



# ASIA-PACIFIC TRADEMARK PROSECUTION REVIEW 2024

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# India: solutions for addressing grievances to enhance efficiency of trademark dispute resolution

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## In summary

This comprehensive study delves into the realm of trademark protection and enforcement in India, with the Trade Marks Act 1999 serving as the governing legislation for registration and enforcement. It explores the safeguarding of both registered and unregistered marks, the criteria for registration, enforcement mechanisms and recent developments. The analysis delves into passing off for unregistered marks, the registration process, non-traditional trademark registration, trade dress protection, opposition proceedings, changes in ownership, cancellation and rectification, enforcement remedies and recent initiatives.

## Discussion points

- Trademark protection in India
- Criteria for trademark registration
- Non-traditional trademark registration
- Trade dress protection
- Trademark ownership changes and transfers
- Trademark cancellation or rectification

## Referenced in this article

- Trade Marks Act 1999
- Trade Marks Rule 2017
- Emblems and Names (Prevention of Improper Use) Act 1950
- Intellectual Property Rights (Imported Goods) Enforcement Rules 2007



India's intellectual property regime is governed by the Trade Marks Act 1999 and the Trade Marks Rule 2017, which provide a comprehensive mechanism for the registration and enforcement of trademark rights in India. The Indian trademark regime extends protection to both registered and unregistered marks. In the case of misuse of a registered mark, the right holder can initiate an infringement action against the infringing party. On the other hand, for unregistered marks, the right holder can seek protection under the law of passing off. To establish a claim for passing off, the plaintiff must: demonstrate established goodwill or reputation of their mark attached to relevant goods or services; prove misrepresentation by the defendant likely to deceive the public; and show damage suffered or likely to be suffered by the plaintiff.

## **Criteria for trademark registration**

In India, a mark capable of being represented graphically and distinguishing the goods or services of one entity from others can be registered as a trademark. This includes various forms such as devices, brands, headings, labels, tickets, names, signatures, words, letters, numerals, shapes of goods, packaging, a combination of colours and even sound marks.

However, certain types of marks cannot be registered in India. The following categories of marks are ineligible for registration:

- marks that lack distinctive character;
- descriptive marks that provide information about the goods or services, such as their quality, quantity or geographic origin, and cannot be registered;
- marks that have become customary in the current language;
- marks that cause confusion and deception;
- marks that are likely to hurt religious sentiments;
- marks that contain obscene or scandalous matter;
- marks that are prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950;
- marks that exclusively consist of the shape of goods resulting from the nature of the goods themselves or those necessary to obtain a technical result or give substantial value to the goods;
- marks identical or similar to well-known marks;
- marks that are prevented by copyright law; and
- marks that are protected by the law of passing off as unregistered trademarks, which cannot be used or registered by other parties as trademarks.



## Trademark registration process

The application for trademark registration can be filed either online or offline with the Trade Marks Registry. After fulfilling the required procedural formalities, the application undergoes extensive examination on different absolute and relative grounds for refusal. If any objections arise, the applicant gets one month to respond after receiving the examination report. If the objections persist, a hearing is scheduled to present the oral arguments of both parties. If the examiner is satisfied with the response, the mark is advertised in the Trade Marks Journal, and four months is allowed for third-party opposition. If the application is refused after the hearing, an appeal can be filed with the concerned high court within three months. If no opposition is filed during this period, the mark proceeds towards registration.

## Non-traditional trademark registration

India also allows the registration of non-traditional trademarks, such as colour marks, motion or animated marks, sound marks and shape marks.

- Registration of a combination of colours as a trademark can be applied for by submitting a reproduction of the mark in 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 must contain different views of the trademark and a description of the nature of the mark in words. If the representation of the trademark provided by the applicant does not show clearly all the features of the trademark, the registrar may require up to five further views of the trademark.
- For a sound mark, a sound recording must be submitted in MP3 format, not exceeding 30 seconds in length and recorded in a medium that allows easy and clear audible replay with a graphical representation of its notation.
- For a motion mark, an appropriate representation of the mark clearly showing the motions must be filed.

