



*How to Register  
Trade Mark in India*

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# HOW TO REGISTER TRADE MARK IN INDIA

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*This comprehensive guideline on how to register trade mark in India will answer your following questions-*

- 1. Whether registration of a trade mark is a legal requirement, i.e. is it mandatory for you to register your trade mark?*
- 2. Can you start your business without registering your trade mark?*
- 3. What is the procedure of registration of Trade Mark?*

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## WHAT IS A TRADE MARK?

Trade mark can be a word, phrase, logo, or other sensory symbol used by a manufacturer or seller to distinguish its products or services from those of others.<sup>1</sup> It may consist of virtually any form of sign. As defined in Section 2(1)(m) of the Trade Marks Act, 1999, a “mark” may include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.

## WHAT PURPOSE DOES IT SERVE?

The main purpose of a trade mark is to designate the source of goods or services. In effect, the trademark is commercial substitute for one’s signature.<sup>2</sup>

## TYPES OF TRADE MARKS

### Coined Trademarks/Fanciful Trade Marks

It is precisely for this reason that invented or coined word marks are the most effective trademarks. For instance, Google, Microsoft, McDonalds are all examples of invented or coined words being used as trademarks.

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<sup>1</sup> Black’s Law Dictionary, Tenth Edition, Ed. Bryan A. Garner, Page 1721

<sup>2</sup> Ibid.



## **Arbitrary Trade Marks**

Another example of a good trade mark is an arbitrary use of common words which have a different meaning in common language but are applied to unrelated goods. For instance Apple (Computers), Penguin (Books), Jaguar (Cars), Dominos (Pizza) etc. are common words associated arbitrarily with trades and businesses to which they have no connections.

## **Suggestive Trade Marks**

Suggestive Trade Marks are those trademark which stand for some idea which requires some imagination to connect it with the goods and which is "suggestive". The information may concern some characteristic or quality or ingredient of the product.”<sup>3</sup> Suggestive Trade Marks do not require proof of secondary meaning for legal protection and registration. Examples may be ‘Facebook’ for online social networking.

## **Descriptive Trade Marks**

Descriptive Trade Marks are those marks which describe the nature, quality, intended purpose, values, geographical origin or time of production of goods or rendering of services, for instance, Sugar Free (Artificial Sweetener), Twenty Four Seven (Stores opening for Twenty Four hours, Seven days a Week), etc. Descriptive Trade Marks require proof of secondary meaning for legal protection. Higher the descriptiveness, greater is the requirement of it having acquired the secondary meaning for the legal protection.

## **Generic Trade Marks**

When a mark becomes the only way of referring to a product, it is called Generic Trade Mark. Examples can be Elevator, Sello Tape, etc. It is almost impossible to protect generic marks as it is very difficult to separate them from the product itself and for these marks, fail as trademarks as they are unable to distinguish products of one person from another.

### ***Is Registration of Trade Mark Compulsory? Why should you get your trade mark registered?***

No; however, it is advisable to have your trademark registered because once the trade mark is registered, the proprietor of a trade mark gets exclusive rights under Section 28 read with Section 29 of the Trade Marks Act, 1999 to use the trade mark. Furthermore, a registered trade mark is a prima facie evidence of validity of trademark as per Section 31 of the Trade Marks Act, 1999. This means, once the trade mark is registered the onus of it being invalid shifts on the infringer of the infringer/challenger to registration. Further, in case of a registered trade mark, the owner is not required to prove goodwill and reputation in comparison to an unregistered trade mark.

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<sup>3</sup> *Manish Vij and Ors. vs. Indra Chugh and Ors.*; 2002 (24) PTC 561 (Del)



### ***Can you protect your Trade Mark without Registration? How?***

Yes; common law doctrines of passing off and unfair competition afford you protection for your trademark even without registration. As per Section 27(2) of the Trade Marks Act, 1999 nothing in the Trade Marks Act, 1999 affects rights of action against any person for passing off of goods or services as the goods of another person. In a case, Supreme Court<sup>4</sup> afforded protection to an unregistered proprietor, over a registered trade mark owner, on account of prior use and trans-border reputation.

