



The Trademark Prosecution Review

2025

**India: Practical application of
legislation to enhance dispute
resolution efficiency**

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The second edition of the *WTR Trademark Prosecution Review* takes a wide-ranging view of best strategies for securing trademarks in the key regions of the Americas, the Asia-Pacific, and Europe, the Middle East and Africa. The review combines on-the-ground knowledge and analytic insight to offer an unparalleled deep dive into the prosecution landscape in specific key markets.

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India: Practical application of legislation to enhance dispute resolution efficiency

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IN SUMMARY

This comprehensive study delves into the realm of trademark protection and enforcement in India, with the Trade Marks Act 1999 serving as the governing legislation for registration and enforcement. It explores the safeguarding of both registered and unregistered marks, the criteria for registration, enforcement mechanisms and recent developments. The analysis delves into the registration process, non-traditional trademark registration, trade dress protection, opposition proceedings, changes in ownership, cancellation and rectification, enforcement remedies, passing off for unregistered marks and recent initiatives.

DISCUSSION POINTS

- Trademark protection in India
 - Criteria for trademark registration and registration process
 - Non-traditional trademark registration
 - Trade dress protection
 - Trademark ownership changes and transfers
 - Trademark cancellation or rectification
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REFERENCED IN THIS ARTICLE

- Trade Marks Act 1999
 - Trade Marks Rules 2017
 - Emblems and Names (Prevention of Improper Use) Act 1950
 - Intellectual Property Rights (Imported Goods) Enforcement Rules 2007
 - Bharatiya Nyaya Sanhita 2023
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TRADEMARK PROTECTION IN INDIA

India's intellectual property regime is governed by the Trade Marks Act 1999 and the Trade Marks Rules 2017, which provide a comprehensive mechanism for the registration and enforcement of trademark rights in India. The Indian trademark regime extends protection to both registered and unregistered marks. In the case of misuse of a registered mark, the right holder can initiate an infringement action against the infringing party. On the other hand, for unregistered marks, the right holder can seek protection under the law of passing off. To establish a claim for passing off, the plaintiff must showcase three ingredients: demonstrate established goodwill or reputation of their mark attached to relevant goods or services; prove misrepresentation by the defendant likely to deceive the public; and show damage suffered or likely to be suffered by the plaintiff.

Criteria For Trademark Registration (what Can Be And Cannot Be Registered)

In India, a mark capable of being represented graphically and distinguishing the goods or services of one entity from others can be registered as a trademark.^[1] This includes

various forms, such as devices, brands, headings, labels, tickets, names, signatures, words, letters, numerals, shapes of goods, packaging and a combination of colours.^[2] In India, unconventional trademarks, such as sound and motion marks, can also be registered.

However, certain types of marks cannot be registered in India. The following categories of marks are ineligible for registration:

- marks that lack distinctive character;
- descriptive marks that provide information about the goods or services, such as their quality, quantity or geographical origin, and cannot be registered;
- marks that have become customary in the current language;
- marks that cause confusion and deception;
- marks that are likely to hurt religious sentiments;
- marks that contain obscene or scandalous matter;
- marks that are prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950;
- marks that exclusively consist of the shape of goods resulting from the nature of the goods themselves or those necessary to obtain a technical result or give substantial value to the goods;
- marks identical or similar to earlier marks covering similar or identical goods and services, which may cause confusion and likelihood of association;
- marks identical or similar to well-known marks;
- marks that are prevented by copyright law; and
- marks that are protected by the law of passing off as unregistered trademarks, which cannot be used or registered by other parties as trademarks.^[3]

Trademark Registration Process

The application for trademark registration can be filed either online or offline with the Trade Marks Registry. After fulfilling the required procedural formalities, the application undergoes substantive examination on both absolute and relative grounds for refusal. If objections are raised, the applicant gets one month to respond after receiving the examination report. If the objections are maintained, a hearing is scheduled for presenting oral arguments. If the examiner is satisfied with the response or submissions made during the hearing, the mark is advertised in the Trade Marks Journal, and four months is allowed for third-party opposition. If the application is refused after the hearing, a review petition can be filed within one month of the date of the refusal order, or an appeal can be filed with the concerned high court within three months. If no opposition is filed during the publication period, the mark proceeds towards registration.

Non-traditional Trademark Registration

India also allows the registration of non-traditional trademarks, such as colour marks, motion or animated marks, sound marks and shape marks.

