

Trademarks

**Course Name – B.A.LL.B 4th
sem / LL.B 2nd sem
Subject – Cyber Law
Teacher – Mrs.Aakanksha
Concept - Trademark**

Property

❓ Property is creation of wealth by an individual which he can use and enjoy to the exclusion of others.

Intellectual property

- ❓ Intellectual property is property that arises from human intellect. It is product of human creation.
- ❓ Improvement or invention is result of intellectual exercise of a person.

Property	Intellectual Property
Movable , Immovable	Abstract form
Tangible	Intangible
Commodities, Products, land & buildings.	Ideas , Design, Poems , Music

Intellectual property Right.

❓ The right of an individual not to have his new product or process of making a product copied by others is known as intellectual property right as his invention is treated as his intellectual property.

Need and purpose of intellectual property right.

- ❑ To prevent the efforts of inventor proved as worthless by copying.
- ❑ Intellectual property right drives competitiveness & encourage innovation.
- ❑ For the benefit of inventor.
- ❑ Enforced Intellectual property rights protect consumers.

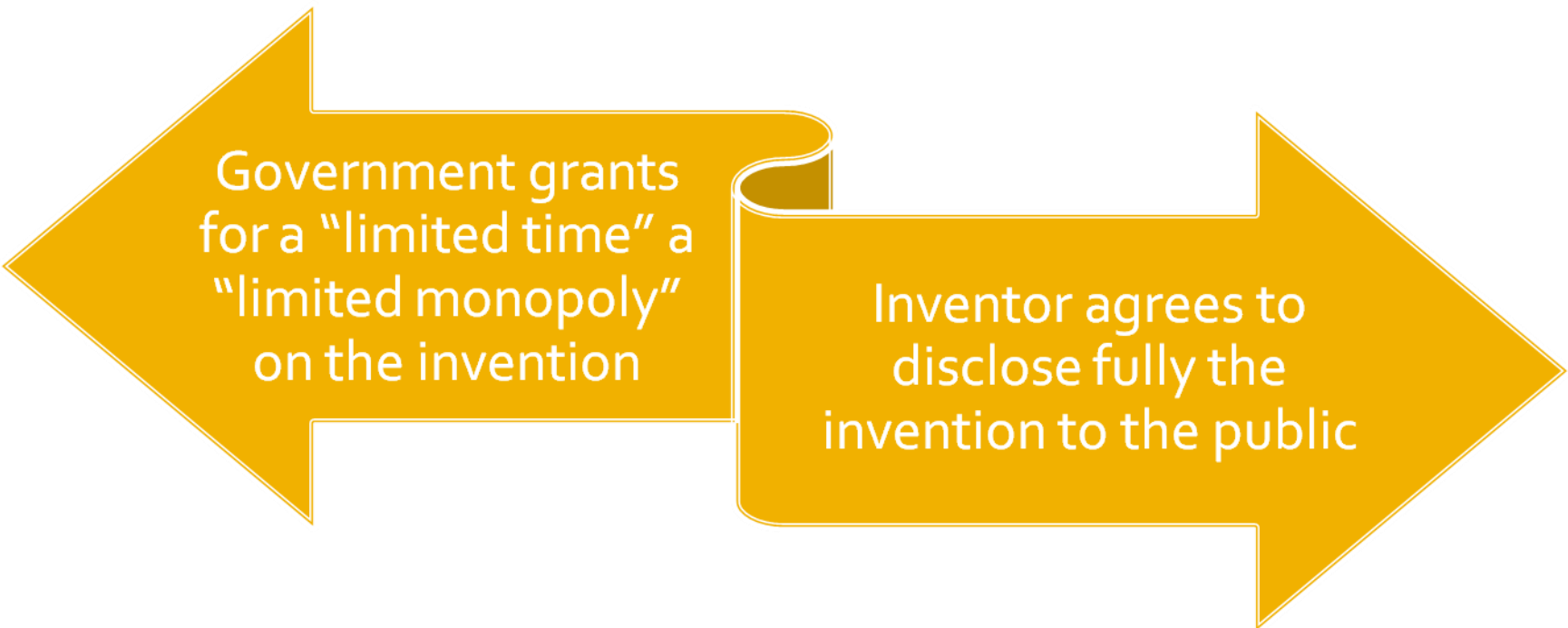
Classes of Intellectual Property

- ❑ Patent
- ❑ Copyright
- ❑ Trade mark

Patent

- ❑ Patent made for invention like new process or technology.
- ❑ A patent is a “contract” between the inventor and the Government (Patent Office).

