



# The Indian Journal for Research in Law and Management

Open Access Law Journal – Copyright © 2024

Editor-in-Chief – Dr. Muktai Deb Chavan; Publisher – Alden Vas; ISSN: 2583-9896

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## TRADEMARK REGISTRATION PROCESS IN INDIA

- *Srivaasthi M*

### INTRODUCTION

Trademarks safeguard a company's identity and goodwill in the market. In the Indian legal framework, the Trade Marks Act of 1999 and Rules of 2017 oversee trademark registration. This guide offers a thorough tour of registering a trademark in India, elucidating what trademarks encompass and covering the registration process step-by-step.

### WHAT IS A TRADE MARK?

A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.

It is considered an effective tool of the competitive economy in which there is competition for the manufacturing of the same product, which makes it important for the manufacturer to mark their goods or services, which would make their goods stand out in the market.

### IMPORTANCE OF REGISTRATION OF TRADEMARK

A registered trademark prevents the unauthorized use of company or individual products or services. It also helps the customers identify a brand's products or services, helping them recognize the brand on the market and distinguish it from its competitors. Registration confers exclusive rights to the trademark owner.

It provides a legal basis to enable owners to enforce their rights and prevent others from using identical or deceptively similar marks on related goods or services.<sup>1</sup>

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<sup>1</sup> Yiteng Feng, Analysis of the Advantages of Trademark Registration Offer Compared with Relying on Unfair Competition or Passing-off to Enforce Rights over Trademarks, 2023

It ensures that a brand's image and reputation remain untarnished nationally, minimizing the chances of consumer confusion or diminishing brand uniqueness.<sup>2</sup>

## **REGISTRATION PROCESS OF TRADEMARK**

### **STEP 1 - CLASSIFYING TRADEMARKS**

To begin the trademark registration process, businesses must first categorize their trademarks under predefined categories based on the NICE Classification System. Nice Classification System has 45 classes; classes 1-34 correspond to goods, and classes 45–46 correspond to services.

### **STEP 2: SEARCH FOR TRADEMARKS**

Conducting a thorough trademark search is a crucial step before beginning the trademark registration process. In this step, local and international databases are searched to see if any marks are similar or identical, which could make it difficult for you to register the mark you want. In addition to reducing the possibility of objections during the examination and review process, a thorough trademark search aids companies in making defensible decisions regarding the distinctiveness and commercial potential of their selected mark.

### **STEP 3 – APPLICATION FOR REGISTRATION**

#### Essential Conditions:

The applicant has to file three copies of the application, along with the required documents.<sup>3</sup>

The trademark should be 8 cm by 8 cm in dimensions, and five copies of it have to be submitted in color or in black and white.

If it is a combination of colors, then at least one copy should be in color. Proper description of trademarks is very necessary. If the description is unsatisfactory, the registrar can call for a sample for the purpose of examination. If the trademark or trade name is in another language other than English, the translation should also be given, failing which the application can be considered as non-compliant or abandoned as per the circumstances.

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<sup>2</sup> Bone, R. G, Enforcement costs and trademark puzzles, Virginia Law Review, 2099-2185, (2004)

<sup>3</sup> [3] The Trademarks Act 1999, § 18, Acts of Parliament, 1999 (India).

The applicant can be a proprietor who uses or proposes to use the trademark who can be a natural person, a corporate body, a partnership firm, a Hindu undivided family, or any other association. It can also be a trust, society or a government body.

#### **STEP 4: PAYMENT OF FEES**

The applicant must submit the required fee payment with the application after it has been filed. These fees pay for the expenses of handling the application, holding the test, and performing other administrative duties. Additionally, applicants must be aware of the fees that apply to them based on the nature of their company and the number of classes for which they want to register their trademark.

#### **STEP 5: EXAMINATION OF THE APPLICATION**

The application, once filed, undergoes a formal examination where the examiner reviews the application for any discrepancies and ensures compliance with the requirements. An examination report is issued, highlighting any objections or issues found which are based on the following grounds

- Absolute Grounds: The trademark lacks distinctiveness, is descriptive, or is deceptive.<sup>4</sup>
- Relative Grounds: The trademark is similar to an existing registered mark.<sup>5</sup>

#### **STEP 6: WITHDRAWAL OF ACCEPTANCE.**

When the registrar is satisfied that the application has been accepted in error or the trademark should not be registered or should be registered under different or additional conditions, they may withdraw the acceptance and treat the application as if it had not been accepted after hearing the applicant if desired.

#### **STEP 7: PUBLICATION AND OPPOSITION OF THE TRADEMARK REGISTRATION**

The Registrar advertises the same as per Section 20 of the Act, and whoever wishes to oppose the registration should, within 3 months, file his opposition in writing as per Section 21. Now, this copy of opposition is also sent to the applicant by the registrar, and within 2 months, the

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<sup>4</sup> The Trademarks Act 1999, § 9, Acts of Parliament, 1999 (India).

