REGISTRATION OF TRADEMARKS

➢ Trademarks in India are listed by the Controller General of Patents, Designs and Trademarks a government agency, which reports to the Department of Industrial Policy and Promotion Ministry of Commerce and Industry.

➢ It is a process whereby a Trade Mark is entered in the register of the Trade Mark.

➢ Registration of trade mark is registered, it may be either registered or unregistered. The law provides legal remedies against infringement for both registered trademarks and unregistered trademarks. Registration of Trademarks is prima facie evidence of ownership, whereas in case non registration it has to be established by the way of prior use and passing off in action.

➢ Trademarks are registered as per the provisions of the Trademark Act, 1999.

➢ Registered trademarks are intellectual property for business, they are used to safeguard the company’s investment in the brand or symbol.

➢ The conditions precedent & procedure for registration of trademarks is contained under Chapter II & III of the Trademark act, 1999.
BENEFITS OF REGISTRATION

➢ Prima-facie evidence of ownership of the trademark.
➢ Gives you stronger enforceable rights to prevent others from using the trademark in connection with the goods or services for which it is registered.
➢ Trademarks can be sold, licensed or assigned.
➢ Registration covers the whole of India.
➢ Important asset for business/company and contributes towards goodwill generation.
REGISTRAR OF TRADE MARKS

- Registrar of trademarks is appointed under section 3 of the Trade Marks Act, 1999.
- The Registrar of Trade Marks is the authority who is accountable for the registration of trademarks, along with the responsibility of settling opposition proceedings and rectification of the register.
- The registrar is vested with a remarkable range of discretionary powers.
- Besides these, the Registrar has powers of civil courts in any specified matters and residuary powers as well.
- The Registrar also has the power to review his own decision.
- The act also provides for the appointment of Joint Registrar, Deputy Registrar, Assistant Registrars and Examiners of trademarks and clerical staff to assist the Registrar.
TRADE MARKS REGISTRY (TMR)

- TMR is established under sec. 5 of the TM act.
- The main purpose of TMR is facilitation the registration of trade marks.
- The head office of TMR in India is located at Dwarka, New Delhi.
- The act also provides for establishing of other branch offices as the Central Government may notify.
REGISTER OF TRADEMARKS

- Sec 6 of the TM act provides for the Register of Trademarks.
- It is a record kept at the head office of the Trade Marks Registry in which the details of all registered trade marks are maintained.
- These details include:
  a) Names
  b) Addresses and description of the proprietors
  c) Notifications of assignment and transmissions
  d) The name, addresses and description of registered users
  e) Conditions, limitations
  f) Other matters relating to registered trade mark
GROUNDS FOR REFUSAL OF REGISTRATION

Grounds for refusal of registration are listed under Section 9 of the TM act.

These grounds include:

- Trade Mark is devoid of distinctive character
- Non-exclusive marks with respect to kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service
- Marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- Marks which may deceive the public or cause confusion.
- Marks which comprise of or contain scandalous or obscene matter.
- Marks prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
- Marks if it consists exclusively of the shape of goods which result from the nature of the good/shape of goods which is necessary to obtain a technical result/shape which gives substantial value to the goods.
In this case the petitioners were established manufacturers of shawls, blankets and they have been selling their goods from 1920 under the Trade name ‘DHARIWAL’ with the device of lamb written in a characteristic style.

The petitioners got registration of the mark granted in its favor in 1955.

The respondent’s registration application describes their Trade Mark as DWM - DHARIWAL, for the same goods in the same class, which could be registered. They have been in fact been using a part of the same class, which could be registered. They have been using a part of the proposed Trade Mark namely DHARIWAL, which is same as registered for the petitioner. By dropping the prefix ‘DWM’ from the Trade Mark in doing actual business an effect is being made by the respondents to device the general public.

This cannot be said to be an honest intention. The possibility of confusion between the goods of the two manufacturers by virtue of their using the Trade Mark containing the same device and the same Trade Mark containing the same device and the same trademark is very real. The court held that the registration is justifiably refused.
HONEST AND CONCURRENT USE

Under Section 12, the Registrar may permit the registration to more than one proprietor of the trademarks which are identical or similar, irrespective of an earlier registration in respect of one of them, on the ground of honest and concurrent use or other special circumstances.
In this case the court allowed registration of the trade mark “MBS” on the ground that there was no complaint from public in relation to the goods under the rival marks even after the user of mark for 25 years and there was nothing to suggest that the user of the trade mark was not innocent, honest and bona fide.
PROCEDURE FOR REGISTRATION

- The Procedure for registration of a Trade Mark is enumerated from section 18-23 of the Trade Marks Act, 1999.
- The application for registration of Trade Mark should be filed in the office of the appropriate Trade Marks registry. The head office and office of the appropriate Trade Marks registry.
- The application for registration has to be filed in that office of the registry within whose territorial limits the principal place of business of the applicant is located. In the case of a joint application, the location of the applicant whose name is mentioned first in the application is to be taken into account for the purpose of jurisdiction.
- An application for registration of a Trade Mark may be made for one or more particular goods included in one or more classes of goods or services. The class to which the goods or services belong is determined by the Registrar. The application is to be taken into account for the purpose of jurisdiction.
The Trade Mark Act, 1999 allows a single application to be made for registration of Trade Mark for goods or services falling in more than one class of goods or services.

An applicant makes an application for registration of Trade Mark still not used by him, this shall operate as a claim on the Trade Mark till the time applicant does not abandon his claim.

If another person makes an application for similar Trade Mark than the claim of earlier applicant is superior and will be preferred.

