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TRADEMARK REGISTRATION

COMPLETE PROCEDURE UNDER THE TRADE
MARKS ACT, 1999



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A trademark is among the most commercially significant assets a business can possess. It is the sign by which consumers identify the source of goods or services, the vessel that carries a brand's reputation and the legal instrument through which that reputation is defended. In India, the law governing the registration and protection of trademarks is codified in the Trade Marks Act, 1999, which came into force on 15 September 2003, replacing the earlier Trade and Merchandise Marks Act, 1958. The 1999 Act represents a comprehensive modernization of Indian trademark law, bringing it into conformity with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) and aligning domestic practice with international standards.

Registration of a trademark under the 1999 Act confers upon the proprietor an exclusive statutory right to use the mark in relation to the goods or services for which it is registered. While common law rights in an unregistered mark may arise from use and goodwill, those rights are territorially limited, difficult to enforce and dependent on establishing reputation through litigation. A registered trademark, by contrast, is presumptive evidence of validity, enables the proprietor to sue for infringement without proving reputation and provides nationwide protection. The economic logic of registration is compelling and the procedural pathway though technical is navigable with a clear understanding of the statute and the practice it generates.

This article sets out the complete procedure for trademark registration in India under the Trade Marks Act, 1999, from the preliminary search to the issuance of the registration certificate, with attention to the legal standards at each stage, the administrative machinery that applies them and the judicial decisions that have shaped their interpretation.

INTRODUCTION



LEGAL FRAMEWORK

The Trade Marks Act, 1999 is the primary legislation governing trademark registration, protection and enforcement in India. It is supplemented by the Trade Marks Rules, 2017, which consolidate and update the procedural framework originally contained in the 2002 Rules. The Trade Marks Registry, which functions under the Office of the Controller General of Patents, Designs and Trade Marks within the Department for Promotion of Industry and Internal Trade, is the administrative body responsible for examination, registration and post-registration administration.

The Registry operates from its headquarters in Mumbai, with branch offices in Ahmedabad, Chennai, Delhi and Kolkata. Applications may be filed at the office having territorial jurisdiction over the state in which the applicant's principal place of business is situated or in the Delhi office where the applicant has no place of business in India.

The 1999 Act recognises trademarks in a wide range of forms. Section 2(1)(zb) defines a trademark as a mark capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others. A mark, under Section 2(1)(m), includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. The Act thus encompasses not only traditional word and logo marks but also shape marks, colour marks, sound marks and, following the 2017 Rules, three-dimensional marks and other non-conventional forms.



STEP 1 - PRELIMINARY TRADEMARK SEARCH

The registration process, in practice, begins before any formal application is filed. A preliminary search of the trademark register is an essential pre-filing step that no prudent applicant should omit. Its purpose is to identify existing registrations or pending applications that are identical or deceptively similar to the proposed mark and thereby assess the likelihood of a successful registration.

The search is conducted through the Trade Marks Registry's publicly accessible online database at ipindiaonline.gov.in. The search tool allows applicants to query the register by word mark, device, proprietor name, application number or class. A thorough search should cover not only the exact mark but also phonetic equivalents, visual similarities and transliterations across scripts.

The significance of the preliminary search is both strategic and legal. If the register already contains a mark that is identical or deceptively similar to the proposed mark in the same class of goods or services, the application is likely to face objection under Section 11 of the Act. Section 11(1) provides that a trademark shall not be registered if it is identical with or similar to an earlier trademark and the goods or services are identical or similar to those of the earlier mark, where there exists a likelihood of confusion on the part of the public. The likelihood of confusion inquiry under Section 11 is the central battleground of trademark examination and a preliminary search maps that terrain before the investment of filing fees and legal costs



STEP 2 - CLASSIFICATION OF GOODS AND SERVICES

India follows the Nice Classification, an international system that organizes goods and services into 45 classes – Classes 1 to 34 covering goods and Classes 35 to 45 covering services. Every trademark application must specify the class or classes in which registration is sought and the protection conferred by registration is limited to the goods or services within those classes.

The selection of the correct class is a matter requiring careful analysis of the nature of the applicant's business. Class 25 covers clothing, footwear and headgear. Class 42 covers scientific and technological services. Class 5 covers pharmaceuticals and medical preparations. An applicant registering a mark for a food product would file in Class 30 or Class 29 depending on the specific goods, while an applicant in the software services sector might file in Class 42. Multi-class applications, which cover goods or services in several classes within a single application, are permitted under the 2017 Rules and are often the economical choice for applicants seeking broad protection.

Misclassification of goods or services can narrow the scope of registered rights in ways that are difficult to correct after the fact. Courts and the Registry have consistently held that the goods specification defines the ambit of protection and a proprietor cannot rely on a registration to restrain use of a similar mark in relation to goods outside the registered class unless dilution or unfair advantage can be established.



