INTRODUCTION
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Statement of Problem

In an age of globalization, the world got shrunk and is considered as a single market, regarded as a single republic that has really started the process of concretising the idea of global governance which presented the stiffer competition from all corners of the world in any given field. Globalization - the 'big idea' of the late twentieth century - lacks precise definition. More than this, it is in danger of becoming, if it has not already become, the cliché of our times. Globalization can usefully be conceived as a process which embodies a transformation in the spatial organization of social relations and transactions, generating transcontinental or interregional flows and networks of activity, interaction and power. Nonetheless, the term globalization captures elements of a widespread perception that there is a broadening, deepening and speeding up of world-wide interconnectedness in all aspects of life, from the cultural to the criminal, the financial to the environmental. At issue appears to be 'a global shift'; that is, a world being moulded, by economic and technological forces, into a shared economic and political arena. Behind the rhetoric of globalization - rhetoric found in public as well as academic debate - laid three broad accounts of the nature and meaning of globalization today, referred to here as the hyper globalist, the sceptical, and the transformationalist views. At this juncture possession of intellectual property rights will give a better edge in the global play. The right to prevent others from using the ideas or information to their own commercial advantage is not easily delineated. Legal techniques of some sophistication are called for and this has until recently made intellectual property a somewhat esoteric specialist. But, particularly in industrial free-market economics, these intangible property rights are becoming increasingly valuable in the fight to secure and retain shares of a market.

The importance of intellectual property was first recognized in the Paris Convention for the Protection of Industrial Property (1883) and the Berne Convention for the Protection of Literary and Artistic Works (1886). Both treaties
are administered by the World Intellectual Property Organization (WIPO). Intellectual property is all about human creativity. Intellectual property rights are like any other property right. They allow creators, or owners, of patents, trademarks or copyrighted works to benefit from their own work or investment in a creation. These rights are outlined in Article 27 of the Universal Declaration of Human Rights, which provides for the right to benefit from the protection of moral and material interests resulting from authorship of scientific, literary or artistic productions. In the sense recognition is given to novel intellectual work by intellectual property sights. These rights are an advantage for creators and investors for conceiving and executing innovative thoughts and ideas. The scope of IPR is expanding very fast globally and the person who creates new ideas seeks protection under the umbrella of IPRs. The Intellectual Property Right regime has served as a means to protect such investment. Protection of intellectual effort is an offshoot by product of the process of production of investment, through IP takes the centre stage. The impact of IPR has spread over every aspect of human life. It has got something in store for everyone ranging from philosophers, Ethicist, scientist, politicians, artists, lawmakers, entrepreneurs, economists students and common man.1

Intellectual Property Right is considered as a reward for creative and skilful work in the execution of ideas. In fact it is more than a reward for conceiving and executing ideas.2 The term IP is covering patent industrial designs, copyright, trademarks confidential information geographical indications and domain names etc. Patents, designs and trademarks used to be considered as different kinds of industrial property. But when copyright and confidential information were included the term intellectual property, though a little high sounding, is a more appropriate description for this class of property.3

Broadly speaking, IPRs, are divided into two categories; firstly, patents, design, trademarks, domain names, trade secrets, geographical indications, plant varieties rights integrated circuits, which are known as industrial property, and secondly the copyright and related or neighbouring rights and collectively known
as intellectual property. It is possible that one may be the owner of one or more rights separately or jointly. It is also interesting to note that all these rights are known as “Intellectual Property Rights”, each rights has its unique and different purpose, different laws protecting different intangible, assets viz. Patents for inventions, trademarks for brands, Designs for aesthetic designs, Copyrights for literary, dramatic, musical and artistic work to name of few.

In India, intellectual property falls in the Union list of the seventh schedule under the article 246 of the constitution, which has itemized same as patents, inventions and designs, copyright trademarks and merchandise marks” (Item 49). A trademark may consist of one or more distinguishable words, signs, letters, numbers, drawings or pictures, emblems, colours or combination of colours etc. The mark may also consist of a combination of one or more of the said elements. A trademark is a commercial asset intended for commercial use and the owner thereof gets a perpetual right to its exclusive use in relation to goods and services. In India the, Trade & Merchandise Marks Act of 1958 was replaced by the Trade Marks Act of 1999 read with T.M. Rules 2002 making drastic changes so as to conform to the international standards on the law and also to include within its fold service marks. The said Act provides for the registration of trade marks in relation to particular goods and services and provides for the action (civil as well as criminal) against infringement of such trademarks. The Act also contains provisions to facilitate civil action for passing off, i.e. where an unregistered trademark is flouted.

The emergence of the internet or the onset of the ‘e’ or ‘electronic culture’ or “e-Culture” that has led to a radical metamorphosis in the manner a business can reach out to its customers. Information about a particular product or a reputed brand name is easily accessible through the powerful search engines available on the internet. While before the emergence of the e-culture, business entities had acquired intellectual property rights viz. Trade marks in their products through continuous promotion of the particular brand name by means of advertising through the media viz. The press, television, radio broadcasts and other means, the
The development of the internet has opened new vistas for a very effective brand promotion for internet users who are in fact increasing leaps and bounds with awareness of the electronic culture. It is not difficult to find cybercafés even in the remote areas of the country and computer with internet access is becoming more of a necessity than a luxury. This factor has also opened Pandora’s Box on the aspect of intellectual rights in the domain names and their conflicts vis-a-vis the registered trademarks. A domain name means the address of a business entity on the internet or cyberspace or a reference for having access to business credentials of an entity. Domain names are made available by the Registering Authorities on application. The importance of domain names on a similar footing with trademarks is now legally recognized.

A conflict situation arises typically when a company having an established brand name and registered trademark approaches the registering authority for registration of the domain name on the internet so as to guide its potential customers to the site where more details about its products and services can be provided. In all probability, the domain name chosen by such a company has to be its reputed brand name or the registered trademark for e.g.: Microsoft Inc. would definitely seek a domain name Microsoft.com or Cadbury’s Ltd. Would definitely seek the domain name cadbury’s.com because potential customers are familiar with the brand name viz. Microsoft or Cadbury’s.

However, there is a possibility that some innocuous entity has already registered the domain name using the established trademark and owing to the strict rules of the registering authorities not to allow the same domain name the company seeking the domain name in the name of its trademark has to contend itself with an identical domain name but not the exact name as its trademark. It has also been observed in all such cases that the innocuous entity seeks a hefty compensation from the company for transfer of the domain name and this practice has come to be known as ‘cybersquatting.'
Importance of trademarks and domain names have increased with the globalization of business and expanded usage of the internet for commercial purpose. Domain names are used to identify one or more IP Addresses. For example, the domain name *intel.com* represents about a dozen IP addresses. Domain names are used in URLs to identify particular Web pages. For example, in the URL *http://www.fordfoundation.org/index.html*, the domain name is *fordfoundation.org*. Every domain names has a suffix which indicates top level domain (TLD) to which it belongs i.e. *gov*-Government agencies, *edu*-Educational institutions, *org*-Organizations, *mil*-Military, *com*-commercial business, *net*-Network organizations, *ca*-Canada, *in*-India as Internet is based on IP addresses, not on domain names whereas every Web Server requires a Domain Name System (DNS) server that translates domain names into IP addresses. Thus, The progress and well-being of humanity rest on its capacity to create and invent new works in the areas of technology and culture. The legal protection of new creations encourages the commitment of additional resources for further innovation. The promotion and protection of intellectual property spurs economic growth, creates new jobs and industries, and enhances the quality and enjoyment of life. An efficient and equitable intellectual property system can help all countries to realize intellectual property’s potential as a catalyst for economic development and social and cultural well-being. However, the intellectual property system helps strike a balance between the interests of innovators and the public interest, providing an environment in which creativity and invention can flourish, for the benefit of all.

**Object of the Study**

Basically the main object of this study is to examine the crucial instances of hurdles in the way of the trademarks and domain names user and the protection given to the trademarks and the domain name under present legislations in India and Abroad. Almost all countries in the world register and protect trademarks. Each national or regional office maintains a Register of Trademarks containing full application information on all registrations and renewals, which facilitates
examination, search and potential opposition by third parties. The effects of the registration are, however, limited to the country concerned.

**Research Methodology**

The methodology adopted by the researcher is purely doctrinal in nature. It involved in depth study of source materials, text review, case study and comparative study. The research is based on two types of material i.e., primary materials and secondary materials. Primary materials consist of the text of laws, declarations etc. on the issue. Secondary materials consist of books, articles, encyclopaedia, research papers, newspapers and magazines. The research also includes study of case laws. Use of the internet was also made to gather important information relating to the subject of study. The research is analytical and descriptive in nature.

