

both operate on different fields. They are not meant to be seen in connect with each other. A copyright of cinematograph film shall not affect the separate copyright of a work, which forms part of it.

2.3 Meaning and Practical Aspects of Registrations of Trademarks

2.3.1 Introduction

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. Popularly known word "Brand Name" is referred as "Trademark" in legal terms. A Trademark means any symbol, word, name, device, numerals or combination of both, which can be represented graphically can be registered as trademark. A trademark is unique symbol which distinguishes your goods or services from others. The trademark which is registered for services are known as the service marks.

At the national/regional level, trademark protection can be obtained through registration, by filing an application for registration with the national/regional trademark office and paying the required fees. At the international level, you have two options: Either you can file a trademark application with the trademark office of each country in which you are seeking protection, or you can use WIPO's Madrid System.

In principle, a trademark registration will confer an exclusive right to the use of the registered trademark. This implies that the trademark can be exclusively used by its owner, or licensed to another party for use in return for payment. Registration provides legal certainty and reinforces the position of the right holder, for example, in case of litigation.

The term of trademark registration can vary, but is usually ten years. It can be renewed indefinitely on payment of additional fees. Trademark rights are private rights and protection is enforced through court orders.

Kinds of trademark can be registered : A word or a combination of words, letters, and numerals can perfectly constitute a trademark. But trademarks may also consist of drawings, symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or color shades used as distinguishing features - the possibilities are almost limitless.

2.3.2 Advantages of Trademark Registration

Few benefits of trademark registration are;

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Exclusive rights : The owner of Registered Trademark enjoys exclusive right over the trademark. The owner can use the same for all the products falling under the class(es) applied. Further, the owner can enjoy the sole ownership of the Trademark and can stop other from the unauthorised use of the Trademark under the same class where it is registered. It gives the right to sue the unauthorized user of the Trademark Registered.

Builds trust and goodwill : The established quality of your product and services are known by everyone through the trademark and which establishes trust and goodwill among the customers in market. It helps in creating permanent customers who are loyal and always opt for the same brand.

Differentiates product : It makes easy for customers to find your products. It makes your product and identity of products different from that of the existing and foreseen competitors and acts as efficient commercial tool. The logo can communicate your vision, quality or unique characteristic of your company and any organisation.

Recognition to product's quality : It gives recognition to the quality of the product. Customers attach the product's quality with the brand name and this image is created in the market about the quality of a particular brand which helps in attracting new customers as they can differentiate the quality of a product by the logo/brand name.

Creation of asset : Registration of Trademark creates an intangible asset i.e. Intellectual Property for an organisation. Registered trademark is a right created which can be sold, assigned, franchised or commercially contracted. Also, the Trademark is an intangible asset which gives the advantage to the organisation.

Use of ® symbol : Once the trademark is registered you can use the ® symbol on your logo stating that it is a registered trademark and no one can use the same trademark. It is exclusive of all types of usages as well as rights. If someone else use the trademark then you can also sue the party if the trademark is registered.

Protection against infringement : No competitor or other person can use the wordmark or logo registered by you under trademark. However, if in any case one uses it without the approval of the owner of trademark or make any deceptive use of same, the owner can get the legal

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Protection for 10 Years at low cost : Online Trademark registration is done on a very low maintainability cost. Once you register the trademark you have to just pay the maintenance cost and renewal cost which is after 10 years of registering the trademark. It is cost efficient and helps your company create an unique image.

Global trademark registration : If one wants to register the trademark in countries other than India, the trademark registered in India can be used as basis of registration there. For any person

willing to expand outside India, the trademark registered in India can provide a good base along with the established goodwill in the country.

Attract human resources : Young minds aspire to join big Brands as it acts as a magnate. It inspires the positive image of the organisation and thus candidates are attracted towards them easily. This reduces the cost towards hiring and related activities.

