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Legal – Patent and Trade Mark/Brand – Brief insight on Registration



Smriti Yadav & Saumya Gupta, *Advocates*

Innovation is necessary for the growth of any country. It is also necessary that the individual/entity contributing towards such innovation is well rewarded. This is where the role of intellectual property ('IP') comes into play. Amongst other forms of IP like Copyrights, Designs, Geographical Indications, etc., Trademarks and Patents are two most familiar forms of IP, where the former protects the identity of the brand, making it easier for the consumer to identify the origin or source of a particular product, while the latter protects inventions by giving rights to the inventors or assignees/licensees of such inventors. Protecting the brand/invention and the identifiers of such brand/invention acts as a catalyst to boost the economy by protecting interests of various sectors such as FMCG, automobile, pharmaceuticals, chemicals, mechanical engineering, technology, retail, etc.

I. TRADEMARKS

A consumer is duped if he/she buys a commodity presuming it to have originated from a certain identified source, when actually it hasn't, and later finds the commodity to be of a sub-standard nature. In this process, the reputation of the trader suffers. The interests of both the consumers and the traders can be saved if some definite symbol which marks the origin of goods from

a definite trade source is attached with the goods emanating from such source. In simple terms, such a symbol is called a trademark.

Thus, a trademark is some symbol consisting in general, of a picture, label, word or words, which is applied or attached to goods of a trader so as to distinguish them from similar goods of other traders and to identify them as ones own goods or as those of ones successors in the business in which they are produced or put forward for sale. For example, the trademark 'MAYBELLINE' distinguishes the cosmetics of 'MAYBELLINE' from those of, say 'REVLON'. The brand 'REVLON' is a separate trademark which distinguishes the make-up products manufactured under other brands like 'LAKME', 'FACES', 'SUGAR', 'L'Oréal', etc. Thus, a trademark is an intangible property right and the law protects that right.

A trademark is designated by the following symbols:

- i) TM - It is used for an unregistered trademark to promote or brand goods.
- ii) SM - It is used for an unregistered service mark to promote or brand services.
- iii) ® - It is used for a registered trademark or a service mark.

A. Functions of a Trade Mark




A trademark serves the purpose of identifying the source of origin of goods/services. A trademark performs the following four functions:




- i) Identifies the product and its origin
- ii) Guarantees quality of the products
- iii) Advertises the product
- iv) Creates an image of the product in the minds of the public

In India, the Trademarks Act, 1999 (hereinafter referred to as the ‘**TM Act**’) read with the Trade Mark Rules, 2017 (hereinafter referred to as the ‘**TM Rules**’) governs the landscape in relation to trade marks. Section 2(1)(zb) of the TM Act provides for the definition of a “trade mark” as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours; whereas Section 2(1)(m) of the Act provides that a “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.

B. What Can be Registered as a Trademark



There are different types of trademarks which can be registered in India and details of the same are as follows:

- i) **Word marks:** These would contain words or letters or numerals or a combination of the aforesaid. For e.g., CALVIN KLEIN, PANASONIC, etc.
- ii) **Device marks:** These marks consist of exclusive representation of a word, letter or numerical. For e.g. , , , etc.

- iii) **Figurative marks/logos:** They consist of a figure or a logo. For e.g. , (the SWOOSH sign of Nike),  (Apple logo),  (Mercedes-Benz logo) etc.

- iv) **Service Marks:** A service mark is any sign, mark, symbol, word, or design or a combination of any two or more of these, indicating the services of a company or any entity making it distinguishable from the services of any other entity. A service mark is used by a business that offers services. For

e.g. , , , etc.

- v) **Collective Marks:** These marks serve to distinguish members of a collective group. The owner of such marks may be an association or public institution or cooperative. For e.g. , (CA used by members of the Institute of Chartered Accountants),  (CS used by the members of the Institute of Company

Secretaries of India), , etc.

- vi) **Certification Marks:** They are used to define standards and assure the consumers that the product meets certain prescribed standards in terms of origin, material, quality, and quantities.

For e.g., , , etc.

- vii) **Series Marks:** These are the marks which are registered to use before or after a chain of products where there would be a common suffix/prefix or symbol. Series marks help form an association amongst the products as they fall within the same family of marks and distinguish them from the other

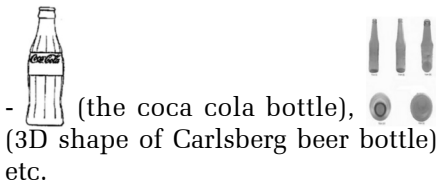
range of products. The series of marks can be registered within one application whereby particular characters can be granted additional protection. For e.g., 'MC' series in McDonald's is an example of a series mark, this family includes, McCafe, McPuff, Chicken McNuggets, McVeggie etc.

