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Corporate, Tax, IPR and Immigration

TRADEMARK REGISTRATION IN INDIA

Comprehensive Strategic & Prosecution Advisory Manual

A definitive blueprint for brand architecture, clearance,
registry prosecution, and litigation defense.

Strictly Confidential & Privileged

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1. Executive Summary: The Asset Value of Brand Equity

In the modern commercial ecosystem, a company's brand identity frequently surpasses its physical assets in valuation. The legal mechanism to monopolize, monetize, and protect this identity is governed by the **Trade Marks Act, 1999** and the **Trade Marks Rules, 2017**.

This manual serves as a definitive prosecution and advisory blueprint for founders, corporate counsel, and foreign entities seeking to ring-fence their Intellectual Property (IP) within the Indian jurisdiction.

STRATEGIC IP INSIGHT

The Corporate Name Fallacy: A common oversight among founders is assuming that registering a Company or LLP name with the Ministry of Corporate Affairs (MCA) automatically grants Trademark rights. It does not. An MCA registration prevents another company from registering the exact corporate name, but only a Trademark registered with the DPIIT provides exclusive commercial rights to use the brand name across goods and services, enabling civil and criminal remedies against infringement.

2. The Spectrum of Distinctiveness (Brand Clearance Strategy)

Prior to filing, a proposed mark must be evaluated against the "Spectrum of Distinctiveness." The Indian Trade Marks Registry evaluates applications on a sliding scale of inherent registrability.

Category	Legal Definition & Strength	Example
Fanciful / Coined	Made-up words with no dictionary meaning. Highest protection.	KODAK, EXXON
Arbitrary	Existing words used in an entirely unrelated context. Very strong.	APPLE (for computers)
Suggestive	Suggests a quality/characteristic without directly describing it. Strong.	NETFLIX (Internet + Flicks)
Descriptive	Directly describes the product, service, or geography. Weak / Difficult to register without acquired distinctiveness.	SUPERIOR CAR WASH
Generic	Common name for the product. Never registrable.	SMARTPHONE (for phones)

CRITICAL RISK ALERT

Section 9 & 11 Refusals: The Registry will issue an absolute refusal (Section 9) if the mark is purely descriptive or lacks distinctiveness. A relative refusal (Section 11) will be issued if the mark is identical or deceptively similar to an already registered or pending mark in the same class. A rigorous Public Search is mandatory prior to filing.

3. Classification Architecture (The Nice Agreement)

Trademarks are not granted in a vacuum; they are tethered to specific classes of goods and services under the 12th Edition of the Nice Classification (NCL). Selecting the correct class is pivotal; failing to cover your core commercial activity leaves you vulnerable to competitors.

3.1. High-Frequency Corporate Classes

- **Class 9 (Goods):** Software, mobile applications, AI algorithms, electronics, scientific apparatus.
- **Class 35 (Services):** Advertising, business management, e-commerce marketplaces, retail services.
- **Class 41 (Services):** Education, entertainment, online training platforms, sporting events.
- **Class 42 (Services):** Software as a Service (SaaS), IT consultation, architectural and engineering design.

4. The Prosecution Protocol: Step-by-Step Filing Matrix

The lifecycle of a trademark application in India transitions through several statutory phases. Our firm executes this protocol with exacting precision.

- Phase 1: Clearance Search & Opinion:** Comprehensive search across the Indian TM Database, common law unregistered uses, and domain name registries to assess infringement risk.
- Phase 2: Filing the Application (Form TM-A):** Submission of the application defining the mark type (Word, Device, Sound, Shape), user date claim, and specifications of goods/services.
- Phase 3: Vienna Codification:** If the mark contains a logo or graphical elements, the Registry assigns specific codes based on the Vienna Agreement to categorize the visual elements.
- Phase 4: Examination Report (TM-O):** The Examiner issues a report citing any objections under Section 9 or 11. **Action:** A robust legal Reply to Examination Report must be filed within 30 days.
- Phase 5: Show Cause Hearing:** If the Examiner is not satisfied with the written reply, a hearing is appointed. Our specialized IP counsels represent the entity before the Registrar.
- Phase 6: Journal Publication:** Upon acceptance, the mark is published in the Trade Marks Journal for a statutory period of 4 months.
- Phase 7: Registration Certificate (Form O-2):** If no third party opposes the mark during the publication period, the DPIIT issues the final seal of Registration.

