
INDIAN PERSPECTIVE ON THE REGISTRATION OF TRADEMARKS

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INTRODUCTION:

Every time an entrepreneur in the modern day decides to enter this fierce economy, they must think carefully to keep up with the competition. The greatest and most important task is to invest time in matters related to name, identity and brand. Trademarks provides a mechanism for businesses to provide a legally protected identity for their business.

The Trade Marks Act of 1999 and the Trade Marks Rules of 2017 govern trademark registration in India. Trademarks are jurisdictional rights, and just like other tangible assets, they may be bought, sold, and licenced. A registered trademark offers a company its own unique identity and protects its reputation as a trusted brand. A trademark may be used for ten years following registration and, if the owner renews it on schedule, for as long as the trademark owner's business is in operation. The necessity to protect trademarks can be seen from the fact that it provides protection from infringement. Only a registered trademark may initiate a lawsuit for trademark infringement against any third party infringer who attempts to use another person's registered trademark's goodwill and reputation to pass off their own goods and/or services.

After the trademark amendment rules came to be the filing of trademark became more streamlined. The Trademark Rules, 2002 were repealed without affecting applications done under it prior to the new Trademark Rules, 2017 taking effect on March 6, 2017. These rules simplify and streamline the entire trademark registration procedure. In this article, we will look through the filing procedure of trade marks in India.

CLASSIFICATION OF GOODS AND SERVICES FOR PROTECTION:

It is to be understood that a mark can be registered as a service mark or as a trademark depending on the nature of the goods or service attached to the mark. The first aspect that is to be considered when an applicant wants to file for a Trade Mark is to identify the class to which it belongs to. The goods and/or services must be classified in accordance with the class or classes they belong to in order to submit a trademark application with the Indian trademark office and request protection for the mark in the appropriate class. India uses the classification system referred to as the Nice Classification for this purpose and this was translated into the fourth schedule of the

trade mark rules 2002. But today the rule applicable is rule 20 of the rules which states that in order to register a trademark, the goods and services must be categorised in accordance with the most recent edition of "the International Classification of Goods and Services (NICE classification)" published by the World Intellectual Property Organization (WIPO).¹

A treaty signed at the Nice Diplomatic Conference on June 15, 1957 established the International (Nice) Classification of Goods and Services as a system for the purposes of registering trademarks. It was later updated in Stockholm in 1967 and Geneva in 1977. India joined the Nice Agreement on September 7, 2019, and as a result, the Indian trademark office uses the most recent Nice Classification to classify products and services when reviewing trademark applications in India. The Nice classification has 45 classes, of which classes 1 through 34 classify items or products and classes 35 through 45 classify services. The "Class Header" section of the Nice classification gives a detailed explanation of the kinds of goods and services that fall under each class.

The precise category of goods or services for which the trademark is to be used must be ascertained. For instance, if the trademark is to be used for the "manufacturing of shirts and pants," Class 25 would be the relevant class; however, if the trademark is to be used for the "selling of shirts and pants," Class 35 under Retail Stores, Whole Sale outlets, etc. would apply. If the application is submitted under the incorrect class, the trademark owner will no longer be able to protect their rights in the event of a trademark infringement. The Trade Mark office will also make a Nice Codification accordingly after the acceptance of the application.

PROCEDURE FOR REGISTRATION OF TRADEMARKS:

1. Application for Registration

Anyone claiming ownership of a trademark that they have used or intend to use may submit a written or online application to the Registrar in the required format for the registration of their trademark.² An application could be of different types. A normal trademark application to be filed for a word, device or any other combination thereof. A certification mark³ is to be filed when it is a mark that certifies the characteristics like quality, origin and so on of other goods/services. Another type is a collective mark, where the mark belongs to a collective group or association of persons. An example of this is CII (Confederation of Indian Industry). The next type is a

¹ Trade Mark Rules 2017, r 20

² Trade Marks Act 1999, s 18

³ Trade Marks Act 1999, s 2(e)

Series marks where the trademark applied for, is in the form of a series. Currently all the above applications could be filed under Form TM-A.

