



Trademark Registration: A Comprehensive Analysis of Legal Process and Protection

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Abstract: The Intellectual property system protects creativity, discovery and prevents the exploitation of inventions from identical and copy of duplicates. Trademark gives these inventions a unique identity and catchy phrase which is easily remembered and pleasing to hear or look by means of any signs and symbols, design, expression, tagline, logo, abbreviation, which recognize or identifies a product. There are numerous kinds of trademarks are available, such as wordmark, logo, logo composite mark, service mark, product mark, color mark, sound mark, collective mark, certification mark, shape mark, etc. In the process of registration, several legal steps are involved to get the trademark registered. Once the Trademark gets registered, the applicant enjoys benefits like exclusive unique identity, never-ending trademark registration, a shield to protect his product, etc. This paper is attempts to detail the legal process and procedure as per the Trademark Act, 1999 to get the trademark protection through registration and also highlights the advantages of registration.

Index Terms - Registration, Trademark Act, Protection, Renewal, Intellectual Property.

I. INTRODUCTION

A trademark is one aspect of the Intellectual property which is a visible description of a word, name, label, numeric characters, or device. It is widely used in a business for recognition of its goods and services from other similar goods and services. Now-a-days, trademark filings have increased in recent years in a rapid rate. According to the Trade Marks Registry (TMR) and the office of the Controller General of patents, Designs and Trademarks, in 2020, India stood in fifth place for trademark filer in the world, in following year 2021 trademark applications were nearly four lakhs and sixty five thousand which is enormous figure when compared with rest of the world and in present 2024, already around two lakh eighty thousand trademarks were registered.¹ A trademark gives a unique identity of the goods and services and sometimes a catchy phrase which is easily remembered and pleasing to hear or look. Once the Trademark is registered, it is an intangible

¹ Report of filings from Controller General of patents, Designs and Trademarks, visited on 12/11/2024

property for a business and it protects the company's investment in a brand from identical and copy of duplicates and it is generally peculiar to that the goods and services which are provided by the concerned company. If the tendered trademarks are alike or identical to those previously registered, then these tendered trademarks are con not get registered. Apart from this, trademarks are generic, misleading, offensive which contain solely protected emblems that cannot be registered.² The major function of a Trademark is to emphasize the quality of the product, and it also helps to identify the creation of a company. Trademark will also help recognize the origin and source of products and effectively advertise to the consumer in a simpler way by the company.

A trademark means any signs and symbols, design, expression, tagline, logo, abbreviation, which recognize or identifies a product in a unique way. Trademarks are registered in India under the trademark act, 1999 by the "Controller General of Patents Designs and Trademarks," "Ministry of Commerce and Industry, Government of India." The trademark Act sanctions the Trademark to the owner with certain rights like if any violation of the Trademark took place, the owner has a right to sue for damages.

The Trademark act, 1999 define the term trademark as follows – "Trademark means a mark capable of being represented graphically and which is effective of distinguishing the goods/services of one person from the others and may include the Shape of goods and their packaging and combination of colors. "³

The Trademark covers distinctive marks or product appearance and it is just a mark only because it is innate of itself is not a product; it is not a thing to buy. It can create that connection, that mental linkage between what the consumer sees and what he gets. The Trademark covers more than just the symbol itself but it even covers product shapes. e.g., The Coco cola bottle

A color is also a trademark as long as it creates this association in the consumer's mind with the underlying manufacturer or distributor of the product. Sometimes even sounds also could be a properly trademarked. Trademarks can cover a massive variety of things like smell, sounds, shapes, product configuration, the packaging of products, color, etc.

In India there are a variety of trademarks used and hereby presenting a few as follows, a word mark is generally specified by the name of the brand directly. When trademark gets registered for a wordmark, the applicant has an absolute right to use and represent the registered wordmark in any format or font which includes absolute rights to use the wordmark as a whole and it relates in several formats regardless of its manner for all the goods/services concern to the registered company. E.g. Jio, Britannia etc. A logo provides the trademark holder has rights in the combination of words, images, and designs together. Apart from this, if the customers acknowledge the business logo, the applicant wants to file a trademark for that logo. This shield presented to the words in a logo is confined when contrast with the slandered word marks. If a person wants to register a different designed appearance or a union of words as well as design, registering a trademark as a logo would be suitable. E.g., Logo of Nike, Adidas, etc.

² Aman Garg, Trademark Registration: Not a mandate but a necessity, NLUA Journal of Intellectual Property Rights, Volume 2, Issue 1.

