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TM

Trade Marks 2021

A practical cross-border insight into trade mark work

10th Edition

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Manisha Singh



Omesh Puri

India

1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The Controller General of Patents, Designs & Trade Marks (“CGPDTM”) is the head of Trade Marks Registry in India.

1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act, 1999 (“Act”) read with the Trade Marks Rules 2003 is the relevant trade mark legislation.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

A mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. A device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof and sound mark can be registered as a trade mark.

2.2 What cannot be registered as a trade mark?

The following types of marks cannot be registered:

- A mark that does not have a distinctive character.
- A mark that describes the goods or services and gives the consumer an idea about the quality, quantity or geographic origin of the particular goods or services. Descriptive trade marks cannot be registered.
- A mark that has become customary in the current language.
- A mark that causes confusion and deception.
- A mark that is likely to hurt religious sentiments.
- A mark that contains obscene and scandalous matter.
- A mark that is prohibited from use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
- A mark that contains exclusively the shape of goods resulting from the nature of the goods themselves or necessary to obtain a technical result or gives substantial value of the goods.
- A mark which is identical/similar to a well-known mark.
- A mark that is prevented by copyright law.

- If a law of passing off is protecting an unregistered trade mark, such marks cannot be used by other persons as trade marks.

2.3 What information is needed to register a trade mark?

The following information is required to file a trade mark application:

- Exact representation of the mark.
- Name and address of the applicant.
- Legal status of the applicant.
- Relevant Nice classification along with description of goods/services for which mark is to be registered.
- Priority details, if claiming priority; the certified copy of priority documentation along with its certified English translation.
- The exact date of the first use of the mark in India in date/month/year format. If the mark is in use in India, the affidavit of use needs to be filed along with the supporting evidence. If the mark is not in use, the application will be filed on a proposed-to-be-used basis.
- If the mark contains non-English and non-Hindi characters, a translation or transliteration respectively in English.
- A Power of Attorney, if the application is being filed by an attorney/agent.

2.4 What is the general procedure for trade mark registration?

An application for registration of a trade mark can be filed online and offline with the Trade Marks Registry by the applicant or its authorised attorney. Upon an application being filed with the Trade Marks Registry, it is checked to see if all procedural formalities have been complied with. Once it passes through the formality check phase, it goes through substantial examination on absolute and relative grounds of refusal. In the event objections are raised, a response must be filed within one month of receipt of the Examination Report. However, if even after reviewing the response, the Examiner continues to maintain the objections, a hearing is scheduled to hear oral arguments in support of the application. If the Examiner is satisfied with the response, the mark is advertised in the Trade Marks Journal and the mark is open to third-party oppositions for a period of four months. If no opposition is filed by any third party within four months from the date of publication, the mark proceeds towards registration.

2.5 How is a trade mark adequately represented?

A trade mark is said to be adequately represented if it is represented graphically with a high-resolution digital version. If a mark is in different language or script than English or Hindi, a translation or transliteration in English or Hindi should also be included in the representation.

2.6 How are goods and services described?

Goods and services are described on the basis of the Nice classification.

2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

An unusual/non-traditional trade mark in the form of a colour mark, motion or animated mark, sound mark and shape mark can be filed in India as below:

- Colour as a trade mark can be applied for registration by submitting a reproduction of the mark in that colour or combination of colours with colour codes.
- Where a mark contains a shape of the goods or its packaging or is a three dimensional mark, the reproduction of the mark shall contain different views of the trade mark and a description as to the nature of the mark in words. If the representation of the trade mark provided by the applicant does not show clearly all the features of the trade mark, the Registrar may require up to five further views of the trade mark.
- In case of a sound mark, the sound recording of the mark must be submitted in an MP3 format, not exceeding 30 seconds in length, and recorded on a medium allowing easy and clear audible replay with graphical representation of its notation.
- In the case of a motion mark, appropriate representation of the mark clearly showing the motions need to be filed.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No; however, if the trade mark application is filed claiming date of first use, documents showing use of the trade mark under cover of an affidavit are required to be submitted at the time of the filing of the application. If the application is filed on an intent-to-be-used basis, no documentary proof is required at the time of filing of the application. No proof of use is required for renewal purpose.

2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Protection of a trade mark is granted within the territory of India only.