Form TM-A can be used to submit a trademark registration application under the current Trademark Rules 2017 regulations. There are various sections to the application. The form can be summarised into the nature of the application, that is, whether it is a standard mark, certification mark. Then the nature of the applicant is to be filled, specifically if they are an Individual or start-up or small enterprise. Details of Agent of the applicant, if any is to be provided. Details of Trademark Class and description of goods/services Statement of use or proposed to be used and Priority claim if any is also to be stated. Finally the form is completed with verification and signature. The official fee is determined by the type of organisation, whether it is an individual, start up, small business, or corporation, and whether the application is to be submitted physically or electronically.

According to the Trademarks Rules 2017, an application for the registration of a trade mark for goods or services shall explain with sufficient precision, a description by words, of the trade mark if necessary to determine the right of the applicant and be able to depict the mark graphically. Moreover if the mark sought is a 3D mark or a mark consisting of colour combination, there must be a statement to that effect.⁴ When an applicant submits a single application for multiple classes, and the Registrar determines that the requested goods or services fall under another class or classes in addition to those requested, the applicant may limit the requested goods or services to the class requested, or they may amend the application to request the addition of another class or classes upon payment of the proper class fee and the divisional fee.

Application to be filed in the Office of Trademarks Registry:

The Trademarks Registry office where the applicant's major place of business in India, or in the event of joint applicants, the first applicant's principal place of business, is located, is where the application for the registration of a trademark must be submitted.

However, if the applicant or any joint applicants do not conduct business in India, the application must be submitted at the Trademarks Registry office whose territorial jurisdiction

⁴ Trade Mark Rules 2017, r 23

includes the location indicated in the address for service in India that is declared in the application.⁵

Amendment of Application:

The Registrar may at any time, whether before or after acceptance of an application for registration, permit the correction of any error in or in connection with the application or permit amendment of the application.⁶

An application for registration of a trade mark may, whether before or after acceptance of his application but before the registration of the mark, apply in form TM-M accompanied by the prescribed fee for the correction of any error in or in connection with his application or any amendment of his application.⁷

However, no such amendment shall be allowed to substitute a new specification of goods or services not contained in the application as submitted or to fundamentally alter the trade mark claimed for unless the registrar deems it fit accordingly.

EXAMINATION:

Following application receipt, the application will be examined in accordance with the provisions of this Act while also taking into account any prior trademark registrations or applications. The application is assigned to an examiner for review once data input for a trademark registration application is made and digitalization of the trademark application and any other related documents, if any, is complete. There will be one of two results after reviewing the application: Acceptance or Rejection. The Registrar must inform the applicant in writing in the examination report of either objection or acceptance following consideration of the trademark registration application.

The general well settled principles for comparison of trademarks during examination are that the trademark must be considered as a whole. It is not right to take a part of the trademark and compare it with part of the other trademark. No meticulous or letter by letter comparison is required, as in, side by side comparison is not the correct test. Comparison should be made from the point of view of a person of average intelligence and of imperfect recollection. The overall structural, visual & phonetic similarity and similarity of the idea in the two marks and

⁵ Trade Mark Rules 2017, r 4

⁶ Trade Marks Act 1999, s 22

⁷ Trade Marks Act 1999, s 18 (4)

the fact as to whether it is reasonable likelihood to cause confusion should be taken into account.⁸

After reviewing the application, the examiner creates an examination report and decides whether to accept the application or not. If approved, the registry would then proceed to advertise the trademark. If the examination report contains any observations, the applicant or trademark agent will be informed of them so they can respond to the examination report. The cause for objection must be included in the trademark examination report. Within 30 days of receiving the examination report, the applicant must submit his response. Typically, the trademark agent will receive notification of this examination report and take appropriate action. The applicant will then be instructed to respond to the objection within 30 days of receiving the examination report. The Registrar will accept the application and advertise it on Trademark Journal if the reply to the examination report is deemed sufficient. If it is not approved, or further clarifications are requested by the Trademark Examiner, a trademark hearing will be held and the same would be informed with a notice.