### ***Why should you get your trade mark registered, even though you are already protected by under the common law doctrine of Passing Off? What are the advantages of getting your trade mark registered?***

1. Statutory exclusive right;
2. Prima facie evidence of validity, i.e. less burden of proof on the registered proprietor;
3. Registered proprietor can file a suit, in place where (s)he resides, carries on business or personally works for gain irrespective of the fact where infringement occurs;
4. Even if you file a suit after certain delay (delay from the time you actually knew about the infringer and till you approached the Court), the same is no bar/defence in case of a registered Trade Mark.

It is pertinent to note that in India, the registration of a trademark is only prima facie proof of the validity of mark and a prior use of the mark may even trump subsequent registrations.

### ***Can you start your business without registering your trademark?***

Yes, you can. However, it is always advisable to get your trade mark registered. A trade mark can be filed on a 'proposed to be used' basis as well as claiming as a user of it, from a particular date.

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<sup>4</sup> *N.R. Dongre and Ors. vs. Whirlpool Corpn. and Anr.* 1996 PTC (16) 583 (SC)



### *What is the procedure for trademark registration?*

The Trade Marks Act, 1999 along with the Trademark Rules, 2002 govern the trademarks regime in India.

## **PRE FILING REQUISITES**

Before filing a trademark application in India, it is highly recommended to conduct a public search of the trademark using the Trademark Registry's online portal in the relevant class available at <http://ipindiaservices.gov.in/tmrpublicsearch/frmmain.aspx>.

A trademark is always filed in relation to a specific class or classes of goods and/or services. The classification of goods and services under the Trade Marks Act, 1999 is based on the Nice Classification (NCL) of Goods & Services established by the Nice Agreement in 1957. There are total of 45 Classes and before conducting a public search one should know the relevant class(es) in which their goods or services may fall. Classes 1 to 34 are for goods. Classes 35 to 45 are for services. A list of all the classes along with the explanatory note can be found [here](#).

### *Why should I do a trademark Search? What are the benefits?*

The benefit of conducting a trademark search before filing of a trademark application is twofold-

1. It is a preliminary determination of the level of contest a trademark application may face. For instance, if the desired trademark is already registered by a third party who has been using the same for a considerable period of time, it would be advisable to either drop the mark, or to apply the mark with a distinctive element such as a distinctive label. The trademark application for the desired mark may be varied or altered as per the results of the search based on the advice received from the trademark agent on a case to case basis.
2. Conducting a trademark search prior to filing of a trademark application provides a rough estimate of the timelines and costs of obtaining the registration for the desired trademark.

### *How should you conduct a trademark search?*

It depends upon the nature of the mark proposed to be registered.

#### **Word Mark Search (example 'MOBILIO').**

Go to <http://ipindiaservices.gov.in/tmrpublicsearch/frmmain.aspx> and then go on the word mark Search, where it says 'Start With'. Word Mark search can be done in two ways, one in 'Starts With' option and other with 'Contains' option. In 'Starts With' option, you can type 'MOB' and the relevant Class and all marks starting with the letter 'MOB' in that Class will appear as



results. In second option of 'Contains', you can type 'MOB' and the relevant Class and all marks containing 'MOB' anywhere in sequence will appear as results.

### **Phonetic Search**

You can also do a phonetic search as well. Go to 'Search Type'. Change it to 'Phonetic'. Type the word you want phonetic equivalents off, along with the relevant class. There you go, see them, analyze them and take your decision accordingly.

### **Logo mark Search (example McDonald's 'M' logo)?**

Go to 'Search Type'. Change it to 'Vienna Code'. Vienna Code is a six digit number which varies depending upon the logo sought to be registered. In case of 'M' logo which is one letter, the Vienna Code would be 270521(27.5.21). The Vienna Code Classification is available on top of Search Type. The same is accessible [here](#). If you see the link, the codes are along with decimals and the Search option will only take numbers, therefore, the decimals would be replaced by zeroes, but the Code in no case can be more than six (6) digits. For example if the code is 12.4.5, then you should type 120405 and if it is 27.5.21, then 270521.

You will then have the search results before you which you can analyze to make your decision accordingly.

## **PROCEDURE FOR REGISTRATION**

In India, a trademark application may be filed in accordance with the Trademark Form (Form TM-1 and Form TM-2 (priority application) as available in Schedule II of the Trade Marks Act, 1999 along with the requisite government fee of Rs. 4,000/-. In 2011, the Trademark Registry has also made provisions for online filing of a Trademark Application for the ease and convenience of filing a trademark application.

