

**CRITICAL STUDY OF INFRINGEMENT AND
PASSING OFF UNDER THE TRADEMARKS
LAW IN INDIA**

A Thesis
Submitted to Goa University
for the Award of the Degree of

**DOCTOR OF PHILOSOPHY
IN LAW**

By

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DECLARATION

I hereby declare that this thesis titled, **“CRITICAL STUDY OF INFRINGEMENT AND PASSING OFF UNDER THE TRADEMARKS LAW IN INDIA”** submitted for the award of the Degree of Doctor of Philosophy in Law, to Goa University, Panaji is an Original Research work done by me.

I also hereby declare that this thesis or any part of it has not been submitted to any other University for the award of any Degree or Diploma or Fellowship.

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CERTIFICATE

This is to Certify that the thesis titled, **‘CRITICAL STUDY OF INFRINGEMENT AND PASSING OFF UNDER THE TRADEMARKS LAW IN INDIA’** submitted for the award of the Degree of **Doctor of Philosophy in Law**, is a record of the research work done by Mr Vinod Gajanan Shirodkar under m guidance and supervision during 2019.

I certify that this is bonafide work of Mr. Vinod G Shirodkar

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ACKNOWLEDGEMENTS

I pay my Homage to God Almighty for having Grace on me in my path of education and life. I dedicate my Research study to my father late Shri Gajanan Shirodkar who always wanted me to study and my Mother late Shrimati Shanta Shirodkar and my dearest brother Late Shri Dilip G Shirodkar whom I truly miss during this moment of my Life.

I thank and express my tremendous gratitude to my Research Guide, Sir. Dr Shaber G Ali, Associate Prof. VM Salgaocar College of Law who helped me in every moment of my research and encouraged me and believed in me during my research period and who truly went out of way to guide me and help me in my research as a elder brother.

I sincerely give thanks to Prof. Sir. Dr MRK Prasad, Principle of VM Salgaocar College of Law for all the inspiration and motivation given to me during my Law studies.

I thank Prof. Dr Sairam Bhat, Prof. of Law at National Law School Bangalore for all the guidance and encouragement.

I thank Sir Dr. Marian Pinheiro the former Principal of VM Salgaocar College for all his encouragement given to me and I also sincerely thank Sir. Dr. K S Rao for motivating me in my studies.

I thank Dr Sonal Sardesai who truly helped me in my research studies as and when I needed during all my research period. I thank all the Senior Staff and teaching faculty of V M Salgaocar College namely; Dr Kim Couto, Dr Sandhya Ram, Asst. Prof. Pearl Monteiro, Dr Naguesh

Colvalkar and Dr B S Patil who, all, as my teachers have taught me Law and I shall always be grateful and thankful to them.

I thank Shri Prashant Chodankar for all his well wishes in my studies as a friend and so also I thank my library staff, Mr Anand Naik, Mr Ramakant Naik, and Mr Bharat Amonkar for always helping me by providing all the required books whenever needed.

I thank Sir D P Pednekar, Administrator and Mr Inacio Braganza Account Officer of V M Salgaocar College for always having concern for my studies. I sincerely thank Miss Sonam Vaman Tari for always helping me in my studies by giving her precious time as and when required.

My sincere thanks to the Lawyers, Judges, Police, and Administrative officers of Trademark as well as other Government offices like Registrar of Companies, Customs, Professionals from different fields , Traders and service providers, Educational Institutions and Goa University for all the help and motivation provided for me I my Research.

I thank Management and staff of Real Group of Companies for extending help and support to me during my studies. I thank my brothers and sisters for all their love and blessing in my life and studies.

I express my gratitude to Shri Nishakant Narshiv Pednekar for his unlimited help, valuable suggestions and support in my Research and who always stood by me graciously during my studies.

Last but not the least I thank my Loving wife Dr. Beena Shirodkar who always walked with me together in our life's journey and I sincerely

acknowledge that wherever I stand today is only because of her Love and Care. So also I would like to thank two little friends of mine, one is my son Navin who has always inspired me with his marvelous talents and astonishing oratory style and another is my loving pet 'Kane' a German shepherd dog who is no more in this world but whose love will always remain in our hearts forever.

CONTENTS		Page No.
	DECLARATION	i
	CERTIFICATE	ii
	ACKNOWLEDGEMENTS	iii - v
	CONTENTS	vi – xvii
	ABBREVIATIONS	xviii - xix
	LIST OF CASES	xx – xxii
	LIST OF STATUTES ND RULES	xxiii
CHAPTER I		1-22
1.	INTRODUCTION	
1.1	INTRODUCTION	1
1.2	IMPORTANCE OF THE PRESENT RESEARCH	6
1.3	OBJECTIVES OF THE STUDY	11
1.4	RESEARCH QUESTIONS	11
1.5	HYPOTHESIS	12
1.6	METHODOLOGY ADOPTED	13
	i. Primary Source of data:	15
	ii. Secondary Source of data:	16
1.7	LIMITATATION OF RESEARCH STUDY	16
1.8	STRUCTURE OF THE THESIS	17

CHAPTER - II		23-106
2	CONCEPT, SIGNIFICANCE AND DEVELOPMENT OF TRADEMARK AND TRADEMARK LAW IN INDIA	
2.1	INTRODUCTION	23
2.2	CONCEPT OF TRADEMARK	24
2.3	FUNCTIONS OF TRADEMARK/SERVICE MARK	25
a)	To Identify the Manufacturer and Service Provider	25
b)	To Protect the Goodwill and Reputation of the Proprietor	27
c)	Gives Legal Right to the owner as to its Usage	27
d)	To Guarantee the Product and its Quality	28
e)	Advertises and builds image of Product and services with proper representation	29
2.4	NEED AND IMPORTANCE OF TRADEMARK	30
1	BUILDS REPUTATION	31
2	PURCHASING DECISIONS	32
3	EFFECTIVE COMMUNICATION TOOL	33
4	MAKES IT EASY FOR CUSTOMERS TO FIND YOU	33
5	TRADEMARK CONNECTS WITH PEOPLE ON SOCIAL MEDIA	34
6	TRADEMARKS ARE VALUABLE ASSETS	35
7	PERPETUAL LIFE	36

8	GIVES UNIQUENESS TO BRAND & DISTINCTNESS BENEFIT	37
9	PROTECTS YOUR PRODUCT NAME	37
10	HELPS THE BUSINESS GROW	39
11	GLOBAL ECONOMIC GROWTH	40
12	CONFIDENT PURCHASING DECISION	41
13	ENCOURAGE HEALTHY COMPETITION	42
14	COMMERCIALISATION AND GROWTH OF COMMERCE & INDUSTRY	43
15	REPEAT ORDERS	44
16	PREVENTION OF UNFAIR TRADE PRACTICES AND PROECTION OF CONSUMERS	45
17	QUALITY PRODUCTS	47
18	KNOWLEDGE AND EDUCATION COCERNING PRODUCTS	48
19	ADVERTISING SERVES A LINK	49
2.5	CLASSIFICATION/TYPES OF TRADEMARKS	51
a)	Trademark in reference to goods	51
b)	Service Mark in reference to services	52
c)	Certification Trade Mark	52
d)	Collective Trade Marks	53
2.5.1	Forms of Trade Marks/ Service Marks in day today usage	55
2.5.2	Classification of trademarks in this Modern Age	56

I.	Conventional trademark	57
II.	Nonconventional trademark	57
I.	CONVENTIONAL TRADEMARKS	57
a)	Generic/Generalized Trademark	57
b)	Arbitrary Trademark	58
c)	Descriptive Trademark	59
d)	Suggestive Trademark	59
e)	Fanciful Trademark	60
II.	NON-CONVENTIONAL TRADEMARKS	60
a)	Shape Trademark	61
b)	Sound trademark	63
c)	Colour trademark	63
d)	Smell or Olfactory trademark	64
e)	Touch trademark	65
f)	Taste trademark	65
g)	Motion	65
h)	Hologram	66
2.6	TRADEMARKS EVOLUTION AND THE DEVELOPMENT OF ITS LAW	66
2.6.1	<i>Development from Global /International Perspective</i>	66
2.7	TRADEMARK PROTECTION AND DEVELOPMENT IN INDIA	76
2.7.1.	<i>Trademark protection in India before 1940</i>	77
a)	Development of trademark in India during Ancient Period	77

b)	British Period :	78
	<i>a. The Common Law and Equity Principles</i>	80
	<i>b. Indian Penal Code (IPC) 1860.</i>	82
	<i>c. Specific Relief Act 1877(1963 as amended in 2018)</i>	83
	<i>d. The Indian Merchandise Mark Act 1889</i>	84
	<i>e. The Sea Customs Act1878</i>	85
	<i>f. Indian Registration Act, 1908.</i>	87
2.7.2	Trade Mark Protection in India after 1940	87
	<i>a) The Trademarks Act, 1940</i>	88
	<i>b) The trademarks(Amendment)Act1941</i>	91
	<i>c) The Trademarks (Amendment)Act1943</i>	92
	<i>d) The Trade and Merchandise Marks Act, 1958</i>	93
	<i>e) The Customs Act, 1962</i>	95
	<i>f) The Trade Marks Act 1999</i>	96
	<i>g) The Trade Marks Amendment Act 2010</i>	101
	<i>h) The Trade Marks Rules, 2017</i>	101
CHAPTER - III		107-195
3.	CRITICAL ANALYSIS OF INFRINGEMENT AND PASSING OFF WITH REMEDIES	
3.1	INTRODUCTION	107
3.2	PREAMBLES OF TRADEMARK LEGISLATIONS VIS-A-VIS INFRINGEMENT AND PASSING OFF	109
3.3	MEANING OF INFRINGEMENT	112

3.3.1	ELEMENTS OF INFRINGEMENT:	113
	a. Registered Trademark:	113
	b. Unauthorized Use	113
	c. Identical or deceptively similar trademark	114
	d. Trademark used in the Course of business/trade	114
	e. Representation of the trademark	114
	f. Trademark should belong to certain class of goods or service	114
3.3.2	DIFFERENT WAYS OF INFRINGEMENTS	115
	a) Identical Mark for Identical Goods or Services	116
	b) Similar Mark for Identical Services or Goods	116
	c) Identical Mark for Similar Goods or Services	117
	d) Similar mark for similar Goods or Services	117
	e) Likelihood of Confusion	117
	f) Test of Similarity of Ideas	119
	g) Anti Dissection Rule	119
	h) Initial Interest of Confusion	120
3.3.3	RIGHTS OF PRIOR USER UNDER TRADEMARK LEGISLATIONS:	124
3.3.4	DUAL RIGHTS OF REGISTERED TRADEMARK OWNER IN INFRINGEMENT CASES:	128
3.3.5	LIABILITY UNDER TRADEMARK ACT:	129
3.4	PASSING OFF	130
3.4.1	Concept of Passing off	130
3.4.2	Trademark Legislation and ‘Passing off action’:	132

3.4.3	Actual damage' not necessary Element for Infringement /Passing Off	136
3.4.4	Defendant might trade in different type of goods or services than Plaintiff's	136
3.4.5	TRANS-BORDER REPUTATION DOCTRINE	138
	Defendant's jurisdiction immaterial	139
3.4.6	Cyber World and Passing off Action	142
3.4.7	Passing off Service Mark	143
3.5	EXTENDED PASSING OFF	144
3.6	Passing off Well Known Trademark	145
3.7	Reverse Passing Off	145
3.8	Distinction between Infringement and Passing off Action	147
3.9	REMEDIES FOR INFRINGEMENT AND PASSING OFF	147
3.9.1	CIVIL REMEDIES	149
1)	Injunction	152
A)	Perpetual <i>Injunction</i>	153
B)	Interim Relief/ Temporary Relief	154
	<i>Ex parte order / Interlocutory injunction</i>	155
C)	Mareva Injunction	156
2)	Anton Pillar order	157
3)	Discovery Orders/Norwich Pharmacal Order	157
4)	Damages	159
a)	<i>Compensatory damages</i>	159
b)	<i>Punitive Damages</i>	159

5)	Account of Profit	161
6)	Delivery up	161
3.9.2	CRIMINAL REMEDY	168
A)	TMA 1999 contains Penal Provisions	168
B)	<i>Police Action</i>	170
C)	<i>Filing of complaint with Magistrate</i>	170
D)	Remedy under Indian Penal Code (IPC) 1860	171
3.9.3	ADMINISTRATIVE REMEDIES UNDER THE TMA 1999	173
A.	Opposition remedy by Registrar of Trade Mark <i>Opposition provided by all the trademarks legislations in India.</i>	173
B.	Rectification remedy provided by IPAB <i>Rectification provisions under all trademarks legislations in India.</i>	179
3.9.4	INFRINGEMENT REMEDY UNDER CUSTOMS LEGISLATION	186
A)	Sea Customs Act 1887	186
B)	Customs Act 1962;	187
	<i>IPR Cell in Custom House</i>	190
3.9.5	REMEDIES UNDER COMPANIES LEGISLATION	191
	a) Companies Act 1956 contains the following;	191
	b) Companies Act 2013	193
3.9.6	Remedy by. IN Domain Name Resolution Policy (IDNRP)	194

CHAPTER - IV		196-233
4	STATUTORY AUTHORITIES UNDER THE TRADEMARKS ACT	
4.1	INTRODUCTION	196
4.2	AUTHORITIES IN TRADEMARK ADMINISTRATION	196
4.2.1	Department for Promotion of Industry and Internal Trade (DPIIT)	199
	<i>a. DPIIT's Role in IPR</i>	199
	<i>b. National IPR Policy by DPIIT</i>	200
	<i>c. CIPAM established by DPIIT</i>	202
	<i>d. Steps undertaken by DPIIT in Trademark Law</i>	202
4.2.2	INTELLECTUAL PROPERTY APPELLATE BOARD (IPAB)	204
	<i>a. IPAB's Role in Combating Infringement and Passing Off</i>	211
	<i>b. Functions and powers of IPAB</i>	212
	<i>c. Limitation of IPAB</i>	214
4.2.3	CONTROLLER GENERAL OF PATENTS, DESIGN AND TRADE MARKS (CGPTM)	216
	<i>a. Registries and Departments under CGPDTM</i>	217
	<i>b. Functions of CGPDTM</i>	217
4.2.4	THE REGISTRAR OF TRADEMARKS	219
	<i>a. Powers and functions of TMR</i>	222
	<i>b. Registrar's Tribunal</i>	228

