

Introduction on Intellectual Property to Engineers and Technologists
Prof. T. K Bandyopadhyay
Department of Metallurgical and Materials Engineering
And
Rajiv Gandhi School of Intellectual Property Law
Indian Institute of Technology, Kharagpur

Lecture - 25
Trademark Registration

You got an idea about the trademarks, so now I will definitely as a form of derived why not to discussed about the mode or way to create the trademark right. (Refer Time: 00:45) about the rights if you do not know what is right, so worth less to learn little bit about it specifically now what. I will discuss about trademark right specifically, how to create rights just like say if you are compare with others forms of IP already.

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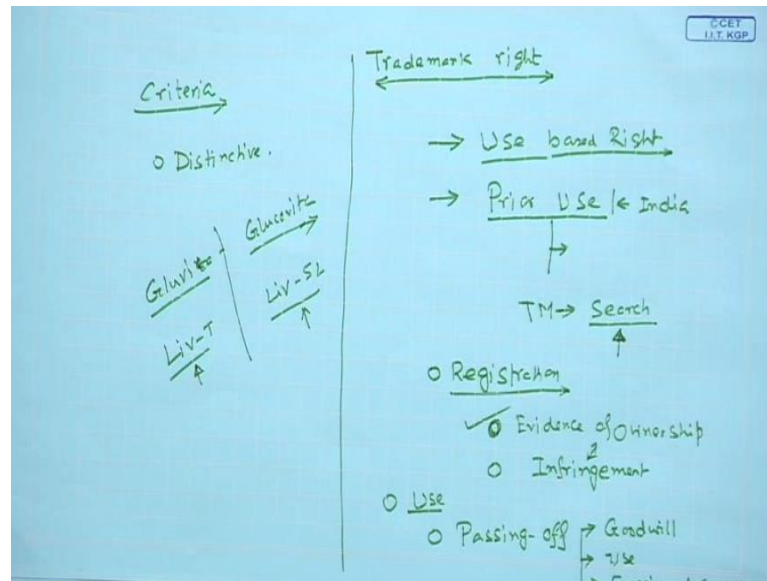
Trademark Registration

- Registration is not Mandatory
- Registration Provides
 - Registration affords better legal protection to facilitate an action for infringement
 - Ø The registered proprietor and authorised users can initiate infringement actions
 - Ø The authorised users can exercise the exclusive right to use the geographical indication
- Statutory Right can be renewed from time to time for further period of 10 years each.
- Authorized user....Permitted User/Registered User

That cooperate the registration is not compulsory industrial design registration is a compulsory. And based on first to five systems for industrial design and for (Refer Time: 01:23) if somebody files first he will write he would give the rights over that.

Now for trademark he will get little bit difference from whatever things we have things discussed till date. Now, for trademark registration is not mandatory. So, trademark rights we can generally consider I put it as a use based right.

(Refer Slide Time: 01:53)



Somebody use that trademark in the goods in the course of trade then also automatically we will get rights over the trademark and he can use the trademark in refers to the goods. So sometimes he use - means we considered prior use. Just like say example let us say you want to trade just you are interpreted you are now manufacturing some good. Now, you have to select a trademark.

In that case you have to be causes you should not use a trademark which is already available in the market. Market means not only Indian market, markets means you should consider the global context also because there is a concept called well known trademark. So, in this case although prior use always we consider is reference to use in India. You have to select a good trademark which is not in prior use, although registration is not compulsory but you should consider a prior use which is not be a prior use. Means it should there also a rule of search.

Just like industry design there is a search. Patent definitely search utility model definitely search again here the search. So, you have to search that that whether the trademark already in a prior use, so trademark search data bases also available. So, sometime based on TM search where from. So, you can search from the trademark office sites, you can search from some data bases available search data bases. So, search is also a required before use of the trademark because although registration is not compulsory, but what

