LexOrbis | Intellectual Property Attorneys & Advocates

# BRAND & IDENTITY PROTECTION IN INDIA

A Comprehensive Guide to Brand, Identity & Trademark Registration, Enforcement & Portfolio Management

# FOREWORD

In today's highly competitive and interconnected marketplace, trademarks lie at the heart of brand identity and commercial success. They serve as critical source identifiers, enabling consumers to distinguish goods and services while embodying the goodwill, reputation, and trust built by a business over time. From names, logos and slogans to trade dress and non-traditional marks, trademarks are indispensable assets that not only protect market presence but also drive brand recognition, consumer loyalty and long-term enterprise value. As businesses increasingly operate across digital platforms and global markets, effective trademark protection has become essential to safeguarding identity and preventing misuse, dilution or infringement.

In this context, robust trademark and brand protection are central to sustainable growth and competitive differentiation. This booklet is designed to serve as a practical and strategic guide to brand and identity protection in India, addressing both the fundamental principles of trademark law and the emerging challenges arising from an evolving trademark landscape.

The booklet examines the entire lifecycle of trademark protection, encompassing trademark search and strategy, registration, validity and renewal, opposition, rectification, and enforcement. Particular emphasis has been placed on critical and evolving areas such as trade dress protection, ownership changes and transfers, and digital brand and identity protection, all of which have assumed heightened importance in the age of e-commerce, social media, and online brand exploitation. By analysing the criteria for trademark registration alongside procedural safeguards and enforcement mechanisms, this publication seeks to translate the legal framework governing trademarks in India into practical guidance and highlight best practices for rights holders.

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# TRADEMARK LANDSCAPE IN INDIA – BRAND AND IDENTITY PROTECTION

India's trademark ecosystem has experienced a remarkable transformation over the last decade, evolving into one of the largest and fastest-growing trademark regimes globally. Driven by legislative reforms, strategic digitisation, and increasing IP awareness among businesses, India today presents a robust, modern and globally aligned trademark framework. The approach has evolved from a compliance-driven registration system into a strategic brand-protection infrastructure that supports innovation, investment, and market differentiation. Today, trademarks in India are no longer viewed merely as legal assets but as core instruments of brand identity, consumer trust and enterprise valuation.

## Trademarks as Strategic Brand Assets

Brands operate as the primary interface between businesses and consumers, and trademarks function as repositories of goodwill and business identity, enabling consumers to identify origin, assure quality and form long-term brand associations. Brands are being protected at earlier stages of business development by startups, MSMEs and digital-first enterprises. Now, trademark portfolios are being structured not only for protection but also for licensing, franchising, technology transfer and brand monetisation. Enforcement strategies are increasingly proactive, driven by the need to preserve brand distinctiveness across both physical and digital markets

## Surge in Trademark Filings

According to WIPO's World Intellectual Property Indicators 2024, India ranks fourth globally in trademark filings, accounting for approximately 3.4% of worldwide trademark application activity.

- In FY 2024-25, India recorded over 5.52 lakh trademark applications, marking a year-on-year growth of approximate 16%.
- Nearly 90% of trademark filings originate from Indian residents, reflecting deepening domestic awareness of brand protection.

## Sectoral Drivers of Trademark Growth

- Health & pharmaceuticals: approximate 22% of filings
- Agriculture & agri-inputs: approximate 15%
- Clothing, textiles & lifestyle products: approximate 13%

## Institutional Strengthening under CGPDTM

The Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM) has played a pivotal role in strengthening India's trademark ecosystem:

- End-to-end digitisation of filings, examinations, hearings and certificates.
- Over 98% of trademark applications are now filed online, significantly enhancing accessibility and transparency.
- Introduction of AI-powered trademark search tools, e-certificates, and the IP Saarthi chatbot for stakeholder support.
- Expansion of human resources, including 200 additional trademark posts, to tackle growing volumes and pendency.

## Faster Processing and Reduced Pendency

- Trademark examination timelines have been reduced from over 12 months to under 30-45 days in many cases, driven by digitisation and procedural reforms.
- Video-conferencing hearings and stricter scrutiny of fictitious applications have further improved efficiency and quality of examination.

## National IPR Policy

Implemented in 2016, the National IPR Policy continues to provide a strong policy backbone for trademark reforms:

- Significant reduction in pendency of trademark applications.
- Enhanced IP awareness initiatives, including NIPAM, which has reached over 25 lakh students nationwide.
- Emphasis on commercialisation of IP, enforcement, and human-capital development.

## India as a Global Brand and Investment Hub

- India now holds the second-largest number of active trademark registrations globally, with over 3.2 million trademarks in force.
- Trademark filings in India increased by approximately 60% between 2018 and 2023, reflecting sustained brand creation across industries.
- With faster registrations, digital accessibility, policy support, and enforcement focus, trademarks now serve as core business assets, protecting reputation, consumer trust, and long-term enterprise value.

# FRAMEWORK FOR BRAND AND IDENTITY PROTECTION IN INDIA

The trademark regime in India is governed by the Trade Marks Act, 1999, read together with the Trade Marks Rules, 2017, which collectively establish a comprehensive framework for the registration, protection, and enforcement of trademark rights. Beyond law, the legal framework is designed to secure the distinctive identity of brands, prevent consumer confusion, safeguard accumulated goodwill, and promote fair and honest competition in the marketplace. Accordingly, it provides protection to both registered and unregistered marks, albeit with significant differences in the strength, scope, and certainty of enforcement available to brand owners.

## Protection of Registered Trademarks

A registered trademark confers exclusive statutory rights on its proprietor in respect of the goods or services for which the mark is registered. These rights include the ability to initiate infringement proceedings against unauthorised third parties who use an identical or deceptively similar mark without consent. The availability of statutory infringement remedies provides registered trademark owners with a more direct, efficient, and potent enforcement mechanism, reinforcing brand integrity and legal certainty.

## Protection of Unregistered Trademarks: Passing Off

In contrast, unregistered trademarks are protected through the common law remedy of passing off, which aims to preserve the goodwill and reputation associated with a mark even in the absence of registration. An action for passing off is premised on the principle that no trader should misrepresent their goods or services as those of another.

