

## TRADEMARK REGISTRATION AND APPLICATION PROCESS

The trademark registration has benefits attached to it. A registered trademark has the following advantages:

- Exclusive rights to the brand/company by enjoying sole ownership of the trademark throughout the jurisdiction where the trademark is registered, thereby stopping others from the unauthorised use of the trademark for the products or services for which the trademark is registered. The brand/company has legal rights to file an infringement suit against third party infringers against unauthorised use of the trademark.
- It helps to build brand/company's goodwill and reputation by establishing trust among the customers in the market.
- It helps to distinguish the brand/company's products or services from that of others and helps the general public or the consumers to identify the brand/company by its trademark. A trademark designates the characteristic of the brand/company.
- It helps consumers or the general public to associate quality of the products with the brand/company's name thereby helping in gaining customer base.
- Registration of trademark forms an intangible asset which is the intellectual property of the brand/company, which can be further licensed, assigned or franchised to third parties in exchange of royalties.



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- Third party infringers can be restricted to the registered trademark and the brand owner can get the legal protection under the Trade Marks Act, 1999.

The symbol  is used to denote that the trademark has been applied for by the brand owner and is pending for registration. Also, this symbol can be used for all trademarks even if the application for registration has not been applied for, to claim use over the mark.

The symbol  is used to denote that the trademark has been registered and the brand owner has exclusive rights over the same. This symbol can be used only after the trademark is registered.

Any person who claims to be a proprietor or owner of trademark can file an application for registration of a trademark on proposed to be used (intent to use) basis or on prior use basis. As per Section 7, the goods and services have been specified in accordance with the International Classification (NICE) of goods and services. The proprietor or owner of trademark can search for the class of trademark by putting in key words related to the goods or services provided under the trademark for which the application has been filed.

The information/documents required to file a Trademark application are:

- The particulars of the proprietor/owner (applicant);
- If the applicant is a company, the incorporation details and in case it is a partnership firm, then details of the partners;
- Whether the applicant is an Individual, Start-up or a small enterprise;
- Details of goods or services for the trademark is in use or is proposed to be used;
- Image of the trademark in case it is a device mark;
- Priority details and documents in case the application is claiming priority from an earlier filed application in another country;
- If the trademark application is filed on a prior use basis, the application is to be accompanied with an affidavit of use. The affidavit of use is to be filed by the proprietor or owner of trademark detailing the use of the trademark sought registration, with respect to the class of goods or services for which the application is being filed for. The evidence substantiating such use of the said trademark is to be attached along with the affidavit of use;
- The Power of Attorney signed by the authorized representative of the applicant authorising the trademark agent/lawyer to act and represent on behalf of the applicant.

The applicant is charged a reduced official fee if the applicant is:

- an Individual
- a Start-up
- a Small Enterprise

In order to claim the said reduction the trademark application is to be accompanied with the required evidence substantiating the nature of the applicant.

An initial trademark search may be conducted on the trademark portal to check if a same or similar mark exists on the register. The search is optional but it is advised to conduct the same prior to filing so that the proprietors or owners are aware of the chances of registrability of trademark before filing.

Upon filing of the trademark application with the Registry, the application is first examined by the Registry for any formal objection. If the Registry is satisfied the application is then examined on relative and absolute grounds for refusal of mark and an examination report is issued. The mark is examined on the following important grounds:

- Distinctiveness
- Descriptiveness
- Similarity to the prior marks

To qualify for registration, mark should be distinctive, non-descriptive, and there shouldn't be any similar prior marks. The Registry may take around 8 – 10 months for issuance of examination report. Within one month of issuance of examination report reply is to be filed with the Registry. Once the reply to the objection raised in the examination report is filed and the Registrar is convinced with the reply then the application proceeds for publication else the application is put up for hearing.

Upon hearing if the Registrar is convinced the application is published in the trademark journal. If, within a period of four months from the date of publication of the mark in the journal, the application is not opposed the application proceeds for registration and registration certificate is issued and the trademark is recorded in the register of trademarks.

The register is being maintained in e-form and contains details of the class of goods/services including the goods/services details in respect of which the trademark is registered including

particulars of the proprietor/owner of trademark; type of trademark; priority details; prior use details; validity detail.

Registration of a Trademark is not mandatory to register a trademark. However, registration is prima facie evidence of ownership of a trademark from the date of trademark application and it allows the trademark owner to institute infringement proceedings against the infringer. A trademark owner cannot institute a suit for infringement of unregistered trademarks and an action of passing off of goods or services can be taken against the third party indulged in unauthorised use of the said trademarks.

In India prior use of a trademark is favoured over prior registration of a trademark as the trademark law recognises first to use. Hence, a registered owner cannot restrain a third party from using a trademark identical/similar to the registered trademark, if the third party has been continuously using the mark in relation to the same goods or services for which trademark is registered, provided the third party is a prior user of the said trademark when compared to the date of use or date of application of the registered mark, whichever is earlier.

The details of a trademark application can be amended post filing of the same or post registration of the trademark the filed mark. The applicant is required to file the requisite form along with prescribed fee for recordal of amendment. Any amendment is allowed by the trademark Registry provided it does not amount to any substantial change in the trademark application or the trademark itself.

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