

**Intellectual Property**  
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**Lecture - 46**  
**Registration of Trade Mark**

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We have already seen that the distinguishing feature between a trade mark that is registered, and a trade mark that is not registered is the fact that it becomes easier to enforce a trade mark that is registered. For instance, while filing an infringement suit, the person who owns the mark can file the infringement suit at the place at which he resides; in the usual course it should be done at the place where the infringement is committed. In most cases it could be the place where the infringer resides or carries his business. So, that is one distinct advantage the fact that the right holder can now choose the jurisdiction or he can choose where to file the case.

The second advantage as we have already seen is that registration, the fact that you have registered your mark will not require you to demonstrate goodwill or reputation tied with a mark; which you should demonstrate if you try to enforce an unregistered mark. The third advantage is that registration can be done even in the case of a proposed to use. You plan to use a mark in the future; you can still file and get it registered. So, registration has it is distinct advantages.

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**Registration of Trade Mark**

- Process of registration
  - Filing of application
  - Examination
  - Publication, observation, and opposition
  - – Registration
    - Period of 10 years
  - Renewal
    - Prescribed fee, renewed for further 10 years

IPTEL

Now, how do you register a trade mark in India? So, the process of registration involves few steps. The first one is filing an application using the prescribed form and paying the prescribed fees. Now this can be done manually, it can be done by post and it could also be done electronically. Once the application is filed, the application is examined and there is a publication. And when it is published it has put the application is put to notice to the world at large.

So, there is an observation period, following which there could be an opposition. Now opposition is soon after the publication any member of the public who is interested in the mark may lodge an opposition. And there are grounds on which you can oppose a trade mark.

So, the office will look into the opposition, and then once the opposition has overcome by the applicant, the office would register the trade mark. Now the registered trade mark is valid for a period of 10 years. And it can be renewed every 10 years. So, the renewal is done by paying the prescribed fee, and it can be renewed for a further period of 10 years.

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The slide features a title 'Classification' at the top center. In the top right corner, there is a small circular logo with the text 'IPTEL' below it. The main content is a bulleted list:

- Classification of goods and services
  - International Classification
  - Nice Classification *-(WIPO)*
  - Disputes determined by the Registrar


Now, when you file a mark, a trade mark, you need to identify the goods and services for which it is applied for. So, we have an international classification system, and the international classification system is called the Nice classification; which was established by the Nice agreement in 1957, this was an agreement entered into by various countries, and it happened for the first time in Nice which is a city in France. So, it takes the name from the place. The nice classification is a system of classifying goods and services for the purpose of registering term marks, the trade marks, for the purpose of registering trademarks.

The classification system is updated every 5 years, and currently we have the 10th version of the nice classification. The system comprises of groups which, the Nice classification system classifies products into 45 classes and allows users seeking to trade mark a good or a service to choose from these classes which may be appropriate for their product or service. The Nice classification system is administered by the World Intellectual Property Organization or WIPO. And if there are any disputes in the classification it is settled by the registrar.

So, though we follow the nice classification system, the classification system is also a part of the trade mark law in India. So, any application has to mention the particular class to which the goods or the services belong to, and whether the use is a current use or whether it is a proposed use. When an application is filed seeking of trade mark, the

registration could be refused for certain grounds. So, there are certain grounds on which a registration can be refused.

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## Absolute Grounds

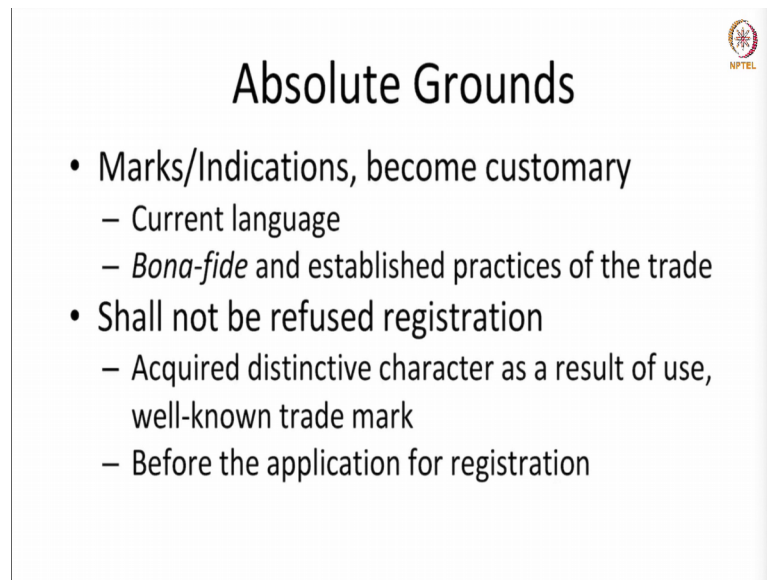
- Relate to inherent objections to distinctiveness and certain public interest objections
- Devoid of any distinctive character
  - Not capable of distinguishing the goods and services of one person from those of another person
- Exclusively consists of marks which designate kind, quality, quantity, intended purpose, values, geographical origins, characteristics

