UNIT – II

## Trade Marks

## Trademark

A trademark is a recognizable insignia, phrase, word, or symbol that denotes a specific product and legally differentiates it from all other products of its kind. A trademark exclusively identifies a product as belonging to a specific company and recognizes the company's ownership of the brand.

Similar to a trademark, a [service mark](https://www.investopedia.com/terms/s/service-mark.asp) identifies and distinguishes the source of a service rather than a product, and the term “trademark” is often used to refer to both trademarks and service marks. Trademarks are generally considered a form of [intellectual property](https://www.investopedia.com/terms/i/intellectualproperty.asp).

## Purpose and function of trademarks

## There are two main purposes that a trademark serves. One is distinguishing and identifying services or goods that a seller or manufacturer sells or is sold by other companies or sellers. The second is to give the public the information about where the logo, name, or brand came from. It ultimately is a way to brand a product, name, or slogan.

**Functions of a Trademark**

A trademark serves the purpose of identifying the source or the origin of goods. Trademark performs the following four functions.

* It identifies the product and it’s origin.
* It proposes to guarantee its quality.
* It advertises the product. The trademark represents the product.
* It creates an image of the product in the minds of the public particularly the consumers or the prospective consumers of such goods.

## Categories Trademarks

A [trademark](https://www.upcounsel.com/trademarks) offers legal protection for a word, symbol, phrase, logo, design, or combination of those that represents a source of goods or services. Types of trademarks for products include five main categories: generic mark, descriptive mark, suggestive mark, fanciful, and arbitrary mark.

* **Generic Mark**
  + A [generic trademark](https://www.upcounsel.com/generic-trademark) actually doesn't qualify for a trademark unless it includes more specific detail. One example of a generic mark is the phrase, "The Ice Cream Shop." Offering trademark protection on something this generic would restrict all other shops that sell ice cream.
  + To qualify a generic mark for a trademark, it needs to describe qualities, characteristics, or ingredients of the good your business sells.
* **Descriptive Mark**
  + A [descriptive mark](https://www.upcounsel.com/descriptive-trademark) identifies one or more characteristics of a prodct or service and only serves to describe the product. It has unique elements that qualify it for protection under [trademark laws](https://www.upcounsel.com/trademark-law) such as it must have secondary meaning such as amount and manner of advertising, volume of sales, length and manner of the mark's use, or results of consumer surveys to qualify. This means that consumers must recognize the mark and identify it with the brand.
  + To qualify as a descriptive mark, it should evolve from what the brand represents to who the brand represents.
* **Suggestive Mark**
  + A [suggestive mark](https://www.upcounsel.com/suggestive-trademark) implies something about the good or service. A mark in this category typically qualifies for protection without requiring a secondary meaning.
  + The term "suggestive" means that the customer must use the imagination to figure out what services or goods the company offers. One example is the luxury automotive brand, Jaguar. It suggests speed and agility, but doesn't immediately convey a car manufacturer.
* **Fanciful Mark**
  + A [fanciful mark](https://www.upcounsel.com/fanciful-trademark) is a term, name, or logo that is different from anything else that exists. This category is the easiest for obtaining trademark protection because it typically doesn't compete with anything else or become too generic.
  + Examples of fanciful marks include Kodak, Nike, and Adidas. These words don't hold any meaning in common language, so trademarking them doesn't infringe on the rights of other companies that offer similar products.
* **Arbitrary Mark**
  + An [arbitrary mark](https://www.upcounsel.com/arbitrary-trademark) might include a term or phrase with a well-known meaning, but the meaning in its case is different. The best example of an arbitrary mark is Apple, the computer and electronics manufacturer. An apple is a familiar term, but in this case, the mark doesn't have anything to do with the general meaning of the term.
* **Service Mark**
  + A [service mark](https://www.upcounsel.com/service-mark) is the same as a trademark, but it distinguishes a company that provides services instead of products. A servce mark still falls under the legal trademark laws and must be registered with the USPTO.
  + A common example of a service mark would be the "McDonald's" service mark since it is used to represent the services provided.

