

Intellectual Property
for Business Series

Number: ①



MAKING A MARK

An Introductory Guide to Trade Marks
Protection in India for Small and
Medium-sized Enterprises

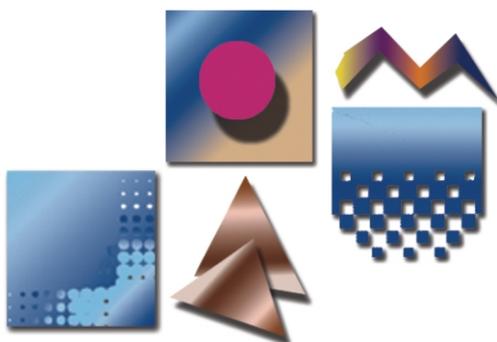


National Institute of Science Communication
And Information Resources, New Delhi

Customized by:
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National Institute of Science Communication
And Information Resources, New Delhi

Designed, published and Printed by
National Institute of Science Communication And Information Resources
Dr K S Krishnan Marg, New Delhi 110 012

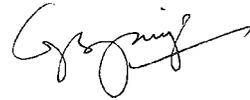
Foreword.....

WIPO's guide on trademarks, "Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises", was the first in the "Intellectual Property for Business" Series. This easy-to-read and well illustrated guide explains, in plain language, the role of trademarks in the marketing and branding strategies of enterprises. It provides a bird's eye view of business aspects of trademarks from an international perspective, given the increasing importance of international markets even for small and medium-sized enterprises (SMEs).

WIPO actively encourages the development of nationally customized versions of the guide. It is, therefore, particularly glad that the National Institute of Science Communication And Information Resources (NISCAIR), New Delhi has taken the initiative to bring out an excellent Indian version. "Making a Mark: An Introductory Guide to Trademarks Protection in India for Small and Medium-sized Enterprises" reflects the Indian context, both in terms of the law of trademarks and use of trademarks by Indian enterprises. It is replete with examples and illustrations from the Indian business scene.

WIPO believes that this guide will prove to be immensely useful for Indian businesses, especially SMEs. It will also be very useful

for anyone having an interest in trademarks and branding, be they students, users/consumers, or policy makers in government or business.

A handwritten signature in black ink, appearing to read 'G. Singh', with a long horizontal flourish extending to the right.

Dr. Guriqbal Singh Jaiya

Director

SMEs Division

World Intellectual Property Organization (WIPO)

P reface.....

In the knowledge-driven, private sector-oriented, highly competitive and internationalizing economy of our times, the tools of the intellectual property system, namely trademarks, industrial designs, patents and copyright, among others, provide the means to prevent free-riding by competitors on the value-adding elements of new and improved products launched by innovative and creative small and medium-sized enterprises (SMEs).

Value-added new and improved products not only meet the needs of the users/consumers but also improve productivity of the economy, which is crucial for continuously improving the living standard of the people of a country. In a crowded market place, trademarks play a crucial role in differentiating competing products. Trademarks also play a major role in reducing transaction costs by communicating the added value to prospective customers, thereby nurturing a relationship of trust between a business or its branded product and the user/customer. Therefore, both the business enterprise and the users/consumers of products must understand the role of trademarks in developing brand value and brand equity that results in repeat purchases by loyal users/customers, often at a premium price, compared with generic or unbranded products.

Once this is understood then the savvy enterprises will do all that needs to be done to get the best of their trademarks. To know all that must be done, this guide will prove to be very handy and beneficial.

By adapting the WIPO guide entitled as "Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises" to Indian law and by using Indian examples, NISCAIR hopes to make a valuable contribution to raising awareness amongst the Indian enterprises, especially SMEs, and their customers to take all relevant measures, in a proactive manner, to get the best of the trademark system for adding value to a business so as to make it sustainable and more profitable.

This guide has been prepared with a view to create general awareness about trademarks and should not be taken as an authoritative statement of the law of trademarks in India. For more detailed information on trademarks, the reader may visit the website of the Indian Trademarks Registry or consult a trademark agent/ trademark attorney.



Acting Director

NISCAIR

A cknowledgement.....

Thanks are due to WIPO, especially its SMEs Division, for having permitted NISCAIR to customize this guide to Indian circumstances. Technical advice and substantive inputs on registered trademarks provided by Shri V. Ravi, Controller General of Patents, Designs and Trade Marks & Geographical Indication Registry, are gratefully acknowledged.

Special thanks are due to Shri V. K. Gupta, Ex-Director, NISCAIR and Shri K C Kailasam, Rtd . Sr Joint Registrar, Trade Marks Registry for imparting valuable advice and support in bringing out this publication.

Special thanks are also due to Shri S.K Rastogi, Acting Director, NISCAIR and colleagues of NISCAIR for their continued support to make this publication.

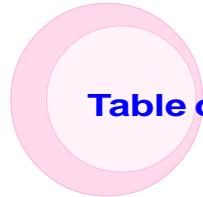


Table of Contents

	Page
1. Trademarks	1
2. Protecting Trademarks	7
3. Types of Trademarks	23
4. Using Trademarks	26
5. Enforcing Trademarks	32
6. Annexes	35

1. Trademarks

What is a Trademark?

A trademark is a sign capable of distinguishing the goods or services produced or provided by one enterprise from those of other enterprises.

“Trademark”, under the Indian law, means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, packaging and combination of colors...¹

Word Mark



Reg. No. 895095
Courtesy : Hindustan Lever Limited

Device Mark



Reg. No. 1278960
Courtesy : Swastik Pipes Limited

A mark may consist of a **name** (such as Tata, Bajaj, Kirloskar, including trade name or its abbreviation, such as Wimco, Glaxo, Alembic, etc.), **device** (such as the image of an Elephant, Tiger, etc.), or **combination of device and word** (such as the word “Wheel” and the drawing or picture of the “Wheel”), or an **invented word** (Kodak, Voltas), or any **arbitrary dictionary word** (such as word or device of an Apple for computers) not being directly descriptive of the character or quality of the goods/ service. It may consist of **letters** (S.K.F., B.M.W, etc.), **numerals** (such as 501 for soaps), **monograms** (which are constituted by intertwining of letters), or any **combination of these** (for example, Brooke Bond 3 Roses, with words and device). Thus, any distinctive **words, letters, numerals, drawings, pictures, shapes, colors, logotypes, labels** or **combinations** used to distinguish goods or services may constitute a trademark.

Logotype



Reg. No. 838428
Courtesy : Reliance Industries Limited

* All references pertain to Trademarks Act & Rules in India

¹ Section 2(1) (zb), The Trade Marks Act, 1999

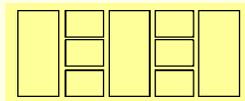
Examples

Nontraditional forms of marks

Nowadays, an increasing number of countries also allow registration of nontraditional forms of trademarks such as single colors, three-dimensional signs (shape of a product or its packaging), audible signs (sounds) or olfactory signs (smells). Many countries have set limits to what can be registered as a trademark, generally only allowing for signs that are visually perceptible or can be graphically represented. Indian law expressly permits registration of marks comprising 'shape of goods', 'shape of packaging', that is, three-dimensional marks. It does not expressly permit or forbid registration of other types of nontraditional marks. However, it is flexible enough to permit registration of a mark, if it is shown to have 'acquired a distinctive character as a result of the use made of it or is a well known trademark'².



Regd.No. 591482
Courtesy: Cartoon Sanitation

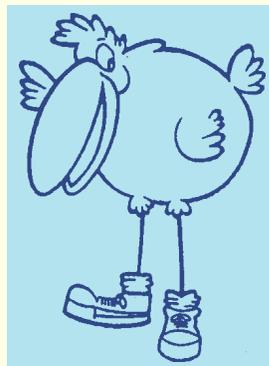


Regd.No. 1253980
Courtesy: European Foundation for Quality Management

Smell or Sound marks

Regarding smell marks or sound marks, the general requirement of the Indian law is that the mark should be 'capable of being represented graphically'. This means that the mark should be capable of being put on the trademark register in a physical form and also being published in the Trade Marks Journal. Obviously, it should be reasonably practicable for persons inspecting the register or reading the Trade Marks Journal, to understand it.

While a sound mark may be graphically represented in conventional notation, the same is not the case with smell marks. It may be possible to describe a chemical by a formula, but it cannot describe its smell. It has been held that 'it was not possible



Regd.No. 996044
Courtesy: Liway Marketing Corporation



Regd.No.13133317
Courtesy: Cavinkare Pvt.Ltd.

² Section 9(1), The Trade Marks Act, 1999

to register an odour by means of its chemical formula since such a formula was not representative of the odour but rather of the chemical substance itself. Neither the requirement for graphical representation would be satisfied by a written description nor by the provision of an odour sample'. 'As a mere written description does not convey a clear and a precise indication of a smell or odour as a mark, therefore it will not be considered to be an adequate graphical representation' and, as such, under the Indian trademark law it is unlikely to be registered.

Advertising slogans

The registration of advertising slogans would depend upon the nature of the mark in India. Since a trademark gives an exclusive right to its proprietor to use it in connection with certain goods or service, it is obvious that such statutory protection should not interfere with *bona fide* and legitimate rights of other traders. At the same time, if the word(s) through use, have become clearly associated in the public's mind with the goods or service of a particular trade source, another person in the same trade could not legitimately use it as a trademark³. But slogans which are deemed fanciful or imaginative can be accepted for registration.

What are trademarks for?

The main function of a trademark is to enable consumers to **identify a product** (whether goods or a service) of a particular company so as to **distinguish it from other identical or similar products** provided by competitors. Consumers who are satisfied with a given product are likely to buy or use the product again in the future. For this, they need to be able to distinguish easily between identical or similar products.