2.10 Who can own a trade mark in your jurisdiction?

A trade mark can be owned by:

- an individual;

- a body corporate;
- a partnership firm;
- a proprietary firm through the proprietor;
- a start-up;
- a government department;
- a statutory organisation/public sector undertaking;
- a trust or Society;
- a Hindu Undivided family; or
- an association of persons or entities.

2.11 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctiveness through continuous extensive use.

2.12 How long on average does registration take?

Registration of a trade mark may take around six to eight months in the case of a smooth registration process provided there are no objections from the Trade Marks Registry and no third-party oppositions.

2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The cost for obtaining trade mark registration of a mark in a class in India in a straightforward case (no office action or oppositions, etc.) would be around USD 550. This cost may vary depending upon the number of classes, official objection from the Trade Marks Registry and third-party opposition.

2.14 Is there more than one route to obtaining a registration in your jurisdiction?

A trade mark registration in India can be acquired through the following two ways:

- by filing a national application with the Trade Marks Registry; or
- by designating India in an international application filed through the Madrid Protocol.

2.15 Is a Power of Attorney needed?

Yes, it is mandatory to submit a Power of Attorney if the application is being filed by an attorney or agent.

2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No notarisation or legalisation is required.

2.17 How is priority claimed?

In order to claim priority in India, the applicant must file an application in India within six months from the date of convention application. Priority application must contain the following details:

- Priority details, including particulars of the mark, serial number, date of convention application, name of convention country.

- A certified copy of the priority application is required to be submitted.
- A statement that priority is claimed.

2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, India recognises Collective and Certification trade marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

A mark which qualifies under one or more of the following absolute grounds is not registrable:

- a mark that is incapable of distinguishing the goods/services of the applicant from those of others;
- a mark that may serve in trade to designate kind, quality, purpose, value, geographical origin;
- a mark that has been commonly used in the current language or established practices of trade;
- a mark that causes confusion or deception among the public;
- a mark that hurts religious sentiments of class/a section of citizens in India; a mark that comprises/contains scandalous/obscene matter which is against the morality of the public;
- a mark that is prohibited under the Emblems and Names Act, 1950; or
- a mark that contains exclusively the shape of the goods resulting from the nature of the goods themselves or necessary to obtain a technical result or gives substantial value of the goods.

3.2 What are the ways to overcome an absolute grounds objection?

An objection based on absolute grounds of refusal can be overcome by establishing continuous and extensive use of the mark which has resulted in the distinctiveness of the mark or by arguing against the objection and convincing the Examiner that the mark is inherently distinctive and absolute ground objections will not be applicable depending upon the facts.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant aggrieved with the decision of the Registrar may file an appeal with the Appellate body, Intellectual Property Appellate Board within three months from the date of receipt of the Registrar's decision.

3.4 What is the route of appeal?

As stated above, an applicant aggrieved with the decision of the Registrar may file an appeal with the Intellectual Property Appellate Board.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The following marks can be refused following relative grounds of refusal:

- a mark which is identical/similar to an earlier trade mark and there is identity or similarity of the goods or services covered by the trade mark which is likely to cause confusion among the public;
- a mark which is prevented by the law of passing off or the law of copyright; or
- a mark which is identical/similar to a well-known mark.

4.2 Are there ways to overcome a relative grounds objection?

An objection based on relative grounds of refusal can be overcome based on the following grounds:

- on the basis of dissimilarity of marks;
- on the basis of dissimilarity of goods;
- prior honest adoption and use of the mark;
- different trading and marketing channels and different set of consumers;
- comparison of the marks as a whole;
- the mark has prior associated registration;
- the mark has a goodwill reputation in India or has a trans-border reputation in India or is a well-known mark; or
- honest concurrent use.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant aggrieved with the decision of the Registrar may file an appeal with the Appellate body, Intellectual Property Appellate Board within three months from the date of receipt of the Registrar's decision.

4.4 What is the route of appeal?

As stated above, an applicant aggrieved with the decision of the Registrar may file an appeal with the Intellectual Property Appellate Board.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed on absolute as well as relative grounds of refusal.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person can file an opposition against a conflicting mark.

