

# GETTING TRADEMARK REGISTRATION IN INDIA (THE COMPLETE PROCESS)

## Getting Trademark Registration In India – The Complete Process

In every market, the manufacturer of goods or service provider cannot compromise on the quality of the goods produced or services provided. The consumer is ultimately satisfied by the quality of the product or service; nothing else.

Yet, the manufacturer or service provide need to ensure that the consumer regularly choose his product or service. In order for that, the consumer needs to identify that the goods or service he intends to purchase or avail actually belong to the manufacturer or service provider.

So, the interest of both the manufacturer and the consumer can best be protected if the goods or services bear a unique mark which marks out their origin. Such a symbol is called a trademark. The trademark is used by the trademark owner to distinguish his goods or services from his competitor's goods or services. The trademark which does so, require protection under law so as to prevent others from using the same and exploit the market and cheat the costumer.

In India the law relating to Trademarks is now contained in the Trademarks Act, 1999. The earlier Trade and Merchandise Marks Act, 1958 has been repealed by Section 159 of the Trade Marks Act, 1999. The Act provides for the registration of Trademarks, Collective Marks and Certification Trademarks. Along with the Act, the Trademark Rules, 2002 supplement the regulation of Trademark protection in India.

Trademarks are also covered by International Law. The following International conventions and treaties cover trademarks:

1. The TRIPS Agreement
  2. Paris Convention for the Protection of Industrial Property, 1967.
  3. Nice Agreement concerning the International Classification of Goods and Services for the purposes of Registration of Marks, 1957.
  4. Madrid Agreement Concerning the International Registration of Marks, 1891 (revised at Stockholm in 1967)
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5. Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989
6. Trademark Law Registry, Geneva, 1994
7. Regulations Under Trademark Law Treaty, Geneva, 1994
8. The Vienna Agreement established on international Classification of the Figurative Elements of Marks, 1973

The Trademark is a visual symbol in the form of a word, a device or a label applied to articles of commerce with a view to indicate the buyer that the goods are manufactured by a particular person as distinguished from similar good manufactured by others.

For any business, protecting its intellectual property is as important as safeguarding its tangible assets; especially its trademarks; as trademarks convey reputation and brand value; and reputation and brand value generate business and consequently it generates revenue.

Section 2 (zb) of the Trademarks Act, 1999 defines the expression “Trademark”:

" trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; and-

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

The TRIPS Agreement in Article 15 Paragraph 1 enshrines:

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Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

After going through the definition as per the Act the following aspects concerning a trademark come to light:

- i. The trademark must be capable of graphical representation.
- ii. The trademark must be capable of distinguishing the goods or services of one person from those of others
- iii. The trademark may be or include shape, packing, combination of colours.
- iv. It must be used or proposed to be used in relation to goods or services.
- v. The use must be for the purpose of indicating a connection in the course of trade between the goods or services and some persons having the right as proprietor to use the mark.
- vi. It includes a “Certification Mark”
- vii. It includes a “Collective Mark”

The Act of 1999 also recognises the following additional marks; according them protection:

### **1. Service marks**

Section 2 (z) defines service:

"service" means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising;

### **2. Well-known trademark**

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Section 2 (zg) defines what constitutes a well-known mark:

"well-known trade mark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or service would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first- mentioned goods or services.

This document provides an overview on the complete process of trademark registration in India; indicating the statutory authorities, the procedure and relevant documents.

## **Registration of Trademark In India**

### **Statutory Authorities**

The statutory authority under the Trade and Merchandise Marks Act, 1958 is the Controller-General of Patents, Designs and Trade Marks. A Joint Registrar, Deputy Registrars, Assistant Registrars, Examiners of trademarks and a compliment of ministerial staff assist the Controller-General in the discharge of his functions. The Joint Registrar, Deputy Registrar and Assistant Registrars exercise the powers as the Registrar delegates to them.

The Trademarks Registry established under the Trade and Merchandise Marks Act, 1958 is the Trademarks Registry in respect of functions of Registrar of Trademarks under the Trademark Act, 1999.

Besides, the Central Government has established the Intellectual Property Appellate Board which sits at Chennai by a notification with effect from 15<sup>th</sup> September, 2003.

