

LÉGALÍCS

Registration of Trademark

The information provided herein is of general nature and not intended to address the circumstances of any particular individual or entity. Although we endeavour to provide accurate and updated insight, there can be no guarantee that such information is accurate as on date.

Procedure for Registration of a Trade Mark:

- Proprietor of the trademark is entitled to obtain registration by filing a request in the prescribed manner and on payment of the requisite fee.
- The application is numbered as per serial order and date. The application number and date of filing become the registration number and date of registration respectively provided the application is able to overcome the objections as may be raised by the Registrar under Section 9 and/or Section 11 of The Trade Marks Act, 1999 and the opposition proceedings, if any, initiated by third party.
- After filing the application, it is examined by the Registrar on the basis of the data it possesses concerning the earlier registered marks or pending applications. Examination generally takes place within 3-4 months of filling of Trademark application.
- The Registrar may accept the application to proceed for publication or direct the same to proceed for publication before acceptance.
- If the application is in conflict with earlier registered or pending marks in respect of same or similar goods and the applicant claims concurrent or parallel rights on the ground of honest and bonafide adoption, the Registrar may waive objections and accept the application for registration irrespective of earlier conflicting marks.
- On publication of the mark in the official gazette namely the Trade Marks Journal, any person can oppose the grant of registration by filing a notice of opposition within the prescribed period of time of 4 months.
- If an application is opposed, the rights of the applicants and opponents are determined in accordance with the provisions of the Trademark Act and/or the common law rights which the parties may claim. Such determination is made by the Registrar after following the due process of law, procedure and providing an opportunity of being heard to the respective parties.
- Registration of a mark can be opposed by any person on any of the grounds enumerated under Sections 9, 11 and 18 of the Trademark Act. The opposer can file, as a ground of opposition that the mark applied for registration is:
 - a) Not distinctive
 - b) Not capable of distinguishing
 - c) Descriptive
 - d) Has a direct reference to the character and quality of the goods

- e) Is a geographical term which in its ordinary significance has come to be known for a particular kind of quality of goods
- f) It comprises or contains scandalous or obscene matter or its use is prohibited under the Emblems and Names (Prevention and Improper Use) Act, 1950
- g) Its identity with the earlier trade mark and/ or similarity of the goods covered by the earlier mark
- h) The use thereof is likely to cause confusion and / or deception and is liable to be prevented under the laws of passing off or by virtue of law of copyright
- i) A person applying for registration is not the proprietor of the mark and the application has been filed in back date

➤ The Opposition procedure is explained as under: -

- a) The Opposition Notice is filed in Form No. TM-5 within 4 months from the date of publication of the Trademark.
- b) The Trademark Registry office sends one copy of the Opposition Notice on TM – 5 to the Applicants
- c) The Applicants sends his Counter- Statement in triplicate in Form No. TM- 6 to the Trademark Registry
- d) The Trademark Registry then sends one copy of the Counter Statements to the Opponents (who have filed TM –5).
- e) On receipt of the Counter Statement, the opponent file their evidence by the use of Affidavit supported by documentary evidence of the use and advertisement of the mark to the Trademark Registry and also sends one set of his evidence to the Applicants simultaneously.
- f) On receipt of the documents from the opponents, the Applicants file their evidence by way of Affidavit and documentary evidence of the use and advertisement of the mark to the Trademark Registry and one complete set to the opponents.
- g) On receipt of the documents from the Applicants, the opponents file their rebuttal evidence within 1 month.
- h) After completion of these formalities, the Trademark Tribunal fixes a date and time for addressing arguments by both the parties through their attorneys.

➤ The decision of the Registrar made in the opposition proceedings can be challenged by the aggrieved person by filing an appeal before the Intellectual Property Appellate Board/ High Court.

➤ In the absences of opposition, a Trademark is registered, and the certificate of registration is issued for 10 years from the date of filing of an application. Presently, it takes 24-30 months from the filling of the Trademark application to the final registration of the Trademark.

- It is imperative for a proprietor to seek renewal of registration before the expiry of the validity, failing which the mark becomes liable to be removed from the Register on account of non-renewal.
- The request for renewal of a trademark can be filed 6 months prior to the expiry of the validity of registration.
- If the registered proprietor of the trademark is not vigilant in renewing the registration either prior to the expiry or within 1 year after the expiry of validity, the mark shall stand removed from the register of trademark and would not qualify to be renewed. In such a scenario, the proprietor will have no other option but to file a fresh application for registration and to go through the same procedural requirements as if the said application was a fresh application for registration.

TRADEMARK REVIEW

When filing a Trademark application, your mark will go through two main types of review. First, the trademark registry will review your application to determine whether or not you have met the minimum filing requirements. Next, the application is forwarded to a trademark examiner. The examiner will then review the application to determine whether it complies with all applicable rules and statutes and includes all required fees for filing a Trademark. A complete examination includes a search for conflicting marks, and an examination of the written application, the drawing, and any specimen. If the examining attorney decides that your mark should not be registered, he or she will send out a report, called an examination report, explaining any substantive reasons for the refusal, as well as any technical or procedural problems with your application. If the examiner sends an examination report with objections, your response to the objections must be received within a month of the receipt of the report, or the application will be declared abandoned.

If your response does not overcome all of the examiner objections, the examining attorney will give you an opportunity for a personal appearance.
