

PANORAMIC **TRADEMARKS**

India



LEXOLOGY

Trademarks

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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 - 31 July 2024

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 - 31 July 2024

Regulators

Which government bodies regulate trademark law?

The Trade Marks Registry (the Registry), supervised by the Controller General of Patents, Designs and Trademarks – a body established under the Department for Promotion of Industry and Internal Trade of the Ministry of Commerce and Industry, is the main body that regulates trademark law in India.

Indian courts deal with cases of trademark litigation, such as infringement, passing off, etc.

Law stated - 31 July 2024

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 - 31 July 2024

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 can be registered under the Trade Marks Act 1999 (the TMA) 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 TMA:

- non-distinctive trademarks 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.

The TMA also prohibits the registration of names of chemical elements or international non-proprietary names as trademarks.

Further, a trademark may be refused 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 registrable under the TMA. Also, non-traditional trademarks, such as sound marks, shape marks, colour marks, image marks and architectural marks, are registrable in India.

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

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.

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, Indian courts have recognised unregistered foreign trademarks' rights in India, based on the trademarks' trans-border reputation in India.

Law stated - 31 July 2024

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 are entitled to broader protection across all classes of goods and services under the TMA. The proprietary rights in well-known marks can be enforced against any conflicting trademarks across all classes, including unrelated goods and services, without having to prove that the trademark is registered or used in respect of 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 or recognition by a relevant section of the public in India;
- the duration, extent and geographical area of any use of that trademark;
- 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
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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 Registrar to consider that the trademark has been used, registered or applied for in India, is 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 TMR), a well-known declaration application shall be filed along with the following documents in the Registry:

- a statement of case describing the applicant's rights and well-known claim in the trademark; and
- documentary evidence to substantiate:
 - trademark's use;
 - trademark registration details;
 - annual turnover and sales statistics;
 - trademark's promotional materials and expenses;
 - knowledge and recognition of the trademark in the relevant section of the public in India and abroad; and
 - a copy of the judgment, if any Indian court or the Registrar has determined the trademark as well-known.

Law stated - 31 July 2024

The benefits of registration

What are the benefits of registration?

Some of the benefits of trademark registration in India are as follows:

- exclusivity: a trademark registration provides its owner exclusive ownership in the Register of Trademarks 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 Register as well as with the customs authorities in India; and
- security or hypothecation: registered trademarks can be used as security to avail loans, similar to immovable properties.

Law stated - 31 July 2024

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;
- power of attorney;
- certified copy of the priority document, if priority is claimed; and
- an affidavit of use, if the trademark's use in India is claimed.

The TMR governs the trademark's representation in the application, and mandates 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 different views must also be filed;
- for shape marks and packaging, the trademark's reproduction must contain five different views and a description of the trademark; if required, a specimen of the goods or packaging must also be filed; and
- for sound marks, 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. Carrying out trademark searches before filing is not mandatory, but it is recommended to check if there are any registered conflicting marks on the database.

Law stated - 31 July 2024

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?

Straightforward trademark registration in India usually takes between six and 10 months. The official fee for online filing applicable to individuals, start-ups and small enterprises is

4,500 Indian rupees, and for companies is 9,000 Indian rupees. The trademark registration effectuates from the date of filing the trademark application.

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;
- number of hearings scheduled by the Registry;
- oppositions filed against the trademark; or
- amendment and assignment recordation applications filed by the applicant.

Law stated - 31 July 2024

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 latest edition.

The TMA 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 - 31 July 2024

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 filing an extension application. If the applicant fails to file any response, the trademark application will be deemed abandoned.

Law stated - 31 July 2024

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 registration application must include details of the trademark's use 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 TMA 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 a non-use cancellation action by third parties if it is not used in India for a continuous period of five years from the date of its actual registration (namely, the date on which the registration certificate is issued).

Law stated - 31 July 2024

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 registered symbol is widely used to indicate a registered trademark, and the symbol is used to indicate an unregistered trademark.

The use of markings acts as a notice regarding the trademark rights to the public. However, representing an unregistered mark as registered by using the symbol or otherwise constitutes an offence under the TMA which is punishable with a fine.

Law stated - 31 July 2024

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 Tribunal Reforms (Rationalisation and Conditions of Service) Act 2021 (the Tribunal Reforms Act) dated 4 April 2021 the Registrar's decisions can be appealed before the appropriate High Court within three months of the Registrar's order.

