

UNIT-2

TRADE MARKS

A trademark is a visual symbol that distinguishes the goods or services of one enterprise from those of the competitors. Trademarks are at the centre of global business today. They are the major source of product differentiation and non-price competition in a modern, market driven economy. Consumers come to associate certain value in terms of performance, durability, price, after-sales service etc. in the goods sold under specific brands, which may be among the greatest assets of the enterprise. In the language of the law, brand names are known as trademarks. Several products, of the same category or of different categories, can be marketed under one brand name.

In 1940 the then British Government of India passed the Trademarks Act for uniform and systematic registration of trademarks in India, which came into force on June 1, 1942. The Trade and Merchandise Marks Act, 1958, which came into effect from November 25, 1959, replaced it. It became necessary to effect changes in the trademark law as India joined WTO as an original member in 1995 and it was obligatory to bring the Indian law in consonance with TRIPS. Hence new Trademark Act, 1999, repealed the old Act.

The Act of 1999 makes important departures from the Act of 1958 in two important respects:

- Shape of goods is recognised as a trademark; and
- Trademarks are now granted for services also, besides goods.

Goods is defined as anything which is the subject of trade or manufacture. Service means service of any description offered to users. Banking, finance, insurance, transport, energy supply, construction, hotels, entertainment, information and broadcasting etc. are all examples of areas where services are offered in connection with business, industry or commerce. Definition of service is meant to be all subsuming.

The Registration of Trademarks is done in Mumbai where the Trademarks Registry is situated. There are branch offices of the Registry at Calcutta, Delhi, Chennai and Ahmedabad with separate jurisdictions.

WHAT IS A TRADEMARK?

A trademark, as currently recognised in India, is a visual symbol (in the form of a word, a name, a device, a symbol, or a label) which identifies any merchants or manufacturer's goods or services and distinguishes them from similar goods or services of competitors in the trade. The mark should be capable of being represented graphically. It may include shape of goods, their packaging and combination of colours. The Act makes a distinction between a trademark and a well-known trademark. If a substantial segment of public associates a trademark with a particular class of goods and services, and if this trademark is used for other goods or services, and the public is inclined to associate the new goods/services with the earlier goods/services,

then the mark is a well-known trademark. If the proprietor of a trademark is an association of persons, who do not make a partnership within the meaning of the Indian Partnership Act, 1932, the trademark is called a collective mark. A special class of trademarks is termed as certification marks. These trademarks do not indicate the origin of the goods, but are certified by the proprietor of the mark as conforming to certain characteristics, like quality, ingredients, geographical origin etc. Agmark used for food items in India is a certification mark. Similarly ISI marks on goods certifies that the goods bear a prescribed quality/specification as per the applicable ISI standards.

A trademark is a sign used on, or in connection with the marketing of goods. Saying that the sign is used on the goods means that it may appear not only on the goods themselves but also on the container or wrapper of the goods. Saying that the sign is used in connection with the marketing of the goods refers mainly to the appearance of the sign in advertisements (in newspaper, on television, etc.) or in the windows of the shops in which the goods are sold. Where a trademark is used in connection with services, it may be called service mark, e.g. service marks used by banks, hotels, restaurants, airlines, tourist agencies. In the following text the term trademark will be considered to include also service mark, collective mark, certification mark unless there is need to mention any of them separately.

A person who sells his product under a particular trademark acquires an exclusive right to the use of the mark in relation to those goods. Such a right can be registered under the new Trademark Act 1999. A registered trademark can be protected against unauthorised use by others by an action against infringement. An unregistered trademark also can be protected against unauthorised use by others by an action of passing off. A trader is guilty of passing off, if he attempts to pass off his goods by misrepresentation that leads the consumer to believe that the goods are the same as those of another better-known trader in those goods. For example, using Coco Cola to cause confusion with Coca Cola is an action of passing off.