Registration of a combination of colours as a trademark can be applied by submitting a reproduction of the mark in colours with colour codes.

Where a mark contains a shape of the goods or its packaging or is a three-dimensional mark, the reproduction of the mark must contain different views of such trademark and a description of the nature of the mark in words. If the representation of the trademark provided by the applicant does not show all the features of the trademark clearly, the registrar may require up to five further views of the trademark.

For a sound mark, 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 replay with a graphical representation of its notation.

For a motion mark, an appropriate representation of the mark clearly showing the motions must be filed.

Non-traditional trademarks are prosecuted and granted registration in the same manner as traditional trademarks.

Trade Dress Protection

Elements such as packaging design, colour combinations, product shape, texture, graphics and illustrations are collectively known as trade dress. These elements are safeguarded to mitigate misuse by other parties seeking to imitate the product's overall appearance to capitalise on its established goodwill and reputation. Indian trademark law specifically has a provision for trade dress protection, including the shape of goods, packaging and colour combinations. To qualify for protection, the overall appearance of the product must be distinctive, either inherently or through acquired distinctiveness.

Rights holders often face the challenge of selecting the most appropriate IP legislation for safeguarding a particular shape. Generally, if the shape of a product is novel, original and undisclosed to the public, it should be protected through design registration. However, where the right holder has not registered the shape under design law, it may still be protected under trademark law or the common law tort of passing off if it has acquired distinctiveness through prolonged and continuous use. To successfully claim to pass off, the right holder must demonstrate that the specific shape has become distinctive of their goods or services, that customers recognise such shape with its business and that its use by others would confuse the public. Courts in India have recognised that unique packaging design, colour combinations, product shape, etc, are entitled to protection under the Trade Marks Act 1999, and common law rights of the owner remain.

Trademark Ownership Changes And Transfers

Both registered and unregistered marks can be assigned and licensed in India. However, the licence can be recorded for registered marks only, and assignment can be recorded for both kinds. For recording a licence, the parties must file a recordal request within six months of the date of signing the agreement.

Trademarks are valid for 10 years from the application date and must be renewed every 10 years. Trademarks can be restored after six months and within one year of the date of expiration of the previous registration of the mark.

Additionally, it is recommended that the records for the name and address of the proprietor be updated with the Trade Marks Registry.

Trademark Opposition Proceedings

Opposition against a trademark application can be filed on both absolute and relative grounds for refusal. Any individual can file an opposition against a conflicting mark, and these opposition proceedings involve three stages: the pleading stage, the evidence stage and the hearing stage.

- **Pleading stage:** this stage commences with the filing of a notice of opposition, which outlines the grounds on which the opposition is filed against the conflicting mark. The notice of opposition must be submitted within four months of the date of the mark's advertisement in the Trade Marks Journal. This period is non-extendable. Upon receiving the notice of opposition, the applicant of the mark has two months (non-extendable) to file a counterstatement. Failure to submit a counterstatement results in the application being deemed abandoned.
- **Evidence stage:** once the counterstatement is served, the opponent must present evidence supporting their opposition by way of an affidavit within two months of the date of official service of the counterstatement by the Registry. Alternatively, the opponent can inform the registrar that they do not wish to provide any evidence and submit a letter relying on the contents of the notice of opposition. Subsequently, upon receiving the opponent's evidence, the applicant has two months to present their evidence in support of the application or submit a similar reliance letter, relying on the statements made in their counterstatement. Failure of this step by either the opponent or the applicant results in the opposition or application being deemed abandoned, respectively. Once evidence is received in support of the application, the opponent has one month to file evidence in reply, which is not mandatory.
- **Hearing stage:** after the completion of the evidence stage, the registrar schedules a hearing on the merits and adjudicates either allowing or dismissing the opposition.

Trademark Cancellation Or Rectification

Cancellation or revocation of trademark proceedings can be initiated through two avenues: before the Trade Marks Registry or before the concerned high court.

Proceedings Before The Trade Marks Registry

The cancellation petition can be filed on Form TM-O, along with a statement of the case submitted by the applicant or petitioner, who is referred to as the 'aggrieved person'. In this statement, the nature of the petitioner's interest, the facts and the relief sought are outlined. Subsequently, a copy of the petition is served on the registered proprietor by the Trade Marks Registry.

Once the petition is served, the registered proprietor must file a counterstatement within two months to defend its trademark registration. This period may further be extended by one month if required. Following the filing of the counterstatement, the Registry serves a copy of the same on the petitioner within one month.