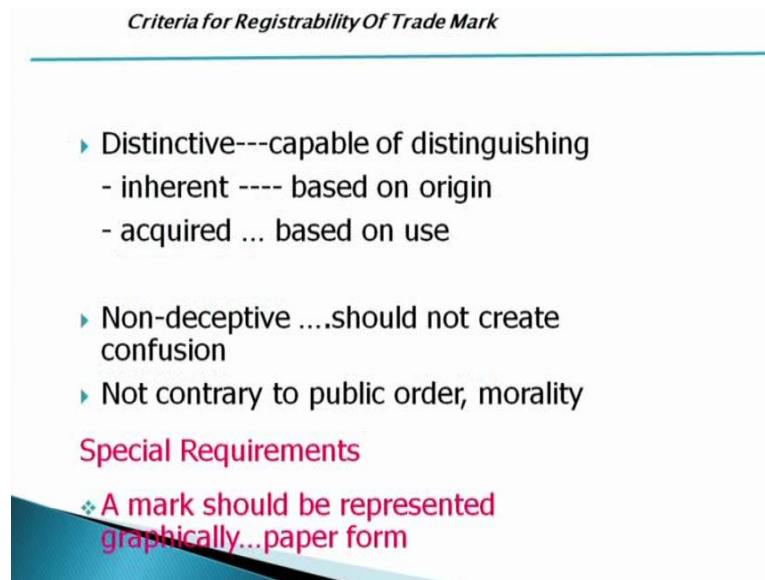
something is already prior in use then you will be liable with reference to the use of that trademark which is already available in the prior use format.

That way, say trademark in the form of a prior use, so used based height prior use and trademark search. So, these three components you understood. So, trademark registration is not compulsory, but registration will give a better production I am trying to mention that part I will just try to analyze little bit. What way the registration will give better protection? Because registration already referred with referenced to the copy right will give evidence of ownership will be provided by registration and also if you are register copy writer you can file a suit for infringement, I will analyze what infringement.

Simply you have the certificate by virtue of that you can file infringement suit, but if you are a prior use you have to prove then that your trademark is having enough goodwill so that for prior user can file a suit called a passing off suit. For passing off suit he has to prove that the trademark has just like goodwill. So, your trademark suit have enough goodwill then some bodies just like using your trademark and use then that lead to the erosion of goodwill.

So, that way this is better compare to the use based right registration and use. So, use will be compare to registration right use will be the compare to the use base situation. Registration base situation is better for you so that the part trademark right. Just like say trademark rights is use based rights registration is not compulsory, so prior user rights generally prevails over the others. So, registration better production we can refer.

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So, then the trademark so just like when we consider any kinds of not kinds of (Refer Time: 06:44) over the rights. So, always we are considering the criteria. So, whether when we consider registration then we have to think about the criteria.

The criteria for registration is the just like a patent we called novelty, industrial design, you all know in our original operate original here we put in (Refer Time: 07:13) but distinctive tips. So, distinctive tips means should be mark should be capable of distinguishing the goods it has should have capacity to distinguish. Just like apple for computer there is no problem there is no relationship, apple for apple juice not really distinguishing, because apple for computer there is no relationship that what the apple and computers is called inherent distinct tip. Apple for apple juice or apple related food act may be the problem. Day one it is not inherently districting tip some attributes of the attributes of the mark is embedded on the goods so that way it is not generally we call that is not inherently distinct tip.

Few cases that descriptive mark can be distinct tip based on use by long use or people will ultimately forget about the descriptive attributes of that mark they will thought about like say consider Microsoft is for software, but micro but we are forgetting about that software components. We are forgetting there we are considering Microsoft is the brand Microsoft is the provider for windows. And window purchase also may consider is a trademark. Just window 95 or whatever format is coming up.

So, that way that we call distinct tipness is the criteria so mark should be capable of or distinguishing the goods or services. Capacity means it is capacity in a day one means inherently distinct tip. Capacity by virtue of use just like even a place name can be a trademark by virtue of long use. People will forget about the place name we will thought about this is a source of goods. So, when that actual name people will forward then it will be have the capacity to distinguish. So, it has called acquired distinct tipness. One is called inherent distinct tipness another is called acquired distinct apple for apple juice inherent distinct tip apple in that or say Microsoft may be for even for software is not acquired distinct it is an inherent distinct tip had the acquired the distinct tipness, because software some relationship is there may be a coined word so that some relationship so acquired distinct tip.

Similarly place them as a trademark may be a trademark based on the acquired distinct tipness. So, that mark which is just like second criteria is there. So, when respect of say we call two criteria absolute grounds of diffusion registration 6 and 9 and another is called relative grounds of diffusion of registration. So, absolute ground if some mark is not distinct tip as I say that and some mark as capacity distinguish with by virtue of long use those marks will be registered based on the grounds of 6 and 9. And some mark is not distinctive then that type of mark which is not or descriptive that type of mark fully descriptive or may not be registered a trademark.

