

TRADEMARK TM

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TRADEMARK

- A trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.
- Trademarks are protected by intellectual property rights.



DEFINITION

- A trademark is an easily recognizable symbol, phrase, or word that denotes a specific product. It legally differentiates a product or service from all others of its kind and recognizes the source company's ownership of the brand.
- Trademarks may or may not be registered and are denoted by the ® and ™ symbols respectively.
- Although trademarks do not expire, the owner must make regular use of it in order to receive the protections associated with them.

UNDERSTANDING TRADEMARKS

- Trademarks not only help distinguish products within the legal and business systems—but just as significantly—with consumers.
- They are used to identify and protect words and design elements that identify the source, owner, or developer of a product or service.
- They can be corporate logos, slogans, bands, or the brand name of a product. Similar to a trademark, a service mark 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.
- Using a trademark prevents others from using a company or individual's products or services without their permission. They also prohibit any marks that have a likelihood of confusion with an existing one. This means that a business cannot use a symbol or brand name if it looks or sounds similar, or has a similar meaning to one that's already on the books—especially if the products or services are related.
- For instance, a soft drink company can't legally use a symbol that looks like that of Coca-Cola and it can't use a name that sounds like Coke.



TRADEMARKS IN THE USA

- Trademarks in the United States are registered through the United States Patent and Trademark Office (USPTO) and are identified with the ® symbol.
- But trademarks don't have to be registered in order to give the company or individual protection rights. Unregistered trademarks can be recognized with the ™ symbol. By using this symbol, the trademark user indicates they are using common law to protect their interests

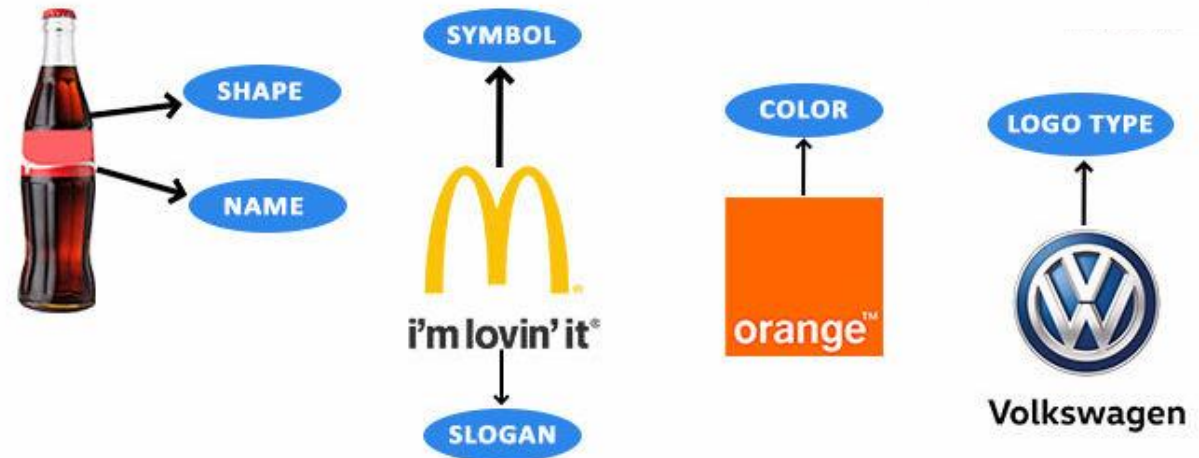


TYPES OF TRADEMARKS

- Trademark is basically a logo, characters and numerals or combination of both. It is used by a company to claim ownership of a design or term that represents the products and services of the company. Various types of trademarks can be registered under a company. In spite of the diversity of Trademarks, they serve the same purpose – to help the customers to identify particular goods or services offered by a specific manufacturer or service provider. We will discuss the various types of trademark in this article.

PRODUCT MARK

- Product mark is used on a good or a product instead of a service.
- This type of trademark indicates the origin of a particular product.
- A product mark helps to maintain the reputation of a business.
- The trademark applications that are filed under trademark class 1-34 can be termed as product mark since they represent goods or product.



TYPES OF TRADEMARK

SERVICE MARK

- Service mark is quite similar to product mark but a service mark basically represents a service instead of a product. A service mark distinguishes its owners from the owners of other services.
- The trademark applications that are filed under the trademark class 35-45 can be called a service mark since they represent services.
- McDonald's: A service mark because it's a restaurant and food service business
- Nike: A trademark because it's a business that sells footwear and garments
- UPS: A business that provides both products and services, so it can be both a trademark and a service mark
- AT&T: A service mark for telephone services
- Walmart: A service mark for retail stores
- CPA: A collective mark used by members of the Society of Certified Public Accountants
- Camel: An arbitrary trademark used in connection with cigarettes
- EXXON/MOBIL: A fanciful trademark that was coined by the company and doesn't exist anywhere else



COLLECTIVE MARK

- Collective marks are registered to let the public know about specific distinct features of products or services that represent a collective.
- A group of people can use the collective mark to make sure they are collectively protecting goods and services.
- The owner of the mark can be an association or a public institution or a Section 8 Company.
- In case of a collective mark, the regulator who owns the mark fixes the standards of products.
- Others, who are associated with the collective, are responsible to abide by certain standards in order to use the mark in the course of business.
- The Chartered Accountant designation is an example of the commonly known collective mark in India.