By enabling companies to differentiate themselves and their products from their competitors, trademarks play a pivotal role in the **branding and marketing strategies** of companies, contributing to the definition of the **image**, and **reputation** of the company's products in the eyes of consumers. The image and reputation of a company create **trust**, which is the basis for establishing a **loyal clientele** and enhancing a **company's goodwill**. Consumers often develop an **emotional attachment** to certain trademarks, based on a set of desired qualities or features embodied in the products bearing such trademarks. Trademarks also provide an incentive for companies to invest in maintaining or improving the quality of their products in order to ensure that products bearing their trademark have a positive reputation.

³ Section 9(1), The Trade Marks Act, 1999

The Value of Trademarks

A carefully selected and nurtured trademark is a **valuable business asset** for most companies.

Estimates of the value of some of the world's most famous trademarks such as **Coca-Cola** exceed more than sixty billion dollars. This is because consumers value trademarks, their reputation, their image and a set of desired qualities they associate with the mark, and are willing to pay more for a product bearing a trademark that they recognize and which meets their expectations. Therefore, the very ownership of a trademark with a good image and reputation provides a company with a competitive edge.

A Well Known Indian Trademark:



Regd.No. 838442
Courtesy: Tata Services Limited

Legal protection of trademark is thus not only in the interest of a business but also in the interest of consumers and public at large. In India, a trademark is protected under the Trade Marks Act, 1999 and the rules framed under it which came into force on September, 2003. The Act is administered by the Government of India through the Trade Marks Registry, Mumbai and its four branch offices at Ahmedabad, Chennai, Delhi and Kolkata (see Annex V).

Why should your company protect its trademark(s)?

In India, the registration of a trademark confers on the registered proprietor of the trademark the **exclusive right** to use the trademark in relation to the goods or services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark by others.

Without trademark registration, your investments in marketing a product may become wasteful as rival companies may use the same or a confusingly similar trademark for identical or similar products. If a competitor adopts a similar or identical trademark, customers could be misled into buying the competitor's product, thinking it is your company's product. This could not only decrease your company's profits and confuse your customers, but may also

damage the reputation and image of your company, particularly if the rival product is of inferior quality. In such cases, in India, legal action can be taken for “passing off” only.⁴ For filing a suit in the court, you have to first establish your title to the mark and also show that the defendant’s act is such that it is likely to result in “passing off” the goods or services as those of yours, which is a cumbersome procedure.

Given the value of trademarks and the importance that a trademark may have in determining the success of a product in the market place, it is critical to make sure that it is registered in the relevant market(s).

In addition, a **registered trademark may be licensed to other companies**, thus, providing an additional source of revenue for your company, or may be the basis for a **franchising agreement**.

At times, a registered trademark with a good reputation among consumers may also be used to obtain funding from financing institutions that are increasingly aware of the importance of brands for business success.

In a very large number of countries, rights in a trademark arise only after it is duly

Trademarks

- ensure that consumers can distinguish between competing products;
- enable companies to differentiate their products;
- are a marketing tool and the basis for building a brand image and reputation;
- are licensed and provide a direct source of revenue through royalties;
- are a crucial component of franchising agreements;
- may be a valuable business asset;
- encourage companies to invest in maintaining or improving product quality;
- may be useful for obtaining financing.

⁴Section 27 and 103, The Trade Marks Act, 1999

registered as a trademark under the applicable trademark law. In India, rights in a trademark arise through:

- registration of a trademark under the Trade Marks Act, 1999;
- acquisition of a registered or unregistered trademark by way of assignment;

- adoption and use of a distinctive trademark in relation to certain goods or services.

It is important, therefore, that while recognizing the importance of using trademarks to differentiate your products from those of your competitors, you should also realize the importance of protecting them through registration.

2. Protecting Trademarks

How can your company protect its trademark(s)?

Trademark protection can be obtained through registration or also through use. Although registration of a trademark is not a requirement for protection, it has two distinct advantages: registration implies that the trademark is distinctive of the product or service to which it pertains, and that the trademark belongs to the person or legal entity in whose name it is registered. In India, a trademark may be registered either as one “proposed to be used” or at any time after commencement of “use in the course of trade.”

The registration of a trademark is a specialized area of work. It may be necessary to employ the services of a trademark agent or attorney to ascertain, with a reasonable degree of certainty, the registrability of the trademark requested to be registered. However, this is not compulsory and the applicant may correspond directly with the Trade Marks Registry in India in this matter.

Is registration of Company name sufficient ?

It is a common misconception that by registering the business or trade name with the Registrar of Firms or Registrar of Companies⁵, the name would be

automatically also protected as a trademark. It is important to understand the difference between **trade names** and **trademarks**. A trade name is the full name of your business, such as “Tata Sons Ltd.”, which identifies the company, whereas ‘TATA®’ is the trademark of the company.

A trademark, however, is a sign that distinguishes the products of your company from those of others. A company may use several trademarks in respect of its products. Such practice is prevalent in a wide range of businesses, such as food stuffs and pharmaceuticals. The company may use them independently or along with their common house mark, which represents essentially the image of the company. However, the goods are ordered only by the product mark.

Similarly, some companies may also use their trade name or part of it as a trademark. In that case, they should register it also as a trademark. For instance, “Tata Sons Ltd.” has registered part of their trade name “TATA” as a trademark in classes 1-17, 19, 22-24, 26-32, 37-42 for a large variety of goods and services. These are used by various Tata companies in relation to their products and services for homes and individuals as well as for industries and companies such as for agrochemicals, fertilizers, automotive

⁵ www.dca.nic.in

services, vehicles, coffee, tea, salt, steel, watches, etc.

Who is authorized to apply for trademark registration?

Any person who intends to use a trademark or to have it used by third parties can apply for registration in India. It can be either an individual or a legal entity.

Is it compulsory to register a company's trademarks?

While registration of a trademark is not a compulsory legal requirement in India, it is highly advisable to register a trademark, as it has distinct advantages as compared to an unregistered trademark. Registering a trademark provides better protection to trademarks as the owner of the trademark, in case of a dispute before a court, does not have to prove that the mark belongs to the owner (in whose name it is registered). Further, there is a presumption in favour of the owner of the mark that the mark is distinctive of the goods or services for which it is registered as a mark.

What are the main reasons for rejecting an application ?

Applications for trademark registration are usually rejected in the following cases, which constitute absolute grounds for refusal. Therefore, it is necessary to bear these in mind at the initial stage of selection of a mark to avoid any legal objection in the process of registration.

- **Generic terms:** A word that represents the name of a good or service is not allowed to be appropriated as a trademark. For example, registration of the word “Modem” as a trademark for modems will always be rejected, since the word “Modem” is a generic word for the goods.

A generic term cannot be registered for goods or services to which it applies. It may, however, be registered for goods or services with which it has no connection. Thus APPLE may be registered as a trade mark for computers but not for apples and sword may be registered for blade but not for swords. There are many instances where a word which was originally a trade mark has now become generic due to neglect or improper protection. Some examples are escalator, fridge, thermos, linoleum, zipper, etc.

- **Descriptive terms:** These are words (or devices) that are usually used in trade to describe the product in question and as such are not registerable as trademarks. For example, the word “Creamy” for cream products or the word “Milky” for milk products, which are descriptive of the characteristics of the goods are not registerable.

Similarly, **qualitative** or **laudatory** terms such as “Perfect”, “Superfine”, “Mild”, etc., are likely to give rise to similar objections, unless they are just part of an otherwise distinctive mark. There is no provision in the Indian law, as it is in some countries, to include a disclaimer to clarify that no exclusive right is claimed for that particular part of the mark. Instead the law lays down the general legal proposition that when a trademark consists of several matters, its registration confers exclusive right only to the use of the trademark taken as a whole and not to any matter forming only a part thereof.⁶

- **Deceptive trademarks:** These are trademarks that are likely to deceive or mislead consumers as to the nature, quality or geographical origin of a product. For example, “Safemix” in respect of thermostatically controlled valves for mixing hot and cold water, was not only held to be descriptive, but also to be deceptive as it would induce purchasers to believe that the goods are safe to use.⁷

An application is liable to be refused if it contains an unduly large number of goods or services. Also, marks containing Bio and Eco would

suggest biological or ecological content and would be deceptive unless used for appropriate organic products.

- **Marks considered to be contrary to morality:** Words and illustrations that are considered to violate commonly accepted norms of morality, or which consist of scandalous or obscene matter, or are likely to hurt religious feelings are expressly prohibited to be registered as trademarks in India. For example, the use of names or device of “Hindu Gods” for beef or meat products or those of “Muslim saints” as trademark for pork products would fall within this prohibition.
- **Marks, the use of which are prohibited under the Emblems & Names (Prevention of Improper Use) Act, 1950:** These would include names and emblems of the Government, flags, armorial bearings, emblems of States and International Organizations.

Accordingly, the name, emblem and official seal of UNO, WHO, UNESCO, IOC or of the Central or State Governments or President of India, the Indian National flag, the name or pictorial representation of Mahatma Gandhi, the Prime Minister of India, Shivaji Maharaj, Ashoka Chakra, name

⁶ Section 17, The Trade Marks Act, 1999

⁷ 1978, RPC 307

of Parliament, state legislature, supreme court, Sai Baba, Sikh Gurus etc are prohibited from registration as a trade mark.

In addition to “absolute grounds”, an application may be rejected on “relative grounds” when a trademark conflicts with prior trademark rights. Having two identical (or very similar) trademarks for the same type of product could cause confusion among consumers. In India, the trademark office checks for conflict with existing marks, including unregistered well-known marks, as a regular part of the registration process. However, checking can also be done when the trademark is challenged by a third party after publication of the trademark. A mark will also not be registered if it is liable to be prevented from use by virtue of any law in particular the law of “passing off” protecting an unregistered Trademark used in the course of trade.⁸ Whenever a trademark is considered to be identical or confusingly similar to an existing one for identical or similar products, it will be rejected or cancelled, as the case may be. However, for the benefit of those who adopted honestly identical or similar trademark and used it concurrently, the law permits registration by more than one

proprietor of identical or similar trademarks for the same goods/ services in exceptional cases.⁹

What should be kept in mind when selecting or creating a trademark ?

