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TRADEMARK REGISTRATION: STATUTORY CONDITIONS, LEGAL STANDARDS, AND PRACTICAL CONSIDERATIONS

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INTRODUCTION

Trademark is a branch of intellectual property rights. Intellectual property rights permit people to maintain ownership rights of their innovative product and creative activity. The intellectual property came to light because of the efforts of human labour, so it is limited by a number of charges for the registration and charges for infringement. Types of intellectual property are Trademarks, Copyright Act, Patent Act, and Designs Act.

A trademark includes a name, word, or sign that differentiates goods from the goods of other enterprises. Marketing of goods or services by the procedure becomes much easier with a trademark because recognition of product with the trademark is assured and easier. The owner can prevent the use of his mark or sign by another competitor.

Trademark is a marketing tool which increases financing of the business. A trademark is not always a brand but the brand is always is a trademark. Sometimes there is a confusion between trademark and brand. The brand name can be simply a symbol or logo but the trademark is a distinguishing sign or indicator in a business organization as it has a wider implication than brands. People are more influenced by the distinctive trademark that reflects the quality of the product. A trademark can be a logo, picture mark or a slogan.

TYPES OF TRADEMARKS

Service mark

A service mark is any symbol name, sign, device or word which is intentionally used in trade to recognize and differentiate the services of one provider from others. Service marks do not cover material goods but only the allocation of services. Service marks are used in day-to-day services :

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

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- Housing development services

A service mark is expected to play a critical role in promoting and selling a product or services. 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 by employees and a collective group, or by members of a collaborative association, or the other group or organization to identify the source of goods or services. A collective mark indicates a mark which is used for goods and services and for the group of organizations with similar characteristics. The organization or group uses this mark for more than one person who is acting in a group organization or legal entity for dividing the different goods or services. Two types of collective marks for distinguishing with other goods or services of similar nature¹:

Collective mark indicates that the marketer, trader or person is a part of the specified group or organization. Example – CA is a collective trademark which is used by the Institute of the chartered accountant.

Collective trademark and collective service mark are used to indicate the origin or source of the product.

A collective trademark is used by the single members of a group of an organization but is registered as a whole group. Example- CA is the title or mark which given to the member of Institute of a chartered accountant. That collective mark may be used by the group of association. This was added to the Trademark Act, 1988.

Certification mark

A certificate mark is verification or confirmation of matter by providing assurance that some act has been done or some judicial formality has been complied with. A certification mark indicates certain qualities of goods or services with which the mark is used is certified, a certification mark is defined in the Trademark Act, 1999.²

Certification trade mark means a mark competent of identifying the goods or services in connection with which it is used in the manner of trade, which is certified by the owner of the mark in respect of source, body, mode of manufacturer of goods or performances of assistance, quality, accuracy or other characteristics.

¹ WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), WORLD INTELLECTUAL PROPERTY ORGANISATION, <https://www.wipo.int/amc/en/domains/guide/#a>

² <https://www.domaindisputes.co.za/downloads/NominetCases/PrincevPrinceSports.pdf>

Those goods or services which not so certified and registrable as such under this Act, in respect of those goods or services in the name as the proprietor of the certification trade mark, of that person. Registration of certification mark is done according to the Trademark Act, 1999. Requirements for registration is the product must be competent to certify.

Trade dress

Trade dress is a term that refers to features of the visual appearance of a product or design of a building or its packaging that denote the source of the product to customers.³ It is a form of intellectual property. Trade dress protection is implemented to protect consumers from packaging or appearance of products that framed to imitate other products.

Essential of trade dress

Anything that makes an overall look or overall dress and feel of brand in the market.

The consumer believes that trade dress is the main indicator of differentiation of one brand or goods from others.

The requirement for the registration of trade dress is the same as the registration of the logo, mark. The features in trade dress are size, colour, texture, graphics, design, shape, packaging, and many more.