## Trade dress protection

The current market scenario poses numerous challenges for businesses, where the overall packaging of a product significantly influences a consumer's purchasing decisions. Elements such as packaging design, colour combinations and product shape, texture, graphics and illustrations are collectively known as trade dress. These elements are safeguarded to mitigate misuse by other parties seeking to imitate the product's overall appearance to capitalise on its established goodwill and reputation. Indian trademark law specifically has a provision for trade dress protection including the shape of goods, packaging



and colour combinations. To qualify for protection, the overall appearance of the product must be distinctive, either inherently or through acquired distinctiveness.

Rights holders often face the challenge of selecting the most appropriate IP legislation for safeguarding a particular shape. Generally, if the shape of a product is novel, original and undisclosed to the public, it should be protected through design registration. However, where the right holder has not registered the shape under design law, it may still be protected under trademark law or the common law tort of passing off if it has acquired distinctiveness through prolonged and continuous use. To successfully claim passing off, the right holder must demonstrate that the specific shape has become distinctive of their goods or services, is exclusively associated with them and that its use by others would confuse the public.

## Trademark opposition proceedings

Opposition against a trademark application can be filed on both absolute and relative grounds for refusal. Any individual can file an opposition against a conflicting mark, and these opposition proceedings involve three stages: the pleading stage, the evidence stage and the hearing stage.

- Pleading stage: the pleading stage commences with the filing of a notice of opposition, which outlines the grounds on which the opposition is filed against the conflicting mark. The notice of opposition must be submitted within four months of the date of the mark's advertisement in the Trade Marks Journal. This period is non-extendable. Upon receiving the notice of opposition, the applicant (proprietor) of the mark has two months (non-extendable) to file a counterstatement. Failure to submit a counterstatement results in the application being deemed abandoned.
- Evidence stage: once the counterstatement is received, the opponent must present evidence supporting their opposition by way of an affidavit within two months of the date of official service of the counterstatement by the Registry. Alternatively, the opponent can inform the registrar that they do not wish to provide any evidence and submit a letter relying on the contents of the notice of opposition. Subsequently, upon receiving the opponent's evidence, the applicant is given two months to present their evidence in support of the application. The applicant also has the option to submit a reliance letter, simply relying on the statements made in their counterstatement. Failure by either the opponent or the applicant to file evidence in the form of an affidavit or reliance letter results in the opposition or application being deemed abandoned. Once evidence is received in support of the application, the opponent has one month to file evidence in reply.
- Hearing stage: after the completion of the evidence stage, the registrar schedules a hearing on the merits of the case and renders orders either allowing or dismissing the opposition.



## Trademark ownership changes and transfers

Assignment and licensing are allowed for both registered and unregistered marks in India. However, the recordal of a licence can only be done for registered marks. In the application for recording a licence, the parties must file within six months of the date of signing the agreement. Additionally, the records for the name and address must be updated with the Trade Marks Registry. Trademarks are valid for 10 years from the application date and must be renewed every 10 years thereafter.

## Trademark cancellation or rectification

Cancellation or revocation of trademark proceedings can be initiated through two avenues: before the Trade Marks Registry or a concerned high court.

### Proceedings before the Trade Marks Registry

The cancellation proceedings commence with the filing of Form TM-O, along with a statement of the case submitted by the applicant, who is referred to as the “aggrieved person”. In this statement, the nature of the applicant’s interest, facts and relief sought are outlined. Subsequently, a copy of the petition is served to the registered proprietor by the Trade Marks Registry.

Once the application is received, the registered proprietor must file a counterstatement within two months to defend their trademark registration. However, this period may further be extended by one month if required. Following the filing of the counterstatement, the Registry serves a copy of the same to the applicant within one month.

If the registered proprietor fails to submit a counterstatement within three months, the applicant for rectification may proceed to file evidence in support of the application, as stipulated. The subsequent proceedings mirror those of opposition proceedings, as mentioned above.

### Proceedings before the concerned high court

Alternatively, revocation petitions can be filed before five high courts in India, based on the jurisdiction of the registered trademark. The five high courts are in Ahmedabad, Chennai, Delhi, Kolkata and Mumbai.



To commence revocation proceedings, any person who claims to be aggrieved (ie, any person substantially interested in getting the mark removed from the Register or any individual whose rights may be significantly affected by the impugned registration) may initiate action.

## Enforcement of trademark rights

There are various remedies available to the aggrieved parties for trademark infringement, which include civil, criminal and border enforcement measures.

