



Trade Marks **2025**

14th Edition



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1 Relevant Authorities and Legislation

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

The Controller General of Patents, Designs and Trade Marks is the relevant authority of the Trade Marks Registry (“TMR”) 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, 2017, 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 can be registered as a trade mark. A device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof, as well as a sound mark, can also be registered as such.

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 or scandalous matter.
- A mark that is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
- A mark that exclusively contains the shape of goods resulting from the nature of the goods themselves or that is necessary to obtain a technical result or gives substantial value to the goods.
- A mark that is identical/similar to a well-known mark.

- A mark that is prevented by copyright law.
- If a law of passing off protects an unregistered trade mark, such marks cannot be used or registered 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 a description of goods/services for which the 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 must 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 or offline with the TMR by the applicant or its authorised attorney. Upon an application being filed with the TMR, it is checked to see whether all procedural formalities have been complied with. Once it passes through this phase, it goes through a substantial examination on absolute and relative grounds for refusal. In the event that objections are raised, a response must be filed within one month of receipt of the Examination Report. However, even if, after reviewing the response, the Examiner maintains 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 opposition 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 and is capable of distinguishing one's goods/services from another.

2.6 How are goods and services described?

Goods and services are described on the basis of the Nice Classification and divided into 45 classes.

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/exotic trade mark in the form of a colour mark, motion or animated mark, sound mark or 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 clearly show 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, a sound recording must be submitted in MP3 format, not exceeding 30 seconds in length, and recorded on a medium that allows easy and clear audible replay with a graphical representation of its notation.
- In the case of a motion mark, an appropriate representation of the mark clearly showing the motions must be filed.

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

No proof of use is required for renewal purposes; however, if the trade mark application is filed claiming use, documents showing the use of the trade mark under cover of an affidavit are required to be submitted at the time of filing.

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

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

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 and 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 TMR and no third-party opposition(s).

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 approximately USD 120. This cost may vary depending upon the number of classes, official objection from the TMR, and third-party opposition.

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

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

- by filing a national application with the TMR; 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 the convention application. Priority application must contain the following details:

- Priority details, including particulars of the mark, serial number, date of convention application, and 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 marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

A mark that 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 amongst the public;
- a mark that hurts the religious sentiments of class/a section of citizens in India, or a mark that contains scandalous/obscene matter that is against the morality of the public;
- a mark that is prohibited under the Emblems and Names Act, 1950; or
- a mark that exclusively contains the shape of the goods resulting from the nature of the goods themselves or that is necessary to obtain a technical result or gives substantial value to the goods.

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

An objection based on absolute grounds for refusal can be overcome by establishing continuous and extensive use of the mark that has resulted in the distinctiveness of the mark, showcasing special circumstances such as similar trading name of the applicant, prior international registrations or by arguing against the objection and convincing the Examiner that the mark is inherently distinctive.

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 concerned High Court within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.

3.4 What is the route of appeal?

An applicant aggrieved with the Registrar's decision may file an appeal with the concerned High Court within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The following marks can be refused on the following relative grounds for refusal:

- a mark that is identical/similar to an earlier trade mark, and there is the identity or similarity of the goods or services covered by the trade mark that is likely to cause confusion amongst the public;
- a mark that is prevented by the law of passing off or the law of copyright; or
- a mark that 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 for refusal can be overcome based on the following grounds:

- dissimilarity of marks;
- dissimilarity of goods/services;
- prior honest adoption and use of the mark;
- different trading and marketing channels along with a different set of consumers;
- prior associated registration of the mark;
- the mark has a goodwill or 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?

Please see the answer to question 3.3 above.

4.4 What is the route of appeal?

Please see the answer to question 3.4 above.

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 for 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. Pleading stage – the pleading stage commences with filing of a Notice of Opposition, which lays down a statement of grounds of opposition on the basis of which a conflicting mark is opposed. The Notice of Opposition must be filed within four months from the date of advertisement of the mark in the Trade Marks Journal, which

is non-extendable. Pursuant to the service of a Notice of Opposition by the TMR, the applicant (proprietor) of the mark is given two months (non-extendable) to file its counter-statement. In case the applicant fails to file a counter-statement, the application shall be deemed abandoned.