CHAPTER - V		234-274
5.	FUNCTIONING OF AUTHORITIES UNDER THE TRADEMARKS ACT IN RELATION TO OPPOSITION AND RECTIFICATION PROCEEDINGS	
5.1	PART 1: STATISTICAL DATA	235
1.	Filing of trademarks applications before the Registry	236
2.	Trademark applications filed, examined, registered and also heard and disposed from 2007 to 2018.	236
3.	Opposition and Rectification proceedings before the Registry	238
4.	10 Years Trademarks Opposition /Rectification / Interlocutory Applications Filed and Disposed (2007-2017)	249
5.	Place wise Applications filed from the year 2007 to 2018	252
6.	05 Years Comparative Study of Different Intellectual Properties Performance in India (2013-14to 2017-18)	253
5.2	PART 2: ANALYSIS OF EMPIRICAL DATA	255
1.	Awareness of Trademark Registration	256
2.	Awareness of Infringement and Passing off of Trademark	257
3.	Awareness of online Registration of Trademark facility	259
4.	Knowledge of Infringement and Passing off Remedy	260
5.	Trademark helps in providing quality to product and services	261

6.	Awareness about criminal remedies for infringement	262
7.	Need for creating more awareness in the society regarding trademark law	263
8.	IPAB's jurisdiction vis a vis Infringement	264
9.	Trademarks Act should include provisions for passing off	265
10.	Trademark legislation has achieved its Objective	266
11.	Satisfaction of the stake holder in relation to Infringement and Passing off action	267
12.	There is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India	268
13.	Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation	269
14.	IPAB vis-a-vis ex-parte orders	270
15.	Trademark act 1999 is more effective and successful than all the previous Acts passed in India	271
16.	Infringement cases filed in Goa State from 1-1-2009 to 20-3-2019 in the District Court of Goa	272
CHAPTER – VI		275-293
6	CONCLUSIONS AND SUGGESTIONS	
6.1	INTRODUCTION	275
6.2	VERIFICATION OF HYPOTHESIS:	276
6.3	RESEARCH QUESTIONS ANSWERED	284
6.4	SUGGESTIONS/RECOMMENDATIONS	287
	<i>Conclusion</i>	292

	BIBLIOGRAPHY	294-300
	BOOKS	294
	ARTICLES	296
	JOURNALS	297
	DISSERTATION	298
	THESIS	298
	SEMINAR/PAPERS	298
	REPORTS/RESOLUTION	299
	NEWS ITEMS	299
	WEBLIOGRAPHY	300
	ANNEXURES	301-313
I	Questionnaires to the Traders	301
II	Questionnaires to the Students	303
III	Questionnaire to the Lawyers	305
IV	Questionnaire to the Trademark Registry	307
V	Questionnaire to the Professionals	310
VI	Questionnaire to the Judges	311
VII	Questionnaire to the Police	313
	APPENDIX	314-331
I	Types of Trademarks	314
II	RTI Reply	317
III	Trader's details	318

ABBREVIATIONS

AIR	All India Reporter
Adv	Advocate
CGPDTM	Controller General Of Patent, Design and Trademarks
CIPAM	Cell for IPR Promotion and Management
CrPC	Code of Criminal Procedure
CPC	Civil Procedure code
CJ	Chief Justice
CJI	Chief Justice India
DIPP	Department of Industrial Policy and Promotion
DPIIT	Department for Promotion of Industry and Internal Trade
EEC	European Economic Community
G I	Geographical Indication
ROC	Registrar Of Companies
RTI	Right to Information
S C	Supreme Court
SCC	Supreme Court Cases
TM	Trade Mark
TMR	Trade Mark Registry/Regisrar
IMMA 1889	Indian Merchandise Marks Act 1889
TMA1940	Trade Mark Act 1940
TMMA 1958	Trade And Merchandise Marks Act 1958

TMA1999	Trade Marks Act 1999
H C	High Court
IPC	Indian Penal Code
IP	Intellectual Property
IPR	Intellectual Property Right
IPAB	Intellectual Property Appellate Board
I S	Indian Standard
IPO	Intellectual Property Office
ISO	International Standard Organization
VPN	Virtual Private Network
NIXI	National Internet Exchange of India
MSME	Medium and Small Manufacturing Enterprises
NIIPM	National Institute of Intellectual property Management
ISA	International Searching Authority
RGNIIPM	Rajiv Gandhi National Institute of Intellectual Property Management
BIS	Bureau of Indian Standards
UDHIR	Universal Declaration of Human Rights
UN	United Nations
UK	United Kingdom
USA	United States of America
WIPO	World Intellectual Property Organization
WHO	World Health Organization

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CHAPTER I
INTRODUCTION

CHAPTER I

INTRODUCTION

‘Trademark Law cannot work on its own but with the team effort of Parliament, Judiciary, and Authorities and last but not least the People in the Society at large’

1.1 INTRODUCTION

One of the most important desires of any human being is to own property. Property is one of the most important assets for human being on this earth. Property provides dignity, status and respect for the holder. Apart from physical and tangible property there has existed one more form of property from many years all over the Globe and that are the brain property which is well understood globally as Intellectual Property that is intangible, incorporeal and abstract property. The outcome of this Intellectual property is idea, creation, creativeness ability, some secretive knowledge or know how which might be relating to business, medicine, art, culture, knowledge from customs and traditions, innovations in different area or walks of life etc . The source of such Intellectual property is Brain of human being and this Intellectual property has been there right from primitive and Stone Age civilization though it has gained more importance and value in the recent time. These Intellectual properties like the physical and tangible property are also protected by different laws from many years and recently these protection laws have been developed to a great extent to meet the demands of the World at large.

Some of the Intellectual properties¹ are Artistic work like Music, Sculpture, Art, Literature, Painting so also Trade secrets, domain name on Internet, Trademark / Service mark, Invention, Indigenous and Traditional knowledge, computer program, Artistic work, Design which may include design of the goods or packaging or it may be industrial design and also include Layout

¹ Cornish W R & Llewellyn, *Intellectual Property –Patent, Copyright, Trademarks and Allied Rights*, (2nd Ed. 2001, Universal Law Publishing Co, Delhi) at .P. 3-5.

design of integrated circuit, Plant Varieties and knowhow of the same, Biodiversity, Geographical indication, and among all these Fashion Law which is of recent origin.

The present research is conducted to verify one of the most important Intellectual properties that are trademark, its infringement and passing off action. The manufacturer or supplier of goods makes it sure that although the goods produced by him are similar to those manufactured by others, their distinguishing marks are different.² The importance of trademarks was recognized only after the Industrial Revolution which enabled large scale production, distribution of goods and publicity through different media. It is in this context that ‘trade marks’ play a very important role in the modern commercial market.

A Trademark is anything that is associated³ with a good or service for the purpose of recognition and identification of the same, so from this point a trademark can be something which identifies and recognizes any product/good. Section 2(1)(zb) of the Trademark Act 1999 contains the definition of the term trademark.

²Utexas Education Trademark, From the Jeffersonian Era to the Industrial Revolution: This period ushered in the use of trademarks in a very familiar to us today. The legislative debate over trademarks was influenced by Thomas Jefferson Father of the American Trademark who was the third President of the United States of America. The first trademark court cases were followed by legislation. Trademarks were now considered legal property. Brand names became familiar to consumers. 1788; Origins of American trademark protection is the manufacture of sail cloth. 1789; Lead label or seal required to be affixed to goods, 1842; Michigan enacts a law requiring log marks to be registered in the country where the logs are to be manufactured into lumber. 1857; trademark laws enacted in France. 1862; Trademark laws enacted in UK, 1870; First trademark is registered to Averill paints, 1876; Bass® brewery registers first trademark in UK .1881; Trademark legislation is passed based on commerce clause of constitution. Provision made for registration of trademarks to be used in commerce with foreign nations and with the Indian tribes .No provision is made for interstate commerce, 1883; first International Trademark Agreement was reached at Paris Convention for the protection of Industrial Property .The countries involved in this convention agreed to provide the same protection regarding marks that they provide to their own Nationals. 1887; *Coca Cola*® first used as a trademark for a tonic beverage, 1895; Quaker® first registered as a trademark for oats. <https://www.legacy.lib.utexas.edu>

³ P. Narayan’s *Intellectual Property Law*, (3rdnd Ed. 1997, Eastern Law House Pvt. Ltd. New Delhi) P.145-146.

The definition of the trademark has been truly enlarged in the sense that now it is inclusive by nature which is more of illustrative and even something not mentioned in the definition also may be considered and taken as trademark or service mark.⁴ The novel trademark in this modern era has brought a transition in the law of trademark and is in a way great challenge for the team drafting the legislation in the country. Most of the marks are registered territory wise and truly speaking the validity of such innovative marks throughout the globe might not truly be possible.⁵

A trademark which is registered under the Statute is called registered trademark, whereas a trademark unregistered is called Common law Trademark.

Present subject matter of research study is that the definition and meaning of trademark now in recent times is taking innovative and flexible form due to the development taking place due to the creativity and Intelligence of the people, sound is given the status of trademark though Sound trademark is not defined by the Trademarks Act 1999⁶. Trademark takes the form of Non-conventional trademark like Sound, Taste, Shape, Smell, texture, motion etc and when it is not Conventional like word mark, logo, sign, symbol etc.⁷ In India the sound

⁴Nimisha Gupta, Non-Conventional Trademarks in India, A Non Conventional Trademark includes both tangible signs like Colours , Shapes , Moving, Images , Holograms and positions or Intangible signs like sounds , scent, taste and texture , which identify the product or service. The stepping over the conventional is a result of the open-ended definition of a trademark. They are challenging to be registered. India's recognition of such marks is a streak of the maturing intellectual property regime in the country. E.g. of Non-Conventional Trademarks are: Yahoo's non-conventional sound mark, Shape of coca-cola bottle, Pillsbury Doughboy's childlike giggle. Roar of the MGM Lion. Updated on 6th May 2019, <https://www.quickcompany.in> visited on June 2nd at 5P.m.

⁵Annand , and Kemp, L.,2011.GlobalRegistration-Where are we Now.TR,101(1), P. 94-99.

⁶Anubhuti Rastogi, "Non Traditional Trademarks" Generally a trademark comprises a name, word, phrase ,logo symbol, image etc however there are certain other non-traditional trademarks which have gained prominence in recent times and include sound marks, color marks, shapes and taste marks, 2ndJanuary, 2019. <https://lawtimesjournal.in> visited on March 25th 2019 at 10 p.m.

⁷*Harley Davidson Inc v. Selectra International Designs* [861 F Supp 754, 754 (E.D. Wis 1994)] The exhaust roar of Harley Davidson's motorcycles seems to be very characteristic, but the Japanese manufacturers , Suzuki, Kawasaki, Yamaha and Honda as well as American manufacturer Polaris objected saying that other motorcycles can also make similar sounds .

William Grant & Sons Ltd. V. Mc Dowell & Co. Ltd. [1997(17) PTC,134]; this case dealt with an action of passing off and for the first time recognized importance of trade dress vis-à-vis a trans-border reputation. With regard to shapes the settled position of Law is that trade dress needs to be distinct and

trademark is being popularly utilized to identify the products. The Researcher believes that there should be a thorough study and critical study of Infringement and passing off law because a genuine trademark always carries Goodwill and Reputation with it⁸.

The modern concept of passing off has been developed into extended Passing off. Earlier passing off action could be initiated by the trademark owner where her or his goods were sold or where the services were rendered, but now with this concept of extended passing off and Trans-Border Reputation publicity, passing off action can be taken even if the Prior users trademarked goods are not sold in a certain place where his trademark is infringed. Trademark has forced the courts to pass innovative decisions taking into consideration the modern innovation in the area of businesses and trade and commerce.⁹

A trademark provides protection to the owner of the mark by ensuring the exclusive right to use it to identify goods or services, or to authorize another to use it in return for payment. The period of protection varies, but a trademark can be renewed indefinitely on payment of additional fees¹⁰.

Although registration of a trade mark is not compulsory, it is advisable to apply for registration, because registration provides a cost-effective way to preventing infringement, and also prevents others from appropriating and registering your trade mark¹¹. In addition, registration is a guarantee of

must have acquired secondary significance. The Indian Courts have also addressed the issue of use of a 'Single Color' and has categorically stated that a single color cannot be inherently distinctive.

⁸ Cornish & Llewelyn, *Intellectual Property : Patents, Copyright, Trade Marks, And Allied Rights* (6th Ed.2007, Sweet & Maxwell, South Asian Edition. Printed in India by Baba Barkha Nath, Haryana).

⁹ ShilpiSharan, "*Recent Important Judgment son Trademark Law in India* :see also *Munish Kumar Singla Trading as Chakshu Food Products v. Jollibee Food Corporation* ;Delhi High court held that MNCs can't claim right on trademark if they don't use it in India . See also *R.J Components and Shafts v. Deepak Industries Ltd.*; Delhi high court reiterated the law that Rights of prior user of a trademark overrides the subsequent user even if the later has registered the trademark. <https://www.vakilno1.com>

¹⁰ VK Ahuja, *Law Relating To Intellectual Property*,(Second E.d.2013, LexisNexis, Gurgaon Haryana) P. 295-304

¹¹ Ibid

immunity to infringement actions based on the registered trademarks of other parties.

