

Unit II

Trade mark meaning, purpose, Functions:- A trade mark & service mark is a word, name, symbol, logo etc used to identify the product from that of others. It indicates the source, quality and ownership of a product. For ex:- "Reebok" for shoes, "Starbucks" for restaurant services, Coca-cola, thumps for cold drinks etc. are few examples for brand names.

In addition to words, trade marks can also consist of slogans such as "your safety is our concern" by LIC, "Neighbours' envy owners' pride" by Onida TV etc. They also consist of distinctive sounds and designs also.

Trade marks perform two critical functions:

- (i) They provide assurance that goods are of certain quality and consistency.
- (ii) They also assist the consumers in making decisions about the purchase of goods.

For ex:- "NIKE" trademark represents ^{high} quality shoes. If it is not protected, there would be no incentive for the owners to produce high quality shoes and to expend money on consumer recognition process. If it is protected both the producer and

Consumer will be benefited. Consumers can get quality products and producers can reap the benefit for their investment and they need not fear that they will deceive them by ~~producing~~ using similar marks. (7)

The value of the business developed by providing quality products & services under a mark is called "goodwill". It is an asset to the business. It creates loyal customers. Today Coca-Cola is the most famous mark in the world. The following are the functions.

- (i) Trade marks help us to identify the products from that of competitors.
- (ii) They indicate that all goods and services offered under the mark come from same source or manufacturer.
- (iii) They indicate that all goods and services are of same quality.
- (iv) They serve as an advertising device.
- (v) They create loyal customers.
- (vi) They create good will to the business entity.

Types of marks:- There are four different types of marks. (1) Trade marks (2) Service marks (3) Certification marks (4) Collective marks.

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- ② Trademarks / Service marks:- Trademarks are used for tangible goods and Service marks are used for intangible services.
- ③ Certification mark:- It is a word, name, symbol, device or combination of these used by a person other than the owner to certify that goods & services are in accordance of set standards. Standards will be in terms of quality, material, mode of manufacture, and some other characteristics.

For Ex:- ISI seal of approval on kitchenware indicates that they are tested in laboratory and found to meet certain standards in regard to quality, safety, price, & size etc.

Certification marks are different from other marks. They do not indicate the origin of goods & services. They are not used by the owner. They will be used by third party to certify the goods. In the above example ISI is the third party. It won't produce goods. It merely certifies that the goods on which their mark is placed meet certain pre-established standards.

- ④ Collective marks:- It is one used by a collective membership e.g.s. Such as labour unions, professional society etc. It helps us to identify that the person displaying the mark is a member of the organization.

Ex: Indian Bar Association, Cricket Association

Acquisition of Trademark Rights: - In most countries trademark rights arise from registering mark with a govt. entity. But the law in the US is quite different. Trademark rights arise from adoption and use of a mark, not from registration. Though the mark is not registered the person using that mark will have enforceable rights over a subsequent user.

(i) The term "use" means not merely some ^{single} show use. That means it must & not be a token use, but it must be public use. There must be bonafide business transactions. Ex: - Sales within a company & to a personal friend or to a family member are insufficient to show "use". Soliciting and accepting orders is usually sufficient to show commercial use.

(ii) ^{Establishing} The date of first use is another critical bit because trademark rights is measured from this date. Ex: - If one party uses the mark on Sep 15th 2007 and another person uses the mark on Oct 17th 2007, the first person can ^(object) preclude the second person from using a similar mark.

(iii) "Inter state use" ^(Between states) is required for a mark to be registered. Intra state use (within the state)

is not sufficient for registration of a mark. The requirement of intent to use is satisfied if the goods & services are advertised and offered to citizens of more than one state.

Although the general rule is that trademark rights stem from use, the main disadvantage of this rule is that if the PTO rejects the application for registration for some reason, the owner will be at great loss because the mark is already in use and he might have invested lot of money and time in advertising to get consumer recognition.