Selecting or creating an appropriate trademark is a critical step, as it is an important element of the marketing strategy of your business. So what is an appropriate trademark for your product(s)? Evidently, there are no hard and fast rules. But the following five-point checklist may be useful.

Five Point Checklist for Selecting Your Trademark

- Check that your trademark of choice meets all the **legal requirements** for registration.
- Do a **trademark search** to make sure that it is not identical or confusingly similar to existing trademarks.
- Make sure that the trademark is **easy to read, write, spell and remember** and is suitable to all types of advertising media.
- Make sure that the mark does not have any **undesired connotations** in your own language or in any of the languages used in potential export markets.
- Check that the corresponding **domain name** (i.e., Internet address) is available for registration.

⁸ Section 9, The Trade Marks Act, 1999

⁹ Section 12, The Trade Marks Act, 1999

While selecting one or more words as your trademark you should also take into consideration the implications of selecting certain types of words:

- **Coined or “fanciful” words:** These are invented words without any intrinsic or real meaning. Coined words have the advantage of being easy to protect, as they are more likely to be considered inherently distinctive. On the negative side, they may be more difficult to remember for consumers, requiring greater effort to advertise the products.

Examples: Exxon, Kodak and Colgate: these invented or coined words have become well-known trademarks by reason of very wide or universal use.

- **Arbitrary marks:** These are words that have a meaning, but it has no relation to the product they advertise. While these types of marks are also easy to protect, they may also require heavy advertising to create the association between the mark and the product in the minds of consumers.

Examples: The trademark “Camel” for marketing cigarettes, “Apple” for computers, “Lotus” for software, and “Sun” for computers.

- **Suggestive marks:** These are marks that hint at one or some of the attributes of a product. The appeal of suggestive marks is that they act as a form of advertising. A slight risk, however, is that some countries (including India) may consider a suggestive mark to be somewhat descriptive of the product and, therefore, may be denied registration, unless massive evidence of use in the Indian market is established to prove ‘acquired distinctiveness.’

Examples: The trademark “Soundcraft” in respect of sound recording apparatus was held to be descriptive of goods.¹⁰ Similarly, “Soflens” for contact lenses was refused registration.¹¹ However, in India, “Stayfree” in respect of sanitary napkins was allowed registration in Part B of the trademark register on the basis of evidence of use.¹² (It may be noted that under the Trademarks Act, 1999, part A and part B of register of trademarks have been merged.)

Irrespective of the type of mark you choose, it is important to avoid imitating existing or well-known trademarks. A slightly altered competitor’s trademark or a misspelt

¹⁰ 1964, RPC 47

¹¹ 1976, RPC 694

¹² 1990, IPLR 96 (TMR)

well-known or famous mark is unlikely to be registered. A trademark is liable to be refused registration if the original adoption is proved to be tainted or copied irrespective of the length of use.

Examples: “Charmis” is a registered trademark for face cream. It would be unwise to try to sell the same or similar products using the trademark “Formis” as it would probably be considered confusingly similar to the existing mark and is unlikely to be registered.

Further, it is undesirable to adopt a well known mark even in respect of entirely different goods or service, as such use is most likely to be restrained by courts and registration refused or, if already allowed, cancelled.

Examples: Use of “7’O Clock” trademark (well known in India for shaving blades) in respect of tooth brushes was held to be dishonest and an injunction was granted.¹³

¹³ 1988, PTC 1

Registering a Trademark in India — Step by Step

The Applicant

An applicant makes an application for registration of a trademark for goods or services included in one class in triplicate on Form TM-1 with a prescribed fee, while on Form TM-51 for registering the same mark in more than one class. The fee payable is to be multiplied by the number of classes in which it is to be registered.

The application will include –

- a representation of the trademark (one affixed on the appropriate form in the space 8 cm x 8 cm), accompanied by 5 additional representations of the mark. In no case the size of the representation shall exceed the size 33 cm x 20 cm
- a transliteration and translation of any part of the mark that is in a language other than Hindi or English
- indication of the class of goods or services
- address of the principal place of business of the applicant.¹⁴ If the applicant has no residence or place

of business in India, an address for service is to be given¹⁵

- a statement of the period during which, and the person by whom it has been used in respect of the goods or services or a statement that the mark is proposed to be used. The Registrar may require the applicant to file an affidavit testifying to such usage with exhibits showing the mark as used
- signature of applicant or his agent. In the case of agent, a Power of Attorney on Form TM-48 is to be filed
- If it is a partnership firm, the names of all partners together with the nationality of each of them and the status of the firm, whether registered or not, are to be given, while in case of a corporate body, the country of incorporation is to be stated
- if the trademark consists of shape of goods or its packaging, the representation should consist of at least five different views of the mark and a description in words of the mark while in case of three dimensional mark, the reproduction of the mark should consist of two-

¹⁴ Rules 3 and 17, Trade Marks Rules, 2002

¹⁵ Rule 19, Trade Marks Rules, 2002

dimensional graphic or photographic reproduction, and

- if color combination is claimed, colors are to be indicated, accompanied by one reproduction in black and white and four reproductions of the mark in color.

The Trademark Office

Application is to be filed at the appropriate office of the Registry at Mumbai, Delhi, Chennai, Kolkata or Ahmedbad, depending upon the place where the applicant resides or has his principal place (see Annex V). In case of foreign applicants, the place mentioned as the address for service in India will determine the appropriate office at which the application should be filed.

Allotment of number: Filing of an application will be acknowledged by the Registrar by way of return of one additional representations of the trademark, with the official number duly entered thereon.

Examination: The application is subjected to formal and substantive examination. The formal examination checks whether the application complies with the requirements of the Act and Rules. The substantive examination includes examination for distinctiveness and a search amongst the registered trademarks and pending applications to

ascertain whether there are on record any marks identical to or deceptively similar to the mark sought to be registered in the relevant class(es).

The time taken between filing an application and taking it up for examination is about ten to fifteen days.

Expedited examination: An applicant may request for expedited examination of an application for registration of a trademark on Form TM-63 together with a declaration stating the reason for the request, on payment of five times the application fee (see Annex VI). In such a case, application is taken up for examination immediately.

Further procedure: After due consideration of any evidence of use or of distinctiveness of the mark or any other matter, the Registrar may refuse the application or accept it absolutely or subject to amendments, modification, conditions or limitations, if any. The applicant may ask for a hearing or comply with the requirements of the Registrar within the time specified. Thereafter, the decision of the Registrar is communicated to the applicant.

Publication and opposition: When an application is found to be acceptable, the details of the application are published in the Trade Marks Journal to allow any person to oppose its registration

within three months from the publication date or within a further period not exceeding one month in the aggregate. At present, applications are published in the Trade Marks Journal normally within three months of acceptance.

Registration: If there is no notice of opposition, or if the opposition has been duly considered and dismissed, then the trademark is registered and a registration certificate is issued for a period of 10 years from the date of filing the application. At present, registration certificates are issued by the Registry within eight to ten months of filing of an application, unless it contested in an opposition proceeding. The Register of Trade Marks contains all the relevant details, such as the mark, the date of filing, actual date of registration, the goods or services and the class or classes in respect of which it is registered and all other particulars.¹⁶

Renewal: The registration may be renewed for successive periods of 10 years. For this purpose, an application has to be submitted in Form TM-12 by the proprietor or his agent within six months prior to the expiration of the current registration of the trademark. If the registration has not been renewed,

or the prescribed surcharge has not been paid within the grace period permissible under law, the Registrar may remove the mark and advertise the fact in the Trademark Journal. However, an application for restoration of the mark to the register and renewal may be made in Form TM-13 (together with the prescribed fees) after six months but within one year from the expiration of the last registration of the Trademark. When the registration of the mark is restored and renewed, the fact will be advertised in the Trademark Journal. At present, renewal is effected across the counter on production of previous renewal certificate or other document and in all other cases within fifteen days.