A trademark application goes through the following stages:

### **STAGE-I FILING**

A trademark application must be filed in the office of the Trademark Registry within whose territory the principal place of business of the applicant is located.

In the event that the applicant does not have a place of business in India, then the address for service in India, which is generally the address of the agent of the applicant, becomes relevant in determining the trademark office where the application must be filed. The office where the trademark application must be filed may be determined as follows:



- **Trade Marks Registry Mumbai (Head Office)** - State of Maharashtra, Madhya Pradesh & Goa;
- **Trade Marks Registry, Delhi** - State of Jammu & Kashmir, Punjab, Haryana, Uttar Pradesh, Himachal Pradesh, Union Territory of Delhi & Chandigarh;
- **Trade Marks Registry, Kolkata** - State of Arunachal Pradesh, Assam, Bihar, Orissa, West Bengal, Manipur, Mizoram, Meghalaya, Sikkim, Tripura and Union Territory of Nagaland, Andaman & Nicobar Islands;
- **Trade Marks Registry, Ahmadabad** - State of Gujarat and Rajasthan and Union Territory of Daman, Diu, Dadra and Nagar Haveli;
- **Trade Marks Registry, Chennai** - State of Andhra Pradesh, Kerala, Tamil Nadu, Karnataka and Union territory of Pondicherry and Lakshadweep Island

A trademark application may be filed for a word mark or a logo/label mark. When filing an application for a logo/label mark, it is generally recommended that an application for the word mark *per se* is also filed. This is because, in the event a registration is obtained for a logo/label mark, the protection granted is for the use of the logo/label as a whole and not to use the elements of the logo/label independent from the logo/label, whereas, on obtaining the registration of a word mark entitles the proprietor of the mark to exclusive use of the word in relation to the goods and services in relation to which the trademark application has been filed provided there are no prior users or honest concurrent users of the mark.

A trademark application may be filed for a single class of goods or services and even for multiple classes in a single application (Form TM-51). The Trade Marks Act, 1999 also makes provision for filing of a priority application from a convention country within six months from the priority date of the convention application.

Along with the Form TM-1 under the Trade Marks Rules, 2002, the applicant has to file an Additional Representation Sheet.

***What information/documents are required for filling in a trademark application and filing it?***

1. The Name/Image of the mark sought to be registered;
2. The exact date of use of the mark. (not required, in case the mark is proposed to be used);
3. The name of the applicant/proprietor of the mark;
4. The address of the applicant/proprietor of the mark;
5. The exact goods/services for which the mark is being used or is proposed to be used by the applicant/proprietor;



6. Trade Description of the applicant/proprietor. (for example, whether the proprietor/applicant a Retailer, Manufacturer, Wholesaler, Merchant, Service Provider etc.), and
7. A Power of Attorney in favour of the agent from the applicant/proprietor of the mark under Form TM-48 of the Trade Mark Rules, 2002 on a Stamp Paper of Rs. 100/-.

## **STAGE-II** EXAMINATION

Once an application is filed, it is examined by the Registrar of the Trademarks. Generally, the Examination of an application takes around one (1) year from the date of filing of the application. If an applicant is interested in expedited examination of the application, it can file an application under Form TM-63 of the Trade Mark Rules, 2002 (Rule 38). The fees for the same is Rs. 20,000/-, In this case, the examination is conducted in about a month.

The Registrar of the Trademarks may pose objections to the application as per Section 9 or 11 of the Trade Marks Act, 1999 or any other technical or procedural objections. It is pertinent to note that objections being raised by the Trademark Registry are the norm and, objections are raised in 95% of trademark applications filed. Only very few marks which are highly distinctive and have no remote similarity to any pending or registered trademarks are cleared without objections.

### **Types of Objections which may be raised in the Examination:**

1. **Absolute Grounds of Refusal** – Section 9 of the Trade Marks Act, 1999 provides for the absolute grounds of refusal of the registration of a trademark which are as follows:
  - The marks which are devoid of any distinctive character, that is to say, not capable of distinguishing the good or services of one person from those of another person;
  - The marks which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service;
  - The marks which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade;
  - The nature of the mark is such as to deceive the public or cause confusion;
  - The mark contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India;
  - The mark comprises or contains scandalous or obscene matter;
  - The use of the mark is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950);





- If the mark consists exclusively of the shape of goods which results from the nature of the goods themselves;
- If the mark consists of the shape of goods which is necessary to obtain a technical result, and
- If the mark consists of the shape which gives substantial value of the goods.

