

TRADEMARK PROTECTION IN INDIA AND ABROAD

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TRADEMARKS

One of the oldest form of IPR

They can be: Words, letters, numbers, shapes, colors, sounds or any symbol, which work as a source identifier.

Levi's

SONY



Functions of a Trademark:

- ✓ identifies the source of the goods or services;
- ✓ guarantees of the quality of the goods or services.
- ✓ advertises the goods or services

Basic Concepts of Trademark law:

- ✓ distinctiveness;
- ✓ deceptive similarity of marks; and
- ✓ similarity of goods

Trademarks can be both registered and unregistered

Advantages of registered trade mark:

- ✓ **excludes others from using an identical/confusingly similar mark,**
- ✓ **allows one to take legal action when the mark is infringed.**
- ✓ **proffers the right of licensing and assignment.**

If mark not registered:

passing off action may be instituted using the common law

But to be successful in a passing off action, one has to prove that:

- ✓ there is likelihood of deception**
- ✓ the user has built up a reputation and goodwill in the mark**
- ✓ the reputation/goodwill of his mark is being tarnished in some way by the other person's use of the mark.**

It is easier to take legal action when the mark is registered.

Generic

Examples: Aspirin, Kerosene

Descriptive

**Examples: Orwoola (Orwoola's TM; 1909 [26] RPC 850 at 860)
ScotchLite (1948 [65] RPC 229)**

Suggestive

Examples: Gluvita (AIR 1960 SC 142 at 147)

Arbitrary

Examples: Apple for computers; Orange for cellphone network provider.

Coined

**Examples: Flavour + Container/Retainer - FLAVOTAINER
Aluminium + Alloy - Aluminoy**

INDIAN SCENARIO

A trademark is defined by the Act as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof which is used to distinguish goods and services provided in the course of trade by a person from the goods and services provided by any other person and should be capable of being graphically represented.

Trademarks that can be registered under the Indian Trademarks Act, 1999

✓ Product trademarks-

A mark which identifies the seller of the mark and distinguishes him from the rest selling similar products.

Examples:



✓ Service trademarks

Like product trademarks, these help in distinguishing one service provider from another and identify the source.

Examples:

kaya skin clinic

JAWED HABIB
• • •



✓ Certification trademarks

These indicate that the goods or services meet certain Standards with respect to origin of goods, mode of production, quality among others. Anybody may use the mark if he complies with the standards defined by the owner of the particular certification mark.

Examples



✓ Collective trademarks

It is owned by an association and only members of the association are allowed to use the mark. The mark is used by the members to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organisation.

Example:



California Certified Public
Society Accountants

FOR REGISTRATION OF TRADEMARK IN INDIA

- ✓ The chosen mark shall be capable of being represented graphically on paper.
- ✓ It shall act as an source identifier and help in distinguishing goods or services of one provider from another.
- ✓ The mark shall be used in relation to goods or services.

Trademarks in India may be registered or unregistered under the Indian Trademarks Act, 1999.