**Sources**

Primary and Secondary sources of information have been utilized in the writing of this research.

**Mode of Citation**

A uniform mode of citation has been followed throughout the research work i.e. OSCOLA.

**Review of the Literature**

A review of the literature was done by the researcher even before selecting the topic “Protection of Trademark and Domain Name in India and Abroad”. Once the topic was zeroed on, the review of the existing literature was done in detail. Lots of Articles, Journal report, Books, case law, paper submitted to a seminar or to a conference and web pages of different website were reviewed. They are as follows.

An Introduction to Intellectual property Rights by J.P. Mishra, Central Law Publication, 2005. According to the author trademark is a kind of symbol that helps a user to make difference in between the goods or services of one enterprise from those of the competitors.


Intellectual Property Law, by P. Narayan, Eastern law house, publication VIth edition, the researcher examines the definition, meaning kinds and essentials of a trademark. It also analyses and evaluates that how trademark performs functions.

Intellectual Property Law by Meenu Paul, Allahabad law agency publication, the book provides basic rules of registration of trademark. The process whereby a trademark is entered on the register of the trademark is referred to as registration.

Law Relating to Intellectual Property by B.L. Wadehra universal law publication IV edition, 2007 examines special provisions relating to protection trademarks to international registration, effects of registration, duration and renewal of registration.

Intellectual Property by D. Bainbridge, Publication by Pearson Education (Singapore). The book provides law relating to passing off in action why passing
off is necessary because already trademark given the protection to goods and services?

Intellectual Property by Cornish and llewelyn, Thomson, Sweet and Maxwell Publication, Vth edition 2005, The researcher examines the doctrine of passing off that it arises in three cases first when it is injured the claimants goodwill, secondly in misrepresentation and thirdly in damages.

Intellectual Property and the Internet by Ryder, Rodney, Lexis Nexis Butterworths, publication the researcher examines the working of internet technology and domain name system. It also analyses the doctrine of cybersquatting and to curb this menace in the present legislation in India and abroad.

Protection of Domain Names in India and Abroad by Prof. Saleem Akhtar and Shweta Jain, published by Aligarh Muslim University Press, 2012 the researcher examines meaning of domain names registration and its protection under Trade Marks Act 1999.

Information Technology law and Practise, by Sharma Vakul Published by Universal Publication (2008), the researcher examines the meaning of cybersquatting. How can this problem solve in the present scenario.

Cyber laws by Justice Yatindra Singh, Universal publication Vth edition, 2012, the researcher analyses online infringement of trademarks with the tooks of cybersquatting, Metatags, Linking, Framing, Spamdexing, Spoofing.

Intellectual Property: Patents, Copyrights, Trade Marks and Allied Rights, by W.R. Cornish and D. Llewelyn, published by Thomson, Sweet and Maxell, VIth edition, 2008. The researcher Examines, much also continued to happen at the international and regional level to give IPR a growing significant worldwide.
Chapterization

The present work namely’ Protection of Trade Marks & Domain Names in India and Abroad” has been broadly divided into fifth chapters. This work has been written primarily to acquaint the initiated as well as uninitiated about the concept of trademarks and domain names and analysis of the legal framework both in national and international context which gives protection to trademarks and domain names as an intellectual property rights.

The first chapter deals historical background of trademark law, important features of Trade Mark Act 1999, the meaning and legal definition, essentials of trademarks and its functions etc. It also includes some new additions in the term of Trademarks.

Second chapter gives an introduction of internet and domain name system. It also includes meaning of domain name and its hierarchy, Social and economic value and globalization of domain name system.

Third chapter deals with the registration of Trademarks and domain names and its protection under the Indian legislation as well as abroad.

Fourth Chapter focuses on infringement of Trademark and the common law remedy the doctrine of passing off in action.

Fifth chapter discusses about the uniform domain name dispute resolution policy, cybersquatting and the role of WIPO. It also includes resolution of domain name dispute under FTDA, ACPA and UDRP.

The work ends with the conclusion, which recapitulates the nodal points of our discussion.
Notes & References


CHAPTER I
TRADE MARKS IN INDIA AND ABROAD
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An Overview

Intellectual Property Right is a genus and trademark is a species which comprises of a name, word, phrase logo, symbol, design, image, letters, numerals 3-d signs or a combination of these elements. It is also used as a service work. A trademark is a kind of symbol that helps a user or purchaser to make a difference between the goods or services of one enterprise from those of his competitors. By distinguishing its products or services, a proprietor gains goodwill and market share while the purchaser can confidently purchase the goods or services without deceive or confuse. Trademarks are at the centre of global business today.

There was no time when man did not possess rights and there was no time when these rights were free from invasion or piracy. These invasions or piracies were mostly influenced by greed and a desire to profit at another man’s expense and make easy money, though, occasionally these were innocent. Literary works, goods and merchandise manufactured and used under special names or marks of features and associated with certain traders, artistic works, patents, inventions, etc. were all the subject-matter of piracy. Goods were passed off as if they were the products of the real property which they were not. This led to the deception of the purchasing public and also of the proprietor of the trade-mark. Development of trade, printing, art, literary works, etc., during the last and the present century and the vastness piracies, which simultaneously developed in respect thereof, necessitated Protection Laws.1

Trademarks are, thus, the quality symbols which mailed the order of priority a consumer can have as regards purchasing things or availing of services. These marks are the product of the intellect of one
who produces them and applies to the trade in question. Therefore, it is
a form of intellectual property that needs protection, if for nothing else
then, for the simple reason that providing such protection will lure
more and more people make an attempt to come out with quality goods
or quality services for the welfare of the making. More so because once
a trademark has been well recognized by the consumer in the market,
the loss of it may spell disaster for the holder of the trade-mark; so can
make an unauthorized use of the trademark by other. 2

The term “brands” is generally used in the expression trademark
in the business world to identify its goods and services from one
another. They guarantee the source and the quality of the
organization’s goods and services. They can be a powerful, commercial
weapon against fair competition and powerful, legal weapon against
the unfair competition. In the care of goods or services protected by a
patent, they build up a trademark's reputation through sales and
advertising, during the period of patent monopolies, can slow or, in
some cases, even prevent the erosion of market share that usually
follows the end of patents life. It is the aim of this chapter to explain
the importance and value of trademarks to our business clients and
colleagues. The chapter first examines what is trademark and the
various types of trademarks, that is available to identify a particular
product (service). Than its show how a new trademark should be
chosen and cleared for an introduction to the market. Finally the legal
remedies that are available to the owner of a trademark to prevent
unfair or illegal competition will be considered.

**Historical Perspective**

The Intellectual Property Right and its journey is as young as
human civilisation itself. Although, trademark law has a long history of
more than two hundred years. This history of trademark law began in
the 19th century by Europe and the U.S.

**English Trade Mark Law**

England did not establish a comprehensive system for trademark
protection until 1905. Prior to the Act of 1905, it was passed The
Merchandise Marks Act on August 7, 1864 dealing provisions with
deceptive indications after that in 1875 the Trade Mark Registration
Act was also passed. Before passing a new Act in 1938, The Act of
1905 was amended in 1919 and 1937. In the act of 1919 the register
was divided into two parts, Part A and Part B. The distinction is thus
stated in Kerly’s book: “Registration in Part B conferred lower rights
than registration in Part A, being only *prima facie* evidence that the
proprietor has the exclusive right to the use of the trademark, even
after seven year registration. Subject to certain restrictions, a mark
which had for not less than two years been bona fide used in the United
Kingdom as a Trade Mark, was entitled to registration in respect of the
goods in connection with which it had been so used. ³

The Act of 1938 consolidates the law on the subject, such as
“associated trademarks” a defensive mark system, consent to use
system and non claiming right system. According to Kerly’s book,
“Law of Trade Marks”, “The Trade Marks Act 1938 which consolidates
the law, consequently appears as a complicated piece of legislation
abounding in cross-references provisions and exceptions”.

Alongside of the rights conferred by registration, the common law
rights of action regarding passing off and actions by unregistered
owners were left untouched. These rights were established in the case
in *Millington V. Fox, (1838) 3 My & Cr. 338*, and other cases. These
cases have laid down the conditions under which a right of property as
regards trade mark may be acquired, and the extent and manner to and in which protection will be given.