Although registration with the PTO is not required for a trademark to be protected, registration does confer a number of benefits to the registering party. Registration gives a party the right to use the mark nationwide. Registration constitutes nationwide constructive notice to others that the trademark is owned by the party. Registration enables a party to bring an infringement suit in federal court. Registration allows a party to potentially recover treble damages, attorneys fees, and other remedies. Finally, registered trademarks can, after five years, become "incontestable," at which point the exclusive right to use the mark is conclusively established

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Applications for registration are subject to approval by the PTO. The PTO may reject a registration on any number of grounds.. For example, the PTO will refuse to register generic marks or descriptive marks that have not attained secondary meaning. The PTO can also reject "immoral or scandalous" marks, certain geographic marks, marks that are primarily surnames, and marks that are likely to cause confusion with existing marks. As noted above, rejection of the mark does not necessarily mean that it is not entitled to trademark protection; it means only that the mark is not entitled to the additional benefits . Some states also have their own registration systems under state trademark law.

2.3.3 Conditions when Trademark Rights can be Lost

The rights to a trademark can be lost through abandonment, improper licensing or assignment, or genericity. A trademark is abandoned when its use is discontinued with an intent not to resume its use. Such intent can be inferred from the circumstances. Moreover, non-use for three consecutive years is prima facie evidence of abandonment. The basic idea is that trademark law only protects marks that are being used, and parties are not entitled to warehouse potentially useful marks.

- **Trademark rights can also be lost through improper licensing or assignment :** Where the use of a trademark is licensed (for example, to a franchisee) without adequate quality control or supervision by the trademark owner, that trademark will be canceled. Similarly, where the rights to a trademark are assigned to another party in gross, without the corresponding sale of any assets, the trademark will be canceled. The rationale for these rules is that, under these situations, the trademark no longer serves its purpose of identifying the goods of a particular provider.

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- **Trademark rights can also be lost through genericity.** Sometimes, trademarks that are originally distinctive can become generic over time, thereby losing its trademark protection *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938). A word will be considered generic when, in the minds of a substantial majority of the public, the word denotes a broad genus or type of product and not a specific source or manufacturer. So, for example, the term "thermos" has become a generic term and is no longer entitled to trademark protection. Although it once denoted a specific manufacturer, the term now stands for the general type of product. Similarly, both "aspirin" and "cellophane" have been held to be generic. *Bayer Co. v. United Drug Co.*, 272 F.505 (S.D.N.Y. 1921). In deciding whether a term is generic, courts will often look to dictionary definitions, the use of the term in newspapers and magazines, and any evidence of attempts by the trademark owner to police its mark.

2.3.3.1 Trademark Infringement

If a party owns the rights to a particular trademark, that party can sue subsequent parties for trademark infringement. The standard is "likelihood of confusion." To be more specific, the use of a trademark in connection with the sale of a good constitutes infringement if it is likely to cause consumer confusion as to the source of those goods or as to the sponsorship or approval of such goods. In deciding whether consumers are likely to be confused, the courts will typically look to a number of factors, including :

- the strength of the mark;
- the proximity of the goods;
- the similarity of the marks;

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- the strength of the mark;
- the proximity of the goods;
- the similarity of the marks;
- evidence of actual confusion;
- the similarity of marketing channels used;
- the degree of caution exercised by the typical purchaser;
- the defendant's intent.

So, for example, the use of an identical mark on the same product would clearly constitute infringement. If I manufacture and sell computers using the mark "Apple," my use of that mark will likely cause confusion among consumers, since they may be misled into thinking that the computers are made by Apple Computer, Inc. Using a very similar mark on the same product may also give rise to a claim of infringement, if the marks are close enough in sound, appearance, or meaning so as to cause confusion. So, for example, "Applet" computers may be off-limits; perhaps also "Apricot." On the other end of the spectrum, using the same term on a completely unrelated product will not likely give rise to an infringement claim. Thus, Apple Computer and Apple

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Records can peacefully co-exist, since consumers are not likely to think that the computers are being made by the record company, or vice versa.