<sup>5</sup> The Trademarks Act 1999, § 11, Acts of Parliament, 1999 (India).

applicant is expected to file his counterstatement defending his trademark along with the evidence, failing which the application for trademark is considered to be abandoned.

### **STEP 8: REGISTRATION OF TRADEMARK AND RENEWAL**

The registrar gives a registration certificate to the applicant once it is accepted as per Section 23 (2), which has a seal of trademark registry. The trademark protection is for a period of 10 years as per Section 25, and it can be renewed subsequently every 10 years upon payment of appropriate fees. The registrar mentions the details of the registered trademark along with the names, addresses, and other details of the applicant in the register of trademarks under Section 6 of the Act.

As per Section 27, the damages for infringement of a trademark can only be claimed if the trademark is registered as per the provisions of this Act. The only remedy available in such cases where the trademark is not registered is passing off goods.

### **INTERNATIONAL REGISTRATION OF TRADEMARK**

The trademark can also be registered internationally as per the Madrid Protocol. The protection is offered in all the countries which are members of the Madrid Protocol.

The application is to be made in the office of the origin country by filing the international application. The application is then forwarded to the World Intellectual Property Organization to examine the same and further publish and register the trademark.

The Madrid Union decides whether the trademark is to be registered or not and if within 18 months there is no objection, the trademark is deemed to be protected as per Section 154 of the Trademarks Act 1999 of India to grant similar protection to the Indian applicants as well as to the applicants belonging to the convention countries without any discrimination.

The Madrid Protocol offers, amongst other international registration systems, a system through which trademark owners can seek protection in many countries with a single application. So, it is not a only procedural benefit. It shows the brand's intention to be globally recognized and give a sense of security from any imitators that may have a potential claim to the market.<sup>6</sup>

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<sup>6</sup> Gaba, J, International Trademark Registration. *Supremo Amicus*, 21, 456, (2020).

## **LANDMARK JUDGEMENTS RELATING TO REGISTRATION OF TRADEMARKS:**

Vishnudas Kishandas v. Vazir Sultan Tobacco Co. Ltd (1997) 4 SCC 201

The Supreme Court concluded that a trader or manufacturer who deals in only some (but not all) of the goods falling under an abstract classification and who has no bona fide intention to trade in other goods falling within the abstract classification is barred from restraining other traders or manufacturers from registering separate and distinct trademarks for diverse and dissimilar goods under the same abstract classification.<sup>7</sup>

Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd (1955 AIR 558),

A trademark registration of a subsequent composite mark (as was the case here) does not preclude an exclusive right to some word in the composite mark without reference to its use as a whole, and it is surprising that the High Court did not in fact consider the possibility that the respondent might have a statutory claim to Shree, given the trademark registration.<sup>8</sup>

Renaissance Hotel Holdings Inc. v. B. Vijaya Sai and Others

A remarkable step in this direction was taken in 2022, when the Supreme Court of India ruled that: (i) Where a defendant uses a mark, which is identical or deceptively similar in construction and appearance of letters and graphics used to the registered mark of a plaintiff, for dissimilar goods and services falling under a different class or description, the only remedy that can be granted is an injunction. (ii) The nature and reputation of the plaintiff's mark in India, the honesty of a defendant in adopting the mark are irrelevant factors.<sup>9</sup>

N.R. Dongre and Ors. v Whirlpool Corporation And Anr<sup>10</sup>

He also decided that, at the most, the registration of a mark in the trademark registry would be irrelevant in an action for passing off, and that whether the mark in respect of which an action for passing off is brought is registered earlier, or has been registered prior in time to

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<sup>7</sup> Vishnudas Kishandas v Vazir Sultan Tobacco Co. Ltd, (1997) 4 SCC 201

<sup>8</sup> Registrar of Trade Marks v Ashok Chandra Rakhit Ltd, (1955 AIR 558)

<sup>9</sup> Renaissance Hotel Holdings Inc. v B. Vijaya Sai And Others, 2022 LiveLaw (SC) 65

<sup>10</sup> N.R. Dongre and Ors. v Whirlpool Corporation And Anr, Appeal (civil) 10703 of 1996

the appellant's use, is immaterial. The bare fact of a mark or similar mark's being in existence in the register is not evidence of use.

## **CONCLUSION**

The registration of trademarks in India is a critical process for safeguarding the unique identity and competitive edge of businesses. The legal framework, primarily governed by The Trade Marks Act, 1999, ensures that trademark owners can protect their marks against unauthorized use and infringement.

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