After the Act of 1938 there were many changes in the international field relating to intellectual property. Thus, the Trade Marks Act, 1994 was enacted in the United Kingdom to make new provisions for registered trademarks implementing Council Directive No. 89/104/EEC of 21 December, 1988, to approximate the laws of Member States relating to Trade Marks; to make provisions in connection with the Council regulations (EC) No. 40/94 of 20 December, 1993 on the Community Trademarks; to give effect to the Madrid Protocol relating to the International Registration of Marks of 27 June, 1989 and to certain provisions of the Paris Convention of the Protection of Industrial Property of 20 March, 1883 as revised and amended and for other connected purposes.4

American Trademark Law

American Trademark Law came with English trademark law. The Lanham Act was passed on July 5, 1946. This Act established a procedure for federal registration of trademarks, which may not be immoral deceptive or scandalous or falsely suggest a connection with persons, institution's beliefs or national symbols. Lanham Act was amended in 1975 to allow for attorney’s fees in exceptional cases. In 1984 congress passed the Trademark Counterfeiting Act which included new civil actions with awards of treble damages. After that Trademarks law Revision Act passed in 1988, the object behind it was to bring trademark law more in live with the international standard. The Lanham Act was amended by Dilution Act of 1996 to protect the interest of business. Lastly an Anti-Cyber Aquatting Consumer Protection Act 1999 came into existence. The introduction of this act basically meant that those who have rights to trade mark also have
rights to the associated domain name, so no body besides Coca Cola.com register the domain name Cokacola.com on the internet.

Indian Trademark Law

The British Government of India passed the Trade Mark Act 1940. This Act was based on the T.M. Act 1938 of England which came into force on June 1, 1942. It was the first statute law on Trade Marks, for uniform and systematic registration of trademarks in India. Prior to the Act of 1940 trademark was governed by common law. The ownership of our trademark was obtained by registering it under the Indian Registration Act 1908. After independence, significant development took place in the field of business and trade. To meet with these challenges the Trade Mark and Merchandise Act 1958 was passed, which replaced the Trade Mark Act 1940.

India joined WTO and become a member in 1995; it was then obligatory on the Indian Government to bring the Indian law in consonance with TRIPS. Hence the Trade Marks Act passed in 1999, which came into force with effect from 15th September, 2003. The Trade Marks Act 1999 replaced the Trade Mark Act 1958. The Indian Trademark law is now fully compatible with the TRIPS Agreement.

That a comprehensive review of the existing law be made in view of developments in trading and commercial practices, increasing globalization of trade and industry, the need to encourage investment flows and transfer of technology, the need for simplification and harmonization of Trade Mark management systems and to give effect to important judicial decisions. The Trade Marks Act, 1999 proposed to incorporate to achieve above purposes, inter alia the following, namely–
a) Providing for registration of Trade Mark for services, in addition to goods;
b) Registration of Trade Marks, which are imitation of well-known Trade Marks, not to be permitted, besides enlarging the grounds for refusal of registration mentioned in clauses 9 and 11; Consequently, the provisions for defensive registration of Trade Marks are proposed to be omitted-
c) Amplification of factors to be considered in defining a well-known mark;
d) Doing away with the system of maintaining the registration of Trade Marks in Part A and Part B with different legal rights, and to provide only a single register with the simplified procedure for registration and with equal rights;
e) Simplifying the procedure for registration of the registered user and enlarging the scope of permitted use;
f) Providing for registration of “Collective Marks” owned by associations etc;
g) Providing an appellate Board for speedy disposal of appeals and rectification applications which at present lie before High Court;
h) Transferring the final authority relating to registration of certification of Trade Marks to the Register instead of the Central Government;
i) Providing enhanced punishment for the offences relating to Trade Marks on par with the present copyright Act, 1957 to prevent the sale of spurious goods;
j) Prohibiting use of someone else’s Trade Marks as part of corporate names, or name of business concern;
k) Extension of application of the convention country to include countries which are member of group or union of countries and Inter-Governmental organisations;
l) Incorporating other provisions, like amending the definition of “Trade Mark”, provisions for filling a single application for
registration in more than one class, increasing the period of registration in more than one class, increasing the period of registration and renewal from 7 to 10 years, making Trade Mark offences cognizable, enlarging the jurisdiction of courts to bring the law in this respect on par with the copyright law, amplifying the power of the court to grant ex-parte injunction in certain cases and other related amendments to simplify and streamline the Trade Mark law and procedure.

In view of the extensive amendments necessitated in the Trade and Merchandise Marks Act, 1958 the Government thought it fit to repeal and re-enact the said Act.

**Treatment of Part B Registrations of 1958 Act in Trade Marks Act, 1999**

As Parts A and B the Trade Marks register have been integrated into one Trade Marks belonging to Part B on the commencement of the 1999 Act have become equal to Part A Trade Marks. The Trade Marks which do not fulfil the strict requirement for Part A registration of the 1958 Act could obtain registration in Part B of the register. In addition to satisfying the definition of Trade Mark, the only condition for registration in Part B of the register was the capability of distinguishing the goods, the expression “distinctive character” in 1999 TM Act equated to the expressive capability of distinguishing in 1958 Act. In the 1999 Act the standard required for registration of all Trade Marks is capable of distinguishing which in lower than the requirements under the 1958 Act. The Protection extended in larger in terms of goods and services, The overall quality of protection of all Trade Marks enjoying protection under Trade Marks Act, 1999 is a bit lower in view of the amendments in erstwhile section-17 and insertion of section 30 (1)
Collective Marks-A New Category of Marks

The collective mark is different from other Trade Marks as a collective mark distinguishes the goods or services of members of an association of persons from the goods or services of another. The association is registered as proprietor of the Trade Mark and the member who uses the marks can do so if they fulfil registrations which are filed together with the application. Regulations of the association are open to public inspection. Members using the registered marks are referred to an authorised user. Use by members, refused to as authorised users, is deemed to be the use by the proprietor. It is desired from the Trade Mark that it should possess such qualities which indicate that it is a collective mark. It should become clear and is not taken to be something other than a collective mark.

Some Important Features of Trade Marks Act, 1999

The important and distinguishing features of the Trade Marks Act, 1999 are as follows-

(1) Registration of Trade Marks for Goods and Services

These are no provision for the registration of service marks in India till Trade Marks Act, 1999, introduced it for the first time. Now Trade Marks Act, 1999 provides for registration and protection of Trade Marks in respect of both goods and services. The term ‘goods’ is defined to mean “Anything which is the subject of Trade or manufacture.”

Services have been defined in section 2 (1) (j) which reads

“Services” means service of any description which is made available to potential users and include the provisions of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit
funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising.

This is quite comprehensive and an all-subsuming definition, service of every description which is made available may have Trade Mark. The definition goes on to effectively mention business industrial and commercial matters and by way of caution or to make matter explicit enumerates 20 types of services. The opening part of the definition does not require valuable consideration as necessary condition.

For the purpose of registration of Trade Marks goods were classified into 34 classes as set out in the Fourth Schedule to the Trade Marks Rules, 1958 and a Trade Mark could be registered in respect of any or all of the goods comprised in a prescribed class of goods. If registration of a mark was required for goods falling under two or more classes, separate applications were to be made for each class.

Now the Registrar has to classify goods and services under section 7 (1) in accordance with the international classification of goods and services. An alphabetic index has to be issued under section 8 of the 1999 Act. Section 157 authorizes the Central Government to determine the manner of publication of the alphabetic index of classification of goods and services.

An application for registration of a Trade Mark can be made for goods or services comprised in more than one class, but the fee shall have to be paid for as many numbers of classes in which the goods or services fall.
(2) **Associated Goods and Services**

Section 2 (3) enacts a new provision. It indicates that the law shall recognize goods and services in an associated manner if the goods and services are provided by one business undertaking. The effect is that a Trade Mark may be used for goods as well as for services and when a Trade Mark is being used for goods by a proprietor who also makes provisions for services from the same business he would be entitled to spill over reputation of the Trade Mark for the purposes of services or vice versa. Section 2 (3) reads:

(3) For the purpose of this Act, goods and services are associated with each other if it is likely that these goods might be sold or otherwise traded in and those services might be provided by the same business and so with descriptions of goods and descriptions of services.

A person who is providing services would not be able to appropriate a Trade Mark already used for goods by one of the services are associated with the goods. Similarly when a Trade Mark is already used for services it shall not be appropriated by another person seeking to sell goods under that Trade Mark. If the goods are associated with services that they can be sold or traded in, by the some business which handles the services? The declaration that the goods can be associated with services or vice versa, would give a proprietor of a Trade Mark a pre-emptive right in relation to associated goods or services as the case may be. The associated goods and services would also be covered in the expression “Similar” occurring is section 11 or section 29.