To successfully sustain a claim for passing off, the plaintiff must pass the well-settled classical trinity test, namely:

- Goodwill: The existence of established goodwill or reputation attached to the mark in relation to specific goods or services;
- Misrepresentation: A misrepresentation by the defendant, whether intentional or otherwise, that is likely to deceive or cause confusion among the public; and
- Damage: Actual or probable damage suffered by the plaintiff as a result of the defendant's misrepresentation.

While passing-off actions offer meaningful protection, they typically entail higher evidentiary burdens, particularly in proving goodwill and consumer deception. Consequently, registration remains the preferred and strategically superior route for securing and enforcing trademark rights in India.

## International Agreements and Harmonisation in India's Trademark System

India's trademark landscape is significantly shaped by international agreements and globally accepted practices that aim to harmonise intellectual property laws, foster foreign investment, and facilitate the global expansion of domestic brands. This alignment with international norms enhances India's credibility in the global marketplace and offers greater legal certainty and predictability to both Indian and foreign businesses operating across borders.

**Paris Convention for the Protection of Industrial Property (1883):** India's membership in the Paris Convention enables trademark applicants to claim priority rights in India based on an earlier filing made in another convention country. This mechanism facilitates international brand protection by allowing applicants to secure filing dates across jurisdictions within prescribed timelines. The Convention thus ensures reciprocity, supporting Indian businesses seeking protection abroad while safeguarding the interests of foreign rights holders in India.

**TRIPS - Trade-Related Aspects of Intellectual Property Rights Agreement (1995):**
As a member of the World Trade Organization (WTO), India is bound by the TRIPS Agreement, which prescribes minimum standards of protection for intellectual property rights, including trademarks. TRIPS has had a profound impact on India's trademark legislation by influencing provisions relating to registration, scope of rights, enforcement mechanisms, and remedies. The Trade Marks Act, 1999, reflects India's commitment to TRIPS compliance while balancing domestic economic and developmental priorities.

**Madrid Protocol (1989):**
India acceded to the Madrid Protocol in 2013, marking a significant step toward integrating its trademark system with global filing frameworks. The Madrid system allows trademark owners to seek protection in multiple member countries through a single international application, administered by WIPO. For Indian enterprises, this offers a streamlined and cost-effective route to global expansion, while foreign applicants benefit from simplified entry into the Indian market.

## Alignment with Global Classification Systems

**Nice Classification:** India follows the Nice Classification (currently in its 13$^{th}$ edition) for categorising goods and services in trademark applications. This internationally recognised classification system ensures consistency with global trademark offices, simplifies cross-border filings, and enables applicants to align their trademark strategies seamlessly across jurisdictions.

**Vienna Classification:** For trademarks containing figurative or visual elements, India applies the Vienna Classification, which standardises the categorisation of image-based marks. This system enhances the efficiency of trademark searches and examination processes and aligns India's practices with those of leading international IP offices.

Through adherence to key international treaties and the adoption of globally accepted classification systems, India has developed a modern, internationally harmonised trademark regime. This framework not only strengthens brand protection and enforcement but also positions India as a reliable and attractive jurisdiction for global commerce, innovation, and investment.

# CRITERIA FOR TRADEMARK REGISTRATION

Under Indian law, a trademark is broadly defined as any mark capable of graphical representation and capable of distinguishing the goods or services of one person from those of others. This expansive definition, embodied in the Trade Marks Act, 1999, reflects India's intent to accommodate both traditional brand identifiers and evolving forms of non-traditional marks.

## Categories of Registrable Marks

The Indian trademark regime recognises and permits registration of a wide variety of marks, including:

- **Word marks:** names, invented words, letters, numerals, and slogans
- **Device or logo marks:** visual symbols, stylised text, and graphical representations
- **Composite marks**: combinations of word and device elements
- **Trade dress:** packaging, labels, tickets, and overall visual presentation
- **Shape of goods and three-dimensional marks**, subject to statutory limitations

In keeping with global trademark developments, India also recognises unconventional trademarks, such as:

- **Colour marks and combinations of colours**, where the registration of a combination of colours as a trademark can be applied for by submitting a reproduction of the mark in colours, along with the corresponding colour codes.
- **Sound marks**, where 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 playback, accompanied by a graphical representation of the sound's notation.
- **Motion marks**, where the movement or change in position of elements can be graphically represented through a series of images or descriptions clearly depicting the motion; and
- **Smell (olfactory) marks**, which are capable of graphical representation and can function as source identifiers.

The increasing acceptance of such marks signifies the adaptability of India's trademark system to branding innovations in the digital and multimedia marketplace.

## Classification of Goods and Services

India follows the internationally accepted Nice Classification, which categorises goods and services into 45 classes, with Classes 1 to 34 for goods and Classes 35 to 45 for services. Adoption of this classification harmonises Indian filings with global practices, enabling easier international portfolio management, alignment with Madrid Protocol registrations, and streamlined inbound and outbound trademark protection strategies.

## Grounds for Refusal of Trademark Application

Despite the wide scope of registrable subject matter, the Trade Marks Act, 1999 prescribes specific exclusions based on public interest, consumer protection, and prior rights. The following categories of marks are not eligible for registration

## Absolute Grounds for Refusal

- Marks devoid of distinctive character, including generic or common trade terms;
- Descriptive marks that directly describe the quality, quantity, purpose, value, geographical origin, or other characteristics of the goods or services;
- Marks that have become customary in the current language or in the bona fide and established practices of trade;
- Deceptive or confusing marks, likely to mislead the public as to nature, quality, or origin;
- Marks that hurt religious sentiments, or offend religious susceptibilities of any class or section of society;
- Marks containing obscene, vulgar, or scandalous matter;
- Marks prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950, such as national symbols, official insignia, or names of international organisations without authorisation;
- Shape marks that consist exclusively of the shape resulting from the nature of the goods themselves, the shape necessary to obtain a technical result, or the shape that gives substantial value to the goods.

## Relative Grounds for Refusal

- Marks identical or deceptively similar to earlier trademarks registered or applied for in respect of identical or similar goods or services, where use is likely to cause confusion or association;
- Marks identical or similar to well-known trademarks, even across dissimilar goods or services, where use would unfairly exploit or dilute the reputation of the earlier mark;
- Marks prohibited by copyright law, such as unauthorised reproduction of artistic works;
- Marks barred by the law of passing off, where the adoption would infringe the goodwill and reputation of an unregistered but prior user.