An additional form of legal protection for distinguishing businesses is:

* **Trade Dress**
  + A [trade dress](https://www.upcounsel.com/trade-dress) includes identifying features of a product or company such as packaging elements, décor items, and other similar concepts. Product features don't usually fall under a type of trademark for legal protection, but instead under [trade dress protection](https://www.upcounsel.com/trade-dress-protection). If a consumer identifies a specific feature or features with a brand or company instead of the actual product, the case for trade dress protection is strong.
  + One example of trade dress is the bottle of Listerine mouthwash. The unique flat shape of the bottle is easily identifiable to customers looking for Listerine, so it qualified for protection, which restricts others from producing a confusingly similar bottle design.

Protectable matter

1. Slogans, Letters and Numbers
2. Logos and symbols
3. Names of performing artists
4. Domain names
5. Foreign names
6. Shapes of containers
7. Trade Dress
8. Colour
9. Fragrances, Sounds and moving images

Exclusions from Trademarks: Trademarks does not include

1. Disparaging marks or falsely suggestive marks
2. Insignia Flags
3. Immoral and scandalous matter
4. Names and Portraits of living person
5. Deceptive matter
6. Mere surnames
7. Geographical terms
8. Merely descriptive or confusing marks
9. Functional devices
10. Statutory protected marks

Acquisition of trade mark rights:

Depending on the country trademarks rights are established through use or registration. Based on English common Law using a mark can establish rights on the mark. In some countries the registration may provide broader rights than common l:aw.

Rights that arise from simply using the mark are limited to geographic area while rights obtained through registration may extend throughout the country. Usually an application to register a trademark is made in the Trademark office where the applicant wishes to protect the mark.

The application includes name and address of the applicant, representation of mark and however most countries do not require the mark to be used before registration.

Once the trademark application meets the requirements for registration, then it is published by Trademark Office. If no opposition is filed in the limited period after publication, the registration is issued which remains valid for ever.

The Law is US is quite different. The rights on arise from adaption and use of mark not from registration. A person using mark has valid and enforceable rights on a mark even though it is not registered with USPTO. Such an owner will have priority over a subsequent user of the mark.

But the use must be public use rather than token use. Establishing date of first use is more important for Trademark owners because validity of trademarks is measured from this date. Although general use is that acquisition of Trademark rights arise from use there is an exception to the rule i.e Intent to use application.

An applicant has began using the mark and then filed an application and if USPTO might refuse registration of he mark subject to any defect, the applicant would have invested money and time in developing the mark and using it in commerce (marketing & advertising) will go waste, to remedy this situation Act allowed persons to file applications for marks based on bonafied intent to use the mark in commerce in future,

#### International Classification of Goods & Services

#### Trademark Classes for Products

[**Class 1: Chemical Goods –**](https://tingenwilliams.com/2018/trademark-class-1-chemical-goods/7898)Class 1 is a very broad category encompassing many different chemical goods. It includes chemicals used in industry, science, photography, agriculture, horticulture, and forestry, as well as many others.

[**Class 2: Paints –**](https://tingenwilliams.com/2018/trademark-class-2-paints/7903)Class 2 is for paints, varnishes and lacquers, preservatives, and other colorants. Additionally, Class 2 covers certain foil and powder metals for artists.

[**Class 3: Perfumes and Personal Hygiene –**](https://tingenwilliams.com/2018/class-3-trademark/7916)Class 3 includes all soaps and personal hygiene items, such as perfumes, cosmetics, hair products, and shaving products. Detergent, bleaches, and abrasives for household cleaning and polishing also fall under this class.

[**Class 4: Fuels, Oils, and Illuminants –**](https://tingenwilliams.com/2018/class-4-trademark/7914)Class 4 includes both liquid fuels, such as gasoline or some alcohols, and solid fuels, such as coal. In a similar way, wax, wood, and other illuminants are also covered here. Finally, the Nice agreement also includes some green energy services, even those that would otherwise avoid the term “fuel,” in this class. This is because Class 4 also covers most products that are used to make electrical energy.

[**Class 5: Pharmaceutical, Medical, and Veterinary Products –**](https://tingenwilliams.com/2018/class-5-trademark-pharmaceutical-medical-and-veterinary-products/7907)Class 5 includes pharmaceutical, veterinary, and sanitary products. Some common examples of products in this class are diapers, medical shampoos, dietary supplements, and personal hygiene products that do not count as toiletries.