In determining whether a trademark is a well-known trademark the Registration is required to consider any relevant fact, including the following:

- The knowledge or recognition of the trademark in the relevant section of the public including knowledge in India as a result of business promotion;
- The duration, extent and geographical area of any use of that trademark or of any promotion of the trademark, or of any registration or application for registration of the mark to the extent they reflect the use or recognition of the mark;
- The record of successful enforcement of the rights in the trademark; in particular, the extent to which the trademark has been recognised as a well-known trademark by any court or Registrar;
- The number of actual or potential consumers, persons involved in the channel of distribution, besides the business circles dealing with the goods or services.

None of the following is taken into account while determining whether a trademark is a well-known trademark:

- That the trademark has been used in India;
- that it has been registered;
- that the application for its registration has been filed in India;
- that—the trademark

a) is well-known in; or

b) has been registered in; or

c) in respect of which an application for registration has been filed in any jurisdiction other than India.

While considering an application for registration of a trademark and opposition filed in respect thereof, the Registrar shall (i) protect a well-known trademark against the identical or similar trademarks, and (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trademark. Thus well-known trademarks enjoy large trademark rights in consonance with the TRIPS Agreements.

DIFFERENT FORMS OF TRADE MARKS

Collective Marks

A collective mark distinguishes the goods or services of members of the Association which owns the mark from those of others. Members of the Association are the authorised users of the mark, and the use of the mark by the members of the Association is considered as the use by the proprietor. A collective mark cannot be registered if it is likely to deceive the public, or confuse the public that the mark may be something other than a collective mark. In such a case the Registrar may require that the mark may carry some indication that it is a collective mark. The Association registered as the proprietor of a collective mark can file a suit for infringement. A collective mark can be removed from the register on following additional grounds (Refer 5.6):

- The manner it has been used is liable to mislead the public; or
- The proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.

Certification Marks

Certification trademarks certify goods in respect of origin, material, mode of manufacture, quality, accuracy or some other characteristics of the goods, which bear them. They distinguish goods so certified from competing goods which do not carry the certification mark. Thus, these marks benefit the consumer. The trading community is not always enthusiastic about these

marks. Some examples of certification trademarks are ISI, Agmark, Woolmark, Sanforized. Because certification trademarks are functionally different from other trademarks, which distinguish a trader's/producer's goods from those of others, several provisions of the Trade Marks Act, 1999, do not apply to these marks. These provisions pertain to • Absolute grounds of refusal of registration:

A certification mark need not be distinctive for registration. Similarly, the provision denying registration to a mark if it consists exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade is not applicable to certification marks.

- Application for registration, advertisement of application and opposition to it.
- The procedure as applied to other trademarks is different in the case of certification marks.
- Rights conferred by registration, infringement, limits on the effect of registered trademark, assignment or transmission, removal from register and limitation on ground of non-use, registered users, power of registrar for variation or cancellation of registration as registered user, right of registered user to take proceedings against infringement, registered user not to have right of assignment or transmission.

Registration of Certification Trademarks

A certification mark cannot be registered in the name of a person who carries on a trade in goods of the kind certified. For registration, the proprietor makes an application in a prescribed manner to the Registrar, accompanied by the regulations governing the use of the certification trademark, which are to be deposited with Trademarks Registry. Acceptance of the application, withdrawal of acceptance and incorporation of any correction or amendment is to be done as provided for other trademarks subject to the restriction on the persons who could be the proprietor of a certification mark as stated earlier.

While accepting the application the Registrar takes into account the following matters:

- Whether the applicant is competent to certify the concerned goods;
- Whether the draft of regulations governing the use of the mark is satisfactory;
- Whether the registration would be to the public advantage in all the circumstances.

If the acceptance and approval would require modification or imposition of conditions/limitation the Registrar shall not decide the matter without giving the applicant an opportunity to be heard. On acceptance, the application shall be advertised, as in the case of other trademarks, and opposition, if any, for the registration of the certification mark shall have to be considered and decided before proceeding to registration.