## Distinctiveness Through Use

It is important to note that certain marks, which are prima facie non-distinctive or descriptive, may still be registered if the applicant can demonstrate that the mark has acquired distinctiveness through long, continuous, and extensive use, resulting in consumer recognition of the mark as a source identifier.

India's trademark regime strikes a careful balance between protecting brand innovation and safeguarding public interest. While the law adopts a liberal approach to what may constitute a trademark, it simultaneously enforces strict exclusionary principles to prevent monopolisation of generic, descriptive, deceptive, or culturally sensitive matter. For rights holders, understanding these boundaries is critical to securing effective and enforceable trademark protection in India.

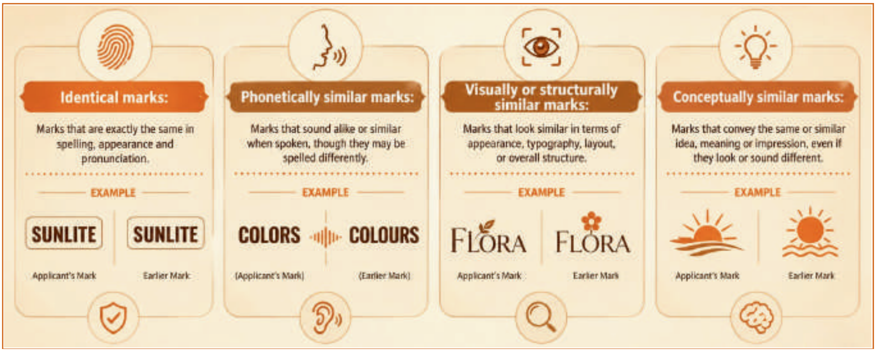
# TRADEMARK SEARCH & STRATEGY

A successful trademark strategy begins well before the filing of an application. The choices made at the brand-creation stage directly influence not only registrability but also the scope of protection, enforceability, commercial value, and long-term sustainability of a trademark. Early strategic planning significantly reduces the risk of objections, oppositions, infringement exposure, and costly re-branding exercises.

## Trademark Search

A comprehensive trademark search is the cornerstone of a sound brand protection strategy. Its primary objective is to identify existing marks that may conflict with the proposed mark and to assess the legal and commercial risks associated with adoption and use.

A robust trademark search typically includes:




In addition to register-based searches, a comprehensive strategy may involve market searches, online usage analysis, and a review of unregistered or common-law usage, which can present passing-off risks despite the absence of formal registration.

## Strategic Benefits of Early Search and Clearance

Conducting a trademark search at the ideation stage enables businesses to:

- assess registrability prospects before investing in marketing or packaging,
- avoid conflicts with well-known or prior-used marks,
- refine brand elements to strengthen distinctiveness, and
- make informed filing decisions across jurisdictions and classes.

## Strategic Considerations in Trademark Selection

A well-designed brand protection strategy must combine legal robustness with commercial objectives. Key considerations may include:

### 1. Distinctiveness of the Mark

- Coined or arbitrary marks enjoy the highest level of protection and enforceability.
- Suggestive marks may be registrable but require careful positioning.
- Descriptive or generic marks inherently face objections and are weaker in enforcement.

### 2. Market Positioning and Consumer Perception

- Whether the mark aligns with brand tone and industry norms,
- How it appears visually, phonetically, and culturally, and
- Whether it avoids unintended meanings across regions or languages.

### 3. Expansion and Scale Potential

- Allows expansion into adjacent product or service categories,
- Can adapt to new technologies, platforms, or markets, and
- Supports international filings under the Madrid Protocol or national systems.

### 4. Enforcement Strength and Limitation Value

- Is easier to enforce against infringers and counterfeiters,
- Faces lower evidentiary burdens in litigation or oppositions, and
- Acts as a deterrent against deceptive adoption by competitors.

TM

# TRADEMARK
## REGISTRATION PROCESS

**STEP 1**
**Trademark Search**
Conduct a comprehensive search to check the availability of the mark in the relevant class(es).

**STEP 2**
**Classification of Goods & Services**
Identify the correct Nice Classification class(es) under which to apply. India follows the Nice Classification (11th edition).
11th EDITION

**STEP 3**
**Filing the Application**
File Form TM-A online or physically at the relevant Registry office. The application must include the mark representation, applicant details, class(es), and a list of goods/services.
TM-A

**STEP 4**
**Examination**
The Registry examines the application for compliance with absolute and relative grounds. An Examination Report is issued within 30 days of filing.

**STEP 5**
**Response to Examination Report**
The applicant must respond to any objections within 30 days (extendable by one month). The response may include legal arguments, evidence of use, or disclaimers.

