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TRADEMARKS

THE TRADE MARKS ACT, 1999

TRADEMARKS

Section 2(1)(m) says that **<u>"Mark" </u>**includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof".

Section 2 (zb) of the Trademarks Act, 1999 defines **<u>"Trademarks" </u>**as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors and - "

- In layman's language a trade mark is popularly known as **brand name.** It is a visual symbol which may be a ***word, signature, name, device, label, numerals or combination of colors.***
- Essentials of a TM
  - – capable of being represented graphically; and
  - – capable of distinguishing the goods or services of one person from those of others.

OBJECT OF THE TRADEMARK

AS EXPLAINED IN DAU DAYAL V. STATE OF UTTAR PRADESH

- Safeguards the rights of manufacturer s and sellers using distinct trademarks
- Guards against the use of counterfeit trademarks by unauthorized entities
- Trademark provides uniqueness to the brand
- TM makes it easier for the customers to distinguish and identify goods.
- TM prevents unfair competition and provides legal framework for addressing trademark infringement

CERTIFICATION TRADEMARK

Section 2 (1) (e) of The Trade Marks Act, 1999

"certification trade mark" means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable as such under Chapter IX in respect of those goods or services in the name, as proprietor of the certification trade mark, of that person;

- A **certification trademark** indicates that a product or service meets specific **standards** or has particular **characteristics** (e.g., quality, origin, material).
- The TM ACT, distinguishes goods/services certified by the proprietor regarding – Origin, Material, Mode of manufacture, Performance of services and Quality or accuracy
- Purpose -
  - Ensures products meet standardized criteria set by the proprietor.
  - Protects consumers by providing reliable information about quality and safety. And Differentiates certified products from uncertified ones, ensuring trust and assurance for consumers.
- Few Examples - **ISI Mark** – Conformity to Bureau of Indian Standards, **BSI Hallmark** – Purity of gold, **Woolmark** – Products made from 100% wool.

COLLECTIVE MARK

Section 2 (1) (g) of The Trade Marks Act, 1999

"collective mark" means a trade mark distinguishing the goods or services of members of an association of persons not being a partnership within the meaning of the Indian Partnership Act, 1932 (9 of 1932) which is the proprietor of the mark from those of others;

- **A collective mark** is a unique symbol, name, or logo used by members of an organization or association to identify and distinguish their goods or services as belonging to the group.
- Unlike standard trademarks, a collective mark represents the collective identity, quality, or geographic origin of the group rather than individual producers or providers. It ensures that products or services meet the shared standards set by the association.
- **Purpose and Benefits:**
  - Distinguishes goods/services produced or provided by members of an association.
  - Promotes traditional Indian family trade marks.
  - Ensures public recognition of quality, qualification level, or geographic origin.
- Examples of collective trademarks include: the "**CA**" device used by the Institute of Chartered Accountants; the mark "**CPA**", used to indicate members of the Society of Certified Public Accountants

WELL-KNOWN TRADEMARK

As per Section 2(1)(zg), a "well-known trademark" is a mark recognized by a significant portion of the public for specific goods or services, such that its use on unrelated goods/services suggests a connection.

- **Key Features:**
  - **Stronger Protection:** Registrar must protect against identical or similar marks.
  - **International Recognition:** Aligns with the Paris Convention and TRIPS.
  - **Examples:** Coca-Cola, Nike, Google.
- **Purpose:**
  - Prevent dilution of brand value and
  - Ensure exclusive association with specific goods or services.
- **Case Study: Daimler Benz Aktiegesellschaft & Anr. v. Hybo Hindustan**
  - An undergarment retailer used the term "Benz" and a logo resembling the iconic three-star ring of Mercedes-Benz, a globally renowned automotive trademark.
  - The court ruled this as trademark infringement, prohibiting the use of "Benz" and the logo in the undergarment domain. The judgement highlighted the global reputation of Mercedes-Benz and reinforced the protection of well-known marks, even across unrelated industries.

