

Trademarks introduction

- Trademarks bill 1999 was passed by both Houses of Parliament It came on the statute book as trademark act 1999.
- Meaning of trademark: the consumer and the trader can be saved by a definite symbol which marks out the origin of goods from a definite source is attached with the goods emanating from such source

Such a symbol is called a trade mark. (it could be a picture, label, word, or words which is applied or attached to the goods

- It is used in relation to goods or services
- Some persons have the right either as proprietor or by way of permitted user to use the mark

purpose of a Trademark/Service mark?

- Allow the public to make informed decisions and to differentiate between competing products and companies.
- To protect the providers' investment in their reputation.
- The Supreme Court held in *Qualitex Co. v. Jacobson Products Co (1995)* that:
- "[T]rademark law, by preventing others from copying a source-identifying mark, 'reduce[s] the customer's costs of shopping and making purchasing decisions,' for it quickly and easily assures a potential customer that ... the item with this mark ... is made by the same producer as other similarly marked items that he or she liked (or disliked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation related rewards associated with a desirable product."

What is a Trademark?

The term trademark is often used when referring to a service mark but the two words have different meanings and requirements.

- A **Trademark** is any word, name, symbol, or device or any combination used by a person
- To identify and distinguish the **goods** of such person, including a unique product, from those manufactured or sold by others
- To indicate the source of the goods, even if that source is unknown.
- A trademark isn't a verb (or noun), it's an intangible asset.

What is a Service Mark?

A service mark is registered for a non tangible service.

- A **Service mark** is any word, name, symbol, or device or any combination thereof used by a person,
- To identify and distinguish the **services** of one person, including a unique service, from the services of others
- To indicate the source of the services, even if that source is unknown.
- Titles, character names used by a person, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

Essentials of trade mark

- Distinctiveness of the trademark (distinctiveness may be class dependent)
- Preferably must be an invented word
- If a word or name should be easy to pronounce and remember for instance “Bata for shoes, Zen for car, Sony for electronics, Ford for car, Panchranga pickles
- If it is a device mark the device should be capable to be described by a single word
- Easy to spell
- Should not be descriptive
- Short for instance Tick, Flex, Ben, Rin
- Marks must be compared as whole, microscopic examination being impermissible
- Should satisfy registration requirements
- Must not belong to a set of marks prohibited for registrations eg emblems and names.

Other marks

- Service marks
- Collective mark (association of persons)
- Well-known trademark in relation to goods or services.
- Deceptive similar work

Registrar TAKE INTO ACCOUNT any fact which he consider relevant for the said purpose :

- Knowledge or recognition of trademark in the relevant section of public including knowledge in India obtained as a result of promotion of the trademark
- Duration ,extent and geographical area of any use of that trade mark
- Duration ,extent and geographical area of any promotion of that trade mark, including advertising or publicity and presentation at fairs or exhibition of the goods or services to which the trademark applies
- Duration ,extent and geographical area of any registration of or any application for registration of that trade mark under the act to the extent they reflect the use or recognition of the trademark
- Record of successful enforcement of rights in that TRADEMARK.

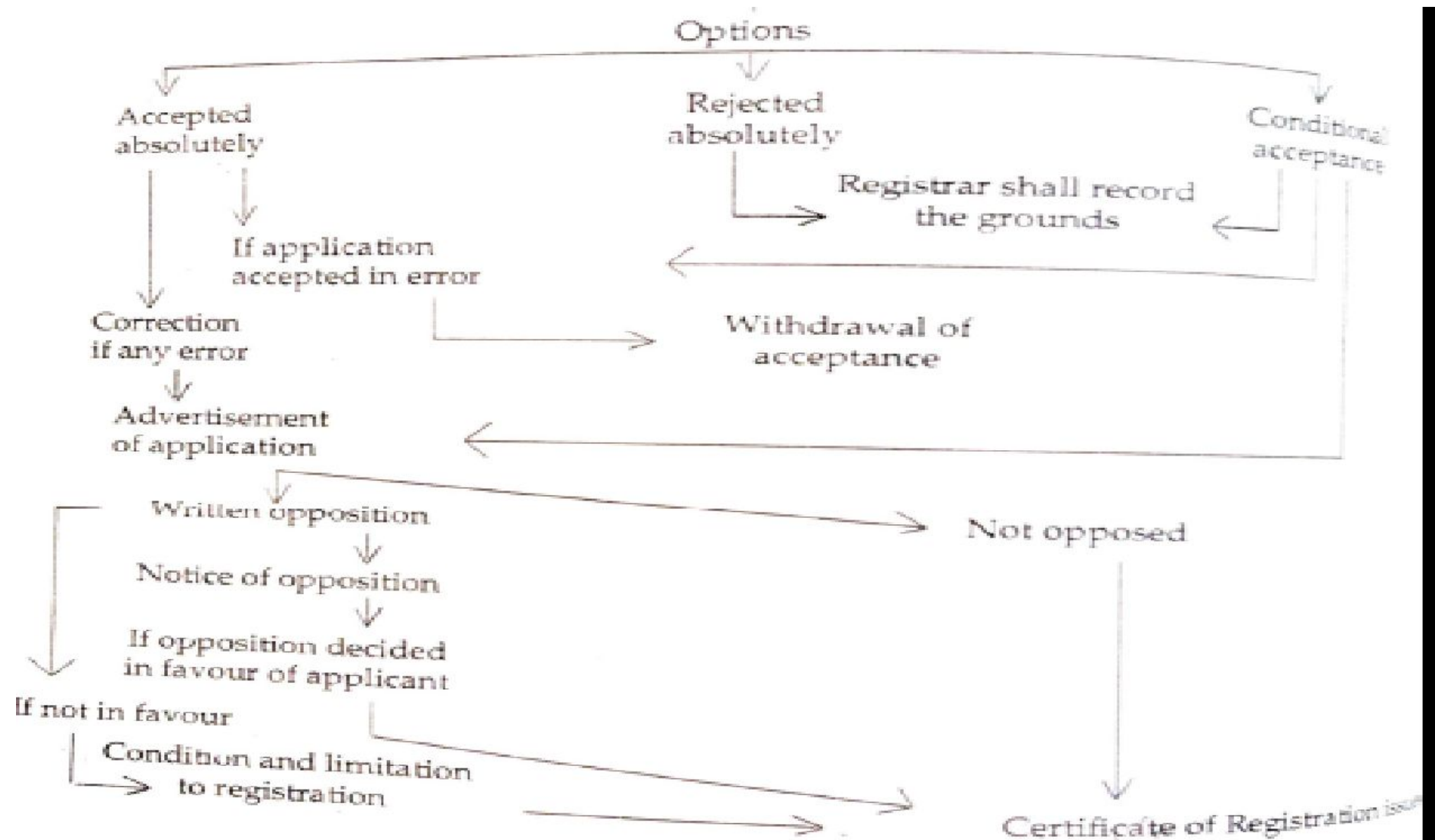
EXTENT to which the trademark has been recognized as a well known trademark by any court of registrar

