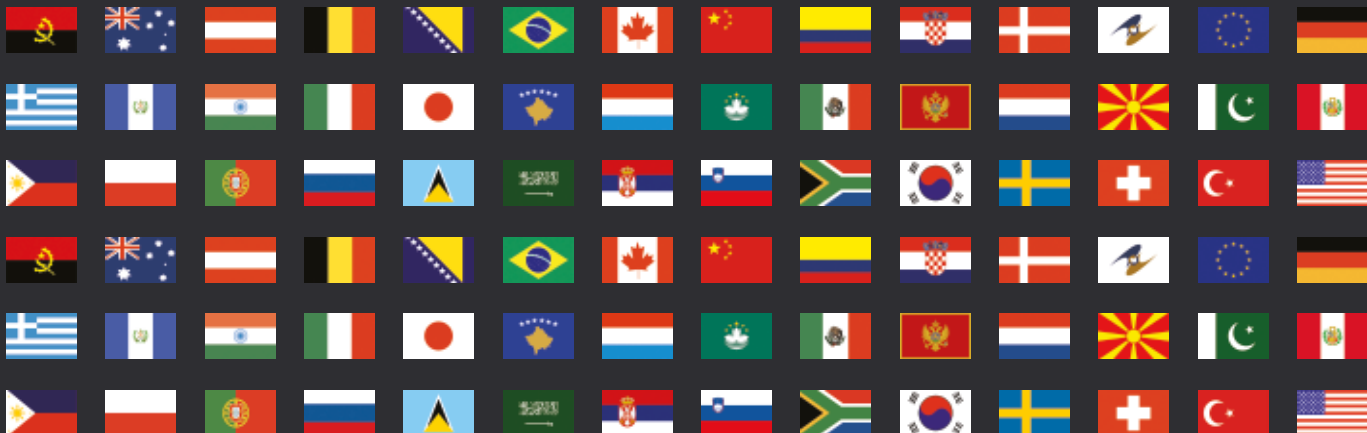


Trademarks 2021

Contributing editors
Theodore H Davis Jr and Olivia Maria Baratta



Publisher

Tom Barnes

tom.barnes@lbresearch.com

Subscriptions

Claire Bagnall

claire.bagnall@lbresearch.com

Senior business development manager

Adam Sargent

adam.sargent@gettingthedealthrough.com

Published by

Law Business Research Ltd

Meridian House, 34-35 Farringdon Street

London, EC4A 4HL, UK

The information provided in this publication is general and may not apply in a specific situation. Legal advice should always be sought before taking any legal action based on the information provided. This information is not intended to create, nor does receipt of it constitute, a lawyer-client relationship. The publishers and authors accept no responsibility for any acts or omissions contained herein. The information provided was verified between August and September 2020. Be advised that this is a developing area.

© Law Business Research Ltd 2020

No photocopying without a CLA licence.

First published 2005

Seventeenth edition

ISBN 978-1-83862-368-5

Printed and distributed by

Encompass Print Solutions

Tel: 0844 2480 112



Trademarks

2021

Contributing editors**Theodore H Davis Jr and Olivia Maria Baratta****Kilpatrick Townsend & Stockton LLP**

Lexology Getting The Deal Through is delighted to publish the seventeenth edition of *Trademarks*, which is available in print and online at www.lexology.com/gtdt.

Lexology Getting The Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique Lexology Getting The Deal Through format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on Australia, Belgium, Eurasia, India, Luxembourg, Netherlands, Philippines and Poland.

Lexology Getting The Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.lexology.com/gtdt.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Lexology Getting The Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. We also extend special thanks to the contributing editors, Theodore H Davis Jr and Olivia Maria Baratta of Kilpatrick Townsend & Stockton LLP for their continued assistance with this volume.