TRADEMARK CLASSIFICATION

The Nice Classification (NCL) for Trademark Registration is an international system used to classify goods and services for the purpose of registering trademarks. The NCL categorizes goods and services into **45 classes**: Classes **1 to 34 cover goods**, while Classes **35 to 45 pertain to services**. Identifying the correct class is crucial before filing a trademark application, as registration under a specific class offers protection only within that category. If a trademark is intended for goods and services across multiple classes, separate applications must be filed for each class to ensure protection for the respective goods and services. This is a classification of almost 80,000 products and services. Following are the classes and categories for goods and services:

Class	Category	Class	Category
1	Chemicals	**7**	Machines and machine tools
2	Paints and Varnishes	**8**	Hand tools and implements
3	Bleaching Preparations	**9**	Scientific, electric, photographic Products
4	Industrial Oils and greases	**10**	Surgical, Medical and veterinary apparatus
5	Pharmaceutical, veterinary	**11**	Apparatus for lighting, heating
6	Common metals and their alloys	**12**	Vehicles; apparatus for locomotion

Class		Class		Class		Class	
13	Firearms; ammunition and projectiles	22	Ropes, string, nets	31	Agricultural, horticultural and forestry	40	Treatment of materials.
14	Precious metals and their alloys	23	Yarns and threads	32	Beers, mineral and aerated waters	41	Education, Training
15	Musical instruments	24	Textiles and textile goods	33	Alcoholic beverages(except beers)	42	Scientific and technological services
16	Paper, cardboard and goods	25	Clothing	34	Tobacco	43	food and drink, accommodation
17	Rubber, gutta percha, gum	26	Lace and embroidery	35	Advertising, business management	44	Medical services
18	Leather and imitations of leather	27	Carpets, rugs, mats	36	Insurance, financial affairs	45	Legal services
19	Building materials, (non-metallic)	28	Games and playthings	37	Building construction		
20	Furniture, mirrors, picture frames	29	Meat, fish	38	Telecommunications		
21	Household or kitchen utensils	30	Coffee, tea	39	Transport, Travel		

REGISTRAR OF TRADEMARK

Section 3
Trademarks Act, 1999

The Central Government appoints the Controller-General of Patents, Designs, and Trade Marks as the Registrar of Trade Marks

Other officers may also be appointed to discharge the Registrar's functions under their superintendence

Section 6
Trademarks Act, 1999

This section mandates the maintenance of a single Register of Trade Marks at the Head Office.

- Records can be maintained in electronic formats (floppies, diskettes, etc.) with safeguards.

Section 7 & 8
Trademarks Act, 1999

SEC 7 - This section empowers Classification of goods and services based on International standards for purpose of trademark registration

Sec 8 - This section requires the Registrar to publish an alphabetical index of classification of goods and services

REGISTRATION OF TRADEMARK

- It is the process of entering a trademark on the official register and Proprietors, companies, or individuals proposing to use the trademark can apply for it. The registration of TM is governed by **Trade Marks Act, 1999** and **Trade Marks Rules, 2017 (Chapter II, Rules 23–38).**
- The registration procedure in India is based on the 'first to file' system. It is therefore important that the rights holder applies for the registration of its mark as soon as possible.
- The Office of the Controller General of Patents, Designs and Trade Marks is the appropriate office for filing of a trade mark application in India. This office has branches in Mumbai, Delhi, Chennai, Ahmedabad and Kolkata.
- Following is the overview of the procedure/process of registration of a Trademark:

TM SEARCH

APPLICATION

OBJECTION

ACCEPTANCE

PUBLICATION

OPPOSITION

REGISTRATION

WHO CAN APPLY FOR TRADEMARK?

- As per Section 18 of the Trade Marks Act, 1999 any person "**claiming to be the proprietor**" of the trade mark 'used' or 'proposed to be used' by him may make an application in the prescribed manner for registration of his trade mark.
- "**Any person**" is wide enough to include any individual, company, or association of persons or body of individuals, society, HUF, partnership firm, whether registered or not, Government, trust etc. **[Section 3(42), General Clauses Act, 1897].**
- Trademarks are registered for **10 years** as per Sec 25 and can be renewed indefinitely, with renewal applications filed 6 months before expiration. A **grace period of 1 year** allows late renewals with a surcharge. Unrenewed trademarks may be removed from the register but can be restored upon meeting statutory requirements.

COMPANY

Application in corporate name; country of incorporation to be mentioned if outside India.

PARTNERSHIP FIRM

Application in names of all partners; omission of a partner's name can be corrected with supporting documents (Vivekananda Match Co. v. Jupiter Match Works, 1991).

TRUST

Application by managing trustee/chairman.