- viii) **Well-known marks:** When a mark is easily recognised among a large percentage of the population it achieves the status of a well-known mark. For e.g.



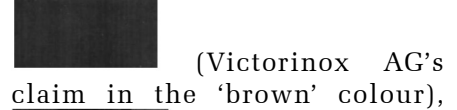
- ix) **Unconventional/Non-Traditional Trademarks:** Apart from the aforesaid marks, there is a new category of modern marks/unconventional trademarks whereby colour, sound, shape of goods, smell, motion, taste, touch/texture, position and hologram marks are also protected as trademark. In India, unconventional marks like shape of goods, sound marks, colour marks, motion marks etc. can be granted protection under the TM Act if they fulfill the criteria required for trademark registration. Following are the examples of unconventional trademarks registered in India:

- Example of shape marks (3D marks)



- Example of sound marks - Yahoo Inc.'s three-note Yodel, Nokia mobile phone's default ring tone, MGM film's lion's roar, ICICI Bank's corporate jingle etc.


- Examples of colour marks -



(Victorinox AG's claim in the 'brown' colour),



(Missionaries of Charity, Kolkata), etc.

- Example of motion mark -  (Nokia Corporation's motion trademark of 'connecting hands').

C. What cannot be Registered as Trademark

To qualify for registration, a trademark has to meet some important requirements viz., it has to be distinctive, capable of graphical representation and also has to distinguish the goods of one person from those of others. In cases where a trademark is unable to meet these requirements, the registration is refused.

Thus, a mark which does not have a distinctive character, or has become customary in current language, or serves in trade to designate kind, quality, quantity, intended purpose, values, geographical origin, or causes confusion or deception, or is likely to hurt religious sentiments, or contains obscene or scandalous matters, or is prohibited from use under the Emblems and Names (Prevention of Improper Use) Act, 1950, or contains exclusively the shape of goods resulting from nature of the goods themselves or necessary to obtain a technical result or gives substantial value to goods, or is identical or similar to an earlier trade mark or a well-known trade mark, or is prevented by law of passing off or law of copyright, will be refused registration. These grounds for refusal are well elaborated under Section 9 (which provides for absolute

grounds for refusal of trademark registration) and Section 11 (which provides for relative grounds for refusal of trade mark registration) of the TM Act.

D. Spectrum of Trademark Distinctiveness vis-a-vis Registrability

A trademark would be considered a good trademark when it is distinctive, i.e., if it earmarks the goods marked as distinct from those of other goods. Distinctiveness may be inherent or acquired. Inherent Distinctiveness means that the mark or get-up is distinct in itself from everything else and no one can justifiably claim the right to use it, for instance, an invented word like 'SPOTIFY', 'KODAK', etc. Acquired Distinctiveness means distinctiveness which has been attained through use of the trademark. Most of the trademarks acquire distinctiveness through long and constant use, like the news channel 'AAJ TAK'.

A highly distinctive trademark will be considered as a strong mark, whereas a scarcely distinctive trademark will be considered as a weak mark. Generally, the stronger the mark is, the easier it is for the mark to be eligible for registration and to obtain protection from unauthorized use and registration by others. The types of marks discussed below range from the strongest to the weakest:

- i) ***Fanciful or Coined or Invented Marks*** – These are at the strongest end of the spectrum of distinctiveness and consists of a combination of letters that have no meaning. For e.g. 'GOOGLE', 'ROLEX', 'ZOMATO' etc.
- ii) ***Arbitrary Marks*** – It consists of a word or words that have a common meaning in the language of the relevant

jurisdiction, however, that meaning is unrelated to the goods or services for which the mark is used. For e.g. 'APPLE', 'DOVE', 'STARBUCKS' etc.

- iii) ***Suggestive Marks*** – These marks hint at or suggest the nature of a product or service or one of its attributes without actually describing the product or service. For e.g. 'AIRBUS', 'NETFLIX', 'INFOSYS', 'BURGER KING' etc.
- iv) ***Descriptive Marks*** - It consists of a word or words that merely describes a product or its ingredient, quality, characteristic, function, feature, purpose or use. For e.g. 'COLD AND CREAMY', 'HOLIDAY INN', 'CAFÉ COFFEE DAY' etc.
- v) ***Generic Marks*** - These are at the weakest end of the spectrum of distinctiveness and are not registrable or protectable in relation to the products or services they signify. For e.g. 'SHOES' for footwear etc.