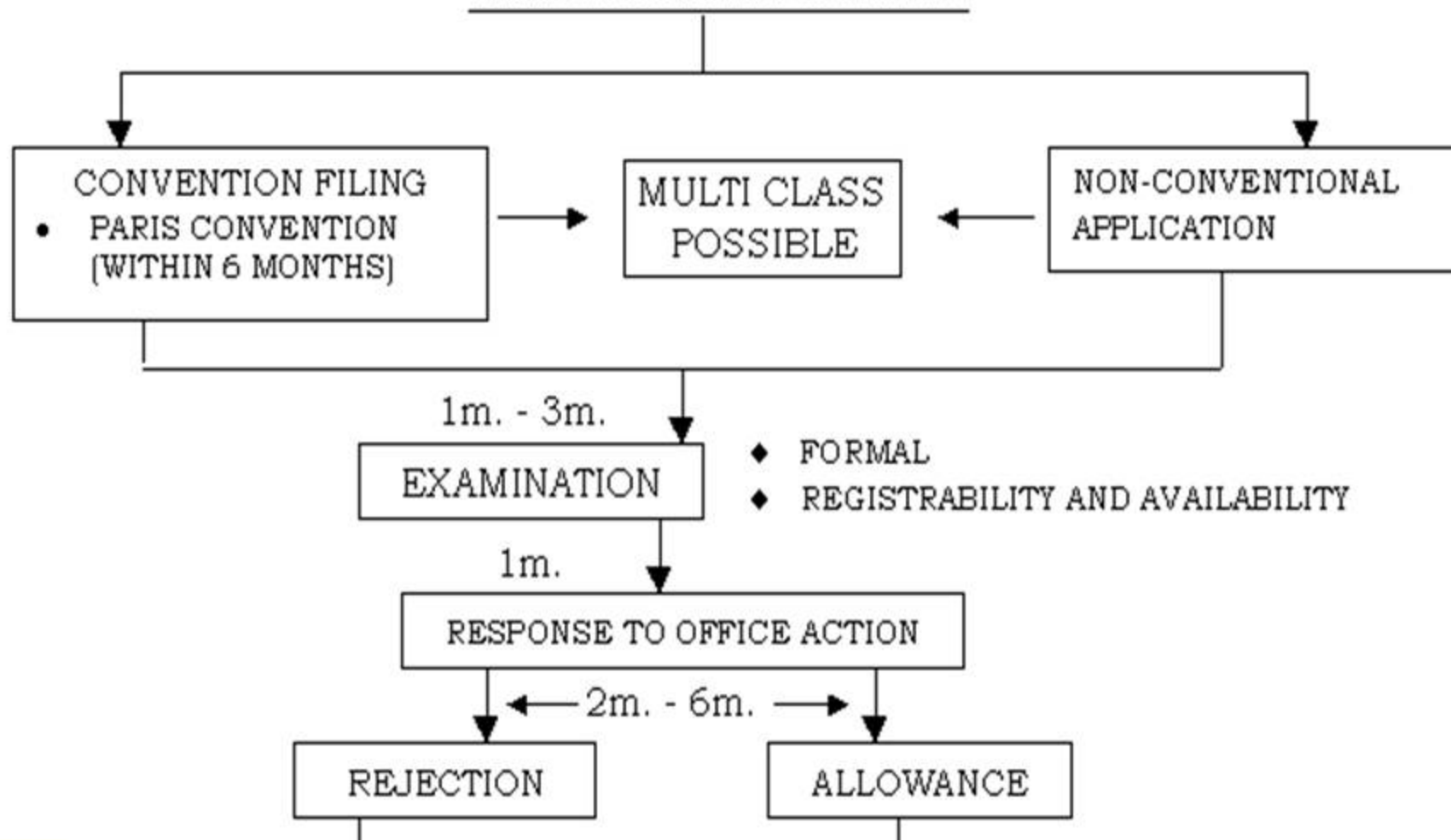
Unregistered trademarks can be protected under Common Law.