To solve this problem the Lanham Act of 1946 was amended in 1988 (Trademark Law Revision Act). According to this revision, the person is allowed to file intent-to-use application to protect the mark. Even if it is rejected the owner will not incur much loss.

Just as one is required for acquiring rights in mark, continued use is required to maintain the right. If the mark is not used for 3 years, it will be assumed that the mark is abandoned and will be available for others.

Advantages of Registration: - Though it is not mandatory to register a trademark with PTO, but the registration

- offers special advantages and rights as follows:
- (1) Registration provides a notice to the public that he can ~~can~~ make use of the mark throughout the nation from the date of filing an application.
 - (2) He can sue others who use the same or ^{similar} marks.
 - (3) He has a right to use the trade mark continuously.
 - (4) He can enjoy a right under Paris Convention to secure a registration in other countries.
 - (5) He can bar imports with similar marks.
 - (6) Incontestable status of the registration after five years of continuous use.
 - (7) The owner has a right to use the registration symbol (®) with the mark.
 - (8) In case of infringement, he can cover all lost profits, damages etc.

Laws and Treaties Governing the Trademarks:-

I Lanham Act:- It is also called as United States Trademark Act. It came into force in 1946 and named after Fritz Garland Lanham, who introduced the legislation. The Act is mainly enforced for the purpose of

- (a) protecting Trademark rights.
- (b) prohibiting unfair competition.
- (c) protecting the customers from deception.

This Act has been amended so many times. But the latest and most significant amendment occurred in 1988. The two critical changes in the Act

are ① allowing the owner to apply for 'intent-to-use' a mark in future (Not based on actual use).

② Reducing the trademark protection from 20 yrs to 10 yrs.

The following are the key amendments to this Act.

① → North American Free Trade Agreement (NAFTA) :- It was enacted in 1994 as an agreement among Canada, Mexico, and the U.S. Its main aim is to exclude the registration of trademarks that are primarily geographically infringed.

② → Trade Related aspects of Intellectual Property Rights (TRIPS) :- This Treaty signed by the United States in 1994. ~~It~~ ① registration of a mark for wine & liquors ~~are~~ prohibited from using ~~being~~ inaccurate geographical terms. ~~For~~:- a new wine can not register a trademark for New York City if it is not produced originally from the New York City.

② It has increased the period of ~~at~~ nonuse of a mark from 2 to 3 years. After 3 yrs it will fall into public domain.

③ → Trademark Law Treaty Implementation Act (TLTIA) :- It came into force in 1999 to liberalize the requirements for trademark registration and maintenance. They are -

① To simplify the process by reducing the no. of specimens that are to be submitted from 3 to 1.

② It has provided a grace period of 6 months to file an application for renewal of a trademark.

① → Madrid Protocol: - It came into force in 2003. It allows the applicants to file a single international trademark application to secure protection in more than 70 ^{member} countries. It provides efficient and cost-effective protection on an international basis.

② → Federal Trade mark Dilution Act: - It came into force in 1995. It protects the dilution of famous marks by preventing the use of confusingly similar marks even on unrelated goods. Ex: The owner of NIKE ^{shoes} can prevent others from using the NIKE mark in connection with Bags, Belts etc.

③ → Anti Cyber Squatting Consumer Protection Act: - It came into force in 1999. It protects the public from acts of internet-cybersquatting (backlink, abusive registrations). Ex: Registration of www.Julianroberts.com by one with no affiliation with Julia Roberts.

State Registration: - Some trademarks will not qualify for federal registration because of its usage only in a particular state. Then the owner has to register under state law of that country. Every state will have its own trademark law to register and maintain its trademarks. Firms are available from State Secretary of that state. The rights enjoyed by the owner will be confined to only that state. It can not avoid others in other states from using the similar marks.