The absolute grounds on which a registration can be refused relate to inherent objection to distinctiveness and certain public interest objections. Now, if the mark is not capable of distinguishing goods and services. It is inherently not distinguishable or it does not have distinctiveness, that could be an ground for not registering it. The mark not having a distinctive character in the sense that, it is not capable of distinguishing goods and services of one person from those of.

Similarly, when the marks exclusively consist of things that designate kind, quality, quantity, intended, purpose, values, geographical origin, characteristics, the mark will not be granted a registration; because these are things that are common to every good or service in that industry. For instance, if there is an aquatic equipment. The aquatic equipment needs to be waterproof or water resistant. So, you cannot sell aquatic equipment saying that it is water resistant or waterproof. So, that is an inherent quality all equipment that has to be used underwater should satisfy.

So, you cannot use as a mark something that designates the kind, quality, quantity, intended purpose, value, geographical origin or characteristics as these are common to all goods and services in that particular segment.

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## Absolute Grounds

- Marks/Indications, become customary
  - Current language
  - *Bona-fide* and established practices of the trade
- Shall not be refused registration
  - Acquired distinctive character as a result of use, well-known trade mark
  - Before the application for registration

Marks and indications that have become by custom a part of the current language, or that are bona fide and established practices of the trade cannot be granted registration. Marks that have become a part of the language for instance, dictionary words or words that are currently used in common parlance are words which people understand as common nouns. Now you cannot have a trade mark using something which is a part of the common language. Because the understanding is that it belongs to the public domain. And while granting a trade mark, you are trying to create special private rights on a particular mark or a word with regard to a goods or a service.


So, anything that is a part of the current language or that is an established practice of a trade, like a safety measure or the fact that something is efficient, or something is faster quicker, now all these things are understood as a part of the trade. They cannot be marks which indicate what is customary or what has become a part of the trade.

However certain marks shall not be refused registration marks that acquire distinctive character as a result of use. So, they could be a mark which refers to something that is generic, but over a period of time it acquires a distinctive character. We had mentioned in some cases metro which even refers to a mass transit system can be used and has being used as a trade mark when it comes to footwear, when it comes to hotels, when it comes to hotels and restaurants as well as for hospitals.

So, in cases where they have acquired a distinctive character, even though they could be refused as an absolute ground, they will be granted a trade mark. And that has to be demonstrated that as a result of constant use the mark though it belongs to an absolute ground of rejection that the fact that it is descriptive or it does not have distinctiveness, it has acquired a distinctive character. So, that has to be shown before the trade mark office. Similarly, well known marks shall not be shall not be denied a registration. Because the fact that they are well known they could be used for any category of goods and services.

The distinctive character should have accrued on the mark before the application of for registration. So, it should not be that the mark is applied for registration, and then over a period of time the mark acquires the distinctive character; rather it has to be before the application for registration.

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## Absolute Grounds

- Deceive the public or cause confusion
- Contains or comprises of any matter likely to hurt the religious susceptibilities
- Scandalous or obscene matter
- Prohibited under Emblems and Names Act

Marks that are likely to deceive the public or cause confusion will not be registered. Marks that contain or comprises of any matter likely to hurt religious susceptibilities and sentiments will not be granted a registration. Scandalous or obscene matter will not be granted registration. And matters prohibited under the emblems and names act. For instance, the Indian flag or the National Emblem, the Ashoka Chakra will not be granted trade mark registration, because they are protected under the emblems and names act.