DESIGNATION OF TRADEMARK

Trademark is designated by:

™ (™ is used for an unregistered trademark.it is used to promote or brand goods).

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).

REGISTRATION OF TRADEMARK

Any person claiming to be the owner of the trademark or supposed to use the trademark by him in future for this he may apply in writing to the appropriate registrar in a prescribed manner.⁴ The application must contain the name of the goods, mark and services, class of goods and the services in which it falls, name and address of the applicant and duration of use of the mark. Here the person means an association of firms, partnership firm, a company, trust, state government or the central government.

³ https://www.mcmdlaw.com/lawyer/2019/03/01/CorporateBusiness-Organization/The-Value-of-Goodwill-and-Your-Brand_bl37322.htm

⁴ <https://www.icann.org/resources/pages/policy-2012-02-25-en>

CONDITIONS OF REGISTRATION

The central government by mentioning in the official gazette appoint a person to be known as the controller, general of patents, designs and trademark who shall be the registrar of the trademark. The central government may appoint other officers also if they think that they are appropriate, for the purpose of discharging, under the superintendence and direction of the registrar, the registrar may authorize them to discharge.

The registrar has the power to transfer or withdraw the cases by in writing with reasons mentioned. Under Section 6 of the Act⁵, discussed the maintenance of a registered trademark. At head office wherein particulars of registered trademarks and other prescribed, particulars, except notice of the trust, shall be recorded. The copy of the register is to be kept at each branch office. It gives for the preservation of records in computer or diskettes or in any other electronic form.

ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION

Absolute grounds for the refusal of registration are defined in Section 9 of the Act. The trademarks which can be lacking any distinctive characteristics or which consists exclusively of marks or signals, which can be used in trade to indicate the kind, fine, quantity, supposed grounds, values, geographical origin.

And also, a time of production of goods or rendering of the offerings or different characteristics of the goods or offerings which consists solely of marks or indications which have come to be average in the present language. That marks are not entitled to registration. Except it is confirmed that the mark has in fact acquired a new character as a result of use before the date of application.⁶

It gives that a mark shall not be registered as trademarks if:

- It frauds the public or causes confusion.
- There is any matter to hurt religious susceptibility.
- There is an obscene or scandalous matter.
- Its use is prohibited.
- It provides that if a mark contains exclusively of

(a) the shape of goods which form the nature of goods or,

(b) the shape of good which is needed to obtain a technical result or,

(c) the shape of goods which gives substantial value of goods then it shall not be registered as trademark.

⁵ <https://www.registry.in/indrp-rules-of-procedure>

⁶ <https://www.marketingmind.in/interbrand-list-of-100-best-global-brands-2020/>

TEST OF SIMILARITY

For the conclusion, if one mark is deceptively similar to another the essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if they are of such a character to prevent one design from being mistaken for the other. It would be enough if the disputed mark has such an overall similarity to the registered mark as it likely to deceive a person usually dealing with one to accept the other if offered to him. Apart from the structural, visual, and phonetic similarity or dissimilarity, the query needs to be viewed from the factor of view of man typical intelligence and imperfect collection secondly. It's regarded as an entire thirdly it is the query of his impressions.

In *Mohd. Iqbal v. Mohd. Wasim*⁷ it was held that “it is common knowledge that ‘bidis’ are being used by persons belonging to the poorer and illiterate or semi-literate class. Their level of knowledge is not high. It cannot be expected of them that they would comprehend and understand the fine differences between the two labels, which may be detected on comparing the two labels are common. In view of the above, there appears to be a deceptive similarity between the two labels”.

RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION

Under Section 11 of the Act, it gives relative grounds for the refusal of registration of a trademark. A trademark cannot be registered if because of

- (i) its identity with an earlier trademark and similarity of goods or services,
- (ii) its similarity to an earlier trade mark and the similarity of the goods and there is a probability of confusion.