Categorised
Every document
getting

Categories of Trade marks: - (Trademarks introduction) +
Every organization strives to protect its marks by
getting it registered. However not all marks are protected
marks which are strong and unique are protected compared
to generic marks. Generally marks are categorized into
the following types.

- ① Generic Term ~~mark~~: - It is merely a common name. It is not
a mark at all. Such terms are not protectable. Ex: pen,
soap, rice etc. They are not protectable because even the
competitors want them to describe their goods. Thus "Tophan"
serves as a trademark but "noodles" is a generic name.
In some cases, marks that were once valid
have become generic through misuse. @ cellphone, escalator
and thermos etc. Thus owners of many well known
marks take great pains to ensure their ^{marks} ~~names~~ do not
become generic.

- ② Descriptive marks: - These marks tell something about
the product or service may be characteristic, quality,
ingredient, function, feature, use of a product or service.
Ex: The mark "Bed and Breakfast" is merely descriptive
and it requires secondary meaning to be eligible for
IPR protection.

Descriptive terms merely describe the goods or
service, rather than identify the source of a product, they
are not registrable, until the consumer links the mark with a
single source.
(Secondary meaning - Consumers must identify the mark with a single source)

system
used
abstract
word.

Secondary meaning ^{can be} has been acquired by years of continuous use of mark & through vigorous advertising, sales, consumer survey etc. The terms Best, Extra, Super are not registrable without proof of secondary meaning.

- ③ Suggestive mark: - They suggest something about the goods and services but does not describe them. They require some imagination on the part of the customer to associate it to a specific product. The law suit between "Orange Crush" Co. vs. "California Crushed Fruits Ltd" was upheld that the "Orange Crush" is suggestive of an orange flavoured juice and the exclusive mark of "Orange Crush Co".

A suggestive mark is registrable without the proof of secondary meaning. (Ex: Greyhound Bus, Playboy Magazine)

- ④ Arbitrary mark: - There are common words used for unfamiliar products. Ex: Apple for Computers, Camel of stationary, Blackberry for cellphones. These terms are found in a dictionary, but have no relevance when applied to the goods. Such marks are very strong and are easily registrable without any secondary meaning.

- ⑤ Fanciful marks / Coined marks: - Coined marks are those marks which are invented and have no dictionary meaning. Ex: Kodak, Pepsi, Honda etc. These are the strongest marks and are eligible for the greatest level of protection.

because it will be difficult for others to claim innocence for creating similar marks for similar products.

Types of protectable marks:-

- ① Slogans, Letters, Numbers:- A slogan constitutes a trademark if it is distinctive. Even letters and numbers can be registered as trademarks if they are distinctive. They should not describe anything about a product/service.

Have it your way - slogan (Restaurants)
NBC - letters (Broadcasting)
ZXS - Alphanumeric. (Food colours)

} Registrable

If the numbers and letters describe something about the product they are not registrable. Ex: - "VT 220" for computer spare parts was held merely descriptive and unregistrable because 'VT' means 'Video Terminal' and '220' were model. Secondary meaning is required for them.

- ② Logos and Symbols:- They are also protectable. Ex: - "Swoosh" mark for Nike's, Two hands protecting a lamp for LIC, Running cheetah for MRF tyres etc. Some symbols such as Smiley face, peace symbols etc. are not registrable. Logos that are purely ornamental & are mere background material are not protectable.

- ③ Names of performing Artists:- A mark that merely serves to identify an artist & entertainer is not registrable. If the owner of the mark controls the quality of goods/services

and the name of the artist used numerous times.
different records, the name may be registrable.
Bob Dylan for musical sound recordings.

Image
only if it is
protectible

④ Foreign Terms: - They are registrable as long as they comply with the requirements of the Lanham Act. Foreign words will be translated into ^{respective country languages} English and then examined by PTO before registering the mark. Ex: - The word 'Vino' could not be allowed ~~for~~ as trademark for wine company because its translation meant "wine" in English. The 'optique' was refused for eyeglasses because it is merely descriptive.

