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TRADEMARK LAWS

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ABSTRACT :

Trademarks have been around since the beginning of time. While people in the past relied on local craftspeople to get what they needed or prepared it themselves, there were nevertheless inventive entrepreneurs who promoted their products beyond their immediate area and sometimes even across long distances. Indian craftsmen have been marking their work for more than 3,000 years before transporting it to Iran. At one point, there were over 1,000 different Roman ceramic marks in circulation, all of which were made by Chinese manufacturers, including the FORTIS brand, which became so well-known that it was copied and counterfeited almost 2,000 years ago. As the middle Ages saw a boom in trade, merchants and manufacturers began using signs to differentiate their wares from each other. However, their monetary worth remained modest. Trademarks began to play a significant part in the current world of international trade and market-oriented economies as a result of the industrialization of the world.

INTRODUCTION :

Trademarks are a type of intellectual property. People can keep ownership of their inventive products and creative activity by using intellectual property rights. Because intellectual property was created through the efforts of human labor, it is restricted by a multitude of registration and infringement fees. Trademarks, Copyright Act, Patent Act, and Designs Act are examples of intellectual property.¹

A trademark is a name, word, or symbol that distinguishes goods from those of other businesses. With a trademark, marketing goods or services by procedure becomes considerably easier because product recognition is secured and made easy. The owner has the right to prevent a competitor from using his trademark or symbol.

¹ Narayanan, P. (2004). *Law of Trade Marks and Passing off* (6th ed.). Kolkata: Eastern Law House. p. 3. [ISBN 9788171772322](https://doi.org/10.1007/978-81-7723-222-2).

Trademarks are used to raise money for businesses. A trademark is not always a brand, but a brand is always a trademark. In some cases, people confuse a trademark with a brand name. However, trademarks are more than just symbols; they are an important part of a company's identity and are used to identify it from its competitors². People are more likely to trust a product's quality if it has a distinctive trademark. Trademarks can include everything from a visual emblem to a slogan.

There was no trademark law in India prior to 1940. A number of trademark infringement issues developed, which were settled under Section 54 of the Specific Relief Act of 1877, and registration was decided under the Indian Registration Act of 1908.³ In 1940, the Indian Trademark Law was enacted to address these issues. As trade and commerce grew rapidly after the trademark legislation was implemented, so did the demand for trademark protection.

The Trademark and Merchandise Act of 1958 replaced the Trademark Act. It improves trademark protection and inhibits the misuse or fraudulent use of trademarks on merchandise. The Act allows a trademark to be registered so that the owner of the trademark can get the legal right to use it exclusively.⁴ The government of India replaced the old Act with the Trademark Act, 1999 in order to comply with the World Trade Organization's TRIPS (Trade-related aspects of intellectual property rights) mandate. Offering legal protection to trademark users, directing the conditions on the property, and providing legal remedies for trademark rights are the objectives of the Trademark Act.⁵

When a trademark is infringed upon, the Trademark Act of 1999 gives police the authority to conduct arrests. For the sake of clarity, the Act offers a full definition of the term "infringement." Penalties and sanctions are laid out in the Trademark Act for anyone who violates it. The process of registering a trademark, as well as registering a non-traditional trademark, is considerably prolonged.⁶

² Landes, William M., and Richard A. Posner. "Trademark Law: An Economic Perspective." *The Journal of Law & Economics*, vol. 30, no. 2, [University of Chicago Press, Booth School of Business, University of Chicago, University of Chicago Law School], 1987, pp. 265–309, <http://www.jstor.org/stable/725498>.

³ CMRU KSCST Intellectual Property Cell/ <https://sites.google.com/cmru.edu.in/cmru-kscst-ip-cell/ipr-an-overview/national-legal-setting/> Last Visited : 12/01/2023

⁴ Supra 3

⁵ Supra 3

⁶ Assaf, Katya. "Magical Thinking in Trademark Law." *Law & Social Inquiry*, vol. 37, no. 3, Wiley, 2012, pp. 595–626, <http://www.jstor.org/stable/23252240>.

EVOLUTION OF TRADEMARK LAW

In the case of *Southern v How*, 1617, a clothier who had built a solid reputation by putting his mark on clothes he made was used to deceive and profit by another. The dictum "nobody has any right to represent his goods as the goods of somebody else" and "nobody has the right to pass off his goods as the goods of somebody else" was established. These ideas were adopted by the courts, and they have since become the law. Disputes like these were labeled as "passing off" and given remedies.