London

September 2020

Reproduced with permission from Law Business Research Ltd

This article was first published in October 2020

For further information please contact editorial@gettingthedealthrough.com

Contents

Angola	5	European Union	96
Patricia Rodrigues RCF – Protecting Innovation		Michael Hawkins and Dr Tobias Dolde Noerr LLP	
Australia	10	Germany	104
Ian Drew and Lauren Eade Davies Collison Cave		Tanja Hogh Holub Beiten Burkhardt	
Austria	18	Greece	114
Peter Israiloff Barger Piso & Partner		Vali Sakellarides Sakellarides Law Offices	
Belgium	26	Guatemala	121
Annick Mottet Haugaard and Olivia Santantonio Lydian		Hilda Monterroso and Marco Antonio Palacios Palacios & Asociados/Sercomi	
Bosnia and Herzegovina	35	India	128
Merima Čengić-Arnaut and Selma Čustović Zivko Mijatovic & Partners		Anoop Narayanan and Shree Misra ANA Law Group	
Brazil	42	Italy	135
Philippe Bhering and Jiuliano Maurer Bhering Advogados		Pier Luigi Roncaglia, Carloalberto Giovannetti and Noemi Parrotta Spheriens	
Canada	51	Japan	142
Coleen Morrison Perley-Robertson, Hill & McDougall LLP		Masayuki Yamanouchi, Ai Nagaoka and Satoko Yokogawa Anderson Mōri & Tomotsune	
China	59	Kosovo	149
Angell Xi Jingtian & Gongcheng		Marija Markičević Pijević Zivko Mijatovic & Partners	
Colombia	67	Luxembourg	154
María Alejandra Pava and Juan Felipe Acosta OlarteMoure		Annick Mottet Haugaard and Olivia Santantonio Lydian	
Croatia	74	Macau	163
Ivana Ervačanin, Luka Jelčić and Ivana Šarlija Zivko Mijatovic & Partners		Patricia Rodrigues RCF – Protecting Innovation	
Denmark	81	Mexico	168
Christina Type Jardorf and Eva Nymark Accura Advokatpartnerselskab		Marcela Bolland Uhthoff, Gómez Vega & Uhthoff SC	
Eurasia	89	Montenegro	175
Julia Zhevid and Tatyana Kulikova PETOŠEVIĆ		Rajka Vukcevic and Marija Savic Zivko Mijatovic & Partners	

Netherlands	181	Slovenia	266
Annick Mottet Haugaard and Olivia Santantonio Lydian		Petra Sever and Metka Malis Furlan Zivko Mijatovic & Partners	
North Macedonia	190	South Africa	272
Aneta Indovska and Aleksandar Bogojevski Zivko Mijatovic & Partners		Shamin Raghunandan, Linda Thilivhali, John Foster and Jeremy Speres Spoor & Fisher	
Pakistan	196	South Korea	280
Ali Kabir Shah and Hanya Haroon Ali & Associates		Mi-Cheong Lee and So-Jung Bae Lee International IP & Law Group	
Peru	205	Sweden	287
Maria del Carmen Arana Courrejolles Estudio Colmenares & Asociados		Emma Kadri Bergström, Katarzyna Lewandowska, Oscar Björkman Possne and Sandra Torpheimer Mannheimer Swartling	
Philippines	214	Switzerland	295
Katrina V Doble, Danielle Francesca T C San Pedro and Jan Eidrienne R De Luis Villaraza & Angangco		Jürg Simon, Sevan Antreasyan, Adrian Wyss and David Hitz Lenz & Staehelin	
Poland	223	Turkey	302
Anna Sokołowska-Ławniczak Traple Konarski Podrecki & Partners		Bentley Yaffe and Sita Sayli CETINKAYA	
Portugal	229	United States	310
Patricia Rodrigues RCF - Protecting Innovation		Theodore H Davis Jr and Olivia Maria Baratta Kilpatrick Townsend & Stockton LLP	
Russia	236		
Vladimir Trey and Evgeny Alexandrov Gorodissky & Partners			
Saint Lucia	245		
Cheryl Charmaine Goddard-Dorville Goddard-Dorville Legal			
Saudi Arabia	252		
Asif Iqbal and Mohammad Jomoa Kadasa Intellectual Property			
Serbia	260		
Dusko Majkic Zivko Mijatovic & Partners			

India

Anoop Narayanan and Shree Misra

ANA Law Group

LEGAL FRAMEWORK

Domestic law

1 | What is the primary legislation governing trademarks in your jurisdiction?

The primary legislation governing trademarks in India is the Trade Marks Act 1999 and the Trade Marks Rules 2017.

International law

2 | Which international trademark agreements has your jurisdiction signed?

India is a signatory to the following international trademark agreements:

- the Paris Convention for the Protection of Industrial Property 1883;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks 1989;
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks 1957; and
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks 1973.

Regulators

3 | Which government bodies regulate trademark law?

Trademark law in India is governed by the Trade Marks Registry under the Office of the Controller General of Patents, Designs and Trade Marks (CGPDTM). The CGPDTM is under the Department of Promotion of Industry and Internal Trade of the Ministry of Commerce and Industry in India.

REGISTRATION AND USE

Ownership of marks

4 | Who may apply for registration?

A trademark registration application in India can be filed by any person claiming to be the trademark's proprietor, including individuals, body corporates, proprietary or partnership firms, start-ups, small enterprises and trusts.

Scope of trademark

5 | What may and may not be protected and registered as a trademark?

A device, design, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging and colour combination can be registered under the Trade Marks Act 1999 (the TM Act), if it can be graphically represented and is capable of distinguishing the goods or services thereunder from those of others.

