

Trademark – Protect your Brand Identity

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In brief

Intellectual Property Rights “IPR” are the most important part of the modern business. Intellectual property which is a combination of copyright, trademark, design, geographical indication, patent, industrial design, integrated circuit, is valuable assets of any company. IP can create healthy competition in the market; consequently, the manufacturer and traders can develop their products more effectively. Hence, IP plays an important role in every business.

Let us discuss about Trademark – A branch of **Intellectual Property Right**.

Relevant provisions

The Trade Marks Act, 1999 and rules framed thereof.

In detail

Trademark includes any word, name, symbol, or device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods and services of one person from those of others and may include shape of goods, their packaging and combination of colors, and to indicate the source of the goods. **In short, trademark is a brand or logo which represents your business.**

The registration of a trademark gives its proprietor the exclusive right to the use thereof for the designated goods/services and to obtain relief against others who infringe the registered mark.

The term of Trademark is for a period of 10 years from the date of registration, which can be renewed indefinitely for consecutive terms of 10 years each.

Registration of Trade Mark

Any person claiming to be the proprietor of a trademark used or proposed to be used by him may apply in writing in

prescribed manner for registration.

Steps for registration of trademark

1. Search Report

Conduct a search for the name, device, logo, and mark intended to be applied as trademark.

2. Apply for registration of trademark.

An application for registration of a trademark could be filed with the Trademarks Registry online by the applicant or their authorised attorney. The application must contain the name of the mark, goods and services, class in which goods and services fall, name and address of the applicant, period of use of the mark.

3. Examination of application by the registry.

Examination report issued by the registry raising objections under different sections of the Trademark Act, 1999.

4. Reply to the official objections

Replying for objection raised and if required, ask for hearing. Applicant needs to file evidence in support of the trademark application.

5. Advertisement of trademark

Advertisement to be published in official gazette/trademark journal for the purpose of opposition filed by the public within 3 months from the date of publication.

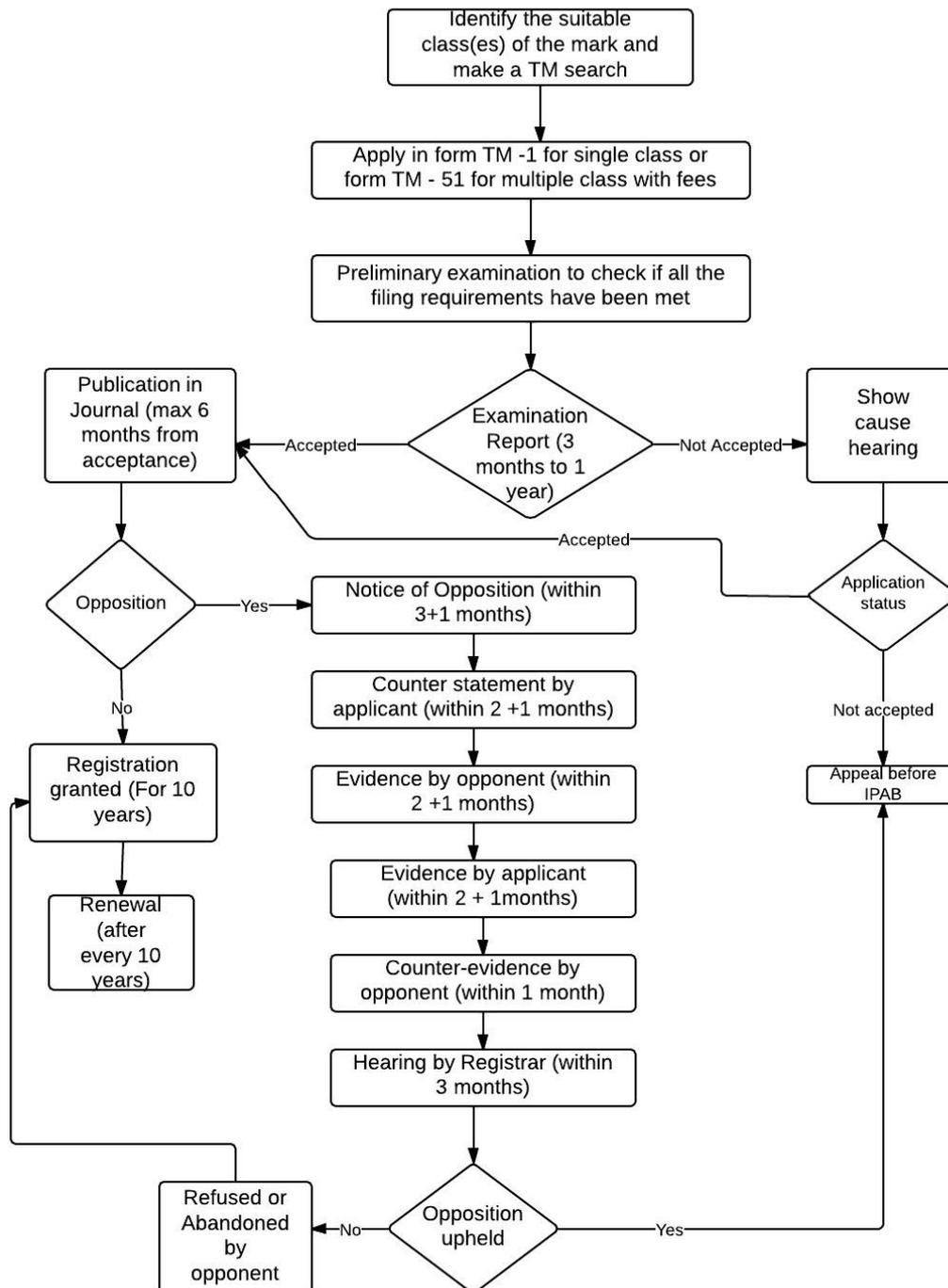
6. If no opposition is received

A certificate of registration is issued in favor of applicant.