⑤ Shapes and Containers: - Non-Functional shapes and containers are also protectable. Ex: - The famous Coca-Cola bottle shape is registered because it is non-functional. It is not essential to the use or purpose of the product. But if the shape aids better functioning of a bottle such as more efficient lip or handle, it would not be registrable. Another ex: - A baby milk powder container shaped as ice-cream cone can be registered because the shape of the container did not promote better functioning of the product.)

⑥ Trade Dress: - The total image of a product, such as size, shape, color, packaging and graphics may be protected through a trademark registration. This total

image is called Trade Dress. It is registrable if and only if it is non-functional. Ex:- U.S. Supreme Court protected the overall image of trade dress of a Mexican restaurant chain from infringement by a competitor who used the same colors, seating configuration and decor.

- ⑦ Domain names: - They are also registrable, if they are used "as an identification of source of a product". Domain names are not registrable if they descriptive & serves as an address. They should not describe the activities that an organization provides or offers.

Ex:- www.~~ibm~~ ibm.com.
www.amazon.com.

- ⑧ Fragrances, sounds and moving images: - They are also protectable if they are distinctive and non-functional. Fragrances can not be registered as a trademark for perfumes or air fresheners. Likewise sounds and moving images can not be a trademark for musical sounds and videography products.

Ex: A floral fragrance - embroidery yarn and sewing thread
Three note chime - NBC etc.
(~~lion~~ lion roar, woodpecker laugh etc. registrable)

- ⑨ Colors: - Colors are registrable as long as they are distinctive and non-functional. Ex:- Qualitex Co. was allowed to protect its green-gold ironing boards pads on the basis that there is no competition for this colour because many

other colors are equally suitable for skin care. The pink color for surgical wound dressings was registrable because the color of the goods closely resembles Caucasian human skin and thus was functional. Same way, ^{pink} PEPTO-BISMOL stomach medicine unable to protect it because the pink color had a pleasing appearance to one with an upset stomach.

Not protectable matters:-

Not every word, design or slogan can function as a trademark. The following are the various aspects that are excluded from the trade protection.

① Generic Terms:- Generic terms are general terms which describe the entire class of goods. They can not be registered as they are weak terms. Ex: cars, bikes, etc. Trucks etc. Ex: - Truck can not be a trademark because there are varied no. of trucks manufactured by Ford, Swift, Toyota etc. It is a general term used to describe the medium of Transportation. If general terms are registered it creates monopoly over other companies.

② Functional Terms:- Trademark law is incapable of protecting the products whose designs are determined by the functions of the product. Ex: - For a guitar it is very difficult to get it registered because the structural design of it depends on functions of the guitar.

Descriptive Terms:- Descriptive marks such as product-description, geographical descriptions can not be protected. They can be registered only after the owner had proved the secondary meaning of that mark. Ex: Garment for bread made of oats and nuts is a descriptive mark not eligible for protection. Secondary meaning requires

(4) Disparaging & Falsely Suggestive marks:- The Lanham Act forbids registration of a mark that brings disrepute & falsely suggests an association with persons, institutions, beliefs, national symbols etc. Ex: "Westpoint" for guns was held to falsely suggest a connection with U.S. military Academy and was refused registration. Similarly registration for 'BAMA' for shoes and stockings was cancelled because (TTAB) found that it pointed out to the 'University of Alabama' and falsely suggests a connection with the university.

(5) Immoral & Scandalous matter:- Immoral or scandalous matter can not be registered. Ex:- A graphic depiction of a dog defecating that was used on clothing was refused registration as scandalous. It was also held to disparage Greyhound bus service as it is widely known for their services. In the same way the mark 'Wick-beater' for T-shirts on the basis that it was disparaging.

(6) Insignia:- National flags, coats of arms and other signs can not be protected.