Between the two ends of the spectrum lie many close cases, in which the courts will apply the factors listed above. So, for example, where the marks are similar and the products are also similar, it will be difficult to determine whether consumer confusion is likely. In one case, the owners of the mark "Slickcraft" used the mark in connection with the sale of boats used for general family recreation. They brought an infringement action against a company that used the mark "Sleekcraft" in connection with the sale of high-speed performance boats. Because the two types of boats served substantially different markets, the court concluded that the products were related but not identical. However, after examining many of the factors listed above, the court concluded that the use of sleekcraft was likely to cause confusion among consumers.

2.3.3.2 Trademark Dilution

In addition to bringing an action for infringement, owners of trademarks can also bring an action for trademark dilution under either federal or state law. Under federal law, a dilution claim can be brought only if the mark is "famous." In deciding whether a mark is famous, the courts will look to the following factors :

- The degree of inherent or acquired distinctiveness;
- The duration and extent of use;
- The amount of advertising and publicity;
- The geographic extent of the market;

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- The degree of inherent or acquired distinctiveness;
- The duration and extent of use;
- The amount of advertising and publicity;
- The geographic extent of the market;
- The channels of trade;
- The degree of recognition in trading areas;
- Any use of similar marks by third parties;
- Whether the mark is registered.

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Under state law, a mark need not be famous in order to give rise to a dilution claim. Instead, dilution is available if :

- The mark has "selling power" or, in other words, a distinctive quality; and
- The two marks are substantially similar. *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026 (2d Cir. 1989).

2.3.3.3 Defenses to Trademark Infringement or Dilution

Defendants in a trademark infringement or dilution claim can assert basically two types of affirmative defense: fair use or parody.

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- Fair use occurs when a descriptive mark is used in good faith for its primary, rather than secondary, meaning, and no consumer confusion is likely to result. So, for example, a cereal manufacturer may be able to describe its cereal as consisting of "all bran," without infringing upon Kellogg's rights in the mark "All Bran." Such a use is purely descriptive, and does not invoke the secondary meaning of the mark. Similarly, in one case, a court held that the defendant's use of "fish fry" to describe a batter coating for fish was fair use and did not infringe upon the plaintiff's mark "Fish-Fri." Such uses are privileged because they use the terms only in their purely descriptive sense.
- Finally, certain parodies of trademarks may be permissible if they are not too directly tied to commercial use. The basic idea here is that artistic and editorial parodies of trademarks serve a valuable critical function, and that this critical function is entitled to some degree of First Amendment protection. The courts have adopted different ways of incorporating such First Amendment interests into the analysis. For example, some courts have applied the general "likelihood of confusion" analysis, using the First Amendment as a factor in the analysis. Other courts have expressly balanced First Amendment considerations against the degree of likely confusion. Still other courts have held that the First Amendment effectively trumps trademark law, under certain circumstances. In general, however, the courts appear to be more sympathetic

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2.3.3.4 Remedies are there for Trademark Infringement and/or Dilution

Successful plaintiffs are entitled to a wide range of remedies under federal law. Such plaintiffs are routinely awarded injunctions against further infringing or diluting use of the trademark. In trademark infringement suits, monetary relief may also be available, including; defendant's profits, damages sustained by the plaintiff, and the costs of the action. Damages may be trebled upon showing of bad faith. In trademark dilution suits, however, damages are available only if the defendant willfully traded on the plaintiff's goodwill in using the mark. Otherwise, plaintiffs in a dilution action are limited to injunctive relief.