CERTIFICATION MARK

- The certification mark is a sign to denote the origin of a product, material, quality or other particular details issued by the proprietor.
- A certification mark serves to fulfill the purpose of bringing out the standard of the products and guarantee the product to the customers.
- A certification mark indicates that the product has undergone standard tests.
- It ensures the quality of the product and uplifts its reputation amongst the customers.
- Certification marks can be found on packaged foods, toys and electronic items.



Mark
registration Ser.
No. 74,650,913
for candy



Mark
registration
Ser. No.
72,464,602
for solid
chocolate,
wrapped



Mark
registration
78,578,036
for candy



Photo of Hershey's Kisses with broken tips

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Trademark registration images for Hershey's Kisses
non-traditional trademark registrations for shapes, and
photo of Kisses with broken tips

SHAPE MARK

- Shape marks exclusively protect the shape of a product in order to help the customers relate to a specific manufacturer.
- It makes the product preferable for the customers who become eager to buy it.
- Once a product is recognized with an identifiable shape, the shape of that particular product can be registered. The Coca Cola bottle and Fanta bottle have a distinctive shapes which can be related to the brand. They are examples of Shape Mark.

PATTERN MARK

- Pattern marks are basically products with specific and designed patterns that are the distinguishing factor of the product. A pattern must be unique and prove it to be registered as a trademark; otherwise, it gets rejected since does not serve any purpose.
- Examples of pattern marks include the iconic Louis Vuitton checkerboard pattern or the Tiffany & Co.



SOUND MARK

- These types of marks are generally sounds that are associated with a product or service of a certain seller or service provider.
- If people can identify a product or service and their provider after hearing the sound, It means the mark is eligible to be registered.
- These sound logos are also called as an audio mnemonic and usually, it appears at the beginning of the end of a commercial or advertisement. The tune of IPL is one of the most popular sound marks in India.

TRADEMARKS IN INDIA

- The Indian Trademarks Act, of 1999 under Section 2(zb) defines a trademark as a kind of intellectual property that marks and differentiates products or services from others via the use of a recognized symbol, design, or expression.
- A trademark can be owned by any individual, corporation, or legal body.
- Anyone who plans to use or proposes to utilize a brand name commercially must file a trademark and pursue it for its registration to stop others from using the same or similar brands name for their product or services.

TYPES OF TRADEMARKS IN INDIA

- Trademarks are often used to identify the source, owner, or developer of a product or service. There are several types of trademarks a business can choose from, including logos, names, taglines, and product brands. However, the use of any mark may be mistaken for an existing one is prohibited. Soft drink firms, for example, are not permitted to use Coca-Cola-like logos or names.



WORD MARKS

- It includes one or more words, letters, numerals or anything written in standard character like brand name , slogan , tagline.
- In simple words where one wants to register only the letters, words or combination of words or numerals without any artistic and pictorial representation can register the trade under word mark category.
- Flexibility is the biggest benefit that the word mark provides as after the registration of the mark; it can be used in any design, style and font. Some good examples of word marks are Microsoft, Tata, KFC, IBM

DEVICE MARKS

- It includes any label, sticker, monogram, logo or any geometrical figure with or without word element in it.
- Device marks may also include colors but if the registration is made along with colors then the same combination of colors have to be used to claim trademark protection.
- Device mark is eye-catching and attractive which makes it easy for the public to remember.
- When unique devices are used it helps in recognition of the business because people may not remember the name but they can easily remember the logo.
- Apple logo is a good example of device mark



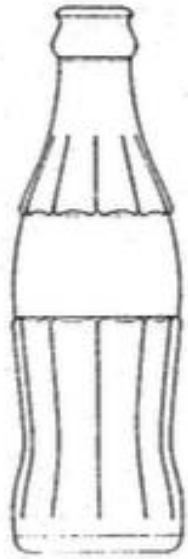
SOUND MARK

- Sound marks are features acquired by hearing and characterized by their unique sound.
- It is a trademark where sound is used to perform the trademark function of uniquely distinguishing the commercial source of products or goods and services.
- According to the new provision the sound submitted should be in MP3 format and it should not exceed 30 seconds of length and visual representation of the sound notations.
- YAHOO was the first company to register a sound trademark across the globe. In India ICICI bank was the first to register sound as a trademark.
- Some of the registered sound marks in India are:
 - Yahoo – (Human voice yodelling Yahoo)
 - National Stock Exchange – (Theme song)
 - ICICI Bank – (Corporate jingle – Dhin Chik Dhin Chik)
 - Britannia Industries (Four note bell sound)
 - Cisco – (Tune heard on logging in to the conferencing service Web Ex)
 - Edgar Rice Burroughs – (Tarzan Yell by its toy action figure)
 - Nokia – (Guitar notes on switching on the device)

