

“Trade Mark under Intellectual Property Law”

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ABSTRACT

Trademark is a branch of intellectual property rights. Intellectual property rights permit people to maintain ownership rights of their innovative product and creative activity. The intellectual property came to light because of the efforts of human labour, so it is limited by a number of charges for the registration and charges for infringement. Types of intellectual property are Trademarks, Copyright Act, Patent Act, and Designs Act. A trademark includes a name, word, or sign that differentiates goods from the goods of other enterprises. Marketing of goods or services by the procedure becomes much easier with a trademark because recognition of product with the trademark is assured and easier. The owner can prevent the use of his mark or sign by another competitor.

Trademark is a marketing tool which increases financing of the business. A trademark is not always a brand but the brand is always is a trademark. Sometimes there is a confusion between trademark and brand. The brand name can be simply a symbol or logo but the trademark is a distinguishing sign or indicator in a business organization as it has a wider implication than brands. People are more influenced by the distinctive trademark that reflects the quality of the product. A trademark can be a logo, picture mark or a slogan.

Keywords: Trademark, Infringement, Distinctive, Brands

Introduction

The Trademark Act, 1999 gives the right to the police to arrest in cases of infringement of the trademark. The Act gives a complete definition for the term infringement which is frequently used. In Trademark Act, it provides punishments and penalties for the offenders. It also increases the time duration of registration and also registration of a non-traditional trademark. The Trademark Act, 1999 by the government of India by complying it with TRIPS (Trade-related aspects of intellectual property rights) obligation recommended by the World Trade Organization. The aim of the Trademark Act is to grant protection to the users of trademark and direct the conditions on the property and also provide legal remedies for the implementation of trademark rights.

Types of Trademark

Service mark

A service mark is any symbol name, sign, device or word which is intentionally used in trade to recognize and differentiate the services of one provider from others. Service marks do not cover material goods but only the allocation of services. Service marks are used in day to day services :

- Sponsorship

- Hotel services
- Entertainment services
- Speed reading instruction
- Management and investment
- Housing development services

A service mark is expected to play a critical role in promoting and selling a product or services. A product is indicated by its service mark, and that product's service mark is also known as a trademark.

Collective mark

A collective mark is used by employees and a collective group, or by members of a collaborative association, or the other group or organization to identify the source of goods or services. A collective mark indicates a mark which is used for goods and services and for the group of organizations with similar characteristics. The organization or group uses this mark for more than one person who is acting in a group organization or legal entity for dividing the different goods or services. Two types of collective marks for distinguishing with other goods or services of similar nature:

- Collective mark indicates that the marketer, trader or person is a part of the specified group or organization. Example – CA is a collective trademark which is used by the Institute of the chartered accountant.
- Collective trademark and collective service mark are used to indicate the origin or source of the product.

A collective trademark is used by the single members of a group of an organization but is registered as a whole group. Example- CA is the title or mark which given to the member of Institute of a chartered accountant. That collective mark may be used by the group of association. This was added to the Trademark Act, 1988.

Certification mark

A certificate mark is verification or confirmation of matter by providing assurance that some act has been done or some judicial formality has been complied with. A certification mark indicates certain qualities of goods or services with which the mark are used is certified, a certification mark is defined in the Trademark Act, 1999.

Certification trade mark means a mark competent of identifying the goods or services in connection with which it is used in the manner of trade, which is certified by the owner of the mark in respect of source, body, mode of manufacturer of goods or performances of assistance, quality, accuracy or other characteristics.

Those goods or services which not so certified and registrable as such under this Act, in respect of those goods or services in the name as the proprietor of the certification trade mark, of that person. Registration of certification mark is done according to the Trademark Act, 1999. Requirements for registration is the product must be competent to certify.

Trade dress

Trade dress is a term that refers to features of the visual appearance of a product or design of a building or its packaging that denote the source of the product to customers. It is a form of intellectual property. Trade dress protection is implemented to protect consumers from packaging or appearance of products that framed to imitate other products.