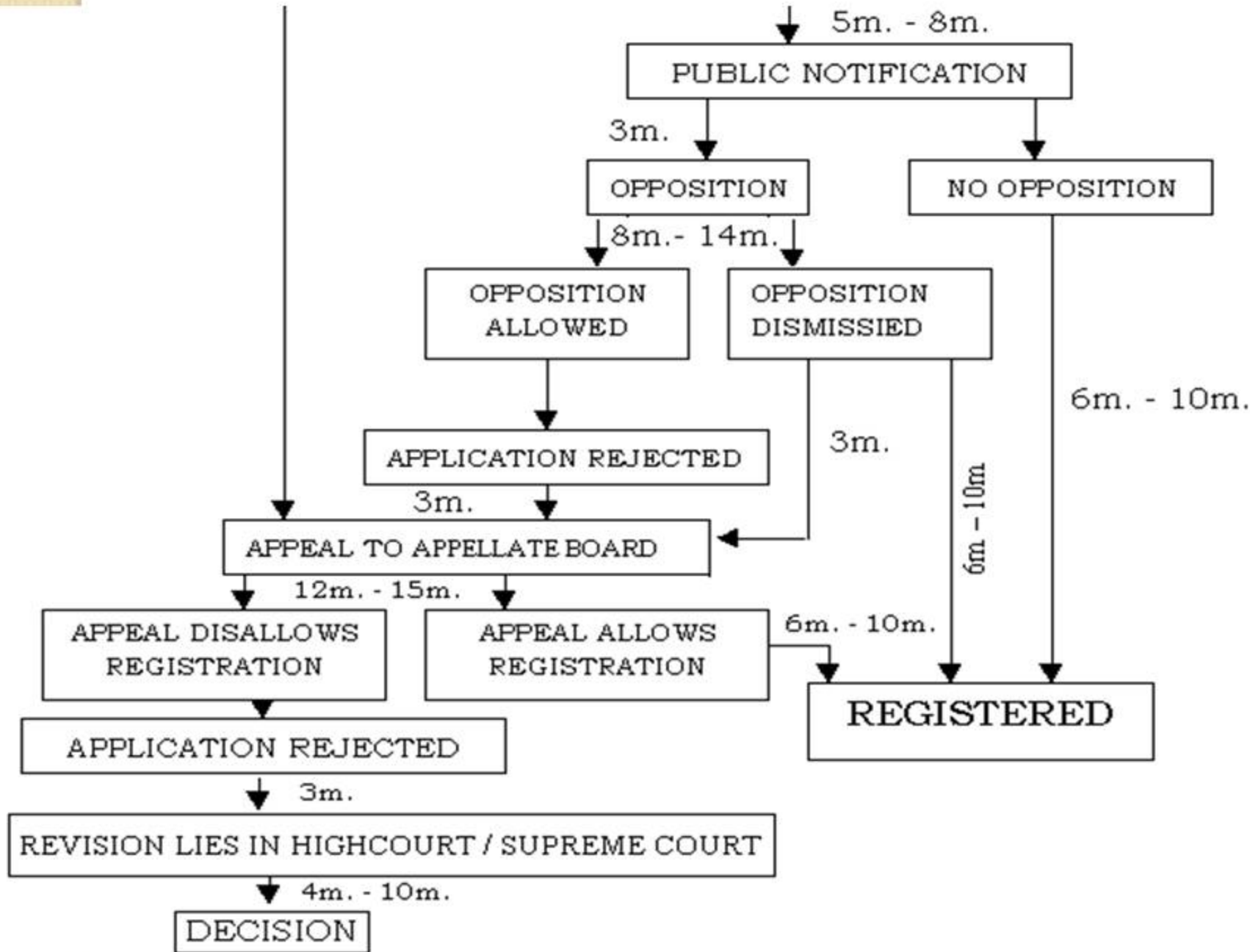
TRADEMARK REGISTRATION PROCESS IN INDIA

PROCEDURE

m. = Month

TRADE MARK APPLICATION





DURATION OF A TRADEMARK UNDER THE INDIAN TRADEMARK ACT

Initial term of registration of a trademark is ten years, which has to be renewed on payment of renewal fees for another 10 years.

Non-use of a registered trademark for a continuous period of five years may result in the cancellation of registration.

Registration provides additional rights

- ✓ Proceedings for infringement of an unregistered TM cannot be instituted.
- ✓ Registration gives exclusive right to the proprietor to the use of the registered TM with respect to the goods or services registered, subject to conditions and limitations.
- ✓ Where two or more persons are registered proprietors of identical, or closely resembling TMs, neither of them has the exclusive right to use the TM vis-à-vis each other, but each of them has the exclusive right against others, excluding the registered users.
- ✓ Registration is prima facie evidence of validity in all legal proceedings.

WHAT AMOUNTS TO INFRINGEMENT

- (A) Its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or**
- (B) Its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or**
- (C) Its identity with the registered trade mark and the identity of the goods or services covered by such registered trademark is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.**

TRIPS

In case of the use of an identical sign for identical goods or services, a likelihood of confusion must be presumed (Article 16.1).

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person. Using by way of permitted use, uses in the course of trade, a mark which-

(A) is identical with or similar to the registered trademark; and

(B) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(C) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he-

(A) affixes it to goods or the packaging thereof;

(B) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(C) imports or exports goods under the mark; or

(D) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising-

(A) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(B) is detrimental to its distinctive character; or

(C) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.



(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringement labels and marks for destruction or erasure.

(2) the order of injunction under sub-section (1) may include an ex parte injunction or any interlocutory order for any of the following matters, namely:-

(A) for discovery of documents;

(B) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;

(C) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

(3) Notwithstanding anything contained in sub-section (1), the court shall not grant relief by way of damages (other than nominal damages) or on account of profits in any case-

(A) where in a suit for infringement of a trade mark, the infringement complained of is in relation to a certification trade mark or collective mark; or

(B) where in a suit for infringement the defendant satisfies the court-

(I) That at the time he commenced to use the trademark complained of in the suit, he was unaware and had no reasonable ground for believing that the trademark of the plaintiff was on the register or that the plaintiff was a registered user using by way of permitted use; and

(II) That when he became aware of the existence and nature of the plaintiff's right in the trade mark, he forthwith ceased to use the trade mark in relation to goods or services in respect of which it was registered; or

(C) where in a suit for passing off, the defendant satisfies the court-

- (I) that at the time he commenced to use the trade mark complained of in the suit he was unaware and had no reasonable ground for believing that the trade mark of the plaintiff was in use; and
- (II) that when he became aware of the existence and nature of the plaintiff's trade mark he forthwith ceased to use the trade mark complained of.