If the registered proprietor fails to submit a counterstatement within three months, the petitioner may proceed to file evidence in support of the petition, as stipulated. The subsequent proceedings mirror those of opposition proceedings, as mentioned above.

Proceedings Before The Concerned High Court

Alternatively, a revocation petition can be filed before five high courts (Ahmedabad, Chennai, Delhi, Kolkata and Mumbai) in India based on the jurisdiction of the registered trademark.

To commence revocation proceedings, any person who claims to be an aggrieved person (ie, any person substantially interested in getting the mark removed from the Register or any individual whose rights are being affected by the impugned registration) may initiate action.

Enforcement Of Trademark Rights

Various remedies are available to the aggrieved parties for trademark infringement, which include civil, criminal and border enforcement measures.

- Civil remedies: in civil proceedings, third parties using the infringing mark can be enjoined (ie, they can be restrained from further use of the mark). The plaintiff can seek a preliminary injunction before the trial. To obtain a preliminary injunction, the plaintiff must establish a *prima facie* case, demonstrate the likelihood of irreparable injury if relief is not granted, and show that the balance of convenience favours granting the injunction. If these conditions are met, the court may grant a preliminary injunction to protect the plaintiff's rights until a final decision is made. After the trial or if the plaintiff obtains relief through summary judgment, the court may pass an order granting a permanent injunction. This injunction permanently restrains the defendant from using the infringing mark. Additionally, the court can award damages to compensate the trademark owner for the losses incurred owing to the infringement. The court may also order the rendition of accounts, delivery and destruction of infringing products to prevent further misuse of the trademark.
- Criminal remedies: in criminal proceedings, offenders found guilty of trademark infringement can face imprisonment and be subjected to fines. The court can seize the infringing copies and deliver them to the rightful owner.
- Border enforcement: these measures involve the prohibition of the import of infringing material, aiming to prevent counterfeit goods from entering the country. The government of India has empowered IP owners to protect their intellectual property rights at Indian borders through the Intellectual Property Rights (Imported Goods) Enforcement Rules 2007. To utilise this protection, it is essential to have a validly registered trademark or IP right. The period of protection granted by Customs is five years from the date of recordation of rights with the customs authorities or upon the expiration of the trademark or IP right registration validity, whichever comes earlier. After this initial five-year period, the right holder needs to submit a fresh notice to continue the protection.
- Appeals and Supreme Court jurisdiction: if a judgment is passed by a district court, an appeal can be filed in the relevant high court. If the judgment is passed by a single judge of the high court, the appeal may be brought before the division bench. Appeals to the Supreme Court of India are allowed only on questions of points of law.
- Anti-counterfeiting measures: anti-counterfeiting is a critical aspect of trademark enforcement. The Bharatiya Nyaya Sanhita (BNS) (previously referred to as the Indian Penal Code) defines 'counterfeiting' as an act intending to deceive by causing one thing to resemble another, which is punishable with imprisonment or a fine or both. Sections 102, 103 and 104 of the Trade Marks Act define offences, penalties and procedures relating to falsification and falsely applying for trademarks. Offenders can face imprisonment ranging from six months to three years, along with a fine. Offences defined under the Trade Marks Act 1999 are cognisable, allowing police officers of designated ranks to arrest offenders without a warrant and initiate investigations.

Before taking any action under the Trade Marks Act 1999, police officers must seek an opinion from the registrar of trademarks on the facts of the case. This helps ensure proper enforcement of trademark rights and deter counterfeit activities.

Need-to-knows

- India is a common law country wherein prior user rights precede the subsequent registered rights.
- In India, trademark applications can be filed either on an 'intent to use' basis or with a user claim. The trademark application filed with the user claim mandates the submission of a signed and notarised affidavit of use showing the use of the filed trademark from the date of first use as claimed, along with supporting documents.
- The trademark registration process can be expedited by an official expedited request, which expedites both prosecution and opposition proceedings relating to the filed trademark.
- In India, trademark registration can be renewed for a further period of 10 years without the need for furnishing use declaration.
- The registered trademark becomes vulnerable to non-use cancellation action after a period of five years and three months from the date of placement on the register of the Trade Marks Registry.

Recent Developments

Recent developments in the field of intellectual property in India have focused on improving electronic systems for easy stakeholder access and providing transparent mechanisms for grievance redressal. Initiatives have been undertaken to expedite case disposal and reduce backlogs.