Consideration



The diagram consists of two large, stylized, orange arrows pointing in opposite directions, connected by a central vertical line. The left arrow points left and contains the text 'Government grants for a "limited time" a "limited monopoly" on the invention'. The right arrow points right and contains the text 'Inventor agrees to disclose fully the invention to the public'. The central vertical line has a small, curved, tab-like shape at the top, resembling a staple or a piece of tape.

Government grants
for a "limited time" a
"limited monopoly"
on the invention

Inventor agrees to
disclose fully the
invention to the public

© Copyrights

A form of protection for original works of expression fixed in a tangible form, including *literary, musical, pictorial, graphic, sculptural, audio/visual works.*

Copyright does not protect an idea, only the expression of the idea.

📅 *First Act in 1914, followed by the Copyright Act 1957.*

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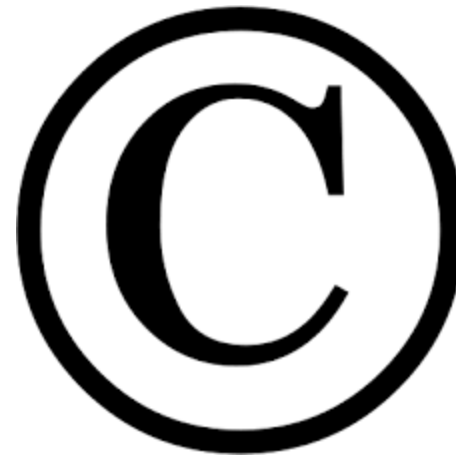
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First Edition : 2013

Published by : Mrs. Meena Pandey for Himalaya Publishing House Pvt. Ltd.,
"Ramdoot", Dr. Bhalerao Marg, Girgaon, Mumbai - 400 004.
Phone: 022-23860170/23863863, Fax: 022-23877178
E-mail: himpub@vsnl.com; **Website:** www.himpub.com

Features of Intellectual Property

parameter	Patent	Copyright
Term	20 yrs	60 yrs.
denotation		



What is a trademark?

A **trademark** is a word, phrase, symbol, or design, or a combination of these that identifies and distinguishes the source of **goods** of one party from those of others.

Evolution of Trademark

Formation of trade marks Act.

- ❑ Trademark Act 1940.
- ❑ Earlier it was governed by common law.
- ❑ Trademark Amendment Act, 1942, 1943, 1946, 1951.
- ❑ Trademarks Act 1940 was replaced by Trade and Merchandise Act, 1958.
- ❑ Trademarks Act, 1999.

Different trademarks.

❑ Conventional Trademarks.

It include letters, numerals, words, pictures.

❑ Unconventional trademarks.

1. Color trademarks.
2. Sound marks
3. Packaging trademarks
4. Holograms
5. Shape of goods.

1. Color trademarks

a. Single Color

Very unusual and peculiar in trade and can be recognized by traders and consumers.

Eg. Purple color of Cadbury in chocolate products category.

b. Combination of colors

Depends on uniqueness and what they are applied to.

c. Word marks constituted by names of colors.

2. Sound Marks

- ❑ Trademark may consists of a sound and represented by a series of musical notes with or without words.
- ❑ Depends on whether sound has became distinctive sign
Eg. Musical tone of Kingfisher.

3. Packaging trademarks

❓ According to packages also a product can be distinguished & that can be treated as Trade mark.



4. Holograms

❓ If holograms are capable of distinguishing the goods or services of one undertaking from those of other undertaking and are capable of representing graphically then they can be used as trademarks.

5. SHAPE OF GOODS

❓ Shape can also be used as trademark if it can be represented graphically. But there are certain cases where shape can not be used as trademark

1. Shape results from nature of goods itself.
2. Shape necessary to obtain a technical result.
3. Shape which gives substantial value to goods.

Functions of a Trademark

- ❑ Origin Function
- ❑ Choice Function
- ❑ Quality Function
- ❑ Marketing Function
- ❑ Economic Function

Why Protect a Trademark?

- Trademarks are protected under federal and state law
 - Trademarks are earned not born
 - Trademarks come into being through actual use
- You do not have to register a trademark to have it protected, but there are some advantages of doing so
 - A trademark registration provides:
 - **Constructive notice** to the public of the registrant's claim of ownership of the mark
 - Registrant's **exclusive right** to use the mark nationwide on or in connection with the goods and/or services listed in the registration

TM



Registration

CLASSES:

- ❑ There are 34 classes of goods and 8 classes of services specified under the act.
- ❑ Each class covers a range of related products
- ❑ A trade mark is registered with respect to goods mentioned in a particular class
- ❑ For eg
Class 15: Musical instruments
Class 25: Clothing, Footwear , Headgear

Procedure for Registration of Trade Marks

1. The applicant shall apply in writing to the registrar in prescribed manner , with necessary fees.
2. The registrar may accept the application absolutely or conditionally or may refuse to accept the same, in the case of conditional acceptance or refusal of acceptance, he shall state in writing the grounds for such refusal or conditional acceptance.

