

# **Trademark**

- **Introduction,**
- **Types of Trademark,**
- **Benefits and Applications**

# Introduction

- A trade mark (popularly known as brand name) in layman's language is **a visual symbol** which may be a **word signature, name, device, label, numerals or combination of colours** used by **one undertaking** on **goods or services** or **other articles** of **commerce** to **distinguish** it from **other similar goods or services** originating from a different undertaking

# Introduction

- **For trade mark (legal requirements):**
  - The selected mark should be capable of being represented graphically (i.e., in the paper form)
  - It should be capable of distinguishing the goods or services of one undertaking from those of others
  - It should be used or proposed to be used mark in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person have the right to use the mark with or without identity of that person

# Introduction

- The Indian law of trademarks is protected by the Trade & Merchandise Marks Act, 1958.
- A new statute i.e. the Trade Mark Act, 1999 has been enacted in India to bring it in conformity with the TRIPS Agreement, to which India is a signatory. Indian Trademarks Act, 1999, came into force on September 15, 2003.
- India has made a step towards fulfilling its international obligations.
- The Indian trademark law has now become fully compatible with the International standards laid down in the TRIPS Agreement.

# Functions of Trademark

- **A trade mark performs four functions:**
  - Identifies the goods / or services and its origin
  - Guarantees its unchanged quality
  - Advertises the goods/services
  - Creates an image for the goods/ services

# Purpose of Trademark

- Identifies the actual physical origin of goods and services.
- The brand itself is the seal of authenticity
- Guarantees the identity of the origin of goods and services
- Stimulates further purchase
- Serves as a badge of loyalty and affiliation
- Enable consumer to make a life style or fashion statement

# Benefits of Trademark

- **Regd. Proprietor:** Regd. Proprietor of a trade mark can stop other traders from unlawfully using his trade mark, sue for damages and secure destruction of infringing goods and or labels
- **Legal professionals:** The Trade Marks Registration system is driven by professionals and legal and para legal advisors (Agents) who act for the clients in the processing of the trade marks application
- Purchaser and ultimately Consumers getting benefit of trade marks for goods and services

# Benefits of Trademark

- The registration of a trade mark confers upon the owner the exclusive right to the use of the registered trade mark and indicate so by using the symbol (R) in relation to the goods or services in respect of which the mark is registered and seek the relief of infringement in appropriate courts in the country.
- The exclusive right is however subject to any conditions entered on the register such as limitation of area of use etc.
- Also, where two or more persons have registered identical or nearly similar mark due to special circumstances such exclusive right does not operate against each other



# Trademark Symbol



**Registered trademark symbol** - It provides notice that your trademark is **registered in a given country** for goods/services sold under that name or logo. This tells consumers your mark is trusted. This symbol may be used **only after trademark registration**.

TM

**Unregistered trademark** - The unregistered trademark symbol is used by entities selling **goods/services** under a given name. This serves as notice to the public that you are considering claiming your trademark rights. This symbol may be used **before, during, or without registration**.

SM

**Service mark symbol** - An uncommon symbol, the service mark symbol tells the public that you are seeking to protect the **services** sold under your trademark. This mark may be used without registration. This symbol may be used **before, during, or without registration**.

# Types of Trademark

- **Any name** (including personal or surname of the applicant or predecessor in business or the signature of the person), which is not unusual for trade to adopt as a mark
- An **invented word** or any **arbitrary** dictionary word or words, not being directly descriptive of the character or quality of the goods/service
- Letters or numerals or any combination thereof
- The right to proprietorship of a trade mark may be acquired by either registration under the Act or by use in relation to particular goods or service

# Types of Trademark

- Devices, including fancy devices or symbols
- Combination of colors or even a single color in combination with a word or device
- Shape of goods or their packaging
- Marks constituting a 3- dimensional sign
- Sound marks when represented in conventional notation or described in words by being graphically represented

