

TRADEMARK REGISTRATION AND INFRINGEMENT PRACTICES IN INDIA

A comprehensive guide





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PREFACE



A trade mark (commonly referred to as a brand name in layman's terms) is a visual symbol that can be a word to identify the source of the goods, a name, device, label, numerals, or colour combination to distinguish it from other similar goods or services coming from another source. It is a distinguishing mark that shows certain products or services are made or offered by a particular individual or business. Its history begins in antiquity, when artisans imprinted their "marks" or signatures on decorative or functional items. These marks developed into the system of trade mark registration and protection that exists today over time.

By guaranteeing the owner's exclusive right to use it or granting another party permission to do so in exchange for payment, a trade mark offers protection to the mark's owner. A trade mark may be renewed indefinitely after the time limit has passed by paying additional fees, though the duration of protection varies. The courts, who typically have the power to prevent trade mark infringement, are responsible for enforcing trademark protection.

In a broader sense, trademarks encourage initiative and business endeavor by bringing fame and financial gain to their owners. The use of similar distinctive signs by unfair competitors, such as counterfeiters, to market inferior or unrelated goods or services is also hampered by trade mark protection.

ECONOMIC OVERVIEW

In the financial year 2023, around 256 thousand industrial trademarks were registered in India. The Office of the Controller General of Patents, Designs, and Trade Marks ("CGPDTM"), a subordinate office under the Department of Industrial Policy and Promotion looks into the filings of various Intellectual Property rights in India.

The use of trademarks by manufacturers helped them expand the market for their products through advertising and other promotional efforts. While the value of trademarks increased, competitors began dishonestly copying or stealing the trademarks of well-known firms after they realized the benefits that came along with them, like reputation, a seal of quality, and goodwill. The need for trademark protection was addressed, which resulted in the acceptance of trademark law on a global scale. As a result, the Paris Convention for the Protection of Industrial Property, the first international agreement, was ratified in 1883.



TYPES OF TRADEMARK

SERVICE MARK

Any symbol, name, sign, device, or word that is purposefully used in commerce to identify and set one provider's services apart from others is known as a service mark. Service marks only apply to the distribution of services and do not cover tangible goods. Everyday services include the following:

- Sponsorship
- Hotel services
- Entertainment services
- Speed reading instruction
- Management and investment
- Housing development services

A service mark is expected to play a critical role in promoting and selling a product or service. A product is indicated by its service mark, and that product's service mark is also known as a trademark.

COLLECTIVE MARK

A collective mark is used to communicate to the general public specific distinctive characteristics of a good or service used to represent a collective. This mark can be used by a group of people to collectively protect a good or service. The mark holder may be a Section 8 Company, a public institution, or an association. In a collective mark, the regulator responsible for the mark often sets the standards of the products. Others connected to the collective are expected to follow particular rules while utilizing the mark for commercial purposes. Chartered Accountant is a collective brand that is well-known in India.



CERTIFICATION MARK

A certification mark is a symbol used by the owner to indicate a product's origin, material, quality, or other specified information. The fundamental function of a certification mark is to highlight the product standard and provide buyers with assurances about the goods. A certification mark can also be used to raise customer expectations of a product by demonstrating that it has completed rigorous quality control testing. Typically, gadgets, toys, and packaged foods bear certification marks.



SHAPE MARK

Shape Marking is only used to safeguard a product's shape so that consumers can relate to it and choose to purchase it from a particular producer. Once a product is acknowledged to have a distinctive shape, its shape can be registered. The Coca-Cola or Fanta bottles, which have a particular shape associated with the brand, are examples of shapes.

PATTERN MARK

Pattern marks are those products that have specific designed patterns that come out as the distinguishing factor of the product. Patterns which fail to stand out as a remarkable mark is generally rejected since it does not serve any purpose. For a pattern to be registered, it has to show evidence of its uniqueness.

TRADE DRESS

Trade dress refers to distinguishing characteristics of a commodity or business, such as packaging components, home accents, and other ideas of a like nature. Product features typically fall under trade dress protection rather than a specific sort of trademark for legal protection. The case for trade dress protection is compelling if a consumer associates a certain feature or features with a brand or firm rather than the actual goods.