Including that let say mark which is of seen which is heartily the religious sentiment just like (Refer Time: 10:32) for shoes may not may had religious sentiment, that type of mark will not be registers. Just like a which is off seen, which is heartily religious sentiment, which is protected by name and emblem act just like I say a national just like I say Ashok Chakra or similarly some other countries national flag may not be in India also may not be consider as a trademark because that is come under the purview of name and emblem acts. Similarly the name and emblem act can prevent the president as a trademark or prime minister word as a trademark so that the common name and emblem act.

Similarly relative ground (Refer Time: 11:17) suggested your mark if you select a mark and that mark have to compare with the earlier trademark and that lead to a create confusion on that grounds your marks would be not be registered. So, visual arrival and conceptual similarity you have to judge with reference to the flower mark on that case

relative grounds are diffusible just like amoxin and leamoxin, gluvita-glucoivita. So, gluvita is there glucoivita, then I have to consider that that relative grounds between the (Refer Time: 11:56) before registration that whether that lead to the create confusion among the minds of the costumers and consumers, so Liv-T, Liv-52. So, understanding that the some sorts of similarity. This similarity with reference to what visual arrival and conceptual similarity, so visual arrival conceptual similarity I have to be considered with reference to the configuration. So, consider relative grounds with reference to that mark which is with reference to the priored mark.

So, registration criteria simply distinctiveness means or capacity to distinguish capacity distinguish on day one inherent based on origin acquired based on use. And that second ground we are telling that should be it is marks should have that with reference to that earlier trademark if that earlier trademark with respect to that if he is not creating confusion, so then it may can be considered to be register able.

So, in that ground that other creates confusion and others they are live the role of again the survey people. They have to go survey from the market whether really getting confusion or not that type of evidences you may have to produce to make your mark register able is difference to gluvita, glucoivite, glucose, glucon-D all those kinds of situation I understood.

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Marks not Registrable

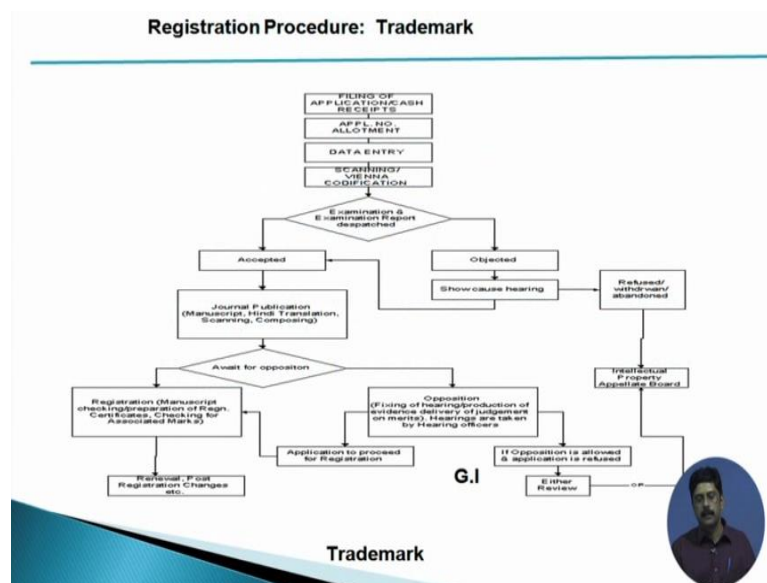
(1) The trade marks-----

- (a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;
- (b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or services;
- (c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.

So, remember there is a ground call that is a say call well known trademark just like I say some mark Pizza Hut is a well known in India, but there is no use of that mark in India, but on that grounds also that somebody may not be allowed to register that mark because considering a well known trademark, because that will create a confusion between that Pizza Hut as a trademark and descriptive to others. So, similarly here the ground suggested which is we consist of some quality or say tin gram (Refer Time: 14:01) you are selling some goods and you are telling that tin as a trademark you are using then some kinds quality or internet purpose or value that you are trying to reflect to that mark then that may attract the absolute grounds of diffusible of registration of trademark.

So somewhat is customer practice that cannot be allowed to use as a trademark, because that is a customer practice just like a konduva or some other part, that may not be allowed is a trademark.

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Now, come to the procedure part of registration of the trademarks. So understood now what criteria you required for a trademark to be registered distinctiveness and such relative grounds you have to think about. But here few other elements also you have to know just like say chemical name or IPUC name cannot be registered as a trademark. Name as a trademark, so if you understood that place name based on the acquired distinctiveness criteria can be trademark not inherently distinctiveness. So, Darjeeling tea

is now considered as a trademark in the day one, but are subsequent use may lead to create distinctiveness can be a trademark.

