

Session 2: Trademarks, its types and importance for Industries and Start-ups

(Dec. 20, 11:30 Hrs. – 13:00 Hrs.)

Speaker: Mr. Akshay Ajaykumar, Associate at Sim and San Intellectual Property Attorney

This second session of the series was led by **Mr. Akshay Ajaykumar**, Associate at Sim and San Intellectual Property Attorney, Faridabad, Haryana. He has vast experience in the field of trademark and its legislation. During his talk he enlightened the participants with every detail pertaining to trademark, its types and registration processes national and international. The brief details of his talk are mentioned below:

- Trademarks are the crucial aspect in commercial fraternity. It guarantees the product quality, identification and characteristics of the product. Additionally it promotes the product/ service in the market to win the trust of the end users.

Eligibility Criteria for Trademark Registration: For goods/services to be legally classified as Trademark, they need to pass the following criteria.

- **Distinctiveness:** The goods and services for which the protection is being sought should possess enough distinctiveness to identify it as a trademark. It must be capable of identifying the source of goods or services in the target market.
- **Descriptiveness:** The Trademark should not be describing the description of the concerned goods or services. Descriptive marks are unlikely to be protected under trademark law. However, descriptive words may be registered if they acquire “secondary meaning”.
- **The similarity to the prior marks:** The mark should be unique and should not be having similarity with the existing marks.

Necessity of the trademarks: The actual value of any company is very much associated with the TM because the company attains a lot of profit and public trust by using the TM of the goods associated with it.

- Once the brand is associated in the market the company can attract the talents, clients, investors and stakeholders to the brand.
- Having a registered TM helps to get franchisees to use their TM and make money out of it. The registered and well recognized TM assures the trust in product and licensing the TM to third parties becomes easy.

Legislation of TM in India:

Acts:

- Trade Marks Act, 1999
- The Trade Marks (Amendment) Act, 2010
- Trademarks Act 1999 in the new elements
- TradeMarks (Amendment) Act, 2010
- Trade Marks Act 1999 (as amended till date)

Rules:

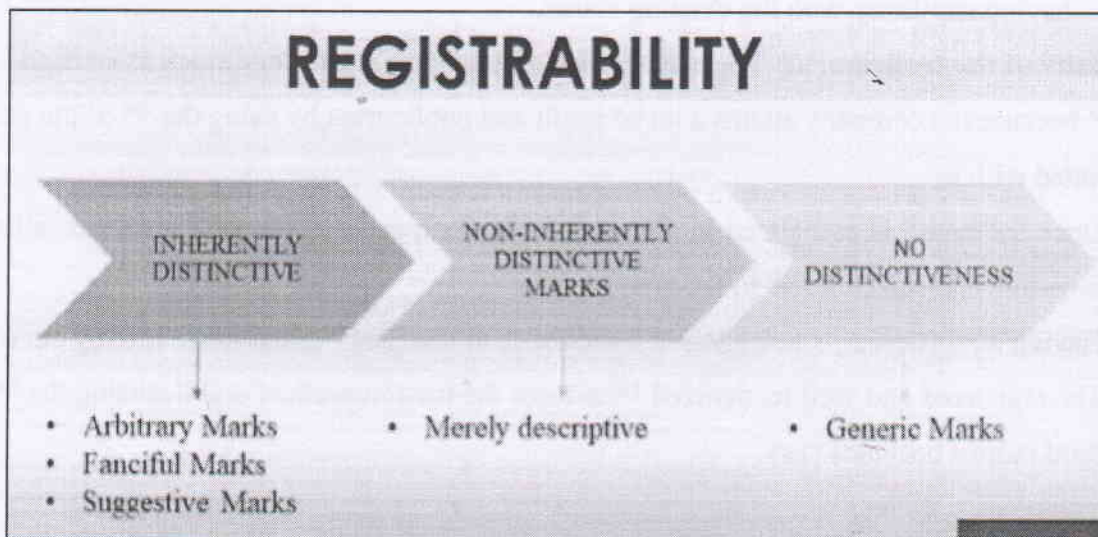
- Trade Marks Rules, 2017
- Trade Marks Rules, 2017
- Trade Marks (Amendment) Rules, 2013
- TM Amendment Rules 2013 Gazette Notification
- Trade Marks Rules 2002, Forms & Fee

The broad classification of trademarks are:

- Conventional TM
- Non-conventional TM

Conventional marks are easy to get registered because they fulfil all the criteria of registration, on the other hand the main issue with the non-conventional mark is its graphical representation. For instance in case of sound mark registration the applicant has to submit staff notation, sonogram, spectrogram and recording of the sound in a CD. The limit of the sound mark for registration is 30 seconds.