5.3 What is the procedure for opposition?

1. **Pleadings stage** – the pleading stage commences with the filing of a Notice of Opposition which is a statement of grounds of opposition on the basis of which a conflicting mark is opposed. The Notice of Opposition has to be filed within a period of four months from the date of advertisement of the mark in the Trade Marks Journal. This period of four months is non-extendable. Pursuant to the service of Notice of Opposition by the Trade Marks Registry, the Applicant (Proprietor) of the mark is provided with a time frame of two months (non-extendable) to file its Counter Statement. In case the Applicant fails to file a counter statement, the application shall be deemed to have been abandoned.
2. **Evidence stage** – upon receipt of the counter statement, the Opponent has to file Evidence in support of opposition by way of an affidavit within two months from the date of official service of the counter statement by the Registry. Alternatively, the Opponent may intimate to the Registrar that they do not wish to adduce any evidence and file a letter relying on the contents of Notice of Opposition. Subsequently, upon receipt of the evidence filed by the Opponent, the Applicant is provided a period of two months to file their evidence in support of the application. The Applicant also has the provision to file a reliance letter and simply rely on the statements made in its counter-statement.
In case the Opponent or Applicant fail to file the evidence by way of affidavit or reliance letter, the opposition or application is deemed to have been abandoned.
After receipt of evidence in support of the application, the Opponent may file evidence in reply within one month from the date of receipt.
3. **Hearing stage** – after the evidence stage is completed, the Registrar appoints a hearing on merits and passes orders allowing or dismissing the opposition.

6 Registration

6.1 What happens when a trade mark is granted registration?

Once a trade mark is granted registration, the Trade Marks Registry issues an electronic registration certificate to the Applicant/its agent. Registration of a trade mark confers statutory rights to the Applicant and entitles them to take infringement action against any infringer.

6.2 From which date following application do an applicant's trade mark rights commence?

The trade mark rights originate from the date of filing of the application. In case of priority applications, the rights originate from the date of filing of the application in the convention country. However, as India follows the first-to-use principle, in case the Applicant can claim rights from an earlier date, i.e., prior to the filing of the trade mark, if such user rights can be successfully established through material evidence; such rights fall under the domain of the remedy of “passing off”.

6.3 What is the term of a trade mark?

The validity of a trade mark lasts for 10 years from the date of application. The trade mark laws accord the Applicant the provision to renew the trade mark for a period of 10 years from the date of expiration of the registration or last renewal, as the case may be.

6.4 How is a trade mark renewed?

The procedure to renew a trade mark involves the filing of the relevant application TM-R which is accompanied by a fee of INR 9,000 (approximately USD 124). The grace period of one year is available.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Yes, an individual can register the assignment of a trade mark.

7.2 Are there different types of assignment?

Both registered and unregistered trade marks can be assigned. One categorisation of assignment is that of a complete and partial assignment. Apart from this, an assignment may also be made with or without goodwill.

7.3 Can an individual register the licensing of a trade mark?

Yes, an individual can register the licensing of a trade mark.

7.4 Are there different types of licence?

Yes. A licence may be exclusive or non-exclusive.

7.5 Can a trade mark licensee sue for infringement?

Yes, a licensee who has been recorded as a “registered user” under Section 49 of the Trade Marks Act can sue for infringement. However, a mere “permitted user” cannot sue for infringement.

7.6 Are quality control clauses necessary in a licence?

Yes, a quality control clause is necessary in a licence.

7.7 Can an individual register a security interest under a trade mark?

No, a security interest cannot be registered under the Trade Marks Act.

7.8 Are there different types of security interest?

Yes, security interest means right, title and interest of any kind whatsoever upon property created in favour of a secured creditor and includes mortgage, charge, hypothecation, assignment.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

A trade mark can be revoked on the following grounds:

- Upon contravention or failure to observe the conditions on the register.
- Upon absence or omission from the Register of any entry.
- If it was made without any sufficient cause.
- If it wrongly remains on the Register.
- If there has been no *bona fide* use of the mark for a continuous period of five years from the date on which the mark was entered into the Register.
- If the application for registration of the mark was made without any *bona fide* intention by the proprietor to use the same and there has been no use thereof in relation to goods or services covered under the registration.
- If the mark is found to be registered in violation of absolute grounds refusal and/or relative grounds refusal.