- ⑦ Names and portraits of living persons: - A mark a name, portrait, & signature of a particular person can not be used without his & her written consent.
- ⑧ Deceptive matter: - Deceptive marks can not be registered because they misrepresent the material, content or origin of the product i.e. geographically deceptive.
Ex: - Silkene was considered as deceptive if it is used for cotton & woolen clothes or not made of Silk. In the same way Cedar Ridge was held deceptive for hard boards when it is not made up of cedar.
- ⑨ True Surnames: - A mark that is primarily a surname can not be registered without proof of secondary meaning. True names such as "Smith" & "Higgins" can not be registered. If the Surname is combined with additional matter, such as other words & a design it may be registered. Ex: - "Hutchinson Technology" was registered for computer components.
- ⑩ Statutorily protected marks: - Certain marks are protected by Central Statute from use. Ex: "Smoking Bear" marks used by various Veteran Organizations. The Red Cross logo and the Olympic rings and abbreviated words are ~~not~~ protected by Central Govt. There are nearly 70 of these special statutes.

Selection and Evaluation of marks Unit II

Selection:- Selection of a trade mark is very important and crucial task because it affects the brand image of the company. Trade mark is an asset to the orgn. Not every word, slogan, & design can be protected as a trademark & service mark. We need to select an effective and unique mark which helps in consumer recognition process. It leads to customer loyalty.

Selecting a mark that elicits poor customer response & which is already used by some other firms may lead firm into legal and financial problems.

~~Before~~ Selecting a mark can be done in a variety of ways. Some companies hold contests and encourage employees to create new marks. Some companies conduct surveys to create marks. There are name, design creation softwares which help us to create marks.

once the mark is selected it must be screened and evaluated for use and registrability. If it is rejected a great deal of time, money, effort will be wasted and sometimes the owner may land in legal problems.

II Review the proposed mark:- Once a mark is selected it must be carefully scrutinized to ensure that it

will be protected under Lanham Act: Review
Considerations include -

- (i) whether the mark contains any scandalous material
 - (ii) whether the consent from a living person is required
 - (iii) whether the mark is generic
 - (iv) whether the mark is functional & deceptive in nature
 - (v) if the mark includes foreign terms, these should be translated to ensure that it is not scandalous.
- Ex:- 'NOVO' (car) word sounds "No Go" in Spanish
This may Confuse them.

Many Law firms specialised in trademark use a questionnaire & data sheet to gather info from their clients to aid in the registrability of mark.

After evaluating and selecting a mark a Trademark Search should be conducted to ensure that the proposed mark is not confusingly similar to a mark. If there are numerous marks including words similar to the proposed mark for the same & related goods, the field is said to be crowded & weak. Weak marks will have a narrow scope.

III TM Search: There are a variety of sources that can be reviewed to locate conflicting marks. Journals, business directories, Telephone books, etc. provide necessary information. Online search is the most effective method of searching. Lexis and Westlaw

the Computer assisted legal Research System offer access to vast databases that may point out conflicts. One of the best-known databases is 'Trademark Scan' available through 'Westlaw'. Most of the data bases are also offered on CD-ROM, allowing IP practitioners to purchase discs and conduct their own searches. These discs are updated periodically.

Conducting Trade-mark Search - A two step process.

- (a) Preliminary Search / Knock-out Search: - The main purpose of this search is to eliminate identical and nearly identical marks. If the results of the preliminary or knock out search indicate a mark may be available a comprehensive search of other records can be conducted.

Following are the some sources commonly used for conducting a preliminary search.

- (i) Trademark Scan: - It is an online database owned by Thomson Comp. mark a renowned trademark search firm which provides information on all active registered trademarks and Service marks. It is used as a quick screening tool to determine the availability of a new mark.
- (ii) Dialog: - It is another database offered by the publisher Thomson and Thomson. Its database includes trademarks from the US and other foreign countries.

It offers free online training and practice.