2. Evidence stage – upon receipt of the counter-statement, the opponent must 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 TMR. Alternatively, the opponent may intimate to the Registrar that it does not wish to adduce any evidence and file a letter relying on the contents of the Notice of Opposition. Subsequently, upon receipt of the evidence filed by the opponent, the applicant is given two months to file its evidence in support of the application. The applicant also has the option to file a reliance letter simply relying on the statements made in its counter-statement. In case the opponent or applicant fails to file the evidence by way of an affidavit or reliance letter, the opposition or application is deemed 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(s) on the 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 TMR 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?

Trade mark rights originate from the date of filing of the application. In the 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, the applicant can claim rights from an earlier date, i.e., prior to the filing of the trade mark, if supported with proper documentary evidence.

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. Trade mark law accords 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 Form TM-R, accompanied by a fee of INR 9,000 (approximately USD 124). A 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 is that of a complete and partial assignment, while 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?

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 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, quality control clauses are 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 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, and 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 and three months 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 or relative grounds for refusal.

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

Revocation proceedings begin with the filing of Form TM-O, accompanied by a statement of case wherein the applicant (the “aggrieved person”) sets out the nature of its interest, facts, and relief sought. Thereafter, a copy of the petition is served on the registered proprietor by the TMR. Within two months (extendable by one month) from receipt of the application, the registered proprietor must file a counter-statement to defend its registration. Pursuant to the filing of the counter-statement, the TMR 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 subsequent proceedings are the same as the opposition proceedings mentioned in question 5.3 above, and the provisions under Rules 46 to 51 of the Trade Marks Rules, 2017 apply, which pertain to opposition proceedings and are applicable in rectification proceedings as well.

Rectification petitions can be filed before five High Courts in India depending upon the jurisdiction of the registered trade mark. The five High Courts are those of Ahmedabad, Chennai, Delhi, Calcutta, and Mumbai.

8.3 Who can commence revocation proceedings?

Anyone claiming to be an “aggrieved person”, i.e., a person who is in some way 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 the non-use of the mark, including 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?

If the applicant is aggrieved by the decision of the Registrar, then the appeal lies before the High Court. If the revocation is filed before the High Court, then an appeal against the decision of the High Court can be filed before the Division Bench of the High Court.

9 Invalidity

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

Please see the answer to question 8.1.

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

Please see the answer to question 8.2.

9.3 Who can commence invalidation proceedings?

Please see the answer to question 8.3.

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

Please see the answer to question 8.4.

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

Please see 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 trade mark infringement or passing off shall be filed before a District Court with the jurisdiction to try the suit. Additionally, High Courts with original jurisdiction, such as those of Bombay, Calcutta, Delhi, Himachal Pradesh and Madras, 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 that are preceded by the filing of the suit (plaint) before the appropriate court. However, the plaintiff is first required to institute pre-litigation mediation except in cases where urgent interim relief is being sought. This court could be the State’s District Court or High Court (based on original jurisdiction). The stages of a civil suit until trial are described below:

- Stage 1: Admission of suit and hearing on *ex parte* injunction application. The filed suit is accompanied by 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 the 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 time frame.

In case the court decides against passing an *ex parte* injunction order and deems it necessary that the defendant be present to defend its case, the court issues court summons to the defendant for appearance in further hearings and to file its written statement within the stipulated time frame.

- Stage 2: Service of court summons on the defendant. The plaintiff and Court's Registry are mandated to serve copies of the plaint and supporting exhibits alongside the court's order on the defendant through 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 defence and appear in the second court hearing. The defendant, at this stage, generally 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 liberty to file an application seeking vacation of the 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.
- Stage 5: The court decides the plaintiff's application for grant of interim injunction based on submissions 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; the defendant follows. Thereafter, the trial begins, i.e., exhibiting documents filed by the plaintiff/defendant, examination and cross-examination of witnesses for both sides.

Final arguments are followed by the court's judgment.

It generally takes anywhere between two to four years, sometimes more depending on the backlog of cases, 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 injunctions are available.

The following conditions must be satisfied to avail preliminary injunctive relief:

- The plaintiff must establish a *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 and it is likely to suffer substantial harm if the injunction is refused when compared to the harm that might be caused to the defendant if the injunction is granted.