**2. Relative Grounds of Refusal** – Section 11 of the Act further provides for the relative grounds of refusal which are as follows:

- If the mark is identical to an earlier trade mark and is in relation to similar goods or services covered by the earlier trade mark, or
- If the mark is similar to an earlier trade mark and is in relation to identical or similar goods or services covered by earlier the trade mark and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- Also, if the mark is similar or identical to an earlier trademark which is a well known mark may be refused even if the later mark is applied for different goods or services provided the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.
- A mark may also be refused by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade, or by virtue of law of copyright.

**3. Procedural Objections** – The Examiner may also raise objections on certain procedural ground such as the absence of a valid Power of Attorney in favor of the trademark agent, incorrect classification of goods or services, incomplete information in the Trademark Application etc. However, these objections are relatively easier to clear and do not substantially hamper the registration of the mark.

*How would you know that your trademark application has been objected?*

The objections raised by the Registrar are communicated to the applicants by way of examination report. The Examination Report is uploaded on the Website of Trade Marks Registry and a hard copy of the same is sent to the Applicant/Agent (depends on who filed the application).

As per the Trade Marks Act, 1999 and the relevant rules thereto, specifically rule 38, in the event the Registrar has any objection in relation to the registration of the trademark, he shall communicate the same to the applicant and the applicant must respond to such objection within one month from the date of such communication. However, there is ambiguity as to whether uploading/downloading of the Examination Report from the TM Registry website construes as communication of the objections to the applicant.



The Hon'ble Bombay High Court in [\*Institute of Cost Accountants of India vs. The Registrar of Trade Marks, Mumbai & Anr.\*](#)<sup>5</sup>, observed that the time period of one month begins from the date of the receipt of the hard copy of the Examination Report and not from the date of the uploading of the Examination Report on the Trademark Registry website. However, this is the only ruling in relation to this point and although it may be reasonably assumed that the other Courts shall also decide similarly if and when faced with this question, in absence of a specific ruling from other Courts, the ambiguity continues. It is pertinent to note here that by way of abundant caution, the applicants can always file an application seeking extension of time to file the examination responses in the relevant form along with the requisite fee to ensure that the deadline is not missed by them. However, it shall be incorrect to argue on one hand that the time period for filing the response to examination reports begins from the day when the hard copy of the examination report is received by the Applicant and to file an application for the extension of time on the other. Hence, it is advisable to consult with the legal advisors having specific knowledge of the trademark law in India and the procedures of the Registry to decide the best way forward.

***What is the fee for filing a reply to Objections raised in Examination Report?***

There is no fee for it.

***How should you respond to the Trademarks Registry if your mark is objected?***

An applicant is required to file a written reply to the objections raised by the Registry within one month from the date of communication of the Examination Report. In the event the applicant fails to respond to the objections within the stipulated time period, the application is deemed to be abandoned.

In the event the Registrar is satisfied with the written reply, he may clear the mark for advertisement. However, if the Registrar is not satisfied he is required to give a hearing to the applicant unless a hearing has been waived off by the applicant in his response.

The Registrar may also impose reasonable conditions, amendments, modifications and/or limitations on the registration as he deems fit and such proposal is communicated to the applicant in writing. The decision of the Registrar must be communicated to the applicant in writing and the law makes a provision for an appeal from the decision of the Registrar.

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<sup>5</sup> W.P. No. 2088 of 2012



### STAGE-III ADVERTISEMENT

Once the mark is cleared of all the objections from the Trademarks Registry, it proceeds for advertisement in the Trade Marks Journal. The Trademark Journal is open to the public and the purpose of advertisement is to invite any opposition to registration of the mark from any third parties. Once a mark is advertised and no oppositions are filed within the statutory time period, the mark moves to registration.

#### *What is the statutory time period of making Opposition?*

A notice of opposition must be given within four (4) months from the advertisement of the trademark in the Trademark Journal. This time period is non extendable.