Also, there are certain terms that were not generic originally can, under certain circumstances, become generic when a majority of the relevant consuming public comes to consider it the name of the product. For e.g. 'XEROX', 'ASPIRIN', 'CELLOPHANE' etc.

E. Registration of a Trademark

- A trademark can be registered by filing a requisite application with the relevant Trademarks Registry ('TMR'), present in New Delhi, Mumbai, Ahmedabad, Kolkata and Chennai. For doing so, a few basic documents are required. For instance, if the mark is being filed on a 'proposed to be used' basis, then only a

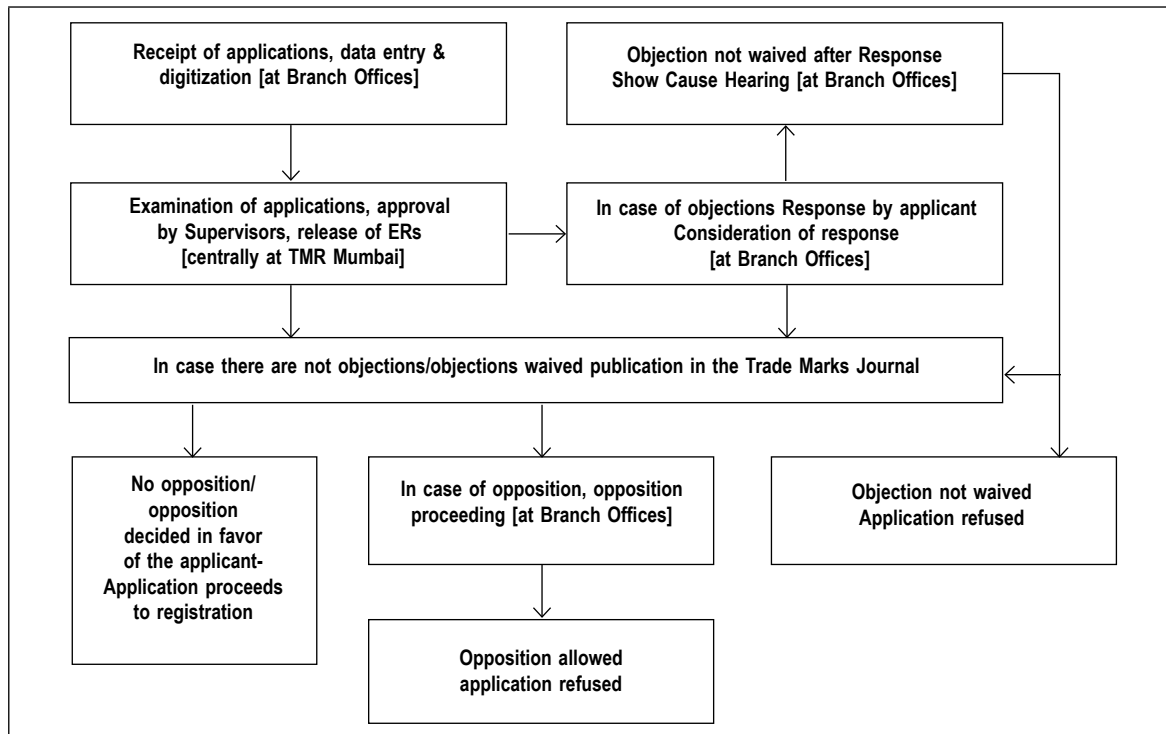
Power of Attorney is required, whereas, if the mark is filed with any user claim, then apart from a Power of Attorney, a user affidavit is also required. This affidavit is typically accompanied with documents evidencing use of the trademark applied for registration such as sales invoices, newspaper articles, advertisement and promotional material, etc.