The court passes an order granting perpetual injunction after the trial or where the plaintiff is able to obtain 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 materials as the court may direct.

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

Yes, submissions and evidence are presented in writing. Cross-examination of witnesses is 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 High Court. Under Section 124 of the Act, 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 a stay on 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 trade mark infringement can be filed within three years from the date of the cause of action as per the law of limitation.

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 can arrest an infringer without a warrant) and punishable with imprisonment of between six months and three years and/or a fine, which may be between INR 50,000 (USD 583) and INR 200,000 (USD 2,332).

10.9 If so, who can pursue a criminal prosecution?

A complaint against an infringer can be filed by the holder of the trade mark registration or its authorised representative.

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, or even damages, against such threats.

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?

An alleged infringer 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 they provide 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 the use of such a mark by the defendant is therefore not an infringement.
- The defendant's use of the trade mark is in accordance with honest practices in industrial or commercial matters and does not take unfair advantage of or is not 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 is permitted 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 must also prove that the mark was adopted in good faith and not fraudulently or dishonestly. 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, third parties can be enjoined from using the infringing mark, and the cost or damages can be awarded. In criminal proceedings, infringers can be imprisoned and fined. The remedies provided against the infringement of a trade mark can be categorised as follows:

- Civil remedies – the registered proprietor can seek injunctions, damages, rendition of accounts, delivery, and destruction of infringing products.
- Criminal remedies – this includes imprisonment, fines, seizure of infringing copies and delivery to the owner.
- Border Enforcement through customs authorities – 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 defendant, and the Commercial Courts Act specifically provides the mechanisms for payments of costs. However, recovery of costs depends upon several factors, such as the 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 cases 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:

- if the court or tribunal from whose order the appeal is preferred has refused to admit evidence it ought to have admitted;
- 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 best efforts; or
- 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 intellectual property ("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 expiration of five years, the rights holder is required to furnish fresh notice. Under the rules, an IP rights holder may give notice to the Customs Commissioner requesting the suspension of clearance of goods suspected of 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, such as the doctrine of "passing off".

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 Act. 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 or film titles, besides copyright protection for their content. However, film titles can be registered with industry bodies such as the Indian Motion Picture Producers' Association, the Association of Motion Pictures and Television Program Producers, the Film and Television Producers' Guild of India, the Film Writers' Association, the Western India Film Producers' Association, and the Screenwriters Rights Association of India, but the same may not offer protection against unauthorised use by others and therefore, they must 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?

The ".in" domain name can be registered with any of the Registrars associated with the IN Registry. Other generic top-level domain names can be registered with any of the recognised Registrars, which can be done online by logging onto the Domain Registration registry portal.

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 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 customers, then such domain name can be protected under common law, like unregistered trade marks. Domain names can also be protected/enforced under the relevant rules of the .IN Domain Name Dispute Resolution Policy ("INDRP") and the Uniform Domain Name Dispute Resolution Policy ("UDRP").

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 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 (Government of India).
- .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 INDRP governs disputes in connection with .in or .bharat domain names. The body responsible is the IN Registry.

17 Current Developments

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

1. Karnataka High Court forms Committee to draft IP Division Rules ("IPD Rules"): On 20 June 2024, the Karnataka High Court released a notification forming a sub-committee to draft rules for establishing an IP Division. IP Divisions within the High Courts are being created keeping in mind efficiency with respect to time and money. After drafting, the IPD Rules shall be placed before the High Court and the District Judiciary Rules Committee for their approval.
2. As per the official notification dated 2 July 2024, Calcutta High Court has notified its own dedicated IP Division.
3. Adding to the existing list of IPD Rules, the latest entry, Himachal Pradesh High Court, notified its Intellectual Property Rights Division Rules, 2022 on 8 July 2024. Himachal Pradesh is a hub for the pharmaceutical industry in India and the State itself grants subsidies to such industries, which means that there are rising disputes with respect to trade marks, amongst others, making it an important IP bench. The IPD Rules follow the pattern of the Delhi IPD Rules, and Himachal Pradesh High Court is now the fourth High Court in India to have dedicated IPD Rules after Delhi High Court, Madras High Court, and Calcutta High Court.
4. The Ministry of Commerce and Industry notified the Trade Marks (Holding Inquiry and Appeal) Rules, 2024 on 16 August 2024. These Rules establish a mechanism to adjudicate violations of Section 107 of the Act, which pertains to the offence of falsely representing a trade mark as registered. As per the Jan Vishwas Act, 2023, the penalty for contravening Section 107 is "a sum equal to one-half per cent of the total sales or turnover in business, or of the gross receipts in the profession, as reflected in the audited accounts of the individual, or a sum of five lakh rupees, whichever is lower". Additionally, the IPD Rules include provisions allowing an appeal for individuals aggrieved by the adjudicating officer's order.
5. On 18 September 2024, the Ministry of Commerce and Industry introduced trade mark search tools based on artificial intelligence ("AI") and machine learning ("ML") to enable faster clearance of trade mark applications, and also introduced IP Saathi Chatbot. These initiatives aim to enhance efficiency and expedite the process of trade mark searches by providing instant support to users navigating the IP registration process.

