

# **TRADEMARK**

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# WHAT-IS- A- TRADEMARK



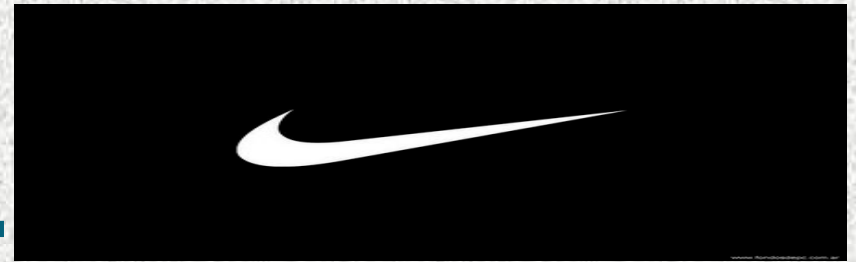
**A trademark** is a word, symbol, slogan, design, sound, color etc. or combination thereof that serves to identify the source of goods or services and distinguish them from others.



WORD



SYMBOL



SLOGAN



DESIGN



Sound Marks are a  
reality in India:  
'Yahoo yodel'  
registered



YAHOO!



# TRADEMARKS ACT, 1999

- First TM registered in UK under No. 1 of 1876 consisting of red equilateral triangle in respect of alcoholic beverage is still in force.
- The present Trade Marks Act, 1999 has replaced the Trade and Merchandise Marks Act, 1958. And the Trade Marks Act, 1999 has been brought into force only on 15th September 2003. The Trade Mark Rules, 2002 are passed under the Trade Marks Act, 1999.



# A trademark may be designated by the following symbols

- ™ (for an UNREGISTERED TRADEMARK, that is, a mark used to promote or brand goods)
- SM (for an unregistered SERVICE MARK, that is, a mark used to promote or brand services)
- ® (for a REGISTERED TRADEMARK)



# **WHAT IS THE FUNCTION OF A TRADEMARK**

- It identifies the goods / or services and its origin.
- It guarantees its unchanged quality.
- It advertises the goods/services.
- It creates an image for the goods/ services.



# How to select a Trade Mark ?

- A word, letter or any combination thereof and simple in design.
- If it is a word it should be easy to speak, spell and remember.
- The ideal word for a trade mark is an invented or coined word.
- Words which are laudatory or which directly describes the character or quality of the goods should not be adopted.



# Is it necessary to register a trademark?

Registration of a trademark is not compulsory. However registered trademarks have additional benefits when compared to unregistered trademarks. Registration of trademarks allows the owner of the trademarks to file infringement suits for violation of his rights whereas the unregistered user has to search remedies in common law.



# **Who may apply to register?**

Any person claiming to be the proprietor of the trademark used or proposed to be used by him can apply. The application may be made in the name of an individual, partners of a firm, a Corporation, any Government Department, a Trust or joint applicants.



# What is the procedure for registration?

## Sections 18-24 of Trademarks Act, 1999

The trademark Registry having its head office at Mumbai and branch offices at Delhi, Kolkata, Ahmedabad and Chennai keeps register of trademarks.

**Trademark search**

**Trademark Application in the relevant international class**

**Filling of your application**

**Obtaining acknowledgement**



# THEREAFTER.....

Trade Marks Registry will issue the first examination report (minimum 8-12 months required) and there is no objection in that they publish the mark in the Trade Mark journal for public information (minimum 3-5 months required) and will call for objections if any up to 3 months. If there is no objection from anyone, the Trade Marks Registry will issue the certificate of Trade Mark Registration.



# Information/Documents for filing trademark application

- Please furnish your full address to prepare the forms for filing.
- Sent me the Image file of your trademark (if it a logo, label or composite mark).
- Evidence for the usage if any.



# FILING OF FORMS

For filing new applications there are prescribed forms depending on the nature of application such as Form TM-1, TM-2, TM-3, TM-51 etc.

