



## Trademark registration process & trademark infringement in India

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### Abstract

Investing time and money to establish a brand only to have the same brand name utilised by someone else, robbing you of your hard-earned brand reputation, is not a pleasant situation. Many trademark (TM) owners find themselves in protracted litigation because they did not register their brand name as a trademark in India when the time came. Infringement occurs when one party, the "infringer," uses a trademark that is identical or confusingly similar to another party's trademark in relation to products or services that are identical or similar to the products or services covered by the registration. The procedure of registering a brand name as a trademark is not complicated. You'll obtain the much-needed legal protection of your brand name registration in India in a few simple steps, as outlined below.

**Keywords:** trademark process in India; form TM-A; form TM-O; trademark infringement in India; trademarks Act, 1999; documents required for different entities; penalties for trademark infringement

### Introduction

A trademark plays a vital function in product promotion and offers information about the product's quality. It permits a company to get exclusive rights to use, distribute, or assign a trademark. This can be accomplished by registering a trademark. India is a hugely competitive market for entrepreneurs and business owners, with thousands of new but identical brands/products appearing every day. Protecting your brand becomes vital in this situation to prevent others from profiting from your name or brand. A trademark is also said to be infringed when a registered trademark or a trademark deceptively similar to the registered trademark is used in relation to the goods and services for which it is registered by a person who is neither the registered proprietor nor the licensee and/or assignee of the said trademark. Infringement occurs when one party, the "infringer," uses a trademark that is identical or confusingly similar to another party's trademark in relation to products or services that are identical or similar to the products or services covered by the registration. Infringement is a violation of a registered trademark owner's exclusive right, which is controlled in India under Section 29 of the Trademarks Act, 1999<sup>[1]</sup>.

### Step By Step Procedure to Register a Trademark

The filing of a trademark registration application, examination of the trademark, publication or advertisement of the trademark, opposition (objections) if raised/found, registration of the trademark, and renewal of the trademark every ten (10) years are all steps in the process of getting a trademark registered.

**Step 1: To search for a trademark:** When selecting a trademark, the applicant must exercise caution. Because there are so many various types of trademarks accessible, it is critical to conduct a public search on the Trademarks Registry's trademark database to ensure that the trademark is original and that no other trademarks are similar or identical to his or hers.

**Step 2: To file the trademark application:** The trademark registration application can be filed in a single-class or multi-class format, depending on the goods and services that the company provides. The trademark registration application is Form TM- A<sup>[2]</sup>, which can be filed online through the official IP India website or in person at the Trademarks Office, depending on the trademark's jurisdiction. Multiple papers containing complete details of the trademark for which registration is sought must be submitted with the trademark registration application. Moreover, in case the applicant is claiming prior use in the trademark, then a user affidavit has to be filed supporting the usage along with the evidence of its prior usage.

**Step 3: Examination of the trademark application by the government authority:** After an exhaustive examination of the trademark application in accordance with the rules of the Trademarks Act, 2016, the Examiner is required to issue an obligatory examination report following the filing of the trademark application. The authority's examination report may or may not reveal any objections, which can be absolute, relative, or procedural. The Trademark Authority issues this examination report within 30 days of the filing of the registration application. Within 30 days of obtaining the examination report, a reaction to the report must be filed presenting the arguments and evidence against any objections to waive them off.

**Step 4: Post- examination:** If the Examiner (Trademark Authority) is not completely pleased with the reply filed or if the objections are not addressed, the Examiner (Trademark Authority) may schedule a hearing. After the hearing, the Examiner may accept the mark and then transmit the application to the journal for publication or reject the application if any objections remain.

**Step 5: Advertisement of the trademark:** When a trademark registration application is approved, it is advertised and published in the Trademarks Journal for a

period of four months. The purpose of the publication and advertisement is to encourage the general public to file an opposition to the mark's registration.

**Step 6: Opposition from general public:** Any aggrieved party can file a notice to dispute the registration of the advertised/published trademark once it has been advertised and published in the journal. Within four months of the trademark's publication in the Trademark Journal, a notice to oppose the trademark must be filed using Form TM-O<sup>[3]</sup>. If a trademark application is contested or objected to, the proper legal procedure must be followed, which includes filing a counter-statement application, providing proof, and holding a hearing in order to have the trademark registered.