Common law trademarks predated the introduction of statutory law. This recognition of the necessity for legislation on trademark registration and protection against infringement in Britain in 1875 allowed for the very first statutory enactment.⁷

The British Trademark Act of 1875 stipulated that a trademark may only be registered if it clearly identified the trader's goods from those of others. Consequently, trademark registration was taken as prima facie proof of trademark ownership. At some point in time after repealing and replacing the Trademark Act of 1875, which allowed the registration of "fancy words not in common use" and "brands" as new trademarks, the Patents, Designs, and Trademark Act of 1883 was passed. The Trademark Act of 1905 completely replaced this legislation. It was re-enacted in 1938 as the Trademark Act.

The Trademark Act of 1940 was based on the British Trademark Act, of 1938, and was the first law on the subject in India. The Trade & Merchandise Mark Act, of 1958, was shaped in independent India. The Trademark Act, of 1999, came into effect on December 30, 1999, and is currently known as the Trademark Act, of 1999.

WHAT SOURCES OF LAW GOVERN TRADEMARKS?

Laws governing trademarks apply to both state and federal jurisdictions. In the early days of trademark law, state common law was the primary source of protection. The first federal trademark law was adopted in the late 1800s, however, by the US Congress. Since that time, federal trademark law has steadily evolved, supplanting state common law in many areas. The

⁷ Wolff, John. "Non-Competing Goods in Trademark Law." *Columbia Law Review*, vol. 37, no. 4, Columbia Law Review Association, Inc., 1937, pp. 582–608, <https://doi.org/10.2307/1116874>.

Lanham Act, enacted in 1946 and most recently revised in 1996, is the most important federal law. Laws of the United States, 15 U.S.C. As of today, federal law is the primary source of trademark protection, while state common law lawsuits are still accessible. For the most part, this synopsis discusses federal law.

DIFFERENT TYPES OF TRADEMARKS

- **Trademark for a service**

Any symbol, name, sign, device, or term used in commerce to identify and distinguish the services of one provider from those of another is referred to as a service mark. Service marks only apply to the distribution of services, not to physical objects.⁸ In everyday services, service marks are used:

- **Mark as a group**

A collective mark is used to identify the source of goods or services by employees and a collective group, members of a collaborative association, or any other group or organization. A collective mark is a mark that is used to identify a group of related organizations, as well as goods and services. This mark is used by the organization or group to divide the various goods or services provided by more than one person working in a group organization or legal entity. There are two types of collective marks that can be used to distinguish between similar goods or services:⁹

A collective mark identifies a marketer, merchant, or individual as a member of a specific organization or group. The collective trademark CA is used by the Institute of Chartered Accountants, for example. To identify the product's origin or source, the collective trademark and collective service mark are utilized. Individual members of a group of people use a collective trademark, which is registered as a whole. Members of the Institute of Chartered Accountants, for example, are given the title or mark CA. That collective mark may be used by the association's group. This provision was inserted into the Trademark Act of 1988.

⁸ Legal path shala/ <https://legalpaathshala.com/introduction-to-trademark-law-in-india/> Last Visited : 12/01/2023

⁹ Beebe, Barton. "Search and Persuasion in Trademark Law." *Michigan Law Review*, vol. 103, no. 8, The Michigan Law Review Association, 2005, pp. 2020–72, <http://www.jstor.org/stable/30044489>.

- **Mark of approval**

A certificate mark verifies or confirms a matter by assuring that some act has been performed or that some judicial formality has been followed.¹⁰ A certification mark is defined in the Trademark Act of 1999 as a mark that certifies particular qualities of products or services with which it is associated.¹¹

A certification trademark is one that can be used to identify the goods or services with which it is linked in the course of business and is certified by the mark's owner in terms of source, body, manner of manufacture, quality, accuracy, or other attributes.

In respect of any goods or services in the name of such person as the proprietor of the certification trademark that is not certified or registrable as such under this Act.

The Trademark Act of 1999 governs the registration of certification marks. The product must be competent to certify in order to be registered.¹²

- **Trade attire**

Trade dress refers to characteristics of a product's visual appearance, such as the design of a building or its packaging, that indicate the product's source to customers. It falls within the category of intellectual property. Consumers are protected by trade dress protection from products that are packaged or look to copy other products.

- **Trade dress is a must**

Anything that contributes to a brand's overall look, dress, and feel on the market. The consumer believes that trade dress is the most important factor in distinguishing one brand or item from another.¹³ The requirements for registering a trade dress are the same as for registering a logo or mark. Size, color, texture, graphics, design, shape, packaging, and many other characteristics are included in trade dresses.¹⁴

¹⁰ Supra 3

¹¹ Dogan, Stacey L., and Mark A. Lemley. "What the Right of Publicity Can Learn from Trademark Law." *Stanford Law Review*, vol. 58, no. 4, Stanford Law Review, 2006, pp. 1161–220, <http://www.jstor.org/stable/40040289>.

