


Intellectual Property
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Lecture - 44
Trade marks in India

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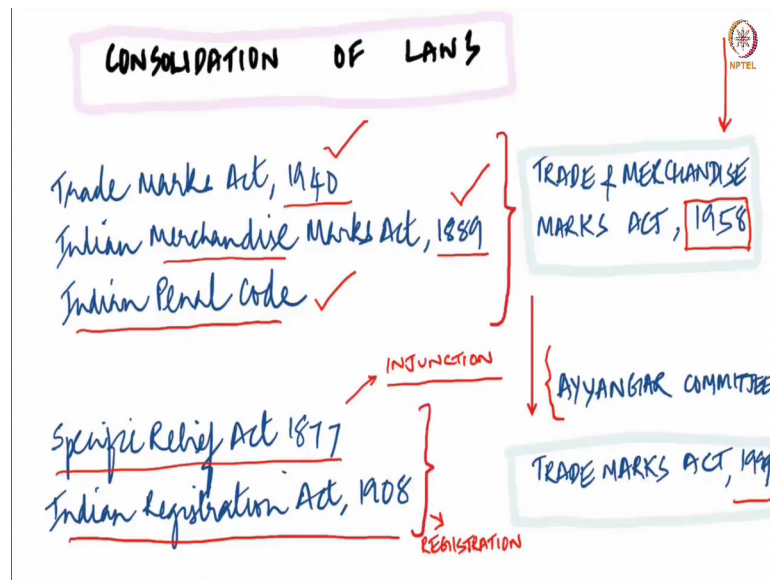
History in India

- Earlier, no mechanism or law
- Criminal Law [IPC]
 - Offences relating to documents and property marks
 - Offences relating to property and other marks
 - Repealed, Trade Marks Act, 1958

As we had already mentioned, there was no mechanism or law for protecting trade marks. Initially there was a provision under the Indian penal court, which is a part of the criminal law; which pertained to offenses relating to documents and property marks, and it also had offenses relating to property and other marks. These were the provisions by which if someone used a mark without authorization that was regarded as a criminal offence. So, there was a penalty attributed to a person who uses a mark without authorization.

Now, this was repealed from the criminal laws; when the Trade Marks Act, 1958 was enacted. So, when the when we had a special regime the provision which criminalized unauthorized use of marks was removed from the criminal statutes, and it was now a part of a separate act in itself. So, the act the first act that we have is the Trade Marks Act, 1958.

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Now, if we look at the laws pertaining to trade marks, we can see a consolidation of laws happening over a period of time. First, there was the Trade Marks Act, 1940 which existed during the British time. And there was also an Indian Merchandise Marks Act merchandise we had already mentioned that trade in goods or services could also refer to merchandise; which again is a British act which existed in 1889, since 1889 and as we have just mentioned we had provisions of the Indian Penal code.

Now, all these 3 acts or provisions were replaced when the trade and merchandise marks act was enacted in 1958. So, 1958 was the first act passed by independent India, and it replaced the 1940 act, the 1889 act and some provisions of the Indian penal court. Now before the 1958 act, if there was a need to stop a person who was using a mark, you would use the Specific Relief Act 1877 and get a permanent injunction. So, injunction was the relief a trade mark holder could get against a person who was unauthorizedly using the mark.

So, you could get an order from the court to inject the person from using that mark. And anything that pertain to registration was covered by the Indian Registration Act. So, registration matters of registration was covered by the Indian Registration Act, 1908, and matters pertaining to infringement was covered by the specific relief act.

In the 1958 act had been in operation for close to 4 decades, and the act was replaced by the 1999 trade marks act to bring the Indian law in compliance with the obligations under

the world trade organization; when India became a member of World Trade Organization since, 1995 they brought the trade mark regime in compliance with the requirements of the trips agreement, and the 1999 act was passed to bring the law in compliance with the trips agreement.

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History in India

- Trade Marks Act, 1940 ✓
- Trade Marks Enquiry Committee
 - Trade & Merchandise Marks Act, 1958
- Trade Marks Act, 1999
 - Comprehensive review of existing law
 - Development in trade practices
 - Give effect to imp judicial decisions

So, just to recap so, we had a Trade Marks Act of 1940, then there was a trade marks inquiry committee; which was headed by Rajagopal Iyengar the Iyengar committee. Pursuant to the recommendations we had the 1958 act. The 1958 act existed for close to 4 decades, and then we had the 1999 act which brought the law in comprehends with the obligations under the trips agreement.

Now, the this was based on a comprehensive review of the existing law, and in tune with the development and trade practices, and to give also effect to important judicial decisions which came in the 4 decades after the 1958 act.

