



THE INSTITUTE OF Company Secretaries of India

भारतीय कम्पनी सचिव संस्थान

IN PURSUIT OF PROFESSIONAL EXCELLENCE
Statutory body under an Act of Parliament
(Under the jurisdiction of Ministry of Corporate Affairs)

ICSI: PFP: 2023

May 15, 2023

Dr. Pawan Kumar Pandey

Deputy Registrar of Trade Marks & GI

Office of Controller General Patents, Designs & Trademarks

Boudhik Sampada Bhawan, S. M. Road

Antop Hill, Mumbai

Sir,

Reference: Letter No. CG/TMA/2023-24/27 dated May 5, 2023 regarding verification of Membership of the Institute of Company Secretaries of India.

The Institute of Company Secretaries of India (ICSI) is a premier professional body established under an Act of Parliament, namely, The Company Secretaries Act, 1980 to regulate and develop the profession of Company Secretaries.

The ICSI has nationwide presence with its headquarters at New Delhi, four Regional Offices at New Delhi, Chennai, Kolkata and Mumbai. The Institute has its Centre for Corporate Governance, Research and Training at Navi Mumbai & Hyderabad, 72 Chapters spread all over India and Six overseas centres at Australia, Canada, Singapore, UAE, UK and USA. The ICSI has on its register over 71,000 members and around 2,00,000 students.

A Company Secretary is a competent professional who undergoes exhaustive exposure provided by the ICSI through coaching, examination, rigorous training and continuing professional development programmes. A Company Secretary can undertake the profession, either in 'employment' or in 'practice' after obtaining Certificate of Practice from ICSI.

With reference to the letter referred above, we hereby submit the following:

Clause (f) of Sub-section 2 of Section 2 of the Company Secretaries Act, 1980 empowers the Council of the Institute to specify other services rendered by the Company Secretaries in Practice, the text of which is reproduced below:

“(2) Save as otherwise provided in this Act, a member of the Institute shall be deemed "to be in practice" when, individually or in partnership with one or more members of the Institute in practice or in partnership with members of such other recognised professions as may be prescribed, he, in consideration of remuneration received or to be received —

(a).....

(f) renders such other services as, in the opinion of the Council, are or may be rendered by a Company Secretary in practice;”

Further, Regulation 168 of the The Company Secretaries Regulations, 1982 provides that :

(1) A Company Secretary in Practice shall not engage in any business or occupation other than the profession of Company Secretary unless it is permitted by a general or specific resolution of the Council.

P.K.P.

Vision

"To be a global leader in promoting good corporate governance"

Motto

सत्यं वद। धर्मं चर। इदमेव कर्म तपते। abide by the law

Practising
16/5/23

प्राप्तकर्ता

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Mission
To develop high calibre professionals facilitating good corporate governance

Connect with ICSI

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The Controller of Patents, Designs & Trademarks

Trade Marks & GI

एन. एम. रोड, अंतोप हिल, मुंबई - 400 037

W. Road, Antop Hill, Mumbai - 400 037



*Provided that a **Company Secretary in Practice** who at the commencement of the Act was engaged in any business or occupation other than the profession of Company Secretary may continue to engage himself in such business or occupation for a period of six months from the commencement of these regulations.*

- (2) *Without prejudice to the discretion vested in the Council in this behalf, a **Company Secretary in Practice** may act as a secretary, trustee, executor, administrator, arbitrator, receiver, appraiser, valuer, internal auditor, management auditor, management consultant or as a representative on financial matters including taxation and may take up an appointment that may be made by the Central or any State Government, Court of Law, Labour Tribunals, or any other statutory authority.*

In this regard, the Council of the Institute pursuant to the powers conferred under Clause (f) of Sub-Section (2) of Section 2 of the Company Secretaries Act, 1980 read with Regulation 168 of the Company Secretaries Regulations, 1982 has allowed '**Company Secretaries in Practice to act as IPR agent**' [Ref: Item II (I) of the Resolution as mentioned below].

The aforesaid decision of the Council is available on the website of ICSI, which can be accessed at [https://www.icsi.edu/media/webmodules/Resolution_2\(2\)\(f\).pdf](https://www.icsi.edu/media/webmodules/Resolution_2(2)(f).pdf).

Rule 144 (iii) of the Trade Marks Rules, 2017 specifically recognizes the qualification of Company Secretary to be registered as a Trade Marks Agent.

It is pertinent to note that the qualification of Company Secretary to act as Trade Marks Agent is recognized since 1991. Rule 148 of the erstwhile Trade and Merchandise Marks Rules, 1959 specifically includes Company Secretary to be qualified to act as Trade Marks Agent. The extracts of the relevant text of the Rules is attached as **ANNEXURE I**.