The following trademarks are not registrable under the TM Act:

- non-distinctive trademarks incapable of distinguishing the goods or services of one person from those of others;
- descriptive trademarks, which indicate the kind, quality, quantity, intended purpose, geographical origin or other characteristics of the goods or services applied for;
- trademarks that are customary in the current language and established practices of the trade;
- marks that may deceive the public or cause confusion;
- marks that may hurt the religious susceptibilities of any class or section of the citizens of India;
- marks consisting of scandalous or obscene matter;
- marks that are prohibited from use under the Emblems and Names (Prevention of Improper Use) Act 1950; and
- marks comprising shapes:
 - resulting from the nature of the goods themselves;
 - that are necessary to obtain a technical result; or
 - that give substantial value to the goods.

Further, a trademark may be refused if it is identical or deceptively similar to a prior existing trademark, and there exists a likelihood of consumer confusion. Additionally, trademarks prohibited from use under the copyright law, the common law of passing off protecting an unregistered trademark and other applicable laws are not registrable in India.

Service marks, collective trademarks and certification marks are registrable under the TM Act. Additionally, non-traditional trademarks such as sound marks, shape marks, colour marks, image marks, architectural marks, etc, are registrable in India.

The TM Act recognises common law protection of trademarks by way of use as well.

Unregistered trademarks

6 | Can trademark rights be established without registration?

Yes. Unregistered trademarks are protected in India under the common law. The trademark rights can be established through passing-off actions by substantiating the trademark's use in India.

The Indian courts consider the following factors in passing-off actions:

- the unregistered trademark's prior use, goodwill, reputation, acquired distinctiveness and exclusivity;
- misrepresentation of the origin of the goods and services caused by the conflicting trademark and the likelihood of consumer confusion; and
- any injury suffered or likelihood of injury to the unregistered trademark's owner as a result of the misrepresentation.

Also, the Indian courts have recognised unregistered foreign trademarks' rights in India, based on the trademarks' trans-border reputation in India.

Famous foreign trademarks

7 | Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

Famous foreign trademarks are protected in India and entitled to broader protection across all classes of goods and services under the TM Act. The proprietary rights in well-known marks can be enforced against any conflicting trademarks across all, including unrelated, goods and services, without having to prove that the trademark is registered or used in respect of the unrelated goods and services in India.

The Registrar of trademarks considers the following factors when determining a trademark's well-known status:

- the relevant section of the public's knowledge and recognition of the trademark;
- the trademark's duration, extent and geographical area of use (within and outside India);
- the trademark's duration, extent and geographical area of promotions, including advertising or publicity and presentation, at fairs or exhibitions of the goods or services thereunder;
- the duration and geographical area of the trademark's registration, or any pending registration application, to the extent they reflect the trademark's use and recognition; and
- the trademark's successful enforcements; specifically, the extent to which the trademark has been recognised as a well-known mark by any Indian court or registrar.

Further, while determining the trademark's well-known status, it is not mandatory for the Registrar to consider that the trademark has been used, registered or applied for in India, is regarded as well known, registered or pending registration in other countries, or that the trademark is well known to the public at large in India.

Under the Trade Marks Rules 2017 (the TM Rules), a well-known declaration application shall be filed along with the following documents in the Registry:

- a statement of case describing the applicant's rights and well-known claim in the trademark; and
- following documentary evidence to substantiate the applicant's rights and claim:
 - use of the trademark through copies of advertisements, invoices, news articles, etc, available internationally and in India;
 - any registrations or pending registration applications of the trademark;
 - annual sales turnover of the applicant's business under the trademark;
 - the number of actual and potential customers of goods and services thereunder;
 - the trademark's publicity and advertising, and the expenses thereof;

- knowledge and recognition of the trademark in the relevant section of the public in India and abroad;
- details of successful enforcements of rights related to the trademark, and specifically the extent to which the trademark is recognised as a well-known trademark by the Indian courts or the Registrar; and
- a copy of the judgment by the Indian courts or the Registrar, wherein the trademark is determined as a well-known mark.

The benefits of registration

8 | What are the benefits of registration?

Some of the benefits of a trademark registration in India are as follows:

- **Exclusivity:** a trademark registration provides its owner exclusive ownership in the Register of trademarks and exclusive right to use the trademark in India.
- **Proof of validity:** in legal proceedings, the trademark's registration is the prima facie evidence of its validity.
- **Infringement action:** the proprietor or registered user of the registered trademark can institute infringement proceedings against any conflicting mark in India. Further, the burden of proof of likelihood of consumer confusion is presumed, and discharged from the owner in infringement actions.
- **Border protection:** for enforcement against infringing goods at the border, a trademark must be registered in the Register as well as with the customs authorities in India.
- **Security/hypothecation:** registered trademarks can be used as security to avail loans similar to immovable properties.

