

How to file a Trademark Application in India?

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INTRODUCTION

Trademark is a symbol that allows a purchaser to identify goods or services that have been proved satisfactory and not to buy goods or services that have not been satisfactory. Trademarks serve mainly three purposes viz. (i) encourage the production of quality products; (ii) reduce the customer's costs of shopping and (iii) help the customer to make decisions on purchasing products.

Trademarks help promote economic efficiency. If trademarks are not allowed to be registered with the manufacturers it may eventually take away the incentive of trademark owning manufacturers to make investments in quality control. There would thus be no healthy competition among the manufacturers leading to the loss of vitality of the economy. If we do not have a system of having trademark a manufacturer would get nothing by improving his product's quality. And consumers would not be in a position to identify high or low-quality products. In such a situation a manufacturer who reduce the price by reducing quality may pocket the benefit of the market. The consequence would be attempts to produce inferior quality products rather than competition to produce better quality products.

FILING OF TRADEMARK APPLICATION

PROCEDURE FOR REGISTRATION

1. Application for Registration

Section 18 of the Trade Marks Act 1999 says that any person, claiming to be the proprietor of a trademark used or proposed to be used by him, who is desirous of registering it shall apply in writing to the registrar in the prescribed manner for the registration of the mark.

Essential Ingredients for registration:

(i) *Any person*

Any person includes individual, partnership firm, association of persons, a company whether incorporated or not, a trust, Central or State Government. It does not allow the representative of the proprietor to apply in his own name.

(ii) *Claiming to be proprietor*

A person may obtain proprietorship in a trademark either by use or by registration under this Act. He may also acquire proprietorship by assignment or by inheritance. In case of unregistered mark but in use, proprietorship will be the person who first used it in case of two rival claims whereas in case of proposed use of mark, which comes up for registration, the designer or the originator will be the proprietor in case of any controversy. Between two rival claims of user of the mark and designer of the mark the former will be preferred. At this stage of making application, the proprietor has to show his bona-fide claim. If the mark is not mistaken on the face of application and also there is no objection to the claim, the registrar is entitled to accept the application.

In case of manufacturer having a trademark abroad has made goods and imported them into this country with foreign mark on them, the foreign mark may acquire distinctive character and in such circumstances, the same or colorable similar mark cannot be registered not because it is registered abroad but because it lacks distinctiveness.

(iii) *Used or proposed to be used*

The law permits registration of a mark, which has been or is being used or is proposed to be used. In case of proposer of the mark, he must have definite and present intention to use the mark as on the date of the application. Definite and present intention is different from the general intention to use the mark sometime in future to something, which he may think desirable later on. Definite and present intention means a real intention to use the mark for resolved and settled purpose. In case of used mark, the use in itself is not sufficient but is to be accompanied with real intention continue with the use.

The 'proposed use' of the trademark must be normal and fair, which, however, may include variations in presentation or color difference but such variation should not stretched to far so that

the used form will be totally different from the one sought to be registered. If proprietor does not have the real and present intention to use the mark, and try to register is for some mala-fide intention, such as to block the mark, it would amount to registration in bad faith¹, which is a serious form of commercial fraud.

The application for registration of the mark must be filed with the Registrar in the prescribed manner who has been conferred the discretion either to accept or reject or accept with amendments, modifications, conditions or limitations². The Registrar must communicate his decision in writing with the applicant and is under obligation to give the reasons in cases of rejection or acceptance on conditions or with modification.³

2. Withdrawal of Acceptance

In case the Registrar decides to accept the mark for registration, but before actual registration, the Registrar may withdraw his acceptance under certain circumstances under section 19 of the Trade Marks Act 1999. For example, if the Registrar is satisfied that the application is being accepted in error or that circumstances are such that such registration should not be granted, he has been empowered to withdraw the acceptance of application.

This power can be exercised subject to certain conditions. In the case of *Tikam Chand and Another v Dy. Registrar of Trade Marks*⁴, it was held that Registrar has to issue a notice, specifying the objections, which has led him to think that the application has been accepted in error or why the mark should not be registered, to the applicant and give him an opportunity of being heard by requiring him to show cause why acceptance should not be withdrawn.

3. Advertisement of Application

Once the Registrar for registration has accepted the application, he shall get the application advertised in the prescribed manner after acceptance. However, the application shall be advertised

¹ K. C. Kailasam/Ramu Vedaraman, Law of Trademarks and Geographical Indications (Wadhwa and company, Nagpur) 2003 at 239.

² Section 18 (4).

³ Section 18 (5).