(iii) Sageis - It is an entire suite of services provided by Thomson business that allows online worldwide trademark search. // Apart from these, Trademark Lexis, Westlaw are the computer assisted search systems offer access to vast trademark databases.

Many law firms subscribe these services so that they can perform an initial screening search in house and the results can be communicated to the client along with recommendations. Knock out search is sufficient if the mark is intended to be used for a short time.

Once a mark is displayed on your computer screen, you will be given four separate options to obtain additional information.

→ TARR :- The Trademark Application and Registration Retrieval System provides additional information about an application, & registration, information on current status etc.

→ Assignment status :- If the mark has been assigned, you will be given the names of its assignor, assignee & date.

→ Trademark Document Retrieval (TDR) :- It shows actual images of files such as drawing of the mark, images of specimens of the mark, notice of publication, certificate of reg'n etc.

The Second Step in Search process is Comprehensive Search.
Step Two - Comprehensive Search: - The final step is to perform a Comprehensive / full search by using services of professional Trade mark Search firms. These firms review the records of the USPTO for existing registrations and pending applications, Common Law search of various journals, directories, press releases etc to locate un-registered names and marks. This is called full search.

(These searches for marks are usually expensive)
A client interested in protecting his or her mark in foreign countries should conduct a search of the records of each country in which an application will be filed. The International Trade Mark Association offers direct link to databases of member countries.

Evaluating Trade mark Search Reports: -

Once the results of the search have been obtained, they must be evaluated so that the fundamental question, whether the mark is available for use and registration or not, can be answered. This analysis takes into account the overall commercial impression of the marks, their similarity in regard to sight, sound, meaning, strength and weakness of the mark etc.

Assume a client wished to introduce a new line of children's books called "Buddy Bear". The existence of "Billy Bear" for toys & stuffed animals

may present a conflict. Consumers think that "Buddy Bear" books are somehow connected to "Billy Bear". There are numerous works like "Bear" "Boomer Bear" etc. indicates that the word including "Bear" for toys and related goods is a weak mark. (Ex: Microsoft, Microslat)

For ease of evaluation, firms use the "Trade mark Evaluation Form". Most of the sections in this form are self explanatory and simple. These sections will be as follows.

- (a) Client Company details:- It consists of company name, address, phone nos., list of marks currently being used etc.
- (b) Product details:- It contains the details the product/service with which the client firm deals with. Details include common name of the product, its classification design of the product etc.
- (c) Use of mark:- Is the mark currently used by the client, proposed date of first use, in which state it is used etc. will be evaluated.
- (d) Proposed mark:- If a new mark is selected, what is the meaning of the mark, how it has been selected, its historical significance will be evaluated.
- (e) Search Results:- It will be a formal written

report to the client. It is called an "availability" & "clearance" report.

This section includes, how a knock out search and Comprehensive Search carried out, what are the tools and techniques, websites are used for search etc. This form is a crucial document - while selecting a mark and is generally a first document in the firm's trademark file for filing registration. It plays a key role while filing an infringement law suite.

Trademark Registration Process

Once a mark has been selected and evaluated for use and registrability an application for registration of the mark should be prepared and it may be registered under the federal law or state law depending upon the commercial use of the mark. The registration process takes more than one year. The registration process will be as follows.

I Application process - ^{(a) preparing application :-} For registration the owner of the mark should prepare an application for reg:n. The application ~~should~~ can be in a written form or in electronic form and it must be in English. It should contain the following information.

- (i) Request for registration
- (ii) Name of the applicant and proof of identity and address proof.
- (iii) Goods and services offered under the mark.
- (iv) Drawing of the mark.
- (v) Declaration by the applicant or agent or attorney.
- (vi) Specimens
- (vii) Filing fee etc.

The applicant should mention whether the application is based on actual use of the mark or intent-to-use the mark. He should also mention whether he wants to register in the principal register or Supplement Register.