Filing procedure and documentation

9 | What documentation is needed to file a trademark application? What rules govern the representation of the mark in the application? Is electronic filing available? Are trademark searches available or required before filing? If so, what procedures and fees apply?

The following documents are required along with the trademark registration application in the Registry:

- power of attorney;
- certified copy of the priority application, if priority is claimed; and
- affidavit of use along with supporting documents, if the trademark's prior use in India is claimed.

The TM Rules govern the trademark's representation in the application, and mandate that:

- all registration applications must contain clear and legible trademark representations;
- trademark applications claiming colour combinations as distinctive features must contain the trademark's reproduction in colour;
- in the case of 3D trademarks, the reproduction must contain a 2D graphic or photographic reproduction with the trademark's three different views; if required, the 3D trademark's specimen or five views must also be filed;
- for shape marks and packaging, the trademark's reproduction must contain the trademark's five views and description; if required, a specimen of the goods or packaging must also be filed; and
- for sound marks, the reproduction is required in MP3 format not exceeding 30 seconds, along with written musical notations.

Trademark registration applications can be filed online on the Registry's website. Trademark searches can be carried out on the Registry's online database, without any fees.

Registration time frame and cost

10 | How long does it typically take, and how much does it typically cost, to obtain a trademark registration? When does registration formally come into effect? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration?

A straightforward trademark registration in India usually takes between six and 10 months, and the official fee is 9,000 rupees. The trademark registration effectuates from the date of filing the trademark application.

The following factors may increase the estimated time and cost of the registration process:

- nature of objections raised by the Registry;
- extension requests filed in the Registry;
- any hearings scheduled by the Registry;
- oppositions filed against the trademark; or
- amendment and assignment recordation applications filed by the applicant.

Classification system

11 | What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

India is a signatory to the Nice Classification, and currently follows the 11th edition of the Nice Classification.

The TM Act allows multi-class trademark applications. However, there are no cost savings in the official fees, except for attorney fees in a multi-class application.

Examination procedure

12 | What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

After receiving a trademark registration application, the Registry conducts formal examination and may issue an office action for compliance requirements. Thereafter, the Registry conducts substantive examination, and may issue office action raising any objections. The Registry also examines the trademark for potential conflicts with prior existing third-party marks.

Letters of consent are usually accepted by the Registry to overcome objections based on similarities with any prior existing third-party marks. The applicant must respond to the office actions within one month of receiving the office action, which can be extended by a month by filing an extension application. If the applicant fails to file any response, the trademark application will be deemed as abandoned.

Use of a trademark and registration

13 | Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

In India, the trademark's use details are mandatory in the registration application. If the application is filed claiming the trademark's prior use in India, an affidavit of use and documentary evidence to substantiate the use must be filed along with the application.

The TM Act allows priority rights if the application is filed in India within six months of the parent application's filing in the priority country. In that case, a certified copy of the priority application must be filed along with the trademark application.

In India, a trademark registration application can be filed on a 'proposed to be used' basis as well. However, the trademark will be vulnerable to a non-use cancellation action if it is not used in India for five years from the date of its actual registration (ie, the date on which the registration certificate is issued).

Markings

14 | What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The markings indicating the trademark's use or registration are not mandatory under Indian trademarks law. However, in India, the registered ® symbol is widely used to indicate a registered trademark, and the letters 'TM' are used to indicate an unregistered trademark in the trade practices.

The use of markings act as a notice regarding the trademark rights to the public. However, the registered ® symbol's use for unregistered trademarks constitutes falsification of trademarks under the TM Act, which is a punishable offence with imprisonment extending from one to three years or a fine, or both.

Appealing a denied application

15 | Is there an appeal process if the application is denied?

Any decisions from the Registrar, including refusal orders, can be reviewed by the Registrar by filing a review petition within one month of the Registrar's order. The Registrar's decisions can be appealed before the Intellectual Property Appellate Board (IPAB) within three months of the Registrar's order. The IPAB's order can be challenged by way of writ petition before the High Courts, and special leave petition before the Supreme Court.

Third-party opposition

16 Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

After acceptance for registration, the trademark will be published in the Trade Marks Journal. Any person can oppose the trademark within four months of the date of its publication.

