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INTELLECTUAL PROPERTY RIGHTS: THE ENFORCEMENT OF TRADEMARK IN INDIA- Ishita Bakre¹**ABSTRACT**

In this increasingly competitive economy of India, there is a rise in business and other multinational organizations, establishing and working in India to have a goodwill and reputation in Indian market. These various brands and trade names can be breached or exploited in many different ways, thus protection of Trademark has become a necessity. Trademarks are signs or symbols capable of distinguishing one product from another. The proprietor of the business has an exclusive right to utilize the trademark of his brand name. Registration of such Trademark started with its growing awareness among the proprietors and other business entities which dynamically resulted in its widespread development and consequentially resulting in its infringement. In this research paper, the author has reviewed the concept of trademark in brief, following its enforcement process in India, the repealing acts, and development of Trademarks regulating Act. The paper definitely is a guide for the aspiring scholars and the business proprietors of India.

Keywords: trademark, Trademark regulating Act, Remedies, infringement

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INTRODUCTION

One of the essential Intellectual Property Rights is 'Trademark'. Trademark is well defined under the Trade Marks Act 1999 as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.²

Thus, Trademark is something or a medium for distinguishing goods and the accompanying services from others through its identity and a unique appearance and style such as gradient color combinations, single colors, product designing, smell, taste, voice, and any such kinds of signs which symbolizes its quality and functioning and provide for a better goodwill in people's perception.

Trademark is a very important investment in any company to have their legal and distinctive stand in a market. Customers are induced to buy a particular product looking at the trademarked company's brand loyalty and advertising campaigns. A successful trademark making its massive economic value in the market has a right to be protected under law.

THE GROWTH AND DEVELOPMENT OF TRADEMARK LAWS IN INDIA

The Trademark law was first introduced in 1940's prior to which there was lack of protection and awareness regarding trademarks, its infringement, remedies available. The only means of registering a Trademark was by obtaining a declaration under the Indian Registration Act 1908. The unregistered Trademark rights were protected under law of passing off or under section 54 of the specific relief Act 1877. This problem persisted until 1940 when there aroused a heavy demand and need for protection of Trademark in India.

² Section 2(zb), Trade Marks Act, 1999.

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The Indian Trademarks Act 1940 was enacted which brought an increase in the need for securing trademarks with high rise in the trade and business organizations, and rise in competitions. The Indian trademarks Act though needed reparations and amendments. This gave rise to the Trademarks and Merchandise Act 1958. The Act provided for registration and better protection of trademarks and for prevention of use of fraudulent marks on merchandise.

The Trade Related Intellectual Property (TRIPS) Agreement took a turn in India's Intellectual Property regime. Every member of WTO was bound to include the provisions of TRIPS agreement in their respective domestic legislations which also obliged India to enact fresh legislations regarding various IPR Acts. One of them was a new Trademarks Act 1999. The object of the Act is to register for the trademarks applied in the country, protect the exclusive use of the trademark by the trademark's owner, and to prevent its fraudulent use. The Trade Mark Act 1999 and Trademark rules, 2002 are presently the governing authority of Indian trademarks law in India since 2003.

In 2010, the Trademarks Act was amended and chapter IV A was inserted which contains the special provision of trademark protection in 97 countries in the international registration under Madrid Protocol.

REGISTRATION OF TRADEMARK

Trademarks can be registered in India under the Trade Marks Act 1999. The registrar maintains the record of registration of trademark wholly or partly in electronic form to such safeguards as maybe prescribed. There are a certain criteria to get your trademark registered successfully. The criteria consist of a series of guidelines to be followed.