Essential of trade dress

- Anything that makes an overall look or overall dress and feel of brand in the market.
- The consumer believes that trade dress is the main indicator of differentiation of one brand or goods from others.
- The requirement for the registration of trade dress is the same as the registration of the logo, mark. The features in trade dress are size, colour, texture, graphics, design, shape, packaging, and many more.

Designation of trademark

Trademark is designated by:

- **TM** (TM is used for an unregistered trademark.it is used to promote or brand goods).
- **SM** (used for an unregistered service mark.it is used to promote or brand services).
- **R** (letter R is surrounded by a circle and used for registered trademark).

Uses of Trademark

Trademark identifies the owner of the product. Under any authorized agreement of product, a trademark can be used, an example of trademarks goods names are, iPod and a big mac. Company logos like the Golden Arches at McDonald's and McDonald's "I'm lovin' it. Brand names like Apple, McDonald's, and Dolce & Gabbana.

The usage of the trademark by unauthorized means or illegal means by producing it in trading is known as trademark piracy. If there is an infringement of trademark, the owner of the registered trademark can take legal action and for an unregistered trademark, the only option is passing off. Many countries like the United States, Canada and many more also, accept the trademark policies, so they also gave the right to the master of product to take the action for the protection of their trademark A common concept of a trademark is that the owner of a registered trademark has a more legal right for protection than the owner of unregistered trademark.

The concept of usage of the non-physical trademark the Supreme Court held in the case of Hardie trading Ltd. v. Addison paint and chemicals Ltd. The Supreme Court gave a wider interpretation on the usage of a trademark that it could be non-physical and that there were no grounds to restrict the user to use on the commodities or to the sale of the commodities bearing the trademark.

Owner of the Trademark

Trademark gives protection to the owner by assuring them with the exclusive rights to use a trademark, to identify the goods or services or permit others to use it in results of payment. It is a weapon for the registered proprietor to stop the others from illegal use of the trademark. Under Section 28 the rights conferred by registration.

- The registration of a trademark is valid if the right is given to the certified owner of the trademark, the owner has the exclusive right to use of the trademark in respect of goods or services in which the trademark is registered and to claim maintenance in respect of infringement of the trademark is given to the holder of the trademark.
- Wherever more than two persons are certified proprietors of the trademark which are same with or nearly identical with each other. The exclusive right to use of each of those trademarks shall not except if their own rights are related to any conditions or limitations entered on the register be expected to be taken by one of those persons as against of other persons only by registration of the trademark, but each of those persons has the same rights as against other persons.

Registration of Trademark

Any person claiming to be the owner of the trademark or supposed to used the trademark by him in future for this he may apply in writing to the appropriate registrar in a prescribed manner. The application must contain the name of the goods, mark and services, class of goods and the services in which it falls, name and address of the applicant and duration of use of the mark. Here the person means an association of firms, partnership firm, a company, trust, state government or the central government.

Conditions of registration

The central government by mentioning in the official gazette appoint a person to be known as the controller, general of patents, designs and trademark who shall be the registrar of the trademark. The central government may appoint other officers also if they think that they are appropriate, for the purpose of discharging, under the superintendence and direction of the registrar, the registrar may authorize them to discharge.

The registrar has the power to transfer or withdraw the cases by in writing with reasons mentioned. Under Section 6 of the Act, discussed the maintenance of a registered trademark. At head office wherein particulars of registered trademarks and other prescribed, particulars, except notice of the trust, shall be recorded. The copy of the register is to be kept at each branch office. It gives for the preservation of records in computer or diskettes or in any other electronic form.

Absolute grounds for refusal of registration

Absolute grounds for the refusal of registration is defined in Section 9 of the Act. The trademarks which can be lacking any distinctive characteristics or which consists exclusively of marks or signals, which can be used in trade to indicate the kind, fine, quantity, supposed grounds, values, geographical origin.