The trademark opposition procedure in India is as follows:

- A notice of opposition (the Notice) must be filed along with the official fees and a copy of the relevant journal publication within four months of the date of the trademark's publication.
- The Registry then serves a copy of the Notice to the applicant, and the applicant is required to file a counterstatement along with the official fees in the Registry within two months of the date of the Notice's receipt from the Registry.
- The Registry serves the counterstatement's copy to the opponent. Thereafter, the opponent may either file an affidavit of evidence in support of the opposition or inform the Registry that it intends to rely on the facts stated in the Notice within two months of the date of counterstatement's receipt from the Registry.
- Subsequently, the applicant must either file the affidavit of evidence in support of the opposition or inform the Registry of its intention to rely on the facts stated in the counterstatement within two months of the date of receipt of the opponent's affidavit.
- Within one month of the date of the receipt of the applicant's affidavit from the Registry, the opponent may file an affidavit of evidence in reply to the applicant's affidavit.
- Thereafter, the Registry schedules a hearing to conclude the opposition proceedings.

The TM Act prescribes that a cancellation application can be filed by any aggrieved party before the Registry or the IPAB, based on the following grounds:

- that the trademark was registered without any bona fide intention to use, and has not been used until three months prior to filing the cancellation application;
- that the trademark has not been used for a continuous period of five years from the date of its actual registration until three months prior to the date of filing the cancellation application;
- the trademark is registered in contravention of the TM Act or TM Rules;
- non-compliance of any condition related to the trademark's registration in the Register;
- absence or omission of any entry in the Register;
- any entry made without sufficient cause in the Register;
- any entry wrongly remaining in the Register; or
- an error or defect in any entry in the Register.

The cancellation action's procedure before the Registrar is as follows:

- The cancellation application must be filed along with a statement specifying the nature of the applicant's interest, the facts and the reliefs sought, along with the official fees in the Registry.
- The Registry then serves a copy of the application and statement on the registered proprietor within one month. Thereafter, the registered proprietor must file a counterstatement within three months of the date of the application and statement's receipt.

- Subsequently, the Registrar serves the counterstatement's copy on the applicant within one month of its receipt. If no counterstatement is filed, the applicant must file its evidence in support of the cancellation application.
- If the applicant files its evidence, the registered proprietor must either file the affidavit of evidence in support of the trademark registration or inform the Registry of its intention to rely on the facts stated in the counterstatement within two months of the date of the applicant's evidence's receipt.
- Within one month of the date of the receipt of the registered proprietor's affidavit, the applicant may file an affidavit of evidence in reply to the registered proprietor's evidence.
- Thereafter, the Registry schedules a hearing to conclude the cancellation proceedings.

Proceedings before the IPAB are comparatively faster, and are as follows:

- The cancellation application, along with the supporting evidence by way of an affidavit and the official fee must be filed.
- Upon the cancellation application's receipt, the IPAB will scrutinise the application, register it and serve the application on the respondent.
- Within two months of the receipt of the cancellation application, the respondent must file the counterstatement along with the evidence in the form of an affidavit and the official fee to the IPAB, and serve a copy of the foregoing documents directly on the applicant.
- Thereafter, the IPAB will hear both the parties and decide the dispute.

The Notice and cancellation application's official fee before the Registry is 2,700 rupees for online filing, and 3,000 rupees for physical filing, in respect of each class opposed and counterstatement filed.

At the IPAB, the official fee for filing the cancellation application is 5,000 rupees and the fee for the counterstatement is 2,000 rupees.

Duration and maintenance of registration

17 How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The validity of a trademark registration is 10 years in India. To maintain the registration, it must be renewed after every 10 years by filing a renewal application in the Registry. The trademark's use is not mandatory for maintaining or renewing the trademark. However, a registered trademark will become vulnerable to cancellation action if it is not used continuously for five years after registration.

Surrender

18 What is the procedure for surrendering a trademark registration?

The proprietor of a registered trademark may surrender the registration by filing an application for the trademark's cancellation of registration along with the official fee, and an affidavit in the Registry.

Related IP rights

19 Can trademarks be protected under other IP rights (eg, copyright or designs)?

Trademarks containing artistic elements, such as logos and labels, can be protected as artistic works under the Copyright Act 1957. The copyright registration application for logos and labels must be filed with a no-objection certificate from the Registry. Besides copyright, trademarks cannot be protected under any other intellectual property laws in India.

Trademarks online and domain names

20 | What regime governs the protection of trademarks online and domain names?

The TM Act is the comprehensive legislation governing all aspects of trademark protection in India. Although there is no separate law for the protection of trademarks online and domain names, they can be protected as trademarks upon satisfying the registration requirements under the TM Act. Further, domain name disputes in India, including those arising from trademarks used as part of the .in domain name, are governed under the .IN Domain Name Dispute Resolution Policy.

LICENSING AND ASSIGNMENT

Licences

21 | May a licence be recorded against a mark in the jurisdiction? How? Are there any benefits to doing so or detriments to not doing so? What provisions are typically included in a licensing agreement (eg, quality control clauses)?