Law stated - 31 July 2024

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 from 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 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, failing which the application will be deemed abandoned;
- the Registry serves the counterstatement's 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 (letter of reliance), within two months of the counterstatement's receipt;
- subsequently, the applicant must either file the affidavit of evidence in support of its application or a letter of reliance, within two months of receiving the opponent's affidavit;
- within one month of the applicant's affidavit's receipt from the Registry, the opponent has the option to file a reply affidavit; and
- thereafter, the opposition proceeds to the final hearing stage.

A cancellation application can be filed by any aggrieved person before the Registry or the appropriate High Court, 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 before 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 before the date of filing the cancellation application;
- the trademark is registered in contravention of the TMA or TMR;
- non-compliance with any condition related to the trademark's registration entered 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 on the registered proprietor within a couple of months. Thereafter, the registered proprietor must file a counterstatement within three months of the application's receipt;
- thereafter, the Registrar serves the counterstatement's copy on the applicant. If no counterstatement is filed, the applicant must file 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 a letter of reliance within two months of receiving the applicant's evidence;
- within one month of the receipt of the registered proprietor's affidavit, the applicant has the option to file evidence in reply; and
- thereafter, the cancellation application proceeds to the final hearing stage. If the registered proprietor does not respond to the cancellation action, the Registry can proceed based on the merits of the case.

The proceedings of cancellation action before the High Courts are faster, and the procedure is based on each High Court's rules of practice. The broad procedure includes 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; and
- thereafter, the High Court will schedule a hearing of the cancellation action.

The official fee for filing a Notice or a cancellation application before the Registry is 2,700 Indian rupees (approximately US\$30) for online filing, and 3,000 Indian rupees (approximately US\$35) for physical filing, for each class opposed and counterstatement filed.

At High Courts, 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 High Court.

Law stated - 31 July 2024

| 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 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 date of the registration certificate's issue.

Law stated - 31 July 2024

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 - 31 July 2024

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 law, trademarks cannot be protected under any other intellectual property laws in India.

Law stated - 31 July 2024

Trademarks online and domain names

What regime governs the protection of trademarks online and domain names?

The TMA 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 TMA. 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 - 31 July 2024

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 licensed user of a registered trademark (registered user) can register their name through a joint request filed by the registered proprietor and the user in 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 name under the Trade Marks Act 1999 (the TMA), subject to the licence agreement terms.

Further, the TMA empowers the Registrar 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 TMA. Licensing agreements may contain provisions related to the trademark's use, the nature of the licence, quality control regulation, termination, indemnification, etc.

Law stated - 31 July 2024

Assignment

What can be assigned?

A registered or unregistered trademark is assignable, either with or without the goodwill of the business, in respect of all or some of the goods and services thereunder.

Other business assets need not be assigned to make it a valid transaction.

Law stated - 31 July 2024

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 assignment date, assignor's and assignee's details, details of a trademark to be assigned, consideration for the assignment, 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 before filing 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 - 31 July 2024

Validity of assignment

Must the assignment be recorded for purposes of its validity?

It is mandatory under the TMA to record a registered trademark's assignment in the Registry if the trademark has to be validly enforced.

Law stated - 31 July 2024

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 Indian trademark law.

Law stated - 31 July 2024

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 TMA 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 TMA, with imprisonment for six months to three years or a fine of 50,000 Indian rupees to 200,000 Indian rupees, or both. Further, a trademark owner may file a criminal complaint before a magistrate seeking investigation and search and seizure, 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, in April 2021, abolished the Intellectual Property Appellate Tribunal (IPAB) and the erstwhile powers of the IPAB have been given to the High Courts in India.

Law stated - 31 July 2024

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) and the TMA. 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 also provides for amicus curiae's assistance to the judge as necessary in the legal proceedings.

Typically, the interim relief (in the form of a temporary restraint order) is granted swiftly within one to two months of filing the complaint, and in ex parte cases, within a week. However, the final decision in an infringement or passing off action, including the trial stage, takes two to four years.

Criminal proceedings can be initiated by filing a complaint before the magistrate requesting to investigate and carry out a 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's opinion before making any search and seizure.

