

TRADEMARKS

India



Trademarks

Consulting editors

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Quick reference guide enabling side-by-side comparison of local insights, including legal framework; registration and use; licensing and assignment; enforcement; and recent trends.

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UPDATE AND TRENDS

Key developments of the past year

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India



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LEGAL FRAMEWORK

Domestic law

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 rules formed thereunder, which are the Trade Marks Rules 2017 .

Law stated - 11 August 2022

International law

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.

Law stated - 11 August 2022

Regulators

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 a subordinate office under the Department of Promotion of Industry and Internal Trade of the Ministry of Commerce and Industry in India.

Law stated - 11 August 2022

REGISTRATION AND USE

Ownership of marks

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, bodies corporate, proprietary or partnership firms, start-ups, small enterprises and trusts.

Law stated - 22 April 2021

Scope of trademark

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, and any combination of those elements 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 that are 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 not be deemed acceptable 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 also registrable under the TM Act. In addition, non-traditional trademarks such as sound marks, shape marks, colour marks, image marks, architectural marks, etc, are registrable in India.

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

Law stated - 22 April 2021

Unregistered trademarks

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.

Law stated - 22 April 2021

Famous foreign trademarks

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 (the Registrar) considers the following factors when determining a trademark's well-known status:

- the knowledge and recognition of the trademark in the relevant section of the public in India;
- the duration, extent and geographical area of the trademark's use (within and outside India);
- the duration, extent and geographical area of promotion of the trademark, 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 trademark to be used, registered or applied for in India, or 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 Trade Marks Registry (the Registry):

- a statement of case describing the applicant's rights and well-known claim in the trademark; and
- the following documentary evidence to substantiate the applicant's rights and claim:
 - the use of the trademark through copies of advertisements, invoices, news articles, etc, available internationally and in India;
 - any trademark registrations or applications pending registration, if available;
 - the 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 any 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, if available; and
 - a copy of the judgment by the Indian courts or the Registrar, wherein the trademark is determined as a well-known mark, if available.

Law stated - 22 April 2021

The benefits of registration

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 Registry, 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 the 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 Registry as well as with the customs authorities in India.
- **Security or hypothecation:** registered trademarks can be used as security to avail loans similar to immovable properties.

Law stated - 22 April 2021

Filing procedure and documentation

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:

- a clear representation of the trademark in soft copy (in case of a design mark);
- power of attorney;
- a certified copy of the priority application, if priority is claimed; and
- an 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 three-dimensional (3D) trademarks, the reproduction must contain a two-dimensional graphic or photographic reproduction with the trademark's three different views; if required, the 3D trademark's specimen or five views may 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 may 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.

It is not mandatory under the TM Act to carry out trademark searches before filing an application. However, it is recommended to carry out trademark searches to ensure that there are no conflicting trademarks in the Registry.

Law stated - 22 April 2021

Registration time frame and cost

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. Further, a trademark registration effectuates from the date of filing the trademark application in India.

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 and any subsequently filed written submissions;
- oppositions filed against the trademark; or
- amendment and assignment recordation applications filed by the applicant.

Law stated - 22 April 2021

Classification system

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 its 11th edition.

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.

Law stated - 22 April 2021

Examination procedure

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 a 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 abandoned.

Law stated - 22 April 2021

Use of a trademark and registration

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?

The applicant must specify in the trademark application whether or not its trademark is used in India. 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. However, the trademark will be vulnerable to non-use cancellation action if it is not used in India for a continuous period of five years from the date of its actual registration (ie, the date on which the registration certificate is issued).

Law stated - 22 April 2021

Markings

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 trademark law. However, in India, the ® symbol is widely used to indicate a registered trademark, and the letters 'TM' are used to indicate an unregistered trademark.

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

Law stated - 22 April 2021

Appealing a denied application

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. Under the recently promulgated Tribunal Reforms (Rationalisation and Conditions of Service) Ordinance 2021 (4 April 2021), the Registrar's decisions can be appealed before the relevant high courts within three months of the Registrar's order.

Law stated - 22 April 2021

Third-party opposition

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 on the applicant, and the applicant is required to file a counterstatement along with the official fees in the Registry within two months of the Notice's receipt.
- The Registry serves the applicant's counterstatement copy on 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 the counterstatement's receipt.
- Subsequently, the applicant must either file the affidavit of evidence in support of its application 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 receipt of the applicant's affidavit from the applicant, the opponent may file an affidavit of evidence in reply to the applicant's affidavit, which is optional.
- Thereafter, the Registry schedules a hearing to conclude the opposition proceedings.

A cancellation application may be filed by any aggrieved party before the Registry or before a high court with relevant jurisdiction 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 Registry;
- absence or omission of any entry in the Registry;
- any entry made without sufficient cause in the Registry;
- any entry wrongly remaining in the Registry; or
- an error or defect in any entry in the Registry.

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 receipt of the applicant's evidence.
- 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.

Under the newly introduced Tribunal Reforms (Rationalisation and Conditions of Service) Ordinance 2021 (4 April 2021), proceedings before the high courts will be faster and based on the rules of practice of the relevant high courts. To give a broad summary, the procedure will include the following:

- The cancellation application, along with the supporting evidence and the court fee must be filed.
- Upon the cancellation application's receipt, the high court will scrutinise the application, register it and serve the application on the respondent.
- After receipt of the cancellation application, the respondent must file the counterstatement along with the evidence and the official fee in the high court with a copy to the applicant.
- Thereafter, the high court will hear both the parties and decide the dispute.