GOVERNMENT

Central/State Government or its undertakings can apply.

JOINT APPLICANTS

Section 24 allows joint proprietors to apply for marks used for joint goods/services.

PROCESS OF REGISTRATION

1. CHECKING TRADEMARK ELIGIBILITY

- Before applying for trademark registration, it is crucial to confirm that the proposed trademark complies with the **Trademarks Act, 1999.**
- A trademark must be **distinctive, non-descriptive, and unique,** ensuring it can differentiate the goods or services it represents from those of others.
- It **should not resemble** any existing registered trademarks, as this could lead to rejection or legal disputes and ensuring it does not cause **confusion** with existing trademarks.

2. TRADEMARK SEARCH

- Once the eligibility is established, the next step is to conduct a thorough search to check whether the proposed trademark is already in use or registered.
- This search can be performed through the **Intellectual Property India website** or the **Trademark Electronic Search System (TESS)**. A comprehensive search reduces the chances of rejection by identifying potential conflicts with existing marks.
- This step also helps in ensuring that the trademark does not infringe on any unregistered but commonly used trademarks, as identified through common law searches.

3. FILLING OF THE APPLICATION

- After confirming that the trademark is unique, the application is filed online through the **Controller General of Patents, Designs, and Trademarks (CGPDTM)** portal.
- The application must include all relevant details, such as the applicant's name, address, and nationality. If the applicant is a company, the company's details, such as its name and incorporation information, must be provided.
- Additionally, the trademark's description, including the logo or design and the goods or services it represents, must be included.
- If the trademark has been filed in another country, a priority claim can also be submitted, along with the details of the original filing.

4. EXAMINATION

- Once the application is submitted, it undergoes scrutiny by the **Trademark Registrar**. The Registrar examines the application for compliance with legal and procedural requirements.
- If any issues arise, such as similarity to existing trademarks or procedural deficiencies, an **examination report** is issued.
- The applicant is then required to respond to the objections within a stipulated timeframe by providing explanations, evidence, or amendments to resolve the issues.
- If the application is deemed compliant, it proceeds to the next stage.

5. PUBLICATION

- If the Registrar accepts the application, it is published in the **Trademark Journal**, a public record of trademarks. This publication invites third parties to review the proposed trademark and raise objections, if any, within three months.
- The purpose of this step is to ensure transparency and provide an opportunity for existing trademark holders to object if the proposed trademark infringes on their rights.

6. OPPOSITION & FEE

- If an opposition is raised, the applicant must file a counterstatement defending TM and explaining why it is valid and proving the trademark does not infringe existing rights. The Registrar reviews both sides and decides to accept or reject the application.
- After resolving or if no opposition arises, the applicant pays the prescribed fees, which vary based on the applicant type and goods or services covered.

7. REGISTRATION CERTIFICATE

- If no objections or oppositions remain, or if they are resolved successfully, the trademark is registered. The applicant receives a **registration certificate**, granting them exclusive rights to use the trademark.
- This certificate is crucial for enforcing trademark rights in case of infringement. The entire registration process typically takes 1–2 years, depending on the complexity of the application and any disputes raised.

BENEFITS OF REGISTRATION

01 Acts like a PR (Public Relations)

02 Valuable Asset for the Company

03 Act as Catalyst for Brand Promotion

04 Creates Opportunities for Business Expansion

05 Host of Exclusive Rights

06 Global Recognition

07 Offers Rights & Legal Protection

08 Presumption of Ownership

09 Make Brands More Credible and Trustworthy

10 Right to use the Registered Symbol

FORMS AND FEES

Form TM- A

Purpose: For registering a new trademark, collective mark, certification mark, or series mark. Includes details like applicant information, description of the trademark, and its intended use.

Fees:

- Individual/Startup/Small Enterprise: ₹5,000 (Physical) / ₹4,500 (E-Filing)
- Others: ₹10,000 (Physical) / ₹9,000 (E-Filing)

Form TM- P

Purpose: For post-registration changes, such as assignment, changes in ownership, or dissolving trademark associations.

Fees:

- Assignment/Transfer: ₹10,000 (Physical) / ₹9,000 (E-Filing)
- Dissolution or cancellation requests: ₹1,000 (Physical) / ₹900 (E-Filing)
- Time extension requests: ₹2,000 (Physical) / ₹1,800 (E-Filing)

Form TM- O

Purpose: For opposing a trademark, filing a counter-statement, or rectifying the register by canceling or varying registration.