³ Trademark Act, 1999, section 2(zb).

A Logo Composite mark is a brand name of a business represents both words as well as logos. The safest way to protect intellectual property would be to file the Trademark as both word and logo. But the filing application for various trademarks is always costly. So, it is recommended to register the Trademark as a word-mark. Sometimes a different trademark application for word as well as the logo to be filed to obtain a broader shield. E.g., Jack & Jones, BMW. A Product mark is attached to goods to distinguish its identity from another similar or identical products E.g., Bata, Amul. A Service mark distinguishes the service of one proprietor or owner from that of another. The company providing services like Computer software and hardware Assembly, restaurant and hotel services, courier, Transport, Beauty and healthcare, Advertising publishing, etc., are now in a position to protect their names and marks from being misused by others. E.g., Yahoo, Google, etc.

A Collective mark is used to inform the public about a particular characteristic of the product to which the collective mark is used. The owner of collective marks may be an association or public institution, or it may be cooperative. E.g., Reliance, Tata. A Certification mark indicates that the owner's service/goods which are certified in terms of origin, quality, material, accuracy, or other characteristics. It specifies the safety and the quality of the product. E.g., ISI marks the ISO certification mark. A Shape can also be trademarked as sound mark which denotes the Shape of goods, packaging has some distinctive feature and it can be registered. 3D Shape or design are also protected under trademark law. E.g., Shape of a coke bottle, Shape of kit – Kat chocolate, car models, etc. Even a sound also can be trademarked as sound mark where a particular sound does the distinctive origin of a product or a service. E.g., MGM's roar of a lion.

II. THE PROCESS AND PROCEDURE FOR TRADEMARK REGISTRATION IN INDIA

The applicant wants to register their trade-mark first they have to do is name search, if at all it is identical with some other, they have to change the name or make composition of the name. If it is not identical then they have to pay a fee and file a new trade mark registration application, which is examined by the Registrar. If no objections were raised then the application will be advertised on the portal for up to 3 months for review by the public. But if the Registrar put some objection, then the applicant has to reply and clear objection, if the registrar is satisfied then the application is sent for 3 months review by the public. On Contrary if not satisfied the application fall under the category of identical Trade mark and we cannot register. Once the Public haven't raised any objection then Trademark is registered, on contrary if the public raises any Objection, then the applicant has to submit a reply to defend the title.

While searching for a mark to registration the applicant must be very careful because different registered trademarks are already registered for the similar products. Once the applicant selects the Trademark, they must conduct a public search on the trademark database. This database is accessible with the "Registry of Trademark" for its uniqueness and the trademark search reveals all the types of trademarks that are existed in

the market, either registered or not. If there is no other registered trademark that is either identical or similar to the applicant's trademark, then the applicant can register his trademark.⁴

To apply for trademark registration the applicant can file it either in a single-class or multi-class and it is wholly based on the goods and services and also the business. The trademark registration application is available in the "Form TM – A", which can be applied online through the "Intellectual property India" website or can be applied physically at the "Trademarks Office", based on the trademark jurisdiction.⁵

Once the trademark application was filed, the examiner appointed by the government authority will initiate examination of whether the trademark application was following the guidelines of the Trademark Act or not. After the examination, the examiner provides his examination report. The examination report given by the authority may or may not reveal some objections, which can be relative, absolute, or procedural. After receiving the examination report within 30 days, a reply must be filed by the applicant.

Post examination after the reply to the examination report was filed, the examiner appoints a hearing if the examiner is not satisfied with the reply of the applicant or if the objections are not met. After the hearing, the examiner accepts the Trademark and forward it for publication in the journal, or if any objection is still present, the application will be rejected.⁶

The Applicant has to advertisement his trademark after the examiner accepted the registration and the trademark is advertised and published in the journal for four months.⁷ The main objective of the advertisement and publication is to call for objections by the public to raise opposition against the trademark registration. The trademark journal is on the official Registry. This website usually gets updated every Monday of the week.

If there is opposition from the general public after the advertisement and publication of the Trademark, any aggrieved person can file a notice against a trademark registration as per through "Form TM – O" within four months from the advertisement of the trademark application.⁸ If the applied Trademark is objected to, the procedure should be followed to file the counter statement application, evidence, and hearing to get the Trademark registered again.