[**Class 6: Common Metals –**](https://tingenwilliams.com/2018/class-6-trademark/7945)Class 6 includes partly wrought and unwrought metals. For example, metal goods used in buildings and railways, metal pipes and tubes, and nuts and bolts all fall under this class. Certain other forms of metal hardware also fall under Class 6, such as wires, chains, aluminum foil, and metal signs.

[**Class 7: Machines and Machine Parts –**](https://tingenwilliams.com/2018/trademark-class-7-machines-and-machine-parts/7923)Class 7 covers a wide array of machines and their parts, from 3D printers to industrial robots and engines. Most non-hand operated, non-vehicular machines fall under this classification.

[**Class 8: Hand Operated Tools –**](https://tingenwilliams.com/2018/trademark-class-8-hand-operated-tools/7938)Class 8 is very similar to Class 7, but specifically covers hand-operated tools and machines. Basically, if you need a hand, rather than a motor, to use it, then it would fall under this class. For example, hammers, razors, kitchen knives, and certain gardening tools all fall under this class.

[**Class 9: Electric and Scientific Apparatus –**](https://tingenwilliams.com/2018/trademark-class-9-electric-and-scientific-apparatus/7941)An electric or scientific “apparatus” is a piece of technical or mechanical equipment created to perform a very specific job. For instance, recording and media equipment (whether audio or video), fall under Class 9. Class 9 also includes computer parts and electrical parts such as fuses, sockets, and plugs.

[**Class 10: Medical Apparatus –**](https://tingenwilliams.com/2018/trademark-class-10-medical-apparatus/7943)Similarly to Class 9, Class 10 includes medical apparatuses, equipment, and supplies that are specifically made for diagnosing and treating people and animals. These products range from rehabilitation tools to veterinary supplies, artificial organs, and more.

[**Class 11: Appliances –**](https://tingenwilliams.com/2018/class-11-trademark-appliances/7958)Any industrial or home appliance used to clean, cook, or otherwise make a space cleaner or nicer go in Class 11. This can include air-conditioning, electric kettles, electric cooking utensils, and refrigerators.

[**Class 12: Vehicles –**](https://tingenwilliams.com/2018/class-12-trademark-vehicles/7948)This class includes all vehicles and vehicle parts that help transport people and goods by land, air, and water. Airplanes, boats, cars, transmission parts, steering wheels, and many other vehicle-related marks go into this class.

[**Class 13: Firearms, Fireworks, and Explosives –**](https://tingenwilliams.com/2018/class-13-trademark/7963)Weapons, ammunition, pyrotechnics, and other non-military explosives are in Class 13.

[**Class 14: Jewelry –**](https://tingenwilliams.com/2018/trademark-class-14-jewelry/7985)This class includes things such as jewelry, cufflinks, clocks, watches, and the components used to make these things. This class also covers precious and semi-precious stones.

[**Class 15: Musical Instruments –**](https://tingenwilliams.com/2018/trademark-class-15-musical-instruments/7988)This category covers all musical instruments and their components, both acoustic and electric.

[**Class 16: Paper Products –**](https://tingenwilliams.com/2018/trademark-class-16/8031)This class mostly deals with paper and the things people use to organize paper. If it’s made of paper, or holds paper in some way, it’s probably in Class 16. Some examples include typewriters, painters’ easels, napkins, envelopes, and metal binder clips.

[**Class 17: Rubber and Plastic Products –**](https://tingenwilliams.com/2018/trademark-class-17-rubber-and-plastic-products/8018)This is another broad category that covers a variety of products made of rubber and plastic. Some examples are tubes and hoses, seals and fillers (like caulk), and insulation.

[**Class 18: Leather –**](https://tingenwilliams.com/2018/trademark-class-18/8049)Leather and non-leather suitcases and wallets, as well as certain leather animal supplies (like horse bridles), are in Class 18. Pelts, hides, and fur (including fake fur) are also in this class. It’s important to note that clothing made of leather is **not** in Class 18.

[**Class 19: Non-Metal Building Materials –**](https://tingenwilliams.com/2018/trademark-class-19-non-metal-building-materials/8056)Stone, metal, wood, and glass for building are in this class, along with any non-metal building materials. Cement, however, falls under Class 1.