- ☐ To file a Notice of Opposition to oppose an application published in the Trade Marks Journal (**Form TM-5**).
- ☐ For Renewal of a Regd. trade mark (**Form TM-12** ).
- ☐ Restoration of removed mark (**Form TM-13**).
- ☐ Legal Certificate (**Form TM-46**).
- ☐ Request for search ( **Form TM – 54**).



# REFUSAL OF TRADEMARK REGISTRATION

## ABSOLUTE GROUNDS

- ☐ Which is devoid of any distinctive character.
- ☐ Which have become customary in the current language.
- ☐ Which indicates quality or other descriptive character of the goods or services

## RELATIVE GROUNDS

- ☐ A mark, which by its very nature will deceive the public or cause confusion.
- ☐ A mark, which is likely to hurt the religious susceptibilities .
- ☐ A mark, which contains scandalous or obscene matter.
- ☐ A mark, the use of which is prohibited under the Emblems and Names (prevention of Improper Use) Act 1950



# Terms of Trademarks

## Infringement

- If the use of a trademark is likely to cause confusion among the consumers about the origin of products or services then there is said to be trademark infringement.



## Passing off

- means introducing products or services into the market under someone else's trademark.



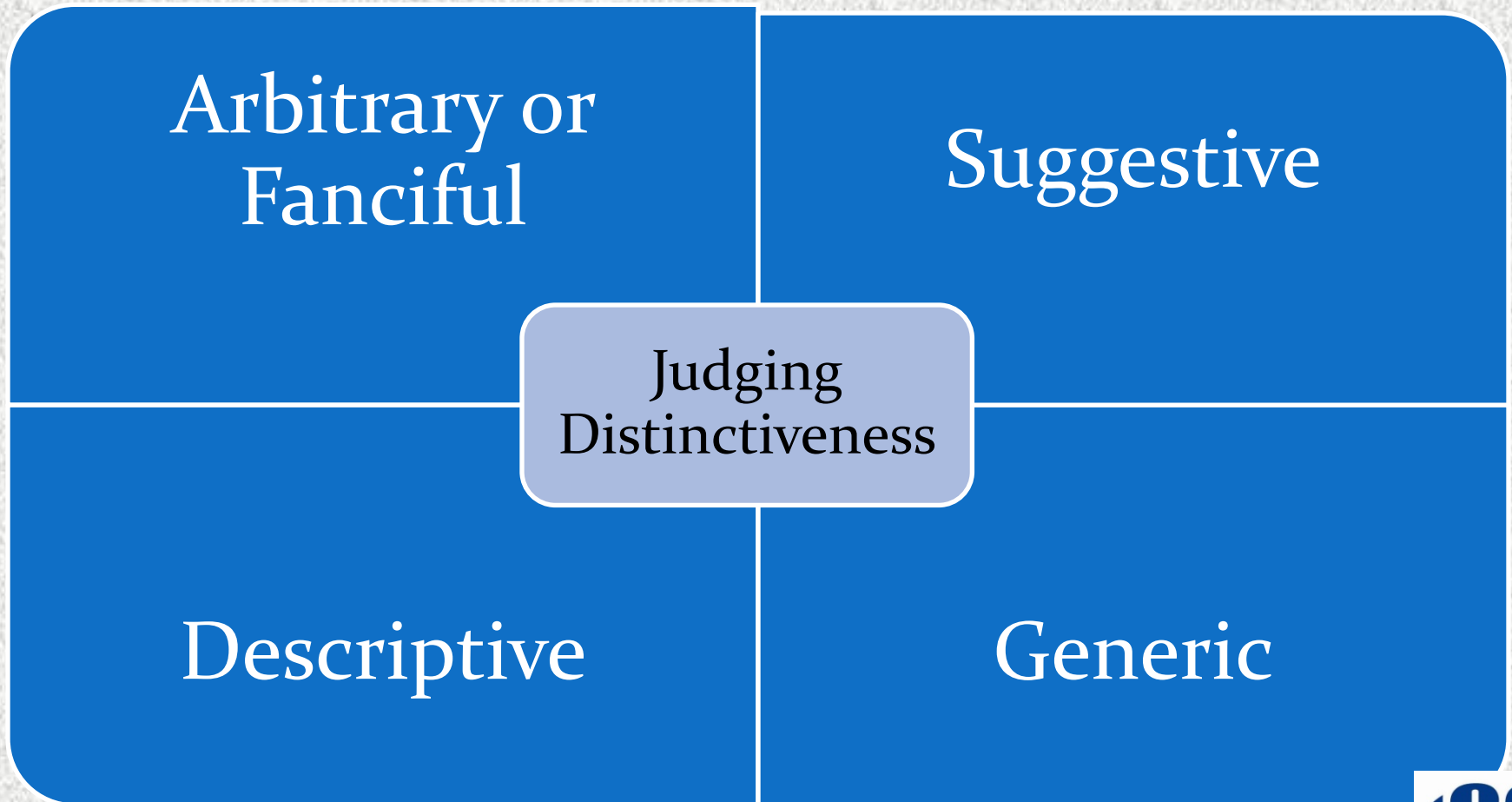
# Collective trademark v/s certification marks

