

**Entrepreneurship and IP Strategy**  
**Professor. Gouri Gargate**  
**Rajiv Gandhi School of Intellectual Property Law**  
**Indian Institute Of Technology, Kharagpur**  
**Lecture No. 14**  
**Trademark - Registration**

A very warm welcome in the fourth module of the 3rd of the course entrepreneurship and IP strategy title trademark infringement. Now, we know by this time what is trademark, whether I need a trademark as an entrepreneur what advantages I will get if I will have a trademark? what are the types of trademark,? how to register trademark? We hope that you are ready with now your application for a trademark.

Now, we will try to know the crimes and legal activities which happen related to trademark and what actions you can take against such crimes. So, now the next say 25 to 30 minutes After going through this module, you will understand that what are the crimes or illegal activities that happened related to trademark, what remedies if someone had to take if any such copy or infringement happened.

You will also become cautious while choosing your trademark by knowing this particular infringement or passing a passing off, you will be cautious that my trademark should not be suffered because of this infringement or passing off. So, you will develop your trademark in such a way that there will be that less chances of for infringement. So, here we go. So, we quickly go through now a few trademarks. check here.

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Adidas is there check this. Now are you able to find the difference between the original trademark and the duplicate. I am using a layman language as a duplicate in legal language if I want the same, I should say, are you able to differentiate between trademark of a trademark owner and a trademark of a infringer are able to do that thing? So, I used them here infringer.

So, the question is what is infringement? Let us see. Now check this again and observe the manipulations done by the infringer.

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So, carefully watch this adidas and adidas. So, you can just see the difference of A and O. But you just imagine if any illiterate person who is not aware about this language, probably he will get confused with this name and what will happen? Suppose Adidas is getting say 100 percent share of the market. Adidas which is a infringer, that infringer will pull the benefit of the business of Adidas and that share from 100 percent it may take 50 percent it may take 40 percent it may take 30 percent.

So, that share will be pulled by that particular infringer for in that particular locality where that infringement happened and that infringer will get benefited and the original owner will get hampered his, his or his or her sale, whosoever is the owner and maybe individual maybe organization that cell will be hampered.

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Now checked another example, Pizza hut and Pizza huh, I do not know how I should pronounce. They have just made a change like hut to huh a single word is changed. This is a big infringement. Probably you and me also get what we can say confused because of this kind of writing.

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Next example you check Jack Daniels and John Daphne here it is a complete what we can say the trade dress is completely copied. Ok See the another example favourite McDonald's.

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So, it is written as OMC McDonald. So, what they have done with that one more half circle I will say that one more that half circle, it is there in this infringer's trademark. So, obviously, probability is that you somebody may definitely get confused because of this kind of a representation. And they will think that, ohh this is a original McDonald. Check this, this is a most funny one you can see.

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Starbucks and a Starbusksh ah Sardarbuksh. Starbucks. It is not a Starbucks also it is a Sardarbuksh. So, what the thing happened here, this, you can just check the image also. So, image is of Sardarji as you can see inside of that image and the word Starbucks is written like a Sardarbuksh and here they have written like established also.

So, it looks like a very authentic trademark and it is like a clear cut what we can say infringement and Starbucks have filed case this is a very popular case actually.

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So, now, after knowing this kind of a infringement, check this another example of a “make my trip” and “get my trip” that that that you can see that my trip is very common and they have changed the word like make and get.

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Now here is another example of a Paytm and PayPal. Now I have not marked here with that red circle. Here, what I will suggest you that you just find out that who is aggrieved party? So, this case is like a very it is a case where one party filed a case against another PayPal and Paytm. Probably, you know both these what we can say the, what we have that that is the thing, but these are like in the in this current scenario for online mode payment, these two are very popular, you find out who is original one and who has copied that trademark. This is your assignment.

So, you know now that two things; how infringement happened and how wisely infringer do this infringement. So, these two things you have seen these examples, that how infringement happen and how wisely because a Starbucks example you see, it is a very classic example how they have done the infringement. Second, you may become alert now as an entrepreneur to check what possible combinations are possible. If someone copy your trademark.

I have, in the start, only I have suggested you that this when you go through this module you will come to know that what caution you will take while designing your trademark. So, here you can appreciate or you will try to understand what are the possible combinations possible combinations somebody can think of after seeing your trademark? So, you can think of that particular what we can say combinations and there is some



strategy that you can register that all trademarks which are possible related to your trademark that is one of the strategy many of the organizations follow that thing.

