

Trademark in India

Emerging economies like India and China are the new investment hub for the developed countries. On the one hand the emerging economies provide cheap labor, low cost resources and educated professional but on the other hand businesses are exposed to certain unseen losses like infringement of Intellectual Property. Many a times corporations / businesses do not take adequate steps for protection of their brand and intellectual property while doing business in emerging economies, as a result they either lose brand value or valuable intellectual property like trademark and patents. The registration and protection of trademark in India is governed by Trademark Act, 1999 and trademark rules and regulations.

APPLICATION FOR TRADEMARK

In India the proprietor of the trademark can apply for the registration of its mark for goods as well services. A person may apply for registration of a trade mark to the Trademark office under whose jurisdiction the principal place of the business of the applicant in India falls. In case, the principal place of business is outside India, then the application can be filed in the Trademark office under whose jurisdiction the office of the lawyer appointed by the proprietor is located.

In case of a company about to be formed, anyone may apply in his name for subsequent assignment of the registration in the company's favor.

Before making an application for registration it is prudent to conduct a trademark search in the Trademark office in context of the already registered trademarks to ensure that registration may not be denied in view of resemblance of the proposed mark to an existing one or prohibited one.

WHY TO REGISTER A TRADEMARK?

The registration of a trade mark confers upon the owner the exclusive right and allows the use of the registered trade mark and indicate so by using the symbol (R) in relation to the goods or services in respect of which the mark is registered and seek the relief of infringement in

appropriate courts in the country. The exclusive right is however subject to any conditions entered on the register such as limitation of area of use etc.

REGISTERING AUTHORITY FOR TRADEMARKS

Trademarks are registered in the trademark offices located in different parts of the country. In India the Trademark Register offices are located as per the territorial jurisdiction in Mumbai, Ahmadabad, Kolkata, New Delhi and Chennai respectively.

REMEDIES FOR INFRINGEMENT OF TRADEMARK IN INDIA

Two types of remedies are available to the owner of a trademark for unauthorized use of his or her mark or its imitation by a third party. The remedies are:

- an action for infringement' in case of a registered trademark; and
- an action for passing off' in the case of an unregistered trademark

While former is a statutory remedy, the latter is a common law remedy. In an action involving infringement or passing off, a court may grant relief of injunction and/or monetary compensation for damages for loss of business and/or confiscation/destruction of infringing labels and tags etc.

Although registration of trademark is prima facie an evidence of validity of a trademark, yet the registration cannot upstage a prior consistent user of trademark, for the rule is 'priority in adoption prevails over priority in registration`.

Successful plaintiffs are entitled to a wide range of remedies. Such plaintiffs are routinely awarded injunctions against further infringing or diluting use of the trademark.. In trademark infringement suits, monetary relief may also be available, including: (1) defendant's profits, (2) damages sustained by the plaintiff, and (3) the costs of the action. Damages may be trebled upon showing of bad faith. In trademark, however, damages are available only if the defendant willfully traded on the plaintiff's goodwill in using the mark. Otherwise, plaintiffs are limited to injunctive relief.

LEGAL REQUIREMENTS FOR REGISTRATION OF TRADEMARK IN INDIA

The legal requirements to register a trade mark under the Legislation are:

- The selected mark should be capable of being represented graphically (that is in the paper form).
- It should be capable of distinguishing the goods or services of one undertaking from those of others.
- It should be used or proposed to be used mark in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person have the right to use the mark with or without identity of that person.

An application for trademark may be made on **Form TM-1** with prescribed fee of Rs. 2500/- at one of the five office of the Trade Marks Registry located at Mumbai, Delhi, Kolkata, Chennai and Ahmadabad depending on the place where the applicant resides or has his principle place of business. The application is examined to ascertain whether it is distinctive and does not conflict with existing registered or pending trademarks and examination report issued. If it is found be acceptable then it is advertised in the Trade Marks Journal to allow others to oppose the registration. If there is no opposition or if the opposition is decided in favor of the applicant then the mark is registered and a certificate of registration is issued. Generally, the time taken to register a trademark in India is 1 year and in cases where there are objections raised by a third party in such a situation the time taken for registration might move up to 1 year 6 months.