

THE TRADEMARK ACT, 1999

TRADE MARK PROCEDURE IN A NUTSHELL

The Trademark Act, 1999, governs the laws related to trademarks and their registration. The trademarks in India are registered by the Controller General of Patents, Designs and Trademarks, (Office of the Registrar of Trademarks), Ministry of Industry and Commerce, Government of India.

The following, or a combination of these, could be trade marked:

- Letter
- Number
- Graphics
- Smell or a mix of colors
- Pattern Marks
- Three Dimensional Marks, etc.
- Word
- Phrase
- Sound Mark
- Logos and Symbols
- Colour Marks

- ✓ A trademark, being a type of **intellectual property**, becomes an intangible asset and can be traded, franchised, commercially contracted or distributed.
- ✓ The owner of a registered trademark can exercise his legal rights in case there is any infringement with regard to the owner's logo, brand, slogan, that has an active trademark against it. The owner has the **right to sue** any third party who uses the trademark without the prior permission of the owner of the trademark.
- ✓ The goods and services under the Act are classified into 45 different sectors. Each sector is referred to as a **class**. Every logo or brand name is to be registered under the appropriate class at the time of application. Out of the 45 different classes, 34 comprise of product classes, and the remaining 11 are for service.
- ✓ A registered trademark has a period of **validity** that stretches up to 10 years. It can be renewed once the above period exhausts. However, the renewal process may be initiated only within one year before the expiry of the registered trademark.
If one fails to do so, the trademark would be removed. Nonetheless, on removal, the trademark can be reinstated through what is known as restoration of the trademark in the prescribed form
- ✓ It is however to be noted that a trademark is only protected and valid in India and does not warrant any international status.
- ✓ Service Fee -
 - **For an individual, small enterprise or a start-up**
 - Rs. 4500.00/- for opting the application form through e-filling mode.
 - Rs. 5000.00/- for physical submission with the Office of Trade marks.
 - **For others**
 - Rs. 9000.00/- through the the e-filling mode.
 - Rs. 5000.00/- for submission in person with the Office.

Eligible Applicants

Any individual, a company and an LLP can be an applicant and may file the application for the registration of the particular trademark. In the Trademark Registration form, the person, whose name is mentioned as the applicant will be declared as the owner of the trademark once the trademark is successfully registered.

Documents Required

- Business Registration Proof: an identity proof of the Proprietor/Partner/Company and an address proof have to be submitted (PAN or AADHAR)
- Soft copy of the trademark.
- Power of attorney (signed by the applicant).

Registration Procedure

Pre-requisites:

1. **Choosing a trademark** - It should be unique and catchy.
2. **Class** - It would be registered under class 41(Education Services) of NICE.
3. **Mark search**- the chosen mark should not be similar to an already registered TM and hence a proper search should be conducted before choosing the brand.
4. **Filing application** - Form TM-A.

Registering a TM involves the following step:

- **Filing the application of brand name registration**

Registration application can either be done manually or through the e-filing mode (Form TM-A). If 'manual filing' is chosen, one has to personally handover the application to the Registrar Office of Trade Marks situated in the major cities of India like Delhi, Mumbai, Kolkata, Ahmedabad, and Chennai. Post submission, the receipt of acknowledgment would at least take 15 -20 days.

However, in the case of an e-filing system, the application can be made from anywhere and the receipt of acknowledgment would be received instantly on the government website. On receipts of such acknowledgment, it is eligible to use the Trade Mark (TM) symbol along with the brand name.

- **Examination of the brand name application**

Once the application is dispatched, or submitted virtually, as the case may be, the Registrar of Trademark will peruse whether the brand name complies with the existing law. Further, there should not be any similarity or homogeneity with an already existing or pending brands due for registration.

- **Publication of the brand in the Indian Trade Mark Journals**

After proper examination, the Registrar of Trademark will publish the brand name in the Indian Trademark Journal. This is certainly the most important part of the trademark registration owing to no opposition within 3 months, i.e. 90 days (or 120 days in some cases), from the date of publication. When there is no opposition, the Registrar of Trademark will proceed towards issuance of **Trademark Registration Certificate**.

- **Trademark Opposition**

If there is any opposition by a third party within 3 months of the trademark publication in the trademarks journal, the Registrar of Trademarks will issue a copy of Notice of Opposition. The Opposition Notice is responded by filing a counter-statement. If the counter statement is not submitted within 2 months, the trademark application is considered to have been abandoned and rejected.

However, if there is no opposition within 3 months from the date of application, this step would not apply and the brand name would proceed for the issuance of Trademark Registration Certificate.

- **Hearing on Trademark Opposition**

This step will not apply if there is no trademark opposition.

However, if the trademark is opposed by a third party and a counter-statement is sent within 2 months, the Registrar of Trademarks will send the copy of the counter-statement to the third party opposing trademark registration.

Evidence must be submitted by the applicant and the third party in support of the case. The Registrar will give the applicant and the third party an opportunity of being heard after submission of evidence. After hearing both the parties and considering the evidence, the Registrar will pass an order of acceptance or rejection of the trademark application. If the Registrar of Trademark accepts the trademark application, then he will proceed to issue the registration.

- **Issue of Trademark Registration Certificate**

After trademark opposition hearing, the Registrar will accept the trademark application if there is no opposition raised within the stipulated period of 90 days or on acceptance of the trademark application. The Registrar then issues the Registration Certificate with the Trademark Registry seal. The approval or rejection of the application may take 18-24 months.

The moment the Certificate is issued, the registered trademark symbol (®) can be used with the brand name.

Once the trademark gets the approval, the Registry will give a Trademark Registration Certificate. The registration will be valid for a period of 10 years from the date of the filing of the application. After the exhaustion of the said period, the trademark may be renewed.

POOJA PRASAD