WELL KNOWN MARKS(Articles 16.2 and 3).

Obliges members to refuse or to cancel the registration, and to prohibit the use of a mark conflicting with a mark which is well known.

The provisions of that article must be applied also to services.

WELL KNOWN MARKS

It is required that knowledge in the relevant sector of the public acquired not only as a result of the use of the mark but also by other means, including as a result of its promotion, be taken into account.

The protection of registered well-known marks must extend to goods or services which are not similar to those in respect of which the trademark has been registered

Section 11

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the registrar shall -

- (i) protect a well-known trade mark against the identical or similar trade marks;**
- (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.**

The TRIPS Agreement requires member countries to make patents available for any inventions, whether products or processes, in all fields of technology without discrimination, subject to the normal tests of novelty, inventiveness and industrial applicability.

It is also required that patents be available and patent rights enjoyable without discrimination as to the place of invention and whether products are imported or locally produced (Article 27.1).

The exclusive rights that must be conferred by a product patent are the ones of making, using, offering for sale, selling, and importing for these purposes. Process patent protection must give rights not only over use of the process but also over products obtained directly by the process. (Article 28).

If the subject-matter of a patent is a process for obtaining a product, the judicial authorities shall have the authority to order the defendant to prove that the process to obtain an identical product is different from the patented process, where certain conditions indicating a likelihood that the protected process was used are met (Article 34).

3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

UK TRADEMARK REGISTRATION PROCESS

APPLICATION RECEIVED BY INTELLECTUAL
PROPERTY OFFICE(IPO-UK)

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graph TD; A[APPLICATION RECEIVED BY INTELLECTUAL PROPERTY OFFICE(IPO-UK)] --> B[ACKNOWLEDGEMENT RECEIPT SENT BACK TO APPLICANT]; B --> C[SEARCH REPORT SENT TO APPLICANT];
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ACKNOWLEDGEMENT RECEIPT SENT BACK
TO APPLICANT

SEARCH REPORT SENT TO APPLICANT

IF THE EXAMINER DOES NOT RAISE OBJECTIONS OR YOU CAN YOUR APPLICATION OVERCOME ANY OBJECTIONS RAISED, MARK IS ADVERTISED IN THE TRADE MARKS JOURNAL.



THERE IS AN EXTENDABLE PERIOD OF TWO MONTHS FOR ANYONE TO OPPOSE THE REGISTRATION OF THE MARK.