Fees: ₹3,000 (Physical) / ₹2,700 (E-Filing)

Form TM- R

Purpose: For renewal/restoration of a registered trademark.

Fees:

- Renewal: ₹10,000 (Physical) / ₹9,000 (E-Filing)
- Renewal with surcharge: Additional ₹5,000 (Physical) / ₹4,500 (E-Filing)

CONTINUED..

Form TM- M

Purpose: For miscellaneous requests, such as extension of time, certified copies, amendments, or expedited processing of trademark applications.

Fees:

- General Requests: ₹1,000 (Physical) / ₹900 (E-Filing)
- Review or petitions: ₹3,000 (Physical) / ₹2,700 (E-Filing)
- Expedited Processing: ₹20,000 (Individual/Startup/Small Enterprise) or ₹40,000 (Others) (E-Filing only)
- Well-known trademark inclusion: ₹1,00,000 (E-Filing only)

Form TM- G

Purpose: For registering or maintaining a trademark agent's details, restoration of registration, or alterations in the register.

Fees:

- Registration as an agent: ₹5,000 (Physical) / ₹4,500 (E-Filing)
- Continuation of registration: ₹10,000 (Physical) / ₹9,000 (E-Filing)
- Restoration of registration: ₹5,000 + Continuation Fee
- Alteration of details: ₹1,000 (Physical) / ₹900 (E-Filing)

Form TM- U

Purpose: For registering a person as a registered user of a trademark or handles variation, cancellation, or suspension requests.

Fees: ₹5,000 (Physical) / ₹4,500 (E-Filing)

Form TM- C

Purpose: For requesting a search and issuance of a certificate regarding trademarks.

Fees:

- Standard Search: ₹10,000 (Physical) / ₹9,000 (E-Filing)
- Expedited Search: ₹30,000 (E-Filing only)

OPPOSITION

- Under Section 21 of the Trade Marks Act, 1999, any person can oppose the registration of a trademark, regardless of whether they have a commercial or personal interest in the matter.
- A Notice of Opposition must be filed using Form TM-5 with a ₹2,500 fee, including required details such as the application number, goods/services, and opponent's status.
- Section 21 does not specify an grounds listed so opponents can rely on any grounds under the Act or Rules. Few are as following –

1. Trade mark is not registrable (not distinctive or capable of distinguishing).
2. Essential part is a common word descriptive of goods/services.
3. Devoid of distinctive character (cannot differentiate goods/services).
4. Exclusively designates kind, quality, geographical origin, etc.
5. Generic or common to the trade.
6. Likely to deceive the public or cause confusion.
7. Hurts religious susceptibilities of a class/section of Indian citizens.
8. Comprises scandalous or obscene matter.
9. Similar to an earlier well-known trade mark
10. Trade mark is not graphically representable.

GROUNDS FOR REFUSAL TO REGISTRATION

ABSOLUTE GROUNDS FOR REFUSAL

Sections 9(1) to 9(3) of the Trade Marks Act define absolute grounds on which a trademark can be refused registration.

1. **Lack of Distinctiveness (Section 9(1))**

A trademark may be refused registration if it is devoid of distinctiveness, meaning it cannot distinguish the goods or services of one person from those of another. This applies to marks that are:

- **Devoid of Distinctiveness**: Marks that are generic or descriptive, which cannot identify the goods or services of a particular trader.
- **Descriptive Marks**: Marks that consist exclusively of terms or indications describing the goods/services, such as quality, geographical origin, or intended purpose.
- **Customary Marks**: Marks that have become commonplace in the trade or language.

However, a trademark may be registered if it has acquired distinctiveness through use or if it is a well-known trademark. Length of use was deemed a material factor in acquiring distinctiveness, as affirmed by the Supreme Court in **Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories (AIR 1965 SC 980)**.

2. Deceptive or Offensive Marks (Section 9(2))

A trademark may be refused registration if:

- **Deceptive Marks**: The mark is likely to deceive or cause confusion among the public.
- **Offensive Marks**: It contains matter that may hurt religious susceptibilities or is scandalous or obscene.
- **Prohibited Marks**: It includes matter prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.