**Step 7: Registration of the trademark:** The final step in the process is registration, which occurs once the application has overcome any objections and/or opposition to the trademark registration. Furthermore, if no objections to the trademark's registration were raised throughout the four-month advertisement/publication period, the trademark is awarded an auto-generated registration certificate within one week. After the registration is completed, it is valid for ten years, after which it must be renewed within a specified time period.

#### **Documents required in individual & sole proprietorship**

In India, any person (applicant), whether an Indian or a foreign national, can easily register a trademark. Because registering a trademark does not necessitate the formation of a legal or business entity. Aside from that, the paperwork required to register a trademark in a proprietorship's name are identical to those required to register a trademark in an individual's name, as follows:

- A black-and-white version of the proposed logo (which is optional). If the logo is not provided, a trademark application for the word might be filed instead.
- Form 48, which has been duly signed. This document serves as an authorization for a Trademark Attorney to file a trademark registration application on the applicant's behalf.
- A copy of the individual applicant's or proprietor's identity evidence, such as a passport, aadhar card, or PAN card.
- A copy of the individual applicant's or proprietor's address evidence, such as the most recent electricity bill or phone bill.

#### **Documents required for a Partnership, Limited Liability Partnership, or Company- Small Businesses or Start ups**

In India, the cost of registering a trademark ranges from Rs. 4500 to Rs. 9500.

Start-ups, small enterprises, individuals, and sole proprietorships pay a lower trademark registration price of Rs. 4500, whilst all other business entities pay a higher trademark registration fee of Rs. 9500. To be considered as a small business, individuals must now present their Udyog Aadhar registration certificate. In addition to the Udyog Aadhar registration, the following information is necessary.

#### **Partnership / Company / Limited Liability Partnership**

In the event of a partnership firm or an LLP, the entrepreneur/applicant must present the following

documents:

- Duly signed Form-48
- Scanned copy of the logo (optional)
- Udyog Aadhar Registration Certificate
- Partnership Deed or Incorporation Certificate
- Copy of signatory/ applicant's identification evidence
- Copy of signatory/ applicant's address proof

#### **Other applicants in a trademark registration must submit the following documents.**

All other applicants, including companies without an Udyog Aadhar number, must present the following documentation to achieve trademark registration in India.

- Duly signed Form-48
- Scanned copy of the logo (optional)
- Partnership Deed or Certificate of Incorporation
- Copy of signatory/identification applicant's evidence
- Copy of signatory/address applicant's proof

#### **What is Trademark Infringement?**

Trademarks in India are protected by the Trademarks Act of 1999<sup>[4]</sup>. The Act provides the rules for trademark registration, protection, and infringement penalties. Trademark infringement is defined as the unlicensed use of a mark that is identical or deceptively similar to a registered trademark. When a typical consumer examines the mark, he or she is likely to be perplexed as to the origin of the goods or services. Trademark infringement is the unlicensed use of a trademark or service mark on or in connection with products and/or services in a way that is likely to cause confusion, deception, or error about the source of the goods and/or services.

#### **Trademark Infringement Penalties**

In India, trademark infringement is a cognisable offence, meaning the offender could face criminal and civil penalties. Indian law does not require the registration of a trademark in order to initiate civil or criminal proceedings. As previously noted, this is related to the common law concept of passing off. In the event of trademark infringement, the court may grant the following remedies:

1. Temporary injunction
2. Permanent injunction
3. Damages
4. Account of profits (damages in the amount of the profits gained from the infringement)
5. Destruction of goods using the infringing mark
6. Cost of legal proceedings

In the event of a criminal case, the court will impose the following penalties:

1. Imprisonment for a period not less than six months that may extend to three years
2. A fine that is not less than Rs 50,000 that may extend to Rs 2 lakh

#### **Conclusion**

Trademark registration gives the owner an exclusive right and distinguishes the product from comparable products sold by other companies. For the owner, a trademark serves as an intangible asset that protects the brand for a long time. The owner of a trademark has the exclusive right to use such phrases, logos, and slogans. It is critical for a brand to be safeguarded and safe in a market like India. As a result,

having a trademark registration in India is vital not because it is required, but because it is necessary.

**References**

1. Trademarks Act, 1999
2. Trademark under section 18 (1) or 18 (2) of the Trademarks Act, 1999
3. Apply for a notice of opposition under section 21(1), 64, 66 or 73 of the Trade Marks Act,1999,
4. Section 29 of Trademarks Act, 1999