CHARACTERISTICS OF A GOOD TRADEMARK

A trademark should be distinctive. Distinctiveness may be inherent or acquired. An invented

word may be inherently distinctive as a trademark e.g. RIN. Other trademarks may have acquired distinctiveness through usage e.g. TATA, Reliance, Revlon. Most brands acquire distinctiveness through use. A brand may depend on the class of goods e.g. Hawkins and Prestige are two distinctive brands in pressure cookers. **If the trademark is a word, it should be short and easy to spell, pronounce and remember;** if it is a device it should be expressible in a word. The word should be preferably an invented word. Zen, Avon, RIN, Flex are all fine examples. The mark can be denied if it is not considered distinctive. A trademark consisting of parts of a chain wheel and chain to cover a business in chains and chain wheels is not considered distinctive. However, distinctiveness alone is not sufficient for registration of a trademark. **It may also depend on whether other traders, without any improper motives, want to use the same mark.**

REGISTRATION OF TRADEMARK

In India an office of the Registrar of Trademarks has been established for the maintenance of the Trademark Registry. Controller General of Patents and Designs is also the Registrar of Trademarks. The Register of Trademarks contains the record of all registered trademarks, with names, addresses and description of proprietors and users, assignments and transmissions, and conditions and limitations and the name of registered users.

Any person who claims to be a proprietor of a trademark can apply to the Registrar of Trademarks for its registration. The application may be made in the name of an individual, partners of a firm, a Corporation, any Government Department, a trust or joint applicants claiming to be the proprietor of the trademark. **For registration of a trademark the nature of goods or services in relation to which the trademark is to be used has to be specified.**

Application

- [1] Application in the prescribed form has to be filed in the office of the Trademark Registry within whose territorial limits the principal place of business in India of the applicant, or the first applicant in the case of joint applicants, is situated. The Registrar is required to classify goods and services in accordance with the international classification for registration of trademarks. **A single application is sufficient for registration of a trademark for different classes of goods and services;** however, **the fee is payable for each class separately.** If the applicant or any of the joint applicants does not carry on business in India, the application shall be filed in the office of the trademark registry within whose territorial limits the place mentioned in the address for service in India lies.
- [2] Every application for registration of a trademark shall contain a representation of the mark in the place provided in the form for the purpose. **Five additional representations of the mark have to be supplied with the application.**

- [3] The application can either be accepted completely or accepted subject to amendments or rejected. It is possible that an application is accepted and later, before registration, the acceptance is found to be in error. In such a case the Registrar, after hearing the applicant may withdraw the acceptance.

Advertisement

Soon after acceptance, the application as accepted, together with the conditions or limitations, if any, is advertised in the Trademarks Journal to provide the public an opportunity to oppose the registration. Any person may, within three months from the date of the advertisement or within such further period not exceeding one month, as the registrar may allow, give notice in writing to the Registrar of opposition to the registration. A copy of the notice of opposition is given by the registrar to the applicant to file a counter-statement, etc. The Registrar decides the issue giving both parties due hearing, if required, or after considering their respective views.

If the person giving notice of opposition of the applicant neither resides nor carries on business in India, the Registrar may require him to give security for the cost of proceedings and if such security is not given the Registrar may treat the opposition (or the application) as abandoned. When the procedure for registration, including the opposition, if any, is satisfactorily complete, the Registrar is mandated to register the mark with effect from the date of application.

Time Period

The registration of a trademark is for a period of ten years, but it may be renewed indefinitely on the payment of the prescribed renewal fees.

Registration is prima facie evidence of validity of the trademark. A registered trademark shall not be held to be invalid on the ground that it was not registrable under the Act except upon evidence of distinctiveness. However, if it is claimed and proved that the trademark had become distinctive due to use by the proprietor at the date of registration, it can be contended that such evidence was not submitted to the Registrar at the time of registration. If a trademark has been registered, even if it lacked distinctiveness, it shall not be declared invalid if, in consequence of the use made of it, it has acquired a distinctive character in relation to the goods or services for which it is registered, between its registration and commencement of the legal proceedings challenging its validity.

REGISTRABILITY OF TRADEMARK

A trademark which consists of at least one of the following essential characteristics can be registered.

1. The name of a company, individual or firm represented in a particular or special manner;
2. The signature of the applicant for registration;

3. One or more invented words;
4. One or more words having no direct reference to the character or quality of the goods except the exceptions listed in the next section;
5. Any other distinctive trademark; and
6. A trademark which has acquired distinctiveness by use over a prolonged period of time.

