

## Registration of Trademarks in India

Trademark is a distinctive mark that can be graphically represented and consist of words, symbols numerals or combination of colour used for distinguishing goods and service of one person from that of another person. Trademarks are popularly known as brand name or logos or trade name and are basically business identifiers. Goods or services are sold in the market under the said trade mark or the trade mark is attached to the said goods or services as a business identifier. For example, Xerox is the trade mark for a photocopying machines and apple is trade mark for apple computers.

Trademark may include names of person owning the business, numeral, invented words, and shapes, horizontal or vertical lines in any colour. Trademarks have over period of time acquired considerable significance especially in the business world owing to their inherent quality of being identifiers of business. Trade mark indicate source of origin and help in building a brand name and brand value to which the ordinary consumer associate with. The ordinary consumer shall after looking the trade mark on goods shall identify goods to have inherent quality that some other goods with the said trade mark possess and would be tempted to buy the said goods and thus helping the businesses to grow. Hence, Trademarks have become extremely important as they help in generating good will of the business in a competitive market and help in promoting businesses. Trademarks hold great value to the business and hence, owing to these qualities trademarks have emerged as indispensable intangible intellectual property i.e. a property that is not in physical form and arise from the intellectual capacity of human mind. Many rights have been attached with the said property i. e. trade marks. These rights exist in India by virtue of common law and by virtue of the Trade marks Act 1999.

Trademarks are around the world governed by the territorial law of the country and in India they are governed by the Trade marks Act 1999 and the Trade marks Rules 2002. India is a common law country and hence, action of passing off action with respect to trade mark can also be maintained in case trademarks are not registered with the Registrar of Trade marks. Registration of trademarks is compulsory in India and only registered trademarks can enforce their rights under the said Act though passing off action can be maintained under common law but mala fide intension on the part of violator of the rights of trade mark holder is required to be proved. Registration of trademarks is a much better proposition as compared to passing off action under common law as with registration the position of trade mark is made much stronger and the trade mark owner rights are easily protected by virtue of the Act.

Registration of a trade mark is essential for enforcement of rights with respect to trade mark in India. There is also a Madrid Protocol of international registration where registration of the trade mark under one jurisdiction shall entitle the trade mark owner to exercise all his rights (attached to trade mark) in all other jurisdictions of the world but India is not party to the said Protocol as on date though a Bill has been proposed in the Parliament in this regard and in future this system could be adopted by India. The European Union nation states also have also entered into the Community Trade Mark system under which a trade mark can be registered at the office of

Harmonization in the Internal market headquartered in Spain by virtue of which the rights with respect to the said trade mark can be enforced throughout the European Union.

As mentioned above, trademarks consist of words, symbols that can be graphically represented but the marks are also required to possess some other characteristics as prescribed by the trade mark Act to be categorized as trade mark. In India, a mark can be registered as a trade mark by any person who wishes to register the said mark as a trade mark. This mark is required to fulfil the following mentioned criteria as prescribed by the said Act to be categorized as a trade mark. The mark is required to be:

- Distinctive in character that is the mark is required to be distinctive and unique in character.
- Does not indicate any quality or describes the goods for which mark is being used.
- Does not contain any word that is commonly used and is part of normal day to day language.
- Is not similar to well-known trade mark.
- Is not similar to a registered trade mark.
- Not causing confusion and deception in the minds of ordinary consumers regarding source of origin.
- To contain any symbol or word that is prohibited under the Emblem and Names (Prevention of Improper Use) Act 1950.
- The mark should not contain shape of goods or shape that is by virtue of the nature of goods or a shape that is necessary to obtain a technical result or adds substantial value to goods.

The mark if fulfils the above criteria then, it shall registered as a trade mark.

### **Registration Process of Trademarks in India**

Trade mark can be registered either through an attorney or in person with the Registrar of Trade mark that is the Office of the Controller General of Patents, Trade Marks, Industrial Designs and Geographical Indications which is situated in Mumbai. However, there are also regional branch offices in Delhi, Chennai, Ahmedabad and Kolkata where trade mark applications can be filed on the basis of territorial jurisdiction. The steps that are required to be undertaken in the registration process of Trade marks in India are as follows:

1. The first step towards registration of trade mark is deciding how the proposed mark shall look.
2. The second step is doing a search that is name search or market search or market survey to search if any identical or similar trade mark exists to the proposed mark as it helps later at a later stage when the mark shall not be opposed after making application for registration. An action of infringement shall also not lie in future if a proper mark is formed.