Once your trademark is approved the registry will give you a trademark registration certificate. This will officially confirm that your trademark has been registered and is now protected.

The simplified process of trademark registration is shown below:

Trademark Registration in India



INFRINGEMENT OF TRADEMARK

A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered. **Infringement of trademark means use of such a mark by a person other than the registered proprietor of the mark.**

Absolute Grounds for Refusal of Registration

The Act provides that following marks can be refused:

1. The mark is not capable of distinguishing the good/services of one person from those of another.
2. The mark exclusively contains marks/ 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/services.
3. The mark comprises of scandalous or obscene matter.
4. The mark exclusively contains marks/ indications which have become customary in the current language or in the

established practice of the trade.

5. The mark causes confusion/deception in commerce.
6. The mark contains any matter likely to hurt the religious sentiments of any section of the citizens.
7. The mark is prohibited under the Emblems and Names (Prevention of Improper use) Act, 1950.
8. The mark exclusively contains the shape of the goods which results from the nature of the goods themselves; or which is necessary to obtain a technical result; or which gives substantial value to the goods.

Relative Grounds for refusal of Trademark Registration

Section 11 provides that a mark shall not be registered:

1. If the mark causes likelihood of confusion on part of the public i.e. likelihood of association with the earlier trademark.
2. If the mark is identical to a well-known trademark in India and use of the later mark may be detrimental to the distinctive character of the well-known trademark.
3. If the mark's use in India is liable to be prevented by law of passing off or copyright law.

The provision further

envisages that where the goods are of different description refusal will not be justified but registration may be refused if the mark is likely to be deceptive or cause confusion.

Circumstances of Trademark Infringement

Section 29 of the Act provides remedy in cases of trademark infringement. The statutory provision also enlists the circumstances under which a mark is infringed:

1. Infringement of a mark occurs when a person not being registered proprietor uses a mark which is identical or deceptively similar to a registered mark in relation to goods or services in respect of which the trademark is registered.
2. When a person not being a registered proprietor uses a registered trademark which because of its identity with registered trademark and similarity with goods or services is likely to cause confusion in public.
3. When a person not being registered proprietor of a mark uses mark, which is identical or similar to the registered trademark in relation to similar goods or services and the registered mark has a reputation in India.
4. A registered trademark is infringed by a person, if he uses such registered trademark as part of his trade name of his business concern dealing in goods

or services in respect of which the trade mark is registered.

5. A registered trademark is infringed by any advertising of that trademark if such advertising takes unfair advantage and is detrimental to its distinctive character.

Remedies for Trademark Infringement

The remedies available for trademark infringement include:

1. Injunctions;
2. Damages, including exemplary damages;
3. Accounts of profit;
4. Cost towards legal fees; and
5. Delivery up of the infringing labels and marks for destruction.

Identical Registered Trademark

If on comparison of the trademarks of the two parties in case the trademark adopted by the Defendant is identical to that of the Plaintiff, the Plaintiff may not be required to prove anything further.

However, when the two marks are not identical, then the plaintiff would be required to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trademark as is likely to deceive or cause confusion in the minds of the consumer public.

RIGHT TO APPEAL

Any Court order/decision in a suit for infringement/passing off may be appealed against before a High Court. A single judge of the High Court hears the appeal. The order in appeal could be further appealed against before a division bench of the same court. Appeal to the Supreme Court thereafter should lie only on a point of law.

Documents required for Trademark registration

The following supporting documents together with the application have to be submitted for online trademark registration: -

Business Registration Proof

On the basis of your registered business (for eg: sole proprietorship and so on), an identity proof of the company's directors and an address proof have to be submitted. In case of sole proprietorship business, id proof of the proprietor viz. PAN card, Aadhar card could be submitted.

Whereas, in the case of companies, the address proof of the company needs to be submitted.

Power of attorney to be signed by the applicant.

Legal Fees for registration INR 9000 or 10,000

If you are not a start-up, small enterprise or an individual you will fall under this bracket. Legal fees of Rs. 9,000 for e-filing of the form or

rupees 10,000 if you file the form in person.

Legal fees for registration INR. 4,500 or 5,000

If you are an individual, small enterprise or a start-up then you fall under this bracket. Rupees 4,500 is the charge for e-filing of the form or rupees 5,000 if you file the form physically.

While filling the form make sure not to make any mistakes, this may lead to delays or even rejection of the application. The full file must be then submitted with two duplicates when filing.

CONCLUSIONS

Intellectual property registration and protection is essential to safeguard logo, invention, design, etc. In case no legal protection is provided to such creative innovations, then the individual would not be able to reap the full benefits of their inventions and creativity would suffer as a result.

Hence, Trademark registration becomes an integral part of your business as it is a brand or image which is recognized by most of your customers which represents business.



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