And also a time of production of goods or rendering of the offerings or different characteristics of the goods or offerings which consists solely of marks or indications which have come to be average in the present language. That marks are not entitled to registration. Except it is confirmed that the mark has in fact acquired a new character as a result of use before the date of application.

It gives that a mark shall not be registered as trademarks if:

1. It frauds the public or causes confusion.
2. There is any matter to hurt religious susceptibility.
3. There is an obscene or scandalous matter.
4. Its use is prohibited. It provides that if a mark contains exclusively of (a) the shape of goods which form the nature of goods or, (b) the shape of good which is needed to obtain a technical result or, (c) the shape of goods which gives substantial value of goods then it shall not be registered as trademark.

Test of similarity

For the conclusion, if one mark is deceptively similar to another the essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design and if they are of such a character to prevent one design from being mistaken for the other. It would be enough if the disputed mark has such an overall similarity to the registered mark as it likely to deceive a person usually dealing with one to accept the other if offered to him. Apart from the structural, visual, and phonetic similarity or dissimilarity, the query needs to be viewed from the factor of view of man typical intelligence and imperfect collection secondly. It's regarded as an entire thirdly it is the query of his impressions.

In Mohd. Iqbal v. Mohd. Wasim it was held that "it is common knowledge that '*bidis*' are being used by persons belonging to the poorer and illiterate or semi-literate class. Their level of knowledge is not high. It cannot be expected of them that they would comprehend and understand the fine differences between the two labels, which may be detected on comparing the two labels are common. In view of the above, there appears to be a deceptive similarity between the two labels".

Relative grounds for refusal of registration

Under Section 11 of the Act, it gives relative grounds for the refusal of registration of a trademark. A trademark cannot be registered if because of (i) its identity with an earlier trademark and similarity of goods or services, (ii) its similarity to an earlier trade mark and the similarity of the goods and there is a probability of confusion.

It also gives that a trademark cannot be registered which is identical or similar to an earlier trademark. And also which is to be registered for goods and services which are not similar to those for which earlier trademark is registered in the name of a different proprietor if, or to the extent, the earlier trademark is well known in India. It further gives that a trademark is cannot be registered if, or to the extent that, its use in India is liable to be prevented by virtue of any law.

Procedure and Duration of registration

The registrar on the application made by the proprietor of the trademark in the prescribed manner within the given period of time with the adequate payment of fees. Registration of a trademark shall be of ten years and renewal of the registered trademark is also for a period of ten years from the date of expiration of the original registration or of the last renewal of registration.

The registrar shall send the notice before the expiration of last registration in the prescribed manner to the registered proprietor. The notice mentions the date of expiration and payment of fees and upon which a renewal of registration may be obtained if at the expiration of the time given in that behalf those conditions have not duly complied with the registrar may remove the trademark from the register.

But the registrar shall not remove the trademark from the register if implication made within the prescribed form and the prescribed rate is paid within six months from the expiration of the final registration of the trademark and shall renew the registration of the trademark for an interval of ten years. If the trademark is removed from the register for non-payment of the prescribed fee, the registrar shall after six months and within one year from the expiration of the last registration of the trademark renew the registration,

And also on receipt of implication in the prescribed form and on payment of the prescribed fee the registrar restores the trademark to the register and renew the registration of the trademark, for a period of ten years from the expiration of the last registration.