- Apart from the aforementioned documents, a few basic and other details are required, like - name, address, nationality of the application, relevant class of goods/services, specification of goods/services etc. For a mark which contains non-English and non-Hindi characters, a translation and transliteration respectively is required in English language.
- The application for registration of the trademark can be filed by an individual, a start-up, a company, a sole proprietorship firm through its proprietor, a partnership firm, a government department, a statutory organization/public sector undertaking, a trust or society, a Hindu undivided family, an association of persons or entities. The fees to be paid by an individual/start-up/small enterprise is

INR 5000 for physical filing and INR 4500 for online filing of an application for one mark in one class. For the rest of the aforementioned applicants, the fees is INR 10000 for physical filing and INR 9000 for online filing of applications. In many foreign jurisdictions, there are additional fees payable for publication and registration of a mark. However, no such fees are required to be paid in India until the conclusion of registration of trademark. The aforementioned fees are paid one time to the TMR during the filing of the application.

- Post filing of application, the mark is examined and if found to be in order, it proceeds for publication in the Trademarks Journal. Once published, anyone from anywhere in the world can file an opposition against the mark so published, if it is identical or similar to the trademark of the person/entity filing an opposition. In a situation where no opposition has been filed within four months of publication of the mark, the same proceeds to registration.
- The registration of a trademark may be completed somewhere between 6 to 8 months in case the registration process goes on smoothly, i.e., no objections are raised by the TMR or oppositions are filed by third parties.

The process for registration of trade marks as explained above is represented in the following flowchart:



Source: <https://ipindia.gov.in/workflow-chart.htm>¹

F. Term of Registration

If a trade mark is registered, its registration is valid for a period of ten years. The registration of the trade mark can be renewed after every ten years for infinite years by filing a request under Form TM-R and payment of prescribed fees for renewal.

II. PATENTS

Patents are perhaps known to be one of the most important IPs as they help in the creation of wealth for the inventor, promote industrial development, and also enable research and development, which further helps in the economic growth of the country. For instance, the patent

policy pursued by India enabled it to become a big international player in the generic drug market.

Patents refer to a grant of some privilege, property or authority made by the government of the country to one or more individuals. Such a right allows an inventor or his/her assignees to exclude others to use, make and sell an invention for a specific period of time. Thus, a patent gives a monopoly right to a person who has invented a new and useful product or a new process of making a product or an improvement or modification of an existing product or process.

1. The flow-chart has not been updated as per the source.

The Patents Act, 1970 (hereinafter referred to as '**Patents Act**') and The Patents Rules, 2003 (hereinafter referred to as '**Patents Rules**') govern the law regarding patents in India. The basic goal of the Patents Act is to encourage innovators to contribute more to their fields by giving them exclusive rights to their inventions. Section 2(m) of the Patents Act defines 'patent' as a patent for any invention granted under the Patents Act; whereas an 'invention' is defined under Section 2(1)(j) of the Patents Act as a new product or process involving an inventive step and capable of industrial application. A patent right is territorial in nature. As a result, it can only be applied in the country where it has been granted.

Under the Patents Act, what is granted is not merely the right to make, use, offer for sale, sell or import, but the right to exclude others from making, using, offering for sale, selling or importing the invention for a limited period of time, i.e., 20 years. Thus, there will be no other competing products during the patent term. Hence, the patent owner can meet the demand of the market by supplying the entire market. Lack of competition also allows the patent owner to set a higher price for the product since consumers can only access the patented product. However, to avoid any abuse of the rights granted under the Patents Act, certain limitations and compulsory licensing provisions have been included in the Patents Act, which can be invoked in certain circumstances.

A. Essentials of a Patent

There are three major ingredients of a patent, viz.:

- i) **Novelty** - The invention must be novel and it is considered so if it does not already exist or is not known to the public in any form, such as oral, written, or any other form, on the date of filing of the application for

registration of a patent. If something is already in the public domain, it will not be considered novel or new.

- ii) **Non-obviousness/inventive step** - The invention must be non-obvious, i.e., it must be a considerable improvement over the prior one; a mere change in technique alone will not grant the inventor the right to a patent. The obviousness must be judged by the standard of a man skilled in the art.
- iii) **Capable of Industrial application** - The invention must have practical utility such that it can be made or used in an industry. It is pertinent to mention that in certain countries, not so useful inventions are protected as 'utility models'. But the concept of 'utility models' is not statutorily recognized in India.