PUBLICATION OF APPLICATION:

When an application for registration of a trade mark has been accepted, the Registrar shall, as soon as may be after acceptance, publish the application in the trademark journal. This could happen after a hearing in which the mark is accepted or right after the examination stage, if the Registrar is persuaded by the justifications given in the examination response. Alternatively, the mark may be ordered to be posted immediately without filing a response to an examination report where the Registrar is confident that there can be no legitimate objections even in the preliminary stage of examination. The Trademark Journal then publishes an advertisement for the mark. Every Monday, the Trademark Office publishes the Trademark Journal for the class.⁹

The trademark, date of application, priority claim (if any), applicant information with address, applicant's address for service of process including agent information, class & specification of goods or services, statement as to use of the trademark, and the appropriate office should all be included in the advertisement of application in the trademark journal.

This has also been set out in various cases. Once an application for registration is made and accepted by the Registrar, the Registrar has to cause the application to be advertised.¹⁰ Where

⁸ *Cadila Healthcare Limited v Cadila Pharmaceutical Limited* (AIR 2001) SC 1952

⁹ Trade Marks Act 1999, s 20

¹⁰ *American Home Products Corporation v Mac Laboratories Private Limited* (1986) 1 SCC 465

an application has been accepted either absolutely or subject to certain conditions or limitations, it has to be advertised, though the Registrar may advertise it even before its acceptance in certain situations contemplated by that section.¹¹

OPPOSITION¹²:

Any person may object to the mark within the 4-month window following its publication or advertisement in the Trademarks Journal by submitting a Notice of Opposition on the required Form TM-O and paying the prescribed cost of INR 2700. The cost for each class for which the opposition is submitted must be paid when a notice of opposition is filed in connection to a single trademark but for various classes of goods and services. In *BDA Private Limited v Paul P John*¹³, the Delhi High Court observed that an examination of the Act¹⁴ reveals that any person may give a notice in writing 'in the prescribed manner' to the Registrar of his opposition in respect of an application for registration.

The name of the trademark applicant, the application number against which opposition is sought, and, if the earlier trademark owner filed the opposition, his name, address, and information regarding his trademark and rights are all included in the Notice of Opposition.

The name of the opponents and their address for service in India must be provided if the opposing party has no place of business there. If the opposition is based on an earlier trademark, a statement to that effect as well as an indication of the status, application number, and the filing date, including the priority date, of the earlier trademark, must also be provided. The opposition application must include a statement of the grounds for opposition. The registrar typically serves a copy of the notice of opposition on the trademark applicant within three months of the date of receipt, following which the opposition moves toward the filing of the counter statement. This is subject to inspection and compliance with the relevant formalities.

Within two months after receiving the notice of objection, the applicant must file a counter statement¹⁵ or reply to it using Form TM-O and paying the prescribed fee of INR 2700. The cost charged even for counter statements must be paid for each class to which the counter is being filed. The counter statement must comprise a paragraph-by-paragraph refutation of each of the reasons raised in the notice of opposition as well as the facts, if any of the facts asserted

¹¹ *Whirlpool Corporation v Registrar of Trademarks* (1998) 8 SCC 1

¹² Trade Marks Act 1999, s 21

¹³ *BDA Private Limited v Paul P John* (2008) 37 PTC 41 (Del)

¹⁴ Trade Marks Act 1999, s 21(1)

¹⁵ Trade Marks Act 1999, s 21(2)

in the notice of opposition are confirmed by the applicant. Accordingly, if the applicant fails to file its counter statement with two months of service of the opposition, its trademark is deemed to have been abandoned for non-prosecution. Alternatively, if the applicant files the counter statement, the opposition will proceed to the evidence stage. The evidence stage includes the evidence by the applicant as well as by the opposition. They will be given an extra chance to file additional evidence after which it will move onto hearing.

After both parties have finished submitting their evidence, the registrar will schedule a hearing and notify the parties of it. If both parties show up for the hearing at the scheduled time and day, the Registrar will decide whether or not to register the trademark after hearing from both parties and considering the presented evidence, ending the opposition process. The parties can also seek adjournments but it is to be understood that ex parte orders can also be given by the authority. Any party who is dissatisfied with the Registrar's judgement may appeal it to High Court or the Commercial court as per the jurisdiction.

Depending on the result of the hearing or the appeal, the trademark may be registered.

REGISTRATION:

A trade mark is registered¹⁶ when an application for registration of a trade has been accepted and either when the application has not been opposed and the time for notice of opposition has expired or if the application has been opposed and the opposition has been decided in favour of the applicant, The Registrar shall register the said trade mark unless the Central Government directs otherwise. A trade mark shall be registered as of the date of making of the said application. The date of application is to be deemed to be the date of registration.

