

# Guide on Trademark Laws and Regulations in India

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**A** trademark serves as a distinct identifier for a company, its products, or services, distinguishing them from competitors. This can encompass words, signs, symbols, graphics, or a blend of these elements. Examples include Louis Vuitton's Damier Pattern, Cadbury's trademarked purple color, and Coca-Cola's unique bottle design. Trademarks are crucial assets, offering legal protection against unauthorized use and aiding consumers in associating specific qualities with a brand.

Trademarks can take various forms, such as word marks (e.g., COCO CHANEL), device marks (e.g., Amazon's distinctive lettering), figurative marks/logos (e.g., McDonald's Yellow M or Nike's Swoosh), service marks (e.g., UNITED AIRLINES), collective marks (used by a group of companies), certification marks (indicating adherence to standards, like ISI or FSSAI), well-known marks (easily recognized by a large population, e.g., Rolex), and unconventional trademarks (those with distinctive features).

In India, the **Trade Marks Act, 1999** governs trademarks, addressing aspects like registration, protection, and relief in cases of infringement. The Act aligns with international agreements such as the Paris Convention and the TRIPS agreement. Trademarks are invaluable for safeguarding a brand's reputation and preventing counterfeiting. While registration isn't mandatory, it enhances protection, providing a legal basis for recourse if another entity attempts to use a similar mark. In India, the law affirms private rights, and enforcement involves legal remedies through court orders.



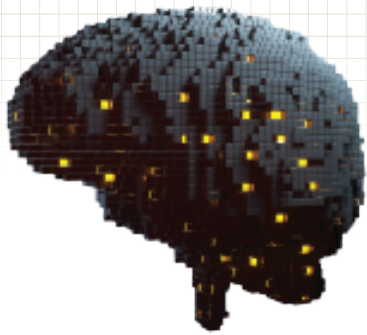
### Registration

Upon filing a trademark application, the registry issues an official receipt containing the filing date and application number. Subsequently, the Indian Trademarks Office examines the application to ensure compliance with the Trademarks Act. If any objections to registration arise, the registry issues an examination report to the applicant. The applicant is then required to submit a written response or provide evidence of acquired distinctiveness, followed by a hearing with the examiner.

If, after examination and the hearing, the registrar deems the trademark eligible, a Letter of Acceptance is issued to the applicant. Following this, the trademark is published in the Trademark Journal, opening a 4-month window for potential opposition. If no objections are raised during this period, a certificate is issued. In cases of opposition, both parties are given opportunities to present their arguments.

The trademark registration process is often time-consuming, typically taking around 18-24 months for completion in cases without objections or oppositions. Once registered, a trademark remains valid for 10 years from the date of application. Renewal is possible indefinitely, contingent on the payment of renewal fees every 10 years.

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*"Security is always excessive until it's not enough."  
- Robbie Sinclair*

### **Descriptive trademark**

A descriptive trademark is a term that signifies the characteristics of the product or service it represents, functioning akin to an adjective. For instance, the term "DEEP BOWL" would be considered a descriptive trademark if used to describe a spoon with a deep bowl for scooping. Other examples include "KOLD AND KREAMY" for ice cream, "CHOCO TREAT" for chocolates and chocolate-based confectionery, and "AERO GEAR" for skydiving suits, tools, and equipment.

A mark is deemed descriptive when, in its common usage, it reasonably indicates the nature of the associated product. The requirement for descriptiveness is met if the information provided gives a general sense of the product's character, and it is not necessary for the words to offer a precise or exhaustive description. The interpretation of a descriptive mark depends on the meaning most likely to be understood by the public.

To assess whether a mark directly refers to the character and quality of goods, it is crucial to consider how the word is perceived by the target audience, rather than adhering strictly to grammatical rules. Proving descriptiveness involves demonstrating that the word, taken as a whole, is descriptive and cannot be dissected into fragments to render it objectionable. The connection between the mark and the goods it represents is a key factor in evaluating its descriptiveness. Additionally, it is essential to understand what the mark would convey to the average consumer of those goods and how they would react mentally to the mark.

