

COURSE NAME- B.A.LLB 4TH SEM/ LL.B 2ND SEM
SUBJECT – CYBER LAW
TEACHER- MRS. AAKANKSHA
CONCEPT- INFRINGEMENT AND PASSING OFF

INFRINGEMENT AND PASSING OFF

Rights Of A Registered Proprietor

Registration of a trade mark confers the following rights on the registered proprietor:-

- The exclusive right to use the trade mark in relation to the goods or services in respect of which the mark is registered.
- The right to obtain relief in respect of infringement of the trade mark.

There are two types of remedies are available to the owner of a trademark for unauthorized use of its trade mark by a third party i.e. an action for passing off in the case of an unregistered trademark and an action for infringement in case of a registered trademark. An infringement action is a statutory remedy and an action for passing off is a common law remedy.

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:

- Appointment of a local commissioner, for search, seizure and preservation of infringing goods, account books and preparation of inventory, etc.
- 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.