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## Absolute Grounds

- Shall not be registered if it consists exclusively of:
  - Shape of goods which results from the nature of the good themselves
  - Shape of goods, necessary to obtain a technical result
  - Shape which gives substantial value to goods

And as we have seen already a mark shall not be registered if it consists exclusively of shape of goods which result from the nature of the goods themselves. Shape of goods necessary to obtain a technical result, we had mentioned this in the context of flasks which traditionally have a shape; where it has a broad body and a narrow mouth.

And shape which gives substantial value to the goods, all balls need to be round. So, any shape that gives substantial value to the good cannot be a subject matter of registration.

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## Relative Grounds

- Arise because some other proprietor has an earlier conflicting right
- Fall into two categories
  - Concerned with 'earlier trade mark'
  - Concerned with 'earlier rights'
- Trade Marks shall be refused subject to certain conditions

There are also certain relative grounds on which registration can be refused. Our registration will be refused, if some other proprietor or owner has an earlier conflicting right. So, the day you file application for a mark, there is another person who has been using that mark before you. So, there could be a relative ground for registration largely because of a prior or a conflicting user.

Now, this can fall into 2 categories. One there are there is an earlier trade mark in place, or there are earlier rights, a person has been using a particular mark, he has a right to use the mark though it they may not be an earlier mark registered itself. And trade marks shall be refused subject to certain conditions. So, if there is going to be a rejection based on a relative ground that will be subject to certain conditions.

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## Relative Grounds

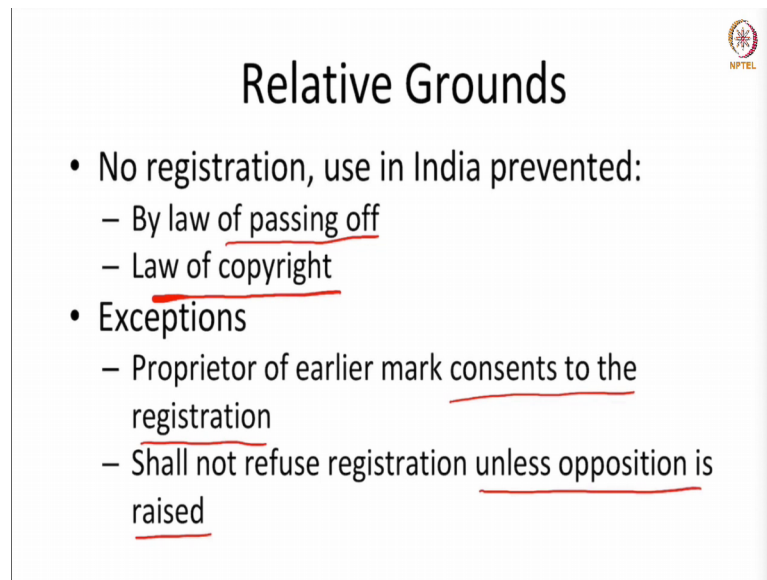
- Earlier TM well-known, use of later would take unfair advantage or detrimental to the distinctive character or repute of the earlier mark, shall not be registered
  - Identical, similar to an earlier TM
  - Registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor

Another ground for rejecting a trade mark is where the earlier trade mark is well known, use of the later would take unfair advantage or would be detrimental to the distinctive character or reputation of the earlier trade mark. So, when you have a well-known trade mark, the use of a later trade mark would be seen as taking an unfair advantage, or would it would be detrimental to the earlier trade mark.

Now, for this the mark has to be identical or similar to the earlier trade mark. And it has to be registered for goods or services which are not similar to those of which the earlier trade mark is registered in the name of a different proprietor.