Registration of the Trademark is the final step towards the entire procedure where the application proceeds to registration after overcoming the objections against the trademark registration. Apart from this, if no objection is made against the registration during the advertisement or publication, then the trademark is issued an auto-

⁴ Trademark Act, 1999, section 16.

⁵ ibid, Section 18.

⁶ Mahak Jain & Shivam Singh, Emerging issues and challenges in the protection of trademark in India, International Journal of Advanced Legal Research, Volume 4, Issue 3.

⁷ Trademark Act, 1999, Section 20

⁸ Ibid, section 21.

generated certificate within one week. After the registration has been made, it will be valid for ten years and it would be renewed within that period.

In India, a trademark can be renewed from time to time for an unlimited period with a Renewal fees. The Trademark renewal fails or not renewed; the mark will be removed from the register of Trademark as the renewal term is for ten years only⁹

The process for renewal of a trademark is as follows, Request to renew a trademark can be filed within six months before the expiry of the registration or renewal term, along with the required renewal fee on the specified Form and sometimes request to renewal application can be filed within 6 months after the expiry of registration or renewal term along with required late fee and renewal fee on the specified Form at the Trademarks Office or through online.

III. ADVANTAGES OF A TRADEMARK REGISTRATION

- A trademark can provide unique identification of the product. Throughout the period, the market place overfilled with more companies and brands. So, it is impossible to differentiate between those companies and brands. Because of this, the only distinction between companies for the only source to attract the customers through the Trademark which is registered.
- Registration of Trademark comes with a validity of 10 years. After completion of this period, it can be renewed easily before expiry and after expiry with a late renewal fee.
- In every business, trademark registration is mandatory to make sure that the brand is protected against competition and duplication. If the person has been working to build a product but with an already registered trademark by someone else, then the person also loses his goodwill and business. So, the shielding of the Trademark shall protect the business, which further helps the individual by preventing others from using similar Trademarks.
- A registered trademark is an absolute benefit for the business, which directly brings goodwill among customers. Consequently, the worth of a trademark flourish with the development of business. Indeed, a registered trademark can be transferred, sold or purchased, or even used as security to take a loan similar to any of the other tangible assets.

IV. CHALLENGES OF A TRADEMARK REGISTRATION

- In most of the cases the trademark of the goods or services are identical with existing ones. If there is a similarity with the existing mark, the application might be refused at the time of registration.
- For registration, the mark of goods or services should have a feature of distinctiveness from other marks. Lack of distinctiveness may lead to the rejection of the application at the time of registration.
- It is a multistage process for registration and would be a major challenge for their trademark get registered due to this lengthy procedure, sometimes it takes over the years or longer if there are any objections regarding the particular trademark.

⁹ Trademark Act, 1999, Section 25

- India is home to diverse populations with different cultures, languages and religions. So, the meaning of mark or word or sound related to trademark may have a different or offensive meaning in other language. It may lead to raise objections by the public, hence application for trademark registration might be rejected.
- After registration, non-use of trademark leads to removal from the register. The owner of the trademark must use it regularly otherwise he may lose his rights and protection out of the registered trademark and also the owner can not use the mark continuously for the period of five years from the date of registration, it can be removed from the register.¹⁰

V. SUGGESTIONS

- Trademark registration is not mandatory even though it become a need to get the trademark registered. So that the real owner of the trademark has an exclusive right to use the mark. Otherwise, there is a difficulty to prove that he himself is the real owner at the time of any infringement.
- The applicant should be conducting an extensive search on the website to choose a unique mark to avoid similarity or duplication of the trademarks.
- Applicant should keep check on the website to get the status of the application after applying for trademark registration.
- If there is any opposition from the general public after the advertisement and publication of the Trademark, any aggrieved person can file a notice against a trademark registration then applicant shall file an explanation immediately.

VI. CONCLUSION

To conclude, the Trademark Act,1999 provides the comprehensive provisions related to the Registration and protection of the trademark. Even though, there is a need for strict implementation to address the various challenges. New principals and rules established by the courts by applying these laws and also safeguard the interest of true owners of the registered trademark.

Trademarks are an essential aspect of Intellectual property. So, it is vital to protect the Trademark because every creator of goods and services wants their mark to be unique, attractive, and easily distinguished from others. The Intellectual property system protects creativity and discovery and prevents the exploitation of inventions. Registration of a trademark is helpful for multinational brands with an international reputation. The introduction of a procedure to apply for registration and renewal process is very flexible to the entrepreneur.

¹⁰ Trademark Act, 1999, Section 47

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