

17. LAW RELATING TO TRADE MARKS

- 1] A trade mark is a mark capable of distinguishing the goods or services of one business from another. It is a visual symbol which could be in the nature of a word, label, numericals, or combination of colours.
- 2] Some functions of trademark are as follows
 - a) It advertises the goods
 - b) It creates the image of goods
 - c) It identifies the goods & services and its origin.
 - d) It guarantees its unchanged quality.
- 3] First the selected mark should be capable of being represented.
It should be capable of distinguishing the goods & services of one undertaking from another.
- 4] It should be used as a mark in relation to goods & services for the purpose of indicating a connection in a course of trade between goods or services and some person who has the right to use the mark.

5] collection mark - A mark which distinguishes the goods & services of an association.

6] what are well known trade marks?

Ans → 1] A well known trade mark in relation to goods & services means a mark that has become so substantial to the public that the use of this mark in relation to other goods or services would likely be indicating a connection in the course of trade between those goods or services & the mark which has become substantial.

2] Google, Apple, Fillete are some examples of well known trade mark & they are protected, in India from any unauthorised use.

3] A well known trade mark are recognized in India on the basis of its reputation, both nationally as well as internationally, unlike other trade marks whose goodwill is limited to a particular geographical area, a well known trade mark has its across nation.

4] A new procedure is created by which a person can apply for designating his trade mark as well known, by making an application in form TM-M to the registrar with a request for declaring a mark well known.

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Q] Processing of trademark application.

1] A trademark typically goes through following stages before it gets registered

Step I: i) Decide upon a mark and then file an application in Form TMA. The first stage is the pre-examination processing

ii) Examination of a trademark is done in two stages, the first examination report is made by examiner and then the application and report is forwarded to the examination controller for his approval

iii) If the controller is satisfied of the report and the application, he approves it and then the application report, is issued to the applicant

iv) However, if there is any deficiency found then the same is noted by the controller and is referred back to the examiner for resubmission.

v) At this stage, the application may be accepted or may be objected.

vi) If it is accepted, it is posted in the trademark journals and if there is an

objection, the applicant is allowed thirty days to submit its response.

2] Step II: Post Examination Processing

- i) If there has been an objection in the pre-examination stage then the applicant needs to reply within one month failing which the application is deemed to be abandoned.
- ii) If timely reply is made, then the authorised officer may accept the application and post it in the trademark journal.
- iii) However, if the objection cannot be waived, a show-cause hearing is given to the applicant where opportunity of being heard is given and the final call is taken.

3] Step III: Post- Advertisement Processing

- i) Once the application is made and published in the trademark journal and there has been no opposition within four months from the date of publication then the

trademark become eligible for registration.

- i) The certification is issued automatically if no opposition is filed within the prescribed time.
- ii) However, if the trademark is opposed then it has to be disposed after giving hearing proper hearing opportunity to both the parties.
- iii) If the opposition is allowed then the application gets refused and if the opposition is dismissed the trademark moves for registration.
- iv) A trademark once registered is valid for ten years and which can be renewed again by paying the prescribed fees.

* Post Registration Trade Mark Management

- i) A registered proprietor is allowed to get post registration changes like the change of name of proprietor, address, assignment, registered user by making an application to the Registrar in the prescribed form and fees. (form TM-P)

2] In case the office has any objection or requires any compliances by the applicant and if the same are done then the changes must be made within the thirty days of compliance. However, if the change is in regards to the name of proprietor then the registrar sends a pre notice of thirty days to the previous proprietor and in this case the application gets processed after the expiry of one month.

Absolute Grounds for Refusal

1] The following grounds are the absolute grounds of refusal of Registration.

- a) Any mark which is complete devoid of any distinctive character
- b) Which consists of a mark which may serve to represent the geographical origin, the kind, quality, quantity or any goods & services
- c) Which consists of any mark, which has become customary in the current language or is used in the normal practices of the trade, shall not be registered.

2] Further following TM shall also not be registered

a) If such a trademark which tends to deceive the public

b) Any Trademark which hurts religious sentiments of the public of India.