B. Non-Patentable Inventions

Some inventions as specified under Sections 3 and 4 of the Patents Act are not patentable. These are: inventions which are frivolous or contrary to the well-established natural laws or their use or exploitation is contrary to public order or morality; mere discovery of a scientific principle or formulation of an abstract theory or discovery of any living thing or non-living substance occurring in nature; mere discovery of a new form of a known substance which does not result in the enhancement of the known efficacy of that known substance; substances obtained by mere admixture resulting only in the aggregation of the properties of the components thereof or a process for producing such substances; mere arrangement or rearrangement or duplication of known devices each functioning independently of one-another in a known way; methods of agriculture or horticulture; plants or animals in whole or any part thereof other than micro-organisms but including seeds, varieties and

species and essentially biological process for production or propagation of plants and animals; mathematical or business methods or computer programmes per se or algorithms; literary, dramatic, musical or artistic works; presentation of information etc. It is notable that some of these inventions/works are not patentable because they form a subject matter of other IP laws, for example copyright, plant variety protection etc.

C. Registration of Patent in India

India is a first-to-file jurisdiction and so the emphasis is on date of application and not on the date when the invention was invented. Applications for a patent can be filed by the true and the first inventor or their assignees or legal representatives of a deceased person in Form 1. The application for a patent can be made in respect of one invention only either in English or Hindi language.

Apart from the above, an international patent application can also be filed under Patent Cooperation Treaty ('PCT'), which allows filing of a single international patent application for registration in various countries, instead of filing several separate national or regional patent applications.

When filing an application, it is necessary that due importance is given to drafting of specifications and claims, as they play an important role in deciding the fate of a patent application. A specification is a technical document which describes the invention and can be either a provisional specification (which sets out the basic initial description of the invention and its essential features) or a complete specification (which sets out the complete and detailed description of invention). Claims, on the other hand, are the concise definitions of various aspects of the invention. They serve as the primary source of proprietary rights and distinguish one invention from another.

While the Patents Act grants the exclusive right to the inventor to exploit his/her invention for commercial gain for a specific period of time, it also imposes a duty on the inventor of fully disclosing the invention in the complete specification so as to facilitate anyone from the public working the invention, once the protection period expires.

The full disclosure of the patented invention is mandatory. If an inventor fails to disclose the invention fully, the patent will not be granted. The validity of such a patent, even if granted, can be contested by an opposing party. The patent can be revoked on such a successful contest succeeding.

D. Procedure for Grant of Patent in India

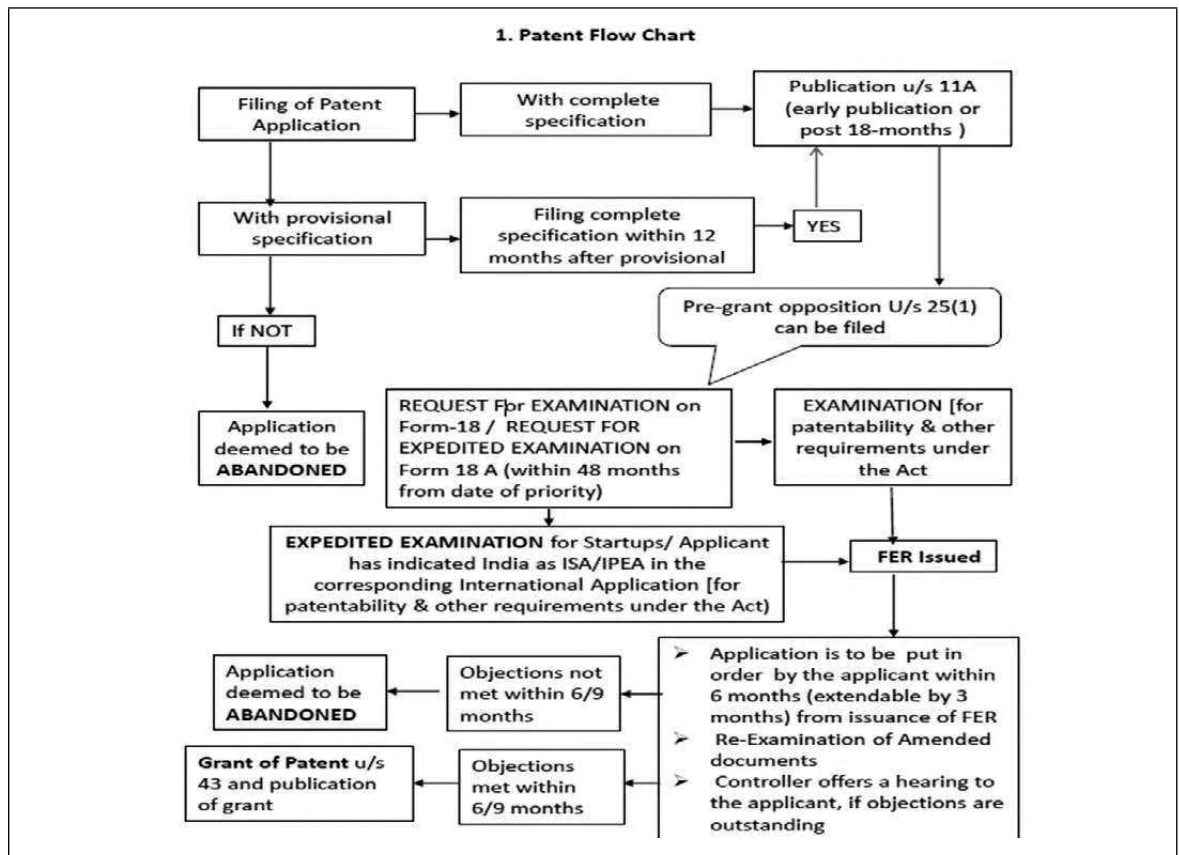
- i) A patent application can be filed with the relevant Indian Patent Office (which is present in New Delhi, Mumbai, Kolkata and Chennai) either with a provisional specification or a complete specification. In case the application for patent is filed with provisional specification, then the complete specification has to be filed within 12 months of filing of provisional application.
- ii) Once the complete specification is filed, the application proceeds for publication in the Office Journal of the Patents Office which is published every week. It is important to note that once an application is published, the applicant has the like privileges and rights of a patentee, except the right to sue for patent infringement.
- iii) Unlike other IPs where examination happens on its own, the examination does not happen on its own for patents and for an examination to happen, the applicant or any other interested person is required to file a request. In case of failure to file the examination

