

TRADEMARK REGISTRATION IN INDIA – PART 1



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With the advent of branding and the increase in value being attached to it, the issue of protection of consumers from unauthorized violation of brands is gaining importance. Most often than not, a brand is represented by a mark, called its trademark. The trademark associates a source or quality or character of a good or service with itself. Accordingly, protecting a trademark from unauthorized use is highly warranted.

Trademarks are protected in India by the Trademarks Act, 1999 (TM Act). The TM Act defines a trademark as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof, which is used to distinguish **goods and services** provided in the course of trade by a person from the goods and services provided by other person and should be capable of being graphically represented. The TM Act calls for registration of trademarks so as to make any likelihood of causing deception in a mark impermissible in law.

A trademark once registered under the act gives the trademark proprietor some very important legal rights. Firstly, the registration of trademark provides the proprietor of the trademark, exclusive rights to use the TM in relation to the goods or services. Secondly, the registration of the trademark is a prima facie proof of validity of the registered trademark. In any legal proceeding, this is highly important. Thirdly, the registration of trademark allows the proprietor of the mark to license his/her rights in the trademark to a third party. This acts as a constant source of royalty for trademark proprietors. All the franchise chains that you find around are a result of licensing of trademarks.

However, most importantly, the registration of trademark provides the proprietor with rights to prevent unauthorized use of his/her registered trademark. The prevention may be in form of injunctions (temporary or permanent stays) ordered by a court of law, or in form of damages. This remedy is not available to unregistered trademarks as section 27 of the TM Act states that no infringement action is maintainable under the TM Act against an unregistered trade mark.

In a recent case, *Mahashian Di Hatti Ltd (MDH) Vs Mr. Raj Niwas*, Proprietor Of MHS, the Delhi High Court restrained MHS from manufacturing and marketing any spices or condiments using the logo MHS owing to its similarity to MDH. The court held that such use is in violation of the trademark held by MDH. Interestingly, MDH was also awarded punitive damages amounting to Rs. 1 lakh against MHS. In another landmark judgment, *Hero Honda Motors Ltd. Vs Mr. Laxmikant Patel And Anr.*, the Delhi High Court allowed Hero Honda to take infringing goods of the deceiver and destroy those goods. A huge penalty of Rs. 5 lakh was also charged for the infringement of trademark protected in favor of HERO HONDA.

There are myriad examples in trademark jurisprudence in which the trademark proprietors have successfully and easily got stays or received punitive damages from courts of laws in case of violation of their trademark rights. Trademark disputes are treated differently by the courts from common civil disputes, and the enforcement is relatively easy.