Filing the application: - After signing the application the applicant should file the application with PTO within one year. The application must be accompanied by a filing fee for each class of goods & services. If the mark is to be used for more than one class of goods, additional fee must be paid for each additional class as prescribed by PTO.

The applicant must handover the application by hand & by mail & electronically. Applicant should enclose all the documents that are required for registration. Once the PTO receives the application it will send the official filing receipt to the applicants after verifying the necessary documents. It will assign official filing number which is imp. because PTO responds ~~to~~ to all inquiries basing on this filing no. only. Filing date of the application is also critical because it initiates various time limits to exercise the rights.

(2) Examination process by PTO: - After receiving the application, if the application does not meet the minimum requirement then it is returned along with the fees to the applicant. If it is accepted a receipt of application will be given.

After issuing the receipt the PTO attorney examines the application to determine whether

the proposed mark is Confusingly Similar
mark or Scandalous & deceptive & descriptive
If the mark is unregistrable the examiner
a letter of explanation stating the reasons for
The applicant should respond to the defects within 6
months. If not application will be abandoned by the
PTO.

If the applicant's response is not sufficient to
overcome the defects by the examiner, then the applicant
can appeal to the Trade mark Trial and Appeal Board.
(TTAB).

If there are no defects PTO will approve the
application for publication in the Official Gazette:

- ③ publication in the Official Gazette: - If the applicant
responds within the time to the office action, the
examining attorney will approve the mark for publication
in the Official Gazette. It is a weekly publication that
lists all the marks seeking registration. It permits
the third an opportunity to review the marks
and oppose its registration if they are similar
to other marks. A notice of opposition must be
filed with the TTAB within 30 days

- ④ Opposition proceedings: - It is an opportunity for
someone to challenge the reg'n of the proposed mark,
based on the premise that its reg'n will cause damage
to existing mark.

Intent to use application and Statement of Use:

After publishing the mark if there are no opposers for the intent-to-use application, the PTO will issue a 'notice of allowance', granting six months time within which to commence use of the mark. After that a Statement and Specimen verifying such use and the date of first use must be submitted to the PTO. PTO may extend another 6 months time on request. If the applicant again fails to submit the Statement, then PTO will abandon the mark considering that the delay was intentional.

The applicant must file an amendment to its original application in case if he is using the mark during the application process. Such an amendment is called "Amendment to Allege use".

- ⑥ Abandonment and Revival of Application: - PTO will abandon the application if there is no timely response from the applicant to the office action & notice of allowance. In case of abandonment PTO will issue a formal notice of abandonment to the applicant and also allows the applicant to revive the abandonment application by filing a petition with 'TTAB' within 2 months, stating the reasons for delay in giving response to office action.

If the application get abandoned it can be registered with PTO.

- (7) Registration:- If no opposition is filed then the mark will be registered and certificate of registration will be issue within 12-18 months of time for use - based application and for ITU application it is more than 42 months. The term of protection will be 10 yrs and it can be renewed for 10 more yrs. The certificate of registration should contain all the information about the mark, owner details, registration number, date of registration. Once the certificate is issued, the owner can use the Regn symbol along with the mark.

Elements of Trademark application

I Identification of the mark:- The first step in the application process is identification of the mark. The mark may be a word, a symbol, a logo etc.

(a) Stylized words:- Some companies use stylized words as their marks. Ex:- 'Coca-Cola' company uses cursive style as its trademark. Some Co's use capital letters, different font-sizes etc.

(b) Design marks:- Some Co's along with words, they also use some designs or graphics for easy recognition.

Trademark infringement and remedies:

Infringement means if any person uses the trademark of others without their consent which is likely to cause confusion in the market is called infringement. In such cases, the owner may bring civil action in Federal Court against the infringer. The following factors are considered in determining whether trademark infringement exists or not.