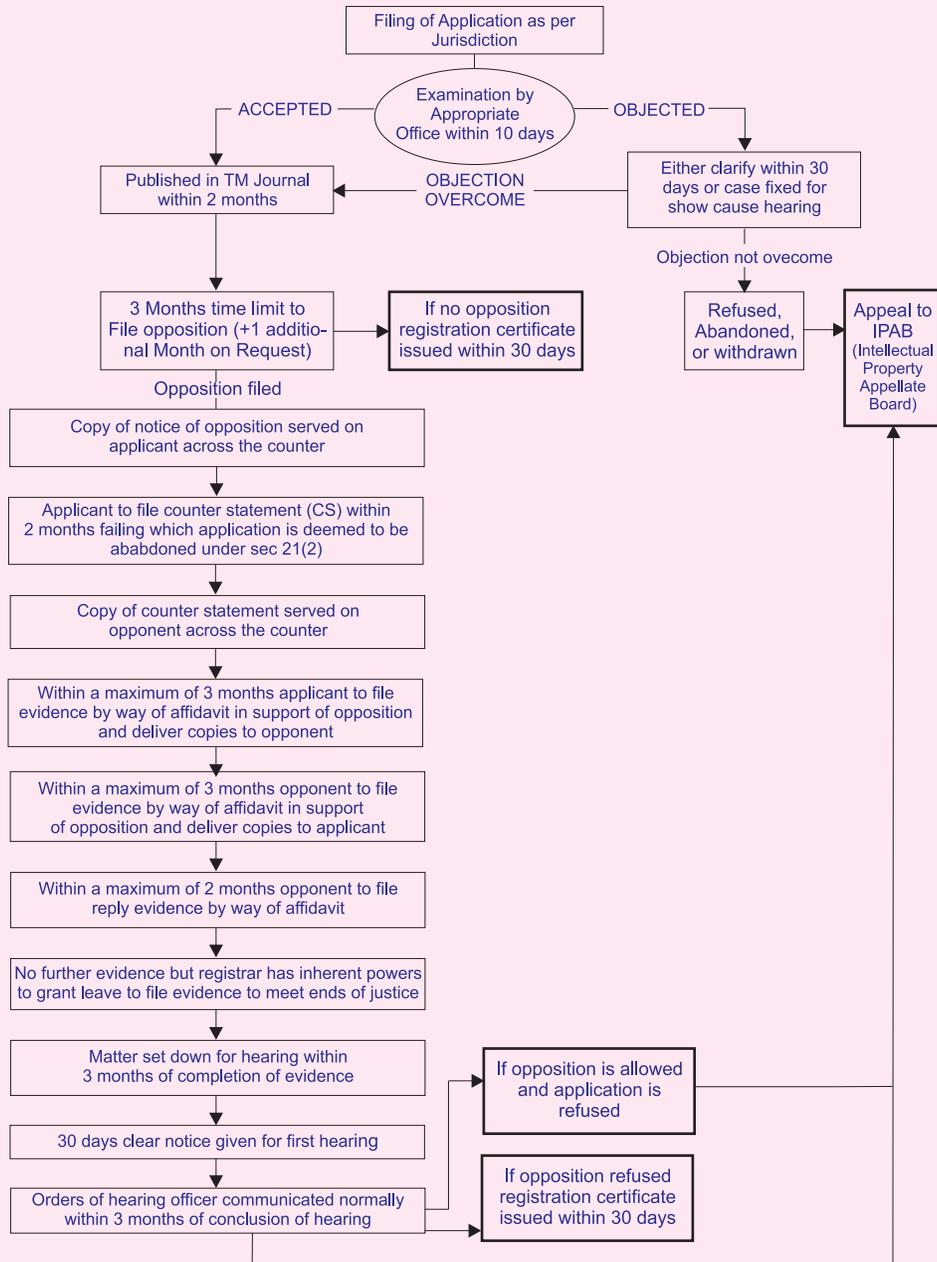
Removal of mark for non-use: Non-use of a registered trademark for a continuous period of five years renders the mark liable for removal.¹⁷ The period of five years will be reckoned from the date of actual registration and not from the filing date of application for registration. The use of a trademark by a licensee or a registered user will be deemed to be used by the proprietor.¹⁸ Non-use may be justified due to “special circumstances in the trade”, which would include restrictions imposed by any law or regulation on the use of the trademark in India.

¹⁶ Section 6, The Trade Marks Act, 1999

¹⁷ Section 47, The Trade Marks Act, 1999

¹⁸ Section 48, The Trade Marks Act, 1999

WORK FLOW CHART OF A TRADE MARK APPLICATION IN INDIA



How long does it take to register a trademark?

The time required for registration of a trademark varies significantly, generally ranging from three months to two years, depending, among other things, on whether a trademark office conducts substantive examination or not.

In India, registration of a trademark is generally takes from eight to twelve months from the date of making a formal request for registration of a trademark in the prescribed form (TM-1) and on payment of the prescribed fee to the trademark registry. The registration is effective from the date of filing the application. If a trademark is not properly selected, there is higher likelihood of it being opposed, which may considerably delay its registration.

What are the costs associated with trademark creation, protection and use ?

It is important to keep in mind, and properly budget for the costs related to trademark creation and registration:

- There may be costs associated with the creation of a logo or word to be used as a trademark, as many companies outsource this task to a logo designer or a branding company.
- There may be costs for conducting a trademark clearance search.

- There are costs associated with the registration process, which vary depending on the number of countries and the categories of products. In India, the Trade Marks Rules prescribe the official fees payable in respect of various proceedings in the Registry (see Annex VI).
- If a company uses a professional trademark agent to assist in the registration process, it would face additional costs, but would probably save significant time and energy in effectively following up the registration process in accordance with the law.
- There may be costs in respect of enforcement of rights in a trademark by instituting civil or criminal proceeding against infringers, as per law.

How can you find out if your chosen trademark might conflict with other registered trademarks? What is a trademark search?

Before submitting an application for registering a trademark, you should ensure that a proper **trademark clearance search** is carried out. This is done to make sure that the trademark you intend to use, or a similar one, is not already registered by another person or company for identical or similar products. You can either make a

trademark search yourself or hire the services of a trademark agent. It may be difficult to make sure that your trademark of choice is not “confusingly similar” to existing validly-registered trademarks. This is why the guidance of an experienced trademark agent, who is familiar with the practice of the trademark office and court decisions, may be very helpful.

Before applying for registration, it is desirable to obtain preliminary advice regarding the distinctiveness of your proposed mark from the Registrar of Trademarks in India by making a request in form TM-55 and on payment of the prescribed fee.¹⁹ A request for search can also be made in form TM-54 along with the prescribed fee to the Trade Marks Registry to obtain an official report to ascertain whether any identical or deceptively similar Trademark exists on the Register or is pending for registration for the same goods or services.²⁰ Such a report is normally issued on the same day. Computerised search facility is available at all Trade Marks registry offices on payment of Rs. 400/- for 15 minutes. You may also undertake an independent market survey to rule out the possibility of the

same or a similar mark in actual use by another person or company in relation to the relevant goods or services. Depending upon the geographical scope of your business, the survey may even have to extend beyond the territorial limits of India.

While searching can never be conclusive, it does reduce the degree of uncertainty. After being satisfied about the availability and registerability of a trademark, you may start using the mark in relation to the goods or services, and, at the same time, make an application for its registration under the Act.

Trademarks are grouped into “classes” according to the goods or services they serve to identify (see Annex III). You may therefore begin by familiarizing yourself with the 45 different trademark classes. The International Classification, which had 42 classes earlier, has been enlarged to 45 classes. The changes are in the separation of some of the services, which were hitherto covered by class 42, into classes 43, 44 and 45. The Indian Classification does not however reflect these changes.

¹⁹ Section 147, The Trade Marks Act, 1999

²⁰ Rule 24, Trade Marks Rules, 2002

A Well-classified System

While filling in your trademark application form you are required, in most countries, to indicate the goods and/or services for which you wish to register your trademark and to group them according to classes. These refer to the classes in the **trademark classification system**. The trademark classification system allows for the storage of data on registered trademarks in an orderly manner in relation to the types of goods or services. This makes it easier to retrieve information from trademark databases. It is critical to register your trademark in all classes in which you intend to use your trademark. The most widely used classification system is the International Trademark Classification System {the so-called Nice system for classification of word marks}, which has 34 classes for goods and a further 11 for services. More information on the Nice

classification system is available at: www.wipo.int/classifications/en/nice/about/.

Example

How are products classified? Let us take an example. If your company is producing knives and forks, then your trademark application should be made for the corresponding goods in class 8. If, however, you wish to market other kitchen utensils (such as containers, pans or pots) by using the same trademark, you will also have to register the mark for the corresponding goods in class 21. In India, the law permits a single application to be made to cover goods/services in several classes for the same mark, but additional fee is to be paid in respect of each such additional class of goods or services.



Reg. No. 465568
Courtesy: TTK Prestige Limited

Do you need a trademark agent to file a trademark application?

In India, the services of a trademark agent/attorney is not necessary for filing an application for registration. However, the services of a trademark agent skilled in conducting trademark clearance searches and familiar with the detailed procedure for trademark registration may be used to save time, ensure that you apply for protection in the appropriate trademark class(s), and avoid refusal on absolute grounds. If you apply for trademark registration abroad you may be required to have a trademark agent who is resident in the relevant country.

The Trade Marks Registry has a list of registered trademark agents. There are, however, quite a number of lawyers who are practicing in this branch of law, without being registered as trademark agents in India.

For how long is your registered trademark protected?

In India, registered trademark is protected for 10 years from the date of filing the application. Registration may be renewed indefinitely (usually, for consecutive periods of 10 years) provided renewal fees is paid on time. Make sure that someone in your company is made responsible for ensuring timely renewal of trademark registrations.

Outsourcing Trademark Creation

Designing a trademark is a creative process. In India, a creator automatically owns the copyright over creative or artistic works, such as the artwork of a trademark.

Therefore, when the creation of a trademark and associated artwork, if any, is outsourced, it is usually best to clarify issues of copyright ownership in the original agreement and/or to make sure the copyright over the trademark and associated artwork, if any, is formally assigned to your company.

Is trademark registration in India valid internationally?

Valid registration of a trademark in India gives you rights only in India, unless your mark is considered to be a well-known mark.

Should you consider protecting your trademark abroad?

All the main reasons for registering your trademark in India also apply to the commercialization of your products in foreign markets. It is, therefore, highly advisable to register your trademark abroad if you are currently engaged in export operations or intend to do so in the near future. Exporting goods bearing a

distinctive trademark will enable your export products to be recognized in foreign markets, allowing your company to build a reputation and image among foreign consumers that may result in higher profits for your company.

How can you register the trademark of your company abroad?

If you have registered the trademark(s) of your company in India, but wish to export or grant a license to use the trademark(s) in other countries, then it is advisable to register the trademark(s) abroad. There are following ways to do so:

The National Route: your business may apply to the trademark office of each country in which you are seeking protection by filing the corresponding application in the required language and paying the required fee. A country may require you to use the services of a locally based trademark agent for this purpose.

The Regional Route: if you wish to apply for protection in countries which are members of a regional trademark system you may apply for registration, with effect in the territories of all Member countries, by filing an application at the relevant regional office. The regional trademark offices are:

- The African Regional Industrial Property Office (ARIPO).