It also gives that a trademark cannot be registered which is identical or similar to an earlier trademark. And also, which is to be registered for goods and services which are not similar to those for which earlier trademark is registered in the name of a different proprietor if, or to the extent, the earlier trademark is well known in India. It further gives that a trademark is cannot be registered if, or to the extent that, its use in India is liable to be prevented by virtue of any law.

DURATION OF REGISTRATION

The registrar on the application made by the proprietor of the trademark in the prescribed manner within the given period of time with the adequate payment of fees. Registration of a trademark shall be of ten years and renewal of the registered trademark is also for a period of

⁷ AIR2002MP162

ten years from the date of expiration of the original registration or of the last renewal of registration.

The registrar shall send the notice before the expiration of last registration in the prescribed manner to the registered proprietor. The notice mentions the date of expiration and payment of fees and upon which a renewal of registration may be obtained if at the expiration of the time given in that behalf those conditions have not duly complied with the registrar may remove the trademark from the register.⁸

But the registrar shall not remove the trademark from the register if implication made within the prescribed form and the prescribed rate is paid within six months from the expiration of the final registration of the trademark and shall renew the registration of the trademark for an interval of ten years. If the trademark is 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 trademark renew the registration,

And also, on receipt of implication in the prescribed form and on payment of the prescribed fee the registrar restores the trademark to the register and renew the registration of the trademark, for a period of ten years from the expiration of the last registration.

TRADE MARK REGISTRATION PROCESS

To register a trademark, the owner needs to go through the following steps⁹:

1. Conducting an exhaustive trademark search;
2. Filing an application with necessary documents;
3. Examination of the application by the Trademark Registry;
4. Post examination procedures;
5. Advertisement of the application in the Trademark Journal;
6. Opposition by any third party;
7. Registration and renewal of the same after every 10 years.

Step 1: Trademark Search

This step is very crucial before filing for trademark registration because conducting a detailed search will help a trademark owner to know whether their trademark is unique and distinct in nature and also check whether there is any similar or identical mark already existing or not.

⁸ Microsoft Word – SoP TM Processing of TM Application in TMR 27.10.2022
(ipindia.gov.in)

⁹ Manual of trade marks (ipindia.gov.in)

The trademark owner will get to know whether they have any existing competition in the same trade or not, since, all the existing trademarks are available with the Trademark Registry. Conducting a search gives a warning that whether the owner will have any risk of using that trademark or is it safe.

Step 2: Filing an Application

After conducting a search, comes the process of filing the application for registration. The application must be filed in Form TM-A either online from the IP India's official website or physically at the Trademark Registry Office according to one's jurisdiction. The application must be filed for registration of a single class of goods and or services or in multi-class, and the fees will be calculated for each class included in the application.

The application must be backed up with the required documents, along with complete details of the trademark. If the trademark is already in use before filing the application (i.e. the owner wants to claim prior use), they have to attach a user affidavit indicating the usage of the mark also the evidence of its prior use in the trade.

Step 3: Examination Process

Once the application is filed, it will be thoroughly examined by the Registrar and they will prepare an examination in writing and will send a copy of it to the applicant with thirty days to let them know whether the Registry wants to refuse or conditionally accept the application and shall also include the materials by which he came to such a decision.

The applicant within thirty days from receiving the examination report, must file a reply, stating all the defences along with evidences against the objection raised by the trademark office and the owner shall put forward the reasons as to why their application should not be refused and must be proceeded for further registration procedures. If the applicant fails to reply within the above-mentioned time frame, the application will be abandoned.

Step 4: Post Examination Procedures

Once the applicant files the reply to the examination report, the Examiner if wants can arrange a hearing if due to any reason he/she is not satisfied with the reply sent by the applicant or if, the reply is not able to fulfil the purpose of the objection stated in the report. After the hearing process, if the examiner is fully satisfied, can accept the mark & forward it for publication in Trademark Journal or can refuse the application if any objection is still there.