A registered trademark's licensed user's name (known as the registered user) can be registered by filing a joint request by the registered proprietor and the user in the Registry. The request must be filed along with a copy of the licence agreement entered into between the registered proprietor and the licensee, an affidavit stating the particulars of the proprietor and the user's existing or proposed relationship, the proprietor's degree of control over the licensed use, goods and services covered, conditions and restrictions and proposed term of the permitted use, and the official fees.

A registered user can initiate infringement proceedings in his or her own name under the Trade Marks Act 1999 (the TM Act), subject to the licence agreement terms.

Further, the TM Act empowers the Registrar to request the registered user's confirmation regarding the licence agreement's continuation. If the licence agreement's continuity is not confirmed, the registered user ceases to exist under the TM Act.

Licensing agreements may contain provisions related to the trademark's use, the nature of the licence, quality control regulation, termination, indemnification, etc.

Assignment

22 | What can be assigned?

In India, a registered or an unregistered trademark is assignable, with or without the goodwill of the business, in respect of all or some of the goods and services thereunder.

Assignment documentation

23 | What documents are required for assignment and what form must they take? What procedures apply?

The assignment recordation application for a registered trademark must be filed along with a certified copy of the original assignment deed, a statement of the case and an affidavit stating that there are no pending legal proceedings related to the trademark ownership at any courts or tribunals in India. The assignment deed and the affidavit must be executed and notarised at the place of execution, and affixed with the Indian stamp duty (a nominal government levy) prior to filing in the Registry.

For the assignment of trademarks pending registration, a certified copy of the assignment deed must be filed along with the assignment recordation application. The Registry will examine the application and issue an office action in case of any objections or outstanding requirements. If the Registry is satisfied with the office action response, the

assignment will be recorded. If the Registry is not satisfied with the response, it will schedule a hearing.

Validity of assignment

24 | Must the assignment be recorded for purposes of its validity?

The TM Act mandates the recordation of a registered trademark's assignment in the Registry.

Security interests

25 | Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?

There are no specific provisions related to security interests under trademarks law in India.

ENFORCEMENT

Trademark enforcement proceedings

26 | What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

The Trade Marks Act 1999 (the TM Act) provides for enforcement through infringement and passing-off actions. An infringement or passing-off action in India can be instituted before the district courts, and the four high courts having original jurisdiction. Trademark infringements and falsifications are punishable offences under the TM Act, with imprisonment for a term of six months to three years or a fine of 50,000 rupees to 200,000 rupees, or both. Further, a trademark owner may file a criminal complaint before a magistrate, seeking investigation, search and seizure of infringing goods within the premises of the infringer, under the Code of Criminal Procedure 1973. A criminal complaint can also be filed with the police for the infringement and falsification of trademarks.

Administrative enforcement includes recordation of the registered trademark with customs to prevent the import of infringing goods.

There are no specialised courts or tribunals other than the Intellectual Property Appellate Board (IPAB) for handling trademarks and other IP cases in India.

Procedural format and timing

27 | What is the format of the infringement proceeding?

The procedural formats in infringement proceedings are entirely adjudicated by a judge under the Code of Civil Procedure 1908 (CPC). The procedures include institution of suits, summons, filing of pleadings, examination of parties and witnesses (including live testimony), discovery and inspection, hearings and final arguments. The CPC allows certain persons to provide expert evidence and perform any work of expert character necessary in the infringement action.

Typically, the final decision in an infringement action takes from two to four years. In certain cases, the proceedings may last longer, depending on multiple factors, such as the nature of the infringement action and jurisdiction.

Criminal proceedings can be initiated by filing a complaint before the magistrate requesting to investigate and carry out search and seizure of the infringing materials at the infringer's premises. Criminal complaints can also be filed before a police officer, not below the rank of

superintendent, and the officer must obtain the Registrar's opinion prior to making any search and seizure.

Burden of proof

28 | What is the burden of proof to establish infringement or dilution?

The Supreme Court of India in the landmark judgment of *Kaviraj Pandit Durga Dutt Sharma v Navratna Pharmaceutical Laboratories* [(1965) 1 SCR 737] held that the burden of proof in an infringement action is 'on the plaintiff to establish that the trademark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is identical or is deceptively similar'. Further, the burden of proof to establish the validity of a trademark registration is on the party alleging its invalidity in the infringement action.

In opposition proceedings, the Indian courts have recognised that the burden of proof to prove the similarities between trademarks lies with the opponent. In the case of prior existing registered trademarks, the likelihood of consumer confusion is presumed in opposition and infringement proceedings, and the burden of proof to negate the claim lies with the applicant or defendant. In trademark falsification proceedings, the burden of proof to establish the trademark proprietor's assent lies with the accused.