Pursuant to the above recognition, large number of Company Secretaries in Practice all over the country are registered as Trade Marks Agents.

Further, as stated in the referred letter, *Trade Marks registry is altogether a specific domain services which is different in nature when compared with the professional practice of the Company Secretary.* In this regard we would like to draw your attention towards the following:

- Intellectual Property Laws and practice have always been covered in detail as a part of the syllabus of the Company Secretaryship Course.
 - the present Curriculum of Company Secretaryship Course includes Intellectual Property Laws at the Executive Programme covering law relating to Patents, Trade Marks, Copyright, Geographical Indications of Goods and Industrial Designs.
 - a dedicated paper on Intellectual Property Rights at the Professional Programme to impart expert knowledge to the students on the laws governing the Intellectual Property Rights, various organisations actively involved in IPR related matters and their role in upholding the interests of the stakeholders by preventing infringement of Intellectual Property Laws and other critical facets.

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- the Institute conducts Certificate Course and Crash Course on IPR for capacity building of its Members.

We wish to submit that Company Secretary is a competent professional who is well versed with compliances, filing, registration and various procedural requirements etc. under the Trade Marks Act, 1999.

In this background, we wish to clarify your goodself that by virtue of the above, the Company Secretaries in Practice are allowed to be registered and act as Trade Marks Agent. Company Secretaries in Practice are governed and regulated by the ICSI through The Company Secretaries Act, 1980 enacted by the Parliament and the Regulations made thereunder and is subject to the disciplinary mechanism for professional and other misconduct.

It has been understood from some of our Members that your good office has been keeping on hold various applications for registration as Trade Marks Agent, with a requirement to submit an affidavit that '*after their registration as Trade Marks Agent, they shall not practice as Company Secretaries*'.

In view of the facts above, we reiterate that:

- (a) **Company Secretaries in Practice** are allowed to be registered as Trade Marks Agent under Rule 144 of the Trade Marks Rules, 2017, read with the Company Secretaries Act, 1980 and the Regulations made thereunder.
- (b) **Company Secretaries in Practice** be considered as fit and proper persons to be registered as Trade Mark Agents under Rule 144 (iv) of the Trade Marks Rules, 2017; and that the Membership & Certificate of Practice issued by the ICSI are sufficient.

We shall be pleased to provide any other information you may desire in this regard.

Thanking you,
Yours faithfully,

(CS Asish Mohan)
Secretary, The ICSI

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कार्यालय महानियंत्रक, एडव्हॉकेट, अभिकल्प
व्यवहार विभाग तथा पेटेंट, डिजाइन, उपासना
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ANNEXURE I

(I) TRADE AND MERCHANDISE MARKS RULES, 1959

Rule 148 - Qualifications for registration

Subject to the provisions of rule 149, a person shall be qualified to be registered as a trade marks agent if he-

- (i) is a citizen of India;
- (ii) is not less than [1] 21 years of age;
- [2] (iii) has passed the examination prescribed in Rule 152 or is an Advocate within the meaning of the Advocates Act, 1961 or is a Member of the Institute of Company Secretaries of India;
- (iv) is a graduate of any university in India or possess an equivalent qualification; and
- (v) is considered by the Registrar as a fit and proper person to be registered as a trade mark agent.

FOOTNOTES:

1. Substituted for 25 by the Trade and Merchandise marks Act (Amendment) Rules, 1991 with effect from . 9-12-1991.
2. Substituted by the Trade and Merchandise marks (Second Amendment) Rules, 1985, with effect from . (iii) has passed the examination prescribed in rule 152".

(II) THE TRADE MARKS RULES, 2001

150. Qualifications for registration. -

Subject to the provisions of rule 151, a person shall be qualified to be registered as a trade marks agent if he-

- (i) is a citizen of India;
- (ii) is not less than 21 years of age;
- (iii) has passed the examination prescribed in rule 154 or is an Advocate within the meaning of the Advocates Act, 1961 (25 of 1961) or is a Member of the Institute of Company Secretaries of India;
- (iv) is a graduate of any university in India or possess an equivalent qualification; and
- (v) is considered by the Registrar as a fit and proper person to be registered as a trade mark agent.

(III) TRADE MARKS RULES, 2017

Rule 144- Qualifications for registration

Subject to the provisions of rule 145, a person shall be qualified to be registered as a trademarks agent if he—

- (i) is a citizen of India,
- (ii) is not less than 21 years of age;
- (iii) is a graduate of any university in India or possesses an equivalent qualification and has passed the examination prescribed in rule 148 or is an Advocate within the meaning of the Advocates Act, 1961 (25 of 1961) or is a member of the Institute of Company Secretaries of India;
- (iv) is considered by the Registrar as a fit and proper person to be registered as a trademark agent.