STEP 3 - FILING THE APPLICATION

An application for trademark registration is filed using Form TM-A, prescribed under Schedule I to the Trade Marks Rules, 2017. The application must be accompanied by the prescribed fee, which varies depending on the nature of the applicant and the mode of filing. As of the current fee schedule, an individual, startup or small enterprise filing electronically pays a reduced fee of ₹4,500 per class, while other applicants pay ₹9,000 per class for e-filing. Physical filing attracts higher fees and has become uncommon given the Registry's emphasis on electronic processing.

The application must contain: the name and address of the applicant; a representation of the mark; the class or classes of goods or services; a statement of goods or services; the date of first use of the mark in India, if the mark has been in use prior to the application; and, where priority is claimed under the Paris Convention, the details of the convention application. A statement of use or proposed use is required in all cases. Where a mark has been in continuous use prior to the application date, the date of first use must be accurately stated, as this establishes the priority of the mark against competing claims.

Form TM-A replaced multiple earlier forms under the 2017 Rules as part of a simplification of the application process. The application may now be filed online through the e-filing portal of the Trade Marks Registry, which issues an instant acknowledgment with the application number. Physical filing at the Registry is still available but significantly slower in terms of processing.

The applicant may file the application personally or through a registered trademark agent or attorney. Rule 14 of the Trade Marks Rules, 2017 governs authorization of agents and Form TM-M is used to record the power of attorney. Where the applicant is a body corporate or a foreign entity without a principal place of business in India, representation through a registered agent is effectively mandatory for practical purposes.



STEP 4 - EXAMINATION BY THE REGISTRY

Once filed, the application is assigned to an examiner at the Trade Marks Registry for substantive examination. The examination process is governed by Section 9 (absolute grounds for refusal), Section 11 (relative grounds for refusal) and the Manual of Trade Marks Practice and Procedure, which provides administrative guidance to examiners.

Under Section 9, the Registry will refuse an application if the mark is devoid of distinctive character, consists exclusively of marks or indications that designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or services or consists exclusively of marks that have become customary in the current language or established practices of the trade. These are the absolute grounds – they concern the inherent qualities of the mark itself, without reference to other marks on the register.

The concept of distinctiveness is the cornerstone of absolute grounds examination. A mark is distinctive if it is capable of identifying the goods or services of a particular undertaking and distinguishing them from those of other undertakings. Invented words – those with no meaning in any language connected to the goods in question – are inherently distinctive. Words that are descriptive of the goods, by contrast, are prima facie not registrable, though an applicant may overcome this bar by establishing that the mark has acquired distinctiveness through extensive and long-standing use – what the statute, in the proviso to Section 9(1), calls acquired distinctiveness or secondary meaning.

The Delhi High Court addressed the acquisition of secondary meaning in the context of descriptive marks in *Godfrey Phillips India Ltd. v. Girnar Food & Beverages (P) Ltd.* (2004), where the court examined the extent to which a descriptive mark could acquire distinctiveness through use sufficient to merit trademark protection. The principle that flows from this and analogous decisions is that evidence of long, continuous and exclusive use of a mark, supported by evidence of market recognition, can cure an initial deficiency in inherent distinctiveness.



Under Section 11, the examiner assesses the relative grounds – whether the mark conflicts with earlier registrations or applications. The likelihood of confusion analysis requires comparison of the marks in their totality, assessment of the similarity of the goods or services and consideration of the average consumer's level of attention. The Supreme Court's decision in Corn Products Refining Co. v. Shangrila Food Products Ltd. (AIR 1960 SC 142) remains the foundational authority on the test for deceptive similarity. The Court held that the question is whether the marks are likely to be confused by a person of average intelligence and imperfect recollection – not a meticulous comparison of the two marks side by side, but an assessment of the overall impression each leaves on the relevant consumer.

The Supreme Court elaborated further on the test in Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. (2001 PTC 300 SC), where it emphasised that in cases involving pharmaceutical products, a stricter standard of similarity should apply, given the potential for consumer confusion to have serious health consequences. This decision has had a lasting influence on the examination of marks in Class 5 and related classes.

Following examination, the Registry issues an Examination Report setting out any objections. The applicant must respond to the Examination Report within 30 days of its issuance, though extension may be sought. Where the examiner raises objections on absolute or relative grounds, the applicant may respond in writing or seek a hearing before the Assistant Registrar or Deputy Registrar to present arguments in person.



STEP 5 - HEARING BEFORE THE REGISTRY

Where the examiner's objections are not resolved by the written response, the applicant may request a hearing. The hearing provides the applicant with an opportunity to present oral arguments, file additional evidence of use or distinctiveness and address the examiner's concerns directly. Hearings before the Registry are relatively informal compared to court proceedings but require careful preparation, particularly where complex issues of likelihood of confusion or acquired distinctiveness are involved.

