



LAW RELATING TO TRADEMARK
PART- 4

Relative Grounds for Refusal of Registration

Section 11(1) stipulates that a trademark shall not be registered if, because of:

- (a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or
- (b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

Section 11 (2) states that a trade mark which

- (a) is identical with or similar to an earlier trade mark; and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered if or to the extent the earlier trade mark is a well known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

Section 11 (3) and (4) Provisions

Section 11 (3) provides that a trademark shall not be registered if, or to the extent that, its use in India is liable to be prevented

- (a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
- (b) by virtue of law of copyright.

Section 11(4) states that nothing in this section shall prevent the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration, and in such case the Registrar may register the mark under special circumstances under section 12.

Earlier Trade Mark means

- (a) a registered trade mark or an application under section 18 bearing an earlier date of filing or an international registration referred to in section 36E or convention application referred to in section 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks.
- (b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.

Determining Well-Known Trade Marks

As per Section 11 (6) of the Act, the Registrar shall, while determining whether a trademark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trademark including

(i) Knowledge or Recognition

the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) Duration and Extent of Use

the duration, extent and geographical area of any use of that trade mark;

(iii) Promotion Activities

the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) Registration Records

the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) Enforcement History

the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

Section 11(7) - Relevant Section of the Public

Section 11(7) provides that the Registrar shall, while determining as to whether a trademark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account³

1. (i) the number of actual or potential consumers of the goods or services;
2. (ii) the number of persons involved in the channels of distribution of the goods or services;
3. (iii) the business circles dealing with the goods or services; to which that trade mark applies. Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:

- (i) that the trade mark has been used in India;
- (ii) that the trade mark has been registered;
- (iii) that the application for registration of the trade mark has been filed in India;
- (iv) that the trade mark³
 - (a) is well-known in; or
 - (b) has been registered in; or
 - (c) in respect of which an application for registration has been filed in, any jurisdiction other than India, or
- (v) that the trade mark is well-known to the public at large in India. While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall⁴
 - (i) protect a well-known trade mark against the identical or similar trademarks;
 - (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

Where a trade mark has been registered in good faith disclosing the material information to the Registrar or where right to a trade mark has been acquired through use in good faith before the commencement of this Act, then, nothing in this Act shall prejudice the validity of the registration of that trade mark or right to use that trade mark on the ground that such trade mark is identical with or similar to a well-known trade mark

Case Study: Imperial Tobacco Co. vs. Registrar

In the case of **Imperial Tobacco Co. of India Ltd. vs. The Registrar of Trade Marks** Calcutta High Court judgement dated 28 May, 1968, the Imperial Tobacco Company manufactured and distributed cigarettes with a label "simla" all over the country. ITC Ltd. made an application to the Registrar for the registration in the year 1960 and 1966. But both the times the registration application was refused by the registrar. The Calcutta High Court rejected the appeal on the ground that the term "simla" is a famous geographical place. This term cannot be registered as a trademark. The trade mark "Simla" with the label is composite in character. Its essential feature is the word Simla. "Simla" is neither an invented word nor is it a word having a dictionary meaning. It is a well-known hill-station of India. Its geographical signification is, therefore, plain and unequivocal. The snow-clad hills in outline on the label makes the geographical significance inescapable.



Prohibition of Registration

Prohibition of Registration of Names of Chemical Elements or International Non-Proprietary Names

Section 13 states that no word (a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or (b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name, shall be registered as a trade mark and any such registration shall be deemed for the purpose of section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.

Use of Names and Representations of Living Persons or Persons Recently Dead

Where an application is made for the registration of a trade mark which falsely suggests a connection with any living person, or a person whose death took place within twenty years prior to the date of application for registration of the trade mark, the Registrar may, before he proceeds with the application, require the applicant to furnish him with the consent in writing of such living person or, as the case may be, of the legal representative of the deceased person to the connection appearing on the trade mark, and may refuse to proceed with the application unless the applicant furnishes the Registrar with such consent.

Withdrawal of Acceptance and Advertisement

Withdrawal of Acceptance

Section 19 provides that where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied

- (a) that the application has been accepted in error; or
- (b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

Advertisement of Application

According to Section 20, once the Registrar for registration has accepted the application, he shall get the application advertised in the prescribed manner after acceptance. However, the application shall be advertised before acceptance if the application is related to a trademark to which Section 9(1) and Section 11(1) & (2) apply or in any other case as it seems expedient to the Registrar. The purpose of advertisement is to give information to the public at large in respect of the trademark advertised and afford an opportunity to oppose the registration of the mark on given grounds. So the advertisement must be complete in all respects and otherwise the very purpose of advertisement will be frustrated. If there is incomplete or incorrect information in the advertisement, it would amount to misrepresentation, which deprives a prospective opponent of the opportunity to get full information and of filing an effective opposition.

Registration Process

Registration

Section 23 states that subject to the provisions of section 19, when an application for registration of a trade mark has been accepted and either:-

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant, the Registrar shall, unless the Central Government otherwise directs, register the said trade mark within eighteen months of the filing of the application and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of section 154, be deemed to be the date of registration.

On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice. The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

Duration, Renewal, Removal and Restoration of Registration

Section 25 of the Act deals with duration, renewal of registration, for removal and restoration of registration. It allows registration of a trademark for a period of 10 years. In keeping with the generally accepted international practice and to reduce the work-load of the Trade Marks Office, Section 25 allows renewal of registration for successive periods of 10 years, from the date of the original registration or the last renewal. With a view to facilitate renewal of registration, Section 25(4) provides for restoration of removed trade marks on payment of renewal fee.

Can a Registered Trademark be Removed from the Register? It can be removed on application to the Registrar on prescribed form on the ground that the mark is wrongly remaining on the register. The Registrar also can suo moto issue Notice for removal of a registered trademark.



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