### **Direct Reference**

A word that has only an indirect reference to the character and quality of goods is generally not considered descriptive. The crux of the issue regarding the eligibility of a word for trademark registration lies in its direct reference to the character and quality of goods.

A word that is merely suggestive in relation to the goods is not objectionable as a trademark. The analysis of direct reference versus suggestive nature considers the public's perception rather than a strict grammatical interpretation.

### **No Monopoly in Descriptive words**

Descriptive words, particularly those that directly name or describe goods, are generally not eligible for trademark protection or monopoly, as emphasized by legal principles and Lord Herschell's Committee in the UK. The committee asserted that words of description belong to the public domain, and it would be unjust for any individual to monopolize and exclude others from using them. Registration under Section 9(1)

According to the law, registration of descriptive marks is typically not allowed under section 9(1) of the Trademarks Act in regular circumstances. However, courts have recognized exceptional cases where descriptive marks may be registered. If a mark is inherently descriptive but, due to prolonged use in trade, has lost its primary descriptive meaning and gained distinctiveness in relation to the associated goods, it may be considered for registration. Examples include trademarks like INTERNATIONAL BUSINESS MACHINE (IBM) for computers, SHARP for televisions, and GLUCON-D for a revitalizing beverage.

### **Acquired distinctiveness**

Each trademark serves as a unique identifier for the goods it represents, indicating their origin from a specific source. Over time, a trademark tends to solidify its association with a particular product and its source in the minds of consumers. Some trademarks are inherently distinctive from the start, possessing inherent characteristics that warrant immediate legal protection upon their use as trademarks. In contrast, certain marks acquire protection through the development of a secondary meaning over time.

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*"The only security lies in individual personal honesty,  
the law cannot make people honest."*

*– Albert E. Bowen*



Consequently, there exists a connection between the "strength" of a trademark and the establishment of a "secondary meaning." For a non-inherently distinctive mark to qualify as a trademark, it must possess a certain degree of strength or have acquired a secondary meaning.

The Trademarks Act of 1999 indirectly addresses the concept of 'acquired distinctiveness' or 'secondary meaning' through the proviso in Section 9(1) and Section 32. The Act explicitly prohibits the registration of descriptive trademarks under Section 9(1)(b). However, the proviso to Section 9(1) states that a trademark shall not be refused registration if, before the application date, it has gained a distinctive character through use or is already a well-known trademark.

Additionally, Section 32 stipulates that if a trademark is registered in violation of Section 9(1), it will not be invalidated if, after registration and before the commencement of legal proceedings challenging its validity, it has acquired a distinctive character in relation to the registered goods or services.

Unlike the United States and other countries with established principles, the Indian Trademarks Act does not explicitly outline factors for assessing whether a mark has 'acquired distinctiveness' or 'secondary meaning.' In India, the courts and the Intellectual Property Appellate Board (IPAB) have played a crucial role in establishing principles for determining acquired distinctiveness.

Mere use of a mark does not automatically confer distinctiveness, and increased use alone is insufficient. The use and increased use must be in a distinctive sense to have any significance. It is essential to assess the meaning and significance a sign holds on a specific date. Moreover, the scope of usage extends beyond consumers to include others involved in the trade, such as manufacturers, wholesalers, and retailers.

### **Conclusion**

The implementation of the new Intellectual Property Rights Policy and the adoption of the Madrid Protocol have facilitated the submission of international trademark registration applications in India. The Indian judiciary's inclination to extend protection to globally recognized trademarks is favorable for international brands looking to tap into the extensive consumer base in the country. The streamlined e-filing system in India significantly reduces paperwork at trademark registry offices. Moreover, offline documents are being digitized and updated in real-time. To enhance efficiency, trademark registration offices in India have bolstered their workforce through increased recruitment and invested in human resources and technical training programs to ensure examiners are proficient in reviewing international filings. Indian law's provision for parallel civil and criminal proceedings against trademark violators underscores a comprehensive approach to trademark protection, covering various aspects of infringement



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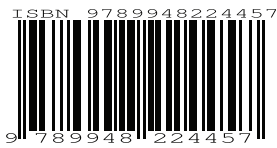
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