



Selecting a Mark

Avoiding likelihood of confusion

The likelihood of confusion exists when the marks of the parties are similar (looks alike, sounds alike, similar meaning or creates similar overall commercial impression) or the parties have related goods and services in such a way that the consumers are likely to believe that it comes from the same source.

Create a strong mark

A strong mark fulfills two main objects: stops third party use and is easier to protect.

Strong Mark

Fanciful and arbitrary marks – they are inherently distinctive as they are created or invented that does not have any dictionary or other known meaning and therefore less likely that they are being used by third party like Nike or Addidas for shoes.

Weak Mark

Generic words/ terms – these are common everyday names for goods and services e.g. CARS for automobiles

Descriptive words/terms – directly describe the features or quality of the goods or services or provide the information but do not identify or distinguish the goods or the services e.g. CREAMY for milk

Suggestive marks – suggest qualities or characteristics of the goods and the services without actually describing them e.g. GLANCE A DAY for calendars

What is Trademark?

Trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises

Sign: Name, Word, Sound, Logo, Symbol, Design, Phrase

Criteria: Distinctive
Non-Descriptive

Duration: Unlimited subject to renewal

Rights: Prevent unauthorized use of the mark and counterfeiting

Trademark Symbol - TM, SM, ®

- Use of the "TM" symbol - for trademark
- Use of the "SM" symbol - for service mark
- Use of the "®" symbol - for registered trademark

Who can use a Trademark?

The right to use a mark can be exercised either by a **registered proprietor or a registered user** or anybody else who has been duly authorized by a registered proprietor or a registered user.

Who can make an application?

- Any person who claims to be the proprietor of a trademark used or proposed to be used by him can apply for the registration of the mark for goods as well services.
- The application for registration has to be made in writing to the Registrar of Trade Marks and it has to be filed in the office of the Trade Mark Registry under whose jurisdiction the principal place of the business of the applicant in India falls.
- In case the principal place of business is outside India, then the application can be filed in the office of the Trade Mark Registry, under whose jurisdiction the place that has been mentioned in the 'address for service' section of the application (usually office of the lawyer appointed by the person) is located.
- In case of a company about to be formed, anyone may apply for a trademark registration in his name for subsequent assignment of the registration in the company's favor.

Assignment, Transmission and Licensing of Trademarks in India

- Assignment means an assignment in writing by an act of the parties concerned. While in case of licensing, the right in the trademark continues to vest with the proprietor, the assignment of the trademark leads to a change in the ownership of the mark.
- According to section 39 of the Indian Trade Marks Act, 1999, a registered trademark is assignable with or without the goodwill in respect of all or only some of the goods/services for which the mark is registered.
- Indian law contains embargo on the assignments of trademark, whether registered or unregistered, whereby multiple exclusive rights would be created in more than one person which would result in deception/confusion.



Legal Requirements for Registration



- The selected mark should be capable of being represented graphically (that is in the paper form).
- It should be capable of distinguishing the goods or services of one undertaking in relation to which it is being used from those of others.
- It should be used or proposed to be used in relation to goods or services for the purpose of indicating a connection in the course of trade between the goods or services and some person having the right to use the mark with or without revealing identity of that person

Trademark Classification in India

- Trademark in India is classified in about 45 different classes, which includes chemical substances used in industry, paints, lubricants machine and machine tools, medical and surgical instruments, stationary, lather, household, furniture, textiles, games, beverages, preparatory material, building material, sanitary material and hand tools, other scientific and educational products.
- These classes again are further sub-divided. The main objective of trademark classification is to group together the similar nature of goods and services.



Duration of trade mark protection in India

- Term of registration of a trademark is ten years, which may be renewed for a further period of ten years on payment of prescribed renewal fees.
- However, non-usage of a registered trademark for a continuous period of five years is a valid ground for cancellation of registration of such trademark at the behest of any aggrieved party.

INFRINGEMENT OF TRADE MARKS & PASSING OFF

Infringement of trademark is **violation** of the **exclusive rights** granted to the registered proprietor of the trademark to use the same. A trademark is said to be infringed by a person, who not being a permitted user, uses an identical/ similar/ deceptively similar mark to the registered trademark without the authorization of the registered proprietor of the trademark. However, it is pertinent to note that the Indian trademark law protects the vested rights of a prior user against a registered proprietor which is based on common law principles.



Passing Off

- **Passing off** occurs in the case of **unregistered Brand Names**.
- The owner or to say **Brand holder** has the preferred right over the Brand owing to long and continuous use though the **Brand being unregistered** (under the Trademark Act), an action of **Infringement cannot be initiated**.
- In such a situation, action of **PASSING OFF** is an alternate remedy. A '**Passing off**' action can be **initiated in the appropriate Court of law**.
- A Passing Off action can be brought in by the original owner or user of a Brand against another person, who in the course of trade, misrepresents to its prospective or ultimate customers about its goods or services in a manner so as to show that they are connected to the goods or services of the original owner and this is done in a calculated fashion to injure the business or goodwill of the original owner or to earn benefit at the cost of the original owner. It is also important that actual deception and actual damage has to be proved for any relief of passing off.



WHO CAN BRING A SUIT OF INFRINGEMENT

The plaintiff in an infringement suit may either be:

1. The **owner/proprietor** of the registered Brand/Trademark
2. A registered user of a trade mark subject to a **prior notice to the registered proprietor** and consequent failure of the registered proprietor to take any action against the infringer
3. **Legal heir and legal successor of the proprietor** of registered trademark
4. Legal heirs of the deceased proprietor of a trade mark
5. **Joint proprietors** of a trade mark

INFRINGEMENT OF TRADE MARKS & PASSING OFF

ESSENTIALS IN THE CASE OF INFRINGEMENT

1. **The person must have registered the Brand** (whether in form of words, name, logo, design, tag line etc.) under its name as per the applicable provisions of Trademark Act 1999 to be entitled to file the suit.
2. The suit for infringement can be brought for **unauthorized use of registered brand** or even for intended or threatened use.
3. **The infringement must be of a nature** as it would actually amount to infringement due to the similarity of the mark used with the registered mark or due the mark being identical to the registered mark.
4. It is also **essential to prove** that the person being alleged for Infringement knew or had reason to believe that the application of the mark **was not duly authorized by the proprietor or a licensee of the mark**.
5. Existence of huge and **natural likelihood of confusion**, between the genuine trademark of the registered proprietor and the mark used by the alleged infringer. For Example, a company dealing in same business using the mark "Samsang", even though the spelling and way of presentation is different from the famous "Samsung" trademark
6. Prominence, Popularity, and Convincing strength of the infringer's trademark by showing similarity in the overall impression caused by both the trademarks. Example: In the pronunciation of mark, overall commercial impression, etc.
7. The plaintiff has stated that the name and trade mark of 'Mahindra' is extremely popular in India and is associated with the products and services of the plaintiff. It was further averred that the Mahindra group of companies have a nation-wide network of selling and distributing agents. The name and trade mark "Mahindra" have come to be known exclusively with the plaintiff and its group of companies and have acquired tremendous reputation and goodwill among members of public throughout the world including India.

*The views expressed in this article are those of the author.