Section 133 provides for the applicant to obtain information by making an application in the prescribed form of the proposed Trade Mark is prima facie distinctive, before making an application for registration.

Section 47 (1) (a) of the Trade Marks Act, 1999 enables any aggrieved person to apply to the registrar or to the Appellate Board to take off a registered Trade Mark from the register the Trade Mark was registered without any bona fide intention on the part of the applicant to use the Trade Mark on goods or services stated in the application.
The following information and documentation must be submitted in a trademark registration application:

a) the applicant’s name and address;
b) the state or country of incorporation;
c) a description of the trademark;
d) a representation of the trademark;
e) a list of the relevant goods or services;
f) the power of attorney;
g) statement of user and the dates of first use. If use is claimed, an affidavit of use and documentary evidence must be filed electronically;
h) a statement of intention to use;
i) the official filing fee;
j) a priority claim and documents, where priority of an earlier application is claimed;

If the applicant is not domiciled in a particular jurisdiction, a local service address must be provided.
Upon receipt of an application for registration, the Registrar’s office undertakes an ex-officio examination.

It causes a search to be made amongst the registered Trade Marks and pending applications to ascertain whether there are on record, in respect of the same or similar goods or services or description of goods or services, any mark identical with or confusingly similar or which may show an association with the mark sought to be registered.

In conformity with the provisions the Registrar may accept the application either absolutely or subject to such amendments, conditions or limitations as he may think fit.

He is entitled to refuse the application, but only after recording in writing the grounds for refusal or for conditional acceptance and stating the material used by him.

After acceptance the application is advertised in the form in which it has been accepted in the Trade Mark journal.
Within three months of the advertisement or re-advertisement of acceptance of an application for registration, any person may give notice in writing, of opposition to registration. The registrar requires to serve a copy of opposition notice to the applicant for registration.

The applicant must submit his counter statement of the ground on which the applicant relies within two months therefrom, otherwise it is deemed that the registration application has been abandoned.

The copy of counter statement is required to be served on the opponents. All the evidences are required to be submitted.

The Registrar shall decide after hearing the parties and pass a speaking order stating all the reasons for imposing any conditions or limitations whether registration is to be permitted or not.

The registration is to be permitted to take into account any ground of objection even if that has not been relied on by the opponents.
The Registration of Trade Mark is completed under section 23, before the grant of registration, either the registration application should not have been opposed or if it was opposed the opposition should have been decided in favor of the applicant.

The Central Government should not have prohibited the legislation.

If the above conditions are fulfilled, than the Trade Mark is entered in the register and the Registrar issues a certificate to that effect.

The registration takes effect from the date of application.
**Procedure for Registration of Trade Mark**

1. **Filing a Written Application**
2. **Examination Process by the Trade Mark Office**
   - Accepts Application by the Registrar
   - Applicant successfully makes representations or amends appropriately
   - Rejects conditionally Application by the Registrar
     - Applicant fails to remove objections
     - Application fails
3. **Advertisement of Application in Trade Mark Journal**
   - Written opposition within 3 months of publication.
     - No Opposition
       - Mark Registered
     - Yes, Opposition
       - If not divided in favour of Applicant
         - If Opposition decided in favour of Applicant
1. **Registration published and certificate of Registration issued.**
A CERTIFICATE OF TRADEMARK REGISTRATION
TERM OF A TRADEMARK

- Term of registration of a trademark is ten years, which may be renewed for a further period of ten years on payment of prescribed renewal fees.
- Non-user of a registered trademark for a continuous period of five years is a ground for cancellation of registration of such trademark at the behest of any aggrieved party.
RENEWAL PROCESS

➢ On the expiration of a period of ten years, the registered proprietor or an assignee can obtain a renewal on payment of prescribed fees by making an application in the prescribed manner and period.

➢ The Registrar has no discretion in the matter of renewal.

➢ The Trade Mark can be further renewed indefinitely by following the same procedure on each expiration of registration.

➢ The Registrar is required to give notice for payment of fee stating date of expiration of Trade Mark so as to avoid inadvertent lapse or delay in making the application or payment of the renewal fee.

➢ If the payment is not made in stipulated time, the Registrar may remove the Trade Marks from the register. If the application is made within six months from the time of expiration with a fee and surcharge,

➢ The Registrar is mandated to renew the registration and is not to remove the mark from register.

➢ When the Trade Mark is removed for non-payment of fee, in spite of its removal it is deemed to be on the register for the limited purposes of registration of other marks for a period of one year.
RIGHT CONFERRED ON APPLICATION OF REGISTRATION

➢ It serves as evidence of the adoption and solution of Trade Mark of state goods or services.

➢ It enjoys priority against identical or similar marks pending registration for same or similar goods or services, if similar mark is applied or used after the date of application

➢ Preservation of the filing date within six months of priority period in all countries of the Paris convention and WTO which means that by making an application in one country, if the applicant chooses to make an application in the other countries, other application will be deemed to have been filed at the earliest date
RIGHTS CONFERRED ON REGISTRATION

➢ Exclusive right to use of the Trade Mark in relation to the goods or services in respect of which the Trade Mark is registered.

➢ Entitles the registered proprietor to obtain

➢ Registration of a Trade Mark forbids every other person (except the registered or unregistered permitted user) to use or to obtain the registration of the same Trade mark relief in respect of infringement of Trade Mark.

➢ A right to restrict the import of goods or services marked with a Trade Mark similar to one’s Trade Mark.

➢ A right to restrain use of the Trade Mark as Trade name or part of the Trade name of business concern dealing in the same goods or services.
THE END