[**Class 20: Furniture –**](https://tingenwilliams.com/2018/trademark-class-20-furniture/8058)All furniture, including furniture for outdoors, babies, or pets is in Class 20. This class is also for furniture components like dowels, pins, latches and hinges.

[**Class 21: Household Utensils –**](https://tingenwilliams.com/2018/trademark-class-21-household-utensils/8161)Trademark Class 21 includes kitchen utensils, pots and pans and hand-operated kitchen tools. This class also includes some cleaning tools and bathroom items, as well as most glassware and dishes. Finally, certain related items, such as combs and toothbrushes, watering cans, and aquariums, also fall under this class.

[**Class 22: Textiles and Fibers –**](https://tingenwilliams.com/2018/trademark-class-22-textiles-and-fibers/8061)Class 22 covers textiles including ropes, materials for ship and boat building, padding materials, cushioning and stuffing materials, raw fibrous materials, and other textiles.

[**Class 23: Threads and Yarns –**](https://tingenwilliams.com/2018/trademark-class-23-threads-and-yarns/8064)This class is for yarns and threads for textile use.

[**Class 24: Textile Goods –**](https://tingenwilliams.com/2018/trademark-class-24-textile-goods/8084)Unlike Class 22, this class is for goods made from textiles. Some examples are fabrics, linens, flags, and wall hangings. Sleeping bags are also a common Class 24 product.

[**Class 25: Clothing –**](https://tingenwilliams.com/2018/class-25-trademark-clothing/8129)All clothing, including footwear and headwear, is in this class. Only certain specialized clothing falls under other classes, such as hair ribbons (Class 26).

[**Class 26: Cloth Finishing –**](https://tingenwilliams.com/2018/trademark-class-26-cloth-finishing/8131)Cording, lace, hooks, buttons, and accessories such as charms fall under the “cloth finishing” class. Interestingly, this class also includes false hair and hair accessories. Basically, most accessories used to compliment a particular outfit fall under Class 26.

[**Class 27: Floor Coverings –**](https://tingenwilliams.com/2018/trademark-class-27-floor-coverings/8135)Carpets, rugs, mats, linoleum, and other general floor coverings are in Class 27. Non-textile wall hangings also go into this class.

[**Class 28: Games and Sporting Goods –**](https://tingenwilliams.com/2018/trademark-class-28-games-and-sporting-goods/8164)This class includes all games, video games, sports equipment, toys, and playground equipment. Some religious holiday decorations are also in Class 28, such as Christmas tree ornaments.

[**Class 29: Meat, Dairy, and Nuts –**](https://tingenwilliams.com/2018/trademark-class-29-meat-dairy-nuts/8173)Class 29 is for all meats, including seafood, that are intended for human consumption. It also includes dairy products, nuts, fruits, and vegetables.

[**Class 30: Bread, Baking Ingredients, Coffee, and Tea –**](https://tingenwilliams.com/2018/trademark-class-30-breads-baking-ingredients-coffee-tea/8190)As the second food-related trademark class on this list, class 30 covers a wide range of food items prepared from plants.

[**Class 31: Natural Agricultural Goods –**](https://tingenwilliams.com/2018/trademark-class-31-natural-agricultural-goods/8192)Class 31 is for raw and unprocessed agricultural products and grains that are not included in other classes. For instance, seaweed, raw cocoa beans, and flower bulbs all fall under this class. This class also covers living animals, natural plants and flowers, and animal feed.

[**Class 32: Beverages –**](https://tingenwilliams.com/2018/trademark-class-32-beverages/8196)All non-alcoholic beverages, including bottled water, are in this class. All beer and beer products (like malt beer) are also included in Class 32. Syrups and other flavorings can also fall under this class, while things like milk, coffee, cocoa, and tea bases all fall under Class 29 and Class 30.

[**Class 33: Alcoholic Beverages –**](https://tingenwilliams.com/2018/trademark-class-33-alcoholic-beverages/8209)Wine, liquor, cocktail ingredients, and pre-mixed alcoholic beverages are in Class 33.

[**Class 34: Tobacco Products –**](https://tingenwilliams.com/2018/trademark-class-34-tobacco-products/8244)This class covers all products that contain tobacco or are related to smoking tobacco, such as cigarettes, matches, and ashtrays.

