

## **TRADEMARK**

A trade mark (popularly known as brand name) is a visual symbol which may be a word signature, name, device, label, numerals or combination of colors used by one undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from a different undertaking.

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

### **Trademark performs four functions –**

- It identifies the goods / or services and its origin;
- It guarantees its unchanged quality;
- It advertises the goods/services;
- It creates an image for the goods/ services

### **Who can apply for Trademark?**

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may apply in writing in **Form TM-1** for registration. The application should contain the trade mark, the goods/services, name and address of applicant and agent (if any) with power of attorney, period of use of the mark and signature. The application should be in English or Hindi. It should be filed at the appropriate office.

### **Location and Jurisdiction of Trademarks Office**

#### **1. Trade Marks Registry, Mumbai**

Jurisdiction: States of Maharashtra, Madhya Pradesh and Goa.

## **2. Trade Marks Registry, Delhi**

Jurisdiction: States of Jammu & Kashmir, Punjab, Haryana, Uttar Pradesh, Himachal Pradesh, Union Territory of Delhi and Chandigarh

## **3. Trade Marks Registry, Kolkata,**

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

## **4. Trade Marks Registry, Ahmedabad,**

Jurisdiction: States of Gujarat and Rajasthan and Union Territory of Damman, Diu, Dadra and Nagar Haveli

## **5. Trade Marks Registry, Chennai**

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

### **Particulars to be filed with application for registration**

The application should be filed in triplicate with the following particulars –

- Graphic representation of the trademark.
- Five Additional representations are to be provided corresponding exactly with one another.
- In the case of three dimensional mark, the reproduction of the mark should consist of a two dimensional or photographic reproduction.
- Where the trade mark contains a word or words in scripts other than Hindi or English, a transliteration and translation of each word in English or in Hindi should be given indicating the language to which the word belongs, at the time of filing the application to facilitate completion of data entry at the initial stage itself.
- The application may contain a declaration claiming priority as per the Paris Convention

### **Administrative procedure of registration of trademarks**

An application for registration of trademarks is received at the Trademark Registry according to territorial jurisdiction.

Applications are then examined mainly with regard to the distinctiveness, possibility of deceptiveness and conflicting trademarks.

If accepted, the trademark is published in the official gazette i.e. Trade Marks Journal (published in CD Rom).

Within a prescribed period any person can file an opposition, a copy of which is served to the applicants who is required to file a counterstatement within two months failing which the application shall be treated as abandoned.

Thereafter, the opponent leads evidence in support of his case by way of affidavit followed by the applicant's evidence also by way of affidavit in support of the application.

After that the opponent files evidence by way of rebuttal. On completion of evidence, the matter is set down for a hearing and the case is decided by a Hearing officer. The registrar's decision is appealable to the Intellectual Property Appellate Board.

### **Correction and amendment of registration application**

An applicant for registration of a trade mark can before the registration of the mark, apply in **Form TM-16** for correction of any error in connection with his application. But the correction should not alter the trade mark that has been applied for or substitute a new specification of goods or services not included in the application.

### **Renewal of registration**

The period of registration is **10 years** under the present Act. The 10 year period of registration is reckoned from the date of making of the application which is deemed to be the date of registration.

Registrations can be renewed by payment of prescribed renewal fees in all cases (trademark / collective marks/certification marks) on **form TM-12**. The application is filed by the proprietor of the registered trade mark or his agent. If there is any change in the proprietorship of the mark, and it has not been brought on record, proof of title should be filed in the first instance.

### **Offences & Penalties**

There are mainly two classes of Offences relating to Trademarks –

- (a) Falsification of Trademark
- (b) Falsely applying the trademark to goods or services

The punishment for the above offences shall not be less than 6 months imprisonment which may extend to three years and a fine which shall not be less 50,000/-, but may extend to Rupees Two

Lakh. Wherever the court proposes a lower punishment than the minimum, it has to record, adequate and special reasons for the same.

However second and subsequent offences shall be more severely punished. There shall be an Imprisonment of not less than one year which may extend to three years and a fine which shall not be less Rupees One lakh, but may extend to Rupees Two Lakh. The court can propose a lower punishment than the minimum, only after recording adequate and special reasons for the same.

### **E-filing of Trademark application**

E-filing is the service provided by the Trademark Registry in order to enable customers to apply for a Trade Mark on-line allowing from the applicant's browser to:

- Complete an electronic application form;
- Provide the associated attachments;
- Complete the necessary payment details

### **Procedure for e-filing**

In order to submit an electronic application form, following steps should be followed -

- 1) Acquire Class 3 Digital Signatures from (n)Code Solutions or Tata Consultancy Services (TCS) or Safe Script from Sify . The Procedure for getting the Digital Signature and the location of their Offices is available at their website.
- 2) For users (Proprietors/Agents or Attorneys), already registered with TMR (Trademark Registry) Office India can complete online registration by providing a desired User ID, their User Type (Proprietor/Agent/Attorney) and User Code.
- 3) For Users who are not registered as Proprietor / Attorney with TMR Office, they can search and fill online form to obtain User code (Party Code).
- 4) Secure Login into the system with created User Id and the Digital Signatures.
- 5) Obtain a New Reference Number for New Application. Use this option when the applicant wants to apply for a new Trademarks Application.
- 6) Update Application Details: Use this option to edit / update the application details along with relevant images and attached documents. Final Submission to TMR-India with Digital Signature is included in this option after which application cannot be edited.
- 7) The Cases which are Digitally Submitted to TMR, India are available for online payment. The applicant can pay for more than one application in a single transaction. Once the payment is

realized as confirmed by the Payment Gateway, an acknowledgement receipt for the fees paid is generated by the system indicating the Receipt Number, Application Number and Date of Filing.

8) An applicant can also view online History and status of the applications filed by him / her by clicking Status of Filed Application.

9) An applicant can also view the online status of e-Payments.