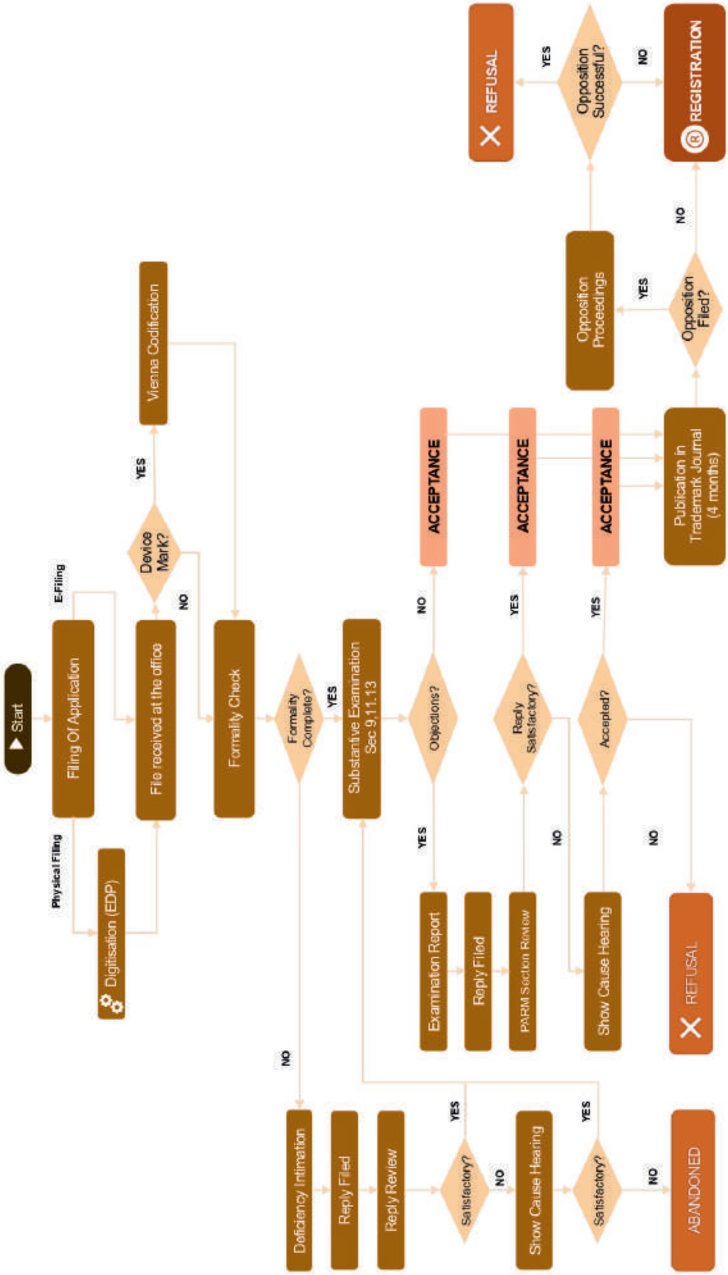
**STEP 6**
**Hearing (if required)**
If the Examiner is not satisfied with the written response, a hearing is scheduled before the Trade Marks Registrar.

**STEP 7**
**Publication in Trade Marks Journal**
If accepted, the mark is published in the weekly Trade Marks Journal. This initiates a 4-month opposition window.
JOURNAL

**STEP 8**
**Opposition Period**
Third parties may oppose the registration within 4 months of publication by filing Form TM-O. The applicant has 2 months to file a counterstatement.
VS

**STEP 9**
**Registration & Certificate**
If no opposition is filed, or opposition is decided in favour of the applicant, the mark is registered, and a Certificate of Registration (Form TM-23) is issued.

! The entire process typically takes 12 to 18 months, depending on the case.



Start
Filing Of Application
Physical Filing
E-Filing
Digitisation (EDP)
File received at the office
Device Mark?
YES
NO
Vienna Codification
Formality Check
Formality Complete?
YES
NO
Substantive Examination Sec 9,11,13
Objections?
YES
NO
Examination Report
Reply Filed
PARM Section Review
Reply Satisfactory?
YES
NO
Show Cause Hearing
Accepted?
YES
NO
REFUSAL
ACCEPTANCE
ACCEPTANCE
ACCEPTANCE
Publication in Trademark Journal (4 months)
Opposition Filed?
YES
NO
Opposition Proceedings
Opposition Successful?
YES
NO
REFUSAL
REGISTRATION
Deficiency Intimation
Reply Filed
Reply Review
Satisfactory?
YES
NO
Show Cause Hearing
Satisfactory?
YES
NO
ABANDONED

### Remedies Against Refusal

Where an application is refused after hearing:

- Review petition may be filed before the Registrar within one month of the refusal order; or
- Appeal may be preferred to the concerned High Court within three months, in accordance with the Trade Marks Act, 1999.

### Key Benefits of Trademark Protection

1. **Brand Recognition and Market Identity**: A distinctive trademark serves as a powerful brand identifier, enabling consumers to instantly recognise and differentiate a business's goods or services in an increasingly competitive and cluttered marketplace. Over time, a trademark becomes synonymous with the quality, reputation, and values associated with the brand.

2. **Legal Protection and Exclusivity:** Trademark registration grants the proprietor exclusive statutory rights over the mark in relation to the registered goods or services. These rights allow the owner to restrain unauthorised use, initiate infringement proceedings, and effectively enforce brand protection against counterfeiters, imitators, and dishonest competitors.

3. **Creation of a Valuable Commercial Asset:** A trademark is a valuable intangible asset that can be commercially exploited through licensing, franchising, assignment, or brand collaborations. Strong trademarks enhance enterprise valuation, attract investors, and can generate independent revenue streams beyond core business operations.

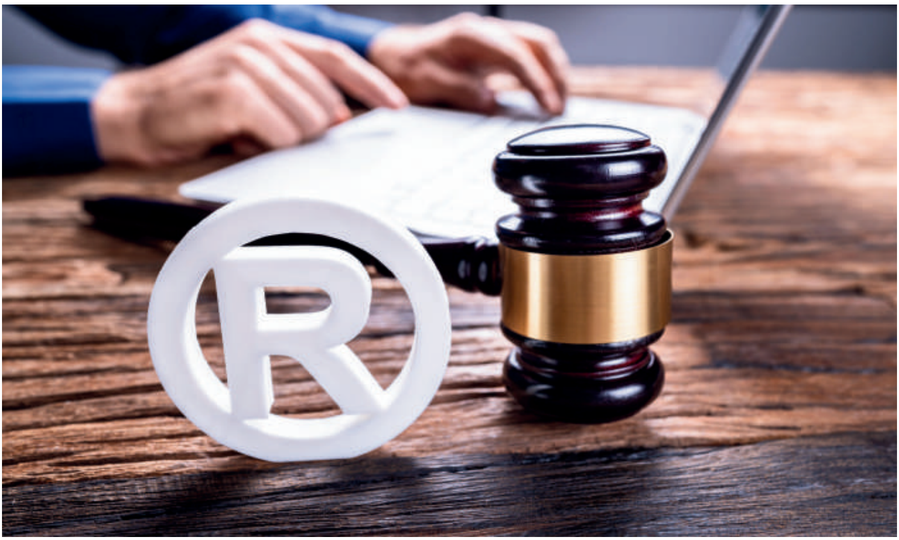
4. **Consumer Trust and Brand Loyalty:** Consistent and uninterrupted use of a trademark builds consumer confidence and goodwill, fostering trust and long-term customer loyalty. A recognised trademark reassures consumers of product authenticity and quality, encouraging repeat purchases and sustaining brand equity over time.