If a mark is determined to be well known by even one section of the public in India, by any court or registrar , it should be considered as well known for registration.

Procedure for registration of trade mark

- Application for registration of trademark for various purposes shall be in forms TM-1, TM-2, TM-22, TM-37, TM-45, TM-51, TM-52, TM-53, TM-61, TM-64, TM-65, TM-66 AND TM-68 AS PROVIDED IN SCHEDULES OF THE TRADE MARKS RULES 2002
- APPLICATION CAN be signed by agent of the applicant. A single application can be made for different class of goods or services included in any one class from a convention country . A single application can also be made for series trade marks.
- Registrar determines that the goods or services applied for fall in class or classes in addition to those applied for, the applicant may restrict the specs of the goods or services to the class applied for or amend the application to add additional class on payment of appropriate class fee and divisional fee
- According to the rule 43 an application for registration shall be advertised in trade mark journal ordinarily within six months of the acceptance of the application or expiry of period referred to sub section
- Registrar may call upon applicant to furnish a camera ready copy or properly asserted in the initial application
- Registrar may inform public in the trade mark journal
- A notice of opposition to the registration of trademark shall be given in triplicate in Form TM-5 within 3 months or within further 1 month extended from the date the journal is made available to

Procedure for registration of trademark



Procedure for registration of trademark

Application must contain the following

- Class and goods or services for the class in which the application is made
- Full name , description of occupation and callin and nationality of applicant
- Principal place of business in India
- Address for service in India when there is no place of business nor residence in India
- Statement relating to colour combination
- Statement if the mark is three dimensional trade mark

Where the application to be filed

- Application shall be filed in the office of the Trade Mark register within whose territorial limits the principal place of business in India of the applicant with complete specification on the prescribed form .

Trade marks statutory authorities

- Statutory authority under the trade and merchandice mark act 1958 is controller –general of patents, design and trade marks
- A joint registrar, deputy registrars, assistant registrar, examiners of trade mark and a complement of ministerial staff assist the controller –general in discharge of functions. Registrar delates power to each of the above authorities
- Places like Ahmedabad, Chennai, Delhi, Mumbai, Kolkata have benches of Intellectual property appellate board Main board office is in Chennai. Jurisdiction of head office and other branch offices are demarcated.

Trade marks statutory authorities

- Registrar of Trade Marks is the authority responsible for registration of trade marks settling opposition proceedings and rectification of the register. He is vested with wide range of discretionary powers
- Register of trade marks is the official record of trademarks .
- Trade mark registered for the company is to be used a person a registered user after the registration of a trade mark

A person other than registered proprietor of trade mark may be registered as registered user in some or all goods or services

Licensing in trade mark

- Trade mark registered for the company is to be used a person a registered user after the registration of a trade mark

A person other than registered proprietor of trade mark may be registered as registered user in some or all goods or services

- Removal from register and imposition of limitation on the ground of non use
- On application made in prescribed form to registrar or to the appellate board by an aggrieved party a registered trade mark may be taken off the register on the ground that the trade mark got registered without any bonafide intention of applicant in a case where company concerned made no bonafied use of the trademark