

# Module 2

## Part 1

### Trademarks

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### ❖ Introduction

- ▶ **Refer Textbook :** Dr. R. Radhakrishnan and Dr. S. Balasubramanian, “Intellectual Property Rights: Text and Cases”, Excel Books  
(Page No: 110-114)

### Types of trademarks



Product & Service



Geographical Indicators



Collective



Certification



LOGO

# TYPES OF TRADEMARKS



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**SELVAM & SELVAM**  
AN INTELLECTUAL PROPERTY LAW FIRM

## ❖ Guidelines for registration of Trademark

- 1) Trademark application can be filed for a mark which is in “USE” or “PROPOSED TO BE USED”. It is considered as an inseparable part of the goodwill of the business and is being considered as “Movable Property”
- 2) The Proprietor or Director or Managing Partner should authorize your attorney or agent under **Form TM-48** to appear before the Registrar on behalf of the firm/company. It would be on non-judicial stamp paper. If you authorize in **Form TM-48**, the attorney or agent is entitled to sign in all papers to be filed for registration except affidavit

### FORM TM - 48

The Trade Marks Act, 1999

#### Form Of Authorisation Of An Agent

(See Sec. 145; Rule 21) Attorney Code: \_\_\_\_\_

I, [Applicant Name] on behalf of [Firm Name if applicable] having address [Address] hereby authorize [Attorney / Agent Name], having his/her/their address at [Attorney / Agent Address] to act as my (or our) agent for registration of our trade mark(s). I hereby revoke all previous authorizations, if any, in respect of the above proceeding.

All communications relating to this application may be sent to the following address in India:

[Address]

[Firm Name]

Date: \_\_\_\_\_

[Applicant Name]

- 3) You have to furnish the FIRST DATE from which the mark is being continuously used. This you can verify from your first sales invoice
- 4) Furnish the name of proprietor or name of all partners in the firm and address of the firm or company. If it is a private/public limited company, please furnish the Memorandum and Articles of association
- 5) You have to furnish 20 labels of your mark, if such mark contains any lettering style or logo or device or label, it should be in small size. Otherwise, please furnish the “word” itself. Labels should be mounted upon the Form-TM-1 in triplicate and on ten additional representations

- 6) Furnish the specification of goods to which the mark is applicable
- 7) After filing, **computerized application number** will be allotted to your mark within **FORTY DAYS** from the date of filing application. Then you have to pass the following stages during the period of four to five years or to some extent

- 1) Examination stage
- 2) Enquiry stage by Registrar
- 3) Advertisement stage - TRADEMARKS JOURNAL
- 4) Opposition stage if any

- 8) While your case is pending, you can use your trademark as you like. 'User' is very important in trademarks. You will gain goodwill because of the continuous use of your mark. For better protection, you have to get registration of your trademark

- 6) Date of the **first use of your trademark, if the mark is already in use**. Otherwise application may be filed as '**proposed to be used**'

- i. This you can verify from your first invoice
- ii. If the product is medicinal preparation, then you can verify from the Drug Endorsement made for the particular product in your drug license

- 7) Authorization Form on **Form TM-48 in stamp paper** and then to be signed by the authorized signatory in case if the applicant wants to engage the services of a Trademark Attorney

- 8) If it is a private ltd company or a public limited company, please **furnish the Memorandum and Articles of Association**

## ❖ Requirements for filing trademark application

- 1) Name of the trading style or firm name company name
- 2) Name of the proprietor or the name of the partners
- 3) Address of the business place
- 4) 20 labels of your trademark logo in visiting card size or lettering style
- 5) Specification of goods to which the mark is applicable

## ❖ Trademark Infringement (Infringement of Trademark)

The essentials of infringement of trademark are

- The taking of any **essential feature of the mark** or taking the whole of the **mark** and then **making a few additions** and alterations would constitute infringement
- The infringing mark must be **used in the course of trade**, i.e. the proprietor of the mark is engaged
- The use of the infringing mark must be **printed or usual representation of the mark in advertisements, invoices or bills**. Any oral use of the **trademark is not an infringement**
- Any or all of the above acts would constitute infringement

## ❑ Cases of Infringement

- ▶ The plaintiff was selling cosmetic products under the registered trademark "Lakme". The defendant was using the trademark "Like-me" for the same class of products. The two words are also phonetically similar. There is every possibility of deception and confusion being caused in the minds of prospective buyers
- ▶ The plaintiffs were a reputed manufacturer of dental cream COLGATE, defendants used the mark COLLEGIATE, which is phonetically similar. It creates confusion in the minds of the customers. Hence the mark was restrained through injunction

### 1) Registration

- ▶ Marks may be registered with the United States Patent & Trademark Office ("PTO"), and similar agencies throughout the world
- ▶ Unregistered marks are protected at common law in the U.S. - marks need not be registered to be recognized and enforced
- ▶ Marks registered with the PTO have advantages over unregistered marks

