



## INTELLECTUAL PROPERTY RIGHT - TRADEMARK: GENERAL REVIEW

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**ABSTRACT**

Abstract: An Act to amend and consolidate the law relating to trademarks, to provide for registration and better protection of trademarks for goods and services and for the prevention of the use of fraudulent marks. A trademark (popularly known as brand name) in layman's language is a visual symbol which may be a word signature, name, device, label, numerals or combination of colours used by one undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from a different undertaking.

**KEYWORDS** : Intellectual Property Right, Trademark, Process, Cadbury**INTRODUCTION:**

The legal requirements to register a trademark under the Act are: Section 2 (V)(zb)

The selected mark should be capable of being represented graphically (on the paper). It should be capable of distinguishing the goods or services of one undertaking from others. It should be used or proposed to be used mark in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person have the right to use the mark with or without identity of that person.

If it is a word it should be easy to speak, spell and remember. The best trademarks are invented words or coined words or unique geometrical designs. It is advisable to conduct a market survey to ascertain if same/similar mark is used in market (Narayan P 2019).

**Govt. of India step towards promoting IPR:**

IPR Awareness: To create public awareness about the economic, social and cultural benefits of IPRs among all sections of society. Undertake studies to assess the contribution of IP content in different industries on the economy, employment, exports and technology transfer. Focus on improving IPR output of national research laboratories, universities technology institutions and other researchers by encouraging and facilitating the acquisition of Intellectual Property Rights by them. Encourage researchers in public funded academic and R & D institutions by having uniform guidelines for division of royalties between the organizations and individual researchers and innovators.

Encourage R&D including open source based research such as Open Source Drug Discovery (OSDD) by the Council of Scientific and Industrial Research (CSIR) for new inventions for prevention, diagnosis and treatment of diseases, especially those that are life threatening and those that have high incidence in India. Establish and strengthen IP facilitation centers as nodal points especially in industrial and innovation university clusters. Create an industry-academia interface for encouraging cross-fertilization of ideas and IPR-driven research and innovation in jointly identified areas. Introduce support systems for MSMEs, start-ups and grass root innovators to reduce transaction costs linked to IP creation for the entire value chain from IPR generation to commercialization, including schemes to facilitate domestic IPR filings.

Promote India's rich heritage of traditional knowledge with the effective involvement and participation of the holders of such knowledge. Traditional knowledge holders will be provided necessary support and incentives for furthering the knowledge systems that they have nurtured from the dawn of our civilization (Wadehra 2011).

Different kinds of marks (brand names, logos, signatures, symbols, well known marks, certification marks and service marks)

**Section 2(V)m:**

"mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;

**Section 2(V)r**

"permitted use", in relation to a registered trademark, means the use of trademark— (i) by a registered user of the trademark in relation to goods or services— (a) with which he is connected in the course of trade; and (b) in respect of which the trademark remains registered for the time being; and (c) for which he is registered as registered user; and (d) which complies with any conditions or limitations to which the registration of registered user is subject.

**Section 2(V) (zg)**

"well known trademark", in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.

Word mark includes one or more words, letters, numerals or anything written in standard character. A word mark could be a text of Name, Brand, Slogan or tagline without design. For eg. Microsoft, Tata, KFC, IBM, DD etc.

A brand name or trade name is a name (usually a proper noun) applied by a manufacturer or organization to a particular product or service. Dhara, Maggi, DELL

**Logo:**

Logos or brand marks are a visual identity of any business, brand, or company. It could be anything— a symbol, a text, or a combination of both (Myneni 2019)

**Signature:**

A great logo shows the world what you stand for, makes people remember your brand, and helps potential customers understand if your product is right for them. Ex Godrej, Marks media, Signature, Chris wood etc.

**Symbols:**

It may take the form of an abstract or figurative design, or it may present as a stylized version of the company's name if it has sufficient brand recognition. Ex. SBI, Indian Airlines, Tata Motors.

**Service marks:**

A service mark or service mark is a trademark used in the United States, India and several other countries to identify a service rather than a product. ®, ©, ™, LLC, Advocate, Doctor.