¹² McKenna, Mark P. "A CONSUMER DECISION-MAKING THEORY OF TRADEMARK LAW." *Virginia Law Review*, vol. 98, no. 1, Virginia Law Review, 2012, pp. 67–141, <http://www.jstor.org/stable/41350238>.

¹³ Supra 8

¹⁴ Supra 8

TRADEMARK LAWS IN INDIA

Trademark law in India is a very new development, having been incorporated into law only in the mid-19th century. India had no official trademark law prior to 1940. Section 54 of the particular relief act of 1877 was used to resolve several infringement and passing-off issues, and the issue of trademark registration was finally settled by getting an official declaration of trademark ownership under the Indian Registration Act of 1908.

In 1940, the Indian Trademarks Act was passed, which was identical to the English Trademarks Act at the time. Due to the rapid expansion of trade and commerce, there was a subsequent increase in the necessity for trademark protection. The Trademark and Merchandise Act of 1958 replaced this act. The purpose of this law was to make trademark registration and greater protection a reality, as well as to guard against the sale of counterfeit goods bearing false trademarks. Trademarks can also be registered under this law so that the trademark holder has the legal right to use the trademark. The goal of this legislation was to make it easier to register trademarks, improve trademark protection, and combat trademark fraud.

Renaming the Trademarks and Merchandise Act to the Trademark Act 1999 was done in order to comply with the World Trade Organization's recommendation that India's Trademark Law be in conformity with the TRIPS obligation. For the purposes of the 1999 Act, trademark rights will be protected, requirements for acquiring trademark rights will be imposed, and legal remedies for trademark violations will be available.

For the first time, service marks will be protected and provisions for collective markings will be provided. It will also distinguish between well-known trademarks and trademarks in general, with well-known trademarks receiving special protection and rights. In addition, under the 1999 statute, police have the ability to hold violators. Because it gave extensive definitions of commonly used terminology, increased penalties for offenders, extended the duration of registration, and registered non-traditional trademarks, the 1999 act can be considered a revision of the 1958 legislation. There are some differences between the 1958 and 1999 acts. Trademark Rules 2002 are the official name of the regulations promulgated under this act. On September 15th, 2003, both the Act and its set of rules came into effect. Indian trademark law is now governed by the trademark legislation of 1999 and the trademark rules of 2002.

Distinctiveness and misleading resemblance are the foundation of trademark law. The brand equity established by one person will be freely exploited by another if distinctive signs are widely employed. It is important to note that the value of a distinctive sign is influenced by sales volume and public perception of the sign.¹⁵

HOW DO WE ACQUIRE RIGHTS IN A TRADEMARK

If a trademark is eligible for protection, the first to use it in commerce or the first to register it with the U.S. Patent and Trademark Office will gain rights to the trademark ("PTO"). Code of Federal Regulations, Title 15, United States Code, Section 1127 (a). However, it is important to remember that descriptive marks can only be protected (and registered) if they have acquired secondary significance. As a result, descriptive marks may not be protected by trademark law for a period of time following their initial commercial use but before they acquire secondary significance. It is protected under trademark law once it gains secondary meaning.¹⁶

Use of a trademark generally refers to the sale of a product that includes the trademark. The priority to use the mark "Lucky" in the sale of bubblegum is mine if I'm the first person to do so in the open market (assuming that the mark otherwise qualifies for trademark protection).¹⁷ However, this priority is restricted to the locations where I now sell the bubble gum, as well as any further areas where I hope to expand or where the brand's reputation has already gained traction. I can undoubtedly prohibit competitors from establishing a "Broadway Pizza" in my geographic market if, for example, I sell pizza in Boston under the brand name "Broadway Pizza." It's unlikely that I'll be able to stop someone else in Los Angeles from opening a "Broadway Pizza."¹⁸

Priority can also be obtained by registering the mark with the PTO and demonstrating a genuine plan to use it in commerce. If you register a trademark with the United States Patent and Trademark Office, you can use it everywhere in the globe, regardless of where your products are sold. As long as the trademark has not been utilized by anyone else in a specified geographic

¹⁵ "Trademark Law — Infringement Liability — European Court of Justice Holds That Search Engines Do Not Infringe Trademarks. — Joined Cases C-236/08, C-237/08 & C-238/08, Google France SARL v. Louis Vuitton Malletier SA, 2010 ECJ EUR-Lex LEXIS 119 (Mar. 23, 2010)." *Harvard Law Review*, vol. 124, no. 2, The Harvard Law Review Association, 2010, pp. 648–55, <http://www.jstor.org/stable/25763022>.