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Now, ok, so, you may say that this infringer are ignorant. So, they probably not know that symbols which are used and now you can see on the here the symbols like a “TM” or “R” or “SM”. Do you know meaning of this symbols? Any idea? R is as a registered trademark offered or TM is a registered trademark you just just think whether R is a registered trademark or a TM is a registered trademark and what is that SM stands for any guess?

So, TM is like the meaning is like this, trademark if it if some if you see the sign like or TM, the meaning is that this trademark application is filed that is a meaning. R the meaning is that this trademark is registered the process is completed, application is examine and this particular trademark is now registered. So, that is R and SM, I will give you a hint here, SM is related to class 35 to 45 off a nice classification. Can you guess what SM is?

So, SM is related to surface mark. Sometimes it is SM is use but many times you will TM and R, which is very common. So, you will say that these examples whatever the whatever are there probable they are ignorant about that, but I will say you that you can

see this TM or R on the most of the trademarks if it is an application process or if it is a registered. So, it is a willful act of infringement. I can clearly say because these are the case, landmark cases or important cases related to trademark, this is a willful infringement.

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Now, check this, whenever you move around you, you are surrounded by a number of trademarks, check the cars here on the road, or the shops or a products in the shop or hotels or bank buildings around you. Everywhere you can see trademark in school, I am just giving you the analogy. In the when in the school time you see that sentence is very common “air is everywhere”. So I will say that trademark is everywhere you just check around and you will see trademark is everywhere.

Now wherever you are watching this video, you please check around you, find out if there is any trademark, I am sure you will see at least one trademark. Right Please list down 1, 2, 10 trademarks or not a maybe more than that also. Is there any anyone who is who will say that there is no trademark around me. Are you sure when you say that there is no trademark product around me?

I am sitting in the garden or I am sitting on the river side and I am watching this video. Now I will say, that please watch your device on which you are watching this video.

Check the trademark on it. Whether it is Apple, HP, or Samsung or Dell, what it is. So, in short you can see that anywhere you go trademark you can see around you similarly, most of the IPs also in every device, every product you are using chances are there that trademark will be there or patent will be there or some copyright will be there some more than other IP is always there in any of the product or services you are using. So, now the question is what is infringement?

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After seeing all this background now, we will just go in a deeper and we will try to understand what that infringement is. So, trademark infringement is an unauthorized use of a mark or reference to a goods or service. So, whatever mark is there, trademark is there is an unauthorized use. This unauthorized use may create a confusion or it may be deceptive or it may be mistaken by a consumer. This is going to happen.

So, trademark infringement in India, how it is defined. It is define in Section 29 of trademarks act 1999. So, who is unauthorized person? Unauthorized person or organization means, someone who is not always the owner or the licensee of the Registered Trademark, you should know that trademark is a intangible asset. So, there is a possibility of license. So, if you are not owner and if anybody is not a licensee and still they are using the trademark, then this is a case of infringement.

Now, what is a test for that deceptive or identical? Simple test is if it creates confusion in mind of public if that confusion are likely to get confused between the two marks, then, this is called as a infringement simple litmus test confusion of a consumer or a customer, we will check details in our short file, what that infringement that details we will look.

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Now, the infringement can be direct or it may be indirect infringement. Now, direct as mentioned earlier, that is defined in Section 29. What do you understand by indirect infringement? It is like also known as a secondary liability. It may be a contributory infringement, or it may be a vicarious liability. So, what is the meaning of this contributory infringement or a vicarious liability? A person may be liable for contributory infringement in two circumstances, when a person knows the infringement, and when a person materially contributes or induces direct infringer to commit infringement.

So, this is called as a contributory infringement. I again say this thing that what is a contributory infringement? Person knows the this is a infringement and still helps in that infringement process or the person materially contributes or induces that infringement. So, this is a contributory infringement. Now, next is a vicarious liability. Now when the person has the capability to govern the actions of a direct infringer, this is like a person is capable of controlling that person that who is doing the infringement activity.

Still, that person has not taken effort to control that thing or second when a person drives a financial benefit from that infringement. And therefore, although he is aware about that infringement, he is just keeping mum is not taking any action. Third cases like when a person has a knowledge of the infringement and contributes to it. If any of these three acts are there one that is capability to govern, but he is not taking action, he getting financial benefit, and he has a knowledge of that infringement, that is a what we can say vicarious liability.

So, either it will be a contributory or vicarious. So, employer and employee, this is a very good example I can give you about the vicarious liability. So, in this relation if you see if employee do infringement, and employer is not taking any action, and if any case will file employer if he says that I am not aware about this thing, no, this is not accepted. Your vicarious liability is there your employee is doing the infringement and how you are not aware about this thing. So, this is a vicarious liability.

