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# India - FAQ's on registering your brands

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## **What are the different kinds of mark that can be registered as trade marks under the Indian *Trade Marks Act*?**

- Word marks, logos, slogans, signatures, names, devices, labels, numeral(s) and/or any combination of these
- Combinations of colours
- Shape of goods
- 3-dimensional marks
- Sound marks
- Smell marks (None have so far been registered).

## **Is registration of a trade mark essential?**

Registration of a trade mark is not essential; unregistered marks can be protected in India by means of a passing-off action. Registration is, however, advisable; it is prima facie proof of validity and ownership of the trade mark.

## **Who can apply to register a trade mark?**

Any person claiming to be the proprietor of a trade mark can seek registration. The application can be filed either on the basis of actual use (prior to the filing of the application) or intention to use.

## **Are service marks registrable in India?**

Yes, since the enactment of the *Trade Marks Act, 1999*, service marks are registrable. However, India still follows the 7th Edition of the International Classification of Goods and Services, which contains only 42 classes. Applications for registration of services that would fall within Classes 43 – 45 under the 9th Edition of the International Classification, should, in India, be filed in Class 42.

## **Can you use the symbol ® in connection with trade marks in India?**

It is not only permissible, but also advisable in India to use the symbol ® next to a registered trade mark. Use of this symbol will put third parties on notice of the registration. Using the symbol in connection with an unregistered trade mark, however, will amount to a false representation, which is a punishable offence.

## **What documents are required when filing a trade mark application in India?**

- Description of the mark i.e. whether it is a word mark or a logo or device. If it is a logo or device mark, a representation of the mark must be provided.

- Class/es in which registration is sought (as per the 7th Edition of the International Classification of goods and services).
- Goods/services in respect of which registration is sought.
- Date of first use of the mark in India. Where the mark has not been used, confirmation that the mark is 'proposed to be used' should be provided.
- Name, address, legal status and trade description of the Applicant.
- Authorisation of Agent (this can be filed later).
- Where a priority claim is being made, a certified copy of the priority document together with a certified English translation (if the priority document is not in English). The priority document must be filed within two months of the date of filing the application.

### **Next step once an application for registration of a trade mark has been filed?**

Once an application has been filed, the Trade Mark Registry will issue an Examination Report which may contain a refusal to register on either absolute and/or relative grounds, and/or other requisitions. The Applicant has 30 days from receipt of the Report within which to submit its written response. This period may be extended by one month by filing a request and paying the official fees.

### **What are the absolute grounds for refusal to register?**

The absolute grounds for refusal include that the mark:

- is devoid of distinctive character;
- is generic or common to the trade;
- is likely to deceive or cause confusion;
- is likely to hurt religious sensibilities;
- is scandalous or obscene; or
- that registration of the mark is prohibited under the *Emblems and Names (Prevention of Improper Use) Act*.
- is identical with or similar to an international non-proprietary name (INN).

### **What are the relative grounds for refusal?**

The Registrar can refuse to register a mark on the ground that it is identical with or similar to an earlier mark that has been registered in relation to similar goods or services.

### **If the Registrar does not accept the applicant's written submissions, will the Registrar allow a hearing?**

In this situation, there will usually be a hearing.

## **What is the procedure once acceptance of a trade mark application has been published in the Trade Marks Journal?**

Once acceptance is published in the Journal, the trade mark application will be open to opposition from interested third parties for a period of up to four months from the date of publication of the acceptance. If no opposition is lodged by a third party during this period, the application will proceed to registration. The registration will be valid for a term of 10 years from the date of filing.

## **How long does it take for a mark to be registered?**

If no substantial objection is raised at the examination stage, and no opposition is filed (by a third party) on publication of acceptance of the application, the mark will generally be registered within 18 to 24 months of the date of filing.

## **Can the applicant appeal a refusal to register?**

In the event of a refusal to register, the applicant can appeal to the Intellectual Property Appellate Board. The appeal must be filed within three months of receipt of the refusal order.

## **Can a mark be registered as a 'well-known' mark under the Indian *Trade Marks Act*?**

There are no provisions in the Act for the registration of a mark as a 'well-known' mark. Marks can, however, be protected as well-known marks and the Act sets out the facts that should be taken into account when determining whether or not a mark is 'well-known'. These are:

1. The knowledge or recognition of the trade mark in the relevant section of the public, including knowledge in India obtained as a result of promotion of the trade mark in or outside India;
2. The duration and extent of use of the trade mark;
3. The duration and extent of promotion of the trade mark, including advertising or publicity and presentation at fairs or exhibition of the goods or services to which the trade mark is applied;
4. The duration and geographical scope of any registration of the trade mark, to the extent they reflect the use or recognition of the trade mark; and
5. The record of successful enforcement of the rights in the trade mark; in particular, the extent to which the trade mark has been recognised as a well known trade mark by any Court or Registrar.

The Act further provides that the Registrar shall, while determining whether a trade mark is known or recognised in a relevant section of the public, take into account the following: number of actual/potential consumers of the goods or services; number of persons involved in the channels of distribution of the goods or services; and the business circles dealing with the goods or services.

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