International registration of a trademark

The law of trademark passed by the Indian government is applicable only within the territory of India. The trademark which is registered in has effect only in India, for the protection of trademark in other countries needs to be registered in another country as well. Each country has its own trademark law with rules and law for the registration of a trademark in that country. In other words, if an individual desire to obtain trademark registration in any particular nation then a separate application must be moved in all such international locations. Within the year 2013, the Indian government agreed to the Madrid conference which prescribes a methodology of submitting a worldwide application to the contracting events from India by means of the workplace of the Registrar of Trademark. For example- India's mobile phone manufacturing Micromax received 1.25 millionth international trademark registration for its trademark 'MICROMAX' protection in over 110 countries. The international trademark registration for Micromax filed under the Madrid Protocol, under mark can be protected in many jurisdictions by only filing an application for international registration. There are two methods by which an international application can be filed:

- **International application in each foreign country:** For the protection of trademark in any foreign country, an international application must be filed to the trademark office by following the rules and regulations of that country. For this purpose the applicant must hire a firm dealing in trademark registration in foreign, the applications to countries which is not a party to the Madrid system can be filed as per above. It provides services that engaging an Attorney in the foreign countries works closely for registration of a trademark in the foreign country.
- **The international application under the Madrid system:** The trademark registration may also be initiated by means of filing an international application under Madrid protocol before the Registrar of Trademark for different nations. The Indian Trademark office collects international Trademark application and after finding it in conformity with the Madrid protocol transmits such a global application to the WIPO (World Intellectual Property Organization), which further transmits it to the situation overseas. Each and every global software is processed by way of the overseas nation as per their legislation and all communications are routed by means of Indian executive.

Effect of Registration

The registration of a trademark shall if valid give the exclusive right to the registered proprietor to the use of trademarks in respect of goods and services of which the trademark is registered, and also to obtain relief in respect of the infringement of the trademark.

Infringement of trademark

A registered trademark is infringed by a person who not being a registered proprietor or a person using by way of permitted use in the course of trade, a mark which is identical with or deceptively similar to the trademark in relation to goods or services in respect of which the trademark is registered. After infringement, the owner of the trademark can go for civil legal proceedings against a party who infringes the registered trademark. Basically, Trademark infringement means the unapproved use of a trademark on regarding products and benefits in a way that is going to cause confusion, difficult, about the trader or potentially benefits.

Infringement of trademark on the internet

The expansion of the web is also leading to an expansion of inappropriate trademark infringement allegations. Probably, a company will assert trademark infringement each time it views one among its trademarks on an online page of a Third party. For example, an individual who develops a website online that discusses her expertise with Microsoft software could use Microsoft's trademarks to consult exact merchandise without the worry of infringement. However, she mainly would no longer be competent to use the marks in this kind of means as to intent viewers of her internet web page to feel that she is affiliated with Microsoft or that Microsoft is somehow sponsoring her net web page. The honour could simplest be analyzed upon seeing how the marks are sincerely used on the web page. In this way, there is an infringement of trademark on the internet.

Case laws on Infringement

Hearst company Vs Dalal avenue verbal exchange Ltd.

The courtroom held that a trademark is infringed when a character in the course of trade makes use of a mark which is same with or deceptively similar to the trademark in terms of the goods in respect of which the trademark is registered. Use of the mark by using such man or woman needs to be in a manner which is more likely to be taken as getting used as a trademark.

Amritdhara Pharmacy Vs Satya Deo Gupta,

In this case for determining the connection in two words related to an infringement action was stated by the Supreme Court that there must be taken two words which are deceptively similar. And judge them by their appearance and by their sound. There must be considered that the goods to which they are to be utilised. There must be a consideration of the nature and kind of customer who would be likely to buy those goods. In fact, it must be considered the surrounding circumstances and also must consider what is likely to occur if each of those trademarks is used in common ways as a trademark for the goods of the particular owners of the marks.

After considering all those circumstances, they came to the conclusion that there will be confusion. This is to say that, not significantly that one man will be injured and the other will gain the illegal benefit, but it for that there will be a mess in the mind of the public which will lead to confusion in the goods then there may be the refusal of the registration.

No action for an unregistered trademark

This is defined under Section 27 of Act that no infringement will lie with respect to an unregistered trademark, but recognises the common law rights of the trademark owner to take action against any person for passing off goods as the goods of another person as services provided by another person or the remedies thereof.