Continued..

- 3 Application accepted in error or under the circumstances of the case, may be withdrawn and can be taken as if the application has not been accepted.
- 4 After accepting, the registrar shall publish the same in the Trade Marks Journal, this is done so as to give an opportunity to the public to oppose the registration on the ground that the mark is likely to deceive or cause confusion.

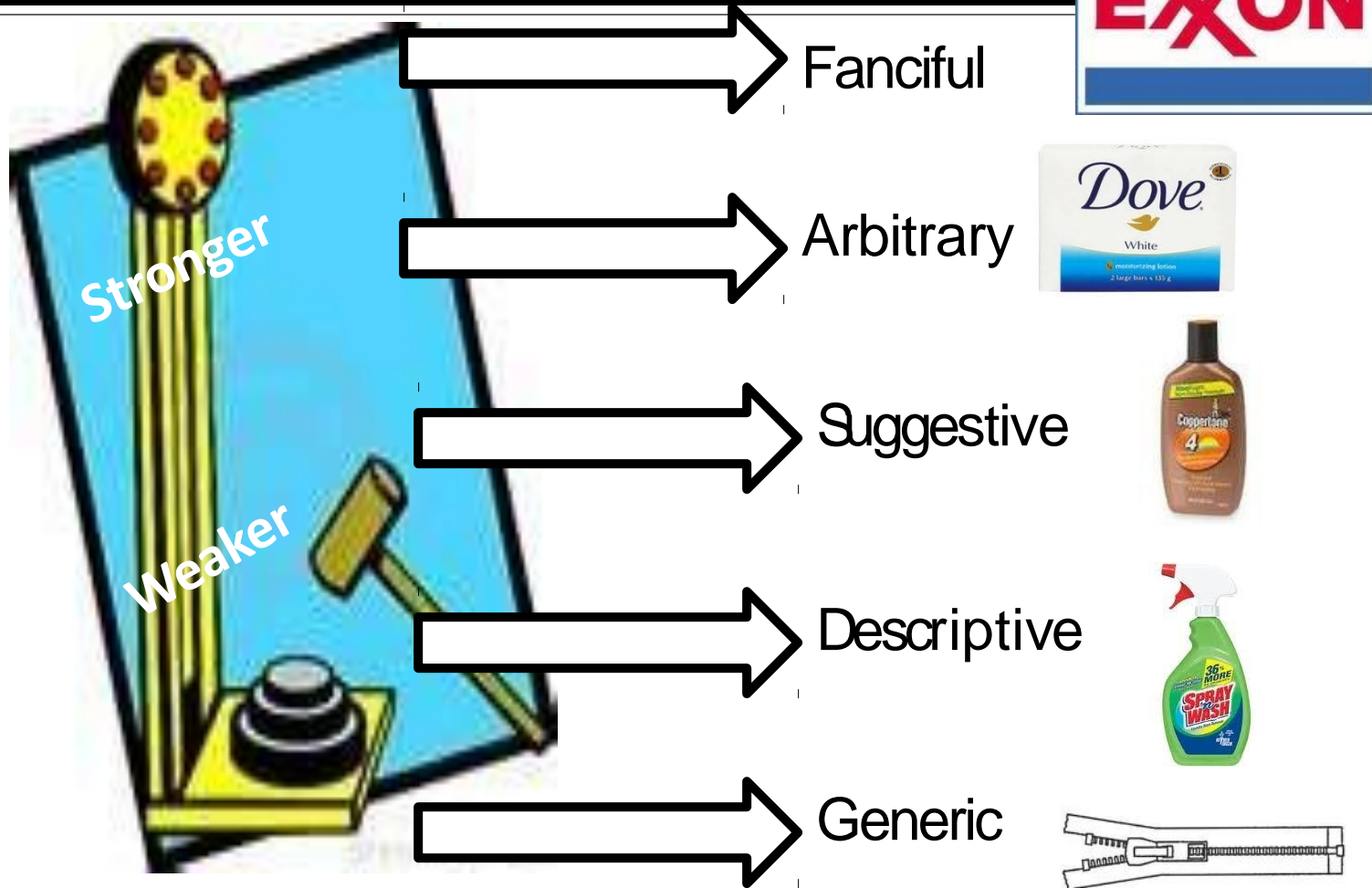
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5. In case of no opposition, the Registrar shall register the trademark and issue a certificate of registration with the seal of Trade Mark Registry.
6. The registration of a trade mark is valid for a period of Ten years.