1. The trademark is required to be different and unique in its form.

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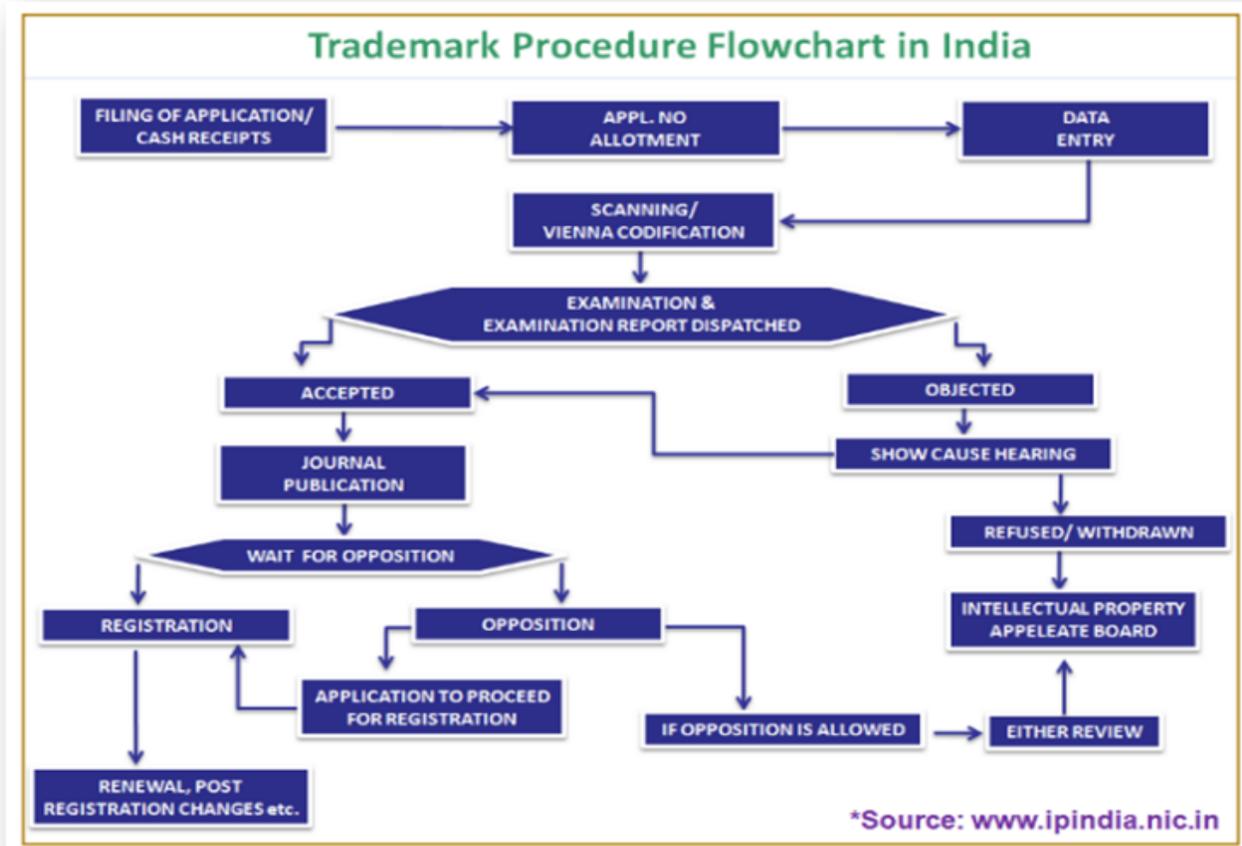
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2. It should not be such that it identifies or describes the goods and services or its quality.
3. The mark should be an unusual one.
4. It should not be similar to any of the trademarks, registered or unregistered.
5. It should not cause any dilemma in the minds of consumers in the purchase of such goods and services regarding its source of origin.
6. It should not contain any word or symbol prohibited under the Emblem and Names Act (prevention of improper use), 1950.
7. The mark should not be of the shape of the goods, which ethically provides the goods a substantial value unreasonably.

The Mark if fulfills the above criteria shall be eligible for registration as a trademark. The registration of trademark has been given under chapter 3 of the Trade Marks Act 1999. In the amendment Act 2010 some major changes in the trademark registration have taken place. The procedure for registration of trademark is now simpler as compared to the 1999 Act.