A part of trademark can be registered separately in addition to a whole trademark if it satisfies the requirements of registration of a trademark. The Act also provides for registration of the same or similar trademark by more than one proprietors in the case of honest concurrent use or other special circumstances.

The Act lays down absolute grounds for refusal of registration, as also the relative grounds for such refusal.

NON-REGISTRABLE TRADEMARKS

The act debars a trademark from registration if it is not distinctive, or consists exclusively of marks or indications which have become customary in the current language and practice. It cannot be registered if it consists exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin, or the time of production of the goods or rendering of the service or other characteristics of the goods or service. Also, a mark falling in any of the following categories is not register able:

- A mark which is identical with or deceptively similar to a trademark already registered in respect of the same goods or goods of the same description as to deceive the public or cause confusion;
- A mark the use of which would be contrary to any law or which would be disentitled for protection in a court of law;
- A mark comprising or containing scandalous or obscene matter;
- A mark comprising or containing any matter likely to hurt the religious susceptibilities of any class or section; and
- A word which is declared by the World Health Organisation (WHO), and notified by the Registrar as an international non-proprietary name, or a word which is deceptively similar to such name.

Shape trademarks attract prohibition from registration in certain conditions which may arise in a very limited number of cases, and it would be difficult in those cases to satisfy the distinctiveness criterion.

A mark cannot be registered as a trademark, if it consists exclusively of the goods

- Which results from the nature of goods themselves? For example, shape of an apple used for apples or their packaging;

- Which is necessary to obtain a technical result? An exclusively technical shape will be the one if no other shape will perform its function;
- Which gives substantial value to the goods? There may be difficulty in interpreting this provision.

The word exclusively is to be noted here. If a mark has a shape of any of the descriptions given above but has other additional features, it could be considered for registration subject to other essential qualifications for a trademark. Also, an unregistered trademark can continue to have a shape of a description that makes it ineligible for registration.

A trademark, save in rare circumstances as of honest concurrent use, to be decided by the Registrar shall not be registered, if it is identical with an earlier trademark, or if it is similar to an earlier trademark and covers identical goods and services so as to cause confusion in the mind of the public.

If a trademark has similarity or identity with an earlier well-known trademark but is sought to be applied to a different category of goods, it will still not be registered, as it seeks to exploit a well-known brand for an unfair advantage or may harm the reputation of the earlier, well-known trademark.

If a trademark violates any law, in particular the law of passing off protecting an unregistered trademark, or the law of copyright, it is not registered.

Additionally, the following categories of marks are also not registrable:

- a word which is the commonly used and accepted name of any single chemical element or single chemical compound; and
- a geographical name or a surname or a personal name or any common abbreviation thereof or the name of a sect, caste or tribe in India.

The Act provides for registration of same or similar trademark by more than one proprietor in case of honest, concurrent use, if in the opinion of the Registrar it is proper to do so in the special circumstances.

Where the proprietor of the trademark claims to be entitled to the exclusive use of any part of the trademark, he may apply to register the whole and the part as separate trademarks.

Registration of trademarks as a series:

If a person is the proprietor of several trademarks in respect of the same goods which may differ in respect of:

- Statement of the goods they cover; or
- Statement of number, price, quality, or names of places; or
- Other matter of a non-distinctive character, or

DECEPTIVELY SIMILAR TRADEMARKS

The word similar is not defined in the Act. However, a trademark is said to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion. **The deceptively similar mark includes not only confusion but deception also.**

Near resemblance is mentioned in the Act in connection with registered trademarks in the name of the same proprietor which may closely resemble each other, so as to deceive or cause confusion in the mind of a user. The Registrar may require them to be registered as associated trademarks.

The following factors are to be taken into consideration when deciding the question of similarity:

- The nature of the marks;
- The degree of resemblance;
- The nature of goods in which they are likely to be used as trademarks;
- The similarity in nature, character and nature of goods in which it is used;
- The nature of the potential class of consumers; and
- The visual and phonetic similarity.