**Services**

[**Class 35: Advertising and Business Management –**](https://tingenwilliams.com/2018/class-35-trademark/7808)Class 35 is the first of the service classes. This is an intentionally broad category that includes all services that involve advertising, human resources, office services, and consulting.

[**Class 36: Insurance and Financial Services –**](https://tingenwilliams.com/2018/trademark-class-36-insurance-and-financial-services/8726)This class covers insurance, real estate, banking, and investment services.

[**Class 37: Repair, Installation, Construction, and Laundry Services –**](https://tingenwilliams.com/2018/class-37-trademark-repair-installation-construction-and-laundry-services/8248)Not only does this broad category include construction and repair services for buildings and technology, but it also covers vehicle and airplane maintenance. Mining and drilling, as well as laundry services, are also in Class 37.

[**Class 38: Telecommunication Services –**](https://tingenwilliams.com/2018/trademark-class-38-telecommunication-services/8260)Any service that allows one person to talk to another person, one person to send a message to another person, or one person to send a visual or audio message to another is in trademark Class 38.

[**Class 39: Shipping and Travel Services –**](https://tingenwilliams.com/2018/trademark-class-39-shipping-travel-services/8342)The travel industry is in Class 39. Anything related to getting people and products from one place to another falls under this classification. In this way, this class also includes any service related to the packaging, transport, and storage of goods.

[**Class 40: Treatment of Materials Services –**](https://tingenwilliams.com/2018/trademark-class-40-treatment-of-materials-services/8405)This trademark class has to do with the treatment or transformation of materials. This “treatment” usually involves chemical or mechanical processing, but it can also include the transformation of organic products. Common examples include blacksmithing, cloth dyeing, food preservation, and woodworking.

[**Class 41: Education and Entertainment Services –**](https://tingenwilliams.com/2018/trademark-class-41-education-entertainment-services/8369)Class 41 covers all services related to education or entertainment, both of people and animals. Some examples are publishing services, media production, and fitness centers.

[**Class 42: Science and Technology Services –**](https://tingenwilliams.com/2018/class-42-trademark/8269)Scientific and technological services, design, and the development of computer hardware and software are in Class 42.

[**Class 43: Restaurant and Hotel Services –**](https://tingenwilliams.com/2018/class-43-trademark/8224)Class 43 includes all names and marks related to accommodation and food services. This includes bed and breakfast hotels, animal boarding, and most bars and restaurants.

[**Class 44: Healthcare, Beauty, and Agricultural Services –**](https://tingenwilliams.com/2018/trademark-class-44-healthcare-beauty-agricultural-services/8424)Class 44 covers services which increase the health and beauty of people, plants, and animals. Remember that this class is for services, not the production of goods. So, while dog grooming would fall under this class, dog shampoo would not.

[**Class 45: Personal, Social, and Security Services –**](https://tingenwilliams.com/2018/trademark-class-45-personal-social-security-services/8428)Essentially, any business that protects, or supervises, property or individuals goes into this class. This definition is intentionally broad, as Class 45 covers a wide range of services from firefighting to pet sitting and legal services. Escorts, matrimonial agencies, and funeral services also fall under this class.

selecting, and evaluating trade mark

It includes Trademark Search

* Performing a trademark [TM] search is a crucial step before adopting a trademark. Trademarks are sought to protect the identity of a business/company. When a TM search is conducted, the possibility of a trademark being similar to an existing trademark is checked. Individuals and companies who fail to perform a TM search early on often regret later when they find themselves embroiled in expensive legal disputes or in situations when they are compelled to change their trademark, both of which could have been easily avoided with a simple TM search.
* Today the market is flourished with brands and each brand owner wants to claim exclusive rights towards their brand name. A new and unique brand name not only gives you an exclusive right over your trademark/ brand name but it also gives an exclusive image in the mind of the customers.
* The process of trademark registration should be always initiated with the conduct of TM search. The conduct of [trademark search in India](https://www.intepat.com/ip-services/trademark-india/trademark-search-india/) gives you the details of the existence of any similar brand names/trademark which can be similar to your brand name/trademark or else if there is no record of any brand name/trademark similar to yours. Trademark Search can be done after you check with your [Class Details](http://ipindiaonline.gov.in/tmrpublicsearch/classfication_goods_service.htm) (The Trademark Act, 1999 provides [trademark classification](https://www.intepat.com/blog/trademark/india-trademark-classification/) which 45 classes for various goods and services).