The official fee for filing a Notice or a cancellation application before the Registry is 2,700 rupees for online filing and 3,000 rupees for physical filing, for each class opposed and counterstatement filed.

At the high court, the official fee (court fees) for filing the cancellation application and counterstatement will depend on the jurisdiction and the applicable rules of practice of the relevant high court.

In July 2021, the High Court of Delhi created its Intellectual Property Division (IPD) to deal with intellectual property rights matters, including cancellation applications. The official fee for filing a cancellation application before the High Court of Delhi's IPD is 525 rupees.

Law stated - 22 April 2021

Duration and maintenance of registration

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 at the end of 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 for a continuous period of five years after the trade mark has been entered in the Register.

Surrender**What is the procedure for surrendering a trademark registration?**

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

Law stated - 22 April 2021

Related IP rights**Can trademarks be protected under other IP rights?**

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.

Law stated - 22 April 2021

Trademarks online and domain names**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 specific statute 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.

Law stated - 22 April 2021

LICENSING AND ASSIGNMENT**Licences**

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?

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 Trade Marks Registry (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 of Trademarks 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.

Law stated - 11 August 2022

Assignment

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.

Law stated - 11 August 2022

Assignment documentation

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

In India, a trademark assignment can be made with or without goodwill. An assignment deed must specify the effective date of assignment, details of the assignor and the assignee, the trademark details to be assigned, a consideration amount paid by the assignee to the assignor, a clear statement as to whether the assignment is made with or without goodwill, and authorised signatories' details and their signatures.

Further, 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 in 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 adequate Indian stamp duty prior to being filed 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.

Law stated - 11 August 2022

Validity of assignment

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.

Law stated - 11 August 2022

Security interests

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.

Law stated - 11 August 2022

ENFORCEMENT

Trademark enforcement proceedings

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.

The government recently abolished the Intellectual Property Appellate Board (IPAB) through the Tribunal Reforms (Rationalisation and Conditions of Service) Ordinance 2021 (4 April 2021). As per the ordinance, the powers of the IPAB have been given to the high courts of India.

The High Court of Delhi's Intellectual Property Division will deal with all original and appellate proceedings, including infringement actions, passing-off actions, cancellation actions and all other proceedings that were previously maintainable before the IPAB.

Law stated - 22 April 2021

Procedural format and timing

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 the 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 of Trademarks (the Registrar) opinion prior to making any search and seizure.

Law stated - 22 April 2021

Burden of proof

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, in the infringement proceedings, the burden of proof to establish the validity of a trademark registration is on the plaintiff.

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.

Law stated - 22 April 2021

Standing

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

In India, 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.

Law stated - 22 April 2021

Border enforcement and foreign activities

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 borders against the import of infringing goods. The IPR Rules empower the customs authorities 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, the customs authorities 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

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.

Law stated - 22 April 2021

Timing

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 defendant appears, 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.

Law stated - 22 April 2021

Limitation period

What is the limitation period for filing an infringement action?

The limitation period for filing infringement actions is three years from the date on which 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.

Law stated - 22 April 2021

Litigation costs

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 the 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 the litigation costs is incurred at the interlocutory stage, which is the most effective and important stage of the litigation.

Law stated - 22 April 2021

Appeals

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 high court having jurisdiction within three months of the date of the Registrar's order. Appeals from the decisions of the single bench of the high court can be filed before the division bench of the high court, and the division bench's order can be appealed before the Supreme Court of India.

Law stated - 22 April 2021

Defences

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 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.

Law stated - 22 April 2021

Remedies

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, as well as punitive damages (usually twice the amount of compensatory damage) and exemplary costs, etc.

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

Law stated - 22 April 2021

ADR

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 proceedings.

Law stated - 22 April 2021

UPDATE AND TRENDS




Key developments of the past year

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

Law stated - 11 August 2022

Jurisdictions

	Angola	RCF – Protecting Innovation
	Austria	Barger Piso & Partner
	Brazil	Bhering Advogados
	Canada	Bereskin & Parr LLP
	China	Jones & Co
	Colombia	OlarteMoure
	Denmark	Accura Advokatpartnerselskab
	European Union	Noerr PartGmbB
	Germany	Meissner Bolte
	Guatemala	Palacios & Asociados/Sercomi
	India	ANA Law Group
	Indonesia	Affa Intellectual Property Rights
	Israel	Reinhold Cohn Group
	Italy	Spheriens
	Japan	Anderson Mōri & Tomotsune
	Macau	RCF – Protecting Innovation
	Mexico	Uhthoff, Gómez Vega & Uhthoff SC
	New Zealand	PIPERS
	Peru	Estudio Colmenares & Asociados
	Portugal	RCF – Protecting Innovation
	Romania	Cabinet M Oproiu Patent & Trademark Attorneys
	Saint Lucia	Goddard-Dorville Legal
	Singapore	Ella Cheong LLC
	South Africa	Spoor & Fisher
	South Korea	Bae, Kim & Lee LLC

	Switzerland	Wenger Vieli Ltd
	United Kingdom	AA Thornton
	USA	Kilpatrick Townsend & Stockton LLP