Internationally India has a status of membership in World Trade Organization.¹²In Madrid Protocol amongst G-20 Economies, India is ranking 14th in acceding it which will help Indian trademark owners to register their trademarks at WIPO in the Member Countries by filing a single application in India.¹³There are number of Conventions, Agreements and Treaties that are in enforcement by Government to protect the Intellectual Properties. ¹⁴ E.g. Adelphi Charter on Creativity, Innovation and Intellectual Property, TRIPS (Trade Related Aspects Of Intellectual Property Rights),¹⁵DOHA declaration, Intellectual Property Organizations which are founded by treaty, Paris Convention ¹⁶ for protection of Industrial Properties, WIPO ¹⁷ (World Intellectual Property organization), Berne Convention for protection of literary and artistic work¹⁸.

¹²Article, Pressroom; India Joins the International Trademark System. The treaty entered into force with respect to India on July 8th 2013. The Madrid System for the International registration of Marks (Madrid system) offers trademark owners a cost effective, user friendly and streamlined means of protecting and managing their trademarks internationally. <https://www.wipo.int> Visited on 15t April 2019 at 5P.m.

¹³Business Line, News; India doing well in Digital IPR. Speaking about new dimension added to intellectual property , the application of Artificial Intelligence and data WIPO Chief Francis Gurry told Business Line , ‘’ India is very well placed in this respect, because of the number of biometric data across the whole population . This is going to be one of the major advantages of India in the future’’ <https://www.thehindubusiness.com>

¹⁴Supra note. , Naryanan P, (3rd Ed. 2000) P.1. 2.

¹⁵Wikipedia; ‘TRIPS Agreement’: Trade Related Aspect of Intellectual Property Rights is an International Legal agreement between the entire member Nations of the World Trade Organization (WTO). It sets down the minimum standards for regulation by National Governments of many forms of Intellectual Property (IP) as applied to Nationals of other WTO member Nations. India is a founder member of both GATT and WTO which automatically made it signatory of TRIPS agreement. <https://www.wikipedia.org.com>

¹⁶WIPO, International Bureau of Op.cit. Para 79. Article 5C(2) of Paris convention permits the use of a Trade Mark in a different form in one of the countries, if such different form of the same Trade Mark does not alter the distinctive character of the Trade Mark . Such use shall not entail invalidation of the registration nor diminish the protection granted to the Mark.

¹⁷WIPO is one of the specialized agencies of the United Nations (UN), WIPO was created in 1967to encourage creative activity , to promote the protection of Intellectual property throughout the World .WIPO currently has 192 member states, administers 26 international treaties, and headquartered in Geneva, Switzerland .

¹⁸ Cornish W.R., *Intellectual Property*(6th Ed. 2006,Sweet & Maxwell).P.16. 22.

1.2 IMPORTANCE OF THE PRESENT RESEARCH:

Trade mark identifies the product and its origin, it guarantees its quality, it advertises the product, and it creates an image of the product or service in the minds of the public, particularly the consumers or the prospective consumers of such goods.¹⁹

The marks associated with the goods or services come to acquire a reputation and goodwill around them. Trade mark plays a very important role in the economy of any country.²⁰ Trademarks establish goodwill between the source of a product or service and the consumer. Trademark guarantees its quality and creates an image of the product in the minds of the public, particularly consumers or the prospective consumer. Trademarks are an asset which forms the foundation of any business to the ultimate purchaser or the consumer. Trademarks play an important role for the commercialization and growth of the industries. Trademark enables consumer to quickly identify and make a purchase decision.

The Researcher has chosen one of the most important Intellectual Property to do an extensive study on the same and it is '*TRADEMARK*'. The Researcher has taken this area of Research because trademark is a very important Concept in today's Commercial world. In India businesses are growing to a great extent and all this contribution obviously goes to the 'business name' or the 'Trademark' of any Company, Corporation, Organization, Society or its Goods or Services at Large²¹.

¹⁹ Abheek Singh, Nimisha Jain, 20-03-2017, 'The New India: *The Many Facets Of A Changing Consumer*'. India's nominal year-over year expenditure growth of 12% is more than double the anticipated Global rate of 5% and will make India the third-largest consumer market by 2025. <https://www.bcg.com> Visited on 9th Jan 2018, at 10 a.m.

²⁰ K.C. Kailasam & Ramu Vedaraman, *Law Relating To Trade Marks*. (3rd E.d. 2013. LexisNexis, Gurgaon Haryana.) P.390, 396.

²¹ Avtar Singh, *Intellectual Property Law*, (1st Ed. 2013, Eastern Book Company, Bangalore.) P.7.

The Researcher wants to find out whether the Trademarks law in India is really protecting the rights of genuine proprietor of trademark or is there any shortcoming in same. The Researcher has found this topic more interesting because Trademark is developing more and more due to innovation and novel creation and people are trying to protect the same from Infringement and Passing off by remaining vigil and alert and safeguarding the same in different innovative ways for e.g. In a recent development, Trade Mark Registry has registered *image of Taj Mahal Hotel* in June 2017 and given it a Trademark which is a *landmark* Registration.²² This is the first time a structure in India has been registered and the second building structure which has got its trademark registered is the Bombay Stock Exchange Ltd. in June 2018 for its Phiroze Jeejeebhoy Towers which is 28 storey building.²³

Trademark and its Law are truly taking a pioneering move in the Country with Judges passing different innovative decision.²⁴ The innovations and development of this law at National as well as International level, has created more interest and curiosity for the researcher to do research in this field. Government is also positively supporting to enrich and develop Trademark and its Law in India.

This study is very important because the trademark or service mark is connected with goods and services which are core of the Business World and without which the Economy would not function. These goods and services again comprises of name, logo etc. which is their trademark or service mark

²²Lalatendu Mishra, *The Hindu News Paper*, and Mumbai on 24th June, 2017- In Mumbai, Taj Palace gets a trademark. This enhances the Taj Palace's place in the world like other well known trademarks around the world with trademarks e.g. Eiffel Tower in Paris , Empire State Building in New York City, Sydney's Opera House .

²³Aarefa Johari, 'Two Iconic Mumbai buildings have got trademark protection' The facades of the Taj Mahal Palace and the Bombay stock Exchange building are now registered as trademarks . <https://www.scroll.in> 16th April, 2019.

²⁴ShilpiSharan, 'Trademark Law In India', In a recent verdict the Delhi High Court in the case; *ITCLTD. v. Britania Industries* [CS(COMM)1128/2016] : has settled the principle regarding term of use by holding that to acquire secondary meaning it is not necessary that product is in the market for number of years . If a new idea is fascinating and appeals to the consumers, it can become a hit overnight. <https://www.vakilo1.com> Visited on 26 Feb 2019 at 3 P.m.

and which need to be protected constantly from Infringement and passing off by the infringer.²⁵

The significance and strength of Trademark can also be understood with the revolution and development it has brought in this recent modern internet age in this area of law and hence requires protection from infringement and passing off.²⁶

The researcher has studied the relevant and landmark cases on the same in order to come up with thesis which throws light on this area of law.

The researcher will try to study and understand the oldest case laws on trade mark that is the passing off action as a remedy available under the common law, hence the present research study is not restricted for a particular year.

Irrespective of the trade mark legislation in India there is rampant infringement and passing-off of the trademarks, of the genuine proprietors²⁷. Sometimes there is a lot off delay by the courts in providing justice to the owner of the trade marks²⁸. Hence the researcher is trying to locate the problem in this area of research i.e., Trade Marks Legislation .The Researcher wants to study the different decisions by the Court of justice on the subject of Infringement and

²⁵ P.K. Mittal & O.P. Chadha, *Supreme Court On Trademarks, Copyrights, Patents & Designs, 1950-1999*, 1st Ed. 2000, Om Law Book House, Delhi.

²⁶ *NAMES* , : Since a “domain name” serves as the primary indicator of what will be found on a particular website on the internet, a distinctive or memorable domain name is highly desirable .further the domain name holder may wish to trademark the domain name in order to prevent others from using it .

In *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.* [2004(3)AWC2366 SC] The Supreme Court held that ‘domain’ names are business identifiers, serving to identify and distinguish the business itself or its goods and services and to specify its corresponding online location. The Court also observed that the domain name had all the characteristics of a trademark and an action of passing off can be found where domain names are involved. The decision was in favour of Plaintiff.

²⁷ LexOrbis; By Omesh Puri, Dheeraj Kapoor, Shilpi Jain and Anirudh Singh, ‘Flashback 2017- Supreme Court Of India on Trademark’ Feb 21, 2018.

The year 2017 has been instrumental in shaping the evolving IP(Intellectual Property) jurisprudence in India, with the Hon’ble Supreme Court having decided and heard several matters inter-alia pertaining to the trademarks . <https://www.lexorbis.com> Visited on 28 Nov 2018 at 5P.m.

Passing-Off Action. ²⁹The Researcher believes that Passing off action which is a Common Law under the Law of tort walks hand in hand with the Statutory Infringement action to sue the wrong doer as far as the infringement of trademark is concerned³⁰. The passing off law is more important when there is a chance where the infringement action might fail. Passing off Law has developed to a very great level and is developing more in the area of trademark jurisprudence where in the judges are coming up with flexible and novel judgment and principles like Cross-border reputation, concept like extended passingoff, also covering Domain names on internet website etc which in turn helps the Law of passing off to develop even more and come out of its traditional ambit and extend to other areas too on the basis of Goodwill and reputation of the trademark or Service mark which truly interests the Research study try to explore more decided case laws and principle set by the Passing off and Infringement action decisions laid down by the Courts.

The Researcher finds the subject of this research very interesting as the trademark/ service mark concept is developing to a great extent in this present era of Globalization where the trademark protection is covering not only the traditional types of trademark but also the non-traditional types too like Sound, shape, colour, smell, Taste, Motion, Hologram, etc and hence the scope of the research is very wide³¹.

Undertaking Research in this field is very important as it gives the Researcher an opportunity to come up with Thesis and Conclusion which can do some

²⁹ SPICY IP, 'Bombay High Court Imposes A Whopping Amount Of Rs 5 Crore Costs for Trademark Infringement in *Nippon Steel & Sumitomo Metal Corporation v. Kishor D Jain & Anr*[COMIP(L)NO.383 OF2019] justice S J Kanthawalla began his order with a quote from Mahatma Gandhi- '*There is sufficiency in the world for man's need but not for man's greed*'. <https://www.spicyip.com>

³⁰ V K Ahuja, *Law Relating To Intellectual Property Rights*, (2nd Ed. LexisNexis, Gurgaon Haryana.)P.1.

³¹Nicholas S. Economides, "The Economics of Trademarks" Trademarks facilitate consumers' choice among experience goods and transmit quality signals for infrequently consumed goods. The primary reasons for the existence and protection of trademarks are: (1) They facilitate and enhance consumer decisions and (2) they create incentives for the firm to produce products of desirable qualities even when these are not observable before purchase, <https://www.stern.nyu.edu>, visited on 12.04 2016, at 6.00 pm.

Positive contribution to the Trademark Law in Academic field in the area of Law jurisprudence in a very positive manner. The Researcher believes that Trademark is connected with the Goods and Services which are used and consumed by the Consumers at large and the consumption of product has a direct relation with the health and well being of the people in the society and hence research on this subject becomes more important from the Society point of view by coming up with valuable conclusion and suggestion by creating a positive awareness of this Law of Trademark with reference to Infringement and Passing off³².

The research result of the thesis will be useful for the Students of Law as a reference in their projects and for further studies etc.

Another reason why the Researcher believes this research is important is also because the Indian Trademark Law is connected with International Treaties, Agreements, Conventions and Protocol which is truly important because the concept of trademark is growing and has gained Trans-border Reputation and Goodwill which is protected by these Agreements and Treaties.

Furthermore this subject is of special significance to the Researcher as the Trademark or Service Mark apart from playing an Important Role in the life of the Product, also plays vital role in the life of Human being too by providing quality product and life by adding value to the Society and hence its protection from infringement and passing off is of utmost significance, which inspired the Researcher to conduct a comprehensive research of the same. Goa being a tourist place and attract Indian and as well a foreign tourist, it is one of business place with more literacy rate in India, till today no study has conducted in Goa to find out the awareness and idea of infringement of trademark in Goa. To find out this research study is very significant.

³² Iyenger's, *The Trademarks Act*, 4th E.d.2014 Universal Law Publishing Co. New Delhi, P.227-232.

1.3 OBJECTIVES OF THE STUDY

Following are the objectives of the present research study

1. The main objective of the research is to make a comprehensive research of the trade marks legislation in India.
2. To Study different Case laws on Infringement and Passing off and see whether the Trademark legislation in India has served its purpose in protecting the 'Rights' of Trademark or Service Mark Proprietors.
3. To study the Role of Judiciary in Infringement and Passingoff action and also the contribution made by the Judiciary in the development of this Law while deciding the Cases.
4. To study the Trademarks Act, 1999 and analyze the advantages and also the shortcomings of the Act if there is any and provide valuable suggestions on the same.
5. To critically verify the functioning of Trademark Registry under the Trademark legislation in relation to opposition and rectification proceedings this in turn related to infringement.
6. To come up with a theory by doing a comprehensive research and forming a thesis comprising of valuable inputs, suggestions and conclusion on the subject of present research.

1.4 RESEARCH QUESTIONS

The Important Questions related to the research study are highlighted below which are truly important to seek and achieve the outcome of the study.

1. Is the law relating to Infringement and Passing off Action in India is serving its purpose and objective entirely?
2. Has the Trademarks Act 1999 fulfilled its Object especially in reference to Infringement and Passing off Action and whether The Rights of Prior User really protected under the legislation in India?

3. Are the Courts in India providing justice to the aggrieved parties at a Satisfactory Level in the cases of Infringement and Passing off and is done so within reasonable period of time?
4. Is the Trade Mark Registry functioning up to the mark to achieve its objective especially in the process of opposition in turn Infringement and Passing off concept is taken into account while registering the Trademarks or Service marks.
5. Does the IPAB give appropriate justice while hearing the Rectification proceedings in relation to the Infringement of trademark and within the reasonable time limit and whether it has achieved the object of the Trademarks Act 1999?
6. Does the Statutory Authorities recognize the rights of Prior User in reality while deciding on the registration and rectification of the trademarks?
7. Has the Trademarks Legislation in India achieved its overall Objectives in the matters relating to Infringement and Passing off Action.