Eg: In *Amrpal Singh V. Lal Babu Priyadarsi* in this case Ramayan was refused from registration on the grounds that it was not distinguishing the goods & services & secondly it was likely to hurt religious sentiments of class of society.

c) It comprises of obscene or scandalous matter

d) The use of which is prohibited under Emblems and Names Act

3] CASE: In *Himalayan Drug Company V/s SBL Ltd.* the dispute was regarding the word 'LIV' as to whether it is a generic word to render no protection to it

Facts of the case: i) Himalayan Drug Company is using its trademark 'LIV.52' from the year 1955 and has voluminous sales

- ii) It is so famous that people use the name 'Liv-52' to buy the medicine
- iii) The defendant started selling a similar product in the name 'Liv-T'
- iv) The lower court held that the name 'Liv' is too generic as it represents a medicine for lives

Judgement: In an appeal in front of the high court the order of the lower court was reversed where the court held that this is not a generic name and more so it is upon the defendant to prove that it is generic hence protection will be accorded.

Relative Grounds of Refusal

- 1] A trademark shall not be registered if a identity of the mark and similarity of the goods and services is resembling ^{an} to already registered trademark
- 2] The trademark is ~~is~~ similar to an ordinary registered trademarks and the identity/ similarity of the goods and services

resembles to the goods and services of an already registered trademark.

3] If a trademark is identical / similar to an already registered trademark but the goods are not identical / similar then the registrar may allow registration however he will not allow registration if the earlier registered trademark is a well-known mark

4] Nothing in this section will apply to a case where the registered proprietor has consented for the registration

CASE LAW: ITC v/s The Registrar of Trade Marks Calcutta.

In this case, the Calcutta High Court refused to register "Simla" as a trade mark for ITC as it was more of a geographical indication than the product and a Geo GI cannot be registered as a trademark.

* Miscellaneous

1] Where an application for registration of trade mark falsely suggest any connection with any person

living or whose death took place in the previous twenty years then the registrar shall not register the trade mark unless the same has been approved through Noc from the person whose name is has been used or the legal representative of the deceased person.

2] Where the application has been accepted but before the registration the Registrar finds the application has been accepted in error or that the trademark should not be registered then he may withdraw the acceptance and treat as if the application was never accepted.

3] ^{where} The Registration of trade mark has not been registered before twelve months because of default of the applicant then the registrar may after giving notice to the applicant treat the application as abandoned.

4] If the application has not been opposed or if there has been any opposition the same has been decided in favour of the applicant then the Registrar shall register the trade mark within a period of eighteen months from the application and shall issue a certificate of

Registration for the same.

* Infringement of Registered Trade Mark

1] A person shall be deemed to have infringed a registered trade mark if he uses a mark which is identical or similar to a registered trade mark and the registered trade mark has a reputation in India.

2] A registered trade mark is considered infringed when it is used by a person not being a registered proprietor or a user, uses in the course of trade a mark which -

a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark.

b) its similarity to an earlier trade mark and the identity or similarity of the goods and services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

2) When the mark is identical with the registered TM and the goods and services covered are identical and is likely to cause confusion on the part of public.

3) A trademark is considered infringed if any person uses such mark as his trade name or name of business while dealing in goods or services in which trademark is registered.

- 4) A person uses a trademark if he
- affixes it to the goods or packaging
 - offers such goods for sale or put them in the market under the registered trade mark
 - imports or exports the goods under the mark
 - uses the trade mark on business papers or advertisements.

5) A trade mark is considered infringed by advertising, if such advertising-

- Takes unfair advantage or is contrary to the honest practices

b) is detrimental to the distinctive character

c) is against the reputation of trade mark.

6] Where the mark of the defendant is identical or the goods are similar or when the trade mark is similar or when the trade mark is similar to the registered trade mark and the goods or services covered are similar or identical, then it may be necessary to establish that it is likely to be cause confusion on the part of the public.

7] However when the trademark is identical as well as the goods or services are identical then the court shall presume that it is likely to cause confusion on the part of public

* Limits on effect of Registered Trade Mark / When a registered trade mark is not infringed.