⁴ 1998 PTC 542 (Del).

before acceptance if the application is related to a trademark to which section 9(1) and 11(1)(2) apply or in any other case as it seems expedient to the Registrar.⁵

In the case of *Virendra Sethi v Kundan Das*⁶, it was held that the purpose of advertisement is give information to the public at large in respect of the trademark advertised and afford an opportunity to oppose the registration of the mark on given grounds. So the advertisement must be complete in all respects and otherwise the very purpose of advertisement will be frustrated. In the case of *Ashoka Dresses v Bonn's Shirts & Another*⁷, it was said that if there is incomplete or incorrect information in the advertisement, it would amount to misrepresentation, which deprives a prospective opponent of the opportunity to get full information and of filing an effective opposition.

4. Opposition to Registration

Section 21 of The Trade Marks Act 1999 allows any person to oppose an application for registration. "Any person" need not be only a prior registered trademark owner. In the case of *P. N. Mayor v Registrar of Trademarks*⁸, it was held that even a customer, purchaser or a member of the public likely to use the goods may object to the registration of a trademark in respect of such goods on the ground of possible deception or confusion. The period within which opposition to the application for registration can be filed is three month from the date of advertisement, which can be extended by Registrar not exceeding one month on application made to him and on payment of the prescribed fee. So the period cannot exceed four months *in toto*.

The grounds of opposition should be based upon the specific provisions of law. The grounds based on section 9, 11, 12, 13, 18, 24, 33, 35, 36(2) etc. would be suitable to challenge the application of registration. However, the grounds based on section 11(2) and (3) are available only to the proprietor of earlier trademark.⁹

On receiving the notice of opposition, the Registrar is under obligation to send a copy of the same to the applicant for registration. Upon receiving such notice, the applicant is given two months

⁵ Section 20

⁶ 20002 (25) PTC 50 (Del).

⁷ (2000) RPC 507.

⁸ AIR 1960 Cal. 80.

⁹ K. C. Kailasam/Ramu Vedaraman, Law of Trademarks and Geographical Indications (Wadhwa and company, Nagpur) 2003 at 261.

time, from the date of receipt of the notice, to file counter statement together with the 0prescribed fees to the registrar. This copy of counter statement shall be sent to the person who has filed opposition under section 21 (3). In *Oswal Industries v Registrar of Trade Marks*¹⁰ it was held that the applicant and the opponent are given the opportunity to adduce evidence in support of their claims and may also be given an opportunity to be heard if they so desire under Section 21 (4). However the onus is on the opponent to allege and prove the existence of facts, which may lead the tribunal to assess the existence of likelihood of confusion in the minds of the public, which includes likelihood of association with the earlier mark. But this does not relieve the applicant of his onus to satisfy the Registrar or the court that there is no reasonable probability of confusion, in respect of all goods coming within the specification applied for and not only in respect of the goods on which he is proposing to use it immediately.¹¹

5. Registration

Subject to Section 19 the Registrar is under obligation to register the Trade Mark under section 23 if he decides in favor of applicant after listening to the opposition. However, Central Government may direct otherwise on certain grounds. The mark can also be registered jointly for two or more persons under section 24 if two or more persons agree to work jointly. In such cases, the registrar shall require a copy of joint venture agreement to satisfy himself because none of them is entitled to use the mark independently. The section in its earlier part specifically precludes the Registrar from registration of two or more persons who use the trademark independently or propose to use it independently. The registration shall be made as of the date of the application and the applicant shall be issued a certificate of registration. However the registrar is empowered U/S 23 (4) to amend the register or certificate of registration for the purpose of correcting a clerical error or an obvious mistake. The applicant must complete all formalities within one-year time period or within such time as may be given in the notice. If defaulted, the application may be treated as abandoned after the registrar gives notice in this regard to the applicant.

Section 25 provides that Registration shall be for a period of ten years but may be renewed from time to time in accordance with the provisions of this act. Renewal can be made before the

¹⁰ 2000 PTC 24.

¹¹ K. C. Kailasam/Ramu Vedaraman, Law of Trademarks and Geographical Indications (Wadhwa and company, Nagpur) 2003 at 272.

expiration of the registration. In case of default in renewal before expiration, the act provides for the grace period of six months from the date of expiration for renewal on payment of prescribed fee. However, before expiration of the last registration of a trademark, the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and conditions as to the renewal. If the proprietor does not file for renewal, the name of the mark will be removed from the register. However, the Registrar is entitled to restore the mark in register if it is just to do so after six month but before one year from the expiration of the last registration, on the receipt of application and on payment of the fee by the proprietor. Such restoration shall be for another ten years to period.