Evidence of use may be submitted in the form of affidavits, invoices, advertisements, sales figures and other documentation demonstrating the extent of the mark's use in the market. Where the objection is on relative grounds due to a conflicting earlier mark, the applicant may seek the earlier mark's proprietor's consent and a letter of consent or a coexistence agreement may be filed to resolve the conflict.

Following the hearing, the examiner issues an order either accepting the application for advertisement or maintaining the refusal. A refused application may be appealed to the Intellectual Property Appellate Board (IPAB), though the IPAB has since been abolished by the Tribunals Reforms Act, 2021 and its jurisdiction has been transferred to the High Courts. Appeals against Registry decisions now lie before the High Court having jurisdiction over the relevant Registry office.



STEP 6 - ADVERTISEMENT IN THE TRADE MARKS JOURNAL

Upon acceptance, the application is advertised in the Trade Marks Journal, an official publication of the Trade Marks Registry available at ipindia.gov.in. Advertisement serves the function of putting the public – particularly competing traders and existing proprietors – on notice of the pending registration and inviting any oppositions. Section 20 of the Trade Marks Act, 1999 governs publication and the advertisement triggers a mandatory opposition window of four months from the date of advertisement, as provided under Rule 45 of the Trade Marks Rules, 2017. During this period, any person may file a notice of opposition to the registration of the mark.

STEP 7 - OPPOSITION PROCEEDINGS

Opposition proceedings are one of the most significant and contested stages of the trademark registration process. Any person – not merely an interested party or a prior registrant has standing to oppose registration. This broad standing reflects the public interest dimension of trademark protection: a monopoly over a mark in commercial use has consequences beyond the immediate parties.

A notice of opposition is filed using Form TM-O, accompanied by the prescribed fee of ₹2,700 for e-filing per class for individuals, startups and small enterprises and ₹5,400 for other applicants.



The notice must set out the grounds of opposition, which may include any of the grounds for refusal under Sections 9 and 11, the ground that the mark is not capable of distinguishing the opponent's goods or services or specific grounds such as the mark being identical or deceptively similar to the opponent's registered or unregistered mark. Upon receipt of the notice of opposition, the Registry serves it on the applicant, who must file a counter-statement using Form TM-O within two months. Failure to file a counter-statement results in the application being deemed abandoned. Where a counter-statement is filed, both parties are afforded the opportunity to file evidence by way of affidavit and to cross-examine the other party's witnesses. Following the close of evidence, a hearing is convened before the Registrar, who issues an order either dismissing the opposition or upholding it and refusing the application.

The opposition procedure has generated a rich body of jurisprudence. In *Himalaya Drug Company v. S.B.L. Limited* (2012), the Delhi High Court examined the standard for assessing deceptive similarity in the context of pharmaceutical marks and underscored the importance of the visual, phonetic and conceptual dimensions of similarity analysis. The court reaffirmed that confusion in the mind of a consumer of average intelligence not a side-by-side comparison by a trademark expert – is the operative standard.

In *S.M. Dyechem Ltd. v. Cadbury (India) Ltd.* (2000 PTC 297 SC), the Supreme Court addressed the weight to be given to the overall impression of composite marks, holding that where a trademark consists of several elements, the comparison must take into account the mark as a whole and not merely its component parts. This decision has informed the examination and opposition practice for device marks and logo marks where word and figurative elements are combined.



STEP 8 - REGISTRATION AND ISSUANCE OF CERTIFICATE

Where no opposition is filed within the four-month opposition window or where any opposition filed is dismissed, the mark proceeds to registration. The Registrar enters the mark in the Register of Trade Marks and issues a certificate of registration bearing the registration number, the date of registration and the class or classes covered. Registration is effective from the date of filing of the application, not the date of issuance of the certificate. This backdating is commercially significant, as it means the proprietor's rights as against third parties who have used the mark after the application date are treated as if the mark had been registered since filing. registered trademark in India is valid for a period of ten years from the date of registration, as provided under Section 25 of the Act. The registration is renewable indefinitely for successive ten-year periods upon payment of the renewal fee, using Form TM-R. A mark that lapses due to non-renewal may be restored within one year of expiry upon payment of a surcharge.

Section 28 of the Act grants the registered proprietor the exclusive right to use the mark in relation to the goods or services in respect of which it is registered. Section 29 sets out the acts that constitute infringement, including use of an identical or deceptively similar mark in the course of trade in relation to the same or similar goods or services. The proprietor of a registered mark may institute a suit for infringement in the District Court or High Court having jurisdiction over the place where the proprietor carries on business or where the cause of action arises.