- The Benelux Trademark Office.
- The Office for the Harmonization of the Internal Market of the European Union (OHIM).
- The Organisation Africaine de fa Propriete Intelectuelle (OAPI).

Advantages of using the Madrid system

The principal advantages of using the Madrid system are that the trademark owner can register his trademark in all the countries party to the system by filing:

- a single international application;
- in one language;
- subject to one set of fees and deadlines.

Thereafter, the international registration can be maintained and renewed through a single procedure.

You can find more information on international registration of marks either at your national trademark office or on the WIPO website: www.wipo.int/madrid/. A list of the Member countries of the Madrid system is available (see Annex IV).

The International Route: If your home country is a member of the Madrid system and your trademark has been registered or applied for in or with effect in that country, you may use the Madrid system (administered by WIPO) to register your trademark in more than 70 countries that are party to the system. India is yet to become a member of the Madrid system. The 'national route' is available currently for Indian applicants to register overseas. Check with a competent intellectual property attorney as to which regional route is/are available to you for filing of your trademark application abroad.

An Indian applicant may be able to use the Madrid System if the applicant has a real and effective business presence in a country which is a member of the Madrid Agreement or Madrid Protocol.

For registering a trademark outside India, the Registrar issues a certificate including a copy of the mark on registration.

The Registrar may state in the certificate such particulars concerning the registration of the mark as he may deem fit, and may specify the terms and conditions and other limitation appearing on the Register. The purpose for which the certificate is issued may be stated therein.

India is a member of the International Convention for Protection of Industrial Property (known as Paris Convention) and as such Indian applicants wishing to register their trademarks in one of the member countries, will enjoy a right of priority. On the basis of an application in one of the member countries, the applicant (or his successor) may, within six months, apply for protection in other member States. The later applications will be regarded as if they had been filed on the same day on which the first application was filed.

3. Types of Trademarks

Trade marks	Marks used to distinguish certain goods as those produced by a specific enterprise.
Service marks	Service Marks used to distinguish certain services as those provided by a specific enterprise.
Collective marks	Marks used to distinguish goods or services produced or provided by members of an association.
Certification marks	Marks used to distinguish goods or services that comply with a set of standards and have been certified by a certifying authority.
Well-known marks	Marks that are considered to be well-known in the market and as a result benefit from stronger protection.

What is a service mark?

A service mark is very similar to a trademark. Both are distinctive signs; trademarks distinguish the goods of one enterprise from those of others, while service marks fulfill the same function in relation to services. Services may be of any kind, such as financial, banking, travel, advertising or catering, to name a few. Service marks can be registered, renewed, cancelled, assigned and licensed under the same conditions as trademarks. The Indian law does not, however, use the term 'service marks', as it is covered by the broader definition of 'trademarks'.

Example: MTNL (Mahanagar Telephone Nigam Ltd.) provides basic telecommunication and internet services.



What are collective marks?

Collective mark under Indian law, is a mark distinguishing the goods or services of members of an association of persons (not being a partnership within the meaning of

the Indian Partnership Act, 1932), which is the proprietor of the mark, from those of others.²¹ Thus, a collective mark is generally owned by an association or cooperative whose members may use the collective mark to market their goods or services. The association generally establishes a set of criteria for using the collective mark, such as quality standards, and provides individual companies the choice to use the mark if they comply with such standards. Collective marks may be an effective way of jointly marketing the products of a group of enterprises, which may find it more difficult for their individual marks to be recognized by consumers and/or to be accepted for distribution by the main distributors.

In India, a collective mark can not be registered if it is likely to deceive or cause confusion on the part of public; in particular, if it is likely to be taken to be something other than a collective mark. In such a case, the Registrar may require that a mark in respect of which application is made for registration comprise some indication that it is a collective mark.

So far, no collective mark has been registered in India.

What are certification marks?

Certification mark, under Indian law, is a mark capable of distinguishing the goods or services in connection with which it is

used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services quality, accuracy or other characteristics from goods or services not so certified and registerable as such.²² It may be used by anyone whose products meet certain established standards.

An important requirement for a certification mark is that the entity which applies for registration is considered "competent to certify" the products concerned.

In India, a mark cannot be registered as a certification trademark in the name of a person who carries on a trade in goods of the kind certified or a trade in the provision of services of the kind certified.

Example: "Darjeeling logo", a property of The Tea Board of India verifies that the packet contains 100% pure Darjeeling unblended with teas from any other growth. Presence of certification mark on a product is an assurance of conformity to the relevant specifications.



Reg. No. 831599
Courtesy: Tea Board of India

²¹ Section 2(1)(g), The Trade Marks Act, 1999

²² Section 2(1)(e), The Trade Marks Act, 1999

What are well-known marks?

A well-known mark under Indian law, is a mark which has become well-known to a substantial segment of the public using such goods or receiving such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.²³

Thus, well-known marks are marks that are considered to be well-known by the competent authority of the country where protection for the mark is sought.

Well-known marks generally benefit from stronger protection. For example, a well-known mark may be protected even if it is not registered (or has not even been used) in a given territory.

The main purpose of this stronger protection is to prevent companies from free-riding on the reputation of a well-known mark and/or causing damage to its reputation or goodwill. In *CIBA GEIGY LTD & Another vs. SURINDER SINGH and Others* (DELHI HIGH COURT), the Plaintiff were registered proprietor of the

trade mark 'CIBACA' and produced sufficient evidence to establish distinctiveness and goodwill. Defendant adopted the same mark for motor vehicles. While granting an injunction, the court ruled that no one should be allowed to use a world famous name for goods which have no connection with the type of goods that generated its worldwide reputation, even though the competing goods were entirely different. Similarly, Windows XP is well known in the computer trade. The expression 'relevant public' would imply that the mark need not have all India reputation; rather, it is well known to end users in that particular trade.

Example: "Caltex" is an example of a well-known mark for petroleum products. Even under the old law, in which there was no explicit provision for protection of well-known marks (as are contained in the present Trade Marks Act, 1999), application for registration of the same trademark by someone else for horological and chronometric instruments (watches) was refused, on opposition by the owners of the well known mark Caltex, though the competing goods were entirely different.²⁴

²³ Section 2(1)(zb), The Trade Marks Act, 1999 See also Section 11(6) to 11(11) of the Act, the factors which are relevant in determining a trademark as "well-known"

²⁴ *Sunder Parmanand v. Caltex* AIR 1969 Bom 24

4. Using Trademarks

Can you register a trademark without having used it ?

You may apply for registration before you have used the trademark but some countries like the United States of America will not officially register it until you have shown proof of use. In India, the law specifically enables an application to register a trademark to be made by any person “claiming to be the proprietor of a trademark used or proposed to be used by him”.²⁵ There are two exceptions²⁶ for recognizing the right of a person to apply for registration of a mark, where the applicant: (i) intends not to use the mark himself, but to assign the mark to a company to be formed and registered under the Companies Act; and (ii) intends the mark to be used by a licensee as a “registered user” after the registration of the trademark.

In India, if the trademark has not been used for a continuous period of five years, an application can be made for its removal from the trademarks register. The five year period is reckoned from the date on which the mark is actually entered in the register and not from the date of application. If non-use is due to ‘special circumstances in the trade’, then such period of non-use will not be counted towards the period of

non-use. ‘Special circumstances in the trade’ would include restriction on use of trademark in India imposed by any law or regulation.

TM or ® !

The use of ®, TM, SM or equivalent symbols next to a trademark is not a requirement and generally provides no further legal protection. Nevertheless, it may be a convenient way of informing others that a given sign is a trademark, thus warning possible infringers and counterfeiters. The ® symbol is used once the trademark has been registered, whereas TM denotes that a given sign is a trademark; SM is sometimes used for service marks. In India, ® is used to indicate that a mark is registered. Such indication for a trademark, which has not been registered (as in a case of pending application) would amount to false representation, and is a punishable offence, which may include imprisonment for a maximum period of three years, or a fine, or both.²⁷



Courtesy : Lion Dates Private Limited

²⁵ Section 18(1), The Trade Marks Act, 1999

²⁶ Section 46, The Trade Marks Act, 1999

²⁷ Section 107, The Trade Marks Act, 1999

Proper Use Essential

The proper use of a trademark is essential for maintaining and enforcing your trademark rights. Infact, proper use of a trademark helps in enhancing its value and that of the relevant product or business as well.

- Use a trademark as an adjective, but not as a noun or a verb. Do not say ‘Cherry Blossom your shoes’. Say ‘polish your shoes with Cherry Blossom’.
- Use a trademark in a consistent manner at all times, be it in advertising, catalogs, packaging, products, invoices, etc. Do not allow use of variations, take-offs, phonetic equivalents, other language equivalents, or abbreviations of the trademark. If it is a logo, do not allow it to be redesigned, compromised or misused in any way.
- Whenever a mark is licensed, ensure that its usage by a licensee is as has been prescribed.
- Use symbol R in a circle, i.e., ® only, when a mark is licensed. When registration is pending or otherwise, use TM to indicate that a trademark right is claimed for the word or device.
- Preserve records pertaining to the use of the mark in India and other countries. They constitute important evidence in legal proceedings.

How should you use trademarks in advertising?

If your mark is registered with a specific design or font, make sure that the trademark is used exactly as it is registered. Monitor its use closely as it is crucial for the image of your company’s products.

Can your company use the same trademark for different products?

Different trademarks may be used for the different product lines of a company. Depending on its branding strategy, your company may decide whether to use the same trademark for your products, extending the brand every time a new product is released, or to use a different mark for each product line.

