
What US brand owners must know about India

Ten Tips about Indian trademark practice to assist US brand owners to protect their brands in India

1. Indian trademarks law allows filing and registering a mark on the basis of "intention to use" the mark in India. Thus unlike US trademark practice, brand owner is not required to show actual use of the mark before a mark is registered or within 6 months of registration.
2. At the time of renewal of the mark, no affidavit with evidence of use of the mark in India is required. Thus marks can be renewed on the basis of a request for renewal accompanied by official fees.
3. The class heading as provided in Nice Classification is not permitted to be registered. However a wide specification of goods identifying the actual goods of interest for which a brand owner is using or intends to use the mark can be applied for registration.
4. The trade mark office database is available online and brand owners can check the availability of a mark and assess the risk of using and registering it. It is advisable to search the register and conduct common law searches to avoid conflict and expense on launch of a product.
5. The online sale of goods and if such goods are available for sale to people in India is sufficient to claim use of the mark in India even if the online store is located outside India.
6. Recordation of a license with Trademark office is not mandatory. In other words, the registered proprietor or the owner of a mark can enter into a license agreement in writing and such use would accrue to the benefit of the proprietor even if such a license is not registered with the authorities. The Indian law gives credence to the concept of "permitted use" and has widened its scope to include unregistered licensing arrangements as well.
7. There are no restrictions on amount of royalty payment to a licensor or a Joint venture partner on use of trade marks by the Indian partner/company.
8. For assignment of a mark in India, it is necessary to mention in the assignment deed as to whether a) assignment of mark is with or without goodwill of the business b) actual monetary consideration-the expression "for a valuable consideration" is not acceptable c) assignor must acknowledge the consideration amount d) date on which assignment is effective specified.

9. India is a signatory to the **Madrid protocol** and the applications can be filed at WIPO with India as a designated country. However, no application through Madrid has yet been examined by the Indian TM Registry. For now this does not seem to be the preferred route.

10. A registered mark can be cancelled on the ground of “**non-use**” if the mark has not been used in India for a continuous period of 5 years from the date such a mark is physically placed or entered on the register. This date appears as the sealing date on the registration certificate.

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Vatika Towers
10th Floor Block-B
Sector-54
Gurgaon-122002
National Capital Region (Haryana)
India

Tel. **+91** 124 4655999
Fax. **+91** 124 4045047
Email info@indiaiprights.com