(3) **New Categories of Trade Marks**

Trade Marks Act, 1999 has introduced distinct unequal categories of Trade Marks namely.
(i) **Trade Marks; and**

(ii) **Well-known Trade Marks**, with different rights before the Registrar in registration or opposition proceedings. A third category is on those unregistered Trade Marks proposed for registration. The fourth category is of reputed Trade Marks which are infringed when unauthorized used on different goods or services under section 29 (4). This category would combine the second and third categories above.

(4) **Trade Mark Tending to Become Absolute**

In India, and in other countries, there is no exclusive right to use of the Trade Mark in relation to all goods or services. The exclusive right in available on registration of a Trade Mark in respect of only those goods or services for which it is registered or used, including the right to restrain others from using a similar Trade Mark. To vindicate this right, there is a right of opposition to registration of new Trade Marks similar to the earlier registered Trade Mark. The Trade Marks Act, 1999 has enlarged this right of restoring to opposition, In 1958, Act the right of the opposition was in relation to some goods which are now being extended to similar goods or services in section 11 (1). If the earlier mark is a well-known Trade Mark, the right to oppose the registration extends when the Trade Mark is opposed even in relation to dissimilar goods or services. There is still further right in section 11 (3) to oppose registration of similar marks, in case the earlier Trade Mark is entitled to resort to copyright law or law of passing off. These laws are not concerned with goods or services or in other words they can be availed for dissimilar goods or services.

The enunciation of law in section 2 (3) also contributes to the Trade Marks becoming absolute for all goods or services. The goods and services are declared as associated when offered, provided or
traded by the same business. The Trade Mark rights may get expanded to an extent that a Trade Mark may become absolute for all goods or services or at least equal to well-known marks within India.

It appears that the basic tenant of Trade Mark law that the rights and goodwill of Trade Mark are only in relation to those goods or services on which the concerned Trade Mark is used, is in for change, to the situation that a Trade Mark shall enjoy rights for a whole range of goods or services. In any case now every Trade Mark has rights in relation to related, associated can cognate goods or services.

TRIPs and Paris Convention and Trade Mark Act, 1999

The Indian trade mark law laid down in Trade and Merchandise Marks Act, 1958, has been re-enacted on 30th December, 1999 as the Trade Marks Act, 1999 in order to comply with the obligations of the Paris Convention and TRIPs. The changes made in the law to make it compatible with the Paris Convention.

The provisions of the Paris Convention concerning the trademarks are discussed in three categories, 12

(1) National treatment and Indian trademarks law.
(2) Right of priority and Indian trade mark law.
(3) Obligations on member Countries - Rules detailing minimum standards of protection; requiring or permitting member countries to enact of protection following these rules and Indian trade mark law.

(1) National Treatment Principle

Articles 2 and 3 of the Paris Convention contain the most important provisions of national treatment. National treatment means
that each country which is party to the Paris Convention must grant the
same protection to nationals of the other countries as it grants to its
own nationals. Article 3 of the Convention requires that national
treatment must be granted even to nationals of non-member countries,
provided such persons are domiciled or has an industrial or commercial
establishment in a member country. The term “domiciled” does not
require a domicile in the strict legal sense of the term. A mere
residence, as distinct from a legal domicile, is sufficient.13

The trademarks of foreigners are not only to be protected, but are
also not to be discriminated against in any way. Without the rule of
national treatment, it would be very difficult to obtain adequate
protection in foreign countries for trademarks.

The term “national” includes both natural persons and legal
entities.

The national treatment rule means that the national domestic law,
it is then applied to the nationals of a particular member country, must
also be applied to the nationals of the other member countries. The
national treatment rule in Article 2 (1) excludes any Possibility of
discrimination to the detriment of nationals of other member countries.
Thus a member country gives protection to foreigners (nationals of
another member country) equal to its own nationals.

(a) Exclusion of the Reciprocity

Any requirement of reciprocity of protection is excluded. For
example, Indian has trademark duration of ten years and another
member country X has trademark duration of seven years. India will
provide a trade mark duration of ten years to the nationals of X where
as country X will provided seven years duration to the trade marks
originating from or belonging to the nationals of India as X provides to
nationals of X. Thus, the reciprocity requirements have to be structured
equivalent to what a member country provides to its own nationals or to the nationals of any other country. The reciprocity requirements cannot be used for curtailing the rights of nationals of other member country if the same is provided to its own nationals.

To comply with new developments and to deal with newer treaties or arrangements, Trade Marks Act, 1999 contains sections 154 and 155 which fulfil the demands and aspirations of the people in relation to trade mark laws. The method of reckoning the period in section 154(3) from earliest of applications is in line with the Paris Convention. The provisions in section 155 as to the reciprocity with the Paris Conventions.

(b) Negative Treatment

Section 155 authorises the Central Government to specify the country(s) which do not accord the same rights to Indians as it/they accord to its/their own national. If a country is so specified by the Central Government, then no national of such country (s) can;

- Apply for registration, or
- Be registered as the proprietor of a trade mark, or
- Be registered as assignee of a trademark, or
- Apply for registration or be registered as a registered user in Indian of any trade mark”.

It appears that the nationals of such a country would be eligible to become proprietors of unregistered trade marks in India, as there is no express bar against the same.

(c) Exceptions to the National Treatment Rule

Article 2(3) of Paris Convention reserves the national laws relating to judicial and administrative procedures, as well as to
jurisdiction and the requirements of representation. If national laws impose certain requirements of procedural nature or special conditions on foreigners for the above purposes, they can be imposed on the nationals of member countries also. An example of this is the requirement for foreigners to deposit a certain sum as security or bond for the costs of litigation. Another example is expressly stated; the requirement for foreigners to either designate or address for service or to appoint an agent in the country in which protection is requested. These are the most common special requirements imposed on foreigners and are permitted as an exception from the national treatment rule. In India only these requirements are applicable to foreigners in relation to trade marks. The registration procedure requires an address within India to be designated and security for costs can be asked.

(2) The Right of priority

The right of priority contained in Article 4 of the Paris Convention means that the registration application for a trademark filed with an application in one of the member countries entitles the applicant (or its successor in title) to apply for protection of the trade mark in all or any of the other member countries within a period of six months. All such applications filed within six months are regarded as if they had been filed on the date of first application. These later applications enjoy a priority status with respect to any application relating to the same trade mark filed in the intervening period in member countries. They also enjoy a priority status with respect to all acts accomplished after that date which could destroy the rights of the applicant for Trade Mark registration. Section 154 and 155 of the Trade Marks Act, 1999 are in conformity with and give effect to these requirements.
The effect of the right of priority is that the later application must be treated as it had been filed simultaneously at the time of the filing of the first application in any other member country. The basic advantage the right of priority offers to the applicant is that he is not required to present all applications at home and in foreign countries at the same time. The applicant has six months at his disposal to request protection and organised with due care the steps to be taken to secure protection in other member countries of interest to the applicant.

(3) Obligations on Member Countries

The Convention does not unify the Trade Mark legislation of member countries. Each member country is free to regulate the Trade Marks in its territory except for the specific obligations which the member countries are required to follow; these obligations are discussed below:

(a) Use of Trade Marks

Article 5C(2) of the Paris Convention permits the use of a Trade Mark in a different form in one of the countries, if such different form of the same Trade Mark does not alter the distinctive character of the Trade Mark. Such use shall not entail invalidation of the registration nor diminish the protection granted to the Mark. The Paris Convention allows for unessential differences between the forms of the mark as it is registered and as it is used. This is so for example, in cases of adaptation of translation of certain elements for such use\(^{18}\). The national authorities are to decide in actual practice as to the nature of the differences and whether they are permissible or not as per their own law.\(^{19}\) In other words the countries have the freedom to enact laws as to what should be treated as unessential difference or a substantial difference.
In India, section 47\textsuperscript{20} requires compulsory actual use of the Trade Marks, as otherwise it can be expunged on the motion of an aggrieved person. The cancellation of a Trade Mark can only take place if the period of 5 years or longer has elapsed from the date of actual entry of the Trade Mark in the register. Five years is considered a reasonable time as per the Trade literature of other countries. Thus the law has been in conformity with the clause (2) of Article 5C of the Paris Convention.