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Salient Features

- Trade Marks Act, 1999
 - Enlarge scope and definition of trade mark
 - Improvement in procedure of registration
 - Period of protection made to 10 years
 - Introduced registration for service, well-known, and collective marks WTO
 - Infringement suit, where plaintiff resides

The 1999 act has certain features which were not there in the 1958 act. It enlarged the scope and definition of trade mark, it improved the process of registration. The period of protection was enhanced from 7 to 10 years, now you had to renew a trade mark every 10 years earlier it was 7 years. It introduced registration for service well known marks and collective marks. This was not there in the 1958 act and this was again in compliance of the obligations under the world trade organization.

And importantly now an infringement suit can be filed where the plaintiff resides so, earlier it had to be where the infringement occurred or where the defendant resided or carried his business now it could be anywhere where the plaintiff resides.

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Fundamentals


- Jurisdiction
 - Extends to whole of India
- Term
 - 10 years, if registered, renewable
- Rights conferred by registration
 - Exclusive rights to use the mark
 - For registered goods and services

Now the jurisdiction of the 1999 act, it extends to the whole of India, the term of renewal as we just mentioned, if it is registered, it can be renewed every 10 years.

So, a trade mark can be kept alive in perpetuity as long as it is renewed, and as long as efforts to protect it from entrainment are also done. Now the rights conferred by registration include exclusive right to use the mark for registered goods and services. So, your right to use the mark is confined to the goods and services for which it is registered.

For example, if you have registered a particular word for say trade in goods covering a particular kind of goods; say, shoes you may not be allowed to use that mark for selling stationery, unless you have a registration covering that class as well.

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Fundamentals

- What is a good trade mark?
 - Easy to speak & spell
 - Appealing and easy to remember or recollect
 - invented or coined word, unique monogram, logo or a geometrical device

What is a good trade mark? A good trade mark as a mark that is easy to speak and spell, because at the end of the day a trader though he coins the trade mark it should be used by the users or the general public.

And it should be appealing and easy to remember or recollect. It can be an invented or a coined word, because dictionary word and generic words are not allowed as trade marks in the normal course. And you can have a unique monogram logo or a geometrical device representing the trade mark.

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Fundamentals

- Avoid using
 - Laudatory or descriptive matters
 - Geographical names, common surnames, names of a community or persons
 - a matter prohibited by law to be used as a trademark
 - a matter that is same/similar to an already existing trademark in the market

Now, certain things that you should avoid are laudatory and descriptive matters. So, laudatory and descriptive matters are not granted trade mark. Geographical names, common surnames, names of community or persons should be avoided. Geographical names cannot be a subject of trade mark, but goods coming from a particular geographical territory can be protected by GI or geographical indication; which is another subject that we will be covering.

A matter prohibited by law to be used as trade mark cannot be used as a trade mark. A matter that is same or similar to an already existing mark. Because that can cause confusion or it can lead to what we call deceptive similarity. And that can be a reason for an infringement action.

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Fundamentals

- Meaning of a trade mark [S.2(1)(zb)]
 - “..means a mark capable of being represented
1 graphically and which is capable of
2 distinguishing the goods or services of one
person from those of others and may include
A shape of goods, their packaging and
C combination of colours..”


Trade mark is defined in section 2. It means a mark capable of being represented graphically. So, graphical representation is key for a mark and which is capable of distinguishing goods and services.

So, it can be represented and it distinguishes goods and services of one person from those of the other, and may include shape of goods, it may include their packaging and combination of colours.

Now, these were definition, now these were introduced by the new definition. So, a mark is something that can be graphically indicated represented graphically, and it does the

function of distinguishing goods and services. Now so, what can be graphically represented, what can distinguish goods and services from one person to another this regarded as a trade mark. It can include shape of goods like the Coca-Cola bottle. It can include packaging material. Now there are some packaging materials there are unique to a particular product that can also be covered. And it can also cover combination of colours.

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Types

- Word Marks
 - Rights claimed only in the word, letters or numbers
 - No rights claimed in manner how these words are presented
- Service Marks
 - Word, phrase, symbol or design, or a combination thereof
 - Identifies and distinguishes the source of a service rather than goods

Word marks claim the right to use the word alone, or letters or numbers. There is no right claimed in a word mark in a manner on how these words are presented. So, word marks are marks which pertain to a word alone, and it gives the right only for the use of the word or the letters or the numbers. Service marks are word phrase symbol or design or combination of any of these. And they are used to identify and distinguish the source of a service rather than goods. So, good marks are used for recognizing goods whereas, service marks are used to recognize this source of the service.

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Types

- Collective Marks
 - Distinguishes the goods or services of members of an association of persons
- Certification Marks
 - Certified by the proprietor of the mark
 - Origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics

Collective marks are used for distinguishing goods or services of members of an association of persons. So, they collectively use a mark certain trading communities or certain trading bodies, would use mark and would allow the members to use those marks. Certification marks are certified by the proprietor of the mark. And they pertain to origin material mode of manufacture of goods or performance of services, quality, accuracy or other characteristics. So, all the quality marks that we know are certification mark. Old mark is a certification mark.