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The slide is titled "Relative Grounds" and features a small logo in the top right corner. The content is a bulleted list:

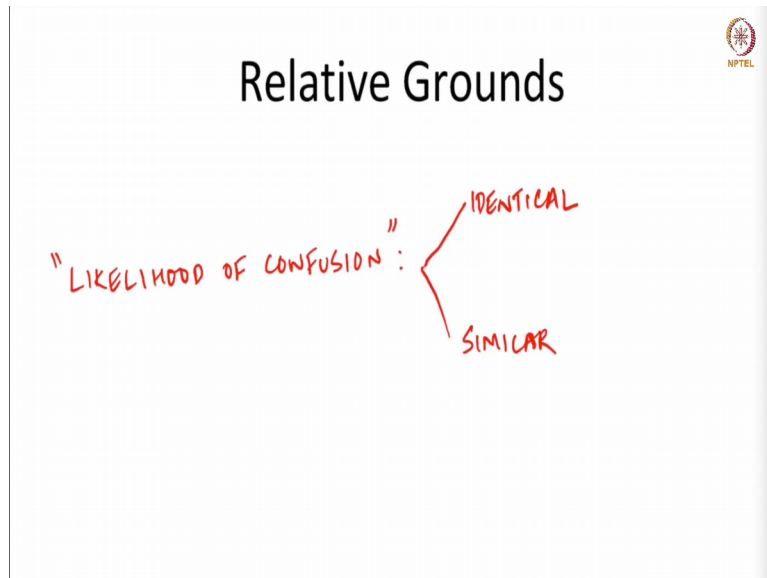
- No registration, use in India prevented:
  - By law of passing off
  - Law of copyright
- Exceptions
  - Proprietor of earlier mark consents to the registration
  - Shall not refuse registration unless opposition is raised

Similarly, no registration will be granted to a trade mark; whose use in India is prevented by the law of passing off. So, there is a prohibition in the law of passing off from using that mark. So, such marks will not be registered, and the law of copyright will not allow such mark to be registered.

So, these are additional grounds on which a mark will not be offered registration. Now there are some exceptions, a proprietor of an earlier mark consents to the registration. So, in such cases where the proprietor of the earlier mark, gives us consent you could still have a registration.

Refusal of registration shall not be done unless an opposition is raised. So, there has to be an opposition to the grant of a mark, and only then the mark would be refused. In normal course the mark will get granted, but refusal of registration under the relative grounds has to be done by an opponent; an opponent has to raise these grounds.

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A mark will not be granted registration, if it is likely to cause confusion. Likelihood of confusion is yet another relative ground on which a mark can be denied registration. Now this can arise when the mark is identical to an existing mark or it is similar to an existing mark.

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- The slide is titled "Honest Concurrent Use" and features the NPTEL logo in the top right corner. The main content is a bulleted list with three items, each starting with a circled number (1, 2, 3) and containing underlined text. The first item is a general statement. The second and third items are numbered and describe the conditions for registration. The final part of the third item is a sub-point.
- In case of honest concurrent use the Registrar may permit the registration by more than one
  - ① proprietor of the trade marks which are
  - ② identical or similar in respect of the same or
  - ③ similar goods or services
    - Subject to conditions and limitations

Honest concurrent use occurs when the mark is used by 2 owners at the same time. In the case of a honest concurrent use, the register may permit the registration by more than one


proprietor. So, here is a case where 2 people are allowed to use the same mark; which are identical or similar in respect of the same or similar goods or services.

So, there could be cases where 2 parties have been using the mark at the same time or around the same time, and one party approaches the registrar for a trade mark. The registrar would grant the trade mark to that person, but the registrar will not stop, the other person who has been using it if he is a honest concurrent user.

Now, the test is that they should have been using it around the same time, and the mark should be identical or similar. So, you have 2 proprietors one or more proprietors, identical or similar and they should have been used with regard to the same or similar goods or services.

Now, the registrar can subject the use to certain conditions and limitations; for instance, if the users are in India in 2 different states the registrar could set a limitation that each of those parties will confine their usage within particular geographical limits. So, those limitations can be set by the registrar.

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## Effect of Registration

- Initiate suit for infringement
- Exclusive rights to the use of the TM
  - Relation to goods and services for which granted
  - Subject to any conditions or limitations imposed
- Registration to be prima facie evidence of validity

Now, the effect of registration is that you can initiate a suit for infringement. If you do not have a registration or if you do not have a registered mark, then you can only file a case of passing off. It gives exclusive right to use the trade mark in relation to goods and services for which it has been granted and to subject to any conditions or limitations that

could be imposed by the registrar. And registration is prima facie evidence of validity. The fact that it is registered it is understood that the trade mark is valid.