In *Ciba Ltd v M.Ramalingam*¹⁷, the court stated that it is incumbent upon the registrar to register a trade mark if there is no opposition. The provision must be read subject to the substantive provision of the Act which prohibits the registration of the trade mark under certain circumstances.

On registration, the entry of a trade mark in the register shall specify the date of filing of application, the actual date of the registration, the goods or services and the class or classes in respect of which it is registered, and all particulars required by the provision.¹⁸ On the

¹⁶ Trade Marks Act 1999, s 23

¹⁷ *Ciba Ltd v M.Ramalingam* AIR 1958 Bom 56

¹⁸ Trade Marks Act 1999, s 6(1); following entries are to be made in the register of Trademarks- all registered trademarks with the names, addresses and description of the proprietors, notifications of assignment and

registration of a trade mark, the registrar is obliged to issue a certificate of registration to the applicant which is to be sealed with the seal of the trade mark registry.

Abandonment of Application:

Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on part of the applicant, the Registrar may, after giving notice to the applicant, treat the application as abandoned unless it is completed within the time specified in the notice. The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

POST REGISTRATION:

A trademark application that has already been registered must be renewed every ten years, or it risks being struck off the Register of Trademarks¹⁹. Anytime within one year of the mark's registration expiring, an application for the renewal of a trademark must be submitted using Form TM-R and the required fee of INR 9000 per class. The trademark may be deleted from the Register if the required fee and Form TM-R are not submitted.

The Registrar must notify the trademark owner of the renewal deadline by sending a notice to the prescribed address of service if no application for renewal of the trademark is submitted with the required fee. This notice must be delivered no later than six months before the registration expires. It is important to remember that the trademark cannot be deleted from the Register unless the Registrar has given the proprietor such notification. If, however, a trademark is due for renewal and was registered before or after the renewal due date by more than six months, the trademark registration may be renewed by paying the required renewal fee within six months of the actual date of registration.

If the renewal fee is not paid within the required time frame in any of the aforementioned situations, the trademark is subject to removal from the Register of Trademarks upon publication of an advertisement in the Trademarks Journal.

The owner of the removed trademark may submit an application for the reinstatement of the trademark to the register and renewal²⁰ of its registration if the removal resulted from failure to submit the renewal request on Form TM-R with the required fee. Such a restoration

transmissions, the names, addresses and descriptions of registered users, conditions, limitations and other prescribed matter relating to registered trademarks.

¹⁹ Trade Marks Act 1999, s 25(1)

²⁰ Trade Marks Act 1999, s 25(4)

application may be submitted using Form TM-R after six months and within one year of the expiration of the registration of the mark, along with the necessary renewal charge and the restoration fee of INR 9000 per class.

REMOVAL FROM REGISTER:²¹

The Act provides that where a trade mark has been removed from the register for failure to pay the renewal fee, it shall nevertheless, for the purpose of any application for the registration of another trade mark during one year next after the date of the removal, be deemed to be a trade mark already on the register unless the Registrar or Appellate Court, is satisfied either:

- (i) that there has been no bona fide trade use of the trade mark which has been removed during the two years immediately preceding its removal; or
- (ii) that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

WELL KNOWN MARKS:

Well-known trademarks are outcome of substantial and widely used mark. The determining factors for a mark to become a well-known trademark include usage, recognition, goodwill, and reputation, among other things. A well-known mark trademark benefits from additional protection over a registered trademark. Earlier well-known trademarks were protected under the common law. The concept of well-known trademark was operational on judicial pronouncements and precedents. Thereafter, Trade Marks Act, 1999, statutorily recognized and defined a well-known trademark²². Further, Trade Marks Rules 2017 empowers the Registrar to determine a mark as well-known trademark after following a due procedure.²³

The factors used by the Registrar of Trademarks to evaluate whether a mark is a well-known trademark are outlined in Rule 124 of the Trade Marks Rules, 2017. For the determination of a mark as a well-known trademark, anyone may submit an application in Form TM-M together with the required fees of Rupees One Lakh. A statement of the case and all the supporting papers and proof that the applicant used to support his claim must be submitted with the application in Form TM-M. The Registrar may seek wide public objections to be submitted within thirty days of the date of such call of objections before determining a mark to be a well-