1.5 HYPOTHESIS

For the present Research study the Researcher proposes the following hypothesis to be tested in course of my study.

Since the inception of the Trade Mark Legislation in India, the Trade Mark law has not achieved its Objectives and Aims, like;

1. The awareness and knowledge of trademark and its law is considerably less amongst traders (public) and hence there is increase in Infringement and Passing off of the Trademark or Service Mark.
2. This Act has failed to achieve the Object of giving utmost Protection to the Owner of the trademark and Service Mark.

- a. At the time of Registration many complaints were filed in relation to opposition and rectification causing hardship to traders in obtaining trademark.
 - b. Infringement and Passing-off action under the Trademarks Legislation has not been totally satisfactory and successful in achieving its goal that is providing justice to the registered Owner / Prior User of the Trademark by bringing prompt action on the Infringer of the Trademark.
 - c. There is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India.
3. The functioning of the Administrative Authorities under the Trademarks legislation namely the Trademark Registry and Intellectual Property Appellate Board (IPAB) is not satisfactory due to delay in the Registration of the Trademarks on the part of Registry and also in disposal of matters by IPAB and the Registry and hence the trademark owners are not satisfied as it leads to economic loss and hardship and also loss to the Reputation of Trademark Proprietor.
4. The researcher proposes that;
- a. Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation.
 - b. Trademarks Act needs to be amended by incorporating passing off provisions to make it more comprehensive and suitable as per the changing conditions in the society.
5. The Rights of trademark owner are not fully protected and there is a delay in giving them justice by the Administrative Authorities under the trademarks legislation as well as Judiciary in India.

1.6 METHODOLOGY ADOPTED

The researcher collected the valuable and relevant information and data by adopting the methodology of Doctrinal as well as Empirical study, collecting the same from Primary as well as Secondary source. The Researcher has collected the data by way of Random sampling and the procured data and information were from the Respondents who showed their quick response to the Questionnaires given to them by the Researcher. These stake holders were selected as they are connected with the trademark and also has stake in the same and some of them for e.g. Students may have interest in the trademark in the near future.

Primary Source of data:

The primary source of data has been collected through Interviews direct/indirect, as well as on telephonic interviews, formal and informal questionnaire and observation methods.

The researcher collected data from stake holders like Advocates practicing in different places in India like Goa, Mumbai and Delhi directly, or through telephone interview and emailed the questionnaires. The researcher also interviewed the statutory authorities of trademark telephonically, the authorities include:

1. Deputy Controller of Patents, Designs and Trademarks, Chennai,
2. Assistant Registrar of Trademark and Geographical Indication (GI) Chennai, Kolkata Trademarks Registry's Senior Examiner of Trade Marks and GI (Drawing And Disbursing Officer),
3. Controller General of Patents, Designs & Trade Marks (CGPDTM), Mumbai,
4. The researcher collected empirical data the Police Stations in Panjim, Old Goa, Mapusa, and Margao, Goa.
5. The researcher interviewed the Goa Custom Office and the Registrar of Companies Office by way of informal questionnaire.

The researcher distributed the questionnaire and collected data from 250 Students, 2000 shops, Businesses establishments and traders in places like Goa, Mumbai, Delhi, and Bangalore.

The Researcher also collected data through formal questionnaires from Professionals in different areas of work like Doctors, Engineers, Professors, Teachers, Architects, Auditors, Company Secretary, and Sales tax Consultants etc.

The Researcher have personally attended the matter related to Infringements and Passing off in the Court in places like Goa, Bombay, Delhi and observed the process of opposition and rectification proceedings.

Secondary Source of data:

The Researcher visited the following libraries in Goa as well as other places during the period research study Salgaocar College of Law library, Goa university library, Central Library, Panjim, Saraswati Library, Panjim, Harold Central Library in Chicago, Public Library USA, in May2015, Government Law College library , Mumbai, Bombay high court library , Mumbai. The researcher collected data form books, articles on intellectual property rights from national and international law journals, magazines, research articles, Official annual reports published by CGPDTM [Controller General of Patents, Designs and Trademarks], Progress reports of intellectual properties, Reports of government agencies and departments, Reports of DIPPs, Various articles published on websites, Law related internet database, Law journals and manuals, All India reporters, Supreme Court cases, High Court cases, various publications by prominent authors, Commentaries of Prominent writers, encyclopedias, dictionaries, various legislations enacted by the Indian parliament on the present research study.

1.7 LIMITATION OF RESEARCH STUDY

Intellectual property includes various subject matters as mentioned in the beginning of this research. The present research study is restricted to trademark legislation and mainly focusing on Infringement and Passing off Law in India. As a result the researcher limited only to the infringement and passing off, concepts under the Trademarks Act 1999(as amended in the year 2012) and Trademark Rules, 2017.

The Researcher analyzed various Supreme Court and High Court judgments on this subject. The researcher referred even to the oldest case laws and landmark Judgments of different Courts.

The other related and relevant Statutes were mentioned with reference to the present research on infringement and Passing off Law like:

- a) The Constitution of India
- b) Indian Penal Code 1860
- c) The Specific Relief Act, 1967
- d) Customs Act 1862
- e) Companies Act 2013
- f) The Code of Civil Procedure
- g) The Code of Criminal Procedure

The Research wherever necessary made comparative study of International Trademark Law but the focus will be more on Infringement and passing off action in India.

The Research study comprises of valuable information and data from The Controller General of Patents, Designs and Trademarks, The Registry of the Trademark and also from the IPAB. Statistical data for this study was collected from genuine IPR website. Researcher collected data for a period of 10 years. For this study the researcher appointed his office staff in collecting empirical data through questionnaires. Further the researcher also filed RTI (Right to Information) application to collect data from judiciary to cross verify the results. But researcher efforts are in vain. Researcher adopted simple random sample in collection of data from various stake holders.

1.8 STRUCTURE OF THE THESIS

The present Research study comprises of Six Chapters. The Structure of this study is briefly highlighted as below;

CHAPTER 1: INTRODUCTION

This is the first Introductory chapter of the Research comprises of a brief explanation of IPR (Intellectual Property Right) as a whole and then it explains the 'Meaning' of Trademark, Infringement of trademark.

This Chapter also deals with the 'Importance' of the study which has been explained along with the 'Objective' of the Research. The Research 'Questions' related to the subject of Research have been raised in this Chapter which will be considered while conducting the research.

The 'Hypothesis' is also mentioned in this chapter which is to be proved or disproved. Then the 'Methodology' that is adopted while conducting the Research has been explained after that briefly the 'Limitation' part of the research and so also the Scope of the present Research has been mentioned.

CHAPTER II: CONCEPT, SIGNIFICANCE AND DEVELOPMENT OF TRADEMARK AND TRADEMARK LAW IN INDIA

This is the Second Chapter of the Research and it contains the detail explanation as regards the Meaning, Concept, Kinds, Significance, and Development of the Trademark and Trademark law. This chapter explains in detail the Concept of the term Trademark, the Evolution of Trademark and its Development and History from Indian perspective although the Researcher has briefly considered the International aspect too.

After this the importance of the trademark is enumerated in detail and last but not least the types and classification of trademarks have been covered by the researcher in detail.

CHAPTER III: CRITICAL ANALYSIS OF INFRINGEMENT AND PASSING OFF WITH REMEDIES

This Chapter is divided in to two parts Part - I deal with infringement and Part - II deals with passing off action. The Researcher has explained in detail the meaning of Infringement, its essentials or ingredients and different methods.

The Infringement of trademark that has been defined in Section 29 of the Trademarks Act, 1999. Infringement idea is applied only in case of registered trademark.

The researcher also enumerated Section 27(1) which says that there shall be no infringement action in case of infringement of un-registered trademark. But clause 2 of the same section has saved and reserved the rights of the trademark proprietor under the Common law to take a Passing off action against such any infringer for passing hers or his goods or services as of another person.

The Researcher has discussed in brief the Concept of Passing off, its Ingredients, the different methods adopted by the wrong doer, The Role of Judiciary the Remedies and Defenses provided in case of passing off.

Most importantly the different tests laid down by different Courts from time to time to identify the different ways of Infringement and Passing off have also been highlighted in this chapter.

The Remedies can be enumerated in the following manner;

- 1) Civil Remedy
- 2) Criminal remedy under the Trademarks Act as well as under IPC
- 3) Administrative remedy
- 4) Other Remedies under;
 - a) Customs Act 2013

- b) Companies Act 1962
- c) File Complaint with 'IN Registry' which solves the dispute in accordance with the IN Dispute Resolution Policy (INDRP) which appoints an Arbitrator.

CHAPTER IV: STATUTORY AUTHORITIES UNDER THE TRADEMARKS ACT

The Researcher has enumerated the different statutory Authorities set up under the Trademark Act, 1999 which looks after the administration of the trademark legislation in India namely:

- a) DPITT (Department for Promotion of Industry and Internal Trade) which was earlier known as The DIPP (Department of Industrial Policy and Promotion) under the Ministry Of Commerce And Industry, here in after DPITT the DPITT is the Nodal Authority which formulates and implements Intellectual Property Rights, DPITT frames comprehensive policies which also covers Trademark, DIPP along with WIPO, also plays an important Role in creating awareness of IPRs.
- b) The CGPDTM (Controller General of Patent Design and Trademarks) reports to the DIPP. One of the administrative sections which it looks after is Trademarks registry in which it supervises the administration of Trademark Registry.
- c) IPAB (Intellectual Property Appellate board): IPAB was established by the Central Government and this board hears the appeal from the decision taken or the order passed by the Registrar under the Trademark Registry (TMR).

So also the application under the trademarks act can be filed at IPAB for Rectification of the Trademarks Register in the Registry The object of IPAB is to dispose the appeal in speedy manner and so also the rectification applications has to be disposed quickly .

d) Registrar of Trademark: The primary object of the Registry under its Registrar is registration of trade and service marks and so also the protection of the same from fraudulent and infringing. While registering the different marks under different classifications the Registrar takes every care so that the genuine trademark or service mark is protected from infringement and passing off by the infringer.

In case of Infringement authorities under the Trademark legislation can play an important role in settling the disputes and reducing the burden on the courts.

Researcher has also specified various Remedies available to the owner of trademark in case of infringement suit under the Act and Passing off action which is under common Law with the help of judicial pronouncements.

CHAPTER V: FUNCTIONING OF TRADEMARK AUTHORITIES UNDER THE TRADEMARKS LEGISLATION IN RELATION TO OPPOSITION AND RECTIFICATION PROCEEDING

This Chapter highlights the Compilation and Analysis of data collected by the Researcher in relation to Opposition and Rectification proceedings of trademark by the Authorities under the Act.

For the purpose of convenience and understanding this Chapter has been divided in to two parts:

Part A deals with Statistical data collected from official web site of trademark registry, its compilation, analysis and depiction of data in table form. The same data was also shown in the form of chart.

Part B deals with Empirical data collected from various stake holders dealing with trademark. The same was analyzed and depicted in the form of tables and charts.

CHAPTER VI: CONCLUSIONS AND SUGGESTIONS

This Chapter pertains to the Conclusions of the research study. It captures the loopholes and gray areas surrounding the functioning of Trademark Registry and IPAB in relation to Registration, Opposition and Rectification proceedings of the of trademarks.

Based on the Empirical data and analysis, the Researcher has drawn various inferences and has given Suggestions/Recommendations for the effective implementation of Trademarks legislation in India taking into consideration Opposition and Rectification proceedings by the Authorities under the Act as well as on the basis of different judgments passed by different Courts in India. Most importantly, the Research hypothesis proposed by the researcher is tested in this chapter based on the extensive Study conducted by the researcher.

CHAPTER II

CONCEPT, SIGNIFICANCE AND DEVELOPMENT OF TRADEMARK AND TRADEMARK LAW IN INDIA

CHAPTER II

CONCEPT, SIGNIFICANCE AND DEVELOPMENT OF TRADEMARK AND TRADEMARK LAW IN INDIA

2.1 INTRODUCTION

Trademark is very essential or vital in the life of Consumer as he tries to purchase goods/product in the market place based on the brand he knows and in which he has trust.³³

In this chapter the researcher has defined the Meaning, Importance, need, idea of trademark and also the functions, kinds, classification, and development of trademark in India from time to time.³⁴ Regarding development the Researcher has firstly explained the development taken place internationally and then covered from Indian context by discussing the different legislations made in India during the British regime and after Independence³⁵. Thus the concept of protection of trademark has its roots right from the ancient times. Today in this modern era we have for the better protection and registration of the trademarks, National as well

As International Law of different countries all over the world protecting trademarks.³⁶ This is so because the entire world has now become a Global village due to the advancement in technology in many areas of our life.

³³ 'Trademark & Consumers', Business Knowledge Resource. Consumers often make their purchasing choices on the basis of recognizable trademarks/service marks. A trademark essentially serves as a link between the consumer and the manufacturer. It enables the consumer to get closer with the manufacturer. Consumers today demand safety and a continuous assurance of quality. In a way trademark is a specified set of promises from the manufacturer to the consumer. There is high level of consumer awareness of goods and the manufacturer of the same. So the manufacturer or the owner of the trade mark has to come up to the expectations of the consumers to make his Trade Mark acceptable to them. <https://www.archive.India.gov.in>

³⁴ K C Kailasam & Vedaraman, *Law Of Trademarks*, (3rd Ed.2013, LexisNexis, Gurgaon, Haryana)

³⁵ *ibid*

³⁶ Intellectual Property(IP) India, 'The Madrid System'- The Madrid system for the International registration of trademarks provides a single procedure for the registration of the mark in several territories. In a nutshell, you benefit from one application, in one language, paid in one currency. <https://www.ipiindia.nic.in>

2.2 CONCEPT OF TRADEMARK

Graphically when a Mark can be represented and this mark can differentiate between Goods or services of one Individual with the goods and Services of another and this mark can be the Shape of goods, colour combination or Packaging we can term this type of mark as a Trademark³⁷.

