

**Intellectual Property**  
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**Lecture – 47**  
**Rights and Defences**

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## Effect of Registration



- Initiate suit for infringement
- Exclusive rights to the use of the TM
  - Relation to goods and services for which granted
  - Subject to any conditions or limitations imposed
- Registration to be prima facie evidence of validity

The effect of registration of a trade mark is that it gives the trade mark holder the right to initiate a infringement suit. And the trade mark holder also has rights exclusive rights in relation to goods and services for which it is granted; which means any other person who uses a mark which is identical or similar with regard to the goods and services owned by the trade mark holder can now amount to an infringement.

And in case of an infringement, the trade mark holder can initiate action to stop the person from continuing the infringement. Now, this is subject to certain conditions and limitations imposed by the trade mark office. Registration is regarded as prima facie evidence of validity.

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## Infringement Suits

- Registered trade mark
- What amounts to infringement?
  - Identity with registered mark and similarity
  - Similarity with registered mark and identity
  - Identity with registered mark and identity
    - Presumption of confusion
  - Identity with registered mark having reputation

Infringement suit with regard to a registered trade mark can be filed at the place where the trade mark holder resides. An infringement suit has to demonstrate that the fact there has being infringement.

Now, this can be done when a registered trade mark is infringed by a person; who not being the registered proprietor uses in the course of trade. A mark which because of it is identity with the registered mark, or similarity of the goods and services or because of the similarity with the registered mark and identity, or similarity of goods and services, or it is identity with the registered mark and identity of goods, and services covered by the mark is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

So, these are the 3 instances. One, it is identity with the registered trade mark and similarity with the goods and services covered is likely to cause confusion. It is similarity with that registered trade marks and the identity or similarity of the goods and services covered by such trade mark is likely to cause confusion. Or the identity with the registered trade mark and the identity of the goods and services covered by the trade mark is likely to cause confusion.

So, what this essentially means is that where a mark that is used by a person is said to be infringing if it is identical or similar either to the registered mark or identical or similar to the goods and services that have been covered by the registered marks.

So, there is identity to the registered mark or similarity to the registered mark, there is identity with the registered mark or identity with the goods and services. Now, this identity or similarity should result in confusion. It is of such a nature that it is likely to cause confusion. So, infringement is proved if there is a likelihood of confusion, and the confusion can arise with regard to identity or similarity either with regard to the mark or with regard to the goods and services.

With regard to the third condition, that it is identity with the registered mark and the identity of the goods or services covered by such registered mark is likely to cause confusion. The court shall presume that it is likely to cause confusion on the part of the public. So, with regard to the third point there is a presumption of confusion. They can also be infringement through advertisements. A registered trade mark is infringed by any advertising of that trade mark if such advertising 1 takes unfair advantage of or it contribute to honest practices in industrial and commercial matters. Or 2, is detrimental to it is distinctive character. Or 3, is against the repetition of the trade mark.

So, any advertisement that is against the repetition of the trade mark is detrimental to it is distinctive character or takes unfair advantage can amount to infringement.

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## Infringement Suits



- What amounts to infringement?
  - Unauthorized use of TM on packaging, goods for sale, import, export etc
  - Disparaging advertisement

So, any unauthorized use of the trade mark on packaging goods for sale import, export etcetera will amount to infringement. So, unauthorized use amounts to infringement, disparaging advertisement as we just saw; where the reputation of the mark or the

distinctiveness of the mark or an unfair advantages made which is against honest practices in industry and commercial matters would also amount to infringement. There is a distinction between a disparaging advertisement and a comparative advertisement. Comparative advertisements are normally allowed, but disparaging advertisements are not allowed.

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## Passing Off



- Unregistered trade mark
- Conditions for passing off
  - The claimant has goodwill
  - The defendant made a misrepresentation that is likely to deceive the public
  - The misrepresentation deceives the goodwill of the claimant

An unregistered trade mark can be protected by the relief of passing off. And for proving passing off the claimant a person who initiates the action has to show that he has goodwill in the mark. And that the defendant had misrepresented that and such misrepresentation is likely to deceive the public. And the misrepresentation deceive the goodwill of the claimant.

So, there are 3 things the claimant has to demonstrate goodwill, claimant has to show that there is been a misrepresentation by the defendant; which is likely to deceive the public, and the misrepresentation harms the goodwill of the claimant. If these 3 conditions are satisfied, then a action of passing off can be initiated against a user who uses the trade mark without consent.