\textbf{(b) Concurrent Use of the Same Mark on Similar Goods}

The possibility of the same mark being used for identical or similar goods by two or more establishments, considered as co-proprietors of the Trade Mark, is addressed by Article 5C(3)\textsuperscript{21}. It is provided that such concurrent use will not impede the registration of the Trade Mark nor diminish the protection in any country of the Union. The Trade Mark may be registered for each of the concurrent users except where the said use results in misleading the public or is contrary to public interest. If the concurrent use misleads the public as to the origin or source of the goods sold under the same Trade Mark, it may not be registered. Further, if the quality of such goods covered by concurrent users differs to the point where it may be contrary to the public interest to allow the continuation of such inconsistency, national legislation may address the situation as is thought fit.\textsuperscript{22}

In India, the provisions in sections 12, 28(3), 33 and 35 of 1999 Act\textsuperscript{23} deal with concurrent use and the provisions are justifiable under this Article. They provide the necessary safeguards as contemplated by Article 5C (3) of the Convention. Equally, section 9(2) or the remedy of passing off would not allow confusion in the market place even if there is a vested right to use the Trade Mark. \textit{Bajaj Electricals Ltd. v. Metal & Allied Products AIR 1988 Bom 167} Section 28(3) may be
taken as declaring the concurrent registered proprietors as co-
proprietors.

(c) Grace Period for the Payment of Renewal Fees

Article 5b is requires that period of grace be allowed for the
payment of renewal fees. The Trade Mark registration and other rights
can be maintained by renewal in perpetuity. A failure to renew the
registration normally entails the lapse of the registration and in some
cases the expiration of the right to the mark. The grace period provided
is intended to diminish the risks of a Trade Mark being lost by an
involuntary delay in the payment of fees.24 A grace period of at least
six months for the payment of the renewal fees in envisaged. The
countries are free to levy a surcharge when such fees are paid within
the grace period can provide for a longer grace period.

During the grace period, the registration remains provisionally in
force.25 If the payment of the renewal fees (and surcharge where
appropriate), is not made during the grace period, the registration will
lapse retrospectively as of the original date of expiration.

In Trade Marks Act, 1999, Section 25 has been provided for the
conditions of payment of renewal of registration. The registrar is
required to send a notice to the owner for payment of fees. There is no
chance of any inadvertent delay on the part of the owner as stated by
the WIPO as a justification. Section 25(4) confers discretion on the
Registrar of Trade Marks. If he thinks it just to do so, he may allow the
payment of renewal fee after the expiry of six months26 but within a
period of one year and restore the mark. The Act does not mention the
trade mark registration provisionally remaining in force for a period of
six months as provided in the Paris Convention. But the effect is the
same as section 26 deems registration, though lapsed for non-renewal,
to be treated as continuing for a period of one year for the purposes of
registering another mark, which is similar to lapsed non-renewed mark, subject to the conditions in which the Registrar may exercise discretion.

(d) Independence of Trade Marks

Article 6 establishes the important principle of the independence of Trade Marks filed or registered in the country of origin from those filed or registered in other member countries. Article 6(1) states the basic principle of national treatment to the filing and registration of the marks. Regardless of the origin of the Trade Mark, a country has to apply only its domestic legislation in determining the fate of the registration application made by national of any member country. Trade Marks are independently in different countries of the Paris Union. Article 6(2) makes provision for applications by applicants entitled to the benefits of the Convention. An application for the registration of a mark filed in any member country may not be refused on the ground that filing, registration, or renewal of the marks has not been affected in the country of origin. Similarly a registration may not be cancelled on the above grounds. Article 6(3) state that a mark duly registered in a member country should be regarded as independent of Trade Mark registered in other countries of the Union, as also the country of origin. Thus, a mark once registered will not be automatically affected by any decision taken with respect to similar registration for the same Trade Mark in other countries.

Christine Holden v. Johnson & Johnson (1990) IPLR 96

In India, the Act does not refer to any of the obligations imposed by the country of origin, and nor does it require home country registration of the Trade Mark for registration in India. The Act has a territorial jurisdiction. The registration of Trade Marks in India does not have any relation with registration of the same or similar Trade Marks in other countries.
(e) **Well-Known Trade Marks**

Article 6b is, an important Article the Convention provides for the protection of well-known marks. It has also been referred to in Articles 16.2 and 16.3 of TRIPs. The subject of famous, well-known or reputed marks has made the law of Trade Mark quite involved. Deliberations have been taking place about the criteria to determine the well-known marks for which special additional protection was envisaged in the year 1925. After the application of TRIPs in developed countries in year 1996 and 2000 in developing countries, the possibility of applying well-known marks to different goods or different service is to be protected by member countries.

The following is the extent of protection under Article 6bis:

Firstly, a member country should refuse the application for registration of a Trade Mark conflicting with a well known Trade Mark for identical or similar goods.

Secondly, the member country must cancel the registration of a conflicting mark if registered.

Thirdly, the member country must prohibit the use of the conflicting Trade Mark for making a request for which a period of more than 5 years has to be fixed.

In India section 11(2), 27, 29(2) and 29(4) of the Trade Marks Act, 1999 are the enabling provisions which may be resorted to for protecting well-known marks which have now been defined in section 2 (l) (zg). Section 57 when read along with section 9(2), 11(2), 11(3), 11(10) and 33 provide removal/objection mechanism if the use of conflicting mark is likely to cause confusion not only in relation to same or similar goods but also in relation to different goods. For similar or different goods, relief could be given by courts alone under common law, but not statutory recognition is given to same in section 11(2), (3) and 29(4) of the Trade Marks Act, 1999.
**Kamal Trading v. Gillette.**\(^{30}\)

An existing registered mark may be injected if a well-known mark prays for an injunction in India, provided its repute can be proved in India by the use or acts of advertising. If the objection is taken at the time of registration or, early enough, the court shall grant an injunction. In recent times, protection has been extended to such Trade Marks also which were not used in India- **Blue Cross v. Blue Cross, 15 IPLR 92.** While protecting such Trade Marks, the courts have not dwelt on the theory of their being well-known as such and have said that their protection is justified on the grounds that a Trade Mark has acquired goodwill, and a reputation. The registration or use of a confusingly similar Trade Mark would, in most cases, be prejudicial to the interests of the public would be misled by the use of a conflicting Trade Mark. The courts have gone further and protected reputed Trade Marks from being used on goods of a different description whereas Article 6bis provides for measures only for identical or similar goods. But TRIPs goes further.

**(f) State Emblems, Official Hallmarks and Emblems of International Organizations**

The Article 6ter of the Paris Convention covers the following distinctive signs: armorial bearings, flags and other emblems, official signs and hallmarks indicating control and warranty, and any imitation of those signs from a heraldic point of view. It does not purport to create an industrial property in favour of these signs.\(^{31}\) Article 6ter obliges a member country, in certain circumstances, to refuse or invalidate the registration and to prohibit the use of the above as Trade Marks or as part of the Trade Marks, so as to restrict commercialization of the distinctive sings of member countries and certain international and inter-governmental organizations. If the State or Organizations concerned allow the use of their signs as Trade Marks, Article 6ter does not have any application.
Section 23 of the Trade Marks Act, 1999 has authorised the Central Government to issue general or specific directions in relation to the registration of Trade Marks.

(g) Assignment of Trade Marks

Sometimes a Trade Mark is used by an enterprise in various countries and it is desired to make a transfer of the Trade Mark rights in one or more of those countries. Some nations allow an assignment of Trade Mark without a simultaneous or corresponding transfer of the enterprise to which the Trade Mark belongs. Others require the simultaneous or corresponding transfer of the enterprise. Article 6quater of the Paris Convention regulates the assignment of the Trade Mark.

Section 37 and 38 of the Trade Marks Act, 1999 allow the assignment of a registered Trade Mark with or without the goodwill of the business. Section 39 of the Trade Marks Act, 1999 permits the assignment of the unregistered mark without goodwill of the business.

The transfer of assignment of the Trade Mark rights in other countries with or without the transfer of the enterprise are not the concern of the Trade Marks Act, 1999 and are not required to be transferred for recognition of assignment of the Trade Mark in India. A member country may not regard the assignment of a Trade Mark as valid if the use of that Trade Mark by the assignee would be of such a nature as to mislead the public, particularly as regards important features of the trademarked goods. This freedom to avoid any confusion in the market place is in necessary and Section 40 and 41 of the T M Act, 1999 is directed toward this end.
Protection of Trade Marks Registered in one Country of the Union in other Countries of the Union

The Convention establishes a special rule for the benefit of the owner of Trade Marks registered in their country of origin in Article 6 quinquines of the Convention which provides for extra-territorial effects of the registration.