# TRADE DRESS PROTECTION IN INDIA

One of the recurring challenges for rights holders lies in determining the most appropriate form of IP protection for product shape or packaging. This determination depends largely on the nature, novelty, and stage of commercial exploitation of the shape or design:

- **Design Law Protection:** Where the shape or configuration of a product is novel, original, and not previously disclosed to the public, protection should ideally be sought under the Designs Act, 2000. Design registration offers time-bound monopoly protection for the aesthetic features of articles and is particularly suitable for newly launched products.

- **Trademark or Passing Off Protection:** If a product shape or packaging has not been registered as a design, or where design protection has expired, it may still be protected under:
    - Trademark law, provided the trade dress functions as a badge of origin and has acquired distinctiveness; or
    - Passing off, where registration is unavailable but goodwill has accrued through use.



## Passing Off and Trade Dress

To succeed in a passing off action relating to trade dress, the rights holder must demonstrate that:

1. The specific shape, packaging, or get-up has acquired distinctiveness and goodwill associated with their goods or services;
2. Consumers recognise the trade dress as originating from the claimant; and
3. Use of an identical or deceptively similar trade dress by another party is likely to cause confusion or deception in the marketplace.

Indian courts have consistently affirmed that unique packaging, colour schemes, product shapes, and overall get-up are entitled to protection under both the Trade Marks Act, 1999 and common law. Even in the absence of statutory registration, the proprietary rights arising from goodwill remain enforceable, provided the claimant satisfies the evidentiary threshold. Courts have therefore granted injunctive relief where imitation of packaging or product appearance was shown to unfairly ride on the reputation of an established brand.

# TRADEMARK VALIDITY AND RENEWAL

In India, a registered trademark is initially valid for a period of 10 years from the date of application. To maintain continuous protection, the registration must be renewed every ten years. There is no statutory limit on the number of renewals, and a trademark may be renewed indefinitely, provided the prescribed renewal fees are paid and the mark continues to be used.

It is also advisable for trademark proprietors to ensure that ownership details, including the name and address of the proprietor, are kept up to date with the Trade Marks Registry, as inaccuracies may complicate enforcement, renewal, or recordal proceedings.

## Renewal Timeline and Key Stages

- **Renewal Application**: The proprietor of a registered trademark may apply for renewal within 6 months prior to the expiry of the trademark registration. Filing within this window ensures uninterrupted protection and avoids additional costs.
- **Grace Period After Expiry**: If the renewal application is not filed before the expiration date, a 6-month grace period is available after expiry. Renewal during this period is permitted upon payment of the prescribed renewal fee along with a surcharge. During the grace period, the trademark remains on the register but is vulnerable to removal if renewal is not completed.

## Failure to Renew and Restoration

If the trademark is not renewed within the grace period, the mark is liable to be removed from the Register of Trade Marks. However, the law allows restoration of the mark by filing a restoration request within 1 year of the expiry of the last registration. It is important to note that restoration is discretionary and requires payment of additional restoration fees along with the renewal fee.

## Filing of Renewal Application

**Form and Documentation:** Form TM-R must be filed with the Trade Marks Registry to renew or restore a trademark. The application should include the trademark registration number, class(es) in respect of which renewal is sought, and the current details of the proprietor.

Fees: A renewal fee is payable for each ten-year term. Additional fees apply when renewal is filed during the grace period or when restoration is sought after removal.

**Examination and Renewal Confirmation**: Once the renewal application is filed, the Trade Marks Registry examines the application to ensure compliance with procedural requirements. If the application is in order, the trademark registration is renewed for a further ten-year period. The Registry updates its records accordingly and issues a renewal certificate, confirming continued protection.

**Publication in the Trade Marks Journal:** After renewal, the Trade Marks Registry may publish a notice of renewal in the Trade Marks Journal. This serves as a public record confirming that the registration remains in force for the renewed term.

# TRADEMARK OPPOSITION PROCEEDINGS

Trademark opposition proceedings in India provide an important mechanism for third parties to challenge the registration of a trademark that may conflict with existing rights or violate statutory requirements. An opposition may be filed on both absolute and relative grounds for refusal, including lack of distinctiveness, descriptiveness, likelihood of confusion with an earlier mark, dilution of a well-known mark, bad faith adoption, or violation of public interest. Any person may file an opposition; it is not necessary for the opponent to be a registered rights holder, although the opponent must establish sufficient legal interest.

Opposition proceedings are initiated after a trademark application is advertised in the Trade Marks Journal and are conducted before the Trade Marks Registry in a quasi-judicial manner. The process broadly comprises three stages: pleadings, evidence, and hearing.

**Pleadings**: The proceedings begin with the filing of a notice of opposition, which must be submitted within 4 months from the date of publication of the trademark in the Trade Marks Journal. This deadline is mandatory and non-extendable. The notice must clearly set out the grounds of opposition along with the factual and legal basis supporting the challenge.

Once the Registry serves the notice of opposition, the applicant must file a counterstatement within 2 months of service. This timeline is also non-extendable, and failure to file the counterstatement results in the application being deemed abandoned without further examination.

**Evidence:** Upon completion of the pleading stage, the matter proceeds to the evidence stage, which is conducted entirely through affidavits. The opponent is required to file evidence in support of the opposition within two months from the date of service of the counterstatement. Alternatively, the opponent may elect not to file evidence and instead submit a written intimation stating reliance on the contents of the notice of opposition. If the opponent fails to submit either evidence or a reliance letter within the prescribed time, the opposition is deemed abandoned.

If the opponent's evidence is filed or reliance is indicated, the applicant then has 2 months to file evidence in support of the application or to submit a reliance letter confirming reliance on the counterstatement. Failure by the applicant to take this step results in the application being treated as abandoned. Thereafter, the opponent may file evidence in reply within one month, if desired. This stage is optional and limited strictly to matters arising from the applicant's evidence.

**Hearing:** Once the evidentiary phase concludes, the Registry schedules a hearing, and both parties have the opportunity to present oral submissions. Based on the pleadings, evidence, and arguments advanced, the Registrar issues a reasoned order, either allowing the opposition and refusing the application or dismissing the opposition and permitting the trademark to proceed toward registration. The Registrar's decision is appealable before the concerned High Court.

