

# Making a Mark

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# Trademark

A mark used to indicate a connection in the course of trade with the goods of a particular manufacturer (for the purposes of identifying the trade origin)

The consumer identifies, recognizes and demand the goods of a particular manufacturer with reference to the trade mark applied to such goods.

The Trade Mark is owned and possessed by an individual as a proprietor. The individual could be a firm, a corporate, a society or a partnership firm and has the exclusive right to its use and exploitation including the right to license, assign or mortgage etc.

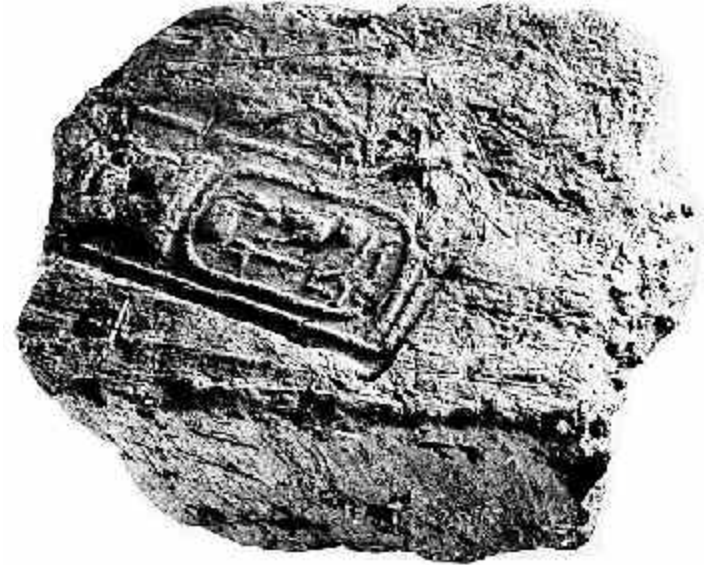
# Very early “trademarks”



China: Ming bowl  
C. 1600 AD





China: Shang dynasty  
mark, C1600 BC



Egypt: Ramses II cartouche on  
a sun-dried mud and straw  
brick. Dynasty 19, 1279 – 1212  
BC

Slide taken from T.Vivian’s presentation at WIPO meeting in Vietnam (2003)

Any sign capable of distinguishing the goods and services of one undertaking from those of other undertakings must be eligible for registration as a trademark provided that it is visually perceptible

- Invented word  
e.g. **Kodak, VISION-IPR, Xerox**
- A word taken out of context e.g. **Orange**
- A symbol or “device” 
- Both a word and a symbol 
- A distinctive Sound/Smell ( only in some countries)
- A distinctive shape

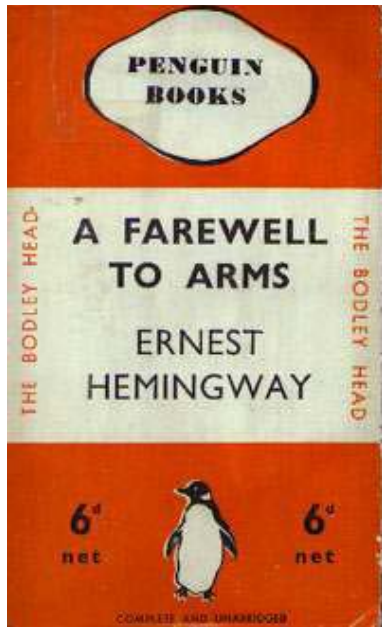
“...the goods and services of one undertaking from those of other undertakings...”

Goods are divided into 34 classes.

Services are divided into 8 classes.

**“Penguin” is registered for books, class 16, paper goods.**

**“Penguin” is registered for biscuits, class 30, bakery products**



Slide taken from T.Vivian's presentation at WIPO meeting in Vietnam (2003)

# Transactions in Trademarks

PanAm bankrupt – Trademark sold for  
US\$1.3M

# Certification Marks

- Sign indicating that the goods/services have been certified by an independent body in relation to one or more characteristics
  - Origin, material, mode of manufacture, quality, accuracy, etc.
- The Owner of a certification mark
  - an independent organisation such as an enterprise, institution, governmental agency that is competent to certify the products concerned.
- The owner cannot use the certification mark but authorises others to use the mark provided they satisfy the prescribed standards
- There is generally a license fee for the use of the certification mark as per set guidelines of its use.
- These certification marks are registered in the national trademarks register
- Anyone who meets the prescribed standards for the said products/services can use the mark

# Certification Marks



WOOLMARK

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**by manufacturers of 100%  
pure new wool products**



# Certification Marks



The UL Recognized Component Mark as shown above is used for components which are tested and certified by UL to both Canadian and U.S. requirements. Individual markings for U.S. or Canada requirements are also available.



A product that has this mark indicates that Underwriters Laboratories had tested the samples of these product and passed the Canada safety requirements . The standards used are based on Canada published Standard for Safety and can be purchased from UL.

