

INDIA IP SME HELPDESK

FACTSHEET

1. Introduction

2. Trade Marks in India: What you need to know

- A. What can be protected as a trade mark
- B. What cannot be registered as a trade mark
- C. Goods and services Classifications
- D. First-to use principle
- E. How long does trade mark protection last?
- F. Types of trade marks
- G. Geographical Indications and trade marks

3. Trade Mark Registration in India

- A. In what language should the procedure be conducted?
- B. How long does the registration procedure last?
- C. Routes to Trade Mark registration in India
- D. The process
- E. Costs

4. Trade Mark Enforcement in India

- A. Requirement of registration
- B. Civil Remedies
- C. Criminal Sanctions
- D. Customs

Guide to Trade Mark Protection in India



1. Introduction

Trade marks are the intellectual property rights which protect the brands, logos and other commercial signs which a business uses in the course of business to advertise, promote, or simply identify itself or its products to customers and the public at large.

Trade marks are a strategic tool through which businesses can enhance their image, make their products stand out, and in general identify themselves in relation to their target customers. Protecting their brands with the use of the legal mechanisms afforded by trade mark registration should be an inherent and central part of any business' strategy when internationalising: failing to do so may lead to competitors using these same signs, or confusingly similar ones, in order to attract unaware customers.

As is the case of all IP rights, registered trade marks are territorial in nature, meaning that they are only valid and have a legal weight where they have been registered. A trade mark registered in Europe will have no legal effect in India and can therefore not be enforced there. As will be seen, while India does afford some level of protection to unregistered trade marks, EU SMEs willing to enter, or already active in, the Indian market should not rely on this and rather prefer the safer, formal registration route.

The Trade Mark Registry, administered by the Office of the Controller General of Patents, Designs and Trademarks (CGPDTM), is the authority in charge of granting trade marks registrations in India. According to [WIPO's 2019 statistics](#), India is among the top ten countries to record the highest trade mark filing activity and accounts for the third-highest number of active registered trade marks worldwide.

Although the Trade Mark Registry has several offices located throughout the country in Mumbai, Ahmedabad, Kolkata, New Delhi and Chennai, the substantive and administrative rules related to the protection of trade marks remain homogenous across all offices.

2. Trade Marks in India: What you need to know

A. What can be protected as a trade mark

Under the Indian Trade Mark Act of 1999, a trade mark is defined as any mark (symbol in trade) which can be graphically represented and is capable of distinguishing the goods or services of one person from those of others.

As such, the following marks can be registered in India: names, words, numerals, letters, devices, slogans, signature, 3D marks, a combination of colours, the shape of goods and their packaging, and sound marks.

Note that, as is the case in Europe, a shape mark cannot be registered if the shape results directly from the nature of the goods themselves, is necessary to obtain a technical result, or gives substantial value to the goods.

TIPS AND WATCH-OUTS:

Non-traditional trade marks in India

Registration of a sound mark is an extremely rare event in India, and it cannot be registered prima facie without evidence of factual distinctiveness.

Unlike the trade mark registration requirements in Europe, Indian law still requires a trade mark to be represented graphically to be eligible for registration. So far, this means that while smell marks are not excluded as unregistrable signs, they are not being registered due to a lack of fulfilment of this requirement.

B. What cannot be registered as a trade mark

In India, as in Europe, there exist two main types of grounds on which a trade mark application might be rejected by the Trade Mark Office: absolute grounds, which refer to deficiencies related to the proposed sign per se; and relative grounds which refer to the inability of the proposed sign to distinguish the goods or services due to its similarity with pre-existing trade marks (but which would otherwise be registrable).

i. Absolute grounds in India

The following marks cannot be registered as trade marks according to the Indian Trade mark Act:

- A trade mark that is devoid of any distinctive character. This means that it is not capable of distinguishing the goods or services of one person from those of another person.
- A trade mark that consists exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.
- A trade mark which consists exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.

However, if such a trade mark has acquired a distinctive character as a result of the use made of it or is a well-known trade mark, it may be registered. In such case, the applicant must provide evidence of such acquired distinctiveness.

Further, the following marks can also not be registered as trade marks:

- A mark that can deceive the public or even cause confusion as to the nature, quality or geographical origin of the goods or services (e.g. using the word “vegan” for a product containing meat).
- A mark which hurts the religious susceptibilities of the citizens of India.
- A scandalous or obscene mark.
- Any symbol prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950. The full list of related signs can be found [here](#).

The nature of goods or services for which the mark is used is not considered a relevant ground for refusal.

ii. Relative grounds in India

These cover the trade marks which are not “available”, as they are already being used by another party. In that sense, the following trade marks cannot be registered:

- Signs identical with an earlier trade mark and covering similar goods or services; or
- Signs similar to an earlier trade mark and covering identical or similar goods or services,

for which there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.