Trademark opposition proceedings, therefore, play a crucial role in maintaining the integrity of the register and preventing the registration of marks that may cause consumer confusion or unfairly encroach upon existing rights. Given the strict timelines and consequences of non-compliance, careful procedural management and strategic preparation are essential for both opponents and applicants.

# TRADEMARK CANCELLATION OR RECTIFICATION

Trademark cancellation or rectification proceedings provide a mechanism to remove, vary, or correct a registered trademark that no longer satisfies the statutory requirements or prejudicially affects the rights of others. Under Indian trademark law, such proceedings may be initiated either before the Trade Marks Registry or before the concerned High Court, depending on the circumstances and jurisdiction. Trademark cancellation and rectification proceedings serve as an important corrective tool to ensure that the Register accurately reflects valid and enforceable rights. They help prevent misuse of statutory monopolies, protect consumer interests, and preserve fairness in the marketplace.

## Grounds for Cancellation

A registered trademark may be cancelled or rectified on several grounds, including both substantive defects at the time of registration and subsequent developments affecting the validity of the mark.

- **Non-Use:** If a trademark has not been used for five consecutive years from the date of registration and for three months before the date of the cancellation application, it can be cancelled. Non-use must be without a legitimate reason, and use includes commercial or bona fide usage.
- **Generic or Common Name**: If the registered trademark has become a generic term for the products or services it represents, it may lose its distinctiveness and be subject to cancellation.
- **Contravention of Provisions:** If the trademark was registered in violation of the provisions of the Act or should not have been registered initially (e.g., lack of distinctiveness or misrepresentation).
- **Deception or Fraud:** If the registration was obtained by fraud, misrepresentation, or concealment of material facts.
- **Violation of Rights**: If the trademark infringes on pre-existing rights or creates confusion among consumers, it can be cancelled by an aggrieved party.

## Proceedings before the Trade Marks Registry

Cancellation or rectification proceedings before the Trade Marks Registry are initiated by filing Form TM-O, accompanied by a statement of case. The application must be filed by an "aggrieved person", meaning a party with a legitimate interest in having the mark removed or corrected, such as a competitor, prior user, or rights holder adversely affected by the registration. The statement sets out the petitioner's interest, material facts, legal grounds, and the relief sought.

Upon filing, the Trade Marks Registry serves a copy of the cancellation petition on the registered proprietor. The proprietor is required to file a counterstatement within 2 months from the date of service. This period may be extended by 1 additional month at the Registry's discretion. Failure to file a counterstatement within the prescribed time may significantly weaken the proprietor's defence and allow the petitioner to proceed with evidence.

After the counterstatement is served, the Registry furnishes a copy to the petitioner, and the matter proceeds to the evidence stage, which broadly follows the same procedure as trademark opposition proceedings. Evidence is submitted by way of affidavits, followed by an opportunity for rebuttal evidence and, thereafter, a hearing. Upon completion, the Registrar issues a reasoned order to maintain, vary, or remove the mark from the Register.

## Proceedings before the Concerned High Court

Alternatively, trademark cancellation or revocation proceedings may be instituted directly before the concerned High Court exercising jurisdiction over trademark matters. Currently, such proceedings may be filed before the High Courts at Delhi, Mumbai, Chennai, Kolkata, and Ahmedabad, depending on where the trademark is registered or where related infringement proceedings are pending.

Before the High Court, any person qualifying as an aggrieved party may seek rectification or cancellation. High Court proceedings are typically invoked when complex legal issues arise, when parallel infringement actions are pending, or when appellate or supervisory relief is required. The High Court has the power to pass binding orders directing the removal or correction of entries in the Register.

# ENFORCEMENT OF TRADEMARK RIGHTS

Various remedies are available to aggrieved parties for trademark infringement in India. These remedies broadly include civil, criminal, and border enforcement measures, enabling rights holders to take effective action against misuse, counterfeiting, and unauthorised exploitation of trademarks.

## Civil Remedies

In civil proceedings, trademark owners may seek injunctive relief to restrain third parties from using an infringing or deceptively similar mark. Courts may grant a preliminary (interim) injunction at the initial stage of the suit. To obtain such relief, the plaintiff must establish a prima facie case of infringement or passing off; the likelihood of irreparable injury if the injunction is not granted; and that the balance of convenience lies in favour of granting the injunction.

If these conditions are satisfied, the court may restrain the defendant from further use of the mark pending final adjudication. Upon completion of trial, or in appropriate cases through summary judgment, the court may grant a permanent injunction, thereby permanently restraining the defendant from using the infringing trademark. The court may also award damages or an account of profits to compensate the trademark owner for losses suffered due to infringement. Additional reliefs may include delivery-up, seizure, and destruction of infringing goods, packaging, labels, and advertising material to prevent continued or future misuse.

## Infringement vs Passing Off

| Infringement (Registered Mark) | Passing Off (Unregistered Mark) |
|---|---|
| Statutory remedy under Section 29 | Common law remedy based on equity |
| No need to prove reputation or goodwill | Must establish reputation, misrepresentation and damage |
| The registration certificate is prima facie evidence | Must produce evidence of use and public recognition |
| Criminal action available under Section 103 | Only civil remedies available |
| Action available even for potential confusion | Must show actual or likely damage to goodwill |

## Available Civil Remedies

| Remedy | Details |
|---|---|
| **Injunction** | Temporary (ex parte or inter partes) and permanent injunctions restraining further use of the infringing mark. An ex parte ad interim injunction can be obtained without prior notice to the defendant in urgent cases. |
| **Damages or Account of Profits** | The plaintiff may claim either damages for actual loss suffered, or an account of profits made by the infringer through use of the mark. |
| **Delivery Up / Destruction** | An order requiring the infringer to deliver up or destroy infringing goods, labels, packaging, or materials. |
| **Costs** | Courts may award costs of the proceedings to the successful party. |
| **Anton Piller / Search Order** | Courts may grant search and seizure orders to preserve evidence of infringement. |
| **Mareva Injunction** | Freezing orders over the defendant's assets to prevent dissipation of assets pending trial. |

## Criminal Remedies

Trademark infringement and counterfeiting also attract criminal liability under Indian law. Offenders found guilty may face imprisonment and monetary fines. Criminal courts are empowered to order search, seizure, and confiscation of infringing goods and may direct delivery of such goods to the rightful trademark owner or their destruction.