Similarly, the personal name there is a issues, the name or surname how it can be registers or some popular name want to use as a trademark including correct or name or just like Gabbar as a trademark or (Refer Time: 15:47) as a trademark corrector name or some popular name used to under a trademark in that case you have to take permissions from the person or his legal hires. Just like a (Refer Time: 15:59) as a trademark that the issues live there. Generally for name kinds of situation the procedure suggested name should be (Refer Time: 16:10) name state of common name because understood there lies the issues. So, but they are lies the different issues over the name is a different trademark, but we are not discussing regarding that.

But now let us come to registration part. So, trademark registration component trademark. Registration is who can apply for registration that like a proprietor or owner can apply for registration or how to register the trademark means let say particular forms with the fees and you have to give that representation what marks what is the use word label and logo and you have to give representation that mark. That you are marked will be pasted in A4 size paper and you have to produce along with the application forms.

So, who can apply? Any person can apply for registration of the trademark. Any person means the persons from India or even abroad and apply for the registration of the trademark. Where to apply? A particular registry of they are just like a Delhi, Calcutta, Chennai, Ahmadabad, Madras, and Mumbai. So, these are the there are trademark registers are there. Based on the address of service you can apply in any appropriate offices then what we will do that appropriate office given a just like I say from other form they will give a number application. Number then data entries scanning verification, then they will examine your trademarks on the grounds that was the really trademark. Then second case that was the trademark just like other grounds of distinctiveness or not on that ground they can send you an objection. Or if there from could not found any grounds or objections they may accepted it.

So, if objection registered then you can you have to meet the objections with (Refer Time: 18:07) or the specific frame or you can go for a show cause hearing. Then in that case if you hearing based on hearing it is accepted then and that it will go for journal

publications it will be published in the journal trademark at generally come up from the trademark office. Journal it will be published this trademark this is the proprietor is registered that which class means I have to mention. Again I forgot to mention we follow nice classification of the goods which class of goods means basically consumer goods or other goods that class you have to refer, the class which class you are registered in the trademark then the class of goods it publish in the journal, journal publications then it will go wait for opposition.

Within three months that can be extended for another one month. Any person can oppose, any persons means any person from any other countries can also oppose the registration of the trademark. So, any person will oppose can oppose the registration of the trademark when three months that can be extended for another one month. If opposition there is no opposition then it will be say again it will be registered if no opposition. Then it will be registered. If opposition decided in favor of you also it will be registered, but in that case the opponent can go an appeal before the operate authorities operate authorities also. So that way your trademark will be registers. Now if registers it you from that another part, so you register it the register for 10 years.

Now, every 10 years you have to renew your trademark. If your trademark is registers then after every 10 years you have to renew then your rights will be per mutual. So, remember that trademark rights is per mutual based on renewal, means if you renew your trademark, but another grounds if you do not use your trademark that that you may lose the rights just like a patents non working ground revocation similarly non use ground led to the rectification or renewal of the trademark.

So, non use of trademark or 5 years may lead to the renewal of the trademark from the register of the trademark. So, remember if you are trademark owner you should use the trademark, use means use in the course of trade. Means amount of usage not should be substantial, but even single sale or the good hearing is the trademark will be consider as use. If you read that just like say let say Vodafone and Hutch. So, Hutch was now a good trade brand Hutch trademark which not in use, we may not if we use then automatically hutch trademark will be abundant.

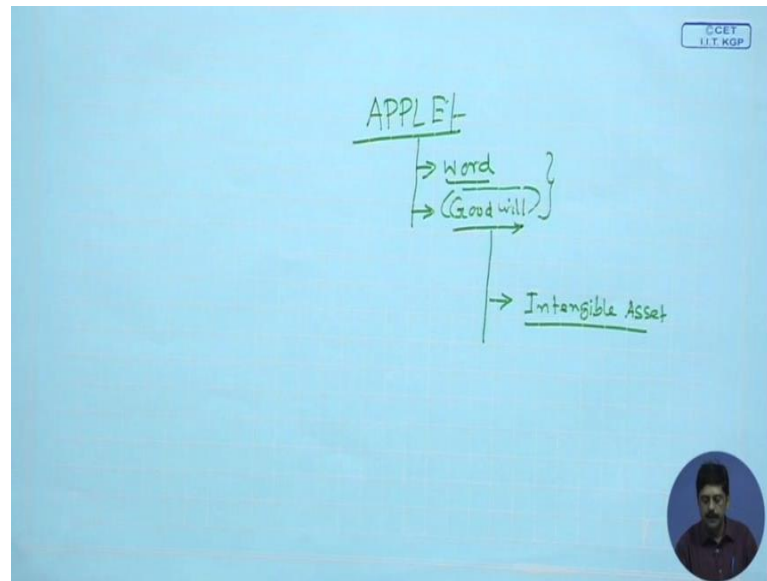
Similarly, as a lot of other situation may get it just like say L N Barries or other kinds of situations. If the trademark is not in use as with respect of goods then automatically the