Extending an existing brand to new products enables the new product to benefit from the image and reputation of the mark. However, the use of a new mark, more specific and relevant to the new product, may also prove advantageous and enable the company to target the new product to a specific customer group (e.g., children, teenagers, etc) or to create a specific image for the new product line. Many companies also choose to use a new brand in conjunction with an existing brand (e.g., Ferrero and Nutella).

Different companies adopt different strategies. Whatever your choice, you

should make sure that your trademark is registered for all categories of goods and/or services for which it is, or will be, used.

What should be kept in mind when using trademarks on the Internet?

The use of trademarks on the internet has raised a number of controversial legal problems with no easy or uniform solution. One important problem stems from the fact that trademark rights are territorial, whereas the reach of the Internet is global. This creates problems when it comes to settling disputes between persons or companies legitimately owning identical or confusingly similar trademarks for identical or similar goods or services in different countries. Legislation in this area is still developing and treatment may differ from one country to another.

Registration of a trademark in India is limited to India only and does not give protection against possible infringement by use of a similar mark abroad. If you offer goods for sale via the Internet into a country where someone else owns the trademark, you may be sued for infringement. You need to be aware of the potential risks of trading over the Internet. You should seek legal advice on the best ways to avoid or minimize those risks, especially when you receive a notice from an overseas trademark owner alleging infringement of trademark rights. You

should also consider the potential benefits for your business of applying for registration of your trademark overseas using the Madrid Agreement or Madrid Protocol, if it possible to do so. Till such time India becomes a signatory to the Madrid Protocol, it is advisable to obtain registration of Indian trademarks at least in countries where the goods are likely to be exported, availing of the privilege of 'right of priority' under the Paris Convention for the protection of Industrial Property (of March 20, 1883, as amended upto September 28, 1979), to which India is a signatory.



What is a domain name and how does it relate to trademarks?

Domain names are Internet addresses, and are commonly used to find websites. For example, the domain name 'wipo.int' is used to locate the WIPO website at <http://www.wipo.int>.

Over time, domain names have come to constitute business identifiers, thus often coming in conflict with trademarks.

Therefore, it is important that you chose a domain name, which is not the trademark of another company, particularly a well-known trademark.

With the advent of the Internet, protection of domain names, has received due judicial recognition in India, as in other countries. A domain name often serves the same function as a trademark in identifying a particular person or source.²⁸ However, the position may be different where the domain name is descriptive. In *Online India Capital Co. Pvt. Ltd. v. Dimensions Corporate*²⁹, the plaintiff who was using a website under the name www.mutualfundsindia.com brought an action against the defendant who adopted the name www.mutualfundsindia.com. It was held that the plaintiffs' domain name was the description of the character of the services offered by it. There was no evidence to show that the word has acquired a secondary meaning, which was a pre-condition for granting trademark protection to a descriptive name.

Sometimes, domain names of wellknown companies are registered as a trade mark. These are liable to be expunged from the Register if fraud or cyber squatting is established. In *Acqua Minerals Limited vs. PRAMOD BORSE & Another* (Delhi High Court 2001) –

the plaintiff was the registered proprietor and copyright owner of BISLERI for bottled mineral water. They applied for domain name registration to Network Solutin Inc.- to register bisleri.com. A suit was filed in which the court ruled that the defendant had registered, with *mala fide* and dishonest intention to block, and thus had adopted a squatting tactic. The court also ruled that Internet domain name is a valuable corporate asset and is more than an Internet address. Therefore, it is entitled to equal protection as a trade mark.

In order to find out whether a particular trademark is already protected, please contact directly the national or regional trademark offices, which may have an Internet-searchable trademark database. A list of such databases is available on WIPO's website at: ecommerce.wipo.int/databases/trademark/

On the other hand, if the trademark of your company is being used in a domain name or is being cybersquatted by another individual or company, then you may take action to stop such misuse/infringement of the rights of your company. In such a case, one option would be to use WIPO's very popular online administrative procedure for domain name dispute resolution at: arbiter.wipo.int/domains/.

²⁸ Yahoo Inc. v. Akash Arora 1999 PTC 201

²⁹ Online India Capital co. v. Dimensions Corporate 2000 PTC 396

This WIPO website includes a model complaint as well as a legal index to the thousands of WIPO domain name disputes that have already been successfully resolved.

Can you license your trademark to other companies?

A trademark may be licensed to another company. In such a case, the trademark owner retains ownership and merely agrees to the use of the trademark by one or more other companies. This is usually done on payment of royalties and involves the consent of the trademark owner, which is usually included in a formal licensing agreement which spells out the terms and conditions of the trademark license. In practice, trademark licenses are frequently granted within broader licensing agreements, for example, franchising agreements or agreements including the licensing of other intellectual property rights such as patents, know-how, and technical assistance for the production of a given product.

In India, licensing of a trademark is recognized and there is a provision for registration of the licensee as a “registered user”, though such registration is not mandatory. However, it is explicitly provided that an unregistered licensed user will have no right to ‘institute any proceeding for any infringement’, as this

may be done only by a registered user.³⁰ The permitted use of a trademark by the licensee is deemed to be use by the owner of the mark.³¹

What does a franchising agreement have to do with trademarks?

The licensing of a trademark is central to a franchising agreement. In franchising agreements the degree of control of the trademark owner over the franchisee is generally greater than is the case for standard trademark licensing agreements. In the case of franchising, the franchiser allows another person (the franchisee) to use his way of doing business (including trademarks, know-how, customer service, software, shop decoration, etc.) in accordance with a set of prescriptions and in exchange for compensation or royalty.

Example: Nirula’s, established in 1934, is a diversified group having a chain of Elegant Business Hotels, Waiter Service Restaurants, Family Style Restaurants, Ice



Reg. No. 1073747
Courtesy: Nirula Corner House Pvt. Ltd.

³⁰ Section 52 and 53, The Trade Marks Act, 1999

³¹ Section 48(2), The Trade Marks Act, 1999

Cream Parlours, Pastry Shops and Food Processing Plants in India. The chain with over 60 outlets operated mostly by franchisees in different Indian states caters to the Indian palate of over 50,000 customers everyday.

Is there any restriction in selling or assigning the trademark of your company to another company?

It is increasingly possible to sell or assign a trademark independently from the business that currently owns it.

Assignment of a trademark involves transfer of ownership of the mark and such assignment under the Indian law may be made with or without the goodwill of the business. The law prescribes a procedure for advertisement of assignment as a notice to the public where the assignment is without goodwill of business. Then, there are also restrictions on assignment where multiple exclusive rights would be created or where exclusive rights would be created in different parts of India.

When a person becomes entitled by assignment or transmission to a registered trademark, he is required by law to register

his title.³² Further, an instrument in respect of which no entry has been made in the register is not to be admitted in evidence by any court as a proof of title to a trademark acquired by assignment.

Do you need to register all small modifications to your trademark?

Many trademarks, including some of the most famous, have slightly changed or evolved over the years in order to modernize the image of a company or adapt to new advertising media.

Under the Indian law, alteration of a registered mark in any manner ‘substantially affecting the identity thereof’ is not permissible. Further, where the use of a registered trademark is required to be proved, the **tribunal** may accept use of a registered associated trademark or of the trademark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.³³ As such, when the alteration is rather substantial, the altered mark may become the subject of separate registration, so that it is associated with the prior registered mark.

³² Section 45, The Trade Marks Act, 1999

³³ Section 55, The Trade Marks Act, 1999

The Trade Marks Act, 1999, 1(ze): “tribunal” means the Registrar or, as the case may be, the Appellate Board before which the proceeding concerned is pending.

5. Enforcing Trademarks

What should your business do if its trademark is being used by others without authorization?

The burden of enforcing a trademark is mainly on the trademark owner. It is up to your company as a trademark owner to identify any potential or actual infringement and to decide what measures should be taken to protect and enforce your trademark rights. Registration of a trademark will be purposeless, unless the rights conferred by registration are enforced against unauthorized use of a trademark as a trademark by third parties.

It is always useful to seek expert advice if you believe that someone is infringing your trademark. An intellectual property lawyer would be the right person to provide guidance on the existing options in India and abroad to initiate action against counterfeiting and infringement and will provide you with advice on how to enforce your rights.

If you are faced with **infringement** of your trademark rights, then you may choose to begin by sending a letter (commonly known as a “cease and desist letter”) to the alleged infringer informing him/her of the possible existence of a conflict. In

writing such a letter, the assistance of a trademark lawyer is recommended.

In India, there is an appellate board to exercise the jurisdiction, powers and authority conferred on it.³⁴ Any person aggrieved by an order or decision of the Registrar may prefer an appeal to the Appellate Board within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal³⁵. The court or other authority are not entitled to exercise any jurisdiction, powers or authority in relation to the matters referred³⁶.

In India, the law provides for filing a suit for infringement before a court of a minimum level of a District court.³⁷ The relief may include *ex parte* injunction or any interlocutory order.³⁸ Apart from the civil and administrative remedies, the law provides for criminal proceedings against falsifying and falsely applying trademarks, which are criminal offences. The penalties include imprisonment for a term varying from six months to three years and with fine from fifty thousand rupees to two lakhs rupees.

Any police officer not below the rank of deputy superintendent of police or

³⁴Section 83, The Trade Marks Act, 1999

³⁵Section 91(1), The Trade Marks Act, 1999

³⁶Section 93, The Trade Marks Act, 1999

³⁷Section 134, The Trade Marks Act, 1999

³⁸Section 135(2), The Trade Marks Act, 1999

equivalent, may search and seize without warrant the goods, die, block, machine, plate, other instruments or things involved in committing the offence. All the articles so seized are to be produced before a Judicial Magistrate of the first class or a Metropolitan Magistrate. The police officer, before making any search and seizure, has to obtain the opinion of the Registrar on facts involved in the offence relating to trademark and will abide by the opinion so obtained.³⁹

In order to prevent the **importation of counterfeit trademark goods**, measures at the international border are available to trademark owners in many countries through the national customs authorities. As a trademark owner, your company may seek the assistance of the customs authorities at the border, that is, before the counterfeit goods have been distributed in the country concerned. The assistance of customs would generally require payment of prescribed fees, for which you will have to contact the relevant customs authorities.