1. The similarity of the marks in regard to appearance, sounds, connotations, commercial impressions etc.
2. The similarity of the goods or services offered under the marks.
3. The similarity of the channels of distribution in which the goods & services are offered.
4. The strength or fame of the prior mark.
5. Whether there has been any actual confusion or not.
6. The no. & nature of similar marks on similar goods.
7. The conditions under which sales are made.

8. The length of time during which the ^{4.76} ^{registered} ⁵ ⁷ has been concurrent use with no confusion.

9. The example of infringement which is ^{con-} similar is ~~TRU~~ TRU COOL for synthetic coolants. It was held that it is likely to be confused with TUR COOL for cutting oils. It is just rearrangement of alphabets. And the court upheld that TUR COOL is an infringer mark.

Defences to infringement:

In case of infringement ^{suit} the defendant will have a variety of defences to protect himself. 9

1. The defendant may argue that the owner has abandoned the mark without using it for three consecutive years.
2. The defendant may argue that the mark has become generic which can be used by common public.
3. The defendant may raise that the mark is merely descriptive and it has not acquired secondary meaning.

4. He may argue that the owner procured the registration in a fraudulent way.
5. The defendant may assert that the owner has unclean hands and has committed wrongful usage of the mark. He may assert laches that means the owner has delayed filing a case for a long period.
6. He may also argue that the mark is functional and needed by him.
7. He may allege that the use is a mere parody (joke).

Remedies for infringement:

1. Injunction: The court may order injunction preventing the defendant from further use of the mark.
2. Monitory damages: The court may order to compensate the owner for the damages he has suffered. The damages may be financial or reputational (goodwill of the firm).

3. Seizure & destruction of the goods
may order to seize the goods or total
of the articles and related materials.

4. Reimbursement of costs: The court will recover
all expenses including attorney fees from the
defendant and reimburse to the owner.

Trademark policing and maintenance:

To ensure that marks are used properly,
to avoid genericide and abandonment trademark
owners should initiate active policing and
maintenance procedures to avoid infringement of
their marks. The classic trademark rule is that
"police it or lose it". The following are the
steps to be taken to protect the trademarks
from infringement.

1. Critical dates must be docketed to ensure marks,
applications, registrations are ^{not} abandoned and
then used by others.

2. Owners must subscribe to watching or tracking
services to monitor the marks from illegal
copying & infringement. The professional service

3. One should review a number of resources like official gazette, state trademark registers internet domain names, common law sources etc.

3. Company employees should be asked to be alert in the market place. Trade publications, business press, marketing materials of competitors should be monitored carefully to ensure that the marks used by them are not confusingly similar with the companies' marks.

4. Trademark owners must review internet uses to locate infringing marks or misuses of marks. Internet policing is double edged sword. Few simple keywords may reveal numerous uses, the owner runs the risk that ignoring infringers may lead to loss of the mark.

These are the steps to be taken while policing the trademarks.

Genericide:

If a trademark becomes a general term due to continuous misuse by the customer, we call it as Genericide (General term). When the consumers begin to call the product or service offered under the mark by the mark itself, it is called Genericide. For eg. Aspirin, escalator, thermos etc. are once trademarks became generic. Once the mark becomes generic, it can be used by anyone.

For eg. Xerox Corporation has always been worried that its famous mark "Xerox" became generic due to continuous use. Customers will be saying "I'm going to Xerox of this document." Instead of saying "I'm going to take photocopy." Xerox corporation has spent a lot of amount in attempting to ensure consumers use the mark correctly by consistently saying in advertisements "Xerox brand copiers."

- Similarly, the roller blade is a registered trademark for inline skates. Now it is in danger of becoming generic due to consumer misuse saying "Let us go roller blading"

Such use of trademarks will lead to loss of trademark rights. In some cases, that become generic & victims of their own success coz consumers will become so familiar with the companies' goods & services and use the trademark as the name of the product. Once the mark becomes generic, it is difficult for the owner to revive the mark again.