Owned by an organization and Used by members to identify them.

certification marks may be used by anybody who complies with the standards defined by the owner of the particular certification mark.



courts group marks into four categories, based on the relationship between the mark and the underlying product or service



# TERM OF PROTECTION

- Initial registration and each subsequent renewal is for seven years.

- India provides ten years with effect from the commencement of Trademarks, Act, 1999.

- non-use of a registered trademark for a continuous period of five years is a ground for cancellation of registration of such trademark

# Since May 20, 2010

- ❖ **Class 42.** Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.
- ❖ **Class 43.** Services for providing food and drink; temporary accommodation.
- ❖ **Class 44.** Medical services, veterinary services, hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- ❖ **Class 45.** Legal services; security services for the protection of property and individuals; personal and social services rendered by others to meet the needs of individuals.



# Since May 20, 2010

## Another Change

That provides for issuance of duplicate registration certificate without any additional cost, if the Registrar is satisfied on a claim of Registered Proprietor supported by evidence that registration certificate has not been received by him. But further specifies that no such duplicate registration certificate shall be issued where such request is received after expiry of time limit for renewal or registration or restoration of the registered trade mark.



# Amul wins Trade mark case in Gujarat High Court, (Sep 24, 2007)

Amul has won the trade mark case in Gujarat High Court and no one else can use it. The Kaira District Co-operative Milk Producers' Union Ltd. and GCMMF had filed trade mark infringement cases, against two local shop owners ? Amul Chasmaghar and its partners and Amul Cut Piece Stores in the District Court, Anand. The District Court, Anand passed an order dated 25 April 2007, ruling that it was a clear case of infringement and restrained the two from using the Amul trademark. Amul Chasmaghar had challenged this interim injunction in the Gujarat High Court. The Gujarat High Court ruled the decision in favor of Amul, terming the order passed by the trial court as true, correct, legal and in consonance with the facts of the case, as well as in accordance with the provisions of the Trade Marks Act 1999.



# Apple files, dismisses suit against teenager who sold white iPhone 4 kits

- The teenage boy who runs an online business selling white iPhone 4 conversion kits has been hit with a trademark infringement lawsuit from Apple, though the company also filed a simultaneous request for dismissal.

Filed this week in U.S. District Court for the Eastern District of New York, Apple's complaint comes against Fei Lik "Phillip" Lam and his parents, Yuk Lam and Dunwah Lam. Their son created the website "whiteiphone4now.com," where he sold tools and materials that allowed customers to modify a black iPhone 4 and make it white.

The site has been offline since Apple issued a cease-and-desist letter on Dec. 1, 2010.