request, the application is considered as withdrawn. Upon receipt of examination request, the examiner checks the specifications and the drawing sheets, clerical errors, verifies the patent database and other information provided in the patent application, reviews whether the essential conditions of a patent have been met, whether the application is not hit by Section 3 and Section 4 of the Patents Act, etc. and then issues a first examination report ('FER').

- iv) Against the FER so issued, the applicant is required to file a response within the specified deadline. If no response

is filed within the specified deadline or the extended deadline, then the patent application is considered to be abandoned. In case the examiner is not convinced with the response to the FER, hearing(s) is fixed in the matter. But if the objections raised in the FER are complied with and the application is found to be in order, the application proceeds further for grant of patent. A letter patent is issued to the applicant and thereafter a notification regarding grant of patent is published in the Patent Office Journal.

The procedure for registration of patent is explained in the flowchart below:



Source: https://ipindia.gov.in/writereaddata/Portal/Images/pdf/Final_FREQUENTLY_ASKED_QUESTIONS_-PATENT.pdf

E. Opposition of a Patent

A patent is open to opposition in the pre-grant and post-grant stages and a few of the important grounds for filing opposition against a patent are: that the patent has been wrongfully obtained by the applicant from the opponent; the invention is known to the person skilled in the art (obviousness); the invention has been in use in India; the claims do not relate to the invention, etc. A brief about the pre-grant opposition and post-grant opposition has been provided below:

- **Pre-grant opposition:** In this stage, an opposition is filed by any person after the patent application is published in the journal but before a patent is granted. The grounds for pre-grant opposition are enlisted in Section 25 (1) of the Patents Act read with Rule 55 of the Patents Rules.
- **Post-grant opposition:** In this stage, an opposition is filed by any interested person within one year of publication of grant of patent. The grounds for post-grant opposition are enlisted in

Section 25(2) of the Patents Act and Rules 55A to 70 of the Patents Rules. Any individual who is interested in any of the specific grounds can file a post-grant opposition within one year of the date of publication of the grant of patent.

F. Term of Patent

A patent is protected for a restricted term of 20 years, which begins on the date the patent application is filed, irrespective of whether it is filed with provisional or complete specification. However, in case of applications filed under the PCT or under the Paris Convention, the term of 20 years begins from the international filing date or the priority date respectively.

Once a patent is granted, the patentee is required to pay the renewal fees every year, or a lump sum amount for all years can be paid. No renewal fees have to be paid for the first two years. However, from third year onwards, the renewal fees have to be paid, failing which the patent is ceased.



“The world is a grand moral gymnasium wherein we have all to take exercise so as to become stronger and stronger spiritually.”

— *Swami Vivekananda*

“I decline to be a slave to precedents or practice I cannot understand or defend on a moral basis.”

— *Mahatma Gandhi*