If a trademark is similar to an existing mark with a reputation, it may be refused registration if it causes confusion. **Burrogh Wellcome v. Uni Sole Pvt. Ltd. (1999 PTC 188)**: In this case, the Bombay High Court applied the test of confusion not for the general public, but for professionals such as doctors and pharmacists in the pharmaceutical industry.

3. Shape Marks (Section 9(3))

Section 9(3) prohibits the registration of a trademark if it consists solely of the shape of goods that:

- Result from the nature of the goods themselves.
- Are necessary to achieve a technical result.
- Provide substantial value to the goods.

This provision prevents unfair market distortions created by monopolizing the shape of goods. The shape must not be merely descriptive or customary in the industry. If a shape claim in a patent application has been made to achieve a technical result, it may be subject to refusal under Section 9(3)(b). **Nestle v. Thankaraja (AIR 1978 Mad 336)**: The court affirmed the distinctiveness of coined words and found that "Nestle" had acquired secondary meaning in trade.

Relative Grounds for Refusal to Registration (Section 11)

1. Likelihood of Confusion (Section 11(1))

A trademark will be refused registration if the trademark is identical or similar to an earlier trademark, there is a likelihood of confusion among the public regarding the source of the goods or services. The core objective is to prevent consumer confusion by ensuring that a new mark does not appear to be connected to an existing one in the marketplace.

2. Prohibition of Registration of Marks Imitating Well-Known Trademarks (Section 11(2))

If a trademark is merely a reproduction or imitation of a well-known mark, registration will be refused, even if the goods or services are not identical. The **well-known mark** has trans-border reputation and substantial recognition, and any attempt to mimic such a mark can lead to consumer deception.

3. Protection from Passing Off or Copyright Violation (Section 11(3))

Passing Off: The use of the mark in India would be prevented by the law of passing off, which protects the goodwill and reputation of an earlier trademark. ***Copyright Violation:*** The use of the mark in India would violate the copyright of an earlier work unless the proprietor of the earlier trademark consents to the registration. This ensures that new trademarks do not infringe on established legal rights concerning unfair competition, passing off, or unauthorized use of creative works.

4. **Well-Known Trademarks (Section 11(6) and (7))**

- The **term "earlier trade mark"** as defined in Section 11, includes: **Registered Marks**: Any mark that is registered under Indian law, **International Registration or Convention Application**: Marks protected under international treaties, **Well-Known Marks**: Marks recognized in India, regardless of whether they are registered in India or not. The **well-known trademark** enjoys special protection, and the owner of such a mark may oppose the registration of an identical or similar mark, even if it is for goods or services that are not similar to those covered by the well-known mark.

5. **Factors Considered by the Registrar in Determining Well-Known Trademarks (Section 11(6))**

- **The Degree of Knowledge or Recognition**: Whether the mark is known by the relevant section of the public in India.
- **The Use and Reputation**: The extent to which the mark has been used and its reputation in India.
- **The Duration of Use**: The length of time the mark has been used in India or internationally.
- **Geographical Scope**: Whether the mark has been used in relevant markets and how widely it is recognized.

CONCURRENT USE: EXCEPTION TO SECTION 11 (SECTION 12)

Section 12 provides an exception to the relative grounds for refusal where **honest concurrent use** or special circumstances exist. This exception balances the rights of both parties involved, recognizing that the use of a mark in good faith can sometimes overcome objections based on earlier marks. In such cases, the Registrar may allow the registration of identical or similar trademarks, even if one is already registered, under the following conditions:

Honest Concurrent Use: If two marks have been used concurrently without causing confusion or harm to the public.

Special Circumstances: Where it is deemed proper to allow registration despite the conflict.

TRADEMARK INFRINGEMENT

Infringement of Registered Trademarks refers to the unauthorized use of a trademark that is identical or deceptively similar to a registered trademark, leading to confusion or harm to the distinctive character or reputation of the registered trademark

ACTIONS CONSTITUTING INFRINGEMENT

1. Use of a mark that is **identical or deceptively similar** to the registered trademark for **similar goods/services** is considered as infringement. Another infringement is use of a mark for **identical goods/services**, causing a likelihood of confusion or association with the registered mark.

2. Use of a mark for **dissimilar goods/services**, if the registered mark has a reputation in India and such use:

- Takes **unfair advantage**.
- Is **detrimental** to the distinctive character or reputation of the registered mark.

