



WEEK DAY PROGRAMME OF  
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# TRADE MARKS REGISTRATION IN INDIA - AN OVERVIEW

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# WHAT ARE TRADE MARKS ?

- Trade Marks are words/designs that identify and distinguish the products/goods/services of one person from others.
- They provide a distinct identity to goods/services of the proprietor in the market so that they can stand out from the rest.

- Is registration of a Trade Marks mandatory ?

- No.

- Consequences of non registration:

Only a proprietor of Registered Trade Mark can take action for infringement under the Trade Marks Act, 1999. A holder of Unregistered Trade Mark can only sue third parties under common law for passing off goods/services as that of the holder of the unregistered Trade Mark to gain advantage in the market based on goodwill. But establishing passing off itself can be difficult and therefore registering is advisable.

# USAGE OF “TM” AND “®”

- “®” stands for “Registered”
- “TM” stands for a claim on right to usage. Most of the times it is used when the application for Trade Mark is in process and pending.

# TYPES OF TRADE MARKS



## WORD MARKS

- What is a word mark ?

Is a set of letters, usually the business entity name which stands for a brand name. Being a set of letters, protection is for the word which can be represented in any way. No body can use the set of letters in the same order other than the proprietor/with his consent.

## DEVICE MARKS

- What is device mark ?

Logo consisting of set of words, with or without a pictorial representation but in a specific style. Copyright application advisable for original artistic work of design. Copyright protects the design itself thereby stopping people from using the design itself irrespective of the purpose.

- Word mark stands for a name/word while device mark stands for a design

## SOUND MARKS

- These deal with registration of a particular series of musical notes with or without words. Herein the subject of registration is the distinctive tune.  
Mostly signature tunes associated with goods/services

Ex. Britannia Biscuits, Nokia tune, etc.

## 3 DIMENSIONAL MARKS

- Deal with packaging/shape of the product which is used to sell the goods.  
Graphical representation required. Distinguish the product from others.

Ex. Contour Coco Cola bottle, Super Cub Scooter of Honda

## SERIES OF MARKS

- The proprietor reserves the right to use a part of the mark separately in respect of new marks.

Ex. UberEats, UberGo, UberPool, etc

## COLLECTIVE MARKS

- Distinguishes the goods/services of members of an association of persons. The association will be the proprietor of the mark.

Ex. CS logo of ICSI

## CERTIFICATION TRADE MARKS

- Distinguishes the goods/services certified by the proprietor from others

Ex. ISI – Indian Standards Institution, AGMARK – Agricultural Marketing



# WHO CAN APPLY ?

- Any business entity
- Individual/partnership firm (registered/  
unregistered)
- LLP/Companies, etc.

# SEARCH - METHODOLOGY

- Before making an application, public search to be conducted in respect of similar marks to locate conflicts if any.
- Search to be conducted in the same classes which are relevant in respect of the application to be made and also related classes.
- In case of conflicting marks the applicant can be advised to make relevant changes to avoid the conflict on making applications.

# NICE CLASSIFICATION OF GOODS & SERVICES/ACTIVITIES

- There are around 45 classes to select from. Classes 1 to 34 deal with goods classification while 35 to 45 deal with service classification.
- Separate application will be required for each class. Registry fees will also be charged separately even in case of multi class application.

# DOCUMENTS REQUIRED FOR APPLICATION

- Logo/design/ word mark/MP3, pictorial representation of music notes, etc.
- POA – power of attorney for making application and appearances.
- Board Resolution/Governing Body resolution
- Notorised User affidavit with documentary proof/evidence of usage in case the mark is already being used like invoices with the mark, details of expenses incurred /revenue generated which can be attributed to the mark to establish standing in market
- Payment of fees as prescribed. Amount of fees depends on the structure of the applicant. For MSME/Start ups/individual/sole proprietor the fees is comparatively low.

# PRECAUTIONS TO BE TAKEN WHILE MAKING APPLICATIONS

- POA is to be specific power of Attorney
- In case of registered partnership, Partnership Deed to be attached
- In case of Company, Incorporation Certificate to be attached
- In case of MSME/Start Up, certificate to be attached
- NOC wherever applicable to be attached
- Words which are generic in nature to be avoided like rice, toys, textile , etc.
- Distinct identity to be focused on to avoid objection
- Applications can be in respect of proposed or used marks.
- In case of used marks priority dates will be relevant and proofs to be attached.
- If the application is made in black and white all color combinations get covered in case of device marks.
- Better to substitute multi class application with separate individual applications to avoid delay

# PROCESS OF REGISTRATION IN BRIEF - STAGES

- 1) Conducting search for availability.
- 2) Filing of Application along with representations and other annexures.
- 3) Receiving of Application Number.
- 4) Formalities check failure
  - Corrections to be carried out, in case of clerical errors/mistakes in application are pointed out by the Registry
- 5) Modification of application
  - Classification changes, changes in logo, changes in application form, modifications suggested by the Registry to be incorporated

# PROCESS OF REGISTRATION IN BRIEF CONTD.

- 6) Examination report-Grounds for objections
  - absolute grounds – most common is usage of generic names/description of goods/services
  - relative grounds – comparison with other conflicting marks, explanation/reply to be submitted
- 7) Hearing
  - if the Registry is not satisfied with the reply given for objection a hearing may be fixed where explanation can be provided in person
- 8) Advertised
  - Published in gazette inviting opposition from public once the objections of the Registry have been addressed and satisfied

# PROCESS OF REGISTRATION IN BRIEF CONTD.

- 9) Accepted
  - if no oppositions are received from public then accepted.
- 10) Registered
- 11) Certificate of Registration
  - takes around two years
  - valid for 10 years from application date
- 12) Objections/oppositions/Refusal
  - if the Registry is not satisfied with submissions/public oppositions not settled in favour, application for review can be made to the registrar.
  - Appeal can also be made to the Intellectual Property Appellate Board



# WHERE COMPANIES ACT AND TRADE MARKS MEET ....

- 1) How to conduct search for company name application?
  - Public search of trade marks to be conducted in respect of the classes closest depending upon the objects of the Company.
  - reason for this is to avoid confusion in respect of the product identity in the mind of the consumer
  - apart from letters, phonetic effect also is to be considered
  
- 2) Safeguards while selecting activities considering MOA of the Company while making Trade Marks Application by a Company
  - The MOA can have any number of objects but activities of the Company to be considered depending upon the NICE classification while making an application.
  - there is no restriction in using the same mark in respect of different activities but the applications will be construed as separate and the Rules to be followed.

# THE GREATEST CHALLENGE !

- ❖ Interpretation of marks/ depictions
- ❖ Establishing distinctiveness





*Thank You !!*

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