THREE-DIMENSIONAL TRADEMARK

- It includes both shapes of goods or packaging.
- It is a non-conventional trademark and to get its registered the shape of goods or its packaging must be distinctively different from the competitors in the market and is enough for the public to recognise the origin of the goods , without the aid of other word marks on it.
- In simple words it must be able to perform the function of the trademark.
- In order to secure protection of a 3D mark, the brand owner must satisfy the test of distinctiveness as laid down under Section 9 of the Act. Thus, the onus is on the brand owner to prove that the shape or 3D mark sought for protection has acquired distinctiveness and that the public and trade associate the mark as originating from the brand owner and none else. There are certain types of 3D marks which cannot be granted protection, such as the marks which:
 - (i) result from the nature of the product;
 - (ii) are necessary to obtain a technical result; or
 - (iii) give substantial value to the goods.





Mark
registration
Ser. No.
73088384



Mark
registration
Ser. No.
74611506



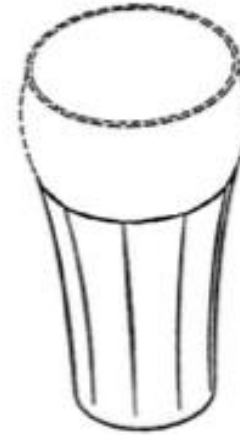
Mark
registration
Ser. No.
74611507



Mark
registration
Ser. No.
77878543



Mark
registration
Ser. No.
77818735



Mark
registration
Ser. No.
75796806

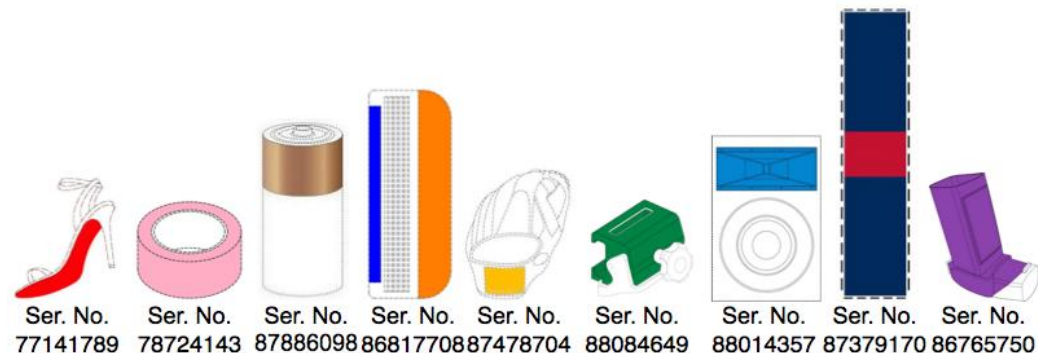


Mark
registration
Ser. No.
85226870

Images from Coca-Cola's registrations for non-traditional trademarks: shapes of bottles and more

COLOR TRADEMARK

- Trademark act permits registration of combination of colors to represent the goods and services. When the distinctiveness is claimed in the combination of colors with or without device it is called color mark.
- In trademark law the color could be considered to acquire distinctiveness when the purchasing public recognises the product or brand by particular combination of color only.
- In this case the brand is the color. According to section 10 of the Trademark Act, 1999, Colour trademark can be of a single color or combination of colors, but Section 2(1)(m) of the Trademarks Act, 1999 requires a mark to be a 'combination of colours' shows the intention of the legislature to not allow single-colour trademarks.
- Thus it is suggestible to file for a combination of colours as a trademark but where a trade mark is registered without limitation of color, it shall be deemed to be registered for all colors.



SMELL MARKS

- When the smell is distinctive and cannot be mistaken for another product, a smell mark can be recognized. Consider perfumes.
- Other non-traditional trademark registrations for scent marks include:
 - Ser. No. 86467988, for “retail store services featuring jewelry...” where the mark “consists of the scent of chocolate” (currently on the Supplemental Register) – because while you can’t register the smell of chocolate for selling chocolate, you may be able to register it for use with other goods or services.
 - Ser. No. 86265443, for “shoes, sandals, flip flops, and ... flip flop bags” where the mark “consists of the scent of bubble gum” (currently on the Supplemental Register).
 - three marks, registered to an individual in Texas, for lubricants and motor fuels (variously), where the marks are described as a “grape scent” for Ser. No. 75360104; as a “strawberry scent” for Ser. No. 75360102; and as a “cherry scent” for Ser. No. 74720993.