RIGHTS CONFERRED BY REGISTRATION OF TRADEMARKS

Registration serves as evidence of adoption and selection of the trademark for specified goods & services. The proprietor of a registered trademark enjoys the following rights by virtue of the registration:

- An exclusive right to the use of the trademark in relation to the goods or services in respect of which it has been registered;** if the trademark consists of several parts, the exclusive right pertains to the use of the trademark taken as a whole; if the trademark contains matter common to trade and is not of a distinctive character, there is no exclusive right in such parts.
- Registration entitles the proprietor to obtain relief in case of infringement when a similar mark is used on (a) same, or similar, goods or services, (b) dissimilar goods or services.
- Registration forbids other persons, except the registered, or unregistered permitted user to **use the registered trademark or a confusingly similar mark in relation** to the same goods or services, (or the some description of goods and services) in relation to which the mark is registered.
- Once a trademark is registered, the same or confusingly similar mark can not be registered for the same or similar goods or services. In case of well-known trademarks, it cannot be registered even for dissimilar goods and services.
- A registered trademark shall not be used by any one unauthorized in business papers

and in advertising. Use in comparative advertising should not be contrary to honest practices and should not harm the distinctive character or reputation of the trademark.

- vi. Import of goods and services bearing a mark similar to a registered trademark can be restricted by the registered proprietor.
- vii. A right holder has a right to restrain the use of his registered trademark as trade name or part of a trade name or name of business concern dealing in the same goods or services.
- viii. A registered trademark continues to enjoy all the rights available to an unregistered mark, emerging from common law like passing off action.
- ix. Registration confers the right to assign or transmit the trademark to another person by the registered proprietor.

Exception to Rights

There are exceptions to these rights in certain situations where considerations like vested rights and concurrent use come into play.

Rights of the prior user

If a person A gets registration for a trademark and uses it and another person B has been using the trademark from an earlier time, the right of B to use it is not affected after A's registration, even if B had not opposed it. However, B's growth of business may be affected. But if B's business has got great reputation, A can even be restrained from using the trademark despite registration.

Rights to use one's own name

Registration does not confer a right on the proprietor to interfere with the business of another person who is using, in a bona fide manner, his own name, or that of his place of business or any description of the character, quality of goods or services.

Concurrent use

A mark which has been in concurrent use in the same jurisdiction on the same, similar, dissimilar or different goods is not affected by the registration of the same mark by another person.

It may be reiterated that there is no exclusive right (i) in parts of a trademark and (ii) in non-distinctive or other matter common to trade. A matter is said to be common to the trade when it is in common use in the trade, or when it is open to the trade to use. It could be a word or a symbol or a get-up which any trader in the trade can use and no body can claim as his own.

INFRINGEMENT

Trademark infringement is a violation of the exclusive rights attaching to a registered trademark without the authorization of the trademark owner or licensee. Infringement may occur when the infringer, uses a trademark which is identical or confusingly similar to a registered trademark owned by another person, in relation to products or services which are

identical or similar to the products or services which the registration covers. The owner of such registered trademark may commence legal proceedings against the infringer.

Passing Off

Passing off occurs in the case of unregistered Brand Names. Here, the owner or to say Brand holder has the preferred right over the Brand owing to long and continuous use though the Brand being unregistered (under the Trademark Act), an action of Infringement cannot be initiated. A Passing Off action can be brought in by the original owner or user of a Brand against another person, who in the course of trade, misrepresents to its prospective or ultimate customers about its goods or services in a manner so as to show that they are connected to the goods or services of the original owner and this is done in a calculated fashion to injure the business or goodwill of the original owner or to earn benefit at the cost of the original owner. It is also important that actual deception and actual damage has to be proved for any relief of passing off. It has been settled in catena of authorities that essential characteristics of a passing off action are as follows:

- Misrepresentation
- Made by a person in the course of Trade Mark
- To prospective customers of his or ultimate consumers of goods or services supplied by him
- Which is calculated to injure the business or goodwill of another trade
- Which causes actual damage to a business or goodwill of the trade by whom, the action is brought or we'll probably do so.