Standing

29 | Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

The registered trademark owner or the registered user can initiate infringement actions, and only the trademark owner can initiate passing-off actions. However, the registered user's right to institute infringement proceedings is subject to the licence agreement entered into between the user and the owner. A criminal complaint against trademark infringements can be filed by the trademark owner.

Border enforcement and foreign activities

30 | What border enforcement measures are available to halt the import and export of infringing goods? Can activities that take place outside the country of registration support a charge of infringement or dilution?

In India, the Customs Act 1962 and the Intellectual Property Rights (Imported Goods) Enforcement Rules 2007 (the IPR Rules) provide for enforcement measures at the borders against the import of infringing goods. The IPR Rules empower Customs to intercept, seize and confiscate infringing goods at the border. To enable border protection, the trademark proprietor must register its registered trademark with Customs by filing an application in the prescribed format, requesting to suspend the clearance of infringing goods. Thereafter, Customs may intercept and suspend the infringing goods at the border.

Activities taking place outside India do not constitute any grounds to institute infringement action in India. However, information regarding extraterritorial activities may be beneficial to substantiate the mala fides of the infringing party.

Discovery

31 | What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The TM Act allows discovery of documents in ex parte or interlocutory injunctions, and prohibits the refusal to make complete discoveries in

infringement proceedings. The adverse parties can be interrogated, and directed for the production and inspection of documents, after seeking the court's prior permission. The adverse party's refusal to allow the inspection or production of documents may negatively impact its position in the legal proceedings.

Timing

32 | What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

Based on the interim application or motion seeking a temporary restraint order in the initial stage, filed along with the infringement suit, the court may pass an ex parte injunction order on the same day or within a few days of filing the suit. If the court does not pass an ex parte order and issues a show cause notice to the defendant, it may take two to three weeks for the defendant to appear and show cause. After the defendants appear, the court hears the arguments for the interim application and passes the final orders. The final disposal of the suit may take two to three years in India.

Limitation period

33 | What is the limitation period for filing an infringement action?

The limitation period for filing infringement actions is three years from the date the cause of action arises. If the infringement is a continuous one, a new cause of action will arise every time an act of infringement occurs, and accordingly, the limitation period will vary.

Litigation costs

34 | What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

The court fee payable depends on the jurisdiction for filing the complaint and the amount of damages claimed. The major cost for handling the legal proceedings is attorney fees. The arguing counsels (barrister equivalent) charge per appearance and their rates vary based on their seniority and expertise, and impact the overall cost of the litigation. The major portion of litigation costs is involved at the interlocutory stage, which is the most effective and important stage of the litigation.

Appeals

35 | What avenues of appeal are available?

The TM Act empowers the Registrar to review its own decisions by filing a review petition in the Registry. An appeal from the Registrar's decision can be filed by the aggrieved person before the IPAB within three months of the date of the Registrar's order. Appeals from the IPAB's decisions can be filed by way of writ petitions before the high courts, and special leave petition before the Supreme Court of India.

Defences

36 | What defences are available to a charge of infringement or dilution, or any related action?

The defences available in trademark infringement actions are as follows:

- Trademark's descriptive use: a trademark may not be regarded as infringing if it refers to the kind, quality, quantity or other characteristics of the goods or services.
- Legitimate use in respect of goods or services: a trademark used in accordance with the permitted use and the consent of the

- proprietor or registered user, and without subsequently being removed or obliterated, will not amount to infringement.
- Necessary use: if the trademark is used in respect of goods part of, or accessory to, other goods or services, and such use is reasonably necessary to indicate the goods or services without negating the purpose and effect of the trademark's use, it will not be considered as infringing use.
- Two or more registered trademarks: where two or more identical or similar trademarks are registered and used in compliance with the TM Act, the lawful use of any such trademarks will not amount to infringement as against other identical or similar registered trademarks.
- Exhaustion: the sale of lawfully acquired goods bearing the registered trademark does not amount to infringement on the grounds that the trademark was assigned to another person after the goods were acquired or put in the market.
- Prior use: if an identical or similar trademark is continuously used prior to the registered trademark's date of use or registration, it does not amount to infringement.
- Use of name, address or description of goods or services: the bona fide use of a person's name, place of business, predecessors, and the goods' and services' descriptions, etc, does not amount to infringing use.

Remedies

37 | What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The following civil remedies are available in infringement and passing-off actions:

- interlocutory injunctions, upon establishing a prima facie case of infringement, irreparable harm or injury caused to the aggrieved party, and balance of convenience in favour of the aggrieved party;
- permanent injunctions;
- damages;
- accounts of profit;
- delivery up of infringing materials for destruction;
- *Anton Piller* orders;
- *Mareva* injunctions;
- *John Doe* orders; and
- *Quia timet* actions.