A trade mark that is identical with or similar to a well-known mark in India cannot be registered even for dissimilar goods or services if the later mark would take without due cause unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

Furthermore, trade mark registration may also be refused for signs which, while not already registered as a trade mark by a third party, is nonetheless protected by law under copyright. This can include names of literary characters, etc.

Finally, EU SMEs looking to register a trade mark in India must also be aware of the importance of unregistered trade marks in the territory. Indeed, a trade mark application may be refused on the basis that the applied sign is too similar to an unregistered trade mark which would be protected under the rule of “passing-off”. Under this rule, the holder of an unregistered trade mark can still enforce some rights over this sign if it can demonstrate that it has obtained “goodwill”, i.e. a certain reputation.

Note that business names as such do not amount to an earlier right preventing the registration of a trade mark. Nevertheless, if it can be demonstrated that a business name was also used as an unregistered trade mark, i.e. in the course of trade towards the public, then it may indeed impede the registration of a trade mark or give rise to an action for passing-off.

Notwithstanding the above, it should be noted that the Indian Trade Mark Office respects coexistence agreements signed between an applicant willing to register a new trade mark and a third party. Therefore, in case there is a clash between two trade marks, the owners of each trade mark may reach an agreement allowing the registration of the later mark, which the Indian Trade Mark Office will respect.

TIPS AND WATCH-OUTS:

The Examiner's role

In India, the examiner will not only examine the trade mark application on the basis of the absolute grounds (checking whether the sign is capable of being a trade mark), but also on the relative grounds.

This is different from EUIPO and most trade mark offices in Europe, where the examiner only examines the trade mark for registration on absolute grounds of refusal, the relative grounds described above only being enforced in case a third party presents an opposition to the trade mark registration on the basis of their earlier right.

C. Goods and services Classifications

The registration of a trade mark is necessarily done in relation to specific goods and services, and the application must specify for which registration is sought. For this purpose, the International [Nice Classification](#) system, categorizing goods and services within 45 different classes, is used.

An application for registration of a single trade mark may be made in respect of goods and services in one or more classes. However, it is to be kept in mind that a specification that claims registration for all goods, products, or services etc. in a particular class would be regarded as too wide.

TIPS AND WATCH-OUTS:

TMClass

The TMClass tool developed by the EUIPO can be used since the tool specifically includes the Indian trade mark office while classifying and highlighting goods and services that may not be acceptable by the Indian trade mark office.

D. First-to use principle

Indian law follows the “first to use” principle. Hence, whoever uses the trade mark first has in principle a superior right even though the subsequent user is the holder of the registered trade mark.

Details of a trade mark's use are a mandatory part of the application for registration, when the applicant claims the trade mark's prior use. Consequently, the applicant has to submit an affidavit of use and documentary evidence to support the claim of the use along with the application.

E. How long does trade mark protection last?

The registration of a trade mark lasts for ten years. The trade mark can be renewed indefinitely.

An application for the renewal of a trade mark should be filed at any time during the six months prior to the expiration of the last renewal. In some cases, a late renewal may also be possible.



It is important to note that trade marks which have not been used for more than five consecutive years are subject to cancellation: any party can seek to remove a registered trade mark from the register. Trade mark holders in India should therefore make sure that they use their registered trade mark within 5 years following registration, and keep records/evidence of such use to avoid any problems.

F. Types of trade marks

Apart from the “classical” trade marks widely known, EU SMEs should also be aware that other types of trade marks exist, and can be protected both in the EU and in India. It is also possible to register the following two categories of marks under the Trade mark Act:

- Collective Mark, a mark that belongs to a collective group or association of persons.
- Certification Mark, a mark which certifies that the product or service to which it is attached is of specific standard or quality.

G. Geographical Indications and trade marks

Geographical Indications (GIs) are a separate type of sign which indicate the geographical origin of a good (as opposed to trade marks which identify goods or services as coming from a specific producer).

GIs in India are protected under a separate legislation -The Geographical Indications of Goods (Registration and Protection) Act, 1999 The following are the essential requirements for protecting a mark as GI:

- GI has been limited only to **goods**, services are not included
- These goods could fall under any of these three **categories**: agricultural goods, natural goods or manufactured goods or any goods of handicrafts or of industry and includes foodstuff. In contrast, there is no GI protection system for industrial and handcraft goods at EU level. A certain level of protection is offered under EU or national collective trade marks, or other means like unfair trade practices laws. In addition, certain EU Member States provide specific GI protection for non-agricultural products at national level.
- GI may be any **indication** and not necessarily only a geographical denomination.
- These goods should **originate from or be manufactured** in the said territory to which they are linked. In the case of manufactured goods, it is sufficient that only one of the manufacturing steps (production or processing or preparation) takes place in the concerned territory.
- **Quality, reputation or other characteristics; due to both natural or human factors** of such goods is essentially attributable to its geographical origin.