A Trade Mark which fulfils the required conditions must be accepted filing and protected in the other member countries. In the following cases the Trade Mark may not be protected even though it is accepted in the home country.

First: Where the Trade Mark infringes rights of the third parties acquired in the country where protection is claimed. These rights can be other rights in Trade Marks already protected in the country concerned or other rights, such as the right to Trade name or a copyright.

Second: When the Trade Mark is devoid of distinctive character, or is purely descriptive, or consists of a generic name (per Indian law).

Third: Where the Trade Mark is contrary to morality or public order, as considered in the country (India) where protection is claimed.

Fourth: If the registration of the Trade Mark (in India) would constitute an act of unfair competition, as Article 6 quinquines in subject to application of Article 1 Obis.

Fifth: Where the Trademark is used by the owner in a form which is essentially different from that in which it has been registered in the country of origin.

The Indian Trade Mark law, without referring to the country of origin, presently accepts for registration all or any mark whether registered in the country of origin or not. All marks are permitted
registration subject to the requirements and prohibitions for registration laid down in the Trade Mark law.

(i) **Service Marks**

A service mark is a sign used by enterprises offering services, for example, hotels, restaurants, airlines, tourist agencies, car rental agencies, employment agencies, laundries and cleaners, etc., in order to distinguish their services from those of the other enterprises.\(^{33}\)

Full-fledged registration and protection of service marks has been introduced from the commencement of Trade Mark Act, 1999 in compliance with Article 15 of TRIPs.

(j) **Nature of the Goods to which a Trade Mark is Applied**

Article 7 of the Convention stipulates that the nature of the goods to which a Trade Mark is to be applied shall, in no case, be an obstacle to the registration of the mark. The purpose of this rule is to make the protection of the Trade Mark independent of the question as to whether such goods may or may not be allowed to be sold in the country concerned. Thus the law should allow the registration as Trade Marks if the goods are to be disallowed. In this regard, Trade Marks Act, 1999 does not pose any obstacle in the registration of a Trade Mark. The Act is not at all concerned with features, quality or safety standards prescribed for the goods. The registration of the Trade Mark can be proceeded with, irrespective of the nature of goods or services. The explanation to section 9 of the Trade Marks Act, 1999 expressly incorporates this.

(k) **Trade Names**

Article 8 of the Convention obliges the member countries to protect the Trade names. A Trade name is the name of the enterprise engaged in the sale of goods or services and may or may not own the Trade Mark. A Trade name may become known, even if it does not own
any Trade Mark. The protection is to be extended without any obligation of filing or registration trade names as required for Trade Marks. Article 8 also clarifies that a Trade name need not form part of a Trade Mark or vice-versa. In India, the courts steadfastly protect the trade names without any condition that the name is registered. If there is an attempt to appropriate the business reputation, an injunction is issued.34

(l) Importation of Goods Bearing a Trade Mark or Name Unlawfully

Article 9 of the Paris Convention provides detailed rules in relation to seizure of goods which bear a Trade Mark or name unlawfully. Article 9(1) requires that the seizure of such goods, marked unlawfully, it is to be made in those countries where such Trade Mark or name is entitled to protection. There is some practical difficulty implementing Article 9(2) which requires seizure to be affected in the country where the unlawful affixation of the mark occurred. Section 140 of Trade Mark Act, 1999 seeks to address particularly the compliance with article 9 of the Convention.

(m) Collective Marks

Article 7bis obliges a member country to accept for filing and to protect, in accordance with the particular conditions set by that country, collective marks belonging to “associations”. These will generally be associations of producers, manufacturers, distributors, sellers or other merchants of goods that are produced or manufactured in a certain country, region or locality, or that have other common characteristic. The Paris Convention does not cover collective marks of States or other public bodies.

Collective marks have been introduced in the Trade Marks Act, 1999 for which provisions are to be found in section 61 to 68.
(n) Appellations of Origin and Indications of Source

Appellations of origin and indications of source are matters sufficiently related to the Trade Marks they are dealt with by the Geographical Indications of Goods (Registration and Protection) Act, 1999. Unfair competition is also a detailed subject combining many branches of IP and other totality of circumstances related to IP.

Legal Protection of the Trademarks

Before the statute on the trade marks came into effect, only the common law protection was available to a trade mark. If one’s trade mark was misrepresented by another trade the former could bring an action for deceit against the latter at the Common Law Courts. Later, when the court of Chancery - the Equity Court - came into being, it “used the action for ‘passing off’ to protect a trader who had developed a reputation or goodwill through the use of a particular sign or symbol. However, to avail of these remedies was not an easy task.

“In such action the plaintiff had to prove that his mark or name was so well established and for such a length of time that the use of the mark or name was associated by the consuming public with the plaintiff and with a particular quality. He had further to prove that by using his mark, the defendant would be able to pass off his goods as those of the plaintiff. Necessarily evidence had to be let in, of a large number of witnesses. The process of proof was complicated, tedious and costly.

To make the matters worse for the plaintiff he had to go through all these ‘rituals’ of proof every time to prove a case of deceit or passing off against a defendant. To circumvent these difficulties the traders raised their demand for more effective and easily available
protection for their trademarks. A Select Committee of the House of Commons appointed in 1862 with a view to make proposals ‘recommended favourably as regards merchandise marks’ but ‘they did not endorse the proposal urged upon them for the establishment of a Register of Trade Marks and the creation of trademark rights by registration.’

This demand was met with by the Trade Marks Registration Act 1875. The object of the Act is thus stated in the Kerly’s Law of Trade Mark.

“The object of the Act was twofold; it was directed to diminish the difficulty and cost of, or to remove altogether the necessity for, the proof of title by use and reputation; to secure the publication of marks which had been appropriated as trademarks; to define the rights of their proprietors, for the information of traders; and further to limit the classes of marks which should be capable of being so appropriated”. Thus, under the Act of 1875, registration of a trade mark for a particular class of goods became prima facie evidence of exclusive proprietary right of the owner of the trade mark. The first trademark registered under the Act in 1876 was a red triangle used as the trademark for an alcoholic beverage. The mark still continues to be used.

However, it was not until the enactment of the Trade Marks Act, 1905 that the term “trademark” could find a definition in the statute. Also, its amended version known as the Trade Marks Act, 1919 divided the Register in two parts viz. Part A and Part B. Kerly remarks:

“Registration in Part B conferred lower rights than registration in Part A, being only prima facie evidence that the proprietor has the exclusive right to the use of the trade mark even after seven years of registration. Subject to certain restrictions, a mark which had for not
less than two years been bona fide used in the United Kingdom as a Trade Mark, was entitled to registration in respect of the goods in connection with which has been so used.\textsuperscript{39}

The owners of valuable trade marks were not satisfied even with these improvements which had aimed at giving statutory shape to the common law rights of the trademark owners. They, therefore, demanded a greater monopoly right than what was achievable by the Act of 1919. This resulted in an amendment of the Act in 1937 and, soon thereafter, enactment of the Trade Marks Act, 1938. The Act, however, left untouched the common law rights of action regarding passing off and actions of unregistered owners.\textsuperscript{40}

Following the Mathys Departmental Committee’s recommendations in 1974 to admit service marks onto the register of trademarks, the same was implemented a decade later.\textsuperscript{41} These changes notwithstanding the demands were continued to be raised to simplify the law in order to bring it in time with international law and practice. ’As a result, twenty years after Mathys, basic changes have been introduced into United Kingdom law by the Trade Marks Act, 1994.\textsuperscript{42}

**Meaning and Definition of Trade Mark**

A trademark is a means of identification. It has a visual symbol in the form of the word, a device, or a label applied to articles of commerce with a view to indicate to the purchasing power that they are the goods manufactured or dealt by other persons. Trademark is a mark used a proposed to be used in relation to goods.\textsuperscript{43} it is not to registered trademarks but it must be a mark in relation to goods.\textsuperscript{44} We can say that in other words trademarks are visual representation attached to goods for the purpose of indicating their trader origin.
The legal concept of Trade Mark can be understood by referring to the definition of the Trade Mark in Section – 2 (1) (zb) The Trade Mark Act 1999. Trade Mark” means 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.

In relation to chapter XII (other than section 107) a registered Trade Mark or a mark used 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, as the case may be, and some persons having the right as proprietor to use the mark.

In relation to other provisions of this Act, a mark used or proposed to be used 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, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person and includes a certification Trade Mark or collective mark.