###### Why conduct the TM search?

* -TM search provides information and details of any existing similar brand name/ trademark similar to yours.
* -It provides information of brand name/ trademark which can be phonetically similar to your brand name/trademark.
* -Trademark search provides you information of any well-known marks which are similar to your brand name/ trademark.
* -It provides you with a list of [prohibited marks](http://ipindiaonline.gov.in/tmrpublicsearch/prohibitedmarks.aspx) (marks which are prohibited from registration by a private individual) so that you can check whether your brand name/ trademark falls under the list of such prohibited marks.
* -If yo
* ur brand name has a logo or device, TM search gives you information and details of similar brand name/ trademark under the [Vienna Code Classification](https://www.intepat.com/blog/trademark/vienna-codes-in-trademark-search/) (International Classification of figurative elements) similar to your brand name/ trademark.
* Therefore, Trademark Search is very much important to know whether your brand name/trademark can be registrable under the Trademark Act. If any similar trademark exists in the trademark registry, then alter your mark or select a new name. In case your brand-name is acquired distinctiveness in the market, then you can go ahead to register your brand-name. It is always advisable to conduct a trademark search before filing a trademark application for registration of the trademark. TM search gives you a gist of registrability of your trademark under The Trademark Act, 1999.

**Trademark Search Process**

**Conducting a Trademark Search**

1. Describe the Products or Services being sold with the mark.
2. Identify Specific Terms for Your Product or Service using the online Acceptable Identification of Goods & Services Manual. ...
3. Determine International Class. ...
4. Determine Related Goods or Services, and their Classes. ...
5. Develop a Basic **Search** Strategy.

Sources of Trademark Search

-Trademark database

Search Websites

Online search

## Registration of Trademark:

As per section 18 (1) of the Trade mark Act, 1999, any person claiming to be the proprietor of a trademark used or proposed to be used by him may apply in writing in prescribed manner fro registration. The application must contain the name of the mark, goods and services, class in which goods and services fall, name and address of the applicant, period of use of the mark.  
  
Any Person means a Partnership firm, association of persons, a company, whether incorporated or not, a Trust, Central or State government.  
Steps for registration of trademark-  
1. Search for the name, device, logo, and mark intended to be applied as trademark.  
2. Apply for registration of trademark.  
3. Examination of application by the registry. Examination report issued by the registry raising objections under different sections of the Trademark Act, 1999.  
4. Replying to the official objections and if required, ask for hearing. Applicant needs to file evidence in support of the trademark application.  
5. Advertisement of trademark in official gazette/trademark journal for the purpose of opposition filed by the public within 4 months from the date of publication.  
6. If no opposition is received, a certificate of registration is issued in favour of applicant. The validity period of registration certificate is for ten years and after that th same can be renewed subject to the payment of renewal fees.

## Infringement of Trade Mark:

Infringement is a breach or violation of another's right.  
As per Black's Law Dictionary Infringement means an act that interferes with one of the exclusive rights of a patent, copyright and trademark owner. According to the Trademark Act, '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. Infringement of trademark means use of such a mark by a person other than the registered proprietor of the mark.  
  
**As per Trademark Act, a mark shall be deemed to be infringed mark if:**  
1. it is found copy of whole registered mark with a few additions and alterations,  
2. the infringed mark is used in the course of trade,  
3. the use of the infringed mark is printed or usual representation of the mark in advertisement. Any oral use of the trademark is not infringement.  
4. the mark used by the other person so nearly resembles the mark of the registered proprietor as is likely to deceive or cause confusion and in relation to goods in respect of which it is register

## An action for infringement of trademark:

(a) the plaintiff must be the registered owner of a trademark  
(b) the defendant must be use a mark deceptively similar to the plaintiff's mark  
(c) the use must be in relation to the goods in respect of which the plaintiff's mark is registered,  
(d) the use by the defendant must not be accidental but in the course of trade.