## ❖ Protection of trademarks

- ▶ Trademark rights are protected through
  - 1) Registration
  - 2) Maintenance
  - 3) Watching
  - 4) Enforcement
- ▶ These precautions, and proper use, help preserve the ability of marks to indicate the source of a product or service to consumers

- ▶ These advantages are,
  - The ability to bring actions for trademark infringement in federal courts, as well as state courts
  - Eligibility for up to treble damages in a successful trademark infringement action
  - A presumption that the registered mark is valid
  - A presumption that the owner of the registration owns the registered mark
  - A presumption that the registrant has exclusive rights to use the mark in commerce
  - A presumption that the registered mark is not confusingly similar to other registered marks
  - The ability to file applications for registration in other countries, based upon the U.S. registration
  - The ability to prevent the importation of goods bearing infringing marks, by recording the registration with United States Customs

- ▶ International registrations provide similar advantages to trademark owners abroad
- ▶ US registrations are issued for an initial **term of 10 years**
- ▶ During the **fifth year of registration, an affidavit must be filed with the PTO**, attesting that the mark is still used in interstate commerce
- ▶ Failure to file the affidavit can result in cancellation of the registration
- ▶ International registrations are subject to similar, periodic, "proof of use" requirements
- ▶ **Some countries also require the payment of "taxes," or fees, to maintain registration rights**
- ▶ **If a registered mark is used and maintained properly, trademark registration can last "forever"**

- ▶ Marks generally lose their source-Identifying function through **abandonment**
- ▶ An abandoned mark is one which has been **"thrown away"**
- ▶ Marks also may be abandoned unintentionally, through improper use
- ▶ A mark may be abandoned "unintentionally," **when the trademark owner fails to use it properly, or fails to monitor its use by others**
- ▶ Thus, **marks should be used consistently, and distinctively**, to enhance their source-identifying function
- ▶ If an entity other than the trademark owner, uses a mark on its own products, in its own way, the mark's ability to function as an indicator of source is diminished

## 2) Maintenance

- ▶ The key to trademark maintenance lies in the **source identification function of marks** - remember, marks identify the source or origin of products and services
- ▶ If, and when, **a mark no longer performs this function, it no longer is a mark; it becomes a generic term**
- ▶ Generic terms designate a type of product or service, without calling to mind any specific manufacturer or provider
- ▶ **The terms, "escalator," "shredded wheat," "kerosene," "aspirin, yo yo, "zipper," and "trampoline," all began as marks**
- ▶ Through lack of proper use, and/or enforcement, these marks became generic
- ▶ Today, any company may use them to describe certain types of products

- ▶ For this reason, **all third-party uses of a mark should be licensed, and monitored carefully**
- ▶ Unlicensed uses, or unmonitored third-party licensing, can result in a finding that a mark has been abandoned
- ▶ **Trademark infringement also diminishes the source-identifying capabilities of marks**
- ▶ Our Guide to Proper Trademark Use is designed to minimize the possibility that marks will become **generic, or be abandoned, inadvertently, by their proprietors**



### 3) Watching

- ▶ Watching services notify trademark counsel of attempts to register conflicting marks, so that **timely oppositions to adverse applications may be filed**
- ▶ These services are particularly helpful in civil law countries, where trademark rights are secured through registration, rather than use
- ▶ Watching services are available in many countries, including the U.S
- ▶ Trademark **watches** can be customized to meet the needs of a particular business

- ▶ A **watch** may cover one country, several, or the entire computerized world
- ▶ However, watches are unavailable, or more limited, in countries without publicly-searchable, computerized, trademark databases
- ▶ **Watching services are not expensive**, given the level of information provided
- ▶ In any event, trademark watching is an **invaluable practice**, that can help a trademark owner protect the source-identifying function of its products or services

### 4) Enforcement

- ▶ Trademark enforcement consists of **pursuing adverse users**
- ▶ **An adverse user is one who is not authorized to use a mark**, but uses it anyway, or who is authorized to use the mark, but uses it improperly
- ▶ In most instances, adverse users may be stopped **without litigation**, by a friendly contact from the trademark owner
- ▶ Sometimes, a trademark owner will offer **to reimburse** the adverse user for the cost of changing marks, **to avoid the higher cost of trademark litigation**

- ▶ The **monetary remedies** available in trademark infringement actions are based on the actual damages suffered by a trademark owner
- ▶ These damages may include **profits lost to the infringing activity**, and may be trebled where the infringement is proved to have been intentional
- ▶ **Injunctive relief also is available**, to restrain the infringer from further unlawful activity
- ▶ **Litigation should be avoided whenever possible**