Jurisdiction

One of the most important practical benefit given under Section 134 of the Trade Marks Act, 1999 is that a suit for infringement can also be instituted before a District Court / High Court (enjoying Ordinary Original Civil jurisdiction such as High Court of New Delhi, Mumbai, Kolkata or Chennai), within the local limits of whose jurisdiction, at the time of the institution of the suit, the person instituting the suit, actually and voluntarily resides or carries on business or personally work for gain. The person includes the registered proprietor and the registered user. On the other hand the suit for passing off can only be instituted before a District Court, within the local limits of whose jurisdiction The Defendant is residing, working for gain or carrying on its business; or the cause of action has arisen.

Remedies

In case of infringement / passing off trademark, a criminal complaint can also be filed. The Courts can grant injunction and direct the custom authorities to withhold the infringing material / its shipment or prevent its disposal in any other manner, to protect the interest of the owners of intellectual property rights. This legal proposition can be enforced with / without involving the concerned authorities as a party in the suit.

The relief which a court may usually grant in a suit for infringement or passing off includes permanent and interim injunction, damages or account of profits, delivery of the infringing goods for destruction and cost of the legal proceedings. The order of interim injunction may be passed ex parte or after notice. The Interim relief's in the suit may also include order for:

- a. Appointment of a local commissioner, for search, seizure and preservation of infringing goods, account books and preparation of inventory, etc.
- b. Restraining the infringer from disposing of or dealing with the assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

CASE STUDIES:

Rights & Remedies of a Trade Mark Owner-

The owner of a registered trademark may commence legal proceedings for trademark infringement to prevent unauthorized use of that trademark. However, registration is not required. The owner of a common law trademark may also file suit, but an unregistered mark may be protectable only within the geographical area within which it has been used or in geographical areas into which it may be reasonably expected to expand.

Two types of remedies are available to the owner of a trademark for unauthorized use of his or her mark or its imitation by a third party. These remedies are:

- an action for infringement' in case of a registered trademark; and
- an action for passing off' in the case of an unregistered trademark

While former is a statutory remedy, the latter is a common law remedy. In an action involving infringement or passing off, a court may grant relief of injunction and/or monetary compensation for damages for loss of business and/or confiscation/destruction of infringing labels and tags etc.

Although registration of trademark is prima facie an evidence of validity of a trademark, yet the registration cannot upstage a prior consistent user of trademark, for the rule is 'priority in adoption prevails over priority in registration`.

Infringement of Trade Mark-

Trademark infringement is a violation of the exclusive rights attaching to a trademark without the authorization of the trademark owner or any licensees (provided that such authorization was within the scope of the license). Infringement may occur when one party, the "infringer", uses a trademark which is identical or confusingly similar to a trademark owned by another party, in relation to products or services which are identical or similar to the products or services which the registration covers. An owner of a trademark may commence legal proceedings against a party which infringes its registration.

Trade mark Law in India-

The Indian law of trademarks is enshrined the new Trade Marks Act, 1999 came into force with effect from September 15, 2003. The old Trade and Merchandise Marks Act, 1958 was repealed at the same time. The new Trademarks Act of 1999 is in line with the WTO recommendations and is in conformity with the TRIPS Agreement to which India is a signatory.

India has declared certain countries as convention countries, which afford to citizens of India similar privileges as granted to its own citizens. A person or company from a convention country, may within six months of making an application in the home country, apply for registration of the trademark in India. If such a trademark is accepted for registration, such foreign national will be deemed to have registered his or her trademark in India, from the same date on which he or she made application in the home country.

Scope of Foreign Investors With Regard to the Registration of Trade Mark in India-

Registration of trademarks is one of the important protections that businesses should avail in India. Many foreign and domestic Applicants have been able to successfully register their marks in India. Indian courts have upheld many of those registrations and granted favorable decisions to rights holders.

In addition to the registering of their trademarks in India, businesses need to adopt other strategies for protecting their trademarks. Some of them are mentioned below:

- Get trademark searches conducted in the Indian Trade Marks Registry in the classes that are of interest to you including the ancillary classes.