Passing off is generally used with regard to trade marks that are not registered, unregistered trademarks can be protected by way of a passing off. For this goodwill is necessary and the claimant has to demonstrate goodwill and also show there is been harm because of the misrepresentation to the goodwill.

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## Cybersquatting



- Relationship between domain names and TM
- Abusive and bad-faith use of domain names including trade marks
- Internet Corporation for Assigned Names and Numbers
- Uniform Dispute Resolution Policy and Rules

Cybersquatting has we have already seen is where domain names are registered by a person other than the owner of the trade mark.

And these practices are regarded as abusive and in bad faith, and there is a mechanism as we have seen ICANN, International Cooperation for Assigning Names and Numbers, as a policy and a dispute settlement and a dispute settlement mechanism to resolve disputes. And the policy clearly states that a person who registers a domain name will be subject to the dispute resolution policy.

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## Exploitation and Use



- Self-exploitation
- Assignment
- Voluntary licenses
- Mortgages
- Compulsory license
  - No CL in relation to TM
  - Prohibited under TRIPS

Exploitation and use of trade marks; trade marks are generally self-exploited. They can be if they are not self-exploited. They can be assigned and licenses can also be given around them. They can be mortgages on trade mark, but they cannot be a compulsory license unlike copy right and patterns, they cannot be a compulsory license in relation to trade marks, and this was prohibited by the trips agreement.

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## Defences

- Conflict between registered marks
  - Cannot amount to infringement
  - It may constitute passing off
- Legitimate use of a mark by unauthorized user
  - Honest concurrent use
- Use to indicate the characteristics of the product or service

Defences, in case of a infringement suit, if there is a conflict between registered trade marks, that will not amount to infringement. There are 2 concurrent registration for the same or similar mark, and the registration happens with regard to same goods and services.

Now, if both the registrations exists then it cannot amount to an infringement. They could be an action of passing off based on the entity or the party who is able to demonstrate goodwill will succeed in an action for passing off. If they use by an unauthorized user is legitimate, again that can be a ground for a defence; for instance, a honest concurrent use can be a defence in an infringement action.

If they use by an unauthorized user indicates the characteristics of the product or the surface that will not amount to infringement, and that can be a difference in an infringement suit. So, though there is a mark covering the characteristic of the product or a service, then the mark will not be enforceable, because any other person using the product or the service will have to describe the characteristics.

Now we found this as one of the grounds the fact that it explains the kind, quality, quantity, character of the product or services shall not be a ground for granting a registration. In fact, it shall be a relative ground for denying registration.

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## Defences



- Use of mark, outside scope of registration
  - Registration subject to conditions, or limitations
- Descriptive Use
- Use of Name or address
- Comparative advertising
- Consent of the TM holder

Use of the mark outside the scope of registration can be a defence. So, the registration is for particular classes for instances of marks covered for food, but it is not covered for hospitality. So, you could still use the mark in a different class descriptive use marks, which are descriptive of the product or service, if another person uses the mark which again describes the use, then that will be a defence in an infringement suit because the mark describes the product or the service.

Use of name or address which describes the product or which denotes the products or identifies the product again can be a defence. Comparative advertisement that we have already mentioned, and as we had seen in the case of the frozen desserts case study, that was the case of comparative advertisement though HUL, Hindustan Unilever Limited had alleged that it amount to disparaging advertisement.

Now, in a disparaging advertisement there has to be direct comparison to the product and the 3 things it should be an unfair practice, not recognized by the trade, they should be harm to the reputation, and they should be harm to the distinctive nature of the trade mark. If these 3 things are there, then it amounts to a disparaging advertisement. Otherwise it just amounts to a comparative advertisement.

Again, if they use is by the consent of the trade mark holder, that will be a defence in an infringement suit.

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## Losing Protection



- Abandonment
  - Non-use
  - Change in product or service than for which it is registered
- Mark has become generic
  - Has become a common name in the trade
- Mark has become deceptive
  - Misleading the public

The mark has to be constantly renewed, and it has to be protected from unauthorized use. Marks can lose their protection if they are abandoned, by not using the mark, the mark can amount to have been abandoned. And if there is a change in the product of service, than for which is registered. So, you register mark for a particular class and use it in a different class, then that could be another reason why the law will treat the mark has been abandoned.

You may lose protection on a mark when a mark becomes generic. A word now has been used which is traditionally a mark, a word which is originally a mark has now been used commonly in trade. And this could be a reason why a mark could lose it is protection. When the mark becomes descriptive of the goods, then it could amount to misleading the public and again the mark can lose protection.