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PROCESS OF REGISTRATION

- Prior to applying for a registration of trademark, a preliminary search for an appropriate trademark is advisable to make sure its validity, and determination of any objectionable marks already registered. The Act prohibits the registration of International Nonproprietary Names (INN) as trademarks. The marks which are similar to IINs have been legally restrained by the Act. IINs are names which are used for pharmaceutical

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- purposes, needed for clear distinction and identification of medicinal descriptions and an exchange of information among the professionals in the field.
- The registrar shall classify the goods and services, as far as may be, in accordance with the international classification of goods and services for purpose of registration of trademarks.³ The decision of registrar shall be final in case of question arising as to class in which any goods or services fall.
- The proprietor of a trademark can apply for its registration in respect to its goods/services. The application shall be filed in the office of Trademark Registry within whose territorial limits the principle place of business in India of the applicant is situated. The applicant is required to fill the TM-1 form in 3 copies along with prescribed fee and copies of additional representation which contains the mark, name of the company or trader, address of company, description of goods and services, the class of such goods and services as prescribed by the Act, the date from which the mark is intended to be used or can be used.
- The applicant can fill the form TM-54 to enquire about any trademark identical or similar pending in registration.
- After the application is filed, the registrar of trademark allots an application no. to the applicant which shall in the later stage become a trademark number.
- The data entry of the particular trademark is made in the EDP module, which is scanned in original colors and uploaded in the system. It is then verified by the officers in charge. The application is then moved through TMS system and Vienna codification which codifies figurative elements in the trademark appearing in its application.
- The further process is the examination process which is basically for scrutinizing the application that whether all the necessary requirements for filing the application are

³ Section 7(1), Trade Marks Act, 1999.

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properly followed or not as prescribed in the trademark rules 2002 such as any same or similar mark is on record or whether any condition, restriction is required to be imposed.

- Examiner makes a consolidated report on examining the application. If any objections to the acceptance of application defined under sections 9 to 14 of the Trade Marks Act to the registrar, then it's sent to the applicant for necessary adjustments and is expected to respond within 1 month of issuance of examination report.
- With no objections in the application, or has been accepted, subjected to some conditions or limitations, the application is published in the Trademark Journal. The purpose of which is to invite for any objections if any from persons whose interest are likely to suffer. The period for its objection is 3 months. It shall proceed to its registration if no objection is raised. The person shall on the payment of prescribed fee and in prescribed manner give notice to the registrar of opposition to the registration. The applicant then is required to give a counter statement to the opposition within 2 months from receipt of notice. If he fails to do so, it is presumed that he has withdrawn the application and in case, he files the counter statement he needs to prove his claim on the trademark registration. The registrar has his final verdict after hearing both the parties whether to permit the registration or not.
- The Mark is then registered for a period of 10 years from the date of filing of the application and a certificate of Trademark registration is issued to the applicant. This trademark can be renewed for an unlimited period with a certain payment of renewal fee. The nonrenewal of a trademark can result to its removal from the record of trademark registrations which can be restored by filing an application for the same within 6 months and within one year from its date of expiry of last registration of mark.

This completes the process of Trademark registration in India under Trade Marks act 1999.

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The applications to the trademark can be amended. For instance, corporate name change, address change, etc. The amended trademark rules 2017, contains provisions regarding the form and fees applicable for changing or amending any pending or registered trademark.

PROTECTION OF TRADEMARK

As discussed earlier under the head growth and development of trademark in India, the protection to trademark was governed by the common law principles. The practice of protection of trademark was an encouragement to fair trade policies. The Trade Marks Act 1940 gave statutory rights to individuals over an exclusive enjoyment on their trademark and a lawful protection against its infringement.

Every trade business should run on fair trade policies without jeopardizing another's trade reputation or goodwill through restrictive trade practices. Any intention or action to use another's business symbol or trademark for a motive of making illegal profit through its brand name and reputation in the market is the trademark's infringement. Not only it's a wrong against the trader but also a wrong against the customer, who is misguided by purchasing a product which is not actually an original one.