Monetary reliefs may vary depending on various factors, such as the loss caused to the trademark proprietor's business, goodwill and reputation, punitive damages (usually twice the amount of compensatory damage), exemplary costs, etc.

The TM Act provides for criminal remedies in trademark infringement and falsification of trademarks with imprisonment extending up to three years or a fine of up to 200,000 rupees, or both.

ADR

38 | Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Alternative dispute resolution mechanisms are available in respect of infringement and passing-off actions and domain name disputes in India. There is a growing trend in ADR techniques in trademark infringements, as they are cost-effective, enforceable, faster, protect the parties' confidentiality and reputations, and provide equal opportunity to negotiate and control the ADR proceedings.



ANA LAW GROUP
ANOOP NARAYANAN & ASSOCIATES

Anoop Narayanan

anoop@anaassociates.com

Shree Misra

shree@anaassociates.com

ANA Law Group
Indiabulls Finance Centre
Tower-2, 11th Floor, 1103
Elphinstone Road
Mumbai - 400 013
India
Tel: +91 22 6112 8484
www.anaassociates.com

UPDATE AND TRENDS

Key developments of the past year

39 | Are there any emerging trends, notable court rulings, or hot topics in the law of trademark infringement or dilution in your jurisdiction?

The Indian trademarks office has ensured greater ease in filing and leapfrogging of timelines through the digital platform. Further, all judicial and quasi-judicial authorities have enabled virtual hearings in view of the covid-19 crisis in India. Additionally, the Supreme Court and many high courts have enabled online filing of applications, which has eased litigation processes and helped to save time and costs.

Coronavirus

40 | What emergency legislation, relief programmes and other initiatives specific to your practice area has your state implemented to address the pandemic? Have any existing government programmes, laws or regulations been amended to address these concerns? What best practices are advisable for clients?

The Supreme Court of India has extended the statutory deadlines under all general and special laws, including the Trade Marks Act, until 15 days after the nationwide lockdown has been lifted in India. Therefore, all filing deadlines before the Registry currently stand extended.

The courts have also introduced online videoconferencing hearings in light of the pandemic, and the Registry was proposing to introduce online videoconferencing hearings by September 2020.

Other titles available in this series

Acquisition Finance	Distribution & Agency	Investment Treaty Arbitration	Public M&A
Advertising & Marketing	Domains & Domain Names	Islamic Finance & Markets	Public Procurement
Agribusiness	Dominance	Joint Ventures	Public-Private Partnerships
Air Transport	Drone Regulation	Labour & Employment	Rail Transport
Anti-Corruption Regulation	e-Commerce	Legal Privilege & Professional Secrecy	Real Estate
Anti-Money Laundering	Electricity Regulation	Licensing	Real Estate M&A
Appeals	Energy Disputes	Life Sciences	Renewable Energy
Arbitration	Enforcement of Foreign Judgments	Litigation Funding	Restructuring & Insolvency
Art Law	Environment & Climate Regulation	Loans & Secured Financing	Right of Publicity
Asset Recovery	Equity Derivatives	Luxury & Fashion	Risk & Compliance Management
Automotive	Executive Compensation & Employee Benefits	M&A Litigation	Securities Finance
Aviation Finance & Leasing	Financial Services Compliance	Mediation	Securities Litigation
Aviation Liability	Financial Services Litigation	Merger Control	Shareholder Activism & Engagement
Banking Regulation	Fintech	Mining	Ship Finance
Business & Human Rights	Foreign Investment Review	Oil Regulation	Shipbuilding
Cartel Regulation	Franchise	Partnerships	Shipping
Class Actions	Fund Management	Patents	Sovereign Immunity
Cloud Computing	Gaming	Pensions & Retirement Plans	Sports Law
Commercial Contracts	Gas Regulation	Pharma & Medical Device Regulation	State Aid
Competition Compliance	Government Investigations	Pharmaceutical Antitrust	Structured Finance & Securitisation
Complex Commercial Litigation	Government Relations	Ports & Terminals	Tax Controversy
Construction	Healthcare Enforcement & Litigation	Private Antitrust Litigation	Tax on Inbound Investment
Copyright	Healthcare M&A	Private Banking & Wealth Management	Technology M&A
Corporate Governance	High-Yield Debt	Private Client	Telecoms & Media
Corporate Immigration	Initial Public Offerings	Private Equity	Trade & Customs
Corporate Reorganisations	Insurance & Reinsurance	Private M&A	Trademarks
Cybersecurity	Insurance Litigation	Product Liability	Transfer Pricing
Data Protection & Privacy	Intellectual Property & Antitrust	Product Recall	Vertical Agreements
Debt Capital Markets		Project Finance	
Defence & Security			
Procurement			
Dispute Resolution			

Also available digitally

[lexology.com/gtdt](https://www.lexology.com/gtdt)