Hence we can say that if any mark is able to represent itself graphically its coming within the definition of trademark and so also it should be also able to differentiate goods or services of one person from goods and services of other trademark³⁸. This mark may be shape of goods, packaging, colour combination, a symbol, picture, a word, device, logo, label, Number, ticket, letter, heading, Signature, Name, Brand, Shape of Building. It can be combination of all the above things thereof. Trademark is usually has visual represented and also helps in locating the source of Goods or services. Trademark is like movable property and provides status to the owner of trademark.

In *Koonerji Bechari Lal v. Firm Adam Pir Mohammed*³⁹ the Sindh High Court has made an observation in 1994 that when a particular trademark is used by a firm to represent to the buyer that this mark is of their Goods and also of their successors too in the trade in which they are manufactured or are sold and in this arrangement or situation this Trademark becomes the firms property and the law gives protection to the owner of such trademark by protecting his or her right of owning property in such mark.

³⁷Dr S.R. Myneni, *Law Of Intellectual Property*, (2nd E.d. 2003.Asia Book House, Hyderabad)

Section 2(1)(zb) of Trademarks Act defines Trademark as a mark which is 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 colours .

³⁸ By Kislai Komal, February 8, 2019, Trademark; Meaning, Objective and Infringement: The legal definition under the trademark act 1999 is inclusive one and not exhaustive one. So anything can be considered a trademark if it is capable of graphically represent either in single dimension or in two dimension or in three dimensional space. <https://www.setindiabiz.com>

³⁹ AIR1944 Sind21

Now a day's many structures/monuments are registered in India and other countries.⁴⁰ E.g. Mumbai Trademark Registry under the Trademark Act, Registered, and Taj Mahal Palace Hotel has got its Architectural structure as trademark and it is the first such structure to be registered as trademark in India. This makes the concept of trademark broad, modern and innovative.⁴¹ Other such Structure in the World to get such trademark registration is Eiffel Tower in Paris⁴², Opera House in Sydney and Empire State Building in New York.

The importance of the trademark can be perceived on the basis of its functions. Based on the functionary attributes of any trademark, the product as well as the proprietor of the trademark/service mark develops goodwill and reputation in the business world as well as in the society at large.

2.3 FUNCTIONS OF TRADEMARK/SERVICE MARK

Now let us understand what are the functions and role of a good and genuine trademark for goods or services performs and plays in terms of protection of the proprietary right, which the proprietor enjoys in the product and also its role in the life of the Consumers and public at large and finally the value addition and contribution the trademark does in developing the economy of India at National as well as International level.

a) To Identify the Manufacturer and Service Provider

One of the important functions of trademark is that it creates an identity of the manufacture of goods or the provider of the services which in turn helps the consumer to identify the source of the goods and services easily⁴³. It would

⁴⁰Lalatendu Mishra, In Mumbai Taj Palace gets a trade mark under class 43 of the Trademarks Act 1999; Service Classification. <https://www.thehindu.com>, 24th June, 2017, 21:43 IST.

⁴¹ Lionel Bently Brad Sherman, *Intellectual Property Law*(Indian Ed. Oxford New York, Marketed by Asia Law House .Hyderabad)

⁴²My Modern Met; The Eiffel Tower in Paris was registered as Trademark in the year 1978. Technically any images of Eiffel Tower at night must obtain permission from the copyright holder so also even sharing such image on social media. <https://www.mymodernmet.com>

⁴³Narayan. P, *Intellectual Property Law* (3rd Ed. 2017, Eastern Law House, New Delhi), p.147.

rather be rather cumbersome to the consumer and general public to identify the Manufacturer or the service provider. This identity creates a confidence in the public at large and the consumers to purchase the products with confidence. To take an illustration the mobile and internet connection of JIO is bought by the users on the identity of the supplier and proprietor of this service product that is 'Reliance Co'.

After 20 years of long battle, the court *Amul v. Anul* brought an injunction against Anul (Shri Shakti Dairy and Kuldeep Enterprises) for infringing the trademark of Amul (Co-operative Milk Producers Union Ltd).⁴⁴ This case involves phonetic similarity while pronouncing and also deceptively both the names look alike at a glance.

In *Bhavnesb Mohanlal Amin v. Nirma chemicals Works Ltd*⁴⁵ the Supreme Court held that the trademark NIMA is deceptively similar to the registered trademark NIRMA in appearance as well as pronunciation and hence amounts to infringement and hence upheld the decision of the trial court of granting injunction⁴⁶ against the Bhavnesb Mohanlal Amin for using the trademark 'NIMA'.

In, *M/s Marvel Tea Estate India Ltd v. M/s Nusun Genetic Research Ltd*⁴⁷ the Delhi high court passed an interim order and restrained the defendant from using the plaintiff's trademark 'MARVEL' and also ordered to dispose of whatever materials are left by the name 'NUSUN MARVEL' within six months.

⁴⁴ Times Of India June,27, 2018, 'After two decades, Amul wins legal battle against Anul', In Vadodara Commercial district Court ,After 20 years legal battle, an Ahmedabad based private dairy has been restrained from selling pouched milk under the brand names of 'Anul Taaza' and 'Anul Shakti'

⁴⁵ (2006)1 SCC 185.

⁴⁶ See also *Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar proprietor ltd.* [AIR 1996, Bombay, 149] 'In the case of trading name which has become almost a household word and under which trading name a variety of activities are undertaken, a passing off can successfully lie if the defendant has adopted identical or similar trading name and even when the defendant does not carry on similar activity .Even if the defendant's activities in such circumstances are remote, the same are likely to be presumed a possible extension of plaintiff's business or activities '

⁴⁷ I. A. No. 5464/2010 in CS (OS) No. 803/2010.

time as the defendant used a identical trademark and this amounted to infringement and passing off of the Plaintiff's trademark.

b) To Protect the Goodwill and Reputation of the Proprietor

A genuine trademark always creates a goodwill and positive reputation of the proprietor of goods and services sold in the market.⁴⁸ The proprietor of a reputed trademark or service mark shoulders all the responsibility to maintain the quality and quantity of his or her products. E.g. A reputed Co. TATA⁴⁹ is having an tremendous goodwill in the market which wins the faith and trust of the public at large and also which creates the confidence in the consumers to purchase products manufactured or services provided by TATA without any doubt in their mind . It would rather be difficult for the genuine proprietor of the genuine trademark to take care of his or her name as well as the name of the product without a trademark and as a result the unscrupulous dealers would have taken wrong advantage of the same and life of the public and society at large would be at risk.

c) Gives Legal Right to the owner as to its Usage

Trademark owner or the registered user⁵⁰ gets the right to use it legally or assignee⁵¹ always has and gets a legal Right as to its usage⁵² . Provided such proprietor is prior to use such trademark or service mark. Once the proprietor of such trademark is a registered® trademark owner under the trademark Act

⁴⁸ Ahuja VK, *Law Relating To Intellectual Property Rights*, (2nd Ed. 2013. LexisNexis, Gurgaon Haryana), P. 277, 278.

⁴⁹ Economics Times: "Most Successful and Influential Companies in India", 19th Feb 2013, The Tata Group tops the list of most successful and influential Companies in India which had a surprise entrant among Top 5; Deli Metro. The study conducted by London-based consultancy TLG Partners.

⁵⁰ Sec. 48 ,Trademark Act 1999 , 'Registered user is a person other than the registered proprietor of the trademark may be registered as registered user thereof in respect of any or all of the goods or services in respect of which the trademark is registered '

⁵¹ Sec. 37 Trademarks Act 1999. Power of Registered Proprietor to Assign and give Receipt: The person for the time being entered in the register as proprietor of a trademark shall subject to the provision of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trademark and to give effectual receipts for any consideration for such assignment.

⁵²S.S. Rana & Co. 'Trademark Rights and Protection in India.' The Ownership of trademark in India is determined on a first to use basis, the first to use rule over first to file. <https://www.lexology.com>

then such proprietor gets statutory right as to its exclusive usage⁵³ and protection under the act subject to certain provisions of the Act. If the trademark is unregisteredTM then trademark is protected by the common law action of passing off. The trademark act too has recognized and protected the rights of unregistered prior user to an extent that even the registered trademark cannot stop the usage of unregistered prior user. In *Ramdev Foods Products Pvt. Ltd. v. Arvind bai Rambai Patel Pvt. Ltd*⁵⁴ the Supreme Court made an observation that Section 28 of the trademark Act gives exclusive right as to its usage to whoever registers the trademark under the Act.

The Delhi High Court in *Sun Pharmaceuticals Industries ltd v. Cipla Ltd*⁵⁵ held and stated that ‘Sec. 37 empowers the person in the register as proprietor of the trademark to assign the same’.

d) To Guarantee the Product and its Quality

Since there is a link and connectivity between the buyer and seller or manufacturer of trade-marked or service-marked goods and services respectively such seller or manufacturer shoulders the responsibility of providing quality products in the market following all the quality protocol and Standards. There are many quality standards and system followed by businesses in order to give the best quality products to the people like ISO Mark, ISI, AGMARK etc so also businesses also do Research and Development of their products, laboratory Analysis etc so also up-gradation of their existing plant and manufacturing etc. Some of the examples like Johnson

⁵³Sec. 28(1) of the Act provides that subject to the other provisions of this Act, registration of a trademark if valid, give to the registered proprietor of the trademark the exclusive right to use the trademark in relation to the goods or services in respect of which the trademark is registered.

⁵⁴ [Appeal (Civil) 8815-8816 of 3003. Civil Appeal no. 8817 of 2003 SCC] (The Court also observed that ‘However from the opening of section 28(1) of the Act namely, ‘Subject to the provisions’ the right conferred on the registered proprietor is not an indefeasible right. This is further made clear by section 27(2) of the Act, which says “nothing in this Act shall be deemed to affect the right of action any person for passing off the goods as goods of another person or remedies in respect thereof. Thus the right created by Sec. 27(3), 33 (Saving for vested rights of *PRIOR USER*) etc. It is also pertinent to note that the registered proprietor of a trademark gets exclusive rights to use the trademark in relation to goods or services in respect of which it is registered and that person may not have the right to use the trademark in respect of other goods or services in respect of which the trademark is registered’ .

⁵⁵ I A. No. 6872/2008, CS(OS)1073/2008

and Johnson baby products , Apple phones, I-pad, Jaslok Hospital, Hinduja Hospital, Taj hotels , Marriott's, Jet Airways, IIT Institute etc are examples of different Goods as well as services available in Indian as well as International market . All this is done in order to give the best to the consumer so that their health and safety and well being is assured This is how the quality of products are assured and can be trusted by the consumers and the general population of the people . so also in order to maintain the Goodwill of the brand name the producer always makes sure that he gives the best to the consumer for the simple fact that he doesn't want to decline his sale . When there is Quality product in the market, there is always a quality life in the society which always benefits the well being of the citizens and hence the life expectancy of the people is assured.

In *Syntex laboratories Inc. v. Norwich Pharmacal Co.*⁵⁶ the Court held that in case of Pharmaceutical products standards should be more for the prevention of 'Confusion of likelihood' as it can harm the public health physically.

e) Advertises and builds image of Product and services with proper representation

Trademark has inherent quality and function of advertising⁵⁷, in a sense that a trademark whether it is a designed device or a label or shape of the product or an colour trademark or for that matter a sound mark in the form of jingle or musical tone or a simple word mark always carries itself with advertisement feature.

In *Colgate Palmolive (India)Ltd. v. Anchor Health &Beauty Care Pvt. Ltd*⁵⁸ the Court held that the defendant showed 'first' and also 'only' in its advertisement which in reality was not true and was also misleading the

⁵⁶ [315 F. Supp. 45(S.D.N.Y.1970) June 30, 1970]

⁵⁷ Supra note 251: The Court observed 'Trademark is essentially adopted to advertise ones product and to make it known to the purchaser. It attempts to portray the nature and if possible the quality of the product and over a period of time the mark may becomes popular.

⁵⁸ 2009(40) PTC 653

consumer to believe that Only anchor has such ingredients namely ‘calcium’, ‘fluoride’ and ‘tricolosan’, hence the defendant was stopped and restrained by the Court to use such words as the reality is that even the plaintiff is using such ingredients in its product i.e. ‘Toothpaste’.

The product with a trademark can speak for itself who it is and also what it can perform. Even when the prospective consumer sees personally or hears of any product, there is ever likelihood that he can become a present or future consumer of that product and in the near future even a loyal patron of it. E.g. suppose if an empty bottle of a soft drink or a perfume or a wrapper of chocolate or potato wafers is fallen on the road or footpath, still it has an advertisement influence as so many people watches the same. Today the concept of advertisement has totally undergone a huge transition and it is no more old and traditional as in today’s era anything and everything what introduces a product and makes it known and famous is coming in the ambit of advertisement.⁵⁹ E.g. Recently the JCB Company⁶⁰ became famous due to some interesting videos got viral due to which JCB India thanked all the people of India.

2.4 NEED AND IMPORTANCE OF TRADEMARK

Trade mark plays a primary role in every one’s life as majority of the people uses goods or services consciously or subconsciously, sometimes we aren’t aware that we use such product in our daily day today life but it is a fact that we remain connected to such product or services and so also the Name or Brand which carries these products are also in our Mind.⁶¹

⁵⁹Hindustan Times, Mangalore : Samiksha Pattanaik, June 22, 2018 , ‘Bride and Groom went home in a JCB and proved they are the *Coollest*’

If you think driving a luxury or vintage car wedding is cool thing to do, the wait till you read this. A bride and groom from Karnataka chose to make their D Day special by going home in a rather unusual vehicle - a JCB earth moving machine. The photos and videos of the same has gone viral.

⁶⁰ibid JCB @JCB machines 28th May, We are humbled by the love shown for JCB in India today, with JCB Ki Khudai trending across the Country! Thank you to our customers and fans for your enthusiasm and support with @JC BindaLtd.

