

Trade mark act 1999

Rasmita Jena

Assistance Professor

SoPLS, CUTM, BBSR

- A trademark or service mark is a word, name, symbol, or device used to indicate the source, quality and ownership of a product or service.
- A trademark is used in the marketing is recognizable sign, design or expression which identifies products or service of a particular source from those of others.
- The trademark owner can be an individual, business organization, or any legal entity. A trademark may be located on a package, a label, a voucher or on the product itself. For the sake of corporate identity trademarks are also being.

What is a trademark?

- A trade mark is a word, phrase, symbol or design, or combination of words, phrases, symbols or designs used in the course of trade which identifies and distinguishes the source of the goods or services of one enterprise from those of others.
- As stated above, the definition of "trade mark" under Section 2(1)(zb) has been enlarged to mean a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from others and may include shape of goods, their packaging and combination of colors and covers both goods and services.
- “Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof”. [Section 2(1)(m)].
- Being an inclusive definition it will thus include any mark within the definition of trade mark so long as the mark is –
 - capable of being represented graphically; and
 - capable of distinguishing the goods or services of one person from those of others.

Objective:

- A trade mark provides protection to the owner of the mark by ensuring the exclusive right to use it, or to authorize another to use the same in return for payment.
- The period of protection varies, but a trademark can be renewed indefinitely beyond the time limit on payment of additional fees.
- In a larger sense, trade marks promote initiative and enterprise worldwide by rewarding the owners of trademarks with recognition and financial profit.

The salient features of the Trade Marks Act, 1999

- Providing for registration of trade mark for services, in addition to goods.
- Amplification of definition of trade mark to include registration of shape of goods, packaging and combination of colors.
- All 42 international classification of goods and services (as earlier used) now applicable to India as well.
- Recognition of the concept of "well-known trade marks".
- Increasing the period of registration and renewal of trade marks from 7 to 10 years, to bring it in conformity with the accepted international practice.
- Widening the scope of infringement of trade marks. For instance, use of a registered trade mark as trade name or as a part of a trade name or use of a mark which is identical or deceptively similar to a registered trade mark.
- Creation of an "Intellectual property Appellate Board" for hearing appeals against orders and decisions of the Registrar of Trade Marks for speedy disposal of cases and rectification applications which hitherto lie before High Courts.
- Criminal remedies in case of falsification of trade marks.
- Recognition of use of trade mark by even an unregistered licensee.
- Expeditious examination of a trade mark application on payment of five times the application fee.

Trademarks serve the following functions:

- Source Identifier – common source of the good or service.
- Indication of Sponsorship of Authorization – for example the Olympic Rings signifies that the producer of the product is a sponsor of the Olympics.
- Distinguish goods or service – differentiates one firm's products from competitors.
- Indicate Value and Image – an effort to create an impression of quality or exclusivity in the mind of the consumer.

Need for legal protection

- In order to fulfill their distinguishing function for consumers who wish to make their choice between different goods of the same kind on the market, trademarks must be legally protected.
- Otherwise competitors could use identical signs for the same or similar goods or signs so similar that the consumer would be confused as to the origin of the goods.

- Trademark infringement occurs when there is a likelihood of confusion between two products and services. The courts consider the following things when determining trademark infringement:
 - Similarity of the marks.
 - Relatedness of the goods produced.
 - The strength of the plaintiff's mark – level of distinctiveness
 - Similarity of the market channels used.
 - The degree of care used by consumers.
 - The defendant's intent in selecting its mark.
 - Evidence of actual confusion.
 - The likelihood of expansion in product lines.

The following is a guide to selecting a proper trademark.

- Do not trademark the name of your product. If a firm cannot provide the generic name of a product without referring to the brand, the trademark is likely indefensible.
- When using a trademark in a sentence use the trademark as an adjective not a noun, alternatively always use the word “brand” after the trademark.
- In a sentence the trademark should be set aside from the rest of the sentence. Bold lettering, italics and all capital letters are examples.
- Do not allow the trademark to be defined by a dictionary or other published source.
- Use the appropriate trademark designation in print and other types of material.

How can a trademark be protected?

- A trademark can be protected on the basis of either use or registration.
- Both approaches have developed historically, but today trademark protection systems generally combine both elements.
- The Paris Convention for the Protection of Industrial Property of March 20, 1893 ("the Paris Convention") places contracting countries under the obligation to provide for a trademark register.
- Over one hundred States have adhered to the Paris Convention. Nearly all countries all over the world today provide for a trademark register, and full trademark protection is properly secured only by registration.
- A few countries have no trademark register at all, examples being Bhutan and the Maldives.
- This publication is based on the assumption that a trademark register exists in the countries of the participants, and concentrates on questions of trademark registration and the rights deriving from such registration.

The functions of a trademark:

- We have seen that the origin-indicating and/or distinguishing function of the trademark is the basis for its legal protection, but the trademark does, of course, have other functions: as already mentioned, consumers can usually rely on the consistent quality of the goods offered under the mark.
- This is sometimes referred to as the quality function or the guarantee function. Then again, its owner uses the trademark to communicate with the consumer, not only through the goods bearing the mark but also in advertising.
- One can describe these possibilities as the advertising function of the trademark.
- Finally, the trademark can, by its acquired reputation, become a valuable piece of property for the owner, allowing him to license or franchise it or to make other commercial use of it.

- Thus the trademark can have important economic functions which, however, are not normally protected by trademark law ; they depend mainly on the use made of the trademark by its owner.
- This is especially true of the quality function: if a consumer is deceived as to the quality of a product, he may have to resort to an action based on unfair competition or on specific consumer-protection legislation, as trademark law offers him no remedy.
- His best weapon against a trademark owner whose product, offered under the trademark, has disappointed him is to refuse to buy that product again.

Protection against unfair competition, counterfeiting and piracy

- The increasing importance of international trade has led to practices that can no longer be adequately tackled with the traditional concept of protecting a trademark against the use of an identical or confusingly similar mark on competing goods.
- Certain competitors tend to imitate not only trademarks but also the labels and the packaging used for the presentation of the goods, and dishonest traders even try to imitate products to such a degree that they are practically indistinguishable, for the averagely inattentive consumer, from the genuine article. Such practices often cannot be dealt with under traditional trademark law.
- The trademark owner must therefore rely on unfair competition law and other special rules that protect him against labelling and packaging imitations, counterfeiting and trademark piracy.

Who can apply for registration of a trademark?

- In general, any person who intends to use a trademark or to have it used by third parties can apply for its registration. That person can be either a natural person or a legal entity, even a holding company.
- The laws of some countries provide that the applicant must exercise a commercial activity involving the goods for which he requests trademark protection.
- There is, however, a tendency to abandon the requirement. This is true in Europe, as a consequence of the proposed introduction of a Community Trade Mark for which any person may apply.