Passing off

Passing off is common legislation of tort, which can be used to put in force for unregistered trademark rights. The regulation of passing off prevents one man or woman from misrepresenting other items or services. The inspiration for passing off has faced some changes in the duration of time. In the beginning, it was restrained to the representation of one person goods to another. Later it was elevated to business and non- trading activities. Therefore it used to be additionally accelerated to professions and non-trading movements. Today it is applied to many types of unfair trading and unfair competitors where the activity of one person cause damage to another

person. The fundamental question on this tort turns upon whether the defendant's conduct is such as deceive or mislead the general public to the confusion between the industry activities of the two.

In *British Diabetic organization V Diabetic*, both the parties have been charitable societies. Their names have been deceptively identical. The phrases 'association' and 'society' both should be considering that they have been similar in derivation and meaning and were not completely varied in kind. The everlasting injunction was granted.

Difference between passing off and infringement

The measures for passing off is different from the measures of an infringement. The claim for infringement is a lawful remedy whereas the claim for passing off is a common law remedy. Therefore, in order to establish infringement with respect to a registered trademark, it is only required to prove that the infringing mark is same or deceptively similar to the certified mark and no more proof is required. In the case of a passing off claim, proving that the marks are same or deceptively similar only is not sufficient.

The use of the mark should be likely to mislead or cause confusion. Moreover, in a passing off claim it is necessary to verify that the use of the trademark by the defendant is expected to cause injury or damage to the plaintiff's goodwill, whereas, in an infringement suit, the use of the mark by the defendant must not cause any injury to the plaintiff. But, when a trademark is registered, registration is given only with respect to a particular category of goods. Protection is, therefore, provided only to these goods. In a passing off action, the defendant's goods must not be the same; it may be different.

In, *Kaviraj Pandit Durga Dutt Sharma Vs. Navaratna Pharmaceutical laboratories*, the Apex court held that there are some differences between the trial for passing off and trial for infringement of a trademark. In *American Home Products Corpn. Vs. Lupin Laboratories Ltd.*, the Court held that it is well-settled law that when regarding the infringement of a registered trademark. It is important to carry in mind the difference between the search for infringement and the search in passing off the trial. In a passing off action, the courts seem to see whether there is deception whereas, in infringement matter, it is important to note that the Trademark Act gives to the owner an exclusive right to the use of the mark which will be infringed in the case of indistinguishable mark and in the case of related marks, even though there is deception, infringement can still take place.

In *Satyam Infoway Ltd. Vs Sifynet Solutions (P) Ltd.* it was held by the Court that to proceed action for passing off three elements are required to be established, which are as follows:

- In a trial for Passing off, as the expression passing off itself suggests, is to restrict the defendant from passing off its goods or services to the public which of the plaintiff's. It is a claim not only to preserve the status of the plaintiff but also to protect the public. The defendant must have traded its goods or given its services in a manner which was deceived or would be likely to deceive the public into thinking that the defendant's goods or services are the plaintiffs.
- That second element that must be established by the plaintiff is a misconception by the defendant to the public and what has to be placed in the possibility of confusion in the minds of the public that the goods or services offered by the defendant are the goods or the services of the plaintiff. In assessing the possibility of such confusion the court must allow for the 'imperfect recollection of a person or ordinary memory'.
- The third element of a passing off action is loss or the possibility of it.

Notwithstanding, trademark registration under the Act only has effect in India. To get trademark rights and protection in other countries it is required to register the trademark in those countries. Trademark protection is regional in nature. A single registration will have to be made in every country where protection is wanted. To get protection outside India, it is required to file applications in the respect of the countries individually. In enhancement, there should be registration in a country before you begin the use of the trademark in that country. In some countries such as China, Japan, Continental Europe, and Indonesia, the first person who applies for registration will get the rights of a trademark, rather than the person who first uses the trademark. Hence, the different party could legitimately take trademark by applying for registration even if there is the first person using the trademark.