## Anti-Counterfeiting Measures

The Bharatiya Nyaya Sanhita (BNS) (earlier the Indian Penal Code) defines counterfeiting as an act intended to deceive by causing one thing to resemble another, punishable with imprisonment, fine, or both. Sections 102, 103, and 104 of the Trade Marks Act, 1999 specifically deal with offences relating to falsification of trademarks, falsely applying trademarks, and penalties and procedure for such offences, respectively.

Offenders may face imprisonment ranging from 6 months to 3 years, along with fines. Offences under the Trade Marks Act, 1999, are cognisable, allowing police officers of designated ranks to arrest offenders without a warrant and initiate investigations. However, before taking action, police officers are required to seek an opinion from the Registrar of Trade Marks on the facts of the case, thereby ensuring the proper application of trademark law and preventing the misuse of criminal provisions.

## Border Enforcement

The Bharatiya Nyaya Sanhita (BNS) (earlier the Indian Penal Code) defines counterfeiting as an act intended to deceive by causing one thing to resemble another, punishable with imprisonment, fine, or both. Sections 102, 103, and 104 of the Trade Marks Act, 1999 specifically deal with offences relating to falsification of trademarks, falsely applying trademarks, and penalties and procedure for such offences, respectively.

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## Criminal Remedies

India provides effective border enforcement mechanisms to prevent the importation of counterfeit and infringing goods. The Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007, empower customs authorities to prohibit the import of infringing goods into India. To avail this remedy, the rights holder must have a validly registered trademark or IP right and record the same with the customs authorities. Once recorded, customs protection is valid for five years from the date of recordation or until the expiry of the trademark registration, whichever is earlier. To continue protection beyond this period, the rights holder must file a fresh notice of recordation with customs.

## Appeals and Supreme Court Jurisdiction

If a judgment is passed by a District Court, an appeal may be filed before the concerned High Court. Where the judgment is delivered by a Single Judge of a High Court, a further appeal may lie before the Division Bench. Appeals to the Supreme Court of India are permissible only on substantial questions of law, ensuring final judicial oversight in trademark enforcement matters.

# TRADEMARK OWNERSHIP CHANGE AND TRANSFER

In India, trademark rights may be transferred or permitted to be used by third parties through assignment or licensing arrangements. These transactions are governed by the Trade Marks Act, 1999, and play an important role in brand commercialisation, restructuring, mergers, acquisitions, and business expansion. Both registered and unregistered trademarks can be assigned or licensed, subject to statutory conditions and recordal requirements.

## Assignment of Trademarks

Assignment refers to the complete or partial transfer of ownership of a trademark from one person to another. In India, assignments are permitted for both registered and unregistered trademarks. An assignment may be with goodwill (where the business reputation attached to the mark is transferred), or without goodwill (restricted to certain goods, services, or territories).

To ensure enforceability against third parties, assignments must be recorded with the Trade Marks Registry, even though recordal is not mandatory for validity between the parties.

An application for recordal of assignment must be filed in Form TM-P within 6 months from the date of execution of the assignment deed. This period may be extended by an additional 6 months upon payment of prescribed fees. Until recordal is effected, the assignee may face difficulties in enforcing trademark rights, initiating infringement proceedings, or asserting ownership before enforcement authorities.

## Licensing of Trademarks

Licensing, also referred to as registered user arrangements, permits a third party to use a trademark without transferring ownership. Unlike assignments, only registered trademarks are eligible for licensing and recordal with the Trade Marks Registry. Licensing arrangements must be formally documented in a written licensing agreement that clearly defines the scope of use, territorial limits, duration, quality-control obligations, and the licensee's rights and restrictions.

To obtain statutory recognition, the licensor or licensee must apply for recordal of the license with the Trade Marks Registry within 6 months from the date of execution of the licensing agreement. Failure to apply for recordal within the prescribed period may affect the enforceability of the license against third parties, weaken claims in infringement or passing off actions, and restrict the licensee’s ability to assert user rights independently.

## Recordal and Legal Effect

Once the assignment or license is recorded, the Trade Marks Registry updates the Register to reflect the change in ownership or user status. Recordal ensures transparency of trademark ownership, public notice to third parties, and smoother enforcement and prosecution of rights. In the case of licensing, proper recordal also helps demonstrate quality control, which is essential to preserve the distinctiveness and validity of the trademark.

# DIGITAL BRAND & IDENTITY PROTECTION

The rise of e-commerce, social media and digital commerce has created new challenges for brand owners in India. Trademark law applies in digital contexts, but enforcement requires additional strategies.

## Domain Name Disputes

Domain names often function as a brand's primary digital identity, making them particularly vulnerable to misuse. Practices such as cybersquatting, where domain names identical or confusingly similar to well-known trademarks are registered in bad faith, are actionable under Indian law. Brand owners in India may pursue multiple remedies, including:

- Civil suit for passing off and/or trademark infringement before a High Court.
- Filing a UDRP (Uniform Domain Name Dispute Resolution Policy) complaint with ICANN-accredited providers for .com, .net, .org domains.
- Filing an INDRP (Indian Domain Name Dispute Resolution Policy) complaint with NIXI for .in and .bharat domains

## Social Media and Online Marketplaces

Social media platforms and online marketplaces have become critical touchpoints for consumer engagement, but they are also frequent sites of counterfeiting, impersonation, and unauthorised brand use. Effective digital brand protection, therefore, hinges on active platform-specific enforcement. Key enforcement tools include:

- **Platform takedown mechanisms:** Most major marketplaces have brand registry programmes that allow trademark owners to remove infringing listings.
- **Notice and Takedown under the Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021:** Intermediaries must take down infringing content upon notice.
- **Proactive Brand Monitoring:** Use of automated monitoring tools to track counterfeit listings.

## Comparative Advertising and Keyword Use

With the rise of digital advertising and search engine marketing, disputes increasingly arise from the use of competitors' trademarks as keywords in online advertising. Indian courts have recognised that:

- Use of a competitor's trademark as a paid search keyword may amount to infringement where it creates a likelihood of consumer confusion or misleading association.
- At the same time, bona fide comparative advertising is generally permitted under Section 30(1) of the Trade Marks Act, 1999, provided the comparison is truthful, objective, and does not disparage or unfairly exploit another brand's reputation.