On the whole this indirect infringement takes place in generally, when a person though not indirectly infringing that particular what we can say infringement is not directly but he or she induces other person to infringe a trademark. So, I guess you understood what is that direct infringement is and now, this like an indirect infringement, where contributory or a vicarious liability is there.

With the increase in e commerce enterprise liability for indirect infringement holds every person to be accountable. So, many times we have to remember that e commerce is there platforms are there on that what we can say online platforms, some e commerce is going on probability is that, that platform owner may not be aware about this infringement, but as per what we can say law, he is contributing in that particular activity. And so if any infringement case will what we can say initiated at that time this person or a platform on that or may be in a trouble.

Ok Now, whether direct or indirect, in both the cases in India there are remedies and the legal what we can say legal action will be attracted against infringer. So, if anyone is infringing your trademark directly or indirectly, you can initiate legal action.



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So, here what you can do, which are the illegal actions you can take that either there may be a civil action or a criminal action that we will go in details, but before that, you check here that infringement and passing off. So, this infringement we have understood now, what is the meaning of a passing off? There may be some unregistered trademarks. So, there is a possibility that some business is going on without a registered trademark absolutely possible in India it is completely allowed.

It is not like a patent in patent first two file is important then only you have to practice you are allowed to practice that patent otherwise your patent it will come into public domain. But considering trademark if it is unregistered trademark, it is absolutely fine if what happens that unregistered trademark first we will try to understand what that unregistered trademark is that as per definition, it is a mark which are not registered in relation to goods or service.

Now, here this unregistered trademark does not possess a legal benefit considering a Trademark Act. Now, as it is not registered as per Trademark Act, it will not get any benefit. So, what is a remedy in that particular scenario, the possibility is that owner have not registered but his or her business is established in the local market and someone copy that unregistered trademark. So, what is a remedy? Unregistered trademark can still be

protected by means of common law for tort or passing off. So, many times you heard that word like a passing off. This passing off is related to unregistered trademark.

So, in such cases, chances are unregistered trademark get benefit of a common law. To succeed in such an action it is necessary to establish that unregistered trademark has comparable goodwill or a reputation, in connection with the product, service or a business with which it is used. The action against passing off is based on the principle. This principle is a man may not sell his own goods, under the pretence that they are the goods of a another man.

So, this is a principle for the passing of when you initiate the action in a court of law. There are certain essential ingredients related to passing off. Plaintiff has to prove that who is a plaintiff who is filing the case. In short, I am just giving you the idea and I do not want you to take into legal words. So you just remember that plaintiff who is like, who is the applicant in the court, I am giving you the meaning in a very what we can say layman's language.

So here, the plaintiff has to prove that there is a similarity in the trade name. And the defendant that who is infringer is deceptively passing off his good of or a as those of a plaintiff there is bound to be confusion in the minds of consumers customer that is a next what we can say confusion is a very important. The test applied in such a matters is as whether a man of average intelligence, so, how court or judge will look into this matter? That judge will just check that the person or a man or any individual of average intelligence, average intelligence that is very important.

Because in patent, I am just relating it so that you can get a differentiation in patent when we say PHOSITA, we see that it should be comparable that if your it is a mechanical domain, person in the mechanical domain, that that knowledge should be there in trademark what is happening, average intelligence of a man is taken into consideration and based on that the confusion or any deceptive action of a infringer will be checked.

So, the basic difference between the two that is a infringement and passing off is terms of protection available for Registered Trademark And Unregistered Trademark both are like

illegal actions. One is against Registered Trademark one is against Unregistered Trademark, Ok registered infringement unregistered passing off.

Now, former is like a statutory remedy and a latter is a common law remedy. Ok So, I guess you can understand by this time you have understood what is a infringement and what is a passing off now, here we will see an interesting video.

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Now we will watch this video this video. We will just check 4 landmark cases are there. So. you enjoy this video.

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So, I hope you enjoyed the video.

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Now, next question is, if your trademark is infringed, what is the solution? There are two types of remedies provided in case of infringement or passing off of a trademark. Plaintiff or you may be if, unfortunately if this happened with you as a entrepreneur have a option to initiate civil or a criminal action. With the registered or unregistered plaintiff can initiate action, he or she shall file a case in a district court having jurisdiction to try this suit.

Now which District Court, where the head office of plaintiff is situated or where the cause of action has arise, because it is not your product may be sold anywhere in the country. So, wherever that action cause of action is arise, there you can find the case or wherever your offices there. Court can give ex party or interlocutory injunction. So, the major means or the remedy may be ex party decision also there is a possible interlocutory injunction is also order may also you get now, this injunction order maybe for discovery of a document, it may be for preserving of infringing goods, documents or restraining the defendant from disposing assets, which may cause adversely the plaintiff.