8.2 What is the procedure for revocation of a trade mark?

1. Proceedings before the Trade Marks Registry

The revocation proceedings begin with the filing of an application in Form TM-O which is accompanied by a statement of case wherein the Applicant (the “aggrieved person”) sets out the nature of applicant’s interest, facts, and relief sought. Thereafter, a copy of the petition is served on the Registered Proprietor by the Trade Marks Registry. Within a period of two months (extendable by one month) from the receipt of the Application, the Registered Proprietor has to file a counter statement to defend its registration. Pursuant to the filing of the counter statement, the Registry serves a copy of the same to the Applicant within a period of one month. In case the Registered proprietor fails to file a counter statement within three months, the Applicant for rectification shall proceed to file evidence in support of the Application under the provisions of Rule 45 (1). The further proceedings are similar to opposition proceedings and are the same as those mentioned in question 5.3 above and the provision under Rule 46 to 51 of the Trade Marks Rules, 2017 which pertain to opposition proceedings and are applicable on rectification proceedings as well.

2. Proceedings before the Intellectual Property Appellate Board

If the Applicant chooses to file the rectification petition before the Intellectual Property Appellate Board (“IPAB”), then the petition is accompanied by evidence, if any, in support of the proceedings. Within two months from the date of service of the Petition by the IPAB, the Registered Proprietor is required to file the counter statement and serve the same upon the Petitioner directly under intimation to IPAB. Upon receipt of the Counter Statement, the Petitioner may file a reply along with evidence in the form of an affidavit, which is served upon the Registered Proprietor under intimation to IPAB. Thereafter, IPAB appoints a hearing which is heard on the merits.

8.3 Who can commence revocation proceedings?

Any person claiming to be an aggrieved person i.e. a person who is in some way or the other substantially interested in having

the mark removed from the Register or any person whose rights will be substantially affected by the impugned registration may initiate revocation proceedings.

8.4 What grounds of defence can be raised to a revocation action?

A Registered Proprietor can defend the registration of its mark by establishing that the mark was registered with sufficient cause/has been continuously and extensively used/has concurrent use. Further, it may also be argued that the mark has not been used for certain periods and that there were genuine reasons for non-use of the mark which includes restrictions on the use of the trade mark in India imposed by any law or regulation.

8.5 What is the route of appeal from a decision of revocation?

1. If the Applicant is aggrieved by the decision of the Registrar of Trade Marks, then appeal lies before the IPAB.
2. An appeal against the order of IPAB can be made before the High Court by way of a writ petition. If the order of High Court is also adverse, then such person may approach the Supreme Court.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

Same as the answer to question 8.1.

9.2 What is the procedure for invalidation of a trade mark?

Same as the answer to question 8.2.

9.3 Who can commence invalidation proceedings?

Same as the answer to question 8.3.

9.4 What grounds of defence can be raised to an invalidation action?

Same as the answer to question 8.4.

9.5 What is the route of appeal from a decision of invalidity?

Same as the answer to question 8.5.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Civil suits for infringement of trade marks or passing off shall be filed before a District Court having the jurisdiction to try the suit. Additionally, High Courts having original jurisdiction such as the Bombay High Court, Madras High Court, Delhi High Court and

Calcutta High Court, can also entertain trade mark disputes. An action for trade mark infringement or passing off can be initiated by filing a plaint before the appropriate Court wherein reliefs are sought.

10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedure in a civil suit comprises several stages which are preceded by the filing of the suit (plaint) before the appropriate Court. This Court could be the State's District Court or High Court (based on original jurisdiction). The stages of civil suit until trial are explained and jotted down below:

- **Stage 1:** Admission of suit and hearing on *ex parte* injunction application. The filed suit is accompanied with an interim injunction application under Order 39 Rules 1 and 2 seeking *ex parte* interim relief. For the first hearing, the Court reviews the grounds of injunction pleaded in the suit and interim injunction application. If the Court decides that the Plaintiff has made a suitable case for the grant of an interim injunction and balance of convenience is in favour of the Plaintiff, it passes an *ex parte* injunction order and simultaneously issues Court summons to the Defendant for appearance in further hearings and to file its written statement within the stipulated timeline. In case the Court decides against passing an *ex parte* injunction order and it deems that it is necessary that the Defendant be present in the Court to defend its claims, the Court issues a Court summons to the Defendant for appearance in further hearings and to file its written statement within the stipulated timeline.
- **Stage 2:** Service of Court summons on the Defendants. The Plaintiffs and Court's Registry are mandated to serve copies of plaint, supporting exhibits alongside the Court's order upon the Defendant's postal and courier services as well as electronic communication in the form of emails, as compliance under Order 39 Rule 3.
- **Stage 3:** Appearance of the Defendant and filing of its written statement. The Defendant is allowed a period of a few weeks or months upon service of Court summons to file its written statement in its defense and enter appearance on the second Court hearing. The Defendant generally at this stage also files a response to the Plaintiff's interim injunction application under Order 39 Rules 1 and 2. In cases where an *ex parte* injunction order has been passed against the Defendant, the Defendant is at the liberty to file an application seeking vacation of interim injunction order under Order 39 Rule 4.
- **Stage 4:** Filing of reply, rejoinder and replication by parties involved. Both sides have equal opportunity to file responses to the applications filed by the other side. For example, the Plaintiff can file replication to the written statement filed by the Defendant and can file a response or reply to the Defendant's application seeking vacation of interim injunction order and can file rejoinder to its interim injunction application under Order 39 Rules 1 and 2.
- **Stage 5:** The Court decides the Plaintiff's application for grant of interim injunction based on contentions put forth by both sides.
- **Stage 6:** Admission/denial of documents filed by both sides.
- **Stage 7:** Framing of issues by the Court.
- **Stage 8:** The Plaintiff files its evidence under Affidavit and provides a list of witnesses. Thereafter, trial begins i.e.

exhibiting documents filed by the Plaintiff, and cross-examination of its witnesses by the Defendant. The next step involves the same procedure for the Defendant and a cross-examination of its witnesses.

Final arguments are followed by the Court's judgment.

It generally takes anywhere between two to four years and in some cases more than this for proceedings to reach trial from the commencement of a civil suit.

10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary as well as final or perpetual injunction are available.

The following conditions need to be satisfied in order to avail preliminary injunctive reliefs:

- The Plaintiff must make out *prima facie* case.
- The Plaintiff must establish that it will suffer irreparable injury if the relief is not granted.
- The Plaintiff must also establish that the balance of convenience is in its favour, who is likely to suffer substantial mischief if the injunction is refused when compared to the mischief which might be caused to the Defendant if the injunction is granted.

The Courts pass an order granting perpetual injunction after the trial or where the plaintiff is able to obtain a relief in summary judgment.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, the party can be asked to file relevant documents or the materials as the Court may direct to file such documents.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Yes, the submissions or evidence are presented in writing and also argued orally during the Court proceedings. The cross-examination of witnesses is a standard practice in civil suits in India.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, as per the laws in India, infringement proceedings can be stayed pending the resolution of validity before the Intellectual Property Appellate Board. Under Section 124 of the Trade Marks Act, 1999, the Court may put a stay on proceedings where the validity of registration of the trade mark is questioned. However, the provision also states that stay on the proceedings will not preclude the Court from making an interlocutory order during the period of stay.

10.7 After what period is a claim for trade mark infringement time-barred?

A civil suit for infringement of trade marks can be filed within three years from the date of cause of action.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities for trade mark infringement. Acts such as applying false trade marks and/or trade descriptions to goods and services, or possession of any instrument for falsifying or falsely applying a trade mark, are a cognisable offence (the police officer can arrest the infringer without a warrant) and is punishable with imprisonment between six months to three years and/or fine which may be between Rs. 50,000/(USD 700) and Rs. 200,000/(USD 2,800). However, the Police authorities need to seek an opinion from the Registrar of Trademark on the facts of the case before they can initiate any action against the infringer or counterfeiter.

10.9 If so, who can pursue a criminal prosecution?

The complaint against the infringer can be filed by the holder of the trade mark registration or its authorised person.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are provisions in the Act for unauthorised threats of trade mark infringement. The provision states that if an individual makes groundless threats of instituting legal proceedings, then the aggrieved person can institute a suit. In the suit, the aggrieved person may seek a declaration to the effect that the threats are unjustifiable, and trigger an injunction against such threats, or even damages.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The alleged infringer of trade marks can take the following grounds of defence in a trade mark infringement suit:

- The Defendant is a prior user.
- The Defendant is an honest and concurrent user of its mark.
- The parties to the suit are involved in different lines of business or the services provided by them are completely dissimilar. No confusion or deception could be caused in the minds of the target consumers or members of the trade.
- The marks are different.
- The Plaintiff's trade mark is generic and descriptive in nature and therefore use of such mark by the Defendant is not an infringement.
- The Defendant's use of the trade mark is in accordance with honest practices in industrial or commercial matters, and is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the registered trade mark.