- Get common law searches (this includes the internet, market surveys, yellow pages and directories) conducted to ascertain whether third parties are using your trademarks and if so, the extent of such use.
- Based on this information and after seeking the local counsel's opinion decide if the trademark is available for use or not.
- Should the trademark be available for use, immediately apply for the registration.
- The rights holder should also consider hiring a watching service to monitor the trademark journals in order to alert them to any published, deceptively similar trademarks or descriptive trademarks that might be of concern.
- **Should the rights holder own a trademark that has been used and has acquired goodwill and reputation, it** is advisable that along with filing of the trademark application in India, they should also make press releases, publish cautionary notices and advertise the mark to ensure that the relevant section of the public is aware that they are entering the Indian market and are protecting their trademark from any kind of third party violation.
- The rights holder should also take immediate steps to register their domain names including country coded top level domain names in India, as there have been many instances of third parties registering domains for certain well known marks with the intention of extracting money by selling these domain names to the rights holders.
- Should the rights holder discover that their trademark is being infringed, they should take immediate steps to protect their trademark, either by the means of filing oppositions, cancellations, conducting investigations, sending cease and notices or initiating appropriate civil and criminal actions.

Cases of Trade Mark Violation in India-

Trade mark infringement especially among the corporate classes in India is rising on an alarming rate. Few of the notable cases have been described in brief.

1. Pantaloon dragged to court by Shoppers' Stop and Lifestyle; Westside also contemplates similar action, (July 14th, 2008).

Shoppers' Stop and Lifestyle have dragged their rival Pantaloon to court as they were miffed with an advertisement issued by the flagship company of Kishore Biyani owned Future Group that offered 10% extra discount to their loyal customers vide an advertisement issued in The Times of India, New Delhi, dated 28th June, 2008. **The complainant retailers have accused Pantaloon of trademark violations and unfair business practices, says a Live Mint report.** All the three parties operate department store format store chains in lifestyle segment.

Even Westside has taken objection to the ad saying, “We have sent a notice to them to which they have not responded,” said Smeeta Neogi, Head (Marketing) Westside.

Pantaloon’s ‘Central’ mall at Gurgaon had offered 30% discounts to its customers over the weekend. Loyalty card holders of competing retailers like Shopper’s Stop, Lifestyle and Westside, were lured by Pantaloon by offering an additional 10% discount on select brands of apparel. The advertisement asked such customers to: “Present your membership card to avail this offer.”

Loyalty cardholders are mainstay of business for most retailers. Shoppers’ Stop has a highly popular loyalty card programme branded “First Citizen.” According to analysts, more than two-thirds of Shoppers’ Stop’s apparel business is accounted for by its loyal customers.

“They (Pantaloon) are luring my customers by using my name in an unfair manner,” said Sandeep Mittal, the lawyer representing for both the petitioners.

The Honourable Delhi high court has issued an injunction restraining Pantaloon from using names of its rivals in the ads until the next hearing in the matter fixed for 31st July.

Taking potshots at these competitors is not new for Pantaloon. Last year, its Big Bazaar chain had put up hoardings, asking customers to “Keep West-aSide,” “Shoppers! Stop” and “Change Your Lifestyle. Make a Smart Choice.”

2. Amul wins trade mark case in Gujarat High Court, (Sep 24, 2007)

Amul has won the trade mark case in Gujarat High Court and no one else can use it.

The Kaira District Co-operative Milk Producers’ Union Ltd. and GCMMF had filed trade mark infringement cases, against two local shop owners ? Amul Chasmaghar and its partners and Amul Cut Piece Stores in the District Court, Anand.

The District Court, Anand passed an order dated 25 April 2007, ruling that it was a clear case of infringement and restrained the two from using the Amul trademark.

Amul Chasmaghar had challenged this interim injunction in the Gujarat High Court. The Gujarat High Court ruled the decision in favor of Amul, terming the order passed by the trial court as true, correct, legal and in consonance with the facts of the case, as well as in accordance with the provisions of the Trade Marks Act 1999.