So, what the thing is happening that in any of these 3 scenarios what happened when you start a action possibility is that you will require proofs. If anybody has done the infringement, you will require proof. So to get that proof, to preserve that goods, to get the documents, this interlocutory injunction order is a what we can say court can give you

that you can just get that order from the court. Now, in a suit for infringement or passing off, if the court agreed and the case is proof that infringement occurred, court can grant a damages.

In case of criminal if a, so, please note that according to Section 104 any person who helped the accused is a criminal means in this case they are of a trademark infringement. Now, what that person that helped means what exactly that person has done, he may be help in selling or maybe hiring that services, maybe he may be possessing that goods. So, in any case, that person is committed a crime, he will be punished with imprisonment for a term, which shall not be less than 6 months, but which may extend up to the 2 years and with a fine, which shall not less than 50000 and that fine may extend up to 2 lakh.

So, just remember that the punishment is like no less than 6 months of imprisonment, no less than 50000 rupees fine. So, that is a minimum what we can say what the punishment infringer or criminal in this case I can clearly say that infringer or a criminal have face. For the second if second time if somebody do that particular activity, then this limited that lower limit of 6 months, it goes up to minimum imprisonment of 1 year and that fine may go up to 1 lakh minimum 1 lakh fine is there.

Now, there is a possibility that if court can order or a authority can have a means police officers they have a authority to do a forfeiture offer goods also. So, they can take goods in their control, they can do the forfeiture of a goods also. Now, sometimes it may happen, that may be unfortunate scenario, that you face a situation, that police officer refuses to register a FIR in case of a trademark, there might be any reason, whatever the reason is there, then what you will do in that case, you can file a complaint before the magistrate under Section 156 of a CRPC that provision is also there.

So, you can imagine this trademark, it is like, if anything happened to your property say flat or bungalow, immediately you are taking action. So, similarly, if anything happened to your trademark, you can take criminal action or civil action, you have seen what punishment is there. Either there may be imprisonment or there may be a fine or both. That is a criminal if you file a criminal case, if civil action you initiate you will get a damages.



So, this is to summarize here, it may be a legal action either a civil or it may be a criminal, you may get temporary injunction, you may get permanent injunction, you may get damages, you get account of profits, what is the meaning of account of profits? Damages in the amount of earnings, which are received from the infringement that can be calculated you can claim that particular amount, then, destruction of goods, the usage of infringing mark, complete destruction of goods after forfeiture, then you may ask for cost of legal proceedings.

So, in the case of criminal proceedings, the court announced the following punishment of infringement or fine. So, civil remedies, criminal remedies and what benefits you are getting after civil action and what benefits you are getting after criminal action. I guess you got the idea about these to proceedings. Now the last we will move towards a last point, that unfortunately, if you want to initiate a court case, which specific factors court will look into?

So, you can see in the next like a that, which are these factors, we will not go in details of that, but I will mention it here, so that it will be useful for you to design your trademark accordingly.

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So, these are like this factors are first strength of the mark, second proximity of the third similarity of a mark, fourth proof of actual confusion fifth marketing channel, sixth type of a product and what we can say the clear possibility to be exercised by way of the purchaser that is a sixth one and the seventh one is a different times intent in selecting the mark and the last likelihood of growth of the product line.

So, these are the 8 what we can say you can see that 8 what we can say the things or the points which this which will be seen in the court of law. Now, probably now, after going through this details, I guess it is not that much heavy, but you just see I just summarize what we have seen. You have seen that examples, then how infringement is happening, then what is that infringement meaning of infringement.

Yes, registered, passing off is related to unregistered. Ok. Next we have seen direct infringement, indirect infringement. That is a contributory or vicarious. Ok Next point we have seen civil remedies and criminal remedies and then we have seen these 8 factors. ok Now, after knowing this much details, we come to the end of this module. Probably now, you are by these 4 modules, you are very well aware now about trademark basics, then types of trademarks how to file trademark that procedural part we have seen in the earlier module and in this module we have seen infringement passing of civil criminal remedies and how court look into the matter if whenever case will be that trial is going on.

So, with this, we are coming to the end of this module. So, please check the assignments you have done in that earlier weeks also, we have given you few assignments, when that related to every week we have asked you to check what is the difference between brand and trademark. We have suggested you that propose your own trademark for your venture, then ready with the registration process when you have gone through the registration process and now we have gone through this infringement related details.

So, I will suggest you now revisit all the tasks we have done and refine your trademark for your venture. So, here we come to the end, see you in the next session. Thank you.

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