Refusal for registration of Trade Mark-

1. Use contrary to law.
Example-National Flag, National Emblem, ISI
2. Descriptive or laudatory words
Eg. Trademarks exclusively of Marks or indications.
3. Confusion & deception

Spectrum of Distinctiveness & Levels of Protection



Continued..

- ❑ **Fanciful** marks comprise terms that have been invented for the sole purpose of functioning as a trademark or service mark. Examples include: Exxon, Kodak, Aveeno, Neutrogena.
- ❑ **Arbitrary** marks comprise words that are in common linguistic use but, when used to identify particular goods or services, do not suggest or describe a significant ingredient, quality, or characteristic of the goods or services. Examples include: Dove, Apple computers, Sun Microsystems, Tide.
- ❑ **Suggestive** marks are those that, when applied to the goods or services at issue, require imagination, thought, or perception to reach a conclusion as to the nature of those goods or services. Examples include: Coppertone, Jaguar, Greyhound,

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- ❓ A mark is considered merely **descriptive** if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. Examples include: Spray 'n Wash, Park 'n Fly, vision centre, sleepwell mattress.
- ❓ **Generic** terms are words used to name a class or category of a product or a service and are incapable of functioning as a mark. Examples include: zipper, escalator, aspirin, butterscotch.

New Trade Marks Act, 1999

Expansion of the meaning of trade Mark Infringement

- ❓ In earlier law it was possible to register trademark with same name but only in the different class. So sometimes it created confusion for the consumer.
- ❓ For E.g. For milk product “Amul” is the trade mark for Class 29(Class of dairy product). Now in class 29 no other person can register trade mark with name Amul.
- ❓ But they can register trade mark in different class. For E.g. “Amul” Table. This is according to earlier law.

❓ The scope of new law has been discussed under the following heads:

- a) **Similar Goods in different Class:** As per new law trade mark protection is provided across classes. E.g. “Amul”.
- b) **Dissimilar Goods:** Protection against trade mark infringement has been made available even in case of unconnected goods. E.g. Case of “Maruti” automobile & tissue paper.

c)Trade Marks in Advertisements:

- ❓ Expanded meaning of what constitutes “Use of registered trade mark”
- ❓ In the earlier law, a registered trade mark could be used only by attaching it to goods
- ❓ According to new act, Trade Mark is infringed not only by attaching it to goods , but also printing it on packaging material and using it in advertisements

Stringent requirements for registration:

- ❑ A trade mark will not be registered if it is identical or similar to an earlier mark of a similar good
- ❑ The similar goods may be in different classes

Well Known Trade Marks

- ❑ A **well known trade mark** is a mark used over particular goods or services, which has gained sufficient recognition among the consumers.
- ❑ The trade mark need not be registered in India
- ❑ Further, a mark can be well known trade mark even if there are no goods of that trade mark in the Indian market
- ❑ A mark to qualify as a well known trade mark, does not have to be known to the public at large

Actions taken in the case of Trade Mark Infringement

- ❑ Imprisonment which may extend to 3 yrs or fine upto Rs. Fifty Thousand or both
- ❑ Compensation is awarded taking into account the profits made by the offender and may vary from case to case

Cases in Trade Marks

1.

- ❓ The battle began when Cadbury's in April 2005 filed an injunction in Ahmedabad high court seeking to restrain the use of the trademark Eclairs by ITC against its product called Candyman Eclairs
- ❓ In a win for ITC Ltd, the Intellectual Property Appellate Board (IPAB) said that Cadbury India is no longer the owner of three trademarks containing the word Eclairs
- ❓ The three trademarks—Chocolate Éclairs, Orange flavoured chocolate éclairs and Chocolate Eclairs pop—were ordered to be removed from the trademarks registry as the patent board found that Cadbury could not provide evidence showing the use of the three trademarks after they were registered.
- ❓ The implication of this order is that Cadbury can no longer claim to be the owner of the trademarks, which means Cadbury in the future cannot hold anyone for infringement of these marks

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2.

- ❑ Dairy major Amul of Gujarat has won a trademark dispute with a milk producers' co-operative union in West Bengal, which sought to market a brand of milk named 'Imul'.
- ❑ The Intellectual Property Appellate Board (IPAB) has set aside an order of the Registrar of Trademark, Kolkata, registering the trademark 'Imul', holding that it is deceptively similar to Amul.
- ❑ The judges said The marks are no doubt phonetically similar, except for first letters *a* and *i*. When we consider the marks to be deceptively similar, the possibility of confusion is certain. The trademark, therefore, shall not proceed to registration."

Marks Declared Famous



Questions?