In India, as proprietor or a licensee of a registered trademark, you can give notice in writing to the Collector of Customs, objecting to the importation of goods bearing an infringing trademark.

There are certain goods which are prohibited to be imported into India by the Central Government and are liable to confiscation on importation under the Act. The Commissioner of customs, on representation/trademarks complaint, under the Act, can ask the importer or his agent to produce any document in relation to goods and to furnish information as to the name and address of the sender of such goods and also of the receiver of the goods in India. This information may be sought within a period of fourteen days, and if the person fails to do so, he may be fined upto five hundred rupees. In case any aforesaid information is received from the importer/agent, the Commissioner of custom communicates it to the registered proprietor/user of the trademark.⁴⁰

In any proceeding relating to a Trademark, the tribunal shall admit evidence of the usages of the trade concerned and of any relevant Trademark or trade name of get up legitimately used by other person.⁴¹

Plan your trademark enforcement strategy in such a manner that it serves your overall business objectives as well as your overall intellectual property strategy, keeping in mind its likely costs, both in terms of money and time, and benefits. In doing so, it would be very useful to rely

³⁹Section 115(4), The Trade Marks Act, 1999

⁴⁰ Section140, The Trade Marks Act, 1999

⁴¹section 144, The Trade Marks Act, 1999

on the advise of a competent trademark lawyer/attorney, given the complexity of the relevant laws and procedures before the courts, police and customs authorities in India and abroad

Arbitration or mediation: In some instances, an effective way of dealing with infringement is through arbitration or mediation. Arbitration generally has the advantage of being a less formal, shorter and cheaper procedure than court

proceedings, and an arbitral award is more easily enforceable internationally. An advantage of mediation is that the parties retain control of the dispute resolution process. As such, it can help to preserve good business relations with another enterprise with which your company may like to collaborate in the future. For more information on arbitration and mediation, see the website of the WIPO Arbitration and Mediation Center at: [/arbitrator.wipo.int/center/index.htm/](http://arbitrator.wipo.int/center/index.htm/).

ANNEX I

Useful Websites for further information

On other intellectual property issues from a business perspective:

www.wipo.int/sme/

On trademarks in general:

- "About IP" at the WIPO website: www.wipo.int/about-ip/en/

- International Trademark Association: www.inta.org

On practical aspects relating to the registration of marks, see list of websites of national and regional trademark offices available in Annex I; or

www.wipo.int/news/en/links/ipo

On the Madrid system for the International Registration of Marks:

www.wipo.int/madrid/en

For a list of on-line trademark databases maintained by industrial property offices throughout the world:

www.arbiter.wipo.int/trademark/

On the International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement:

www.wipo.int/classifications/en (under Nice Agreement)

On the International Classification of the Figurative Elements of Marks under the Vienna Agreement:

www.wipo.int/classifications/en (under Vienna Agreement)

On the conflict between trademarks and domain names and on alternative dispute resolution procedures for domain names:

www.arbiter.wipo.int/domains/

www.icann.org

ANNEX II

Internet Addresses of National and Regional Intellectual Property Offices

Afghanistan	Not available
Albania	www.alpto.gov.al
Algeria	www.inapi.org
Andorra	www. ompa.ad
Angola	Not available
Antigua and Barbuda	Not available
Argentina	www.inpi.gov.ar
Armenia	www.armpatent.org
Australia	www.ipaustralia.gov.au
Austria	www.patent.bmvit.gv.at
Azerbaijan	www.azpat.org
Bahamas	Not available
Bahrain	<i>Not available</i>
Bangladesh	Not available
Barbados	www.caipo.org
Belarus	www.belgospatent.org
Belgium	www.mineco.fgov.be
Belize	www.belipo.bz
Benin	<i>Not available</i>
Bhutan	Not available
Bolivia	www.senapi.gov.bo
Bosnia and Herzegovina	www.basmp.gov.ba
Botswana	<i>Not available</i>
Brazil	www.inpi.gov.br
Brunei Darussalam	Not available
Bulgaria	www.bpo.bg
Burkina Faso	Not available
Burundi	Not available
Cambodia	Not available
Cameroon	Not available
Canada	www.opic.gc.ca
Cape Verde	Not available
Central African Republica	Not available
Chad	Not available
Chile	www.dpi.cl
China	www.sipo.gov.cn
Colombia	www.sic.gov.co

Comores	Not available
Congo	www.anpi.cg.wipo.net
<i>Cook Islands</i>	Not available
Costa Rica	www.registracional.go.cr
Côte d'Ivoire	Not available
Croatia	www.dziv.hr
Cuba	www.ocpi.cu
Cyprus	www.mcit.gov.cy/mcit/drcor/drcor.nsf
Czech Republic	www.upv.cz
Democratic People's Republic of Korea	Not available
Democratic Republic of the Congo	Not available
Denmark	www.dkpto.dk
Djibouti	Not available
Dominica	Not available
Dominican Republic	www.seic.gov.do/onapi
Ecuador	Not available
Egypt	www.egypo.gov.eg
El Salvador	www.ias.cnr.gob.sv/PI/online
Equatorial Guinea	Not available
Eritrea	Not available
Estonia	www.epa.ee
Ethiopia	Not available
Fiji	Not available
Finland	www.prh.fi
France	www.inpi.fr
Gabon	Not available
Gambia	Not available
Georgia	www.sakpatenti.org.ge
Germany	www.dpma.de
Ghana	Not available
Greece	www.obι.gr
Grenada	Not available
Guatemala	www.rpi.gov.gt
Guinea	Not available
Guinea-Bissau	Not available
Guyana	Not available
Haiti	Not available
Holy See	Not available
Honduras	www.sic.gob.hn/pintelec/indice.htm
Hungary	www.hpo.hu
Iceland	www.els.stjr.is

India	www.ipindia.nic.in
Indonesia	www.dgip.go.id
Iran (Islamic Republic of)	Not available
Iraq	Not available
Ireland	www.patentsoffice.ie
Israel	www.justice.gov.il
Italy	www.uibm.gov.it
Jamaica	www.jipo.gov.jm
Japan	www.jpo.go.jp
Jordan	www.mit.gov.jo
Kazakhstan	www.kazpatent.kz
Kenya	Not available
Kiribati	Not available
Kuwait	Not available
Kyrgyzstan	Not available
Lao People's Democratic Republic	www.stea.la.wipo.net
Latvia	www.lrpv.lv
Lebanon	www.economy.gov.lb
Lesotho	Not available
Liberia	Not available
Libyan Arab Jamahiriya	Not available
Liechtenstein	Not available
Lithuania	www.vpb.lt
Luxembourg	www.etat.lu/ec
Madagascar	Not available
Malawi	Not available
Malaysia	www.mipc.gov.my
Maldives	www.trademin.gov.mv/home
Mali	Not available
Malta	www.foi.org.mt
Mauritania	Not available
Mauritius	Not available
Mexico	www.impi.gob.mx
Moldova	Not available
Monaco	www.european-patent-office.org/patlib/country/monaco/
Mongolia	www.ipom.mn
Montenegro	Not available
Morocco	www.ompic.org.ma
Mozambique	www.ipi.gov.mz
Myanmar	Not available
Namibia	Not available

Nauru	Not available
Nepal	www.ip.np.wipo.net
Netherlands	www.octrooicentrum.nl
New Zealand	www.iponz.govt.nz
Nicaragua	www.rpi.gob.ni
Niger	www.bnda.ne.wipo.net
Nigeria	Not available
Norway	www.patentstyret.no
Oman	www.gulf-patent-office.org.sa
Pakistan	www.ipo.gov.pk
Palau	Not available
Panama	Not available
Papua New Guinea	Not available
Paraguay	Not available
Peru	www.indecopi.gob.pe
Philippines	www.ipophil.gov.ph
Poland	www.uprp.pl
Portugal	www.inpi.pt
Qatar	Not available
Republic of Korea	kipo.go.kr
Romania	Not available
Russian Federation	Not available
Rwanda	Not available
Saint Kitt and Nevis	Not available
Saint Lucia	Not available
Saint Vincent and the Grenadines	Not available
Samoa	Not available
San Marino	Not available
Sao Tome and Principe	Not available
Saudi Arabia	Not available
Senegal	www.oapi.wipo.net
Serbia	www.yupat.sv.gov.yu/sr
Seychelles	Not available
Sierra Leone	Not available
Singapore	www.ipos.gov.sg
Slovakia	www.indprop.gov.sk
Slovenia	www.uil-sipo.si
<i>Solomon Islands</i>	Not available
Somalia	Not available
South Africa	www.uil-sipo.si
Spain	www.oepm.es
Sri Lanka	Not available

Sudan	Not available
Suriname	Not available
Swaziland	Not available
Sweden	<i>www.prv.se</i>
Switzerland	<i>www.ige.ch</i>
Syrian Arab Republic	<i>www.spo.gov.sy</i>
Tajikistan	Not available
Thailand	<i>www.ipthailand.org</i>
The Former Yugoslav Republic of Macedonia	<i>www.ippo.gov.mk</i>
Togo	Not available
Tonga	Not available
Trinidad and Tobago	<i>www.ipo.gov.tt/home.asp</i>
Tunisia	<i>www.inorpi.ind.tn</i>
Turkey	<i>www.turkpatent.gov.tr</i>
Turkmenistan	Not available
Uganda	Not available
Ukraine	<i>www.sdip.gov.ua</i>
United Arab Emirates	Not available
United Kingdom	<i>www.patent.gov.uk</i>
United Republic of Tanzania	<i>www.cosota-tz.org</i>
United States of America	<i>www.uspto.gov</i>
Uruguay	<i>www.dnpi.gub.uy</i>
Uzbekistan	<i>www.patent.uz</i>
<i>Vanuatu</i>	Not available
Venezuela	Not available
Vietnam	Not available
Yemen	<i>www.yipo.gov.ye</i>
Zambia	Not available
Zimbabwe	Not available

Rev. April 29, 2008

Note: For update list of websites visit the WIPO website at www.wipo.int/directory/en/urls.jsp

ANNEX III

Classification of goods and services – Name of the classes

(Parts of an article or apparatus are, in general, classified with the actual article or apparatus, except where such parts constitute articles included in other classes).