Step 5: Publication of the Trademark Application

After the examiner has accepted the application, it will be published in the Trademark Journal which will remain there for four months. Advertisement of such an application is done so that within the time period stated above, any third party can see it and if they want can file an opposition against the applicant. Every Monday the Journal is updated with new accepted trademark applications.

Step 6: Notice of Opposition

Within 4 months from the date of publication of the application, any aggrieved party can file a notice of opposition in Form TM-O. When any third party feels that they're already existing and prior use trademark has been infringed by the applicant, or the application is made in bad faith and if such a trademark is registered, it will harm the reputation and good will associated with the prior trademark of the third party.

Notice of opposition will halt the registration process and the opposed mark of the applicant according to the Trademark Act, 1999, and the applicant have to go through certain legal procedures if they want to continue with the registration of the same mark, which includes filing a counter- statement, submitting evidence in reference to that counter statement and in some cases, it is seen that the applicant has to go through hearing as well.

Step 7: Registration

The last step in the registration procedure is to get the certificate of registration. After the mark goes through all the legal processes related to the opposition, and if the opposition is cleared, the applicant will receive the certificate.

ONLINE TRADEMARK REGISTRATION

So, the trademark is a brand or logo which helps people to differentiate between your products than that of others. A registered trademark is an intangible property of a business that is used to protect the company's investment in the brand or symbol. This unique identity can be a slogan, photograph or logo, it can be anything.

In India, trademarks can be registered online by the Controller General of Patents, Designs, and Trademarks.¹⁰ The trademarks are registered under the regulations of the Trademark Act, 1999. The registration also gives the right to sue anyone who tries to copy your trademark. The validity of the trademark is 10 years from the date of registration and can be re-registered after expiration. With all the technical advancements, trademark registrations can be easily done online with the help of a registered trademark attorney.

¹⁰ (PDF) trade mark Registration Process in India (researchgate.net)

E-FILING OF A TRADEMARK APPLICATION

E-Filing of a trademark application is a simple process. The applicant has to login first on the website portal. New users have to register while old users can log in through their username and password or their digital signature. On successful login, the username and its user code will be displayed. Both international, as well as domestic trademarks, can be filed through this website portal.

CONDITIONS FOR REGISTERING A TRADEMARK IN INDIA

There are certain conditions or requirements to be fulfilled before filing a trademark application in India.¹¹ They are:

- The name, nationality, and address of the applicant are necessary. If there is any sort of partnership, details of every partner must be submitted with mentioning any minor, if present.
- Details of the goods and services linked with the registration must be submitted.
- A soft copy of the trademark came for registration.
- Translation of all the non-English words is required.
- Date of the initial use of the trademark.
- If the application submitted is to claim authority for an earlier-filed application, details of that application are also required.

WHO CAN APPLY FOR A TRADEMARK

1. Any person who shows the authority on the trademark can apply for the registration of its mark for goods as well as services.
2. Any person whose business lies under the jurisdiction of India can apply for registration of a trademark.
3. In case, the principal place of business is outside India, the lawyer associated with the proprietor present in India can file an application in the trademark office.
4. In the case of a company, anyone can apply the application but it should be in the company's benefit.

CHECKLIST FOR TRADEMARK REGISTRATION

1. The selected trademark must be able to represent in the paper form or graphically.
2. The trademark must be different in every way, which means it must be able to differentiate its goods and services from others.
3. It should be used to create a connection between the people and the goods or services the person is offering. It means trademarks are used to promote the business.

¹¹ Handbook-on-trade mark-registration.pdf (msmedithrissur.gov.in)

BENEFITS OF TRADEMARKS

There are many benefits of a trademark.