**Certification marks.**

The mark which certifies the quality of product. Ex ISI, FPO, GOI.

**Objectives of Trademark Law:**

1. Encourage and develop new trade,
2. Induce creator to disclose his creative work,
3. Reward for the expenses of developing trade work,
4. Inducement to invest capital in trade and services
5. To encourage innovation in trade and services.

**Registration of trademark:**

A trademark once its registered is an untouchable asset or intellectual property for a business which is used to safeguard the company's investment in the brand or ideogram.

In India, trademarks get registered by the Controller General of Patents Designs and Trademarks, Ministry of Commerce and Industry, Government of India. Trademarks in India are registered under the Trademark Act, 2016 and authorises the trademark owner with a right to sue for damages when contraventions of trademarks occur.

**Rights of holder:**

Following the registration of the trademark, 'R' symbol can be used by the owner and the said trademark registration will be valid for a fixed period of 10 years. However, the registered trademarks approaching their expiry can be easily renewed by applying for a trademark renewal application for an extended period of another 10 years.

The application for registration of the trademark can either be filed in a single- class or a multi- class totally depending on the goods and services the business pertains to. Post the filing of the trademark application, a mandatory examination report is issued by the Examiner after an extensive examination of the trademark application in consonance with the guidelines of the Trademarks Act, 2016.

Once the registration application has been accepted, the said trademark is advertised and also published in the Trademarks Journal for a period of 4 months. The aim behind the publication and advertisement is to invite the general public to filing an opposition against the registration of the mark. The final step towards the entire procedure is registration where the application proceeds to registration after conquering the objection and/ or the opposition against the said registration of trademark. (Section 16 of Trademarks act).

**Assignment of Trademark (Section 37):**

The person for the time being entered in the register as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for such assignment.

Rights of holder (Section 28): Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act. The exclusive right to the use of a trade mark given (Rattan Jyoti 2021).

Trademark licensing is the process wherein a registered proprietor of a trademark authorises a third party to use the

mark for trade without transferring the ownership of the mark. The licensing of the trademark allows the registered proprietor to let others use the mark without assigning the ownership of the mark. The proprietor can also put other limitations on the use of the mark through the terms that he puts into the licensing agreement. ... For example, the proprietor may license a trademark to be use. Trademark licensing has become a common practice as it benefits both the licensor and the licensee. The licensor earns money by way of royalty, while the licensee gets to commercially exploit the mark. In addition to monetary benefits, the licensor also benefits due to the expanding reach and popularity of the mark (Kailasm 2017).

**Infringement of registered trade marks (29):**

A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

**Remedies against infringement (Section 135):**

The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure, preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit; restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

**Penalties against crimes regarding trademark (Section 103-109).**

Any person who involve crimes regarding trademark shall, unless he proves that he acted, without intent to defraud, be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees: Provided that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

If any person makes, or causes to be made, a false entry in the register, knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both (Section 109).

**Trademark office and Appellate Board.**

1. The Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks. The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as he may from time to time authorise them to discharge.

2. The Copyright Office has been set up to provide registration facilities to all types of works and is headed by a Controller-General of Patents, Designs and Trade Marks and is located at Patents/Designs/Trade Marks/Geographical Indications, Boudhik Sampada Bhavan, Antop Hill, S.M. Road, Mumbai-400037

3. The Appellate Board established under section 83 of the Trademarks Act, 1999 (47 of 1999) shall, on and from the

commencement of Part XIV of Chapter VI of the Finance Act, 2017 (7 of 2017). The Appellate Board shall consist of a 2 [Chairperson], 3 [Vice-Chairperson] and such number of other Members, as the Central Government may deem fit and, subject to the other provisions of this Act, the jurisdiction, powers and authority of the Appellate Board may be exercised by Benches thereof.

**Trademark filing in India:**

The Trademark database contains all the trademark applications submitted to the Trademark registrar in India, including all registered, applied, objected and expired trademarks. A trademark search will give the user an insight into the valuable information relating to the trademark search query.