11.2 What grounds of defence can be raised in addition to non-infringement?

The Defendant can take the defence of acquiescence which can be allowed if the defendant proves that there was prior knowledge and negligence on the part of the plaintiff and that the

plaintiff failed to act for a substantial period of time. However, the defendant also has to prove that the mark was adopted in good faith and was not a fraudulent and dishonest adoption. Further, the Defendant could also challenge the validity of the Plaintiff's mark.

12 Relief

12.1 What remedies are available for trade mark infringement?

In civil proceedings, the third parties can be enjoined from using the infringing mark and the cost or damages can be awarded. In criminal proceedings, the infringers can be imprisoned and a fine can also be imposed. The remedies provided against the infringement of a trade mark can be categorised as under:

- **Civil remedies** – the registered proprietor can seek injunctions, damages, rendition of accounts, delivery and destruction of infringing products.
- **Criminal remedies** – it includes imprisonment, fines, seizure of infringing copies and delivery of infringing products to the owner.
- **Border Enforcement** – it provides for prohibition of import of infringing material.

12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The cost of litigation is recoverable from the defendants and the Commercial Courts Act specifically provides the mechanisms for payments of costs. However, recovery of costs depends upon several factors such as merits of the case, quantum of loss, and evidence submitted before the Court, etc.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In the case where the first instance judgment is passed by the District Court, an appeal may be instituted in the High Court. Further, in cases where the first instance judgment is passed by a Single Judge of the High Court, the appeal may be brought before the Division Bench. Appeals to the Supreme Court of India are allowed only on a question of point of law.

13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be adduced in the following situations:

- a. if the Court or tribunal from whose order the appeal is preferred has refused to admit evidence which it ought to have admitted;
- b. if the party seeking to adduce the evidence establishes that such evidence was not within its knowledge or could not be obtained despite due diligence and efforts; or
- c. if the appellate Court requires any document to be produced or any witness to be examined to enable it to pronounce the judgment.

14 Border Control Measures

14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The government of India has enabled IP owners to enforce their IP rights at Indian borders under the Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007. For this, it is mandatory to have a validly registered trade mark/IP right in place. The period of protection available under customs is five years from the recordation of rights with the customs authorities or upon expiry of the validity of registration of the mark/IP right, whichever is earlier. After the expiry of five years, the right holder is required to furnish a fresh notice. Under the rules, an IP Rights holder may give notice to the Customs Commissioner requesting the suspension of clearance of goods suspected to be infringing the product.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

No infringement action lies in respect of unregistered trade marks. However, the rights in the same are enforceable through common law rights.

15.2 To what extent does a company name offer protection from use by a third party?

If a company name is a registered trade mark, then the same is protected under the provisions of the Trade Marks Act, 1999. However, if it is not registered then the same may have common law rights provided it has acquired substantial goodwill and reputation amongst the public.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no separate rights that confer IP Protection for book titles or film titles. However, film titles can be registered with Industry bodies such as the Indian Motion Picture Producers' Associations ("IMPPA"), Association of Motion Pictures and Television Producers ("AMPTPP") and Film and Television Producers' Guild of India, Film Writers' Association and Western India Film Producers Association ("WIFPA") but the same may not offer protection against unauthorised use by others and therefore they need to be registered as a trade mark for both protection and enforcement purposes provided they meet the requisite qualification.

16 Domain Names

16.1 Who can own a domain name?

A domain name can be owned by any natural or legal person.

16.2 How is a domain name registered?

.in domain name can be registered with any of the Registrars

associated with INRegistry. The other GTLD and domain names can be registered with any of the recognised Registrars.

16.3 What protection does a domain name afford *per se*?

A domain name in trade marks is an integral part of the identity of a brand or a company. Domain name registration may not afford any protection in India but if a particular domain name/website has acquired substantial goodwill and reputation amongst the customers then such domain name can be protected under common law like unregistered trade marks.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The following domain names are available freely to all parties worldwide:

- .in.
- co.in.
- net.in.
- org.in.
- firm.in.
- gen.in (general).
- ind.in (individuals).

The following zones are reserved for use by qualified organisations in India:

- ac.in (Academic).
- res.in (Indian research institutes).
- edu.in (Indian colleges and universities).
- gov.in (Indian government).
- mil.in (Indian military).