- Civil remedies: in civil proceedings, third parties using the infringing mark can be injunctioned, meaning they can be restrained from further use of the mark. Additionally, the court can award damages to compensate the trademark owner for the losses incurred owing to the infringement. The court may also order the rendition of accounts, delivery and destruction of infringing products to prevent further misuse of the trademark.
- Criminal remedies: in criminal proceedings, offenders found guilty of trademark infringement can face imprisonment and be subjected to fines. The court can seize the infringing copies and deliver them to the rightful owner.
- Border enforcement: border enforcement measures involve the prohibition of the import of infringing material, aiming to prevent counterfeit goods from entering the country. The government of India has empowered IP owners to protect their intellectual property rights at Indian borders through the Intellectual Property Rights (Imported Goods) Enforcement Rules 2007. To utilise this protection, it is essential to have a validly registered trademark or IP right. The period of protection granted by Customs is five years from the date of recordation of rights with the Customs authorities or upon the expiration of the trademark or IP right registration validity, whichever comes earlier. After this initial five-year period, the right holder needs to submit a fresh notice to continue the protection.
- Preliminary injunction and permanent injunction: in trademark infringement cases, the plaintiff can seek a preliminary injunction before the trial. To obtain a preliminary injunction, the plaintiff must establish a *prima facie* case, demonstrate the likelihood of irreparable injury if the relief is not granted, and show that the balance of convenience favours granting the injunction. If these conditions are met, the court may grant a preliminary injunction to protect the plaintiff's rights until a final decision is made. After the trial or if the plaintiff obtains relief through summary judgment, the court may pass an order granting a permanent injunction. This injunction permanently restrains the defendant from using the infringing mark.
- Appeals and Supreme Court jurisdiction: if a judgment is passed by a district court, an appeal can be filed in the relevant high court. If the 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 questions of points of law.



- Anti-Counterfeiting measures: anti-counterfeiting is a critical aspect of trademark enforcement. The Indian Penal Code (IPC) defines 'counterfeiting' as an act intending to deceive by causing one thing to resemble another. Counterfeiting is considered an act of cheating under Section 420 of the IPC, punishable with imprisonment of up to seven years and a fine. Sections 102, 103 and 104 of the Trade Marks Act define offences, penalties and procedures related to falsification and falsely applying for trademarks. Offenders can face imprisonment ranging from six months to three years, along with a fine. Offences defined under the Trade Marks Act are cognisable, allowing police officers of designated ranks to arrest offenders without a warrant and initiate investigations. Before taking any action under the Trade Marks Act, police officers must seek an opinion from the registrar of trademarks on the facts of the case. This helps ensure proper enforcement of trademark rights and deter counterfeit activities.

## Recent developments

Recent developments in the field of intellectual property in India have focused on improving electronic systems for easy stakeholder access and providing transparent mechanisms for grievance redressal. Initiatives have been undertaken to expedite case disposal and reduce backlogs.

- Open house for discussion of grievances: at the National Intellectual Property Conference 2022, the Union Minister of Commerce and Industry proposed the establishment of an open house communication system to address concerns and grievances within the IP fraternity. The IP Office promptly implemented this suggestion and began conducting open house sessions on 17 October 2022. These sessions allow direct communication and discussions regarding various IP-related matters. Open house discussions occur every week from Monday to Friday from 4.30pm to 5.30pm (IST) and have successfully addressed multiple challenges faced by stakeholders across different IP offices.
- IPO Grievance Portal: the IP Office has also launched the Grievance Portal, providing stakeholders with a platform to lodge complaints against officials for unnecessary demands or other issues faced during the processing of their applications. The portal aims to facilitate the quick resolution of grievances.
- Update on disposal of trademark opposition cases: to address the pending trademark opposition cases, the IP Office informed the Delhi High Court of plans to hire 250 contractual opposition hearing officers dedicated to reducing the backlog. According to a status report, the number of officials handling opposition matters has increased, resulting in a slight decrease in the pending cases. However, as of 31 December 2022, a total of 238,951 trademark opposition cases remained pending. The intended mass hiring aims to significantly reduce this backlog.