5. Documentation & Fiduciary Requirements

To file an airtight application, specific evidentiary documentation must be structured accurately.

Document Category	Detailed Specifications
Power of Attorney (TM-M)	Form TM-48 (Authorization of Agent) signed by the authorized signatory on a ₹100 Non-Judicial Stamp Paper.
Identity & Entity Proof	Certificate of Incorporation (Companies/LLPs), Partnership Deed, or Udyam Registration (MSME).
User Affidavit	Required only if claiming prior use of the mark (not filed on a "Proposed to be Used" basis). Must be notarized and supported by continuous invoices, advertising spend, and domain registration dating back to the claimed date.
MSME / Startup India Certificate	Highly recommended. Valid Udyam Registration or DPIIT Startup Recognition Certificate grants a 50% reduction in statutory filing fees.

6. Fee Structure & Timeline Analytics

Strategic IP management requires budgeting for both official registry fees and professional prosecution costs.

Applicant Category	Govt. Fee (Per Class)	Typical Timeline
Individuals / Proprietorships	₹4,500	6 - 8 Months (Uncontested)
MSME / DPIIT Startups	₹4,500	6 - 8 Months (Uncontested)
Corporations / LLPs	₹9,000	6 - 8 Months (Uncontested)
Expedited Examination	Multipled by 5x	2 - 3 Months

STRATEGIC IP INSIGHT

The Opposition Trap: The stated timelines apply strictly to "straight-through" or uncontested applications. If a third-party files a Notice of Opposition during the 4-month Journal Publication phase, the process pivots from prosecution to administrative litigation, which can extend the timeline by 2 to 4 years.

7. Litigation: Opposition & Infringement Defense

A registered trademark is only as strong as its enforcement. Our firm provides aggressive civil litigation frameworks.

7.1. Trade Mark Opposition (Pre-Registration)

If a competitor opposes your published mark, a statutory timeline initiates:

1. **Notice of Opposition (TM-O):** Filed by the opponent within 4 months of journal publication.
2. **Counter Statement:** You must file a defense within **2 months**. *Failure to do so results in the automatic abandonment of your trademark application.*
3. **Evidence Phase (Rules 45, 46, 47):** Both parties submit sworn affidavits proving usage, market reputation, and commercial crossover.
4. **Final Arguments:** Adjudication before the Registrar.

7.2. Infringement vs. Passing Off (Post-Registration)

- **Infringement (Statutory Right):** Initiated when an unauthorized party uses an identical or deceptively similar mark for identical/similar goods. Requires the plaintiff's mark to be **Registered**.
- **Passing Off (Common Law Right):** Initiated when an unregistered mark with substantial goodwill and reputation is copied, leading to public confusion and misrepresentation.

8. Post-Registration Fiduciary Duties

Securing the TM-R Certificate does not end the compliance lifecycle.

- **Statutory Symbol Usage:** Post-registration, the entity must transition from using the TM symbol (which only denotes claim of use) to the ® symbol (which legally denotes a registered asset). Falsely using the ® symbol is a punishable offense.
- **Renewal Matrix:** A trademark is valid for **10 years** from the date of application (not the date of registration). It must be renewed in perpetuity via Form TM-R.
- **Non-Use Cancellation Risk (Section 47):** A registered mark can be expunged from the registry by a third party if it has not been used in active commerce for a continuous period of 5 years and 3 months.

9. Global Scalability: The Madrid Protocol

For entities scaling operations globally, filing individual applications in 50+ countries is capital intensive. India's accession to the Madrid Protocol allows a domestic entity to file a single international application via the Indian Registry to the World Intellectual Property Organization (WIPO), designating protection in over 120 member jurisdictions.

Protect Your Market Dominance

Intellectual Property is the bedrock of corporate valuation. **Startup Solicitors LLP** provides elite trademark prosecution, copyright architecture, and IP litigation services. We manage portfolios for industry leaders, ensuring your brand equity is aggressively protected against dilution and infringement.

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