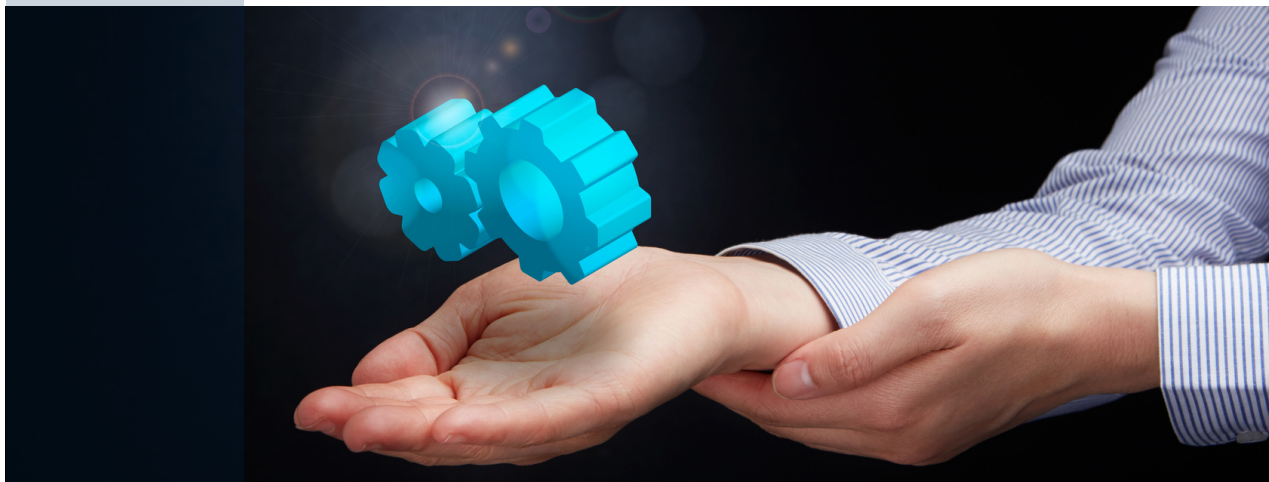
SOUND MARK

Sound mark is a sound that can be associated with a product or service originating from a certain supplier. To be able to register a sound mark, when people hear the sound, they easily identify that service or product or a show that the sound represents. Sound logos are called as audio mnemonic and is most likely to appear at the beginning or end of a commercial. The most popular sound mark in India is the tune for IPL.

Designation of trademark

- TM (TM is used for an unregistered trademark. It is used to promote or brand goods).
- SM (SM used for an unregistered service mark. It is used to promote or brand services).
- R (letter R is surrounded by a circle and used for registered trademark).

PROCESS OF REGISTRATION OF A TRADEMARK



1) Trademark Search- The business owner or a trademark expert must search the trademark database before starting the trademark registration procedure. A trademark search will identify whether a similar or identical trademark has previously been registered with the trademark registry.

2) Trademark Filing- The application for trademark registration can be submitted to the Trademark Registrar following the completion of a trademark search. The trademark registration application must be submitted in the required format and include the appropriate filing fee. Applications for trademarks may be submitted online or at one of the five Trademark Registrar Offices with jurisdiction over the State. IndiaFilings.com, a trademark agency, or a lawyer can file trademark applications online.

The following details must be included in a trademark registration application:

- Logo or trademark,
- The trademark owner's name and address,
- Classification or Trademark Class Trademark used as of the date,
- Details of the goods or services.

3) Allotment of Trademark Applications- Within one or two working days of the trademark registration application being submitted to the trademark registrar, a trademark application allocation number is given. The trademark owner can often add the TM symbol next to the logo after receiving the trademark application allotment number.

4) Vienna Codification- The figurative components of trademarks are categorized internationally by the Vienna Classification or Vienna Codification, which was established by the Vienna Agreement (1973).

The brand Registrar will classify the brand based on its figurative features once the trademark registration application has been submitted.

5) Trademark Examination- After Vienna Codification is finished, a Trademark Officer in the Trademark Registrar Office will be assigned the trademark registration application.

A trademark examination report would subsequently be issued once the trademark officer has checked the trademark application for accuracy. The Trademark Officer can approve the trademark registration application and permit trademark journal publication, or they can object to the application.

If the Trademark Officer objects to the trademark registration application, the trademark applicant has the opportunity to appear before the Trademark Officer and respond to the objections.

If the trademark officer accepts the trademark applicant's explanations, the trademark would be approved for trademark journal publication. If the justifications are rejected by the trademark officer, the applicant may appeal.

6) Publication in a Trademark Journal- The proposed trademark is made public in the Trademark Journal following the Trademark Registrar's approval of the trademark registration application.

All the trademarks that the Trademark Registrar has approved are listed in the trademark journal, which is published every week. The public has the chance to object to the trademark registration when it is published in the trademark journal if they feel that registration will harm them.



The mark will normally be registered in 12 to 16 weeks if no objections are lodged within 90 days of that publication.

The Trademark Hearing Officer will schedule a hearing if someone files a trademark registration application that is contested by another party.

The opportunity to appear at the hearing is given to both the trademark applicant and the opposing party.

7) Registration of trademarks- The trademark manuscript and trademark registration certificate will be prepared and given to the trademark application after there is no opposition or objections to the trademark registration application.

When the trademark registration certificate is given, the mark is regarded as the owner's registered trademark, giving them the sole right to use the mark. Now, the trademark or logo can be positioned next to the ® symbol.



LICENSES AND REGISTRATION

The licensing of intellectual property is an important factor. Licensors, who are the owners of intellectual property rights, provide licenses to licensees who are the users of such rights. In exchange for an agreed-upon sum of money known as a royalty, the rights may include those in a trademark, patent, copyright, or design. This is now standard procedure for both the licensor and the licensee.

