**PROCESS FOR REGISTRATION OF A TRADE MARK**

**Introduction**

Before adopting a trademark, a trademark search is highly recommended, as this will give an indication of any existing trademarks which have been applied for/or registered in the Trademarks Registry.

A trademark availability search is highly advisable before huge amounts of money and time are invested in a trademark and the guidance of an experienced trademark attorney are extremely worthwhile.

**Classes of goods and services**

Before filing a trademark application, it is necessary to identify the classes in which you wish to seek protection for your trademark. An application should be made in the relevant classes of current goods/services as well as in classes where there is intent to use. All goods and services are divided into 45 classes. The 9th edition of the NICE international classification system is followed in India[[1]](#footnote-0).

**Choosing a Trademark**

A trademark must be chosen carefully. If you are launching a product and adopting a new trademark, please bear in mind that the scope of legal protection you would obtain depends on the type of trademark chosen. The guidelines for choosing an appropriate mark is provided in Sections 9, and 11 of the Trade Marks Act, 1999.

The most common mistake is to choose a word that is descriptive of the goods or services. People do this in the belief that the consumer will know straight away what the product is or the service rendered. The same result can easily be obtained by combining a distinctive and fanciful trademark with a word which indicates the goods or services. E.g. Kodak film. Descriptive trademarks are difficult to register and enforce. Although it may be easier to market such products at inception, such trademarks are offered the least amount of protection and therefore, in the long term, it would be difficult to stop your competitors from using the same or similar trademarks. A better strategy would be to adopt a coined word, which has no reference to the goods/services upon which it is used. E.g. Canon Another option is to adopt an arbitrary word, which has no relevance to the goods/services upon which it is used. E.g. Apple computers; Lotus software The more distinctive a trademark is, the broader will be the available scope of protection.

Kinds of marks to be avoided:

* Superlative or Laudatory words E.g. Premium, Gold, Deluxe
* Descriptive words E.g. Coffee shop for coffee bars; Cooler for Refrigerators
* Trademarks Confusing Similar to existing trademarks
* Words which have direct reference to the Character or Quality of the product/service. E.g. Best Choice, Easy Cook, Super
* Common Personal Names or surnames. Such names are registrable only if it has acquired distinctiveness through advertisements and long use
* Well known geographical names such as SWISS chocolates or U.S.A. pizza are also not registrable.

In Hindustan lever vs. Kilts[[2]](#footnote-1) the word SAFEO was held descriptive not registrable for cleaning powder and liquid for being too close to the word SAFE meaning ,clean, white.

In Dilip Chand Aggarwal vs. Escorts Ltd[[3]](#footnote-2), a trade mark ESCORTS which was sought to be registered in respect of electric iron, electric kettles etc. on the opposition by the owner of the well-known mark ESCORTS in respect of a variety of goods in the Indian market, was refused for registration.

**Requirements for filing a trademark application**

* The name, address and nationality of the applicant. If the applicant is a partnership firm, the names of all the partners. Also mention whether any minor is a partner.
* If the applicant is a company, the country or state of incorporation.
* A list of goods and/or services for which registration is required.
* Soft copy of the trademark to be registered.
* If the mark contains or consists of non-English words, a translation of those words into English is required.
* If the application is to claim priority from an earlier filed convention application, details of that application is also required (application number, filing date, country and goods/services). A certified priority document or its duly notarized copy is to be submitted. If the certificate is not in English, a certified/notarized English translation is also required. If it is not readily available, the application can be filed based on the basic application number, date of the application and country of the application. A copy of the priority document can be submitted within 1 month from the filing date of the application.
* Date of first use of the trademark in India, if at all used Power of attorney simply signed by the applicant (no legalization or notarization is required).
* For Indian clients, power of attorney to be executed in 100 Rs. stamp paper and signed by the applicant. The power of attorney is not required at the time of lodging the application and can be submitted later with no additional cost

**Procedure for registration**

All relevant documents as stated above must be filed with the Trade Marks Office in accordance with section 18 of the Act. Upon filing of the application, the registry will issue us with an official receipt with the filing date and number allotted to the application. The application is then formally examined by the Indian Trade Marks Office, as to its inherent registrability and/or any similarity with existing marks.

If an objection to registration is raised, an official examination report will issue. To overcome the objection, it is necessary to file a written response or presenting evidence of acquired distinctiveness and in most cases, an interview/hearing with the examiner is posted. The Registrar may require the applicant to file an affidavit testifying to such user with exhibits showing the mark as used.

If, following examination, the trade mark application is considered allowable, a Letter of Acceptance (TLA order) will issue, after which the trademark will be published in the Trade Marks Journal. If there are no oppositions within 4 months from the date of advertisement in the Trade Marks Journal, then the trademark registration certificate will issue. Trademark

Registration is a tedious process and it takes around 18-24 months to obtain registration in a straight-forward case, without any objections or oppositions. However, once the trademark application is filed, an application number is allotted immediately and the priority starts from the date of application.

Once the trademark is registered, it is valid for a period of 10 years from the date of application. The registration can then be renewed indefinitely as long as the renewal fees are paid every 10 years.

1. <https://www.wipo.int/classifications/nivilo/pdf/eng/nice/9engp2.pdf> [↑](#footnote-ref-0)
2. 1982 PTC 38 [↑](#footnote-ref-1)
3. 1981 AIR Del 150 [↑](#footnote-ref-2)