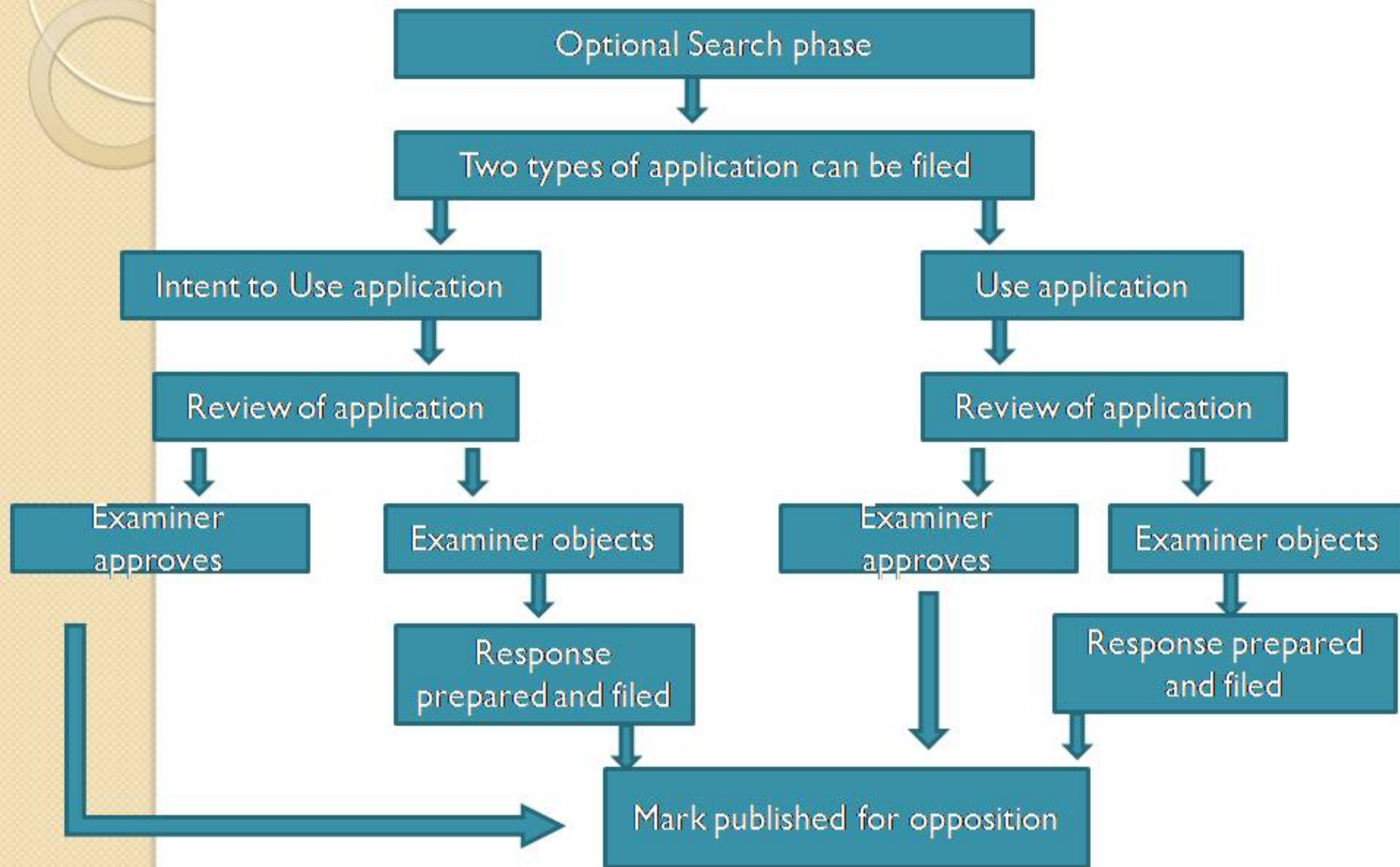


IF THERE IS NO OPPOSITION AND ALL THE OBJECTIONS ARE MET WITH, THE TRADEMARK IS REGISTERED AND A REGISTRATION CERTIFICATE IS SENT TO THE APPLICANT.



IF OBJECTIONS IN THE SEARCH REPORT ARE NOT MET WITH, EITHER THE APPLICANT WITHDRAWS OR THE IPO REJECTS THE APPLICATION

US TRADEMARK REGISTRATION PROCESS



Mark published for opposition

Opposition proceeding

Applicant must file a Statement of Use (SOU) with specimens within 6 months of allowance of ITU application

Mark becomes registered

THE MADRID SYSTEM FOR INTERNATIONAL FILING OF TRADEMARK

Administered by WIPO at Geneva, Switzerland.

**Facilitates registration of trademarks in multiple
countries across the world:**

**by filing one basic application
on payment a single set of fees**

Till date 84 contracting states.

Governed by two treaties:

MADRID AGREEMENT and MADRID PROTOCOL

MADRID AGREEMENT

- **Established in 1891;**
- **Oldest international filing system for trademarks;**
- **Despite being more than 100 years old, very few countries are members.**

Main limitation is the provision relating to “Central Attack”

If within 5 years from the date of international registration, the mark is declared invalid or otherwise lost in the country of origin, all the national registrations based upon it are also lost.

MADRID PROTOCOL

Established in 1989

More members in less number of years as compared to the Agreement

Under the protocol, if a mark is declared invalid or is otherwise lost in the country of origin, there is an option to transform the international registration into a series of national or regional applications. This has to be done within three months of cancellation of the mark.

INTERNATIONAL FILING OF TRADEMARK UNDER THE MADRID SYSTEM

Optional Search to determine if mark is free to use and register

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graph TD; A[Optional Search to determine if mark is free to use and register] --> B[File Application based on home application / registration at 'home' Trade Mark office]; B --> C[Receive official filing date detailing application number and official filing date]; C --> D[Formalities Examination by WIPO];
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File Application based on home application / registration at 'home' Trade Mark office

Receive official filing date detailing application number and official filing date

Formalities Examination by WIPO

Registration granted



Application sent to offices of nations covered by registration

No opposition



Registration confirmed

Objections



National Procedures

Objections waived