TRADEMARK LICENSING

According to Section 2(1)(v) of the Trademarks Act, 1999 (hereinafter referred to as the "Act"), a registered proprietor (licensor) who is currently listed in the register as the owner of a trademark grants a license to a registered user (licensee) who is currently listed as such under Section 49 of the Act or a third party with the registered proprietor's consent.



TYPES OF USERS OF TRADEMARK

There are two types of users of Trademarks-

1) Registered user- The intended registered user and registered proprietor must apply to the trademark registrar jointly in order to be referred to as a registered user. They are allowed to file an individual lawsuit for infringement.

2) Unregistered user / Permitted user- No application needs to be submitted to the Registrar of Trademarks. They are not permitted to file a claim for infringement on their own behalf.



PROCESS OF REGISTRATION AS REGISTERED USER

Step 1: The Registered Proprietor and Proposed Registered User must submit a joint application.



The proposed registered user and the registered proprietor must jointly submit an application in writing to the Registrar in Form TM-U when it is suggested that a person be registered as a registered user of a trademark. This must be submitted within six months after the date of the agreement for the authorized use of a trademark, in accordance with Rule 86 of the Trademark Rules, 2017 (hereinafter referred to as "Rules, 2017").

Step 2: Registrar's entry of registration in Register

The proposed registered user will be registered in respect of the goods or services for which the Registrar is satisfied and will be published in the Journal after the Registrar is satisfied that all requirements specified in section 49(1) are fulfilled.

Step 3: Registration communication

According to Rule 90 of the Rules, 2017, the Registrar must notify the registered proprietor of the trademark, the registered user, and each other registered user whose name is recorded in relation to the same trademark in writing of the registration of a registered user. Within three months after such inclusion in the register, it must also be placed in the Journal

In accordance with section 49(4) of the Act, the Registrar takes action to ensure that information provided for application purposes under this section (other than issues put in the register) is not disclosed to competitors in the market.

TRADEMARK INFRINGEMENT

In India, trademarks are protected by the Trademarks Act of 1999, sometimes known as the Act. The Act outlines the procedures for registering trademarks and providing for their protection as well as outlining the consequences of trademark infringement. Worldwide, trademarks are recognized as intellectual property. To safeguard intellectual properties like trademarks, numerous national and international organizations exist.



The Indian Patent Office, which is run by the Controller General of Patents, Designs, and Trademarks, is the organization in India responsible for protecting trademarks. Trademark infringement, to put it simply, is the unauthorized use of a mark that is identical to or confusingly like a registered trademark. When a typical consumer looks at the mark, it will appear to be deceptively identical.

PENALTIES FOR TRADEMARK INFRINGEMENT

As a cognizable offense in India, trademark infringement carries the possibility of both civil and criminal penalties for the offender. Additionally, according to Indian law, the trademark need not be registered in order to initiate civil or criminal procedures. This is because of the common law doctrine of passing off, as was previously mentioned.

The following remedies may be granted by the court in cases of trademark infringement or passing off:

- 1)Permanent injunction
- 2)Permanent prohibition
- 3)Damages
- 4)Account merch fits (damages equal to profits made from the violation, less damages)
- 5)Destruction of merchandise with the infringement mark
- 6)The cost of court cases

In a criminal case, the court will impose the following punishment:

Including imprisonment for a minimum of six months and a maximum of three years, as well as a fine ranging from Rs 50,000 to Rs 2 lakh.

HOW WE CAN HELP ?

Filing Trademark Applications: Our team of professionals can help individuals and businesses with the entire process of filing trademark applications. They can assist in preparing and filing the application, ensuring that it meets all the legal requirements and includes the necessary information and documents.

Trademark Examination and Response: After filing the trademark application, the trademark office examines it for compliance with legal standards. If any objections or concerns arise during the examination, our team can help draft and file a suitable response, addressing the objections raised by the examiner and advocating for the registration of the trademark.

Trademark Opposition Proceedings: In case of third-party opposition to the registration of a trademark, our team of professionals can represent the client in opposition proceedings. They can prepare and file the appropriate response, gather evidence, present arguments before the relevant authorities, and protect the client's interests.

Trademark Renewals: Our team can assist in monitoring and managing trademark renewals. They can keep track of renewal deadlines, prepare and file renewal applications, and ensure the timely renewal of trademarks to maintain their protection.

Trademark Infringement and Dispute Resolution: If a trademark owner faces instances of infringement or unauthorized use, our team can help enforce their rights. This may involve sending cease-and-desist notices, initiating negotiations for settlement, filing infringement suits, or representing the client in alternative dispute resolution mechanisms like mediation or arbitration.

Trademark Litigation: In cases where disputes escalate, our team can represent the client in trademark litigation before the appropriate courts. They can prepare and file the necessary legal documents, present arguments, and advocate for the client's position in court.

Trademark Licensing and Assignment: Our firm can assist in negotiating and drafting trademark licensing agreements and assignments. Our team can help structure agreements, draft terms, and conditions, ensure compliance with legal requirements, and protect the interests of the parties involved.

SERVING CLIENTS WORLDWIDE



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