Registration of trademarks in India: Although, registration of a Trademark is not compulsory, registration provides certain advantages to the proprietor of the Trademark, such as Legal Protection, Exclusive right, Brand recognition and Asset creation.

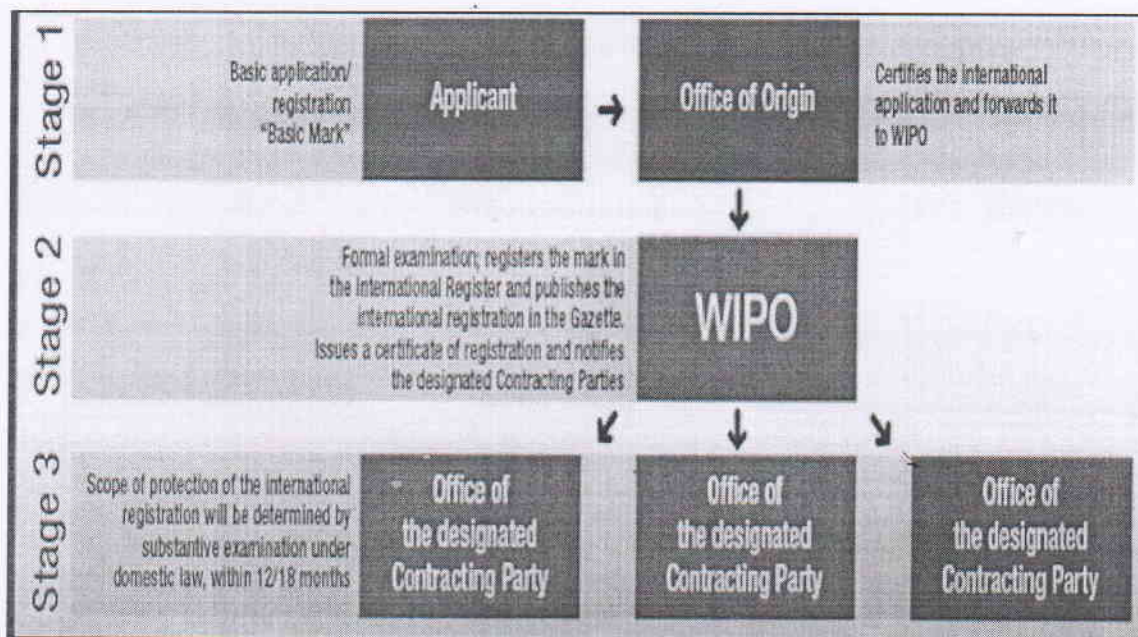


Trademark registry: In India, Trademark registry operates from five locations i.e. Delhi, Mumbai, Ahmadabad, Kolkata, and Chennai. In the case of Indian applicants, jurisdiction is decided based on the place of business of the applicant. In the case of foreign applicants, jurisdiction is based on the location of the office of the applicant's agent or attorney

Mr. Akshay further said that, the generic marks like BAND AID, N 95, Aspirin etc. are not distinctive and are not Registerable. He also explained about merely descriptive TM (Sugar free, Singapore Airlines, Jet Airways), Suggestive TM (Burger King, NETFLIX, Airbus), Arbitrary TM (apple, amazon), Fanciful TM (KODAC, EXXON, Polaroid).

International filing of TM through Madrid system:

The Madrid Agreement was concluded in the year 1891 for the international protection of trademarks. In 1989 a protocol was also concluded related to the Madrid Agreement. The protocol was signed to make the Madrid system more flexible for the countries who cannot comply with the Madrid system. The agreement and protocol is open to any state party to the Paris Convention. As of now, a total of 106 countries are party to 'Madrid Protocol'. The flow chart for international registration through madrid system in depicted below:



So with this Mr. Akshay resolved the queries put up by the participants. He stressed upon that like patents, trademarks are not being filed by the residents of India. Maximum numbers of the trademarks are being registered in India by non-residents applicants. Trademarks are very important part in the industrial fraternity and they should consider TM system seriously to popularise their brand and win the trust of public at large.