⁶¹ Ananth Padmanabhan’s, *Intellectual Property Rights, Infringement and Remedies* (1st Ed.2012LexisNexis Butterworth’s Wadhwa, Nagpur.)

This is the connection which forms between us and the Goods and services. Hence Role and Importance of Trademark or Service Mark is inevitable in our life. Below are some of the points which spell out the Significance of Trademark.

1) BUILDS REPUTATION

A Genuine trademark or Service mark always helps the manufacturer or the service provider to make a good name for its product which in turn helps him or her to build up the good reputation and goodwill the market nationally as well as internationally.⁶² For any Commercial activity in manufacture and selling of goods or providing service in any economy, trademark truly plays a very important role for creation of demand for goods or services. People have their own preferences and choices depending upon their plans of investing their money in the things they want to buy. The goods they buy or the services which they procure could be Consumer durable products or Industrial goods or services and this demand for purchases which they make is based on the Reputation⁶³ which such goods or services carry with them and obviously this reputation⁶⁴ is the outcome or result of trust and assurance which people have in the Trademark or Service Mark of such goods and services.

In *H&M Hennes & Mauritz AB & Anr v. HM MEGABRANDS Pvt. Ltd & Ors*⁶⁵ the Delhi High Court passed an order of injunction in favour of plaintiff and restrained the defendant HM belonging to plaintiff who is the prior user worldwide.

⁶²Michael Ramos-Lynch, Oct 31st, 2018, 'How a Trademark Protects Your Business': One of the most powerful legal options to protect the reputation of brand and business is trademark. There arise several benefits once the trademark is registered. <https://www.medium.com>

⁶³ VK Ahuja, 'Law Relating To Intellectual Property.(2nd Ed. 2013, LexisNexis, Gurgaon, Haryana.)

⁶⁴ Ashna Pruthi, ' Goodwill and Reputation of Trademark in India-Worldwide Prior use plays Significant Role': While determining the goodwill and reputation of a Foreign mark in India it is not necessary that there should be a shop in India as e-commerce and online shopping has increased the knowledge of International brands in India significantly and the Worldwide Prior use of a trademark will play a significant role in determining the goodwill and reputation of the mark in India. <https://www.lakshmisri.com>

⁶⁵IA No.7259/2016 in CS (COMM) No.707/2016.

2) PURCHASING DECISIONS

The purchasing decision of any person either Individual or organization or other business entity purely depends on their likes and preferences which they have for a specific brand.⁶⁶ Brand is nothing other than trademark or service mark of the products decision.⁶⁷ The higher the demand for any product means the higher value for that product the customers have in terms of reputation and goodwill⁶⁸. A good brand or trademark enjoys highest patronage and loyalty of the consumer in the market because its name carries with it a unique identity due to the relationship it has built with the people and society at large. There is something in the product or service which attracts the people towards it , in a way we can say consumers are totally influenced by some brands and don't mind going out of way or spending more to avail these products . Purchasing, decisions could influence consumer durable products as well as Industrial goods and services. Godrej⁶⁹, Sony, Hyundai, JCB, Reliance JIO, Nokia mobiles etc highly influence the general public and attracts them to buy the same. Trademark influences purchasing decisions not only at National level but also in International trade and Commerce also. Now a day's E-marketing, teleshopping, and other source of Internet marketing and selling on website, face book etc is very popular and plays a vital role in creating demand and influencing customers to buy goods and services online.⁷⁰

⁶⁶Lombard & Geliebter ,'Reasons why Trademarks are Important to your Business': The purchasing decisions of consumers are constantly influenced by trademarks .Trademarks support stronger sales volume, stronger margins and can provide price maintenance legally .It is often difficult to see significant differences among competing products and your brand can be the critical factor in driving the consumer's purchase. <https://www.lgtrademark.com>

⁶⁷ Avtar Singh, *Intellectual Property Law*(1st Ed.2013,Eastern Book Company , Lucknow)

⁶⁸Avinash Shivde, *Intellectual Property Manual*,(Ed.2004,LexisNexis, Butterworth, Elsevier India Pvt. Ltd.)

⁶⁹Abey Francis in Management Case study of 'Godrej By Management; 'Brand that went for makeover to succeed' in 2008 the Rs 9000 crore Godrej Group did something it has never done before, the Co. unveiled the groups Colourful new logo and targeted 30% growth annually and also the purpose of this whole exercise was to make the Godrej brand relevant and contemporary. <https://www.mbaknol.com>

⁷⁰ David I Bainbridge, *Intellectual Property*,(5th E.d. 2002, First Indian Reprint 2003, Pearson Education Ltd. Delhi)

3) EFFECTIVE COMMUNICATION TOOL

Trademark or service mark speaks for itself in the sense looking at any recognized trade mark people or consumer understands what this trademark deals with. So also if any person hears the name of a particular trademark he or she again understands what that particular trademark stands for. In fact a trademark communicates with people and gives information of itself as regards its usage, functions and other characteristics⁷¹. E.g.: Even an empty bottle of Parachute oil or an Empty bottle of Coca-Cola will pass a message to us that its oil and coke respectively. The word Amul at once makes us realize that it is butter. So also the word Crocin tells us that it's a tablet for fever and Vicks is meant for treating cold. Trade Mark in fact is a very effective tool of communication with the people of entire country whether some of them use the product or not, but majority of the people knows, what that particular product or brand deals with for example '555' number tells us that it is a well known brand in Cigarettes even though we might not smoke. So also on the basis of Trademark the Manufacturer or the Service provider can effectively communicate with the people the exact message which he or she intends to disseminate to the public as regards the extra benefit or feature of its goods or services.⁷²

4) MAKES IT EASY FOR CUSTOMERS TO FIND YOU

A Trademark creates a separate identity for the Manufacturer or Service provider by distinguishing his or her goods or services.⁷³ Trademark also helps the general public to find and locate the source and origin of goods and services

⁷¹ Venkateshwaran, *Trademarks and Passing Off*, volume 1, (6th E.d.2015.LexisNexis Gurgaon Haryana.)

⁷² Halsbury's Laws of India, *Intellectual Property*.(2ndEd. 2005LexisNexis, Butterworth's, New Delhi.)

⁷³Omvir Singh 'Is a Trademark Registered in India Valid Worldwide': Trademarks are valid only in the Country where it has been registered and recorded and is not valid worldwide by default .However you can file for registration separately in individual counties which can be expensive or you can submit an application via WIPO or CTM for registration across multiple countries as the International Registration and Management of Trademarks is facilitated by Madrid Agreement or Madrid Protocol which is Administered by WIPO .<https://www.quora.com>, April 6th 2017.

in order to know the product well and then to purchase it.⁷⁴Based on the trademark the purchases takes place , in the sense that people then understands from where to buy the goods or procure a particular service because every trademark or service mark is linked and connected with the manufacturer of goods or service provider as they are the legal proprietors of such marks.⁷⁵ On the basis of trademark the customers interacts with the owner of the trademark and also finds out the required details etc. The Consumers easily locates where the product for purchase is available and then buys them the purchases could be in shops, grocery stores, Malls, weekly markets or it could also be teleshopping or online shopping etc.

5) TRADEMARK CONNECTS WITH PEOPLE ON SOCIAL MEDIA

In the present Internet era people all over the world can get access to products and services through Social Media like face book, whatsapp and other source of Internet.⁷⁶E-Commerce is positively growing very high and there is lot of purchases done by making use of Internet like Flip-kart, Amazon, E-bay, Alibaba, Myntra, So also Zomato, Trivago.in, Agoda.com etc. Now a day's people make most of their purchases online because they find it more convenient because they get the product at their door step and also they find it more economical too because of the special discount offered.⁷⁷There is a market for all types of goods and services i.e. Consumer durables products as well as Industrial products on different Internet sites.⁷⁸So also majority of the

⁷⁴ Up Counsel; 'Purpose Of Trademark: Everything You Need To Know'. Use of notices using ™ and ® or (SM) is another way of giving notice to the public and also cementing your legal protection. <https://www.upcounsel.com>

⁷⁵ Cornish W.R, *Intellectual Property Patent, Copyright, Trademark* (1st Indian Reprint 2001.Universal Law Publishing Co.)

⁷⁶Josh Gerben, July 6 2016, 'Trademark and Social Media :What Small Business Owners Need to Know ' As small business owner there is no doubt that social media sites like Face book may play a big role in your marketing and sales plans but before doing this you have to have your legal ducks in a row . <https://www.score.org>

⁷⁷Pankaj Jain and Pandey Sangeet Rai, *Copyright and Trademark Laws* (1st e.d.2005.Eastern Book Company Pvt. Ltd., Lucknow)

⁷⁸Tara Reedy Silva & Shari Klevens, January 3 .2019, 'Controlling your brand in the Age of Social Media' In a borderless world economy brands simply must utilize social media to remain competitive .Even companies with well known brands use social media as a tool to manage their brands image and engage with customers directly .Social media engagement can be informative by sharing valuable content of the brand .It can also be promotional by offering discount to capture more market share ,

Companies as well as sole proprietorship develops their own websites in their trademark or service mark name, hence for a click of any product or services the entire details are procured as regards the type of product, its quality specification, quantity and other characteristics of the products. This truly become very easy and flexible for the buyers as they can place the orders in time and so also cancel the order within certain time period if they have changed their mind.

6) TRADEMARKS ARE VALUABLE ASSETS

There was a time when people were giving more and more importance only to tangible assets like land , building , mansion , factory premises, office premises, car, motorbike, gold, jewelry etc but now in this present era Intellectual Property which are Intangible in nature are given equal or perhaps many a times more importance than tangible Assets.⁷⁹No doubt that we still protect and preserve our tangible assets by different ways to curtail the trespass by others but we also now heavily guard and safeguard Intellectual properties like Trademark or Service mark by the law of the land.⁸⁰Now all this is done because people have now realized the value of such trademarks or service marks to an extent that they are invaluable or many a times more valuable than tangible assets. As and when the business grows more and more the Trademark too becomes more and more valuable.⁸¹ A good trademark or service mark can be easily licensed to anybody interested in selling or manufacturer the goods or services with which it is associated. So also if any well known or recognized

Social media connection can be Interactive tool for building up relationship with customers .It helps to create goodwill and also to cater customer inquiry. <https://www.ipwatchdog.com>

⁷⁹Veena, *Intellectual Property Legal Framework*, 2007, Amicus Books, the ICAI University Press, Dehradun.

⁸⁰ Gene Quinn, October 18,2008 ; ‘Trademark Create Valuable Assets ‘:Trademarks are not only for those Companies that are trying to dominate the world but Trademark can be a significant asset for any business to have , even small businesses .In order to protect your business and develop valuable assets it is good to apply for a trademark . <https://www.ipwatchdog.com>

⁸¹SME Street News; ‘Intellectual Property :the Invaluable Asset ’Intellectual property is one of the most important assets of many well-known major Companies .However, in India the role and value of Intellectual Property in business is not fully understood yet .Intellectual property protection is the essential public policy considerations of knowledge based industries and Global Markets . <https://www.smestreet.in>May 09, 2019.

trademark or service mark is offered for sale then depending on the goodwill these mark carries, there will be many buyers who will come forward to buy it. There is a lot of investment done by People to protect and register these Trademarks. There are lot of cases , litigation going on in the Trademark Registry , IPAB , and also Courts of law in every Nation , hence there is absolutely no doubt as regards the value or importance of the trademarks or service marks.⁸²

7) PERPETUAL LIFE

The trademark once owned by a proprietor, he or she can enjoy its proprietorship Perpetually.⁸³ In India he or she can Register such trademark or service mark under the trademarks act 1999 and enjoy the exclusive ownership⁸⁴ of such mark in the classification of goods or services in which such mark is registered so also he can enjoy this ownership by timely Renewing the same after every 10 years . So as long as the trademark or service mark after getting registered is renewed at proper renewal period by paying the prescribed fees he or she can perpetually enjoy the Proprietorship in such marks. This is one way of enjoying the perpetual ownership in any trademark or service mark. Even otherwise if the Trademark is not registered or is taking time to get registered the Proprietorship of any mark can be definitely safeguarded under the common law by getting an Passing off action against the Infringer. This is because as a general rule Registration of trademark is not Obligatory or Compulsory. Whoever uses the trademark first is the owner of the mark i.e. whoever is Prior user is having and proprietary right in the Trademark which he or she owns and can always own the same as long as he desires and can also safeguard the same from being infringed by others .

⁸² VK Ahuja, *Law Relating to Intellectual Property*.(2nd Ed. 2013.LexisNexis , Gurgaon, Haryana)

⁸³Markables, July 2014; 'The Useful Life Of Trademarks': Accepted opinion among practitioners has it that trademarks are ageless and perpetual .Legally no restrictions exist as to the limitation of the registration of the trademark over time and its continual renewal. <https://markables.net>

⁸⁴Majmudar & Co. 'Rights of Registered Trademark Owner in India: Are they full Proof? :

It has been frequently debated question in India whether the registration of a trademark confers an absolute right in respect of the trademark to a registered proprietor and if so are there any threats or legal hurdles that can threaten such a right. <https://www.majmudarindia.com>

8) GIVES UNIQUENESS TO BRAND & DISTINCTNESS BENEFIT

One of the important features of trademark is its Distinctiveness which makes it Unique and special and on the basis of such feature the proprietor gets benefited in many ways feature⁸⁵. People buy such products or avail services on the basis of such unique identity of goods and services with a distinct trademark⁸⁶. It becomes difficult for others to imitate distinct product because he will be liable for infringement action or passing off action⁸⁷. This quality of Uniqueness and distinctness always helps to set the Brand or Trade mark apart from the Crowd. The effort which an proprietor puts in maintaining his goods or services under a unique trademark is truly worthy and valuable because he or she has valued consumers who are very loyal patrons of such products for many years due to the trust which they have in these trademarks, like TATA, GODREJ, RELIANCE, BATA etc. To create a reputed and unique identity in a product or service there is lot of Monetary as well as Intellectual investment done by trademark owners and this effort in turn builds up a huge goodwill for his trademarked products due to which he gets recognized in the any society or sometimes in the country or the entire world. A simple four letter word NIKE, 555 three digit number, three letter word BMW, TAJ a three letter word is known by the entire World and that is the power and impact of a Unique Trademark.