### **The Trade Marks Registry**

The Trade Marks Registry has its Head Office at Mumbai and Branch Offices at Calcutta, New Delhi, Madras and Ahmedabad having territorial jurisdiction on a zonal basis. The applications for registration are to be filed in the office within whose territorial jurisdiction the applicants' principal place of business is situated.

According to **Rule 3** of the Trademark Rules, 2002, principal place of business means:

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- (i) where a person carries on business in the goods or services concerned in a trade mark-
  - (a) if the business is carried on in India at only one place, that place;
  - (b) if the business is carried on in India at more places than one, the place mentioned by him as the principal place of business in India;
- (ii) where a person is not carrying on a business in the goods or services concerned in a trade mark -
  - (a) if he is carrying on any other business in India at only one place, that place;
  - (b) if he is carrying on any other business in India at more places than one, the place mentioned by him as the principal place of business in India; and
- (iii) where a person does not carry on any business in India but has a place of residence in India, then such place of residence in India.

All opposition and rectification applications are to be filed where the application for registration was filed.

### **Registrar of Trade Marks**

The Registrar of trade Marks is the authority responsible for the registration of trademarks, settling opposition proceedings and rectification of the Register.

### **The Register of Trademarks**

It is the official record of registered trademarks. Section 6 (1) of the Trademarks Act, 1999 mandates that for the purposes of this Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trademarks with the names, addresses and description of the proprietors, notifications of assignment and transmissions, the names, addresses and descriptions of registered users, conditions, limitations and such other matter relating to registered trademarks as may be prescribed.

As per Section 6 (6) there shall be kept at each branch office of the Trade Marks Registry a copy of the register and such of the other documents mentioned in section 148 as the Central Government may, by notification in the Official Gazette, direct.

According to Section 6 (2), it shall be lawful for the Registrar to keep the records wholly or partly in computer floppies diskettes or in any other electronic form subject to such

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safeguards as may be prescribed. Consequently, the eRegister is accessible online and the status of a Trademark can be search online:

<http://ipindiaservices.gov.in/eregister/eregister.aspx>

### **Classification of Goods and Services**

The Fourth Schedule to the Trademark Rules, 2002 enlists a classification of goods and services into 45 classes. There are 34 classes of goods and 11 classes of services. The applicant has to identify the class under which the particular trademark shall fall and the application should mention the class for which the trademark protection is sought for. For a complete list of classes of goods and services as mentioned in the Trademark Rules, 2002; visit: [http://ipindia.nic.in/tmr\\_new/Classification\\_Goods\\_18June2010.htm](http://ipindia.nic.in/tmr_new/Classification_Goods_18June2010.htm)

### **Submission of Application**

The process of registration of trademark commences with the submission of an application. Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark (S. 18 (1) of the 1999 Act). A single application may be made for registration under different classes; but the fee applicable would be as to each class for which the protection is sought for.

The application should contain the following particulars:

- i. The class and goods or services for the class in respect of which the application is furthered
- ii. Full name, description of occupation and calling and nationality of the applicant.
- iii. Principal place of business in India
- iv. Address for service in India when neither place of business nor residence of the applicant is in India.
- v. Statement relating to colour combination
- vi. Statement, if the mark is three dimensional.

The application for registration of trademarks shall be made in forms (Schedule II of the Trademarks Rules, 2002):

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TM-1 (Application for registration of a trade mark for goods or services (other than a collective mark or a certification trade mark))

TM-2 (Application for registration of a trade mark from convention country (other than a collective mark or a certification trade mark))

TM-3 (Application for registration of a collective mark)

TM-4 (Application for registration of a certification trade mark)

TM-8 (Application for registration of series trade marks for goods or services in a class or different classes)

TM-22 (Application to register a textile trade mark (other than a certification trade mark or a collective mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule under rule 145)

TM-37 (Application in respect of series trade mark from convention countries under section 154(2) 26 & 31 for goods or services in a class or for different classes)

TM-45 (An application to register a textile trade mark (other than a collective mark or certification trade mark) consisting exclusively of numerals or letters or any combination thereof for a specification of goods or services included in one item of the Fifth Schedule from a convention country)

TM-51 (A single application under section 18(2) for rule 25(9) registration of a trade mark for goods or services in different classes)

TM-52 (A single application u/s 18(2) for registration rule 25(4) of a trade mark from convention country u/s 154(2))

TM-61 (Application for inclusion of specification of goods or services in excess of five hundred characters)