- Open house for discussion of grievances: at the National Intellectual Property Conference 2022, the Union Minister of Commerce and Industry proposed the establishment of an open house communication system to address concerns and grievances within the IP fraternity. The IP Office promptly implemented this suggestion and began conducting open house sessions on 17 October 2022. These sessions allow direct communication and discussions regarding various IP-related matters. Open house discussions occur every week from Monday to Friday from 4.30pm to 5.30pm (IST) and have successfully addressed multiple challenges faced by stakeholders across different IP offices.
- Open House Helpdesk Portal: the IP Office has also launched the Open House Helpdesk Portal, to provide swift and effective resolution to the queries and grievances of applicants and stakeholders on a plethora of issues. Upon raising a complaint, a ticket is raised in the Portal, and after the IP Office shares its response, the complainant can raise a subsequent support ticket or close the ticket if the query has been resolved.
- Scheme for Facilitating Start-Ups Intellectual Property Protection extended to 31 March 2026: the government of India, to encourage start-ups, launched this Scheme in 2016 to reach out to start-ups and protect and promote their intellectual property and thus encourage innovation and creativity among entrepreneurs, individual innovators and creators, and educational institutes.

- Update on trademark show-cause and opposition hearings: the IP Office, with the aim to strengthen the existing hearing system and reduce distance barriers, time and effort, has introduced the WebVideo Conferencing System. The show cause hearings can be accessed from the dedicated link provided on the dynamic cause list for the scheduled date from 10.30am to 1.30pm IST. This system allows the applicants or authorised agents to have online videoconferencing from their own premises or office simply with the use of a desktop computer or laptop with a camera, microphone and speakers.
- IP Manthan: the Office of Controller General of Patents, Designs and Trade Marks (CGPDTM) launched the 'IP Manthan' series in 2023, which includes periodic discussions on various IP-related topics among the IP fraternity as well as scientists, IP professionals, industry experts and persons from the judiciary.
- The number of trademark registrations and disposals during 2022–2023 was lower by 11.25 per cent and 8.38 per cent, respectively, as compared to the previous year, due to discontinuation of contractual manpower and new recruitments undergoing training.
- National Intellectual Property Awareness Mission: the Mission was launched in 2021 by the Office of CGPDTM to impart IP awareness to students. As at 31 March 2023, 1.862 million students and faculty members had been informed about IP from more than 7,377 educational institutes across the country.^[4]
- Announcement for proposed Intellectual Property Rights Division Rules of the High Court at Calcutta 2023: on 19 December 2023, draft rules were circulated for feedback from legal professionals and stakeholders before being formally enacted. Upon finalisation and notification, these Rules are anticipated to not only expedite the resolution of IP-related disputes but also provide urgent and essential interim relief, as outlined in draft Rule 7(e).
- Budget allocation for 2024–2025: in the intellectual property sector in India, a total budget of 3,182 million rupees has been allocated, with 2,791.8 million rupees for the Office of the CGPDTM; 208.4 million rupees for intellectual property rights policy management; and 180 million rupees for the infrastructure development in the offices of CGPDTM. Another 10 million rupees have been allocated to the World Intellectual Property Organization.

These developments aim to enhance the efficiency and effectiveness of IP dispute resolution, offering stakeholders timely and fair adjudication of their rights.

CONCLUSION

The Trade Marks Act 1999 plays a pivotal role in shaping India's trademark registration and enforcement framework. With a focus on both registered and unregistered marks, the Act provides a robust system to protect the rights of trademark owners. The creation of the Intellectual Property Division (IPD) in the High Court of Delhi and Madras, proposed IPD at Calcutta, and regular listing of hearings before the Trade Marks Registry work towards improving the efficiency of trademark protection and enforcement in India. As India continues to evolve as a major player in the global market, trademark protection remains essential for businesses to safeguard their brands and intellectual property.

Endnotes

- 1 Section 2(1)(zb) of the Trade Marks Act 1999. ^ [Back to section](#)
- 2 Section 2(1)(m) of the Trade Marks Act 1999. ^ [Back to section](#)
- 3 Sections 9 and 11 of the Trade Marks Act 1999. ^ [Back to section](#)
- 4 https://ipindia.gov.in/writereaddata/Portal/IPOAnnualReport/1_114_1_A_NNUAL_REPORT_202223_English.pdf. ^ [Back to section](#)



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