¹⁶ Cyber Harvard Edu/ <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm>/ Last Visited: 13/01/2024

¹⁷ Supra 16

¹⁸ Supra 16

area, this right can be employed. A person who registers the trademark receives the right to use the mark outside of the geographic area in which the trademark was previously used if this is the case. There will be no loss of rights in Boston, but I will be able to use "Broadway Pizza" internationally if I submit a trademark application for it.

TRADEMARK REGISTRATION

You can apply for trademarks in writing to the proper registrar if you claim to be the owner of one or if you intend to use one in the future. There must be a clear and concise description of what is being sold and what is being offered, as well as a clear and concise description of the goods, the mark, and how they are used. The term "person" refers to a group of firms, a partnership firm, a corporation, a trust, a state government, or the federal government.¹⁹

TRADEMARK INFRINGEMENT

People who are not trademark owners can infringe on another person's intellectual property by using the trademark's name or look-alike in connection with goods or services that are registered under that trademark's name. An infringer's civil rights can be violated by legal action by the trademark owner. Trademark infringement, in its most basic form, refers to the use of a trademark in connection with goods or services in a manner that is likely to cause the trader confusion, difficulty, or benefit.

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¹⁹ Supra 8

INFRINGEMENT CASE LAWS

- **Dalal Avenue Verbal Exchange Ltd. vs. Hearst Company**²⁰

The use of a mark that is identical or deceptively similar to the trademark in relation to the goods for which the trademark is registered constitutes trademark infringement in the course of business. Such a person must utilize the mark in a way that makes it more likely to be mistaken for a trademark.

- **SatyaDeo Gupta vs. Amritdhara Pharmacy**²¹

The Supreme Court stated in this decision that two terms that are deceptively similar must be taken to determine the relationship in two words relevant to an infringement action. And you should judge them based on how they seem and how they sound. The things to which they are to be applied must be taken into account. The character and type of customer who is likely to purchase those things must be considered. In fact, the surrounding circumstances, as well as what is likely to happen if each of those trademarks is used in common ways as a trademark for the respective trademark owners' goods must be assessed.

After examining all of the circumstances, they came to the conclusion that there would be confusion. This is meant to imply that while it is improbable that one guy will be injured and the other will gain an illegal benefit, there will be disarray in the public impression, causing uncertainty about the goods and maybe preventing registration. There will be no action taken against a trademark that has not been registered.

A trademark owner's common law right to sue anybody who passes off their goods or services as their own is recognized in Section 27 of the Act, which stipulates that no infringement will be established with respect to an unregistered trademark.

It is possible to protect the integrity of trademarks by using trademark law, but it is not possible to silence valid reporting, analysis, criticism, and artistic expression by using trademark law. In the words of a court, "Trademark rights do not allow the owner to invalidate an unlawful use of the mark by somebody who is expressing thoughts or opinions, "LL Bean vs Drake

²⁰ (1995) 2 CALLT 346 HC.

²¹ 1963 AIR 449 ACT: Trade Mark--Likely to Receive or cause confusion- Approach to determine- Acquiescence-Effect of-Trade Marks Act, 1940.

Publishers”, Inc., 811 F.2d 26, 29 (C.D. Cal) (1st Cir. 1987) Many essential social and commercial discussions would be rendered impossible if speakers were constantly threatened with infringement lawsuits if they mentioned another company, person, or product by utilizing their trademark. *New Kids on the Block v. News America Publ'g*, 971 F.2d 302 (9th Cir.1992)

CONCLUSION :

Protecting names, logos, words, phrases, symbols, sounds, trade dress, product configuration, and other ways of identifying the source of commercial objects or services allows consumers to make more informed decisions while also encouraging firms to produce high-quality goods and services (Economides 1988). Suppliers who employ a distinctive mark to distinguish their products in commerce are granted trademark protection. Unlike suggestive or descriptive marks, which can only be protected after they have acquired secondary meaning for the general public, inherently distinctive marks (like Kodak for photographic supplies) and inherently distinctive marks (like Coppertone for sun tanning products) are protected right away. There is no expiration date for trademark protection, as long as a mark is not abandoned or affiliated with a general product category. It's no longer possible to trademark names like "thermos" and "escalator" because they've become generic and so unprotectable.

To prevent trademark infringement and customer confusion, trademark owners might take legal action. A prominent trademark owner may be able to injunction and collect damages for the dilution, blurring, or tarnishment of their mark in various nations and in the United States under federal law. It is permissible to use a trademark for comparative advertising or other descriptive reasons as long as it does not cause confusion in the minds of potential customers under trademark law.

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