This definition is applicable to registered as well as unregistered Trade Marks. In the new definition of Trade Mark there are inserted more substantive requirements for being a Trade Mark than the definition of the 1958 Act. Some of the substantive requirements of registration are now found in the definition of Trade Mark, which were earlier read from the scheme of the Statute and common law. Section 2 (1)(zb) clearly states that:

1. Trade Mark must be a mark which includes a device, brand heading, label, ticket, name, signature word, letter, members shape of goods, packaging or combination of colours or any combination thereof : S2 (1) (m)
2. Trade Mark must be capable of being represented graphically.
3. It must be capable of distinguishing the goods or services or one person from those of others.
4. It may include shapes of goods, their packaging and combination of colour.
5. It must be used or proposed to be used in selection for goods or services.
6. Thus use must be or the purpose of indicating a connection in the course of Trade between the goods or services. And some persons having the rights as proprietor to use the mark.
7. The right to the proprietorship of a Trade Mark may be acquired by registration under the Act or by use in relation to particular goods or services.
8. The right of proprietorship acquired by registration is a statutory right which acquires no actual user but only an intention to use the mark. On the other hand the right acquired by actual user in relation to particular goods or services, is a common law right which attached to the goodwill of the business concerned.

**Trade Marks under Trips Agreement**

Section 2 of Part I of TRIPs deals specifically with trademarks. The section spreads over seven Articles viz. Articles 15 to 21. Article 15 deals with protecting able subject-matter and defines a trademark as ‘any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings.’

Article 16 talks of rights conferred on the owner of a registered trade mark and states that [the owner of a registered trade mark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar
signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion.46

Most importantly, Article 16 (2) provides that Article 6b is of the Paris Convention (last revised in 1967 at Stockholm) shall apply mutatis mutandis to services relates to the well known marks. Likewise Article 16 (3) of TRIPs provides that the said Article 6b is “shall apply mutatis mutandis to goods or services which are not similar to those in respect of which a trade mark is registered, provided that use of that trade mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided also that the interests of the owner of the registered trademark are likely to be damaged by such use.47

In determining whether a trademark is well known, states Article 16 (2) of TRIPs, members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the member concerned which has been obtained as a result of the promotion of the trademark. 48

Article 17 provides that members may provide limited exceptions to the rights conferred by a trade mark; Article 18 that initial registration and each renewal of registration of a trademark shall be for a term of not less than seven years, and that the registration of a trade mark shall be renewable indefinitely; and Article 19 that where requirement of use is necessary to maintain registration in a member country, the registration may be cancelled only after an uninterrupted period of at least three years of non-use.49

TRIPs also provides that the use of a trade mark in the course of trade shall not be unjustifiably encumbered by special requirements
such as use with another trademark or use in a special form or use in a manner detrimental to its capability to distinguish the goods or services of one undertaking from those of other undertakings (Article 20). Members, stating Article 21, may determine conditions on the licensing and assignment of trademarks, it being understood that the compulsory licensing of trademarks shall not be permitted and that the owner of a registered trademark shall have the right to assign the trademark with or without the transfer of the business to which the trademark belongs.50

**Identification of a Trade Mark**

**A. Word or Words (Known or invented)**

This is the primary source of trademark. The majority of the world’s most famous trademarks consist of one or more word marks being of the modern age, word marks may consist of known words, perhaps, gleaned from a dictionary, a book of Greek mythology or an astronomical publication. They may be missing-spelling of such known words or they may be invented words having either no meaning or perhaps a hidden meaning which only belongs apparent when the mark is attacked to the goods e.g.

| Birdseye  | Nike  |
| Coke      | Pursche |
| Channel   | Orange |
| Chevroles | Pepsi |
| Hoeverprozae | prozae |
| Kodak     | Rayban |
| Lucosie   | Reebok |
| Lego      | Relex |
| Mar/boro  | Sony  |
B. Pictorial Device (Logo)

Pictorial device can be powerful means of product recognition particularly in case where language or lack of literacy may be concerned.

<table>
<thead>
<tr>
<th>Company</th>
<th>Symbol</th>
</tr>
</thead>
<tbody>
<tr>
<td>Esso</td>
<td>Tiger</td>
</tr>
<tr>
<td>International Olympic Committee</td>
<td>Five Rings</td>
</tr>
<tr>
<td>Kellogg’s</td>
<td>Cockerel</td>
</tr>
<tr>
<td>Lloyds TSB</td>
<td>Black Horse</td>
</tr>
<tr>
<td>Mercedes Benz</td>
<td>Bonnet Star</td>
</tr>
<tr>
<td>Michelin</td>
<td>Tyreman</td>
</tr>
<tr>
<td>Renault</td>
<td>Diamond</td>
</tr>
<tr>
<td>Shell</td>
<td>Shell</td>
</tr>
</tbody>
</table>

C. Letters and Numerals

One or two letters and/or numerals generally lack distinctiveness without use. With use, however, such marks may become distinctive. With widespread use, they can become world famous.

<table>
<thead>
<tr>
<th>Mark</th>
<th>Description</th>
</tr>
</thead>
<tbody>
<tr>
<td>BP</td>
<td>Petroleum product</td>
</tr>
<tr>
<td>4711</td>
<td>Perfumery</td>
</tr>
<tr>
<td>501</td>
<td>Jeans</td>
</tr>
<tr>
<td>57</td>
<td>Food Product</td>
</tr>
<tr>
<td>MTV</td>
<td>Music broadcasting</td>
</tr>
</tbody>
</table>
No5 Perfumery
Q8 Petroleum Product
XXXX Alcoholic Beverages

D. Colour

Another means of product recognition, which if employed wisely, can minimize the amount of market share taken by generic competitors.

Heinz Turquoise Packing
Duracell Black and Gold Batteries
Esso Blue Parafud
Signal Red striped Toothpaste
Owens-coring Pink Fibre glass insulation

E. Shapes

As with colours, distinctive shape can inhibit the inroads made by generic competition.

Cointrean Liquer bottle
Dimple whisky Bottle
Jif Plastic Lemon
Toblerone Chocolate bar
Toilet-Duck Disinfectant
F. Slogans

Although the slogan tends to be used as a means of advertising a product, they may become so well known that they also identify the product.

Example

Orange The future bright, the future’s orange
Coca-coin It’s a real thing
Kellogg’s conflates The sunshine breakfast
Pedigree chum top breeders recommend it
Audi Vorsprung Durch Technique
British air ways The worlds’ Fabourite Airlines
Pepsi Yes Peyas hai baree

G. Sounds and Smell

More exotic than the trademark listed above. However there is no reason, in principle, why a distinctive advertising jingle or a distinctive smell, associated with a product such as a disinfectant, should not qualify as a trademark.

Example

Direct line Jingle Direct licence Insurance
Air on a to string Hamlet Cigars
Flower Duct from Lakme British Airways

The clearance of a trademark for use and registration when choosing a new, distinctive trademark to be used in new product, the company and the individual making the choice should want to know the answer the fundamental question.
Am I free to use the trademark chosen for the product in view of earlier trademark that are either already in use or intended to use?

Will I be able to register my trademark chosen on the elsewhere thereby increasing my level of protection against unfair competition?

These questions are best answered by a professional trademark advisor, who is trained to compare the chosen trademark with potentially conflicting trademarks owned by another company/individual, to assess the commercial risk of bringing of the new mark into use and estimate the likelihood of successfully registering the mark.

**Essential of a Trade Mark**

There are certain essentials which every Trade Mark posses to be a Trade Mark. These are –

(1) **Identity of Proprietor**

It is not necessary for the Trade Mark to identify to the proprietor or the permitted user or in other words the person who is applying for placing the mark on the goods. However, many a time labelling or trade description requirements make it necessary to state the name and address of the manufacturer, but it is not a condition emerging from the fact of being a Trade Mark.

(2) **Use**

The mark should be used or proposed to be used in relation to goods and services. To be a Trade Mark, a prior use in relation to goods or services is not necessary. But the proposal to use has to be viewed in the context of making an application for registration of the Trade Mark.
A registration application gives a priority to the proposed mark against the subsequent use or proposal to use by another applicant after the date of application for registration by the first applicant.

(3) Trade Mark for Goods or Services
The fundamental principle of the Trade Mark law throughout the world is that there is no Trade mark is vacumed; it is always in relation of goods or services, i.e. for some specific description of goods or services. Normally the rights have been available only in relation to the goods or services similar to the goods or services for which Trade Mark in either registered or in relation to which it is used. There rights have been inhumed from same goods or services to similar goods or services in India. The new species of well-known Trade Mark enjoy protection even for different goods or services because of international acceptance in Article-16 of TRIPs.

