

# Insight of Trade Marks Registration Process

## What is a Trademark?

Trademark means any mark capable of being represented graphically and which is **capable of distinguishing the goods or services of one person from those of others** and it includes:

- Brand
- Label
- Device
- Name
- Signature
- Word
- Phrase
- Letter
- Ticket
- Numeral
- Shape of goods
- Packaging
- Combination of colors; or any combination thereof.

Trademark can also be of non-visible things such as sounds, scents, tastes, texture etc.

## Illustrations:-

### Word mark:

**COCA-COLA**

### Device/Label:



**Shape of goods/Packaging:**



**A Trademark may be designated by the following symbols:-**

- **™** – This mark can be used after application for trademark registration has been made till obtaining Certificate of Registration from the Registrar of Trademarks.
- **®** – This mark can be used only after the trademark is registered with the Registrar of Trademarks.

**What is Registered Trademark & What is Unregistered Trademark**

Registration of trademark is not compulsory.

<b><u>Registered</u></b>	<b><u>Unregistered</u></b>
Gets <b>Protection under the Trademark Act,1999</b> and shall have right to institute proceedings or to recover damages against infringement	No such protection available. But in some cases proprietor of unregistered trademark shall have common law remedy against offence of passing off
Gets a <b>Stable/perpetual</b> existence subject to renewal after every 10 years	No such benefit
It can be in relation to not only its existing use <b>but also for a proposed use</b>	It can be in relation to its existing use only

## **Primary Functions of Trademark**

- Helps in identifying the source of origin of goods.
- It guarantees its quality.
- It advertises the product.
- Creates an Image/Reputation in the minds of consumer

## **Essentials of trademark/Things to be kept in mind while selecting a trademark**

- Distinctiveness: - A trade mark would be considered good trade mark when it is distinctive. In the case of *Imperial Tobacco v. Registrar, Trade Marks*, the word distinctiveness was held to be some quality in the trade mark which earmarked the goods marked as distinct from those of other products or such goods
- Invented/coined word: - Trademark should preferably be an invented/coined word. In fact, the best trademarks are invented words E.g. KODAK, SAVONOL.
- Trademark should be short and easy to spell, pronounce and remember Eg: SONY, BATA.
- It should appeal to the eye and the ear.
- It should not be descriptive but may be suggestive of the quality of the goods. For Eg: AVON Cycles, where AVON suggests superior quality.
- It should not belong to the class of marks prohibited for registration. For Eg: marks prohibited under the Emblems and Names (Prevention of Improper Use Act, 1950)

## **Illustrations of Words found Invented**

- **GOLDCON** for Glucose Products; *Raj Wadhwa v. Glaxo India Ltd., (2005)*.
- **FLEXGRIP** used in relation to pens and other writing instruments; *The Gillette Company v. A.K. Stationary, 2001*.
- **KODAK** for camera; *Eastman v. John Griffiths, (1898)*.

- **TRAKGRIP** for rubber tyres (Vehicles); *Dunlop's Appln.*, (1942).
- **LEVASOL** in respect of Veterinary medicine; *Ranbaxy Laboratories v. Vest Farms (PIA) Ltd.*, (2005).

### **Illustrations of Non-Descriptive Words – REGISTRATION ALLOWED.**

- **RADIATION** for gas-stoves.
- **SOLAR** for photographic apparatus, studio light, etc.; *Central Camera v. Registrar*, (1980).
- **SAFI** for medical preparations (the word safi means pure, fine, clean, etc); *Registrar v. Hamdard* (1981).
- **THERMAWEAR** for underwear (a skillful allusion to character of goods); *Thermawear v. Vedonis*, 1982.
- **MOTORINE** for lubricating oils.

### **Illustrations of Words found descriptive – REGISTRATION REFUSED.**

- **BULLET** in respect of Motor-cycles; *Enfield India v. Deepak Engine syndicate*, (2006).
- **SAFO** for cleaning powder (too close to the word “SAF” meaning clear, pure, whitw, etc.) *Hindustan lever v. Kilts*, 1982.
- **ELECTRIX** for electric vacuum cleaners (a phonetic equivalent of descriptive word ‘Electric’) *Elextrix Appln.* (1959).
- **RASOI** for vegetable oil.
- **ROTOLOCK** for quick release fasteners (‘Roto’ meaning’ rotatory’ and ‘lok’ a misspelling of ‘lock’; a descriptive word); *Rotolock Tm*, 1968.

## **Grounds of refusal**

Registration of Trademark may be refused on absolute grounds (Sec 9) or relative grounds of refusal (Sec 11)

### **Absolute Grounds**

- Which is devoid of any distinctive character.
- Words which have become customary in the current language.
- Words which are descriptive in nature.