Unregistered GI can be enforced in India in case of prior use. If there is prior use of a European GI in India and if the same can be proved through documentary evidence such as invoices, export figures, publicity and promotional documents etc., a European GI can be enforced in India. If such use cannot be proved, a GI must be registered with the Geographical Indications Registry in India for successful enforcement.



3. Trade Mark Registration in India

A. In what language should the procedure be conducted?

Trade Mark applications should be filed with the India Trade Mark Office in English or Hindi, one of the two working languages of the office.

In case the sign proposed for registration is (or contains) a word in a language which is neither English or Hindi, a translation of said word must be provided. Failure to do so will constitute a deficiency in the application, and will delay the whole procedure.

B. How long does the registration procedure last?

A trade mark application in India takes about eighteen to twenty-four months to be processed, from filing to registration, if no objections and oppositions to the application are filed. The procedure may take a few more months in these cases.

C. Routes to Trade Mark registration in India

There exist two different routes through which a trade mark application may be filed in India: the national route (filing an application directly in India), and the so-called “international route”, through the International Registration System, or “Madrid System”.

- **The national route:** the applicant may file an application directly with the Indian IP Office. It should be noted that while a trade mark attorney or agent is not required for filing a trade mark application in India. However, applicants must provide an address in India. This means that in the case of applicants with no place of business in India and no legal address, a local representative must be selected.

Whilst not a legal requirement, it is always recommended to elect a specialised trade mark attorney as agent to act in the name of a foreign applicant.

A trade mark application can be filed physically by visiting the office, and online through an E-filing Portal. In an attempt to encourage e-filing, the applicant pays a reduced fee when e-filing the application.

- **The international route:** The Madrid System is an international system to obtain trade mark protection for a number of countries which are signatory to the Madrid Protocol, using a single application. The member states of the EU and India are parties to the Madrid Protocol.

Before you can file an international application, you need to have already registered, or have filed an application, at the trade mark office of your home country. Then the international application can be filed with the trade mark office in your home country which will be forwarded to WIPO for formal examination. After approval, WIPO notifies trade mark offices in all countries in which the applicant wishes to obtain protection. If, within 18 months from the notification no objections are made, the trade mark will be registered.

D. The process

The first step is to file the trade mark application, through one of the two channels described above. A trade mark application must include the following information to be accepted by the examiner:

- Name and e-mail id of the applicant
- Main place of business
- Address for service + the address in the applicant’s home country
- Type of mark
- Priority date in case of priority is claimed
- Two representations of the mark
- Description of the trade mark
- Specification of goods and services
- Translation and transliteration of the applied mark if the applied mark contains words in a language other than English/Hindi and/or characters other than Roman/ Devnagri.
- Signature, date, and place

TIPS AND WATCH-OUTS:

Claiming priority for trade marks

A person who has made an earlier application for the registration of the same trade mark in another country has six months to apply for trade mark registration in India and claim priority.

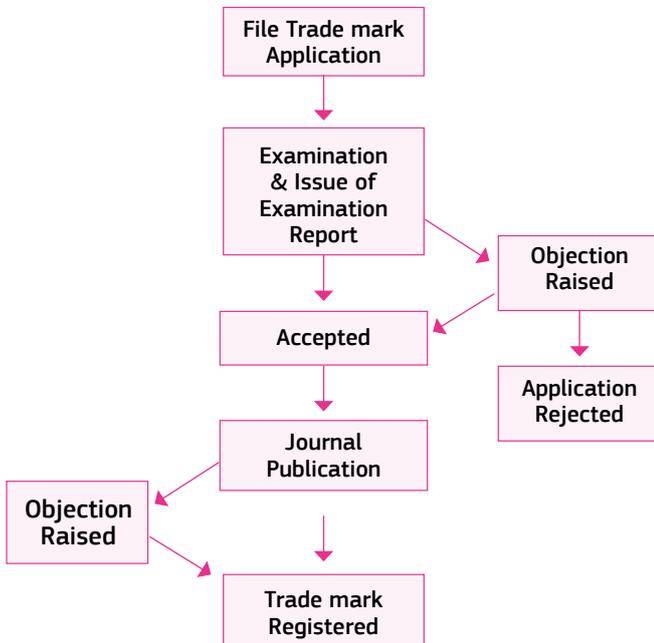
“Claiming priority” means that your trade mark application in India will be examined on the basis of the filing date of the first application (“priority date”). Any other trade mark filed by third parties after the “priority date” but before you file the application in India will be ignored, since you will have priority over this trade mark by virtue of your earlier application filed in another country.