1] It shall not be considered infringement where any person for the purpose of identifying goods or services as those that of the

proprietor provided he uses it as for the honest practices and not to any unfair advantage

2) A Registered Trade Mark is not infringed where - a

a) The trademark's use shows about the type, quality, quantity, use of the goods or services

b) Where the trade mark comes with specific restrictions but the trade mark comes is used in a way that falls outside such conditions then it may not be protected and shall not amount to infringement

c) The use by a person of the trade mark in relation to the goods or services to which the proprietor of the mark of the registered user has permitted to apply the mark so as to indicate that the goods or services are connected with the registered trade mark

d) The use of the registered trade mark being one of the two trade marks registered under this Act which are identical or near resemble each other

Passing off

- 1] Passing off is an act of falsely representing one's own product as that of another in an attempt to deceive the potential buyers.
- 2] If a trademark is registered and there has been a violation then the plaintiff can move to the court under this act. However, if the mark is unregistered, the act recognises the common law remedy of passing off.
- 3] The rule of passing off is based upon the principle that no person is allowed to represent the goods and the goods of another man which deceives the purchaser.
- 4] The object of the remedy of passing off is
 - a) to protect the interest of the trade mark owners.
 - b) to protect the interest of the consumer or the purchaser of the goods.
 - c) to protect the social interest by

promoting fair deal & preventing unethical market practices

5] In an action of ~~is~~ an passing off the plaintiff as to establish

6] However, it is not required to establish any fraudulent intention on the part of the defendant.

7] Lastly, they only have to establish that the confusion is likely to cause damage to the reputation of the plaintiff but he need not prove any actual loss

CASE: Mahendra and Mahendra Paper Mills Ltd. v/s Mohindra and Mohindra Ltd.

The Supreme Court in this case stated that the act of passing off on the basis of unregistered trade mark can be decided on the following factors of the trademark

1] The nature of the mark i.e. if these are words, labels or composite marks.

- 2] degree of resemblance between the marks as well as if they phonetically similar
- 3] The nature of the goods in which they are used
- 4] class of purchasers who are likely to buy the goods
- 5] The mode of purchasing the goods

Registration to be Prima-Facie Evidence

- 1] Even if a trademark is registered it does not become a conclusive evidence rather it is just a prima-facie evidence this means that it's not the prior registration which makes you the owner it's the prior usage which makes the person the owner of the trademark
- 2] Therefore the owner of an unregistered trademark can lodge a case of passing off against a person who got the trademark registered.

Assignment and Transmission

- 1] A registered proprietor of a trademark can assign the trade mark for for any consideration
- 2] A registered trade mark or an unregistered trade mark can be assigned or transmitted either with or without goodwill
- 3] Further, that the restriction on the assignment or transmission of the trademark which creates multiple exclusive rights in favour of more than one person for the same goods or services which is likely to deceive or cause confusion
- 4] Nevertheless, such an assignment is not invalid if the goods are to be sold in different markets
- 5] Lastly, or if the assignment of goods are to be done without goodwill then the same needs to be approved by the registrar and also needs to be advertised as per the direction of registrar

6] Removal of trade mark for non-use → If a trade mark is not used for five years from registration the Registrar may remove it for non-use.

Collective Mark

It is a special type of trade mark used by the members of an association or group rather than by just by individual or company showing that the goods or services come from the members of a particular association and that maintain certain standards

Section 61 to 68 provides for the registration of collective mark and their use for thereof is used by members of association only

The association ensures compliance of certain quality standards by its members

The CA or CPA logo used by the members is an example of collective mark

Trade Mark Agent

- 1] Any legal practitioner, person registered as a trade mark agent or a person in sole or regular employment of the principal can become a trade mark agent.
- 2] A person to be qualified to become a trade mark agent should be -
 - a) Citizen of India
 - b) not less than 21 years of age.
 - c) Graduate in India
 - d) Considered a fit and proper person by the Registrar
- 3] Any person desiring to be registered as a trademark agent shall make an application in form TM-G.