TM-64 (Application to register a collective mark for rule 128(1) a specification of goods or services included in a class from convention country under section 154(2))

TM-65 (Application under section 71 to register a Certification trade mark for a specification of goods or services included in a class from convention country under section 154(2))

TM-66 (Single application for registration of a collective trade mark for different classes of goods or services)

TM-68 to 69

For a list of prescribed forms and fees particular to individual class and purpose, visit:

[http://ipindia.nic.in/tmr\\_new/first\\_schedule\\_forms/the\\_first\\_schedule.htm](http://ipindia.nic.in/tmr_new/first_schedule_forms/the_first_schedule.htm)

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The application can also be signed by the agent of the applicant. A single application can be made for different class of goods or services included in any one class from a convention country. A single application can be made for a series of trademarks.

Every application for registration of a trademark shall contain a representation of the mark in the space provided in the application form for the purpose. Ten additional representations of the mark have to be supplied with the application.

### **Where The Application Is To Be Filed**

The application is to be filed in the office of the Trademark Registrar within whose territorial jurisdiction the principal place of business in India of the applicant or in the case of joint applicants, the principal place of business in India, of the applicant whose name is mentioned first in the application, is situated.

### **Convention Country Applications (S. 154 of the Trademarks Act, 1999)**

With a view to the fulfilment of a treaty, convention or arrangement with any country or country which is a member of a group of countries or union of countries or Inter-Governmental Organisation outside India which affords to citizens of India similar privileges as granted to its own citizens, the Central Government may, by notification in the Official Gazette, declare such country or group of countries or union of countries or Inter-Governmental Organisation to be a convention country or group of countries or union of countries or Inter- Governmental Organisations, as the case may be, for the purposes of this Act. (S. 154 (1))

Every such application from the convention country in which an application for trademark registration has been made, shall state the date of that application and the applicant shall furnish a certificate by the Registrar or other registering authority of that country or shall otherwise verify the application made therein to the satisfaction of the Registrar. A convention application must be filed in India within 6 months of filing the application in the convention country (S. 154 (2) of the 1999 Act)

### **Outcomes of Application**

There can be the following four outcomes upon submission of an application for registration of trademark:

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1. The application is accepted as it is.
2. The application is accepted subject to certain amendments.
3. The application is accepted but later it is found to have been accepted in error.
4. The application stands rejected.

The application is thus accepted completely or is accepted subject to amendments or rejected completely. If the application is accepted in error; the communication with this regard is sent within two months and the applicant has to comply with the suggested amendment. In case the applicant does not comply then the application is considered withdrawn and no further action is taken. If the applicant complies then the amendment is effected or a hearing is held and further decisions are taken and appropriate orders are issued.

### **Advertisement & Re-Advertisement**

As soon as an application is received by the Registrar and the same has been accepted absolutely or subject to conditions, he shall, after the acceptance, cause the application to be advertised in the Trade Marks Journal. (S. 20 of the 1999 Act)

The Registrar may, in his discretion, cause the re-advertisement of an application; where an application has been advertised before acceptance or where after advertisement of an application (i) an error in the application has been corrected; or (ii) the application has been permitted to be amended under section 22 or may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or amendment made in the application.

### **Opposition To Registration**

According to Section 21, any person may within 4 months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing along with required fees (Schedule I to Rules of 2002), to the Registrar, of opposition to the registration. The registrar then shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the

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grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application. (S. 20 (2) of the Act of 1999).

If the applicant files a counter statement (TM-6), the Registrar shall serve a copy thereof on the person giving the notice of opposition.

### **Hearing of the Parties**

The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not. (S. 21 (5))

### **Registration of Trademark (S. 23)**

When the application has been accepted and either:

(1) Subject to the provisions of section 19, when an application for registration of a trade mark has been accepted and either-

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall, unless the Central Government otherwise directs, register the said trademark and the trademark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 154, be deemed to be the date of registration.

### **Duration of Trademark Registration; Removal and Restoration (S. 25)**

The registration of a trade mark is for a period of ten years, but may be renewed for a period of ten years from the date of expiration of the original registration or of the last renewal of registration, as the case may be.

The Registrar may remove the trademark from the Register, if conditions prescribed in the notice intimating the date of renewal, has not been fulfilled. Where a trade mark has been removed from the register for non- payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if

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satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

**PROCEDURE FOR REGISTRATION (FLOW CHART)**