A trademark owner, who believes that his trademark has been infringed by someone, can go for a civil action against the infringer before a session court of appropriate jurisdiction.⁴ Together with civil remedy to trademark infringement, the Act also provides criminal remedy to the owner of the trademark.

Another concept of infringement is passing off. It is not defined in the Trademarks Act 1999, though it has been given a mention in section 27 i.e. "nothing in this Act shall be deemed to

⁴ Section 134 of Trademarks Act, 1999.

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affect the right of action against any person for passing off goods and services as goods of another person or as services provided by another person or the remedies in respect thereof.”

Thus, passing off action involves misrepresentation to prospective customers of goods or services supplied to him and there is a misrepresentation calculated to harm the plaintiff's business and goodwill. The principle behind this concept is that a man may not sell his own goods in pretence that the goods are of another person. For the action of passing off, registered trademark is not necessary. On the other hand infringement is the violation of a statutory right of individual acquired by trademark registration.

DETERMINING INFRINGEMENT OF TRADEMARK

To determine whether there has been an infringement or not, the impact of purchase is taken into consideration. The dilemma in the minds of consumers regarding a product purchase, is a reason to trademark's infringement. Whether the infringing mark is similar to the infringed mark in all aspects likely to cause confusion, it amounts to infringement. Any deception, fraud, dilemma on the part of infringer is essential to constitute infringement.

Section 29 and 30 of the Trade Marks Act 1999 comprises of provisions regarding infringement of trademark. The common forms of infringement and when the trademark is not infringed.

CASE LAWS

Now, as far as the Infringement of trademark is concerned, there are few selective case laws demonstrating the infringement of trademark and selected cases on passing off.

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Pidilite Industries Ltd. V. S.M Associates⁵, in this case the plaintiff was the registered owner of the trademark “M SEAL”. The defendant came with a mark “SM SEAL”. This mark was an unauthorized use of the plaintiff’s trademark. The mark had all essential elements of the plaintiff’s trademark “M SEAL”.

The Bombay High Court ruled that, defendant’s use of impugned mark was causing confusion and deception among the customers. The court restrained the use of “SM SEAL” mark by the defendant.

PAYPAL&PAYTM, Paytm is an online cash wallet for online transactions. With growing demand in electronic transactions in India paytm became household brand with more than 7 million transactions in a day. Paypal being the biggest payment gateway in the world caught an attention towards paytm, having a deceptive similarity between their logos.

PayPal, on 18th Nov 2016 filed a suit against trademark infringement of its name and logo by Paytm. Both the names start from the word “pay” and even the colors in the logos are made of same color combinations. It will take a couple of years to settle down this dispute. The case between the two is still in progress.

Yahoo! Inc. V. Akash Arora &Anr⁶, the domain name serving the same function as a trademark is also entitled to equal protection. In this case of cyber squatting, the domain names “Yahoo!” and “Yahoo India!” was questionable under trademark infringement. The names were identical and phonetically very similar, which in no doubt were deceiving and causing great confusion among the users. The disclaimer used in the name is not enough to differentiate the defendants’ domain name identity from the plaintiff’s domain name. Injunction was granted in favor of plaintiff having the domain name Yahoo! which is a well known and widely publicized domain name all over the world.

⁵2004 (28) PTC 193 (Bom).

⁶ 1999,19 (PTC) 201 (Del).

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N.R. Dongre V. Whirlpool Corp. Ltd.⁷, in this case the defendants the owner of trademark “WHIRLPOOL” failed to renew their trademark in 1977 due to any discrepancies. The plaintiffs applied for registration of the same trademark “WHIRLPOOL” in 1988. Accordingly respondents filed an objection on its advertisement in the trademarks journal. The appeal was filed in the Supreme Court by the respondents, earlier plaintiffs, and the court held that, Whirlpool Corporation had been a widely known brand since 1937 and appellants have only applied for it in the year 1988. The common principle is that no man can sell his own goods in the pretence that the goods are of someone else. Therefore, the court granted interlocutory injunction and dismissed the appeal.

