

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.

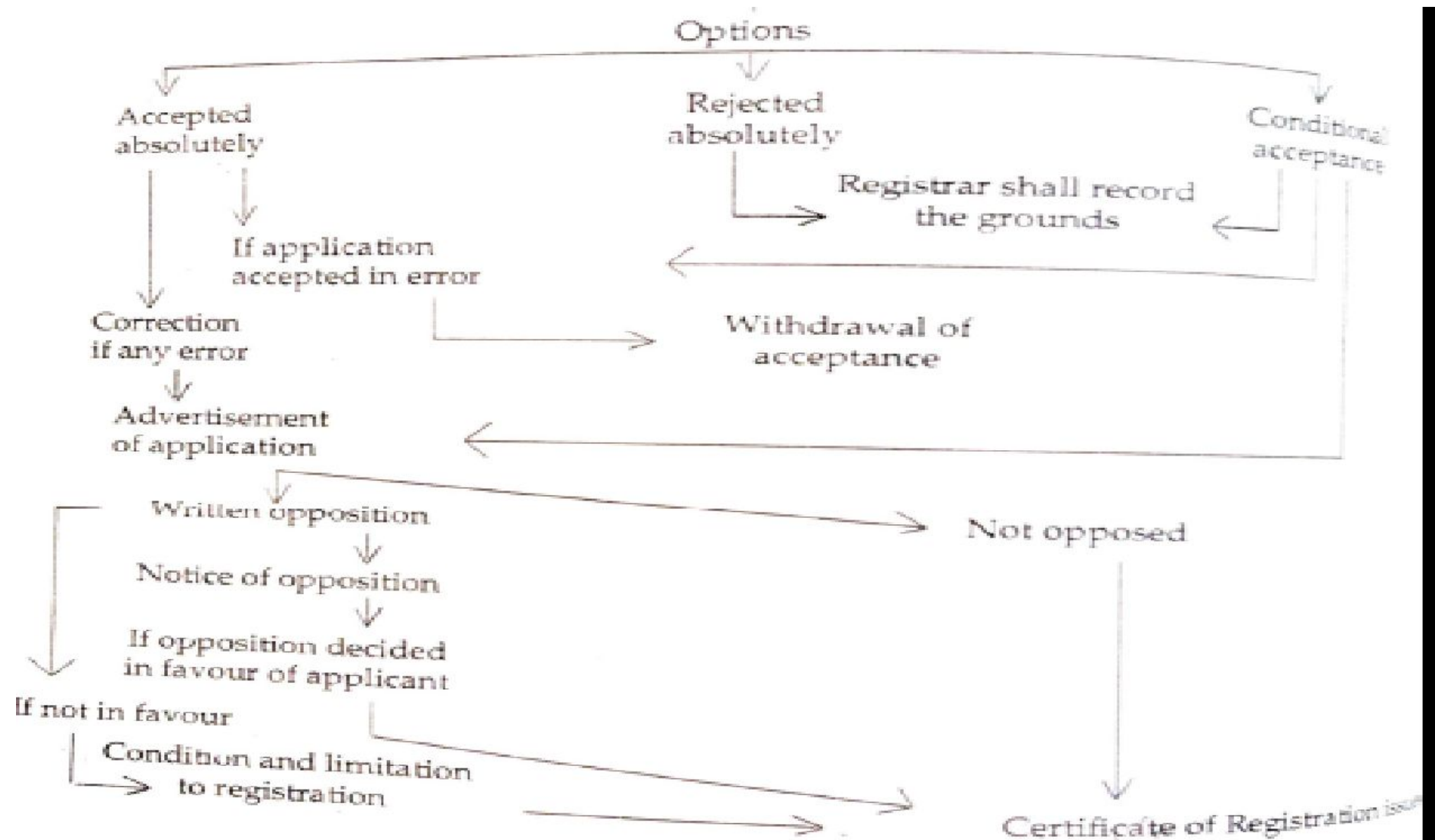
EXTENT to which the trademark has been recognized as a well known trademark by any court of registrar

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 extendable 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 .

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

Powers of the registrar

- Registrar has powers of a civil court for purpose of receiving evidence , administering oath , enforcing attendance of witness, completing the discovery and production of documents and issuing commissions for examination of witnesses
- Register may , on application made in prescribed manner , review his own decision
- Has no power to award cost to any party
- Register may on application in prescribed manner give advice as to whether the trademark is distinctive However fee paid on filing such application will be repaid in case on application made within three months after the advice the registrar on further investigation gives notice to the applicant of objection on the ground that the trade mark is not distinctive

Infringement of trade mark and action against infringement

- Suit filed for infringement of trade mark
- Relating to any right in a registered trade mark
- for passing off arising out of the use by defendant of any trade mark which is identical or deceptive similar to the plaintiff's trade mark , whether registered or unregistered shall be instituted in court on or in a district court having jurisdiction to try the suit
- Section 135 of act lays down relief that court may grant in any suit for infringement of trademark or passing off may include injunction and at the option of plaintiff either damages or an account of profits together with or without any order or delivery up of the infringing labels and marks for destruction or erasure.

Infringement of trade mark and action against infringement

- Order of injunction may include An ex parte injunction or inter-locutory order for following matters
- A. discovery of documents
- B. preserving of infringing goods, documents or other evidence which are related to the subject matter of the suit
- C. restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect the plaintiffs ability to recover damages, costs or other pecuniary remedies which may be finally be awarded to the plaintiff. However the court

Industrial design introduction

- Conditions for registrable designs
- Must be original and not previously published
- New means it has been invented for the first time or it has not been reproduced by anyone.
- A design is registrable if the pattern through already known is applied to a new article eg the shape of teddy bear if applied to a school bag would be registrable . What is essential is that the design is new with respect to the class of the article to which it is applied
- Can be a combination of previously known designs can be registered if the combination produces a new visual appeal.
- Colour may form a part of design but by itself cannot constitute a subject matter of design

Designs not registrable

- Is not new or original or
- It has been disclosed to the public anywhere in india or any other county by publication in a tangible form or any other way prior to the date of iling
- Or not significantly distinguishable from known designs or combination of know designs
- comprises or contains scandalous or obscene matter

Procedure of registration of a design

- 1. submission of application
- Acceptance /objections/refusal
- Removal of objections /appeal to central government
- Decision of central govt decision of central govt is final in case of registrability of design.
- publication of particulars of registered design
- Registration of the designs in register of design

Piracy of a registered design

- Designs act 2000 lays down that the following acts amount to piracy

1. to publish or have it published or expose for the sale of any article of the class in question on which either the design or any fraudulent or imitation has been applied

2. to either apply or cause to apply the design that is registered to any class of goods covered by the registration, the design or any imitation

3. to import for the purpose of sale any article belonging to the class in which the design has been registered and to which the design or a fraudulent or obvious imitation has been applied

Judicial remedies /burden of proof : A suit can be filed in district court or High court .depending on the quantum of damages claimed