SHAPE OF GOODS

- Trademarks can be registered in shape or goods if they have a distinctive shape.
- But it cannot be registered if the
 - -Shape of goods which results from the nature of goods themselves;
 - Shape of goods which is necessary to obtain a technical result; Shape of goods, which gives substantial value to the goods.
- Shape of goods are also non conventional trademarks.



(1969 - 1979)



(1980 - 1992)



(1993 - 2015)



(from 2016)



1903-1931

Traditional script "Trade-Mark Registered" in tail



1930-1941

Traditional script "Trade-Mark Reg. U.S. Pat. Off." in tail



1941-1962

Traditional script "Reg. U.S. Pat. Off." under script



Trade-mark ®

1950-Present

Traditional script "Trade Mark ®" under script

TRADEMARK INFRINGEMENT

- Trademark infringement is defined as the unauthorized use of a trademark or service mark.
- This use can be in connection with goods or services and may lead to confusion, deception, or a misunderstanding about the actual company a product or service came from.
- Trademark owners can take legal action if they believe their marks are being infringed. If infringement of a trademark is proven, a court order can prevent a defendant from using the mark, and the owner may be awarded monetary relief.
- **In India**, the penalty for trademark infringement in a criminal proceeding can include:
 - Imprisonment for a period of at least six months and up to three years
 - A fine of at least Rs 50,000 and up to Rs 2 lakh

STARBUCKS COFFEE V. SARDARBUKSH COFFEE

- Facts:
- The Plaintiff, Starbucks, registered their word mark 'STARBUCKS' and corresponding logo as a trademark in the year 2001 in India. The Defendants started their company in 2015 with the name 'Sardarbuksh Coffee & Co'. Sardarbuksh's logo comprised the face of a turban commander with wavy lines on the sides surrounded by a circular black band.
- In 2017, the Plaintiff asked the Defendants to change this logo through a letter of demand. In response to this, the Defendant only changed the colour scheme to black and yellow and resumed business. In May 2018, the Defendant commenced operations under the same name. The goods and services provided by the Defendant and the Plaintiff are similar. The entire previous sequence of events culminated in the plaintiff filing a suit against Sardarbuksh in the Hon'ble High Court of Delhi. The Plaintiffs filed a suit against the defendants for infringing their trademark by having a deceptively similar mark.
- Issues:
- Whether the Defendant's mark is deceptively similar to that of the Plaintiff's?
- Laws:
- Section 2(1)(h) of Section 11 of the Trademarks Act, 1999.



RULING

- **Analysis**
- After referring to judgements in the past, the Court set forth various tests to prove deceptive similarity, like the test of likelihood and confusion, goodwill and so on.
- The Court gave the decision in the plaintiff's favour. It ordered the defendants to change the name of the business from "Sardarbuksh Coffee & Co." to "Sardarji-Bakhsh Coffee & Co.".
- **Conclusion:**
- In this case, the understanding and the essence of a trademark was reiterated, that it is a unique factor of identification and distinguishment to a consumer and the business in question. The most significant characteristic of a trademark is the goodwill it garners over its period of usage. 'Starbucks Coffee v. Sardarbuksh Coffee' laid down essential guidelines as to when it can be claimed that one trademark is deceptively similar to another and the effect that it can have on the business whose trademark has been infringed.

APPLICATION FOR TRADEMARK IN INDIA

- To apply for a trademark in India, you can:
- Fill out Form TM-A.
- Submit the form online or offline.
- Ensure that the proposed trademark meets all the eligibility criteria for registration. It must be:
- Distinctive
- Non-generic
- Not similar or identical to any existing trademark
- Identify which class you belong to. There are 45 classes of goods and services under which the trademark can be registered.
- Submit the required documents:
- Incorporation certificate
- Partnership deed
- PAN card of the authorized signatory
- Aadhaar card of the authorized signatory
- Signed Form-48
- Logo
- MSME certificate
- You can file the application online by signing up on the ipindia website. You can also file the application at one of the five Trademark Registrar Offices.



CONCLUSION

- In nutshell , Consumer recognition and acquired distinctiveness becomes an important factor in granting a non-conventional trademark like Shape of goods, 3-dimensional trademark, sound mark, smell mark. In granting registration of the non conventional trademark the Registry needs to evaluate the balance of convenience of the Applicant of the mark with the other traders who may be using elements of such trademarks in good faith.
- Choosing the best type of trademark for your organization demands extensive research and professional advice. Furthermore, knowing the many ways your brand's identity is protected may provide you with additional ideas if you are still in the creative process.
- Knowing the parameters and extent of protection included in each type trademark is essential for companies both new and established, in maximizing their Intellectual Property portfolio.