9) PROTECTS YOUR PRODUCT NAME

Generally speaking every product when initially launched in the market without fail carries a name or some symbol or sign with it and this name or

⁸⁵ Krishna Kumar, *'Cyber Laws Intellectual Property and E-Commerce Security*. (1st E.d. , 2001. Dominant Publishers and Distributors)

⁸⁶ B.L. Wadehra, *Patents, Trademarks, Copyright, Design & Geographical Indications*. (3rd E.d. 2006 . Universal Law Publishing Co. Pvt. Ltd, Delhi.)

⁸⁷ U.P. Counsel, 'Trademark Distinctness: Everything You Need To know': The more distinctive a trademark is the easier it is to register that trademark. The higher up in the distinctiveness spectrum a trademark is the more protection that it receives. Even when the trademark is a common word it can still be distinctive for a particular good or service. e.g. 'Apple' word was successfully trademarked for computers and related products. 'Apple' word was also trademarked by another Co. for record label. <https://www.upcounsel.com>

some sign of presentation is called its Trademark or Service mark⁸⁸. A product is like a new born baby and the trademark is both, the name of the product and also the Parent of the product and this is so because the product without trademark is like a nameless child, hence for any product introduced in the market its trademark becomes absolutely important because the product gets an identity and recognition in the market by which the general public and the existing and prospective Consumer recognizes it⁸⁹. The trademarks of most of the countries are given protection under their respective laws and legislations⁹⁰. In India also the trademarks and service marks are protected under different laws prevailing in the country like IPC, Custom, and Companies Act etc protection⁹¹. In India the Special governing statutory legislation at present which is in force for the trade mark protection is the Trademarks Act 1999 which is in force at present⁹². In this case the registered trademark is protected by filing an infringement suit against the infringer so also if the trademark is not registered then also he can file a passing off action under the common law and stop the infringer using his or her mark not only for similar goods and services but also for different types of products, hence the passing off action gives a larger scope for the proprietor as far as different types of

⁸⁸ Mary Lafrance, *Understanding Trademark Law* (2nd Ed. LexisNexis, Gurgaon, Haryana.)

⁸⁹S.S. Rana & Co. 'Trademark Rights and Protection in India': The Ownership in India is determined on a first to use basis. The trademark law mandates the first to use rule over the first to file rule. A registered trademark gets statutory protection in India which gives a right to file a suit under the Trademark Act 1999. In case of unregistered prior user of trademark there is a passing off action he can resort to. Even if a mark lacks inherent distinctiveness, it can still be registered if it acquired distinctiveness through use. <https://www.lexology.com>

⁹⁰ Wikipedia; India is governed by Trademark act 1999 and is also protected under common law by resorting to passing off action, United Kingdom's trademark legislation is Trade Marks Act 1994 which implements the European Trademarks directive into National Law, Passing off right of action is also resorted to enforce unregistered trademark rights. United States trademark law is governed by Lanham Act. Common law trademark rights are acquired automatically when business uses name, logo. Australian trade mark law is based on common-law use-based rights as well as the Trademarks Act 1995 <https://www.en.m.wikipedia.org>

⁹¹Jane Haskins, 'Should I Trademark My Name' <https://www.legaljoom.com>

⁹² Venkatesh, February 26, 2017; 'The Benefits Of Brand Name Registration'; Once you have control of that trademark within the classes it is registered. If someone tries to register the same or even a similar name it is very likely to be rejected. If this is not done by registry, you may even do so by filing an opposition during the four months after it is published in the trademark journal. Without registration not only would it be impossible for you to stop these other brands from being registered you would be unable to file an opposition until you apply to register your brand name. <https://www.vakilsearch.com>

product is concerned⁹³. So also there are provisions in IPC as well as Customs act which can stop the infringer from selling similar or deceptively similar products of other proprietor who is prior user in time. This is how a genuine trademark always protects the name of any product. In *Tata Sons Ltd v. Ram Niwas & Ors*⁹⁴ the Delhi High Court reaffirmed that 'TATA' is a Well Known Trademark. The court passed a judgment of injunction against the defendant for infringing the well-known registered trademark of the plaintiff which is in use since 1917.

The major portion of Government revenue is from different types of taxes which are paid by citizens doing business and other commercial activities, so in a way Trademark contributes the large portion of its money earned, to the Government which in turn helps to develop the Nation in terms of growth and standard of living.

10) HELPS THE BUSINESS GROW

A genuine Trademark plays a major role in the growth and development of any businesses if it sincerely serves its purpose by meeting the needs and requirement of the consumers⁹⁵. There are many businesses and startups which started by scratch and then grew up and became billion dollar companies.⁹⁶ E.g. Microsoft, Software Giant was started by Bill Gates a young college drop out in the year 1975 that too in a small Garage along with his friend. In California Larry Page and Sergey Brin took on lease a garage in which they started GOOGLE and in March 1999, Google started becoming bigger in business establishing its office in 2 million square feet in Santa Clara. APPLE too was started in the year 1976 in a garage by Steve Jobs who was 21 years of

⁹³ P.K. Mittal and O.P. Chadha, *Supreme Court on Trade Marks, Copyrights, Patents & Designs* (1950-1999. Om Law Book House, Delhi)

⁹⁴ CS(COM) 1603/2016

⁹⁵ Venkateshwaran, *Trademarks & Passing Off*, (6th Ed. 2015, LexisNexis, Gurgaon Haryana.)

⁹⁶ Abigail Rubinstein, July, 24th, 2014; '7 Reasons Why Trademarks are Important To Your Business. Consumers purchasing decisions are influenced by trademarks and the reputation such brands represent. Trademarks are valuable assets and helps the businesses grow. <https://www.entrepreneur.com>

age and 2 others and the garage was owned by Steve jobs Parents. Dhirubhai Ambani success story in business world is from rags to riches, he is the founder of RELIANCE and in 1992 this Company became the first company in India to raise Money in the International market globally so also this is our first company in India to appear in Forbes list of 500.⁹⁷ Looking at all these great examples of great business entrepreneur there is absolutely no doubt that Trademark obviously has a great role to grow any business from an local level of operation to an International level provide the trademarked goods and services are genuine and the proprietor of such trademarks follow all the required principles of business⁹⁸.

11) GLOBAL ECONOMIC GROWTH

Economic development and growth of any Nation always depends mainly on the Industrial and business activity that country undertakes as there is always an inverse relationship between both⁹⁹. No matter what business or commercial activity the countries citizen undertakes but there is always a name for that business and so also there is name for the goods and services which they manufacture¹⁰⁰. Name is nothing but Trademark or Service mark of that particular business or its product¹⁰¹. So trademark plays a vital role in increasing the business activity by creating demand for its products and also plays a vital role in increasing any Nations GDP (Gross Domestic product). This demand creation is not only nationally, it is internationally too. Domestic buying and selling as well as import and export at an International level contribute to the growth and development of not only a nation but also of the

⁹⁷My Online; 'Indian Entrepreneur Who Started with Nothing', Dhuru Bhai Ambani Owner of largest Pvt. Corporate sector created an equity cult in the Indian Capital Market .Dhirubhai rewrote the history of Indian Corporate sector. <https://www.myonlineco.in> 1-06-2015

⁹⁸ N.S. Gopalakrishna& T.G. Agitha, *Principles Of Intellectual Property*. (1st Ed.2009. Eastern Book House, Lucknow.)

⁹⁹ Prof. William O Hennessey, 'The Role of Trademarks in Economic Development and Competitiveness', Franklin Pierce Law Center. Trademark protection functions most powerfully in growth- oriented societies in which the autonomous consumers have the capacity to make conscious or subconscious choices over how they conduct their daily lives. <https://www.ipmall.info>

¹⁰⁰Dr Raghbir Singh, *Law Relating To Intellectual Property*.(2nd Ed. Universal Law Publishing Co. Delhi)

¹⁰¹ By Franklin Pierce Law Center, Professor William O Hennessey; The Role of Trademark in Economic Development And Competitiveness. <https://www.ipmall.info>

world at large. India ranks 77th in World Banks Doing business Report.¹⁰² Since India being signatory to TRIPS Agreement and since India follows Madrid protocol and other trademarks related International agreements and protocol, India's trade and commerce has grown up Internationally to a large extent.

12) CONFIDENT PURCHASING DECISION

One of the most important factor in the sale of any product is the confidence of the buyer in the product. This confidence arises from the trust and reliability which the consumer has in any trademarked or service marked goods or services respectively. When the buyer is very much confident of the product then he is quick enough to arrive at his or her decision to purchase the same¹⁰³. Any Trademark which is famous or well known for its name travels a long journey¹⁰⁴. Such well known products maintain its image and reputation in order to create this type of trust and confidence in the people¹⁰⁵. This unique trademark is also safeguarded from wrong people like infringers etc under the different legislation of the countries and this is because these reputed trademarks shoulders the trust of its consumers and public at large¹⁰⁶. Mostly the consumers are confident in the purchase because they feel safe and guaranteed while buying such trademarked products as compared to the other substandard goods or services. e.g. ; Raymond's, Tata motors, Bajaj, Taj hotels, Nike, Mercedes etc these are some of the brands which are known for their commitment and service for years and as a result they have managed to win the Confidence and trust of people Nationally as well as Internationally . Commercial activities op rates at a very high level in the country on the basis

¹⁰²Press Information Bureau; Government of India, Ministry Of Commerce & Industry. The World Bank released its latest doing business Report (DBR,2019) in New Delhi today, 31st October2018. India has recorded a jump of 23 positions against its rank of 100 in 2017 to be placed now at 77th rank among 190 Countries assessed by the World Bank. India's leap of 23 rank in the ease of doing business ranking is significant considering that India had last year improved its rank by 30 places , a rare feat for any large and diverse Country of size of India. India has improved its rank by 53 positions in the last two years. <https://pib.nic.in/newsite/print>

¹⁰³Mark P. Mc Kenna, 'A Consumer Decision Making Theory of Trademark Law': The decision of consumer to purchase any goods or services is highly influenced by the Brand Value and reputation a Brand name holds. www.virginialawreview.org

¹⁰⁴Monalisa , ' What are the Advantages of Trademark Registration '<https://vakilsearch.com>

¹⁰⁵Kailasam & Vedaraman, *Law Of Trademarks*, (3rd E.d.2013, LexisNexis, Gurgaon, Haryana)

¹⁰⁶ Ibid

of Powerful Industrial base and capacity and in all this development process a trademark or service mark plays a very vital role. Many Indian Companies with their efforts and reputation has been highly successful in winning the trust and confidence of the people residing in India and abroad in buying India's goods and services, which are consumer durables as well as industrial goods and services.

13) ENCOURAGE HEALTHY COMPETITION

Competition when it is healthy and genuine, it becomes an blessing to the consumer and society at large. Healthy Competition of a genuine trademark benefits the Consumers in terms of health and safety¹⁰⁷. If the consumers are unsatisfied with the quality standard or the defect in the goods purchased or if the consumers' finds deficiency in the services and in this way their rights are violated such consumers can file a case in Consumer Court under the Consumer Protection Act 1986.¹⁰⁸ The trademark proprietors should take utmost care and quality control to maintain the trust and loyalty of their patrons¹⁰⁹. Genuine trademark proprietor makes sure that their customers are satisfied with their products in an utmost manner, for e.g. when a product is ISO Standard etc, consumers' health and safety is obviously assured¹¹⁰.By maintain the quality standards, the trademark proprietor wins goodwill and

¹⁰⁷ The New York Times, By Megan M Carpenter, Trademark Law Promotes Fair Competition, Not Morality. It is not the preview of trademark law to dictate morality no matter how appealing or distasteful a mark may be. The purpose of trademark law is to promote fair competition by preventing consumer confusion and deception in the market place. Trademark law should evolve as other forms of intellectual property have done. Patents were once unavailable for gambling machines. Copyright was once unavailable for salacious material. <https://www.nytimes.in>

¹⁰⁸ Dr Shaber. G. Ali, *Functioning Of Consumer Dispute Redressal Agencies in the State Of GOA: A Socio Legal Study With Special Reference to Services*. (Goa University, April 2010. P.6, 7 and 205) 'Indian Law and Minimum Standards'; 'There is no separate Legislation in India that governs standard of service provided by the various service providers. Services provided by Housing and Insurance sector generally mentions the standard of services in the agreement/contract made between the party and such service providers'.

¹⁰⁹ Krishna Kumar, *Cyber Laws, Intellectual Property and E-Commerce*, (1st E.d.2001, Dominant Publisher and Distributors. New Delhi.)

¹¹⁰ Supra 93, ISO standards prescribe International Consensus of good management practice, while delivering products and services. BIS is a founder member of ISO and represents India in ISO.

reputation of the consumers for his brands and the proprietor mostly does by investing in Research and Development of his products or services¹¹¹.

So also when a certain trademark owner maintains proper quantity and sometimes as an offer gives 5% or 10 % free quantity on the purchase of his goods and this is how his offer is better than his Rival and in this bargain the consumers are always benefited in terms of the extra quantity he or she gets. So also Service sector too maintains the standard and class of their services by maintaining the reputation and goodwill of their Service Mark. The Service mark proprietor also offers discount and some free services too to allure the customers towards its business. Hence in this way there is a very healthy competition in the market which off course benefits the consumers but it also creates a scope for the trademark or service mark proprietor to develop their product or services by constant research and up-gradation for benefit of consumer n society at large¹¹². In India the genuine trademarks of good products with the mode of advertisement and healthy competition is truly contributing the consumers and society in number of beneficial ways.