²¹ Trade Marks Act 1999, s 26

²² Trade Marks Act 1999, 2(1)(zg)

²³ Trade Mark Rules 2017, r 124

known trademark. If it is found that a mark qualifies as a well-known trademark, the Registrar must publish the information in the trademark journal and add the mark to the list of well-known trademarks. It should also be noted that the Registrar may, at any time, remove a trademark from the list of well-known trademarks after giving the concerned party a fair opportunity to be heard if it is determined that the trademark was inaccurately or inadvertently included or is no longer justified to be on the list.

Benefits of obtaining the status of well-known trademark are numerous. It provides an exclusive right against all unlawful users and gives strong protection against false and frivolous litigation as Well-known trademarks are better recognized than a registered trademark. At all the legal proceedings an Owner of well-known trademark can always claim and stress on the point that he is the owner of well-known trademark and enjoy a better right than others. Furthermore the registrar of trademarks are restricted from registration of marks which are similar or identical to a well-known trademark. Another major perk is that Well-known trademarks are protected across all classes of goods and services even though the said well-known trademark is not used for all classes of goods and services.

CONCLUSION:

Prior to the introduction of the New Trade Marks Rules in 2017, individual applications for each of the types of trademarks had to be submitted, as did separate forms for single-class and multi-class applications, depending on whether priority was claimed or not. The type of application will rely on elements like the type of mark that will be submitted, single or multi-class, priority or not, among others. This has effectively furthered the rights of the owners of Trademark.

The registered trademark owner has total control over the mark, and only with his permission may it be used by others. A violation of the rights associated with the mark occurs when someone uses the logo without the registered owner's consent. Due to confusion among consumers of those goods or services, it also violates trademark law when a trademark that is identical to or confusingly similar to a registered trademark is utilised. The streamlined process also gives effect to better protection from infringement. The Trademarks Acts, 1999 makes passing or using a similar trademark a cognizable offense and a registered trademark is enabled for such protection.

With respect to the new Trade Marks Rules of 2017, it can be seen as a welcome move due to the various advantages offered by the same. Some which could be inferred. The Fees for filing

trademark is Rs.5000 for individuals, start-ups and small enterprises and for others Rs. 10,000. But there is a reduction if it is filed online. Rs. 4500 for individuals who file online and Rs. 9000 for others. Moreover the new regulations comprise a small number of trademark forms, which will save trademark practitioners time and effort. More than 74 different types were formerly employed for a variety of purposes. The quasi-judicial process was also simplified to the effect that the hearing for trademark may be held through video conferencing or through any other audio-visual communication devices and to promote timely disposal of matter, number of adjournments in proceedings are restricted to maximum of two by each party. In order to speed up the registration procedure, emails sent by the Trade Mark office will be regarded as complete communications. Documents will not need to be served through the post. The new rule has provisions to expedite processing of application for registration of trademark. On payment of additional fees, an applicant can make a request for express registration.

Finally the new rules have also empowered the registrar and statutorily validated well known marks. To qualify as a well-known trademark, one must create and develop the mark, make prior efforts, use it extensively, sell a lot of merchandise, and spend a lot of money, among other requirements. As a result, a well-known trademark is very important to its owner because it offers additional advantages. Outside of India, the idea of a well-known trademark is common. The protection of intellectual property has evolved over time and with increased awareness, has now become statutorily expressed under the Trade Marks Act and the Rules.

REFERENCES:

STATUTES:

1. Trade Marks Act 1999.
2. Trade Mark Rules 2017.

JUDICIAL DECISIONS:

1. Cadila Healthcare Limited v Cadila Pharmaceutical Limited (AIR 2001) SC 1952.
2. American Home Products Corporation v Mac Laboratories Private Limited (1986) 1 SCC 465.
3. Whirlpool Corporation v Registrar of Trademarks (1998) 8 SCC 1.
4. BDA Private Limited v Paul P John (2008) 37 PTC 41 (Del).
5. Ciba Ltd v M.Ramalingam AIR 1958 Bom 56.