# Types of Trademark

## Trademark



### Distinctive

Word

Letter

Numeral

Drawing

Picture

Shape

Color

Logotype

Label



A combination of one or more of the above

# Examples



# Examples

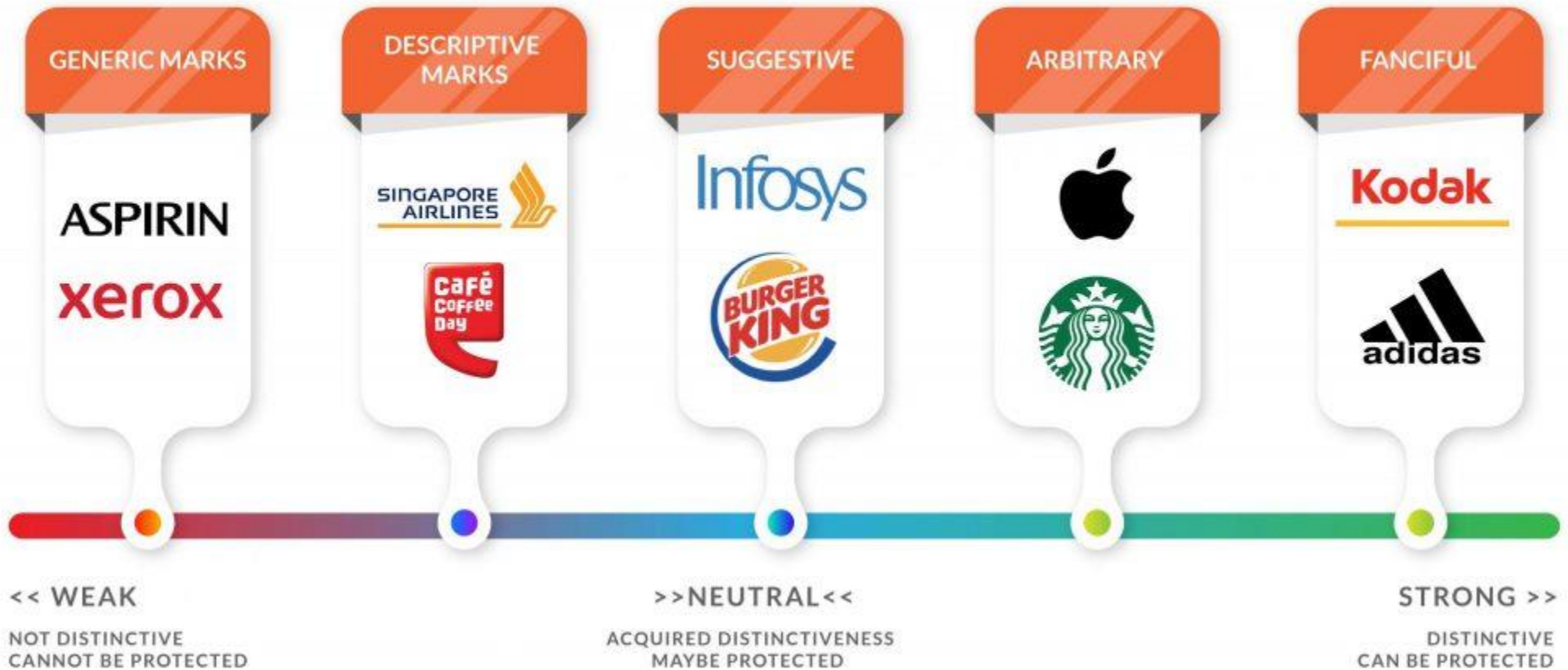
**AMERICAN  
EXPRESS**



|        |   |   |   |
|--------|---|---|---|
| RED    |    |    |   |
| ORANGE |    |    |    |
| YELLOW |    |    |    |
| GREEN  |    |    |    |
| BLUE   |   |   |   |
| PURPLE |  |  |  |

# Examples

## TRADEMARKS DISTINCTIVENESS SPECTRUM




# Sound as Trademark

- The Trade Marks Rules of 2017 introduced provisions that allow for the registration of non-conventional trademarks, including sound marks.
- To register a sound mark, the applicant must submit the sound in an
  - MP3 format,
  - not exceeding thirty seconds in length,
  - along with a graphical representation of the sound notations.
- This development aligns India with several other jurisdictions that recognize and protect sound marks as a part of their intellectual property rights system.



# Example (Audio marks)

**SOUND**  SOUND OF  
**TRADEMARKS**

Uber  
(PENDING)

Goldman  
Sachs  
(SOUND RECORDING & REGISTRATION)

NETFLIX  
(PENDING)

 Apple  
(PENDING)



State Farm  
  
(SOUND MARK)

the roar of a lion



# Trademark Selection

- **Key points:**

- If it is a word it should be easy to speak, spell and remember
- The best trade marks are invented words or coined words
- Avoid selection of a geographical name
- No one can have monopoly right on it
- Avoid adopting laudatory word or words that describe the quality of goods (i.e. best, perfect, super etc)
- It is advisable to conduct a market survey to ascertain if same/similar mark is used in market

# Unfair Competition

- The law of unfair completion is to safeguard the interest of the customers from unfair or misleading trade practice
  - Passing off
  - Misappropriation
  - Right of Publicity
  - False Advertising
  - Product Disparagement
  - Dilution
  - Infringement of Trade Dress

# Unfair Competition

- **Passing Off:**

- Passing off occurs when one party sells his goods or services by affixing another company's trademark on them.
- It is confined to registered or unregistered trademark, symbols, signs and device.
- It is a offence which is done by misrepresenting the good and service for creating confusion in customers' mind which effects the image of good will of the original manufacturer

# Unfair Competition

- **Misappropriation:**

- Misappropriation exists when one uses the property of another party without informing them.
- It means unauthorized use of person's name or likeness for advertising purpose, which effects the image of other person

- **Right of Publicity:**

- Allows individuals to protect their identities from being used for commercial purpose by other parties. Many companies misuse the celebrities name in fake to sell their product

# Unfair Competition

- **Product Disparagement:**

- When a false statement is made with an intention to harm a company or products or its services, then it is known as “Product Disparagement”.

- **Infringement of Trade Dress :**

- The unique and distinctive feature of a product, service, or business which differentiated it from others is known as “Trade Dress”
- It is needed to restrict others from duplicating a product.

# Unfair Competition

- **Dilution:**

- Blurring and Tarnishment are the two important aspects which are responsible for dilution of a product.
- The unauthorized use of a mark on a dissimilar which damages the distinctiveness of the mark is known as “**Blurring**”
- “Tarnishment” refers to the unauthorized use of mark of poor-quality product which affects the products of mark owner

# Application for Trademark

- Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may apply in writing in prescribed manner for registration.
- The application should contain the trade mark, the goods/services, name and address of applicant and agent (if any) with power of attorney , period of use of the mark and signature.
- The application should be in English or Hindi.
- It should be filed at the appropriate office



# Application for Trademark

- **How to apply for a trade mark in respect of particular goods or services?**
- It is provided under the Trade Marks Act, 1999 that goods and services are classified according to the International Classification of goods and services.
- Currently schedule IV of the Act provides a summary of list of such goods and services falling in different classes which is merely indicative.
- The Registrar is the final authority in the determination of the class in which particular goods or services fall.

# Trademark Offices



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