

TRADEMARK BASICS

WIPO TRAINING OF TRAINERS PROGRAM

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Origin and History

Long long ago.....

- In ancient Roman & Greek civilisations clay pots were produced.
- Evidence shows that these pots were marked with a X or ★ which was slowly replaced with names -obviously of the potter , region or monarch.
- Soon inferior quality pots imitating the marks of well-known manufacturers were found.
- Imitated Roman pottery with imitation marks can be seen in the British Museum. They were made in Belgium & exported to Britain in the 1st century AD.

India

- **In India** we can trace the existence of trade marks even further down in history
- **Ancient Mohenjodaro** and Harappan civilizations dating back to almost 3500-2500BC , Indus merchants like in Sumeria stamped their properties with seals.
- **More than 2000** traders seals have been found in the Indus cities & others in Mesopotamia left there by overseas traders.
- **Sindhu merchants** used seals as trademarks impressing them on clay tags to label their goods

Use of Marks

Marks continued to be used on goods

- **Middle ages** -10th century ‘traders marks’ with illustrated depictions & monograms spread as protection against ship wreck or piracy (proprietary, more asset than liability)
- **2nd millennium** AD saw a new trend - kings & emperors used distinguishing marks to exemplify their service & bravery.
- **From use of marks** on goods we learn of the desire of an individual / family to distinguish the goods they own or manufacture
- **Heraldic devices** & trademarks are thus visual proclamations of ORIGIN, OWNERSHIP, PATRONAGE PRESTIGE & CONTROL.

Trade Marks

- **Royal patronage** increased volumes of manufacture & trade in fine porcelain, furniture & tapestries increased.
- **Use of trademarks** and logos to indicate quality and origin also grew.
- **End of 14th century** ‘producers or guild marks’ appeared and spread throughout western Europe to indicate the guild or trade association to which craftsmen belonged.
- **A second unique mark** was also used to identify workmanship of craftsmen in case of defects (more liability than asset)

Unfair Competition & Common Law

- **Trade mark law** was not created by any revolution. It evolved out of the common law of *fraud and deceit* and broader law of *unfair competition*.
- **Starting point** of present laws of trademarks can be traced to the *Southern v How* case in 1618 .
- **In the US** *Sandforths'* case in 1584- was of counterfeiting marks- '*A man is not to sell his goods on the pretence that they are the goods of another man*'
- **TMs as assets** of commercial importance developed in the second half of the 19th century
- **Need felt** for laws against the use of false marks, names, & imitation of brands-1850's passing off was prohibited

Development of TM laws

- **In response** Merchandise Marks Act 1862 was the first specific legislation to target 'forging of a TM' as well as falsely marking goods- criminal statute.
- **Demand for** legislation to protect TMs continued & the TM registration Act was passed in 1875-1st TM register in England.
- **Indian law** developed parallel with the common law system in the UK.
- **In 1877**, Bombay mill owners along with Bombay chamber of commerce went to State of Bombay to have law for protection of marks. Matter was referred to Government of India. TM bill passed in 1879 but withdrawn in 1880.

India and TM laws

- **Principle of infringement** action was embodied in S.54 of the Specific Relief Act 1877
- **1940- 1st legislation-** TM Act granted statutory recognition to trademarks & introduced procedures for registration.
- **1958 Trade & Merchandise Marks Act** replaced the earlier Act
- **TRIPS OBLIGATIONS**
- **Trade Marks Act 1999** -rules reframed & replaced the 1958 Act
 - Recognizes that registration itself does not create TM
 - Registration only gives protection under statute
 - Priority of adoption&use is superior to registration
 - Registration of non-conventional TMs like colours, etc.

What is a Trade Mark ?