### **Relative Grounds of refusal**

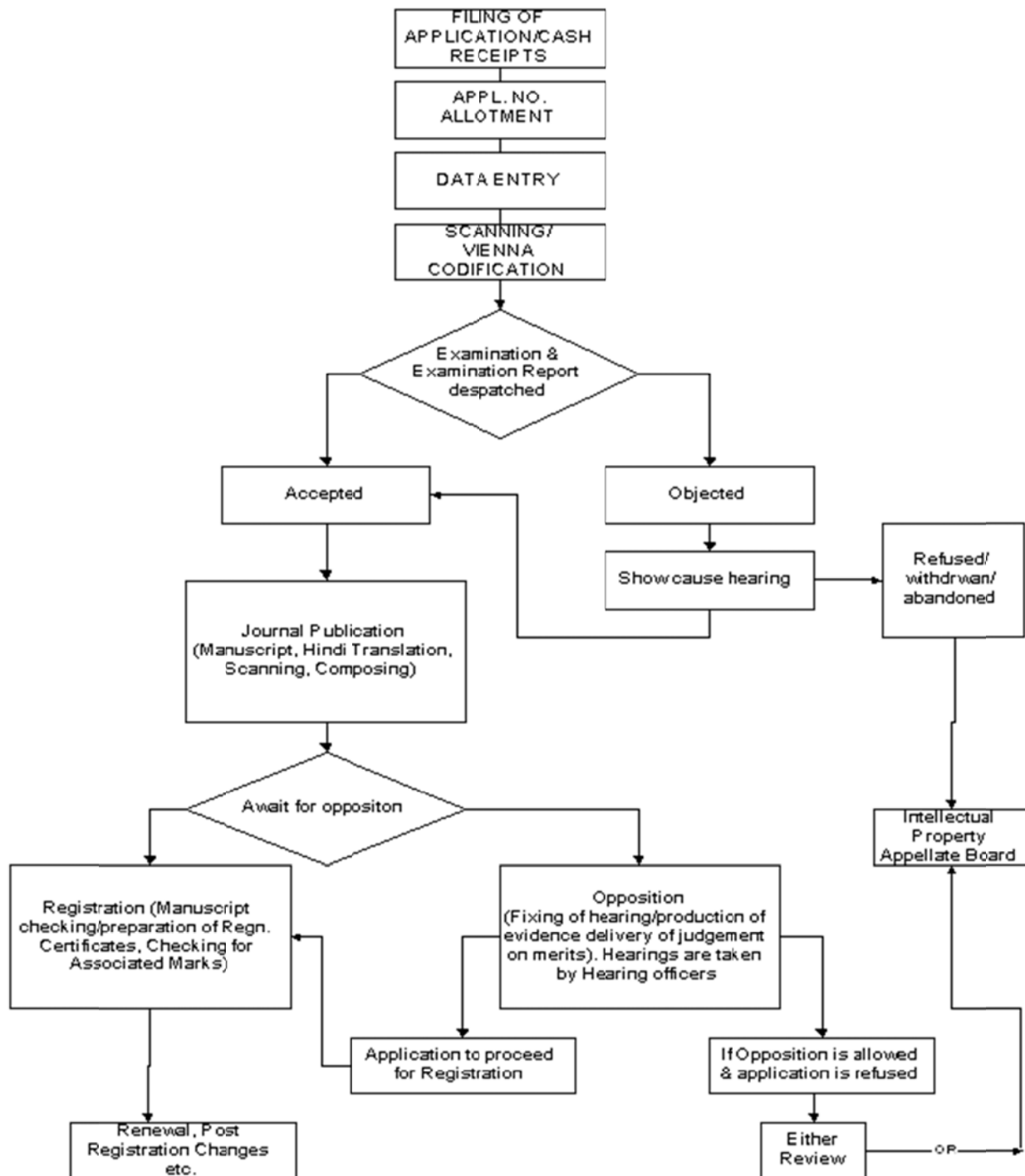
- A mark which is likely to deceive the public or cause confusion.
- A mark which is likely to hurt the religious sentiments.
- A mark which contains scandalous or obscene matter
- A mark which contains words prohibited under the Emblems and Names (prevention of Improper Use) Act 1950

## **Classification of Trademark**

Trademark in India is classified in about 45 different classes, which includes chemical substances used in industry, paints, Bleaching preparations, Industrial oils and greases, lubricants, Pharmaceutical, veterinary and sanitary preparations Common metals and their alloys, Scientific apparatus and instruments, machine and machine tools, medical and surgical instruments, Musical instruments, stationary, lather, household, furniture, textiles, games, beverages, preparatory material, building material, sanitary material, and hand tools, Tobacco, smokers' articles, Agricultural, horticultural and forestry products, Meat, fish, poultry, Advertising, business management, Insurance, financial affairs, Telecommunications, Education, providing of training, Legal services; security services, etc.