Law stated - 31 July 2024

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 or her mark is registered, is identical or is deceptively similar.

Further, in infringement proceedings, the burden of proof to establish the validity of a trademark registration is on the plaintiff. In opposition proceedings, the burden of proof lies with the opponent. In trademark falsification proceedings, the burden of proof to establish the trademark proprietor's assent lies with the accused.

Law stated - 31 July 2024

Standing

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

The registered trademark owners or the registered users only can initiate infringement actions, and the trademark owner can initiate the common law remedy of passing-off action. However, the registered user's right to institute infringement proceedings is subject to the licence agreement between the user and the owner. A criminal complaint can be filed by the trademark owner.

Law stated - 31 July 2024

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 the borders against the import of infringing goods. The IPR Rules empower 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 applying 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 infringing party's mala fides.

Law stated - 31 July 2024

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 TMA allows discovery of documents in ex parte or interlocutory injunctions. 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 - 31 July 2024

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 defendants appear, 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 in India.

Law stated - 31 July 2024

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 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 - 31 July 2024

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

Law stated - 31 July 2024

Appeals

What avenues of appeal are available?

The TMA 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-judge bench of the High Court can be filed before a two-judge bench (the division bench) of the High Court, and the division bench's order can be appealed before the Supreme Court of India.

Law stated - 31 July 2024

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 by 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 as infringing use;
- two or more registered trademarks: where two or more identical or similar trademarks are registered and used in compliance with the TMA, 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 on the market;
- prior use: if an identical or similar trademark is continuously used before the registered trademark's date of use or registration, it does not amount to infringement; and
- 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 - 31 July 2024

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

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

Law stated - 31 July 2024

ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

ADR 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 ADR proceedings.

Law stated - 31 July 2024

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?

In July 2021, the Delhi High Court established India's first Intellectual Property Division (IPD) to deal with intellectual property matters, except cases dealt with by the division bench of the Delhi High Court. The Delhi High Court introduced the Delhi High Court Intellectual Property Rights Division Rules 2022 (the DHC-IPD Rules), which came into force on 15 April 2022. The DHC-IPD Rules were made to address the issues concerning the procedure of IP litigation in India. The creation of this IPD and the DHC-IPD Rules has assisted in the expeditious disposal of various cases that were transferred from the Intellectual Property Appellate Tribunal to the Delhi High Court.

The Parliamentary Committee in its 169th Report on Action Taken by Government on the recommendations or observations of the Committee contained in its 161st Report on 'Review of the Intellectual Property Rights Regime in India', recommended that the government should set up IPDs in all High Courts to ensure effective resolution of IPR cases.

In April 2023, the Madras High Court notified the Madras High Court Intellectual Property Rights Division Rules 2022 and thereafter commenced the working of its IPD. The Bombay High Court, Calcutta High Court and Gujarat High Court have also allotted specific benches to deal with IPR cases.

As per the latest Annual Report of the Office of the Controller General of Patents, Designs and Trademarks, despite the covid-19 pandemic, there has been a massive increase in the trend of applications filed for registration of trademarks in India. The Report also noted that procedural reforms have increased trademark applications' acceptance at the initial stage to about 50 per cent.

After the covid-19 pandemic, the Trademarks Registry has taken the following improvement measures:

- updated the online search facility to expedite the prosecution procedure;
- automated and improved the process for registration, renewal and publication of trademarks;
- shifted all show cause and opposition hearings to video-conferencing mode;
- automated the allotment of applications for examination; and
- started online weekly open-house sessions to address grievances of stakeholders, etc.

Indian courts continue to protect and enforce the trademark rights of international brands in India and grant punitive damages as a deterrent.

- The Registry recently launched a grievance redressal portal (Portal) to expedite the processing of various types of requests that are pending in connection with trademark registration applications and opposition proceedings, including withdrawals, amendments filed in connection with trademark applications, default abandonments, etc.
- The government recently added Section 112A to the TMA, through the Jan Vishwas (Amendment of Provisions) Act 2023, which allows the Registrar to appoint an adjudicating officer to conduct inquiries, impose penalties, and other criminal penalties under the TMA.
- The government notified the Draft Trade Marks (Holding Inquiry and Appeal) Rules 2024 on 1 July 2024, seeking public comments.

Law stated - 31 July 2024