3. Trade Marks Disputes Involving Pharmaceuticals Industry in India-

A. Beecham Group Plc. vs. S.R.K. Pharmaceuticals 2004 (28) PTC391 (IPAB)

The appellant was using the mark 'AMOXIL' in India since 1990. This mark was registered in India in 1972 in Class 5 in respect of Pharmaceutical goods. The respondent started using the

mark 'LYMOXYL' in India from 1985. The respondent filed the application for registration of the mark in 1987 in India in the same class with respect to similar goods.

The appellant brought an action against the respondent stating that the mark is deceptively similar. The only difference between the two marks is in the prefix 'LY' and 'M'. The rival marks are phonetically and deceptively similar and the goods are pharmaceutical goods under Sec. 12(1) of the Act.

The Intellectual Property Appellate Board (IPAB) held that the respondent dishonestly adopted the mark by copying it from the appellant who had got the mark registered long ago. Hence the respondent cannot claim honest concurrent use, by virtue of earlier use. The Appellate Board delivered a judgment prohibiting registration of the Trade Mark 'LYMOXYL'.

B. Ranbaxy Laboratories Limited vs. Anand Prasad & 4 Others 2004 (28) PTC 438 (IPAB)

The appellant was the registered proprietor of the mark 'FORTWIN' and had been using the mark since 1975. The respondent applied for registration of the mark 'OSTWIN'. Both the marks related to pharmaceutical compositions in respect of treatment of bones.

The appellant brought an action against the respondent stating that the mark is deceptively similar. The IPAB held that the prefixes are 'FORT' and 'OST' while both the marks end with the suffix 'WIN'. It was further held that since the rival goods are also pharmaceutical goods it might lead to serious consequences due to deception or confusion in the minds of the public. Hence on the possibility of harm being caused to common person the appeal was allowed.

C. Wyeth Holdings Corp. & Anr. vs. Sun Pharmaceuticals Industries Ltd. 2004 (28) PTC 423 (Bom)

In this case the plaintiff whose former name was American Cynamid Company and who was the proprietor of the trademark 'PACITANE' registered the mark in Class 5 of Pharma goods. The respondent was using the mark 'PARKITANE' with respect to similar goods. The plaintiffs filed a suit for infringement and passing off and sought various reliefs including interim injunction against the defendant for using the mark 'PARKITANE'.

The Court held that in both the cases the goods are similar, being pharmaceutical preparations for treatment of Parkinson's disease, the customers buying these goods are the same and the trade channels are the same. Since the defendants did not show any search of the Register before adopting the impugned mark, prima facie adoption of the mark was not honest. Further, the Court held that despite protests, if the defendants have chosen to continue to sell the products, it cannot be said to be acquiescence by the plaintiff. Therefore the Court held that injunction is to be granted in favour of the plaintiff.

The Court further held that in case of pharmaceutical products, the test is of possibility of confusion and not probability of confusion. The plaintiffs have been in the field since 1950 and as such the balance of convenience is in their favour. The Court granted injunction in favour of the plaintiffs.

D. Hoechst Aktiengesellschaft vs. Arteel Minerals & Anr. 2004 (28) PTC 470 (IPAB)

The appellant was the registered proprietor of trademark 'ARELON'. This mark was registered in class 5 with respect to pharmaceutical goods relating to preparation for killing weeds and destroying vermin. The respondent filed an application for registration of the mark 'ARTEELON' in the same class with respect to pharmaceutical goods.

The appellant opposed the application for registration of trade mark filed by the respondents on the ground that the registration of the impugned mark would be contrary to provisions of Sections 9, 11, 12(1) and 18 of the Trade and Merchandise Marks Act, 1958.

The IPAB held that the rival goods were same and the only difference was the letters 'TE'. The Appellate Board further held that the possibility of confusion and deception is not ruled out and hence affirmed the order rejecting the application for registration filed by the respondent.

The IPAB further held that the benefit of use under Section 54 is given only in case of rectification proceedings when use of an associated trademark is deemed to be use of the registered trademark against which rectification proceedings are initiated for non-use of the mark.

Conclusion-

In conclusion it can be drawn that Indian Trade Mark Law must be updated on frequently keeping in pace with the dynamic and new methods of Trade Mark infringement. Both Courts and Enforcement authorities must be well equipped and be trained for efficient disposal of cases relating to Intellectual Property.