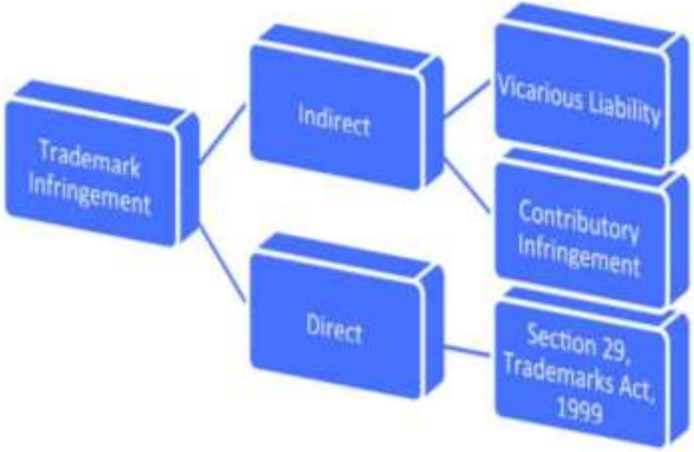
3. Using the trademark in advertising, labeling, packaging, or business papers without authorization.
4. Application of the trademark to goods or materials intended for commercial use.

Parle Products v. J.P. & Co. (1972): *Deceptive Similarity*: Two wrappers for biscuits had similar designs and color schemes, causing confusion among consumers. Held as infringement due to trade dress similarity.

INFRINGEMENT

A person will be liable for **<u>contributory infringement</u>** in two circumstances:

1. When a person knows of the infringement
2. When a person materially contributes or induces the direct infringer to commit the infringement.



<u>Section 114</u> of the Trademarks Act: If a company commits an offence under Act then every person who is responsible for the company will be liable. Except a person who acted in good faith and without knowledge of the infringement.

A person will be **<u>vicariously liable</u>** under the following circumstances:

1. When the person has the ability to control the actions of the direct infringer.
2. When a person derives a financial benefit from the infringement

PASSING OFF

Section 27 recognizes the common law principle of "Passing off". This provision safeguards the rights of a brand owner, even if their trademark isn't registered. It allows them to take legal action against someone who misrepresents their goods or services as belonging to the established brand.

1. Purpose:

- Safeguards the goodwill of unregistered trademarks under common law tort.
- Protects against misrepresentation and unfair business practices.
- Prevents consumer confusion and dilution of goodwill of a brand.

2. It was developed in ***Perry v. Truefitt (1842):*** "A man is not to sell his own goods under the pretense that they are the goods of another man." It extends beyond goods to include services, businesses, and other commercial activities.

3. Criteria for establishing Passing off:

Goodwill and Reputation: Prove that the trademark has established distinctiveness and consumer recognition. Goodwill forms the basis for protecting trademark rights.

Misrepresentation: Unauthorized use of a mark creating confusion about the origin of products/services. Must demonstrate public association with the legitimate trademark owner.

Damages: Show actual or potential harm: Financial loss, Reputational harm, Dilution of distinctiveness and goodwill

OFFENCES AND PENALTIES

Applying a false trademark or trade description attracts imprisonment (6 months to 3 years) and fines (₹50,000 to ₹2,00,000).

SECTION 103

Second or subsequent convictions under Sections 103 and 104 lead to stricter punishments: imprisonment (1 to 3 years) and fines (₹1,00,000 to ₹2,00,000).

SECTION 105

Violation of stamping requirements for piece goods, cotton yarn, or thread results in forfeiture and fines up to ₹1,000.

SECTION 106

Claiming a trademark is registered when it is not, or using symbols like "®" for unregistered marks, can lead to imprisonment (up to 3 years), fines, or both.

SECTION 107

Misleading claims that a business is connected with the Trade Mark Office can result in imprisonment (up to 2 years), fines, or both.

SECTION 108

Falsifying entries in the trademark register is punishable by imprisonment (up to 2 years), fines, or both.

SECTION 109

REMEDIES FOR INFRINGEMENT

CIVIL REMEDIES

1. Injunctions

- Courts can issue restraining orders to stop unauthorized use of the trademark.
- Temporary (ex-parte) injunctions may be granted early in a trial to prevent immediate harm.
- Interlocutory orders can also be issued to preserve evidence, discover documents, or restrain asset disposal.