THE SIGNIFICANCE OF WELL-KNOWN TRADEMARKS

Section 2(1)(zg) of the Trade Marks Act, 1999 defines a well-known trademark as a mark that has become so well-known to a substantial segment of the public that use of that mark in relation to other goods or services would indicate a connection with the registered owner. Section 11(6) to (9) and Section 11(10) provide enhanced protection to well-known marks, including protection across classes – meaning that a well-known mark may be cited against applications in entirely unrelated goods or services if use of the later mark would take unfair advantage of or be detrimental to the distinctive character or repute of the well-known mark.

The Trade Marks Registry may, upon application using Form TM-M with appropriate evidence, declare a mark to be well-known and include it in a list maintained by the Registry. This declaration provides administrative evidence of well-known status, though courts have always had the power to independently determine well-known status in the course of infringement or opposition proceedings.

The Delhi High Court's decision in *Tata Sons Ltd. v. Manoj Dodia & Ors.* (2011) is instructive on the standard for well-known status. The court held that the reputation of the TATA mark extended across industries and sectors to a degree that warranted protection against use in any class of goods or services and that registration or use of a similar mark by a third party would constitute an attempt to ride on the established goodwill of a well-known name.



PASSING OFF
AND THE
RELATIONSHIP
BETWEEN
REGISTERED AND
UNREGISTERED
RIGHTS

While this article is principally concerned with registered trademark rights, the relationship between registration and common law passing off merits brief attention. Section 27(2) of the Trade Marks Act, 1999 expressly preserves the right to bring an action for passing off based on the use of an unregistered mark. An unregistered mark may thus be enforced through a passing off action, provided the proprietor can establish use, goodwill and likelihood of deception – the classic Trinity enunciated by the House of Lords in *Reckitt & Colman Products Ltd. v. Borden Inc.* (the Jif Lemon case) and applied consistently by Indian courts.

The Supreme Court's decision in *Laxmikant V. Patel v. Chetanbhai Shah & Anr.* (2002) is the leading Indian authority on passing off, confirming that an action will lie where a trader adopts a mark that is similar to another's mark already in use, causing confusion and deception in the minds of potential customers. The court emphasised that even a very short period of use can generate protectable goodwill where the mark has achieved recognition in the relevant market.

Registration under the 1999 Act does not extinguish common law rights in a senior unregistered mark. A proprietor of a senior unregistered mark may oppose a junior registration and may, in appropriate circumstances, successfully challenge a registered mark on the basis of prior use and passing off principles, particularly where the registered proprietor has acted in bad faith.



INTERNATIONAL REGISTRATION – THE MADRID SYSTEM

Indian trademark proprietors seeking international protection have access to the Madrid System for the International Registration of Marks, administered by the World Intellectual Property Organization. India acceded to the Madrid Protocol with effect from July 2013, enabling Indian applicants to file a single international application designating multiple member countries through the Trade Marks Registry acting as the Office of Origin.

An international application under the Madrid System is based on a home application or registration and must designate at least one contracting party other than the country of origin. The application is examined by WIPO for compliance with formal requirements, transmitted to the Trade Marks Registries of the designated countries for substantive examination and if successful, results in an international registration that provides protection in each designated country.

The Madrid System offers significant procedural and cost efficiencies for applicants seeking protection in multiple jurisdictions. It replaces the need for separate national applications in each country, with a single filing, a single set of fees (in Swiss francs) and centralized administration of renewals and subsequent designations. However, an international registration remains dependent on the home application or registration for its first five years – what is known as central attack – and any cancellation or withdrawal of the base application during that period results in the cancellation of the international registration.



Trademark registration under the Trade Marks Act, 1999 is a structured, multi-stage process that moves from preliminary search through examination, advertisement, opposition and ultimately registration. Each stage carries its own legal standards, procedural requirements and strategic considerations. The Act provides a robust framework for the protection of brand identity, reflecting India's commitment under TRIPS to a comprehensive intellectual property regime.

The judicial decisions of the Supreme Court and the High Courts have given substance to the statutory framework, calibrating the tests for distinctiveness, deceptive similarity and well-known status in a manner that reflects both commercial realities and the public interest in preserving competition. Cases such as Corn Products, Cadila, Himalaya Drug, Tata Sons and Laxmikant Patel together form the doctrinal infrastructure on which examination and enforcement practice rests.

For businesses operating in India whether established enterprises, startups or foreign entities seeking market entry proactive trademark registration is not merely a legal formality. It is a foundational element of brand strategy, providing the exclusive rights, legal presumptions and enforcement tools without which a brand's commercial value cannot be fully protected. The investment in registration, made early and maintained through timely renewals, is invariably justified by the protections it affords and the disputes it prevents.

CONCLUSION



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