These classes again are further sub-divided as per NICE Classification. The main objective of trademark classification is to group together the similar nature of goods and services.

## Procedure for trade mark registration



## **Advantages of Trademark Registration**

- Protects your hard earned goodwill in the business
- Protects your Name / Brand Name from being used in a same or similar fashion, by any other business firm, thus discourages others from cashing on your well-built goodwill.
- Gives your products a status of Branded Goods.
- Gives an impression to your customers that the company is selling some standard Products or Services
- The exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered.
- To obtain relief in respect of infringement (misuse by others) of the trade mark.
- Power to assign (transfer) the trade mark to others for consideration.
- And many more

## **Who may apply for Registration?**

Any person claiming to be the proprietor of the trademark used or proposed to be used by him can apply. The application may be made in the name of an individual, partners of a firm, a Corporation, any Government Department, a Trust or joint applicants.

## **How to get Complete Protection of Trade Mark?**

- Through Registration as of Trademark as Word mark.

# COCA-COLA

- Through Registration as of Trademark as Device/label.



- Get copy right of Label/Device.



## **Information/Documents required for filing trade Mark application**

- Word mark/Device/LOGO/Label/Shape of Goods etc. which is to be registered.
- Full Name & address of the person in whose name the Trademark is to be registered.
- Description of product/goods/service in relation to which the trademark is to be registered. (For determining the class to which the goods belong)
- Evidence for the usage, if any.

## **Important Cases in Trademark law**

### **❖ *Raj Wadhwa v. Glaxo India Ltd., (2005) 31 PTC 201***

The opponent/ defendant were registered proprietors of trade mark "GLUCON-D". The application sought for registration of trade mark "GOLDCON" by the applicant.

It was held that though no visual resemblance was between the two marks, **close affinity of sound between the two words exists**. It was held that the application for registration was rightly rejected by Assistant Registrar.

### **❖ *Shalimar Chemicals Works Ltd. V. Surender Oil and Dal Mills (Refineries),(2004)119 Comp Cas 535***

The Appellant –Company marketed coconut oil under registered trade mark "Shalimar". The respondent marketed sun-flower edible oil under the same name. The appellant filed a suit through its director.

It was held that once a trade mark is registered, the person gets a statutory protection and he would have the right of restraining others from using the trade mark either identical or deceptively similar visually or phonetically.



❖ ***Glaxo Group Ltd. V. Voltas Ltd., (2006) 32 PTC 562***

The application was made for registration of trade mark “Volmax”. The opposition was made by owner of trade mark “Voltas”, “Volfruit” and “Volfarm” which was used for a range of goods from air-conditioners to truck, transformers, pharmaceuticals and consumer products. It was found that both marks had not much difference when viewed from the perception of common man and there was likelihood of confusion in the mind of consumer. The order of Registrar rejecting the application was affirmed.

❖ ***Bharat Enterprises (India) vs C. Lall Gopi Industrial Enterprises AIR 1999 P&H 231***

In this case the plaintiffs were using the word ‘Gopi’ while the defendants were using the word ‘Belco’ before the word ‘Heat Pillar’.

The Court held that the word ‘Heat Pillar’ was a generic word. No manufacturer can have exclusive right to use of this word. The court further held that between the words ‘Gopi’ and ‘Belco’ there was a clear phonetic distinction. There was thus no case for passing off established. The Court refused to grant temporary injunction restraining the defendant from using its trademark.

❖ ***Amul Trade mark infringement case***

The Kaira District Co-operative Milk Producers Union Ltd. (Amul) and GCMMF had filed trade mark infringement cases, against two local shop owners Amul Chasmaghar and its partners and Amul Cut Piece Stores in Anand.

In this case Gujarat High court held that Amul’s name cannot be used by any other proprietor even if the company is selling goods other than that sold by the proprietor, who has registered the trademark.

## **TRADEMARK CLIENT DISCLOSURE STATEMENT**

- The expected time for Registration of Trademark is 3 Years from the Application date.
- However the Registration will take effect from the filing of Trademark Application.
- While processing the application, any third party can oppose the application and we have to sort out the matter at the Registry level by following prescribed procedures.

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