# Certification Marks in India

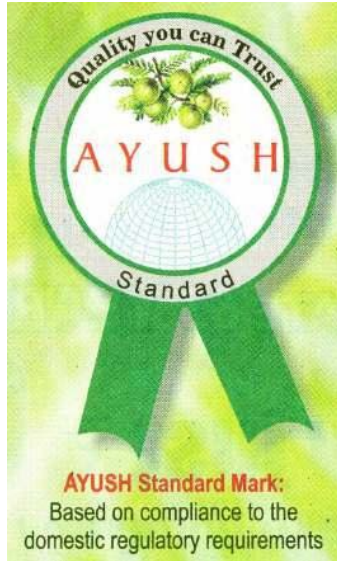


A trademark - "India Organic" will be granted on the basis of compliance with the National Standards for Organic Production (NSOP). Communicating the genuineness as well as the origin of the product, this trademark will be owned by the Government of India. Only such exporters, manufacturers and processors whose products are duly certified by the accredited inspection and certification agencies, will be granted the licence to use of the logo which would be governed by a set of regulations

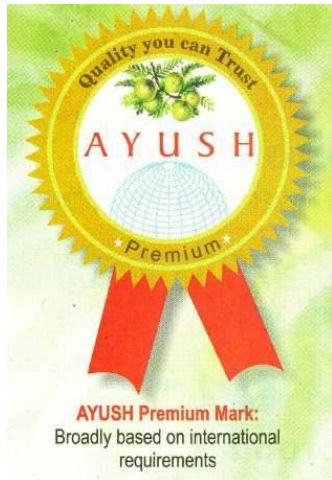


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# AYUSH Certification Mark in India




**Dept. of Ayush, Ministry of Health , Govt. of India in collaboration with the Quality Council of India launched Certification Scheme for Ayush Products for the first time in India in Oct 2009, which would make available common Ayush Products in the market with a quality seal . The criteria for Ayush Products for the first time was launched by Ayush Department, Ministry of Health and Family Welfare, Govt. of India in association with Quality council in Oct 2009**



# Certification mark in India





Signes used to distinguish certain valued characteristics common to the products of the members of an association/cooperative

Owner of the collective mark is an association/cooperative

Mark is to be registered in the trademarks registry

## *Collective marks*

geographical origin, material, mode of manufacture

The owner does not use the mark for commercial purposes, but may use it to advertise and promote the products/services of its members who sell their products under the collective seal

## **Rules of use**

- persons authorized to use criteria for membership
- conditions of use ....must meet the features, criteria set for its use
- sanctions against misuse

## **Authorization to use**

- ❖ membership
- ❖ application or automatic
- ❖ comply with the rules
- ❖ no licenses

# *Collective marks*

**Control**

# *Collective marks*



**a mark used by 16 apple-growing cooperatives in Italy.**

## *Collective marks*

- Usage only by members that comply
- Control by association
- No licence agreement for authorization
- Free use
- Owner allowed to use
- **Promotes Cooperation among members**

## **Certification Marks**

- Usage by anyone who complies
- **Control** by independent entity: stronger
- Authorization through license agreement
- Fee for use
- Owner not allowed to use
- Promotes establishment of standards



# In case of Well-known Trademarks the rights can extend beyond goods or services in the Trademark registration

e.g. In a landmark judgment even before the Trademark Law in India was amended to bring in protection to well known marks the Delhi High Court injuncted the user of a mark similar to the Mercedes Mark for a product not related to automobiles.

Nina Ricci registered for clothing. An application for Nina Ricci coffee shops was refused.

Chanel registered for clothing. An application for Chanel Love Hotels was refused.

# Domain names

- In present times Internet has become a powerful medium for business development and transactions.
- Domain names are registered by Internet Corporation for Assigned Names and Numbers (**ICANN**) since 1999
  - eg .com; .org;
  - Also at the national level by various agencies eg **Nominet** in UK for .uk; and **Denic** In Germany for .de



**Domain names are very closely linked to trademarks as consumers use these to identify the product and/or service with its origin.**



# Domain name disputes

UDRP (Uniform Domain Name Dispute Resolution Policy) administered by WIPO and by ICANN

- A very cost effective and efficient system

**Several examples where this system has been used to evict cybersquatters**

IIT Bombay the owner of iitbombay.com and situated in a place called Powai in Bombay got back iitpowai.com from squatter as it was creating confusion within the users.

UDRP resolved the issue. IIT Bombay did not have to go to court.

Similarly British Telecom and Marks and Spencer got back domain names that were registered by a pirate and offered for sale. Here too it was held as a passing-off case.

# Deriving Value

- **Licensing**..... *allowing use of IPR under a contract for the goods or services in the same class without giving up ownership*
- **Franchising**..... *Allowing use the IPR especially in the case of TM, without giving up ownership, but owner dictates the quality, “image” of enterprise, staff training, staff dress, layout of the office, shop etc.*

*Franchisee necessarily has to use the trademark of the owner.*  
*e.g. Avis, McDonalds, Pizza Hut, Benetton*
- **Merchandising**.....*Allowing someone to use the trademark for unrelated goods. This is true for well known marks... Disney allowing cartoon characters to be used. Cadilla car manufacturers allowed Leather goods manufacturers in China, Taiwan , Japan to use this for 5-10% of wholesale price to realize approx US\$ 5 million.*
- **Assigning**..... *Giving up the ownership to an assignee.*

# How do Trademarks Facilitate the Create Brands and also market Products/Services

- Trademarks, collective marks, certifications and geographical indications (GIs) play significant role in promoting a product in terms of its reputation, quality, sense of genuineness and confidence in the mind of consumers
- Such marks when displayed prominently help to creat distinctiveness in the minds of consumers.

# Brand and IPR dilution

Brands becoming Generics:

Dangers of Brands becoming so popular that their usage becomes generic over time and hence lose their distinctiveness

Examples:

DuPont's "nylon" and "rayon" brands; ICI's "cellophane"; Bayer's "Aspirin"; Cynamid's "Formica"; XEROX of Xerox Corporation

Immediate corrective steps need to be taken otherwise all the advantages can be lost