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Types

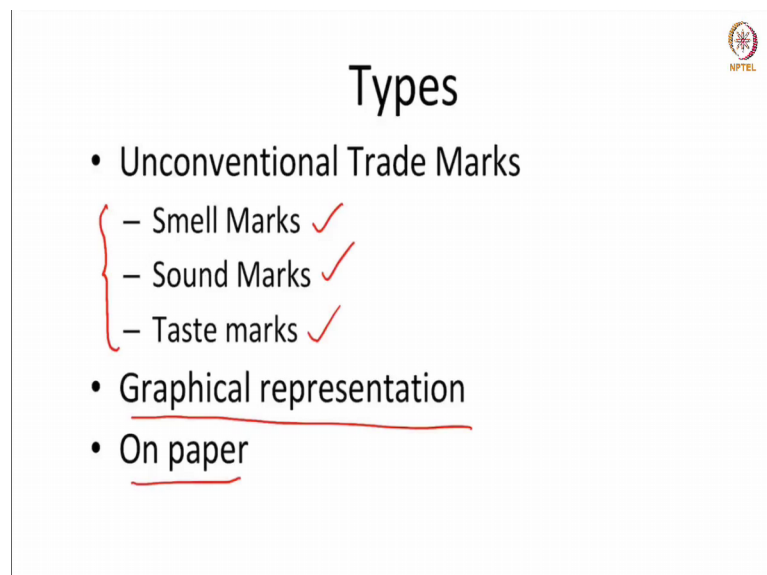
- Unconventional Trade Marks 1958
 - Color Marks - 1999
 - Cadbury purple
 - Shape Marks - 1999
 - Coca-Cola Bottle
 - Smell Marks ✓
 - Tennis balls with the scent of newly mown grass
 - Sound Marks ✓ - HD

There are also some unconventional trade marks. Now colour trade marks though it combination of colours is now used, but unconventional in the sense that it was not there in the 1958 act. But the 1999 act allows for colour combination of colours to be a subject matter of trade mark. So, the use of purple in Cadbury chocolates is one such instance. The shape marks are also allowed under the 1999 act as we just mentioned the Coca-Cola bottle shape can be a subject matter of shape mark.

Certain other unconventional marks are still not recognized under the act; for instance, smell marks and sound marks, now there was a case involving Harley Davidson motorcycles; now they were denied a sound mark in the United States. And there is instances of spell marks being granted in other jurisdictions for tennis ball with a scent of mown grass or with a rose scented tyre of our cars. The law in India with regard to this is that the marks need to be graphically represented. That is a requirement under the law. And if it has to be graphically represented, it should be capable of being portrayed on paper, and that is how you file your trade marks.

So, there is still some uncertainty as to whether smell marks and sound marks will be allowed under the Indian law.

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The slide is titled "Types" and lists the following categories:


- Unconventional Trade Marks
 - Smell Marks ✓
 - Sound Marks ✓
 - Taste marks ✓
- Graphical representation
- On paper

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So, apart from the smell marks and the sound marks, there is also an attempt to have trade marks for taste. So, that is again as we just mentioned in India, there has to be a

graphical representation on paper. So, we the law with regard to smell sound and trade marks is still not crystallized in India.

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Application for a Trade Mark

- **Who:** Any person, claiming to be the proprietor of a trade mark used or proposed to be used by him
- **How:** Apply in writing to the CGPDTM
 - Filed by submitting to office, post, or electronically
 - Application should have TM goods and services, name, address, attorney details, period of use of mark

Now, who can apply for a trade mark? Any person claiming to be the proprietor of a trade mark, who uses the mark or propose to use it can apply for a trade mark. Now this has to be done by applying to the controller general for pattern designs and trade marks. It is a common controller for pattern designs and trade marks, filed by submitting to the office. The application can be submitted to the office by post or electronically e-filing is also permissible.

The application should have the trade mark, the goods and services relating to the trade mark, the graphical representation of the trade mark. Goods and services to which the trade mark pertains to name address attorney details and period of use of the mark if the mark has already been in use.

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Application for a Trade Mark

- **Why:** Confers exclusive rights to use
 - Prima facie evidence of proprietorship of the TM
 - Registered proprietor may assign or license the trademark as any other property
 - Registered proprietor can enjoy the goodwill associated with registered trademark forever, if the mark is renewed from time to time

Now the trade mark confers an exclusive right to use. It is a prima facie evidence of proprietorship of the trade marks. It is proof of ownership.

The registered proprietor may assign or license the trade mark as any other property. Now this is a distinguishing feature of intellectual property, that all intellectual property can be assigned or licensed. Registered proprietor can enjoy the goodwill associated with the registered trade mark forever if the mark is renewed from time to time.

So, the goodwill attributed to the mark can be maintained forever. So, this is what we call an unlimited life intellectual property. Unlimited life IP since you can keep it forever by renewing it. For instance, Coca-Cola has been in existence for about 100 years, because it has been constantly it renewed the trade mark has been constantly renewed and kept a life.