# EVOLVING TRADEMARK LANDSCAPE

Trademark law in India is continuously evolving to respond to changing commercial practices, technological advancements, and digital transformation. As branding increasingly moves beyond traditional formats, trademark law is adapting to address new challenges while balancing innovation and consumer protection.

## Key Trends

- **Protection of Non-Traditional Marks**: With the growing importance of sensory and experiential branding, there is increased focus on non-traditional trademarks such as sound, motion, colour combinations, and, in principle, smell marks. Although statutory recognition exists, practical hurdles, particularly relating to graphical representation and distinctiveness, continue to shape prosecution and enforcement strategies.

- **AI-Generated Branding:** Artificial Intelligence is playing an expanding role in brand creation, including automated logo design, naming tools, and marketing content. These developments raise complex questions around authorship, ownership, originality, and accountability, particularly where AI-generated elements are sought to be protected as trademarks.

- **Social Media Misuse and Digital Infringement:** The rise of influencer marketing, social media commerce, and digital advertising has led to increased misuse of trademarks through hashtags, usernames, sponsored content, and meta-tags. Enforcing trademark rights in fast-moving digital environments remains a key challenge, requiring agile legal and technological responses.

- **Domain Name Disputes:** Conflicts between trademarks and domain names continue to grow, particularly with the expansion of e-commerce and online marketplaces. Cybersquatting, misleading domain registrations, etc., pose persistent risks to brand owners and require consistent enforcement.

## Going Forward

The trademark prosecution and enforcement landscape in India has undergone a significant transformation in recent years, driven by governmental initiatives to streamline registration processes, digitise registry functions, and reduce pendency. Judicial developments and administrative reforms have collectively made trademark protection more accessible, efficient, and enforcement-oriented.

The exponential growth of e-commerce platforms and online marketplaces has introduced new complexities, especially in domain name disputes and digital misuse of trademarks. Indian courts have responded proactively, with recent decisions reaffirming that the unauthorised use of trademarks as domain names, particularly where it creates confusion or exploits goodwill, is unlawful.

At the same time, emerging technologies such as Artificial Intelligence and Blockchain are reshaping trademark management practices. AI-powered tools are increasingly used for trademark searches, clearance, monitoring, and enforcement analytics, enhancing accuracy and efficiency. Blockchain-based solutions, particularly for anti-counterfeiting and supply chain authentication, offer promising mechanisms to protect trademarks and verify product authenticity.

While legislative adaptation to these technologies is still evolving, their integration into trademark strategy and enforcement frameworks holds considerable potential. As India continues to position itself as a global hub for innovation, startups, and digital commerce, a robust, agile, and future-ready trademark system will be essential.

# Offerings by LexOrbis

## 1 Trademark Advisory & Strategy

- Trademark selection and adoption strategy
- Brand structuring and portfolio development
- Risk assessment and clearance opinions
- Distinctiveness and registrability analysis
- Multi class and multi jurisdiction filing strategy
- Trademark audits and gap analysis

## 2 Trademark Search & Clearance

- Preliminary (knockout) searches
- Comprehensive clearance searches (identical, phonetic, conceptual, and visual similarity)
- Common law and market use searches
- Domain name and social media handle availability checks
- Written search opinions and risk based recommendations

## 3 Trademark Prosecution & Registration

- Filing of trademark applications (India and Madrid Protocol applications)
- Filing on "proposed to be used" and prior use basis
- Examination response drafting and prosecution strategy
- Show cause hearing representation before the Trade Marks Registry
- Trademark Journal monitoring and follow up

## 4 Trademark Opposition & Cancellation

- Pre publication watch services
- Filing and defending trademark oppositions
- Drafting notices of opposition and counterstatements
- Evidence preparation and affidavit drafting
- Hearing representation before the Trade Marks Registry
- Trademark cancellation and rectification proceedings
- Non use cancellation actions

## 5 Trademark Enforcement & Litigation

- Infringement and passing off analysis
- Civil enforcement actions (injunctions, damages, accounts)
- Criminal enforcement and anti counterfeiting actions
- Police raids and seizure coordination
- Cease and desist notices and settlement negotiations
- Representation before District Courts and High Courts
- Appellate proceedings and Supreme Court matters

## 6 Domain Names & Online Enforcement

- Domain name disputes (INDRP, UDRP, URS)
- Cybersquatting and typosquatting actions
- Social media takedown actions
- E commerce platform enforcement
- Online brand monitoring and misuse tracking

## 7 Border Measures & Anti Counterfeiting

- Customs recordal under IPR (Imported Goods) Enforcement Rules
- Border seizure and detention actions
- Anti counterfeiting strategy and execution
- Supply chain brand protection advisory
- Training programmes for customs and enforcement agencies

## 8 Trade Dress & Unconventional Marks

- Trade dress protection strategy
- Packaging, get up, colour combination protection
- Shape mark advisory and enforcement
- Design vs trademark overlap analysis
- Passing off actions for trade dress

## 9 Trademark Licensing & Commercialisation

- Trademark assignment and licence advisory
- Drafting and negotiation of assignment agreements
- Drafting trademark licence and franchise agreements
- Registered user applications and recordals
- Trademark valuation and due diligence support

## 10 Trademark Renewal & Portfolio Management

- Renewal and restoration of trademarks
- Deadline and docket management
- Ownership change and recordal services
- Portfolio maintenance and optimisation
- Global renewal coordination

## 11 Due Diligence & Transactions

- Trademark due diligence for M&A, investments, and joint ventures
- Title and chain of ownership verification
- Risk assessment and transaction support
- IP asset structuring and integration

## 12 IP Training & Brand Governance

- In house training programmes
- Brand usage guidelines and policies
- ESG and sustainability branding advisory
- Compliance and governance frameworks

## WHY CHOOSE LEXORBIS

With a strong physical presence across India and a global reach spanning more than 138 jurisdictions, LexOrbis is strategically positioned to serve the evolving needs of its clients. Our offices are fully equipped to deliver the complete spectrum of intellectual property services and allied legal solutions, enabling seamless coordination, consistent quality, and efficient execution across diverse industries and international jurisdictions.

LexOrbis Intellectual Property Attorneys & Advocates

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