trademarks will be abundant. So somebody wants to use that abundant trademark so that will be you will be considered based on first use base system first come first service this is a first use basis, so that way the trademark part; so registration 10 years then renewal. There is also like a procedural like registration that who is (Refer Time: 21:37) trademark there is amendment and within scope and amendment should not enlarge the scope over rights, but amendment is also possible.

Then another components on that so that is called trademark transaction does lies the issues with reference to the trademark just like a without trademark can be licensed, just like I told you a source identification function and quality identification function. So, now trademark owner living somebody trademark on license, then whether the licensee you will have to bear will have to maintain the same quality whatever the trademark proprietor he was maintaining. So, there lies the issue or reference to the trademark licensing.

So, trademark transaction we understood. So, in trademark transaction component, so registration part we have discussed. So, registration parts we have discussed that is say this is the trademark say enforcement of rights so that we are not discussing now. Now transaction is a important parameters for let say managers people just like if you are working as a your technologist or engineers, in work, in an organization then just like say another your marketing managers or so brand promoter or advertiser this type of management job you have to do in an organization then they have to should know the important parameters called trademark transactions. So, that way that licensing and assignment just like say in Indian context now in respect to trademark if you nice. So, analyzed as in the registration is the module, but why not registration along with the registration we can discuss the transaction components also.

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So, now in a simple mark let say apple, so one is the simple word apple, but not only the word apple then with that the word we have some goodwill. So, then that part we are discussing that when you give the license whether that goodwill is also will be goes to the licensee or not because for the diesel just like a clause some quality control clause that will ultimately protect the interest of the licensor or owners and that will also could interest of the consumers. So, that way the quality control clause may be essential I can say or somehow that that sufficient connection the theoretical potential sufficient connection should be established between that, just like I say that product manufactured by such trademark license to mister that company. That company selling or product based on. Using this trademark based on the license agreement, that sufficient connection you have to be established between the licensor and licensee. Now that way you can defraud even people, people protect people from being fault protect.

So, now what we are discussing the apple words. The apple not only the word along with the word we have now goodwill. So, if you allow some body to license the word apple to be used in a particular course of trade then the issue is coming up whether you are assigning the things along with the goodwill or not. So, with or without the goodwill that is the important parameters. Generally the act suggested, so goodwill is also some time people suggested this is the important parameters as a technical goodwill also considered as an intangible asset, intangible- I n t e n g I asset. Separate from simply the word apple because based on that use it as acquired the intangible assets know intangible assets.

So, that way intangible asset, so that way that how to built an intangible assets important parameters how to beat an intangible assets based that is their lies on the branding brand valuation. So, intangible assets so that way you can assign the trademark along with or without the goodwill's. Now what is goodwill? Goodwill is another form of intangible assets. So, you can separate the mark from goodwill that indicated, but really it is feasible to separate or not there issues.

So, goodwill trademark can be assigned with or without goodwill as per Indian Trademark Act. Similarly licensing also trademark can be possible, but I will advice that you should maintain a quality control clause and when you are taking the organization if we the somebody organization taking license or particular trademark or you want to be some license of your trademark to other person that part try to give some license give some sufficient connection or give a quality control clause. Just like I say nowadays how they are doing business just like I say KFC or let say what is that, KFC other brand they are doing business by means of anxiety. They are maintaining the sufficient quality in all the stores in different jurisdiction; just like Subway I forget to Subway, KFC then Cafe Coffee days. They are see that wherever you go that they had same get up, same quality control they tried to maintained for the design. They are protecting the goodwill in across the jurisdiction and they are good brands. So, that part sometimes of confrenzying or frenzying that is the important parameters or with reference to the trademark transaction.

So, we have discussed about registration of the trademark. So, registration of trademark open registers, we discussed what criteria required to register we discussed. So, now what criteria we required to register discussed. Then what we required to discuss that that already we have completed the discussion of the trademark. Next class we will discuss few other elements of that trademark. Then we will go the other forms intellectual property rights.

Thank you.