the said word as the name or description of the article or substance or service by a person or persons carrying on trade therein, not being use in relation to goods or services 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) in relation to goods or services 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 provedwith respect to any words, then, (a) for the purposes of any proceedings under section 57 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, or of the services or of any services of the same description, as the case requires, shall be deemed to be an entry wrongly remaining on the register; (b) for the purposes of any other legal proceedings 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; or (ii) if the trade mark contains such words and other matter, all such right of the proprietor to the use of such words,in relation to the article or substance or to any goods of the same description, or to the service or to anyservices of the same description, as the case requires, shall be deemed to have ceased on the date onwhich the use mentioned in clause (a) of the proviso to sub-section (1) first became well known andestablished or at the expiration of the period of two years mentioned in clause (b) of the said proviso. 21 1 [CHAPTER IVA SPECIAL PROVISIONS RELATING TO PROTECTION OF TRADE MARKS THROUGH INTERNATIONALSection 36A - REGISTRATION UNDER THE MADRID PROTOCOL