

Certification marks in India: what you need to know

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Introduction

The recent jurisprudential developments in trademark law around the world have led to the addition of non-conventional marks (eg, sound marks, smell marks and colour marks) to the trademark family. These non-conventional marks have been recognised as trademarks as they fulfil the quintessential characteristics of trademarks – namely, acting as a source identifier for relevant goods and services, and distinguishing one proprietor from another in the market. However, not all trademarks portray such stereotypical characteristics: certification marks are an exception.

What are certification marks?

Certification marks are essentially trademarks that are used to certify that the goods or services on which they are affixed comply with certain quality standards prescribed by a certifying entity. Such certifying entities, upon the fulfilment of these quality standards, license the certification mark to be used. By indicating that certain standards are met (eg, in respect of origin, material, mode of manufacture of goods or performance of services, quality or accuracy) a certification mark plays the crucial role of instilling legal assurance and acts as evidence that such goods or services are up to certain standards and quality. Due to its characteristic of essentially instilling confidence among consumers, a certification mark is often referred to as a "mark of validity" or a "mark of assurance".

Examples

A certification mark denotes certain characteristics or qualities of a certain product or service. A few examples are shown in Figures 1-4 below.



Figure 1: certification mark to certify that "industrial" products comply with quality standards set by the Bureau of Indian Standards



Figure 2: certification mark to certify that the "purity" of gold and silver jewellery complies with the quality standards set by the Bureau of Indian Standards



Figure 3: certification mark to certify that "organically" farmed food products comply with the National Standards for Organic Products set by the Agricultural and Processed Food Products Export Development Authority



Figure 4: certification mark to certify that "agricultural" products comply with the quality standards set by the Directorate of Marketing and Inspection.

Use

In India, like in other countries, the registered proprietors of certification marks are not allowed to use them in relation to goods or services that they themselves offer. Such proprietors can only license the certification marks – that is, authorise others to use them while ensuring that they observe due compliance with the standards of quality and assurance as set by the proprietors.

Registration

In India, a person or entity seeking to register a certification mark has to file an application (in the prescribed form TM-A with the prescribed fees) before the Indian Trademarks Registry in class(es) of goods and services. The application must include draft regulations governing the criteria for licensing such a mark and its permitted use. These regulations must include:

- a general description of the applicant and the nature of the applicant's business;

- particulars of the applicant's infrastructure (eg, research and development setup, offices or locations and technical manpower support);
- the applicant's competence to administer the certification scheme (ie, how the applicant derives its authority to certify the goods or services);
- the applicant's financial arrangements – in particular, how the applicant generates revenue (eg, membership dues, licensing or royalties) and approximate annual revenue figures;
- an undertaking from the applicant stating that there shall be no discrimination against any party if they meet the requirements set down in the regulations;
- the relevant characteristics that the certification mark shall indicate in the certified goods or services; and
- the manner of monitoring use of the mark in India along with the dispute resolution method to be employed in case of any dispute.⁽¹⁾

The Trademarks Registry may also call for additional information or amendments to the regulations if it deems necessary. The applicant must also furnish a statement of case setting out the grounds on which it relies in support of its application.

Examination

Certification marks are examined as regular trademarks. However, the Indian trademarks registry considers various parameters, such as:

- the competency of the applicant in certifying the goods or services;
- the public advantage if the mark is granted registration in all circumstances; and
- technical or procedural grounds, such as whether the draft regulations submitted by the applicant have been filed in a satisfactory manner.⁽²⁾

Further, in order to determine the distinctiveness of a certification mark, regard is given as to whether the certification mark is capable of distinguishing the certified goods or services from those that are not certified, instead of distinguishing the businesses of different proprietors, as is the case for regular trademarks.

Enforcement

Once a certification mark has been registered, the registered proprietor has the same enforcement remedy of infringement action against an infringer as that of a regular trademark. However, in the case of *Tea Board India v ITC Limited*,⁽³⁾ the High Court of Calcutta categorically observed that in order for an infringement action to be successful, the claimant of a certification mark must showcase that the infringer is using the certification mark for a similar good or service, and that such similar good or service is being certified for a similar set of standards or quality.

Unregistered certification marks

There has been no significant judicial precedents pertaining to the availability of common law rights of passing off to proprietors of unregistered certification marks. That said, since certification marks play such a crucial role, it is always advisable to register them in India to avoid any misuse. The gravity of misuse of a certification mark is more than financial loss – it extends also to loss of consumer trust, leading to physical, mental and emotional losses on the part of the consumer.

For further information on this topic please contact Nikhil Kumar, Meghna Arora or Sumeet Sirohi at G&W Legal by telephone (+91 11 6134 8306) or email (nikhilkumar@gnwlegal.com, meghnaarora@gnwlegal.com or sumeetsirohi@gnwlegal.com). The G&W Legal website can be accessed at www.gnwlegal.com.

Endnotes

(1) Section 74, Indian Trademarks Act, 1999.

(2) Section 72, Indian Trademarks Act, 1999.

(3) MANU/WB/0277/2019.