Classes of Goods

- CLASS 1:** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- CLASS 2:** Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- CLASS 3:** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- CLASS 4:** Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- CLASS 5:** Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- CLASS 6:** Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- CLASS 7:** Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

- CLASS 8:** Hand tools and implements (hand-operated); cutlery; side arms; razors.
- CLASS 9:** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
- CLASS 10:** Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- CLASS 11:** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- CLASS 12:** Vehicles; apparatus for locomotion by land, air or water.
- CLASS 13:** Firearms; ammunition and projectiles; explosives; fireworks.
- CLASS 14:** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
- CLASS 15:** Musical instruments.
- CLASS 16:** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- CLASS 17:** Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
- CLASS 18:** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.

- CLASS 19:** Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
- CLASS 20:** Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- CLASS 21:** Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- CLASS 22:** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- CLASS 23:** Yarns and threads, for textile use.
- CLASS 24:** Textiles and textile goods, not included in other classes; bed and table covers.
- CLASS 25:** Clothing, footwear, headgear.
- CLASS 26:** Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
- CLASS 27:** Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- CLASS 28:** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- CLASS 29:** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
- CLASS 30:** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

CLASS 31: Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.

CLASS 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

CLASS 33: Alcoholic beverages (except beers).

CLASS 34: Tobacco; smokers' articles; matches.

CLASSES OF SERVICES

CLASS 35: Advertising; business management; business administration; office functions.

CLASS 36: Insurance; financial affairs; monetary affairs; real estate affairs.

CLASS 37: Building construction; repair; installation services.

CLASS 38: Telecommunications

CLASS 39: Transport; packaging and storage of goods; travel arrangement

CLASS 40: Treatment of materials

CLASS 41: Education; providing of training; entertainment; sporting and cultural activities.

CLASS 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.

CLASS 43: Services for providing food and drink; temporary accommodation.

CLASS 44: Medical Services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

CLASS 45: Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

Note : The International classification which had 42 classes earlier has been enlarged to 45 classes. The changes are in the separation of some of the services, which were hitherto covered by class 42 into classes 43, 44 and 45. The Indian classification, as above, does not however reflect these changes.

ANNEX IV

Members of the Madrid Union

(As on February 7, 2008)

Albania (A&P)	Germany (A&P)
Algeria (A)	Greece (P)
Antigua and Barbuda (P)	Hungary (A&P)
Armenia (A&P)	Iceland (P)
Australia (P)	Iran (Islamic Republic of) (A&P)
Austria (A&P)	Ireland (P)
Azerbaijan (A)	Italy (A&P)
Bahrain (P)	Japan (P)
Belarus (A&P)	Kazakhstan (A)
Belgium* (A&P)	Kenya (A&P)
Bhutan (A&P)	Kyrgyzstan (A)
Bosnia and Herzegovina (A)	Latvia (A&P)
Bulgaria (A&P)	Lesotho (A&P)
China (A&P)	Liberia (A)
Croatia (A)	Liechtenstein (A&P)
Cuba (A&P)	Lithuania (P)
Cyprus (A&P)	Luxembourg* (A&P)
Czech Republic (A&P)	Madagascar (P)
Democratic People's Republic of Korea (A&P)	Moldova (A&P)
Denmark (P)	Monaco (A&P)
Egypt (A)	Mongolia (A&P)
Estonia (P)	Montenegro (A&P)
European Community (P)	Morocco (A&P)
Finland (P)	Mozambique (A&P)
France (A&P)	Namibia (A&P)
Georgia (P)	Netherlands* (A&P)
	Norway (P)

Oman (P)	Sweden (P)
Poland (A&P)	Switzerland (A&P)
Portugal (A&P)	Syrian Arab Republic (A&P)
Republic of Korea (A&P)	Tajikistan (A)
Romania (A&P)	The former Yugoslav Republic of Macedonia (A&P)
Russian Federation (A&P)	Turkey (P)
San Marino (A)	Turkmenistan (P)
Serbia (A&P)	Ukraine (A&P)
Sierra Leone (A&P)	United Kingdom (P)
Singapore (P)	United States of America (P)
Slovakia (A&P)	Uzbekistan (A)
Slovenia (A&P)	Viet Nam (A)
Spain (A&P)	Zambia (P)
Sudan (A)	
Swaziland (A&P)	

Total: 82

(A) : indicates a party to the Agreement (56)

(P) : indicates a party to the Protocol (75)

* Protection may not be requested separately on Belgium, Luxembourg or the Netherlands , but only for all three countries as a whole (Benelux), subject to payment of a single complementary or individual fee.

Note: For up to date information about member of the Madrid Union visit the website of WIPO at www.wipo.int/treaties/en/documents/pdf/madrid_marks.pdf

ANNEX V

Trademarks Registry

Head Office and Branch offices

MUMBAI (Head Office)

Joint Registrar of Trademarks

Trade Marks Registry

Intellectual Property Bhavan

SM Road, Antop Hill

Mumbai-400 037

Tel. 022- 24101144, 24101177 Fax: 022- 24120808, 24132295

(States covered: Maharashtra, Madhya Pradesh, Chattisgad, Goa)

AHMEDABAD

Assistant Registrar of Trademarks

Trade Marks Registry

15/27 National Chambers, 1st floor

Ashram road, Ahmedabad-380 009.

Tel: 079-26580567, 26587193

Fax: 079-26586763

(States covered: Gujarat and Rajasthan and Union Territory of Damman, Diu, Dadra and Nagar Haveli).

KOLKATA

Assistant Registrar of Trademarks

Trade Marks Registry

I.P.Bhavan, 5th floor, CP-2

Sector V, Salt Lake

Kolkata-700 091

Phone: 033-23675975, 23672848

Telfax. 033-23677311

(States covered: Arunachal Pradesh, Assam, Bihar, Orissa, West Bengal, Manipur, Mizoram, Meghalaya, Sikkim , Tripura and Union Territory of Nagaland, Andaman & Nicobar Island).

NEWDELHI**Assistant Registrar of Trademarks**

Trade Marks Registry
Intellectual Property Bhavan
Plot NO.32, Sector 14, Dwarka
New Delhi-110 075
Tel. 011-28082915/16/17
Fax: 28082917

(States covered: State of Jammu & Kashmir, Punjab, Haryana, Uttar Pradesh, Himachal Pradesh, Union Territory of Delhi and Chandigarh).

CHENNAI**Joint Registrar of Trademarks**

Trade Marks Registry
IPR building, Industrial Estate Sidco
RMD Godown Area, GST Road
Guindy, Chennai-600 031
Tel : 044-22321992, 23222441/42
Fax: 044-24314751

(States covered: Andhra Pradesh, Kerala, Tamil Nadu, Karnataka and Union Territory of Pondicherry and Lakshadweep Island).

ANNEX VI

Fees for some important Trade Marks Transactions

(As per Trade Marks Rules, 2002)

Entry No.	On what payable	Amount Rs. P.	Corresponding Form Number
1.	On application to register a Trademark for a specification of goods or services included in one class [Section 18(1)]	2500.00	TM-1
2.	On a single application under section 18(2) for the registration of a Trademark for different classes of goods or services.	2500.00 for each class	TM-51
3.	For renewal under section 25 of the registration of a Trademark at the expiration of the last registration not otherwise charged.	5,000.00	TM-12
4.	For renewal under section 25 of the registration of a series trade mark at the expiration of the last registration. For the first two marks of the series of each separate class:	5,000.00	TM-12
	For every additional mark of the series of each separate class.	2500.00	

Entry No.	On what payable	Amount Rs. P.	Corresponding Form Number
5.	For renewal under section 25 of a single application of a trade mark for goods or services in more than one class-in respect of every class.	5,000.00 for each class	TM-12
6.	For renewal under section 25 of the registration of a collective mark/certification trade mark.	20,000.00	TM-12
7.	On application under section 25(4) for restoration of a Trademark removed from the register.	3000.00	TM-13
8.	For a search under rule 24(1) in respect of one class	500.00	TM-54
9.	On request for the Registrar's preliminary advice under section 133(1) for a Trademark in respect of one class.	1000.00	TM-55

Note: For more information, see the website of Trade Marks Registry at www.ipindia.nic.in/tmr_new/first_schedule_forms/the_first_schedule.htm

WIPO Publications in the "Intellectual Property for Business" series:

1. Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises. WIPO publication No. 900.
2. Looking Good: An Introduction to Industrial Designs for Small and Medium-sized Enterprises. WIPO publication No. 498.
3. Inventing the Future: An Introduction to Patents for Small and Medium-sized Enterprises. WIPO publication No. 917.
4. Creative Expression: An Introduction to Copyright for Small and Medium-sized Enterprises. WIPO publication No. 918.

For other business oriented content and publications on intellectual property, please consult the www.wipo.int/sme. You may also subscribe to the free monthly electronic newsletter of the SMEs Division available at www.wipo.int/sme/en/documents/wipo_sme_newsletter.html

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Price Rs. 100/-

ISBN 978-81-7236-328-1