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, the .IN Domain Name Dispute Resolution Policy governs the disputes in connection with .IN or. Bharat domain names. The body responsible for it is the .IN registry.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

- **IPAB functioning:** The IPAB has been functional and conducting regular hearings since the month of May 2020 and at present, all appeals, cancellations and revocations are required to be filed physically before Chennai Registry and Delhi branch office. For regular functioning of the IPAB, the Government of India, vide order dated July 21, 2020, has appointed five technical members to IPAB (two for trade marks, two for copyright and one for patents).
- **Courts functioning:** The Courts continued to hear urgent matters via video-conferencing during the lockdown period and after the lockdown also, the Courts continued to hear all types of matters through video conferencing.
- **No deadlines until further notice from the Supreme Court due to COVID-19:** On account of the Public Notice dated April 15, 2020, issued by the Office of CGPDTM, Mumbai Govt. of India (which includes the Trade Marks Registry), all deadlines to file any reply/document, etc. stand

extended till further orders of the Court. This is in reconciliation/compliance of the Order of the Supreme Court of India in *suo moto* Writ Petition No. 3 of 2020 extending all deadlines/limitation periods as prescribed under general and specific law (includes IP Law) from March 15, 2020 till further orders of the Court due to the existing COVID-19 situation. As such, there is no deadline for any matter falling under the ambit of the Trade Marks Act, 1999 and Trade Marks Rules, 2017.

- **Show cause hearings to commence through video-conferencing:** By way of Public Notice dated August 26, 2020, the CGPDTM has notified that in the wake of the COVID-19 situation in India and in view of the provisions under Trade Marks Rules, 2017, show-cause hearings for trade mark-related matter will be conducted through video conferencing.

17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- The Delhi High Court in *Sun Pharma Laboratories Limited v Bdr Pharmaceuticals International Pvt Ltd & Anr*, held that the mark Lulibet is deceptively similar to Labebet even though the marks were used on products designed to treat different ailments. The Courts have frequently held that when pharmaceutical products are concerned, confusion may result in harmful consequences to the health of consumers. Therefore, a stricter approach is required to be applied in pharmaceutical trade mark cases.
- IPAB in an appeal against the refusal of a well known trade mark application for the mark YONEX held that a mark can be considered as well known in India if it has attained recognition in the minds of a relevant section of the public rather than a substantial segment of the public. Accordingly, the impugned order was set aside.

- In another significant case of *M/s ITC Limited v Nestle India Limited*, the Madras High Court had to answer the question as to whether trade mark protection can be extended to words which are laudatory and common to trade as in the case of ITC Limited's famous brand "Magic Masala". The Court went on to state that: "ITC has used the expression 'Magic Masala' in a laudatory manner to praise the 'Masala' in the sachet. Laudatory epithet cannot be given monopoly or protection as has been held by Courts... Since it is a laudatory word, it can never be monopolised." The Court was of the opinion that: "both the words 'Magic' and its derivative 'Magical' are common to the trade."

17.3 Are there any significant developments expected in the next year?

With the complete digitisation of the Trade Marks process and procedure, a significant development as well as challenge that the Trade Marks Registry aims to overcome is that of removing and/or reducing the enormous backlogs of pending opposition proceedings. We expect that the Trade Marks Registry is likely to be able to provide a faster turn around time in all new proceedings as well as conclude pending opposition matters.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Recently, there have been a number of appeals which have been decided by the IPAB against the refusal orders passed by the Registrar of Trade Marks. The Trade Marks Registry in order to expedite the processing of trade mark applications have refused a number of applications which cannot be called reasoned and speaking orders. All such refusals are being challenged before the IPAB and appropriate reliefs are being provided to all the right holders by the IPAB.



Manisha Singh is a founder and the Managing Partner of the firm. She oversees and supervises all practice groups at the firm. Manisha is known and respected for her deep expertise in prosecution and enforcement of all forms of IP rights and for strategising and managing global patents, trade marks and designs portfolios of large global and domestic companies. Her keen interest in using and deploying latest technology tools and processes has immensely helped the firm to develop efficient IP service delivery models and to provide best-in-class services. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution. She regularly represents clients in a large number of intellectual property litigations. She has been involved in and successfully resolved various trade marks, copyright and design infringement and passing off cases in the shortest possible timeframe, and in the most cost-efficient manner, thinking outside of the box in applying strategies.

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