Expanding boundaries of the scope of trademark

Domain name

Every company on the internet has a domain name with a different address in cyberspace at which the website is located. Nowadays companies have internet pages as the producer and consumer are far away located as well as every company is going global. The other purpose is that the Internet has become an essential tool in marketing. The rule came to be revealed as IP numbers are hard to remember therefore they came up with the Domain Name System.

A user of the internet will find the domain name very useful in finding the goods or services that he expected to find. But sometimes a distinct name of a highly commended business may be allowed and passed off as the original one, For example, Tata, Google and Maruti. People visit a website or domain name through a website or a URL. Cybercrime generally means the registration of another party's mark as a domain name for the purpose of misuse. A domain name has to be related to the product given and it has to be different. While choosing a domain name for a website it is desirable that it should be different. A high level of distinctiveness is allowed that two domain names could not be alike. Two types of disputes that occur which concerns with the domain name.

(i) That both the parties have the legal right to forming the words for the domain name in use. In this way, the court decides that who is the original owner and who the infringer is.

(ii)The second type is cyber piracy where a party with no legal right questions the real owner. In this type of problem, there is a number of ways by which a trademark owner can fight with cyberpiracy.

Smell

It is a non-traditional type of trademark. There is a large problem in registering this type of trademarks as there is no physical representation. Due to its high level of distinctiveness, for example, the smell of a perfume strawberry etc., it is difficult to register this kind of trademark. Smell marks are accepted if they are represented with a graphical representation. But this provision is only in some countries. Smell the trademark is protected under copyright. In some instances a particular scent is also a commodity by itself in other circumstances it is a scent used or attached to the commodity not the natural smell of the product itself.

Sound

A sound may be trademark and can also be registered. A sound mark is a sound or a theme with a different identification effect. A well-known sound mark is music owned by Hemglass. When applying for a sound mark the mark can be expressed by a sound file or by an accurate description of the sound in notation.

Shape

Distinguishing the one product from another assures that the customer doesn't get confused by similar products. The shape of goods registered as a trademark as long as the shape is not working. A shape is working if it affects the use or performance of the product. The shape of goods can be a trademark if,

- The shape doesn't superior working.
- The shape has become connected with public and manufacturer.

A shape of goods may be registered as a trademark when the shape is not working. Thus if a certain shape is delicate more than useful in daily life and serves no purpose then it may be registered.

Conclusion and Recommendations

Intellectual Property reflects the meaning that it's subject body is the product of the mind or the intellect. As it's the product of a productive and creative mind, It can be traded, purchased, given and reserved. All this can be done but there are issues related that to be dealt. Trademarks are very important aspects of Intellectual Property so, the protection of the trademark has become essential in the present day because, every generator of a good or service will want his mark to be different, eye-catching and it should be easily distinguishable from others.

Designing a mark like this is difficult and after this when infringing of the mark takes place it will cause maximum difficulty to the producer. Capital Protection is very important and there should be a step towards Global Intellectual Property Order, if there is no IPR protection, it can be explained that inventive activity will terminate. The reason for Intellectual Property protection is that it can arouse creativity and discovery and prevent the exploitation of inventions.

Public policy here points at keeping an Intellectual Property system which promotes innovation through protection initiatives, while at the same time assuring that this is not at the value of societal interests. In this meaning, the challenge for the World Intellectual Property Organisation would be to include public policy effects in applications carried out with developing countries, such as increasing awareness of flexibilities in existing international intellectual property treaties.

Intellectual Property is not an unusual concept, in fact, it is a concept which is discussed in everyday life whether a movie, book, plant variety, food item, cosmetics, electrical gadgets, software's etc. It has become a concept of pervasiveness in everyday life. The World Intellectual Property Day on 26th April every year

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