- Functioning of the Intellectual Property Division at the Delhi and Madras high courts: following the abolition of the Intellectual Property Appellate Board (IPAB), the commercial divisions of the high courts at Delhi, Mumbai, Chennai, Gujarat and Kolkata have taken over pending appeal matters and revocation and rectification actions. The Delhi High Court established the Intellectual Property Division (IPD) to handle IP matters, resulting in faster case disposal, especially in appeals from refusal orders issued by the Registrar of Trade Marks. The IPD started functioning on 28 February 2022 and currently has separate benches presided over by Hon'ble Mr Justice C Hari Shankar and Hon'ble Ms Justice Pratibha Singh. The Madras High Court has also created an IP Division, and the Madras High Court Intellectual Property Rights Division Rules 2022 govern its proceedings.

These developments aim to enhance the efficiency and effectiveness of IP dispute resolution, offering stakeholders timely and fair adjudication of their rights.

## Conclusion

The Trade Marks Act plays a pivotal role in shaping India's trademark registration and enforcement framework. With a focus on both registered and unregistered marks, the Act provides a robust system to protect the rights of trademark owners. Additionally, the creation of the Intellectual Property Division in the High Court of Delhi and Madras and the hiring of more hearing officers are significant steps toward improving the efficiency of trademark hearings and enforcement in India. As India continues to evolve as a major player in the global market, trademark protection remains essential for businesses to safeguard their brands and intellectual property.



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Manisha Singh is the founder and managing partner of LexOrbis. She oversees and supervises all practice groups at the firm. Manisha is known and respected for her deep expertise in the prosecution and enforcement of all forms of IP rights and for strategising and managing the global patents, trademarks and designs portfolios of large multinationals and domestic companies. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution. She has represented companies in many IP litigations with a focus on patent litigation covering all technical fields, particularly pharmaceuticals, telecommunications and mechanics.



Ms Singh has served as the leading counsel for a client base in over 138 countries in their IP management and litigation matters. She has assisted numerous technology giants, Fortune 500 companies, globally renowned universities and public sector research institutions in the APAC region, the United States, Europe, the United Kingdom, Oceania, Latin America and MENA.

Ms Singh is also the standing counsel for the Reserve Bank of India at the Delhi High Court and is known for her deep understanding of corporate, banking and financial services laws. Manisha is a prolific writer and has contributed chapters in Indian IP laws to many leading publications including Mondaq, IP Media Group, Vantage Asia, Managing IP, Asia IP and CTC Media to name a few.



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Omesh Puri is a partner at LexOrbis and heads the trademarks, copyright and designs practice. He has expertise in a wide array of assignments in prosecution, litigation and enforcement of IP rights and has significant experience in handling domain name disputes before NIXI and WIPO as well as advertising and privacy-related issues. He regularly advises on complex commercial and IP transactions. He is responsible for large IP portfolios from various industries including pharmaceuticals, foods and beverages, software, fashion and automobiles, to name a few. Responsiveness is his priority, and he always helps clients achieve the best possible solutions to their intellectual property concerns. Currently, he is a member of the legislation and regulation committee. Omesh is actively involved in IP awareness campaigns with several government organisations. He has authored several articles published in the India Business Law Journal, Asia IP, Trademark Lawyer Magazine, Managing Intellectual Property, Lexology and Mondaq, to name a few.



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LexOrbis is a premier full-service IP law firm with over 260 personnel including 150+ attorneys at its four Indian offices in New Delhi, Bengaluru, Mumbai, and Chennai. The firm provides client-oriented and cost-effective solutions for the protection, enforcement, transaction and commercialisation of all forms of intellectual property in India and globally. The firm has been consistently ranked amongst the Top 5 IP firms in India over the past decade and is well-known for managing global patent, designs and trademark portfolios of many technology companies and brand owners. The firm has dedicated teams to cater to the IP lifecycle including attorneys, engineers, scientists, and specialists to deal with patent, trademark and copyright filing, research, portfolio building and management, enforcement, protection, spotting, transacting, procurement, and consultation.

The trademark practice group at the firm has over 30 attorneys experienced in partnering with brand owners and advising on the entire IP lifecycle from selection to enforcement. The firm's patent practice group has over 100 patent attorneys with domain expertise in information and communication technologies (ICT), computer sciences and software including Artificial Intelligence/Machine Learning, Internet of Things (IoT), blockchain, big data, mechanical, electrical & electronics, chemical and pharmaceutical, biotechnology, energy management, etc.

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