

# PROTECTION OF TRADEMARKS

**WIPO TRAINING OF TRAINERS PROGRAM**

*Anuradha Maheshwari*

Dean

© Institute of Intellectual Property Studies  
Mumbai

**13<sup>th</sup> August, 2007**

# Why TMs need Protection?

- **Trademarks** form the organization's intellectual property- value of creativity & investment of intellectual process
- **Passing off** & unfair competition- people on the prowl to steal attractive popular TMs
- **Exploitation of TM**- leading to loss & dilution of brand
- **Erosion** of goodwill
- **Avoiding costs of litigation**

# Overview of TM Protection

## Bases

- Property rights relating to ownership
- Consumer protection- from confusion and deception

## Methods

- Use- In UK, India & other countries having similar TM systems rights can be protected for the use made of TM- *protection against passing off & unfair competition(US)*
- Registration-Registering TMs in a particular registry- *protection against infringement*

# Hierarchy of protection

- **Invented or arbitrary**- whether names designs or shapes- pure invention is the strongest.  
*Kodak, Exxon, Caltex*- pure invention, coined- legally strong, expensive to market  
*Camel, Tide, Apple*,- arbitrary, no co-relation
- **Suggestive marks** combine protectability with the power to communicate- Dove, Visa, Sunsilk, McDonalds
- **Descriptive marks** communicate ,are popular but are weak TMs-*Kwik-fit, Zip-lock, Sweet-n-low*
- **Generic marks** comprise simple product descriptions from generic terms- no one can lay claim-does not refer to source- *Gramophone, Aspirin, Xerox, Thermos*- generic use dilution of TM

# **Other weak marks**

- **Laudatory names-** Super, deluxe, Gold Medal flour
- **Geographical names-** Champagne, Bharat, Gujarat Ambuja, Bank of Baroda, etc.
- **Common names & surnames-** Smith, Bajaj
- **Letters-** which are also non-distinctive -IBM, L&T

# Passing off

- TMA'99- S.27 -“No action for infringement of unregistered trade mark...” .
- On the other hand a person whose goods and services have been passed off by another as his own is entitled to take action.
- Essence of passing off is not to grant an automatic monopoly in TM but to give legal recognition to an existing position.
- Protection of goodwill from dishonest competition.
- *Nobody has the right to represent his goods ( or services) as that of somebody else*

# Modes of passing off

- Direct false representation or adoption/imitation of existing TM of rival trader.
- Copying colour scheme or get up of existing label.
- Imitating a design or shape of existing goods.
- Adopting/copying of rival traders name.
- Holding out his goods/services as having some association with the plaintiff.

# **Essentials of passing off**

- **Misrepresentation or deceit**
- **Misrepresentation calculated to injure rivals business**
- **Plaintiffs must suffer damage to business or goodwill**
- **Registration of TM not necessary- action for existing marks**
- **POA is a common law remedy**
- **Common field of activity not required to be established**

# Infringement of Registered TM

- **Registered proprietor** can bring legal action for TM infringement & unauthorized use of his TM.
- **Infringing TM** is similar or identical or deceptively similar to the already registered TM.
- **Infringing TM** must be used in the course of regular trade of the registered user.
- **Infringing TM** must cause confusion or deception in the mind of the purchaser (likelihood of confusion is sufficient as opposed to actual confusion).
- Person not authorized to use TM.

# **Comparative Advertising**

- **Involves explicit use of a competitor's trademark- is a common practice in the West eg. auto sector, airlines & computer manufacturers**
- **Comparative advertising is also a commercial practice in India.**
- **New Act permits the use of a registered TM in advertisement thru s.29 provided,**
  - It is a honest practice.
  - Does not take unfair advantage of the distinctive character or reputation of the TM.
  - is not detrimental to the value of the TM.

# Why register your TM?

- **Monopoly rights**- to use registered TM in relation to services & prevent unauthorized use.
- **Easier enforcement**- 3<sup>rd</sup> party action taken far more seriously.
- **Use is not prerequisite**- do not have to establish reputation.
- **More cost effective**- infringement action far cheaper than action for passing off.
- **Unlimited life**- on renewal.
- **Deterrent factor**- because of the public record it's a notice to competitors to keep off.

# Registration of TM

- Practice & Procedures as according to Trademark Act 1999.
- Register of TM.
- Classifications of goods (sections 7&8).
- Examination Procedures- some have & some don't ( France, Austria, Italy & Benelux)
  - Absolute- whether application acceptable or not- examination- UK, US, Japan, Germany
  - Relative- conducting a research of their TM to check if there are any prior registrations of applications which conflict with the mark applied for- UK, US, Japan, Spain Scandinavia
  - India adopts both the systems- most countries

# Absolute grounds for refusal

- Being devoid of distinctive character.
- Consists exclusively of marks which designate quality, quantity, intended purpose, GI of goods/services.
- Consists of marks which have become customary in the current language or established practice of trade.
- Likely to deceive public or cause and hurt religious sentiments of the Indian people.
- Contains scandalous or obscene matter.
- Its use is prohibited under the Emblems & Names Act.

# **Non-registration**

*Further a mark shall not be registered if it consists exclusively*

- **Of the shape** of the goods which result from the nature of the goods themselves or of goods necessary to obtain a technical result
- **Is the name** of a chemical element or international proprietary name
- **Names of living persons or recently dead**

# **Relative Grounds**

*Registrar ‘may’ refuse*

- **Likelihood of confusion** with an earlier TM.
- **Earlier TM is a well known mark & new TM takes unfair advantage of earlier mark.**
- **Its use in India** is liable to be prevented by any law of passing off or any law of copyright.

# **Procedure for registration**

- Application
- Place of filing
- Acceptance or refusal of application
- Advertisement of application
- Opposition
- Registration
- Effect of registration
- Duration

# **Madrid Agreement & Protocol**

- **Paris Convention 1883-** minimum standards for protecting all forms of industrial property
- **Madrid Agreement 1891-** protection of International registration of marks.
- **Essentials-** registration in member countries through WIPO International Bureau within one year
- **Flaws-** too many & not acceptable by many countries.
- **Madrid Protocol 1997-** built on flaws of Agreement with better mechanisms & longer time for registration
- **India** will be joining the Protocol soon.

# **Rights of a trade mark holder**

- Right to exclusive use
- Right to assign
- Right to seek legal remedies against infringements
- Right to seek correction of register

# **Legal remedies**

- **Civil remedies** includes
  - Injunction- preliminary & permanent
  - Damages with or without delivery of infringing labels- actual damages, defendant' profits & costs
- **Criminal remedies** includes punishment and fine according to the nature of the offence

# **Principles of Trade Mark Management**

- **Your company's trademarks are valuable and important assets.**
- **Know and use the legal protection available**
- **Always use an adjective trademark without pluralising it.**
- **Indicate a TM clearly in print.**
- **Use the word 'registered' with the symbol ® or ™**
- **Be alert & vigilant against infringement of your mark.**

# **Trademark Due Diligence**

- Does the your company use marks for their products or services? Your own or licensed? If licensed what are the terms? Are these marks registered?
- If yes, then have you /your licensor paid fees? Is documentation proper? Has the mark been renewed or when does it come up for renewal?
- If no, than have you/they filed for protection? Have you/they searched for conflicting marks? Have you/they advertised or taken action to strengthen such mark. Are you/they using correct symbols to denote your/their marks?
- Have you/they been licensed? What are terms of such license? Are you/they Registered Users?
- Are there any notices or Litigation?

# ***THANK YOU!***

Anuradha Maheshwari

Email: [anuradha@iips.ac.in](mailto:anuradha@iips.ac.in)