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

1. In the case of *Sun Pharma Laboratories Ltd v. Dabur India Ltd and Anr*, decided on 9 February 2024, the court clarified the position on the duty to serve a counter-statement,

therefore interpreting the true position of law within the Act and its corresponding rules. In the present case, the counter-statement was served on the opponent/appellant on 12 June 2007. Thereafter, evidence in opposition was filed by the opponent with the TMR on 10 August 2007. The error/lapse on behalf of the appellant was that a copy of the same was not served on the respondents within the prescribed time. The same was only served via courier on 14 August 2007 and received by the applicant on 16 August 2007. During the course of the hearing, the respondent took an objection that the evidence was filed belatedly, as it was sent to the respondent one month late. This submission was accepted by the Registrar, who held that the opposition would not be allowed and would therefore be treated as abandoned. Hence, the present appeal. The court then held that upon the counter-statement being received by the opponent from the Registrar, the two-month period for filing evidence began. The evidence has to be directly served by the opponent upon the applicant and need not be served by the Registrar. If the evidence is not filed within the prescribed period, the opposition would be deemed to have been abandoned as the Registrar has no discretion, and hence the appeal was dismissed. However, on 22 October 2024, a review petition was passed by the court, wherein the court upheld the previous decision and set the record straight regarding the duty to serve counter-statements under the Act. The decision reflects a proactive approach to prevent any further time delays within the trade mark process.

2. The case of *Solidaire Digital Electronics Private Limited v. Salahudeen Abdhul Latheef & M/S. Sagar Enterprises*, decided by the IP Division of the Madras High Court, had notable observations with respect to the feasibility of allowing a counterclaim in a trade mark rectification petition filed under Sections 47 and 57 of the Act. The respondent filed a counterclaim seeking removal of the registered trade mark of the plaintiff. The plaintiff challenged the maintainability of such a counterclaim on the ground that neither the Act nor the Madras High Court Intellectual Property Rights Division Rules, 2022 provide for a counterclaim in response to a rectification petition. The respondent argued that the court's powers under Section 57 of the Act are so wide that they could include rectification of the trade mark of a petitioner in a rectification action should a counterclaim be made by the respondent. The Madras High Court did not fully accept the respondent's arguments. After reviewing the various subsections of Section 57 of the Act, the court noted that it does not provide for or deal with counterclaims. On the other hand, the Code of Civil Procedure expressly provides for a counterclaim and sets out an elaborate procedure for dealing with the same. As such, the court held that a counterclaim cannot be filed in a rectification petition under the Act. However, when it came to the interaction between Sections 47, 57, and 124, the Madras High Court chose to treat the counterclaim as an original petition rather than incurring the normal procedural costs and delays associated with filing a new petition. The court's decision shows the court's motive to work with efficiency, both in terms of time and money.
3. In the case of *Google LLC. v. MakeMyTrip (India) Private Limited*, a very important matter of trade mark infringement came to light. MakeMyTrip, a leading business in

the airline and hotel sector, filed a suit against another business giant Booking.com for using their registered word marks ("MakeMyTrip", "MMT" and "MakeMyTrip Hotels Ltd.") and Google for promoting Booking.com's ad through their Google Ads program. The Learned Single Judge ordered in favour of MakeMyTrip, restraining Booking.com from using any of their trade marks. He concluded *prima facie* and gave the order that "the use of a registered trademark as a keyword constituted trademark infringement". However, his decision was based on the interpretation that using trade marks as keywords equates to trade mark infringement.