(4) Use in Course of Trade
The mark must be used in the course of Trade i.e. when the goods or services are ordinarily offered for sale and purchase in the market. The presence of a market is sine qua non for operation of any Trade Mark rights or real validity of any advantages of the Trade Mark. In hospital world Trade Mark 1967 RPC 95, free distribution of the journal was not considered as use in the market as a Trade Mark. It also follows that to put a Trade Mark or your own collection or on goods being gifted by a person is not equivalent to putting a Trade Mark on goods.

(5) Connection Between Goods and User
The mark must indicate a connection between goods or services on which it is used and the person who has the right to use that mark on their good and services. By applying the mark on the goods or services, the goods or services become distinctive of the proprietor on
the permitted user. In other word, the planning of the marks should make the goods or services distinctive so that they can be distinguished from other goods or services of the same description.

(6) Competitive Goods or Services

The definition also brings to light two very important factors. It presupposes that there are competitive goods or services for the same description with which the above mark or the person does not have any connection. The compilation with other goods or services whether branded by any Trade Mark or Unbranded, has to be emphasized. The absence of competitive goods or services may pose serious problems to the proprietors of the Trade Mark as the Trade Mark may become a generic name or becomes identified as the product name, which further becomes a ground for removal of the Trade Mark from the register of the Trade Mark.52

(7) Eight Key Characteristics in Section 9 (1) (b)

There is no bar on the Trade Mark that it should not include (i) Kind (ii) quality (iii) quantity (iv) Intended purpose (v) value (vi) geographic origin or (vii) time of production or rendering of service or (viii) other characteristics of goods or services. Seeing the registration requirements, if the Trade Mark is constituted exhaustive of these eight disabilities, it would not be registered. Any of the above eight characteristics may, in association with some other matter, comprise a valid Trade Mark.

(8) Registered Proprietor

The term proprietor is not defined in Trade Marks, Act, 1999 and is not governed by the Act, as it defines only ‘registered proprietor’ in Section 2 (1) (v). The registered proprietor is the person for the time being entered in the register as the proprietor of a Trade Mark.
**Function of Trade Mark**

A Trade mark performs three functions.

(i) It identifies the product and its origin,

(ii) It guarantees its unchanged quality; and

(iii) It helps to advertise the product.

Primarily, Trade Mark gives an indication to the purchaser or possible purchaser as to the identity of the manufacturer or quality of goods, or source from which goods come, or the trade channels through which they pass on their way to the market. It tells the person who is about to buy that what is presented to him is either what he has all along known or the source with which he is acquainted or that it is what he has healed or before as coming from that similar source. It gives the purchaser a satisfactory assurance of the mark and quality of the article he is buying, the particular quality being not discernible by the eyes. It is with the implicit faith of the mark being genuine and promising a quality equal to that he previously found with a similar mark to that the purchaser makes his purchase. A Trade Mark may be used to indicate not only that the goods are of a particular maker put are also goods of that makers of a particular kind or quality. A trade may indicate his best quality by one Trade Mark, his second quality by another Trade Mark and so on.

**Trade Mark as a Property**

Trade Marks are property, just like building and machinery. Everyone realizes that, through neglect building and machinery can become dilapidated or unusable. However, it is often forgotten that, through lack of use or misuse, a trademark can also lose value. In extreme cases of misuse, the trademark can become a more generic description of a product, with no commercial value at all. This could have a more divesting effect on a business than any natural disaster.
Set our below are some important do’s and don’ts of trademark usage provided they are followed in written documents and, where appropriate, in speech, the dooms day scenario set out above should be avoided.

(1) **Ensure that the Trademark Stands Out from its Surroundings**

This can be achieved by employing at least one of the following simple techniques.

1. Write the first letter of each word in a trademark as a capital letter.
2. Write the whole trademark in a capital letter.
3. Use an unusual type face, such as Italics, for the trademark.
4. Use bold colour lettering for trademark.

(2) **Use of Trademark in Association with a Generic Description of the Product.**

This should ensure that the consuming publics are aware of the trademark nature of the trademark. In other words, that the trademark is not generic description of the goods.

This is a particularly important rule for novel patented products that are sold for a long period without competition. It is important in such a case, to think of an appropriate generic description of the new product as it is think of a trademark for the product. If this is not done, there is a real danger, once the patent expires, that the trademark will be seen by the trade as the generic names if your doubts this consider the fate of cell phone, escalator and gramophone, all once well-known trademarks; but now generic names.

**Examples**

<table>
<thead>
<tr>
<th>Solar System</th>
<th>Chocolate bar</th>
</tr>
</thead>
<tbody>
<tr>
<td>Zeus</td>
<td>Washing powder</td>
</tr>
</tbody>
</table>
Ownership of Trademark

I place “SM” or “TM” or ® superscript after the trademark. “SM” may be used to identify both registered and unregistered service marks “TM” may be used to identify both registered and unregistered trademark, for goods. ® may only be used to identify registered trademarks (but may be used in relation to goods, and services). In a number of countries, it is a criminal offense, to identify an unregistered trademark with the symbol ® it follows that many companies which global marketing interests, use of “SM” and “TM” to identify their trademarks, both registered and unregistered.

Thus from the above discussion it is clear that there is no right to the exclusive Ownership of a trademark apart from its use. Property in a trademark can be obtained by registration of the mark.

Summation

Trademark has existed as long as the trade itself. It is defined under section 2(1) (zb) of the Trade Mark Act 1999. It means that a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those if others and may include shape of goods. Their packaging and combination of colours, a trademark is a commercial asset intended to be used commercially by businessmen. In business and economic matters move often the term “brands” is used for the expression trademark. However as and when legal issues are discussed in relation to brands the marketing men to use the term trademark.

A trademark as defined under the trademarks Act 1999, It should be capable of distinguishing the goods or service of one from another.
and should be able to establish a connection or indication in the course of trade between the goods or services and the person claiming to have some right as proprietor for using the mark. Protection of trademark rights will definitely promote the development of new products and services with the immense growth in the scale of business. For the last several years, trademarks were the poor relation of the intellectual property family, undervalued and misused by much of the business community.

Now the time and attitudes have been changed. Trademark law in India is passing through a remarkable and progressive phase. After the entry into force of the TRIPS agreement, India has given effect to its different provisions through amending the existing trademark law or legislating new ones. The new Act expands the scope of the definition of “trademark” to include graphic representation, shape packaging and combination of colours and covers both goods and services.
Notes & References


3. Supra note 1, page 2-3

4. Ibid page-3.

5. Explanation to Section 68 TM Act 1999.


7. Section 2 (1) (j) of Trade Marks Act, 1999.


10. Section-28.

11. Section 11 (2)


17. Section 131 and 132 of Trade and Merchandise Marks Act, 1958.


21. The Jargon of ‘some goods’ has been substituted with ‘similar goods or services’ in India in Section 11 and Section 29 or all other relevant provisions.

23. Section 33 is a totally new provisions. Section 12 (3), Section 28 (3) and in section 33 and 34 of Trade and Merchandies Marks, 1958.


26. At the mark is not to be removed in first six months from the Register.

27. Frederick W. Mostert, Famous and well known Marks – An International Analysis.


29. Section 11 (a), 27 (2) and 32 of Trade and Merchandise Marks Act, 1958.

30. 1988 PTC 1 (Bom)

How Parbros V. Tiger Batm. Co. 20 IPLR 265.
Cartier v. Ramesh Sawhney, 19 IPLR 214.
N R Dongre v. Whirlpool 20 IPLR 211.

31. WIPO, IB, WIPO/Del/91/4bis, Para 97.

32. Section 11 (3) of Trade Marks Act, 1999.

33. Meaning of Service marks as elaborated by International Bureau.

34. Ashwani Kumar, Paper on Expansion of Passing off, circulated WIPO-DU Training Programme 22-26 April, 1996.

37. Ibid, p.2
40. See Section 2 of Trade Marks Act, 1938 of U.K.
42. Ibid.
43. Section 2 (v) (31) Trade Mark Act 1958.
46. Ibid., p. 385
47. Daniel Gervais op. cit., p. 385
48. Ibid.
49. Ibid. pp. 385-86
50. Ibid p. 386
51. Artistic v. Rysta (1945) 62 RPC 65 (HL)
52. Section-36 of Trade Marks Act, 1999.