#### *What happens when your mark is opposed?*

A notice of opposition is given in form TM - 5 of Trade Marks Rules, 2002 along with the requisite fee of Rs. 2,500/-. Once the applicant receives the notice of Opposition, he is required to file his counter statement within two (2) months from the date of receipt of the notice of Opposition along with the requisite fee. Thereafter, within two (2) months of the receipt of the Counter Statement, the Opponent is required to file evidence by way of affidavit in favor of the Opposition. The time period for filing the evidence affidavit may be extended by one month on application to the Registrar. The Applicant is thereafter required to furnish his own evidence by way of affidavit in support of the application within two (2) months from the receipt of the Opponent's evidence affidavit. This time period is also extendable for a period of one (1) month on application to the Registrar. The Opponent is next required to file Evidence in Reply to the applicant's affidavit within one (1) month of the receipt of the applicant's affidavit in favor of the application, which may be further extended for a month on an application being made to the Registrar in this regard.

Within three (3) months of completion of the evidence, the Registrar shall give the notice of first hearing to the Parties. Rule 55 of the Trademark Rules, 2002 provides that the first date of hearing shall be at least one (1) month after the date of notice to the parties. Any party who intends to appear for the hearing must notify the Registrar within fourteen (14) days of the receipt of the first notice. In the event the applicant does not notify the Registrar of his intention to be present for the hearing and is not present on the date of hearing, the application may be treated as abandoned. In the event the opponent does not notify the Registrar of his intention to be present for the hearing and is not present on the date of hearing, the opposition may be dismissed for the want of prosecution and the application may proceed for registration.



## **STAGE-IV**

### **REGISTRATION**

Once the mark is registered, the Registrar shall issue a certificate of registration of a trademark. It must also be kept in mind that the registration of a trademark provides protection to the use of the trademark as a whole but does not protect the use of individual elements of the trademark unless conditions in Section 17 of the Trade Marks Act, 1999 are met. However, the registration of a trademark provides statutory protection to the use of the trademark. The legal protection accorded to the registered proprietor of a mark is always wider than that accorded to a person using the mark without registration.

### **POST REGISTRATION FORMALITIES**

A trademark registration is valid for a period of ten (10) years from the date of application and may be renewed thereafter from time to time. For example, if you file an application on 01.01.2014 and got a registration on 06.05.2016, the mark will be valid only till 31.02.2023.

As per Section 25(3) of Trade Marks Act, 1999, a trade mark can be renewed after the expiry of renewal if the applicant makes an application within six (6) months from the date of expiry of Registration. In such a case, the applicant has to file two forms one for renewal and one for payment of surcharge. The form for renewal is Form TM-12 of the Trade Mark Rules, 2002 and the fees for the same is Rs. 5,000/- for one mark. Application for payment of surcharge is made under Form TM-10 of the Trade Mark Rules, 2002 and the fees for the same is Rs. 3,000/-

The said applications have to be made within six (6) months from the date of expiration of registration. In case, the applicant is not able to make such application within six (6) months from the date of expiry of registration, the Registrar removes the mark from the Register. In such a case, Section 25(4) of the Trade Marks Act, 1999 comes into operation. In such a case a mark has to be restored.

For restoration of the mark, an applicant has to move an application for Restoration and renewal of trade mark under Form TM-13 of the Trade Mark Rules, 2002. The fees for making an application under Form TM-13 is Rs. 5,000/- plus the fees for renewal, i.e. 5, 000/- per mark. In this case, only one application is filed under Form TM-13 with combined fees for restoration as well as renewal. Such application has to be made after expiry of six (6) months but before expiry of one year from the date of expiration of the Registration. For example, if the six months period after expiration of registration has expired on 31<sup>st</sup> August, 2014 an application for restoration has to be moved by 28<sup>th</sup> February, 2015.



It is pertinent to mention herein that as per Section 25(3) of the Trade Marks Act, 1999 read with Rule 64(1) of Trade Mark Rules, 2002, the Registry has to give a mandatory notice to the applicant/agent that the mark is due for renewal and if the said is not provided but the mark is removed, the mark is liable to be restored as per law interpreted in *Union of India v. Malhotra Book Depot*<sup>6</sup>.

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<sup>6</sup> 2013 (54) PTC 165 (Del) (DB)

