

A Gist of Trademark Registration in India

Trademark registration is not mandatory in India and yet registered Trademarks have additional benefits as compared to unregistered Trademarks. In case of a registered trademark the action is of infringement. For unregistered trademark the action available is that of passing of. In case of a registered trademark the 'Trademark Registration Certificate' is the proof of ownership in favour of Trademark Owner. As such the infringement action becomes legally stronger and the onus of proof is not burdensome upon the Trademark owner. A registered Trademark equips the Owner of the Trademark with greater and more effective powers to legally protect its Trademark, its business and all rights associated with the said Trademark. Whereas, in stark contrast, for an owner of an unregistered trademark the only action that is available is that of passing of. The Onus of proof on the Owner of unregistered Trademark is burdensome and on most of the occasions the Owner of such unregistered Trademark has to suffer a variety of losses and look for remedies in Common law, which are, on most of the occasions, not as effective, due to absence of registration.

There are total 45 classes listed in Fourth Schedule of the Trademarks Act, 1999, whereunder the intended Trademark is to be registered. The registration of a trademark in a particular Class, though does not prevent others from using or registering the mark for entries in other classes; however the same enables the owner of a Trademark to prevent/thwart others from using the same or similar trademark relating to entries under that particular class.

Procedure for Registration

The procedure for registration of a Trademark is contained under Sections 18-24 of the Trademarks Act of 1999. The registration includes following steps.

- a. Trademark Search
- b. Application for Registration of Trademark
- c. Examination
- d. Publication
- e. Opposition (contested/uncontested)
- f. Registration

Trademark Search

The registration of Trademark starts with an initial step of 'Trademark Search' that takes a minimum period of one week. This search enables us to identify the registered trademarks that are same or similar to the mark for which search is requested and thereafter we give a further opinion about the possibility of obtaining a registration.

Application for Registration of Trademark

The application for registration of Trademark is filed by an agent/ advocate on behalf of the person claiming to be the owner/proprietor of the trademark used or proposed to be used by such owner, who authorizes the agent/attorney through a Power of Attorney (Form TM-48) duly executed on a Stamp Paper. The application may be made in the name of Company, Corporation, individual or partners, any Government Department, trust or joint applicants.

Filing

Trademark application has to be made on TM1 in triplicate along with five additional representations of the Trademark for registration of single mark in single class after depositing/paying the prescribed Government fee with the Registrar, Trademark. In order to apply in more than one class, a Single application can be made on TM51 in triplicate along with five additional representations by paying prescribed government fee, per class. Further, to apply for more than one trademark, for same class of goods, TM8 application can be made/filed in triplicate along with five additional representations by depositing/paying the prescribed government fee per mark per class. An application number is allotted on filing of the trademark application.

Examination

The application is examined within one month from the date of filing of the application to check whether it complies with the requirements as provided under Section 9 & 11 of the Trademarks act, 1999, which are as follows:

The Trademark

1. Should be distinct;
2. Should not be descriptive;
3. Should not be generic;
4. Should not be deceptive;
5. Should not hurt the religious sentiments of any class or section of the citizens of India;
6. Should not contain scandalous or obscene matter;

7. Should not contain marks prohibited by Emblems and names (prevention of improper use) Act, 1950;
8. Should not be the shape of goods which results from the nature of the goods;
9. Should not be identical with an earlier trademark;
10. Should not be prevented by virtue of any law and in particular the law of passing off; and
11. Should not be identical/similar to any well-known trademark.

If the Registrar is satisfied that the applied mark complies with all requirements of the Act, the trademark will be accepted for registration. If there are any objections, the Examiner will send his examination report detailing the reasons for the objection. The response to such objections can be filed within four weeks from the date of receipt of the examination report. The reply can be sent by way of an affidavit and a hearing can be requested, if necessary.

Publication

Once the examination objections are removed, the trademark is accepted for registration, the details of the application will be advertised in the Official Journal of Trademarks within six months from the date of acceptance of application.

Opposition

On advertisement/publication, any person who believes that the said trademark should not be registered may oppose its registration within three months from the Publication date stating the grounds of opposition. All the requirements of the Trademark Registration are valid grounds for opposition. If no opposition is filed against the application, or if opposition is unsuccessful, the trademark will be registered.

Registration

Trademarks Registry of India will thereafter send a Certificate of Registration and record the details of the trademark in the Register of Trademarks. The trademark will be registered from the date of filing of application, not from the date it was examined or accepted.

Renewal

The term of protection of a trademark is unlimited. However, it has to be renewed every ten years from the date of filing to keep it alive. Non-use of the trademark for a period of five years would result in loss of the trademark