Rupa & Co.ltd V. Dawn Mills Co. Ltd.⁸, the court held that the use of the word “DON” by the Rupa Company was prima facie an infringement of the registered trademark ‘DAWN’ owned by Dawn Mills Ltd. The court held that this was a fit case for grant of injunction.⁹

LEGAL REMEDIES AGAINST INFRINGEMENT AND PASSING OFF

The persons who can file a suit for infringement and passing off and the persons against whom the suit can be filed are provided under the Trade Marks Act 1999.

Who can file the suit?

1. The registered proprietor or his legal successor.
2. A registered user of a trademark subject to prior notice to the registered proprietor.¹⁰
3. An applicant for registration of trademark provided the suit shall commence after its registration.

⁷ 1996,16 (PTC) 583 (SC).

⁸ AIR 1998 Guj 247.

⁹ Mishra J.P., ‘Intellectual Property law’, Central Law Publication p. 229-330.

¹⁰ Section 52 of Trademark Act ,1999.

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4. Legal heirs of deceased proprietor
5. Any one from the joint proprietors of trademark.
6. A foreign proprietor of a trademark which is registered in India and the infringement of the trademark has also taken place in India.

Against whom the suit can be filed?

1. The infringer who infringes or threatens to infringe or pass off the trademark of plaintiff.
2. In case of vicarious liability, the master of the servant who is indirectly liable for his servant's act.
3. Agent of infringer.
4. The directors and promoters of a company cannot be associated with the infringement unless they have a personal relation or have personally been involved in such act.

Filing of the suit

The suit can be filed in the District court having jurisdiction to try such suit of trademark infringement whether be it a registered trademark or unregistered trademark.

Duration

The limitation period for filing the suit for infringement of trademark is 3 years from date of infringement. If the infringement is a continuing one, every time an infringement occurs it will give rise to new cause of action. Suppose, an infringing product is sold continuously, it will every time give rise to a new cause of action.

Onus of Proof

The burden of proving an infringement or passing off of a trademark lies on the plaintiff. The plaintiff in case of infringement must prove that defendant's mark is deceptively similar as of the plaintiff's. In passing off he must prove that his mark is a distinctive one and further to prove

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that defendant's mark is likely to confuse and deceive the customers and cause injury to the plaintiff's business and goodwill.

Relief

The relief which a court may grant to the plaintiff is the injunction, and at the option of the plaintiff either damages or on account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.¹¹

CRIMINAL REMEDIES

Criminal suits can also be initiated in addition to the civil suits in regards to falsifying and falsely applying Trademark. Selling goods or services on which a false trade description is applied, falsely representing a trademark as registered, misrepresentation of place of business as connected with trademark office, falsification of entries in the register. All these acts are sanctioned with punishments maximum up to 3 years imprisonment and fine up to 2 lacs.

CONCLUSION

India has brought many developing changes in the area of intellectual property rights and is aiming towards its efficiency and betterment. Thus, the civil remedies along with criminal remedies against trademark infringement have brought a revealing change in the business scenario and have encouraged fair and healthy competition among the competitors. The studies of current judicial scenarios reveal that the civil remedies are confined to granting of injunction. The enforcement of criminal remedies should also be invoked to ensure effective protection of rights of trademark owners. With the growing of dynamic and new methods of infringing trademark the Indian Trademark law should frequently be updated with new techniques of protection of trademark infringement and more effective remedies against it. The trademark registration now is also done via digital processes which are a very good initiative in effective

¹¹ Dr. M.K Bhandari, Law Relating To Intellectual Property Rights, Central Law Publication, 242
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and fast registration of trademarks. Tackling the issues such as pendency of application, pendency of opposition matters, shortage of the concerned officers, should also be taken into consideration by the government as its next agenda.

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