This judgment was appealed before the Division Bench of the Hon'ble Delhi High Court, wherein the court held that the use of keywords cannot amount to the use of the trade mark. Thus, there can be no infringement of trade mark under Section 29(1) of the Act. The court further held that if trade marks are used by the advertiser as keywords to their own goods and services, it still cannot be termed as infringement of any sort. The court believed that Booking.com was a well-known and popular platform and that no internet user would believe the services offered by them to be the services of MakeMyTrip. The company's trade mark was not applied to any material when used as a keyword. Therefore, the court gave the judgment in favour of Booking.com, dismissing the case. Further, MakeMyTrip filed an appeal before the Hon'ble Supreme Court of India wherein the court did not entertain the Special Leave Petition under Article 136 of the Indian Constitution and upheld the decision of the Division Bench of the Hon'ble Delhi High Court.

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

The Karnataka High Court is expecting its own IPD Rules following the four High Courts that have them already and the forming of a sub-committee for the same (as covered in question 17.1).

Another expected development is the introduction of comprehensive AI for the management of trade mark systems, especially for trade mark searches and examinations. The introduction of AI and ML tools for trade marks will establish trust in automated systems while maintaining integrity and fairness in the trade mark registration process.

Further, the rise of e-commerce and social media platforms has created a new frontier for trade mark infringement. Counterfeit goods, domain squatting, and unauthorised use of trade marks online are rising concerns. Thus, we expect future reforms such as:

- Domain name dispute resolution: Strengthening mechanisms to resolve disputes related to infringing domain names.
- Regulation of online marketplaces: Introducing laws to hold e-commerce platforms accountable for trade mark violations by sellers on their platforms.

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

The year 2024 brought noteworthy changes in the realm of trade mark law, signalling substantial progress within the

Indian IP landscape. Both the Judiciary and the Executive have actively contributed to reforms aimed at enhancing the legal framework and its interpretation. The integration of AI into trade mark processes has further revolutionised the field, improving efficiency and accuracy in registration, monitoring, and enforcement. These advancements are expected to continue shaping the future of India's IP ecosystem, strengthening its position on the global stage.



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, trade marks, 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.

Manisha has served as the leading counsel for a client base in over 138 countries in 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, USA, Europe, the UK, Oceania, Latin America, and MENA.

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Malyashree Sridharan is a seasoned professional with over a decade of extensive experience in navigating various legal domains, with a specialised focus on IP laws, particularly trade marks and copyright. Throughout her career, she has adeptly handled both contentious and non-contentious legal matters, playing a pivotal role in the management of portfolios for prominent Fortune 500 clients.

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Since 2021, Malyashree has held the position of associate partner within the Trademarks & Copyright department at her firm, where she leverages her extensive legal knowledge and practical experience to deliver exceptional client service. Prior to joining LexOrbis, she honed her skills at other esteemed law firms headquartered in Delhi.

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Founded in 1997, LexOrbis has established itself as a premier full-service IP law firm in India. With a specialised team of over 270 professionals, including more than 150 experienced attorneys, the firm operates across four key Indian locations: 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.

Over the past decade, LexOrbis has consistently ranked among the top five IP firms in India and is well known for managing the global patents, designs, and trade mark portfolios of many technology companies and brand owners. LexOrbis offers comprehensive IP lifecycle management services through specialised departments, covering trade mark, copyright, patent filing, search and analytics, portfolio development, IP rights enforcement, litigation, procurement, and client advisory.

The firm has dedicated teams, including attorneys, engineers, scientists, paralegals, and technical specialists who handle patent, trade mark, and

copyright matters, from filing to research, portfolio management, enforcement, protection, transaction, and consultation.

LexOrbis continuously provides client-oriented, cost-efficient, and precise global legal solutions for IP protection, enforcement, commercialisation, and transactions. The teams possess subject matter expertise in managing IP portfolios for corporations, technology leaders, start-ups, individual innovators, universities, and research institutions.

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