Once an applicant files for registration, a trade mark application goes through the following steps:

1. Examination and Examination Report: the trade mark application is examined for both absolute and relative grounds of refusal. The examination report is issued either accepting or objecting to the trade mark application.
2. Response to the Examination Report: The applicant has one month from the date of issue of the Examination report to respond to the objections.
3. Journal publication: if the trade mark application is accepted (after a satisfactory response to any objection if necessary) it is then published in the official trade mark Journal.
4. Opposition: within four months of publication of the trade mark in the Official Journal, any person can oppose the registration of the trade mark.

In case no opposition is filed, the mark proceeds to registration.

Below is a simplified version of the trade mark registration process:



The applicant is not required to perform a trade mark search before filing an application, however, it is highly recommended. For this purpose, [trade mark Search Databases can be used](#).

E. Costs

In India, start-ups and small entities can benefit from reduced official fees. The applicants who declare themselves as start-ups or small entities are required to provide evidence that they meet the related criteria in regard to size, turnover, period of incorporation or registration, which is also applicable for foreign applicants. Foreign entities which comply with the following requirements can claim these benefits:

- Small Entities are businesses with an annual investment in machinery/equipment which does not exceed 100,000,000 INR (approximately 1,140,000 EUR) and an annual turnover which does not exceed 5,00,000,000 INR (approximately 5,700,000 EUR).
- Start-ups are entities which have been in existence for less than 10 years, and have a turnover which does not exceed 1,00,000,000 INR (approximately 11,402,120 EUR).

The cost for the trade mark registration is **52 EUR** for SMEs and, **116 EUR** for larger entities for the other applicants, per class of goods and services. Renewal fees amount to **101 EUR** per each class and each mark for all applicants.

These amounts only include the official fee for filing registration of a trade mark. Trade mark agents will charge additional service fees, which might raise the full cost of the protection. The costs expressed in EUR are subject to change due to variations in the exchange rate with the local currency and only serve as guidance.



4. After the patent is granted

A. Requirement of registration

It is not compulsory to get a trade mark registered. However, no suit of infringement is possible for an unregistered trade mark.

Unregistered trade marks are protected in India through the legal concept of “passing-off”. An action against a third party using an unregistered trade mark can be brought for “passing-off” if the following three elements can be demonstrated:

- The plaintiff must demonstrate that he has “goodwill” in India, i.e. that the sign and the business associated to it have a reputation in India on which its business depends;
- The plaintiff must demonstrate that the sign used by the defendant is deceptively similar;
- The plaintiff must demonstrate economic loss and damage to the aforementioned goodwill as a consequence of the defendant’s actions.

Launching an action for passing-off against an Indian competitor is not necessarily the most advisable course of action for EU SMEs: demonstrating goodwill can be particularly hard, especially if the SME has not been active for a long time in India, and so can be demonstrating actual losses. Furthermore, passing-off is a common-law remedy, i.e. one created through judicial precedent, as opposed to trade mark infringement which is precisely defined by law, making litigation more complex and uncertain.

For these reasons, it is strongly recommended to EU SMEs to prefer the formal registration route for the protection of their trade marks and to not rely on the legal protection of unregistered trade marks in India as normal course of action.

B. Civil Remedies

An infringement suit can be filed for enforcing the rights of a registered trade mark. In such trade mark disputes, the district court is considered as the court of first instance. The decision of

the district court can be appealed at the High Courts, and finally, the decision of the High Courts can be appealed by way of special leave petition at the Supreme Court of India.

The following remedies are available in case of a civil proceedings:

- Damages or accounts for profits
- Discovery of documents
- Injunction against future violations
- Civil search and seizure orders

The appeals from the Registrar’s decision under the Trade mark Act, 1999 were heard by the Intellectual Property Appellate Board (IPAB) until its abolishment in 2021. The High Court is now vested with the power to hear appeals.

C. Criminal Sanctions

Criminal remedies are also available in against infringement, in case of registered trade marks or passing off, in case of unregistered trade marks in India. This may include fine, or imprisonment. Criminal search and seizure orders can only be carried out by a police officer not below the rank of deputy superintendent or equivalent after obtaining a certificate of opinion from the registrar.

D. Enforcement of Patent Rights in India

Registration with the Customs Department of one’s IP ensures protection at the borders. By registering a trade mark with Customs in India, a trade mark holder facilitates the enforcement of his rights at the border. Registration can be done online, on the [Indian Customs IPR Recordation Portal](#). The trade mark holder is required to provide the details of the person or country suspected of exporting counterfeit goods to India. Once this is done, seizure of suspected counterfeit goods is carried out suo moto by the Customs.

Even when the IP is not registered with the Customs, the clearance of imported goods can be suspended if the Customs has prima facie evidence or reasonable grounds to believe that they infringe a trade mark.





GUIDE TO PATENT PROTECTION

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