2. Damages or Account of Profits

- Monetary compensation for losses suffered by the trademark owner.
- Plaintiffs can opt for damages or an account of profits generated by the infringer.

3. Destruction and Sealing of Infringing Materials

- Courts can appoint local commissioners to seize and destroy infringing goods.
- Infringers may be ordered to deliver up all products labeled with the unauthorized trademark.

4. Measures to Restore Reputation

- Infringers may be required to issue public apologies or publish corrective advertisements to restore the damaged goodwill of the rights holder.

CRIMINAL REMEDIES

1. Police Action and FIR - The police are empowered to file a First Information Report (FIR) and initiate investigations. Rights holders may secure search and seizure warrants when infringer details are unknown.

2. Penalties- Maximum penalty: 3 years imprisonment and a fine of up to ₹2 lakh.

3. Continual Nature of the Offense - As infringement is a continuing offense, there is no statutory limitation period for filing criminal suits.

4. Jurisdiction - Criminal cases are initiated in district courts or higher, ensuring no suit is filed in a court below this threshold.

CUSTOM LAW PROVISIONS

1. Seize Infringing Goods - Prevent entry of infringing goods at borders.

2. Destroy or Dispose of Goods - Goods infringing registered trademarks can be destroyed or disposed of as per regulations.

3. Prohibition of Re-exportation- Infringing goods cannot be re-exported in their original state.

JUDICIAL PRECEDENTS:

1. Midas Hygiene Industries v. Sudhir Bhatia (2004): Injunctions are necessary in cases of prima facie infringement.

2. Ramdev Food Products v. Arvindbhai Patel (2006): Loss of goodwill suffices to show irreparable injury.

3. Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal (2010): Delayed actions may affect injunction claims.

INTERNATIONAL REGISTRATION

The **Madrid Agreement (established in 1891)** and the **Madrid Protocol (adopted in 1989)** are international treaties that together form the "Madrid System," which allows trademark owners to apply for protection in multiple countries by filing a single international trademark application, simplifying the process of registering trademarks globally.

MADRID AGREEMENT:

2. It was Established in 1891 and revised multiple times (Brussels, Washington, The Hague, London, Nice, Stockholm).

2. It Simplified trademark registration across signatory countries.

MADRID PROTOCOL:

1. It was Introduced in 1989 to modernize the system and align it with the domestic laws of countries unable to adopt the original Agreement.

2. It Made the system more flexible and widely accessible.

ELIGIBILITY:

1. Open to States that are members of the Paris Convention for the Protection of Industrial Property.

2. Intergovernmental organizations with their own trademark registration systems can join the Protocol.

3. Countries and organizations party to either or both treaties are collectively known as Contracting Parties.

INTERNATIONAL APPLICATION

Designation of Contracting Parties:

- Applicants must specify the Contracting Parties where trademark protection is sought. Additional countries can be designated later.
- A Contracting Party can only be designated if both it and the applicant's Office of origin are parties to the same treaty (Agreement or Protocol).

Languages: Applications under the Agreement must be in French. Applications under the Protocol may be in English or French, unless restricted by the Office of origin.

Fees:

- Comprises a basic fee, supplementary fee (for goods/services beyond the first three classes), and complementary fee (for each designated Contracting Party).
- Least Developed Countries (LDCs) pay only 10% of the basic fee.
- Under the Protocol, some Contracting Parties may replace the complementary fee with an individual fee.

INTERNATIONAL REGISTRATION

Formal Examination by WIPO:

- The International Bureau of WIPO examines applications for compliance with formal requirements (e.g., classification of goods/services).
- Substantive matters, like potential conflicts with earlier marks, are left to individual Contracting Parties.

Publication and Notification:

If compliant, the mark is:

- Recorded in the **International Register**.
- Published in the **WIPO Gazette of International Marks**.
- Notified to designated Contracting Parties.

MADRID SYSTEM

Refusal of Protection: Each designated Contracting Party reviews the application under its domestic laws. Protection may be refused if the mark does not comply with substantive legal provisions.

- **Time Limits for Refusal**: Standard: **12 months** from notification by WIPO. Protocol: **18 months**, with an allowance for opposition-based refusals beyond 18 months.
- **Refusal Process**: Grounds for refusal must be communicated to WIPO, recorded in the International Register, and published in the Gazette. Subsequent actions (appeals/reviews) are handled directly between the applicant and the concerned Contracting Party. Final decisions must also be communicated to WIPO for publication.