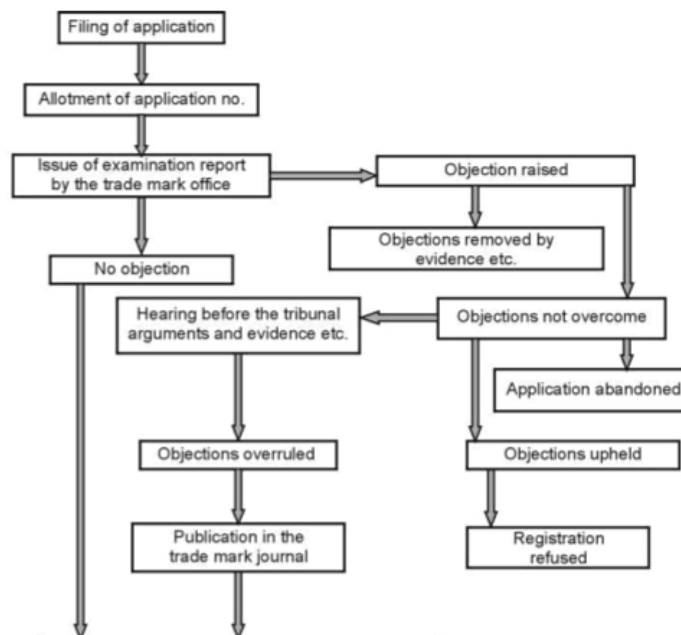
Offences and Penalties : In case of a criminal action for infringement or passing off, the offence is punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and fine which shall not be less than INR 50,000 but may extend to INR 200,000.

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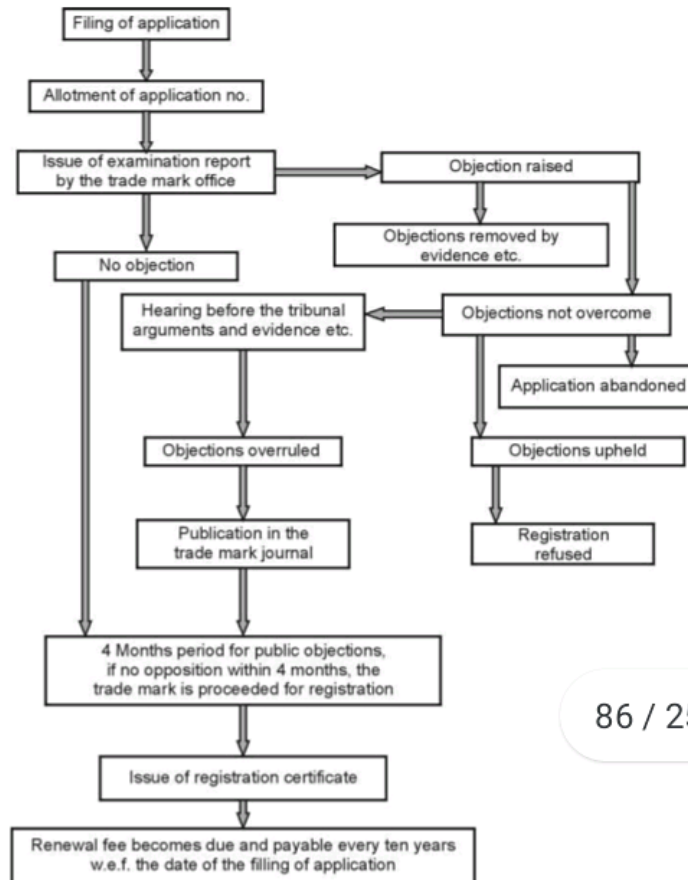
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Convention applications : In order to fulfill the obligations of any treaty, convention or arrangement with a country or countries that are members of inter-governmental organizations, which accord to Indian citizens similar privileges as granted to their own citizens, the Central Government notifies such countries to be Convention Countries. In case of an application for registration of a trademark made in any of the Convention countries, a priority date can be claimed with regard to the application in India, provided that the application is made within six months of

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the application having been filed in the Convention country. The Government has notified and extended this privilege of priority to the members who have ratified the Paris Convention on Protection of Industrial Property.