3. The person applying for registration of mark as a trade mark is the applicant and he is required to apply in Form TM-1 as prescribed by the Act for the registration of the mark as a trade mark. The form is filed in triplicate that is 3 copies along with prescribed fee and copies of additional representation as prescribed by Trade mark Act and Rules. The additional representation is required to contain:
  - The mark
  - Name of the proprietor or company using the mark.
  - Address of the office of proprietorship or company
  - The class i.e. the class of goods and services as prescribed by the Trade mark Act in respect of which the proposed mark is to be used.
  - The description of goods or services in respect of which mark is used or to be used.
  - The date from which the mark is being used. In India, mark can be registered as a trade mark when it is not in actual use in the country that is on proposed to be used basis or intent to be used basis.
4. The applicant may choose to seek preliminary advice regarding the distinctiveness of the mark from the Registrar of Trade mark by making a request in Form TM-55 along with fee as prescribed by the Act.
5. The applicant may choose to also make a request in Form TM- 54 along with the prescribed fee to the Registrar of Trade mark for the official report to ascertain whether any identical or deceptively similar mark is pending registration.
6. The Registrar of trade mark shall then allot an application number. In case the application is accepted then it shall in future become the trade mark number.
7. The Registrar of trade mark shall review the application and do data entry. The registrar than do Vienna Codification. The Registrar begins the process of examination of the application.
8. The Registrar shall check the application to see whether the following requirements are met:
  - That application for registration of trade mark has been filed in accordance to the requirements prescribed by the Trade Marks Act 1999 and Trade Marks Rules, 2002.
  - Whether any same or similar mark is on record.
  - Whether any restriction, condition or limitation is required to be imposed.
9. The Registrar shall then issue an examination report and a search report short listing conflicting marks on record.

10. In case the application is accepted with no objections then, it shall be published in Trade mark Journal.
11. In case the application is accepted but subject to some objections or restrictions, then the applicant is required to respond to the said objections in case they are raised in the examination report within the period of 1 month from the issuance of examination report. The applicant may choose to respond to the objection or remove the said objections. The applicant may choose to abandon the application or withdraw the application. A show cause hearing may also be put up for the applicant to respond to the objections.
12. The Registrar than on the basis of above mentioned shall determine whether the application shall refused or accepted with restrictions or limitation.
13. In case the application is rejected then, the applicant may choose to move to Intellectual Property Rights Appellate Board to appeal against the order of the Registrar of Trade mark.
14. In case the application is accepted, the said mark is published in the Trade mark Journal. The said mark is thereafter required to be opposed by a third party within 3 months from date of publication. In case the mark is unopposed within this stipulated time period of 3 months, then it shall proceed for registration as a trade mark and the application number shall become the trade mark registration number.
15. The trade mark protection is perpetual but it is required to be renewed after every 10 years.
16. The application for renewable of trade mark can be filed within the period of 6 months before expiry of the period of validity of trade mark.
17. In case trade mark is registered but it is not in use for 5 years and 3 months from the date of registration in India then the trade mark shall be struck off from the Register of Trade marks.
18. In case opposition by third party is filed and allowed then the opposition shall continue and trade mark shall not registered until the opposition proceeding are completed. In case the third party files the notice of opposition to the application then the applicant is required to respond to this within the stipulated time period prescribed by the Act and in case the applicant does not respond to it then, the application is said to be abandoned. Under the opposition proceeding, evidence between the applicant and third party are required to be exchanged and the matter is thereafter put up for hearing. The time prescribed by the Trade mark Act and Trade mark Rules for the respective filing and exchanging of evidence is required to be strictly adhered and in case there is a failure to adhere to the prescribed

guidelines then the matter can be adversely affected and either opposition might fail or the application is deemed to be abandoned as mentioned above.

19. In case the opposition is allowed and the application is rejected, the application can be reviewed by applying for the same.
20. In case the application is accepted then it shall proceed for registration and mark shall be registered as a trade mark in the Register of Trade mark with the application number being allotted as trade mark number.

This process completes the process of registration of Trademarks and rights with respect to said Trade mark as prescribed by the Act can hence be enforced in the courts of the country and thereby protecting the business interest and help in creating brand name and brand value.

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