- **A visual mark** used in the course of one's trade to distinguish his goods & services from those of others.
- **A TM is a mark** capable of being represented graphically & which is capable of distinguishing the goods and services of one person from those of others -as defined by the TMA 1999.
- **It includes** shapes of goods, their packaging & combination of colours.
- **“Marks”** means any device, brand, heading, label, ticket, name, signature, words, letter,numerals , shape of goods , their packaging or any combination thereof.
- ***A symbol*** to market one's products- *represents goods/services in a new & attractive light!*

Functions of Trade Marks

- **It *distinguishes*** the product from similar ones in the market place- If a mark cannot be relied upon to differentiate it cannot fulfill any other role. Eliminates confusion & reduces product searching costs
- **It *identifies*** the product- Products are recognized on the basis of TMs
- **It *indicates*** the source & origin of the producer-primary function- establishes connection between goods and people
- **It *advertises*** the product – investment function not merely the symbol of goodwill but often the most effective agent for the creation of goodwill. Mark actually sells goods.
- **It *guarantees*** & assures of a certain quality-TM is a standard of quality- customer expects that goods bearing the same mark will be of the same quality
- **Is an *incentive*** for manufacturers to develop new guarantees

Characteristics of Trade Marks

- ***Distinctiveness*** is the hallmark of TM.
- **Is a name**, sign or symbol- sign is anything which is capable of conveying information.
- **Is a kind of property** in relation to the value it lends a product.
- **Is and needs** to be protected by the law.
- **May be** registered or unregistered.
- **Can be transferred** or transmitted in connection with the goodwill of the business.
- **Many species** such as service marks, certification marks, collective marks & well – known TM's.
- **Indefinite life** and can outlive all other forms of IP protection.

Types of Trade Marks

A TM can consist of

- **Brand**:- Marks that are branded on goods
–*Tortoise brand, Goodnite mats...*



- **Words**- Kodak, Walkman- most common



- **Letters**- Successful & useful strategy to popularise TMs



Types of Trade Marks

- **Phrase**- catch phrases become good TMs, eg. *Yeh dil mange more! I'm loving it!*
Hum hain na! whenever you see
Colour think of us!



- **Signature**- McDowell's, Johnny Walker,..



- **Title** of a book or magazine can be a valid TM
eg. Playboy, India Today, Harry Potter.....
- **Numbers**- combination of numerals,



Types of Trade Marks

- **Symbols & logos-** visual depiction, popular as service marks-



- **Label & tickets** - composite mark with various features like wranglers , levis



- **Shapes** including 3-D shapes



- **Packaging-** pouches, bottles – trade dress involves the total image of a product & may include features such as shape, size, colours, textures, graphics, etc. *Cocacola case*

- **Device, Musical jingles,** Colours or combinations thereof and smells- Metro Goldwyn Mayer, Microsoft,

Forms/species of Trade Marks

These forms relate to specific business activity or purpose to which these marks are put to use

- **Service Marks-** Used for trade in services-banking, insurance, utilities, hotels, etc. Services as defined in the Consumer Protection Act.
- **Collective Marks-** Means TMS belonging to an association of persons- *Godrej, Tata*. SME's sector governed by associations & can use such marks.
- **Certification Marks-** those that are not used in the trade perse but are symbols/marks that certify certain prescribed standards of quality, origin, accuracy, etc.- *Hallmark, Agmark, Woolmark, ISI*
- **Well known TMs-** widely known mark that is well established and a symbol of company's goodwill & reputation –*Reliance, TATA*
- **Internet Domain names-** internet address/site through which commerce is carried out. One generally uses the same brand/TM for the site as in the real world- *Yahoo Inc.v Akash Arora'99 Rediff case 2000*

Multiple Trade Marks

Many established products & services are protected by a series of distinctive trade marks forming the overall trade mix



Excellent example of many protected TMs & trade dress
Name-distinctive copperplate logo style (based on signature style of co's founder) - dynamic ribbon-waisted bottle - slogans (It's the real thing) & combination of colours

Comparison of Trade Names & Trademarks

	Trade Names	Trade Marks & service marks
Protection Law	Commercial Laws	Trademark Law
Function	To distinguish traders (companies)	To distinguish goods and services
Composition	Characters (Chinese characters, Hiragana, Karnataka)	Characters, figures, signs, etc.
Protection period	Indefinite	Ten years from registration (may be renewed)
Scope of right	Within the same city, town, as designated by the law.	Same right throughout India

Requirements of a good TM

- Must be capable of graphical representation
- Must be capable of distinguishing goods and services, one from the other. Philips v Remington- *'sign is any thing which can convey information'*
- Must be capable of being registered
- Must not be descriptive or misdescriptive of the goods for which it is to be registered and used
- Must not be similar to existing or registered TMs
- *Must be capable of marketing your products*