Effects of International Registration: In each designated Contracting Party, international registration is treated as if the mark was directly registered with their Office. If no refusal is issued (or a refusal is withdrawn), protection is effective from the date of international registration.

Advantages of the Madrid System:

1. Simplifies trademark registration with a single application.
2. Requires filing in only one language (English or French).
3. Reduces costs by paying a single set of fees.
4. Streamlines renewals with one payment every 10 years.
5. Enables easy updates or assignments across all designated countries.
6. Avoids complexities of varying national procedures.

DOMAIN NAMES AND TRADEMARK

1. DOMAIN NAMES:

Domain names are user-friendly website addresses that are translated into IP addresses via the Domain Name System (DNS). They consist of unique identifiers and suffixes (e.g., .com, .org, .in), indicating the website's purpose or origin. Domain names can be used as trade names or trademarks if they meet the criteria under trademark law.

2. CYBERSQUATTING:

Cybersquatting involves registering domain names identical or similar to trademarks, intending to sell them at a profit. This practice infringes on trademark owners' rights but speculative domain name registration (without bad intent) is considered legitimate. Cybersquatting exploits trademark reputation and causes disputes.

3. DOMAIN NAMES AND INTELLECTUAL PROPERTY:

Domain names act as business identifiers and often clash with intellectual property systems, raising legal and policy concerns. The World Intellectual Property Organization (WIPO) has addressed conflicts between domain names and trademarks through administrative systems like the Uniform Domain-Name Dispute-Resolution Policy (UDRP).

DOMAIN NAMES DISPUTES IN INDIA

1. In India, there is no explicit legislation addressing cybersquatting or domain name disputes. The IT Act, 2000, does not cover these issues. Domain names are treated as trademarks based on use and brand reputation. Remedies available under the **Trade Marks Act, 1999** for passing off and infringement.

2. ".IN" Dispute Resolution Policy (INDRP) has been formulated by the **.IN Registry** under NIXI. It aligns with international guidelines and IT Act, 2000. Resolves disputes involving the **.IN ccTLD** through arbitration under the **Arbitration & Conciliation Act, 1996**.

3. Grounds for dispute:

- Domain name identical/confusingly similar to a name, trademark, or service mark.
- Registrant has no legitimate interest in the domain name.
- Domain name registered/used in bad faith.

4. Starbucks Corporation v. Mohanraj (2009):

www.starbucks.co.in was found confusingly similar to www.starbucks.in.

Arbitrator held the registration was in bad faith; domain transferred to Starbucks.

5. There is an urgent need for comprehensive legislation to specifically address cybersquatting and domain name disputes in India.

FIRM CREDENTIALS

- Boutique Law Firm of the Year (Hospitality) by Legal Era Awards 2023- 2024;
- Rising Star and Promising Law Firm of the Year -New Delhi for the year 2022-23 by Legal Era Awards;
- Notable Law Firm by Asia Law in 2022 in Banking and Finance, Capital Markets and Corporate and M&A;
- Boutique Law Firm of the Year by Legal Era in 2021-2022;
- Lex Favios has been awarded Client Choice Award for the year 2019 and 2020;
- Lex Favios has been recognized as “Consultant of the Year 2018” by The CEO Magazine in its December Issue and Sumes Dewan Managing Partner;
- IFLR 1000 Financial And Corporate 2018 (The Guide to the World’s Leading Financial Law Firms) has rated Sumes Dewan as a Notable Practitioner in Banking and Finance;
- IFLR 1000 Financial And Corporate (The Guide to the World’s Leading Financial Law Firms) has rated Lex Favios as a Notable Firm in the IFLR 1000 in 2017 and 2018 edition;
- India National Bar Association (INBA) presented Capital & Finance Market Law Firm of the Year 2016 award to Sumes Dewan, Managing Partner, Lex Favios;
- Indian Law Firm Awards 2015 by India Business Law Journal;
- Asialaw Leading Lawyers 2007, 2008, 2011 and 2013 ranked “Sumes Dewan” as leading lawyer in Capital Markets & Corporate Finance.

LEX FAVIOS - AWARDS

- **Awarded Rising Star Law Firm by India Business Law Journal**
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THANK YOU