1. Trademarks differentiate your goods and services to that of your competitors which means that trademarks help consumers to identify you.
2. Trademarks help to increase the goodwill and brand awareness of the product or services.
3. Trademarks help in avoiding confusion in the market as a source of products and services.
4. Trademarks help in creating the brand value in the market to give an upper hand against the competitors.
5. Trademarks provide credit to the source of the goods or the service and it also guarantees its quality.
6. It helps in the proper advertisement of the product.
7. Trademark provides legal protection as the person who registered the trademark becomes the legal owner and he can take some legal against the person who uses your registered trademark without your permission.
8. Trademark helps in establishing a unique identity of the company which means no other company can use your trademark for similar goods or services.

TRADEMARK APPLICATION ALLOTMENT

When the application is received by the Trademark Registrar, a trademark application allotment is given by the registrar to the applicant. This number is given within one or two working days. This number helps the applicant to track the status of the trademark application. But mainly, the trademark application allotment number gives access to the applicant to attach the TM or SM symbol to the logo.¹²

VIENNA CODIFICATION

The Vienna Agreement was concluded in 1973 and was amended in 1985.¹³ Vienna Codification is a classification for trademarks that contains figurative elements. It helps in easing trademark searches and removing substantial reclassification work during the exchange of documents at an international level. The countries followed this agreement without making their own national classification.

The countries can apply this classification as their principal or as a subsidiary system, it's up to the countries. In India, Vienna Codification is done by the registrar to conduct trademark

¹² trade mark Registration in India (ipindia.gov.in)

¹³ Territorial Jurisdiction Under trade mark And Copyright Law In India (livelaw.in)

searches for logos/artwork. So, when the Indian Trademark Website shows “Send to Vienna Codification” it means the trademark includes figurative element such as logon and figurative elements come under the Vienna Codification approved by the Indian Trademarks Registry. The Vienna Code is only assigned to figurative elements which mean as soon as any new trademark is filed, the Vienna Code looks after the trademark in search of any figurative elements.

TRADEMARK JOURNAL PUBLICATION

A Trademark Journal Publication is published by the Head Office of the Trademark Registry every Monday. It plays an important role in the registration of the trademark. A trademark is published in a journal when it gets a positive report in the examination from the trademark examiner. So, when a trademark application is accepted by the Trademark Association, completely or with restrictions, the trademark application is allowed to be published in the journal.¹⁴

Promotion of the trademark in the journal doesn't approve the registration of the trademark rather it helps the public to raise a trademark opposition. There are some requirements the journal wants before publication. The requirements are:

1. Details of the trademark
2. Date of application
3. Priority Claim (If any)
4. Details of the applicant and his address
5. Agent's details
6. Class and specification of goods and services
7. A statement as to use of the trademark
8. Appropriate office

INFORMATION UNDER JOURNALS

Trademark Journals contain much information about trademarks. Such as:

- Recent public notifications and public notices issued by the office for trademarks.
- All the trademark applications which are accepted or allowed to be published before acceptance.
- Re-advertisement of the applications which are ordered by the officers.
- List of trademarks that are registered, removed, renewed, or withdrawn by the office.
- Other information which is necessary to be published from time to time.

¹⁴ [https://www.thousandeyes.com/learning/techtorials/dns-domain-name-system#:~:text=The%20Domain%20Name%20System%20\(DNS\)%20is%20the%20Internet's%20system%20for,name%20to%20a%20phone%20number](https://www.thousandeyes.com/learning/techtorials/dns-domain-name-system#:~:text=The%20Domain%20Name%20System%20(DNS)%20is%20the%20Internet's%20system%20for,name%20to%20a%20phone%20number)

CONCLUSION

Trademark is a marketing tool which increases financing of the business. A trademark is not always a brand but the brand is always is a trademark. Sometimes there is a confusion between trademark and brand. The brand name can be simply a symbol or logo but the trademark is a distinguishing sign or indicator in a business organization as it has a wider implication than brands. People are more influenced by the distinctive trademark that reflects the quality of the product. A trademark can be a logo, picture mark or a slogan.