

All Things IP



Submitted by

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Are you aware of the essential criteria for branding your product or services in order to avoid common pitfalls while registering your trademarks with the Indian Trademarks Registry? In the current scenario, despite investing enormous time and money on the brand name, many trademarks are being either refused by the Trademarks Registry (“TMR”) or opposed by third parties, on the grounds of such trademark either being non-distinctive (absolute grounds) and/or its similarity with earlier existing trademarks on records (relative grounds). The above referred absolute grounds and relative grounds are laid down under the provisions of Sections 9 and 11 of the Trademark Act, respectively. However, such objections and oppositions can be avoided to an extent by considering certain essential criteria while branding your products and services. Following are some of the basic factors to be kept in mind while strategizing and adopting your trademarks:

1. A Trademark must be distinctive in nature and should be capable of being distinguished from the products or services of another person. For example - “ABC”, “1”, “ZE”, “Rose”, “John” etc.,. are non-distinctive in nature and lack intrinsic trademark value by their very nature hence do not qualify to be a good trademark.
2. A Trademark must be coined in such a way that it does not describe its kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the products or rendering of the service or other characteristics of the products or service. E.g:- trademarks containing the words like “Software”, “Calcium”, “Big”, “Strong”, “Healthy”, “Chennai” etc.,
3. A trademark should not be customary in the current language or in the bona fide and established practices of the trade. E.g:- trademarks containing the words like “IT” (which is the acronym of “Information Technology”, “Vitamins”, “Technology” etc.,.

However, there are exceptions to the aforesaid grounds of refusal, viz., a. if you have been using your trademark for a substantial period of time and adequate documents can be adduced before the TMR to prove its continuous usage and the distinctiveness; or, b. where the mark has acquired a well-known status among the public, in which case the Registrar may use his discretion, to accept and allow the application for further process to registration.

It is important to note that in addition to the aforementioned criteria, while branding the products or services, one has to necessarily probe whether any third party has already adopted or has been using a trademark identical or deceptively similar to the newly trademark proposed to be adopted by conducting a search on the online records of the TMR. This preliminary scrutiny is necessary in order to avoid the objections from the TMR under relative grounds of refusal, and also oppositions, rectifications and other legal proceedings from the third party having rights over identical or similar trademarks.

While branding the products and services, one has to bear in mind the above points that will help in the trademark sail through the trademark registration process without any hassle and also to avoid legal action initiated by third parties. For more information please contact saisunder@eshwars.com.