**Trend of activities during 2015-16 to 2019-2**

Sr. no.	Activities	2015-16	2016-17	2017-18	2018-19	2019-20
1	No. of Applications filed for Registration	283060	278170	272974	323798	334805
2	No. of Applications advertised in the Trade Marks Journal	117408	333673	423030	396063	378147
3	No. of Trade Marks Registered	65045	250070	300913	316798	294172
4	No. of post examined applications disposed by otherwise than registration (i.e. refusal, abandonment and withdrawal )	51122	40374	254864	202387	125394
5	No. of marks in respect of which registration was renewed	58160	56270	64661	62497	70583
6	No. of requests for recordal of post registration changes in registered trademarks (including assignments) disposed.	11075	13094	73764	47251	32596
7	Certificates issued under section 45(1) of the copyright Act, 1957	8185	9169	1605	2760	7362

**Trend of applications filed from 2015-16 to 2019-20**

Year	Indian Applicants	Foreign Applicants	Total
2015-16	267390	15670	283060
2016-17	266730	11440	278170
2017-18	247734	25240	272974
2018-19	310116	13682	323798
2019-20	320940	13865	334805

**Trademark applications filed by Indians (State-wise)**

State / Union Territory	No. of. Applications field
ANDAMAN & NICOBAR	31
ANDHRA PRADESH	4386
ARUNACHAL PRADESH	26
ASSAM	1312
BIHAR	3539
CHANDIGARH	2175
CHATTISGARH	2382
DADRA & NAGAR HAVELI	93
DAMAN & DIU	111
DELHI	60720
GOA	726
GUJARAT	26167
HARAYANA	17170

HIMACHAL PRADESH	1330
JAMMU AND KASHMIR	1269
JHARKHAND	1363
KARNATAKA	18063
KEALA	10205
LAKSHADWEEP	1
MADHAYA PRADESH	9727
MAHARASHTRA	65750
MANIPUR	117
MEGHALAYA	56
MIZORAM	41
NAGALAND	28
ORISSA	1873
PONDECHERRY	230
PUNJAB	11440
RAJASTHAN	13328
SIKKIM	68
STATE NOT SPECIFIED	65
TAMILNADU	19276
TELANGANA	11780
TRIPURA	93
UTTAR PRADESH	22506
UTTARAKHAND	2494
WEST BENGAL	10999
TOTAL	320940

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**Case law:**

**Cadbury India Limited and Ors. V Neeraj Food Products** [142 (2007) DLT 724],

The Plaintiff (**Cadbury India Limited**) is a well-known producer and manufacturer of chocolates and confections and has a trademark 'GEMS' registered in its name. The Plaintiff approached the court for an injunction against the Defendant who was allegedly selling a product under the mark 'JAMES BOND' which resembled the 'GEMS' product of the Plaintiff in packaging and size. The Plaintiff claimed that the product sold with mark of 'JAMES BOND' was deceptively similar to 'GEMS'.

The court held that the products of the Defendant were indeed deceptively similar to that of the Plaintiff and granted an injunction restraining the Defendant from selling the said product. An action for trade mark infringement is a statutory remedy and on the other hand, an action for passing off is a common law remedy. The plaintiff No. 1 obtained its first registration in respect of the word 'GEMS' as CADBURY MILK CHOCOLATE GEMS on 20th May, 1968 vide registration No. 249360, GEMS BOND' which was first published in the year 1988. Copy of the certificate granted by the Registrar of Companies dated 24th July, 1989. Cadbury Gems win the claim.

**CONCLUSION:**

A trademark can get registered once it is peculiar for the goods and services that are being provided. Tendered trademarks that are similar or identical to an already existing registered trademark cannot get registered. Besides this, trademarks that are deceptive, generic, offensive, similar, contains exclusively protected emblems, etc. cannot be registered either. The greatest benefit to having a registered trademark is to be able to safeguard one's brand as well as the business by instrumenting to the compassion of one's business. In addition to this, having a strong brand can act as a direct link between the customer and the product by making sure they are reliable and associated to the business for lifetime. An exclusive right in one of the persons concerned, to the use of the trade mark limited to use in relation to goods to be sold or otherwise traded in, in any place in India, or in

relation to services for use, or services available for acceptance in any place in India (Section 41).

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