

# All Things IP



**Eshwars | House of Corporate & IPR Laws**

4, Aishwarya, 12B/177, 6th Street, Kumaran Colony,  
Vadapalani, Chennai - 600026, India T +91-44-4204 8335 | F +91-44-4204 8235

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### **Absolutely not possible..? Prohibition on use of certain emblems and names as Trademarks under the Indian Trademarks Act, 1999- A brief analysis**

Branding of products or services, more often than not is an exercise that involves factors to be considered not only from a business perspective but also from a legal perspective. While a brand owner may be convinced that a particular trademark or trade name aptly describes their products and businesses but such brands may not necessarily be considered to be a good trademark from a legal perspective while going in for a trademark registration as they may fall within the ambit of statutory prohibitions prescribed under law. Accordingly, brand owner need to be cautious while considering a particular Trademark or trade name for their businesses in order to ensure that the said brand does face any impediment during the registration process. Under the Indian Trademarks Act, 1999 a trademark can be refused registration under two grounds- (a) Absolute Grounds and (b) Relative Grounds. Absolute grounds for registration involves grounds such as a trademark lacking any distinctiveness, or where a trademark contains words that is used in the trade to designate kind, quality or intended purpose or where such trademarks contain elements that are customary in the current language pertaining to the trade in which they are being used or where a trademark contains elements that are scandalous or obscene and likely to hurt the religious feelings etc. Relative Grounds for refusal primarily and inter-alia applies to trademarks that contain elements that are deceptively similar or identical to an existing earlier trademark thereby enhancing the chances of confusion.

In this article, we briefly discuss about a specific aspect of Absolute Ground for refusal viz., use of a trademark which is prohibited under “The Emblems and Names (Prevention of Improper Use) Act, 1950” (‘Act’). Though this ground is not very often invoked during the trademark registration process, but given the fact that it has been statutorily prescribed as an absolute ground for refusal it is important that we understand the basics precautions that brand owners need to exercise while choosing a brand in the light of this absolute grounds for refusal.

The Act was brought into force by the Parliament with an objective to prohibit improper use of certain emblems and names as prescribed or notified thereunder for professional and commercial purposes. This enactment is applicable to the whole of India as well as the citizens outside India.

The Act prohibits a person from using any name or emblem or any of its deceptive imitation, as specified in the Schedule, forming part of the Act, for the purpose of any trade, business, calling or profession, in the title of any patent, or in any trade mark or design, without the previous permission of the Central Government.



PC: WHO



As per the Act, Emblem means any emblem, seal, flag, insignia, coat-of-arms or pictorial representation as specified in the Schedule and the “Name” includes any abbreviation of a name. The Act can be accessed at: <https://indiacode.nic.in/bitstream/123456789/1896/1/A1950-12.pdf>.



PC: IP India Portal

The Act further casts the onus on a Competent Authority viz., the Controller General of Patents, Design and Trademark under the law for the registration of trademark, design or grant of Patent, to not allow such registrations if the use of such name or emblem is in contravention of section 3 of The Emblems and Names (Prevention of Improper Use) Act, 1950. Any person who contravenes the provisions of Section 3 of The Emblems and Names (Prevention of Improper Use) Act, 1950 shall be punishable with fine. For example: World Health Organisation, Indian Institute of ....., UNO, RTO, WHO, Indian National Flag, pictorial representation of Rashtrapathi Bhavan cannot be registered without the consent of the Central Government and respective authority. Hence, this is the reason the said aspect has been statutorily prescribed as an Absolute Ground for refusal of Trademark Registration under Section 9(2)(d) of the Trademarks Act, 1999 and the Registrar of Trademarks shall raise an objection under the absolute grounds for refusal of registration if the trademark applied for is prohibited under the Act.

At Eshwars we have recently advised a premier technical education institution in India of national significance, which is a statutory body recognised by an act of the Indian Parliament on questions involving Trademarks vis-à-vis the Emblems and Names (Prevention of Improper Use) Act, 1950 and the remedies available to it against an infringer who had adopted a trademark that potentially tantamount to a violation under The Emblems and Names (Prevention of Improper Use) Act, 1950.

We at Eshwars assist the IP owners across the world in registering and also for safeguarding their trademarks, patents, copyrights and designs. For more details, please send an email to [saisunder@eshwars.com](mailto:saisunder@eshwars.com).