Documents needed for trademark registration : An authorization letter that is duly signed by you allows us to file for trademark registration on behalf of you. After receiving the authorization letter, we start with the preparation of your documents, file the application online and also pay for it. Soon, you receive the confirmation of the application, and you will get the right to use the TM symbol. While filing for the trademark registration, the documents you need to provide are as follows :

- Applicant's name
- Business type
- Business objectives
- Brand/logo/slogan name
- Registration address
- **Identity and business proofs :** The trademark owner or the person who is authorized by the trademark owner needs to submit their identity proof. It can be your Aadhar card, driving license, passport, ration card or voter's id.
- **Using logo with tagline :** If a trademark application is made for a tagline with only words there is no need of a logo. In cases where a logo is used, then it should be submitted in black and white format. The number of words in the logo should exactly be the same as mentioned in the

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- **Form 48** : On behalf of you, an attorney is authorized to file for the trademark application with the trademark registrar. The trademark user affidavit should be submitted in case a claim for the previous trademark was made in the application.

Madrid protocol : India Parliament has passed the Trade Marks (Amendment) Bill, 2009 for enacting special provisions relating to protection of trademarks through international registration under the madrid protocol. As per the Amendment Bill, from the date of the international registration of a trademark where India has been designated or the date of the recording in the register of the International Bureau about the extension of the protection resulting from an international registration of a trademark to India, the protection of the trademark in India shall be the same as if the trademark had been registered in India. The Amendment Bill is yet to be notified.

Classification of goods and services : For the purpose of classification of goods and services for registration of trademarks, India follows the International Classification of Goods and Services (Nice Classification) published by World Intellectual Property Organization (WIPO). For the purpose of classification of the figurative elements of marks, India follows the Vienna Agreement.

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Opposition proceedings : After advertisement of a trademark in the Trade Marks Journal, (which is available online at the website of Office of Registrar of Trademarks) an opposition challenging the application for registration can be filed by any person within a period of 3 months (which may be extended by a period not exceeding 1 month).

Renewal of registration : The trademark is initially registered for a period of 10 years, which is calculated from the date of filing of the application and in case of convention application, from the date of priority. The registration is required to be renewed within 6 months before the date of expiry of the registration, i.e., 10 years from the date of the application or subsequent renewals.

The failure in renewing the trademark within the stipulated period of time and a grace period of maximum 1 year granted for restoration of the trademark, automatically leads to removal of the trademark from the Register of Trademarks.

Rectification of trademark : An aggrieved person may file an application before the registrar of trademarks or to the Intellectual Property Appellate Board (IPAB) for cancellation or varying the registration of the trademark on the ground of any contravention or failure to observe a condition entered on the register in relation thereto.

The application for rectification can also be filed for removal of an entry made in register, without sufficient cause or wrongly remaining on the register and for correction of any error or defect in any entry in the Register.

Assignment, transmission and licensing of trademarks in India : Assignment means an assignment in writing by an act of the parties concerned. While in case of licensing, the right in the trademark continues to vest with the proprietor, the assignment of the trademark leads to a change in the ownership of the mark. A registered trademark is assignable with or without the goodwill in respect of all or only some of the goods/services for which the mark is registered. India is a member to TRIPS and Article 21 of the TRIPS dealing with Licensing and Assignment mandates that "... the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs." Section 39 of the (Indian) Trade Marks Act, 1999 allows for the assignment of an unregistered trademark with or without the goodwill of the business concerned.

Indian law contains embargo on the assignments of trademark, whether registered or unregistered, whereby multiple exclusive rights would be created in more than one person which would result in deception/confusion. However, the assignment with limitations imposed, such as goods to be sold in different markets, i.e., within India or for exports are valid. The Registrar is authorized to issue a certificate of validity of the proposed assignment on a statement of case by the proprietor of a registered trademark who proposes to assign the mark. The said certificate as to validity is conclusive unless vitiated by fraud.