14) COMMERCIALISATION AND GROWTH OF COMMERCE & INDUSTRY

This is one of the biggest contributions a trademark or service mark can do within any economy of the world as these mars are connected with these goods and services¹¹³. When there is more and more production activities undertaken in the society due to the growing demand, the consumption for the same is more which helps the GDP of any Nation to rise.¹¹⁴ The rising sales turnover in

¹¹¹Lall, Sanjaya ,*Indicators Of the Relative Importance of IPR in the Developing Countries* ‘ ICTSD Series, Intellectual Property Rights & Sustainable Development Series ,2002 .

¹¹² Ananth Padmanabhan’s, *Intellectual Property Rights, Infringement and Remedies*,(1st E.d. 2012 LexisNexis, Butterworth's Wadhwa, Nagpur.)

¹¹³Kaushik Laik, *Role Of Intellectual Property in Economic Growth*, CSIR Journal Of Intellectual Property Rights, Vol 10,November 2005 ,pp465-473 .<https://www.niscar.res.in>

¹¹⁴Rishi Ram Chapagai , *Economic Perspective Of Trademarks*, Saptagandaki Journal ; Economists believe and explain that Trademarks plays a valuable macroeconomic function to identify the origin of the products, services and technologies .Trademarks play an important strategic role in business enterprises for the promotion of sales of product and service in the market .Trademarks enables firms to

turn helps the profits of the Business entity to rise which again contributes to the Exchequer through different source of Government Taxation and levies. The Government again utilizes these capitals to provide better Infrastructure and essential Services and amenities for the smooth functioning of the Economy. Proper connectivity of Roads, Airports, Schools, Public utilities, Public transportation, Industrial Estates, loans through EDC (Economic Development Corporation) etc. All these factors in turn help the economical growth of Commerce and Industry. The more developed a Nation means the higher the development of Industry and commerce of any Country and vice versa is also true¹¹⁵. In India there been a tremendous growth in trade, commerce and industries and it goes without saying that the major credit obviously goes to the Trademarks of these goods and services manufactured by the trademark proprietors in India.

15) REPEAT ORDERS

One of the most important thing in any business dealing is that there must be customer repeating their buying. The more they repeat to purchase the more sale takes place and hence the profit of the business grows higher and higher¹¹⁶. A good and genuine trademark or service mark plays an important role in creating more and more demand for any goods or services on the basis of its quality , quantity, Value, pricing , incentives etc¹¹⁷. A good Trademark always

increase profitability , respond to unfair competition, grow and retain market share, introduce new product and service lines ,earn income through royalties of licensing and franchising .Most of the Global Companies such as KFC , *Coca Cola*, Mc Donald's , General Motors are using franchising business model to use their trademark strategically all over the World . <https://www.nepjol.info>

¹¹⁵ WIPO Magazine; 'Trademarks; Valuable Asset In A Changing World' ;Extremely valuable Assets even in the tough economic times, trademarks strongly influence purchasing behavior as consumers make more careful decisions, often reverting to tried and trusted brands . <https://www.wipo.int> July, 2009

¹¹⁶ WIPO Magazine; 'The Role Of Trademarks in Marketing' ; Every business must woo customers to move them quickly from brand awareness via brand recognition to brand preference and finally brand insistence a point where the consumer refuses to accept alternatives and is willing to pay an even higher premium for the desired branded product . Peter Drucker a well known management Guru said that a 'business enterprise has two basic functions: marketing and innovations .These two basic functions guide the underlying desire of a business to make a monetary profit in the process of providing quality product and services to the customers . Intellectual property primarily trademark plays a important role in marketing and innovation function in any business enterprise. <https://www.wipo.int> February 2002.

¹¹⁷ Rama Sarma , *Intellectual Property laws*,(Ed.2009LexisNexis – Butterworth Wadhwa, Nagpur)

has a capacity to fulfill customer needs and likings and hence there is always an element of customer satisfaction in the society at large. Trademark helps to build demand for Goods and Services Generally speaking all trademarks or service marks are same i.e.; they are either word mark or sign or symbol or some type of representation in some form, what really makes a difference in such marks is, what Value they carry with them and this value addition to these marks by the proprietor of the marks truly makes the difference and this value creates the demand for repeat of the purchase orders by the people in the society. Colgate , Gillette , Coca Cola , Parker pens, Taj Hotels , BMW , Jet airways , Thomas cook, SBI , LIC , IIT Institute , Flip kart , Amazon are some of the product with a very high customer base buying¹¹⁸. This customer base for these trademarks or service marks is the result of repeated orders by the consumers of these products and hence a repeat order is the life line of any business and a valuable and appreciated trademark or service mark helps to build up this value addition of the product.¹¹⁹ Many of the goods and services having genuine trademarks are purchased by people of India on a regular basis which ultimately helps the proprietors of these trademarks to enjoy the benefit of repeat orders.

16) PREVENTION OF UNFAIR TRADE PRACTICES AND PROTECTION OF CONSUMERS

A trademark or service mark of any genuine proprietor always carries with it a positive reputation since such trademark always maintains all the quality standards required and hence the health and safety of the consumer is assured¹²⁰. People can always exercise their choice while buying goods or services having a known and reputed trademark and prevent buying

¹¹⁸Dr Myneni S. R. *Law Of Intellectual Property*, (1st E.d., 2001. Asia Book House Hyderabad.)

¹¹⁹ G.B. Reddy, *Intellectual Property Rights and the Law*.(1stE.d.2000. Gogia Law Agency Hyderabad.)

¹²⁰Tyler M Hampy, Nov, 29th, 2012 ,‘Unfair Competition : How does it relate trademark infringement’: In trademark law unfair trade practices are commonly found when one imitates or counterfeits the name ,size, colour scheme, pattern or other distinctive particularities of another’s good or service or when one imitates the shape , color, label, wrapper or general appearance of another product’s package in order to mislead the general public or deceive an innocent purchaser . <https://www.legalteamusa.net>

substandard products in the market known by their specific names¹²¹. Even Government Authorities like Ministry Of Health, FDA, FSSAI,¹²²BIS,¹²³Police Department, Municipal Corporation,¹²⁴etc can easily crack down Unfair trade practices of unscrupulous people on the basis of the name of their product or their name of business under which they operate whether it is duplication of the products or imitation, it can be easily curtailed and stopped on the basis of trademark. So also there always remains an accountability of the genuine trademark owner towards the people and consumers at large as regards the goods or services in which he deals with, hence he makes every effort to maintain all the required parameters as regards the quality, quantity etc of his products imitation¹²⁵. A good trademark always help in Consumer Protection objectives. This is so because a genuine trademark follows all the standards and principles of business and hence the safety and health of consumers is assured and can be trusted. So also a trademark or service mark helps its proprietor or owner to very well establish his or her accountability towards their consumers and society at large. Without the help of trademark it would be next to impossible to exercise control and enforcement over such an Unfair Trade Practices and there would rather be a chaos and confusion in the market which in turn would have an adverse effect on health and life of people¹²⁶. In India the reputed and quality products with genuine trademarks have always helped

¹²¹Will Kenton, 'Unfair Trade Practice'; Unfair Trade Practice refers to the use of various deceptive, fraudulent or unethical methods to obtain business .Unfair trade practices include misrepresentation, false advertising or representation of goods or service etc . <https://www.investopedia.com> March, 14th, 2019.

¹²² FSSAI (Food Safety and Standard Authority Of India) passed a order dated on 1st February, 2019 and directed FBOs to mention 'Whole Wheat Flour (Atta)' on the packaging labels wherever the same is used as singly or s ingredient in food items. <https://www.fssai.gov.in>

¹²³ BIS(Bureau Of Indian Standards); 'BIS,' is the National Standard Body of India working under Ministry Of Consumer Affairs ,Food& Public Distribution, Government Of India . BIS hallmark is a hallmarking system for gold as well as silver sold in India certifying the purity of metal. <https://www.bis.gov.in>

¹²⁴ 'Roles And Functions Municipality/Nagar Palika'; Obligatory function of Municipality is Regulation of offensive, dangerous or obnoxious trades and callings or practices. <https://www.archive.india.gov.in>

¹²⁵ D P Mittal, *Law Relating to Copyright, Patent & Trademark and GATT*,(M K Bhargawa for Taxman Allied Services ,New Delhi)

¹²⁶ V K Ahuja, *Law Relating To Intellectual Property Rights*. (3rd Ed. 2017, LexisNexis, Gurgaon, Haryana.)

to prevent unfair trade practices as well as protect the health of the people all over India.

17) QUALITY PRODUCTS

We can always expect a Quality from genuine goods and services originating from or belonging to a genuine trademark owner¹²⁷. A reputed proprietor takes responsibility to deliver goods and services of good quality as such proprietor may be sole proprietor or a company has earned a goodwill and reputation with hard work and efforts¹²⁸. E.g. When we buy a Almirah of ‘Godrej’ we remain assured about its quality, if we want to buy Compass the first name strike in our mind is ‘Camlin’, we have trust in all the product line of ‘TATA’ Co¹²⁹. Right from its salt and tea to Vehicles and five star hotels because of the quality TATA has maintained of all their products over so many decades¹³⁰. When all these genuine trademark company provides us with good quality products our life is at safe because obviously such products add value to our society at large¹³¹. In *Cadbury India Ltd. And Ors v. Neeraj Food Products*¹³² The plaintiff brought an injunction against the defendant for phonetically infringing the plaintiffs registered trademark Gems by making use of the words ‘James Bond’ on the chocolate products and also for imitating plaintiffs pillow pack in size, shape and get up and infringing the copyrights of plaintiff by imitating the artistic work in the pillow pack. In India there are many goods

¹²⁷ Raman Mittal, ‘*Licensing Intellectual Property Law & Management*’, (1st E.d. 2011, Satyam Law International, New Delhi),

¹²⁸ Up Counsel; ‘Trademark Quality Control: Everything you need to know’; Trademark quality control is an important part of maintaining the value of your trademark. If you are interested in licensing you want to be sure that whoever is using your trademark won't damage the marks value through their use. Quality control protects the trademark owner's reputation by following minimum quality standards which must be met by him or the licensee. Standards that consumers rely on in making their purchasing decisions. <https://www.upcounsel.com>

¹²⁹ Economic Times; Tata Motors move to court against trademark infringement. Tata motors has filed a complaint before Delhi High Court alleging infringement of its trademark and copyright unknown persons manufacturing and marketing spurious ancillary automobile products under its name. <https://www.economictimes.com>

¹³⁰ Sify Finance News; Tata's Top 10 listed Companies, FY 2010 (Tata steel, Tata motors, Tata consultancy, Tata power, Tata Communications, Tata Chemicals, Tata Global Beverages, Titan, Indian Hotels, Tele Services) <https://www.sify.com>

¹³¹ Rodney D Ryder, *Intellectual Property and the Internet* (E.d.2002 LexisNexis, Gurgaon, Haryana, Reed Elsevier Pvt. Ltd.)

¹³² 142(2007)(2)269, 2007(35)PTC95Del.

and services having high level quality with a reputed trademark of genuine trademark proprietor.

18) KNOWLEDGE AND EDUCATION CONCERNING PRODUCTS

A good product always educates its customers and consumers or the general public as to its features, benefits and other necessary things which such goods or services carry with them.¹³³ Trademark creates awareness by imparting proper knowledge as regards the availability of different goods and services in the market with their specific trademarks or service marks¹³⁴. Some of the products required are of essential and necessary nature and which is of utmost need and importance to the mankind so a product of such nature is easily located on the basis of its trademark or service mark¹³⁵. So also a customer is always in a position to make wise purchase since he or she is already having knowledge of their want based on the trademark. There is a saying that Action speaks more than words and it is very true in case of a genuine trademark which truly speaks for itself without words but with the action it carries with it. E.g.; Harley Davidson, Reliance and the like tells the world what they are known for. All this is true and possible because these trademarked brands have been successful for last so many decades in educating and giving right knowledge to all the people who they really are and what they are capable of providing and this Educative factor has made them stand where they are standing¹³⁶. In India there has been development in communication and information technology which helps the trademark proprietors to provide

¹³³ Iyenger's, *The Trademarks Act*, (4th Ed. 2011 Universal Law Publishing Co. New Delhi.)

¹³⁴ Mark Quin, Leggett & Platt, 'Teach Customers Why they need a Product before trying to sell it to them', In a world of nonstop marketing ploys, what your customers really want is some insight. There's a big difference between marketing to your customer and educating them. What's relevant to the consumer, however, isn't what the company values about its own product, but what the product can do to solve the consumer's problem. The smart consumer will opt to buy from the company that has educated him on the issue and presented him with multiple solutions. That company's selflessness has built trust and its ability to teach has bought the consumer's loyalty in the future. <https://www.businessinsider.com> May 1st 2005, 10:16 a.m.

¹³⁵ Supra (Note: 116)

¹³⁶ T.R. Ramappa, *Intellectual Property Rights Law In India*, (1st Ed. 2010. Asia Law House, Hyderabad.)

knowledge of the products to the consumers and people at large by educating them through different medias.

19) ADVERTISING SERVES A LINK

Whenever a product has an identity in the form of name or some symbol or sign by way of Trade or Service Mark and such a product is advertised under different advertising medias, it truly forms a link between the manufacture or the service provider and the consumer and all the people viewing such advertised brands. The link so created extends not only at National level but also at Global level.¹³⁷ The possibility of taking a positive benefit of advertising is possible only on the basis of Trademark or Service mark.¹³⁸ Without a trademark it would have been truly next to impossible to share the business information and innovative ideas to the people at large¹³⁹.

Trademark when advertised through different Medias forms a linkage and gets connected to all the Government Authorities due to the accountability which the proprietor of such trademark has towards them while dealing with their products and services taking into consideration the different parameters and quality standards which by rule or obligation they have to adhere to. for e.g.; The FDA and FSSAI departments of Government makes sure that there is no adulteration in the food products etc, so also BIS is an Indian Standard which is applying ISI mark for different product like Packaged Drinking Water, Cement industries etc and this mark has to be obtained by the trademarked products by following their standards and different parameters then only someone can avail

¹³⁷ Adv. Khoj; ‘ Functions Of Trademark’ ; The trademark, advertises the product representing it through different medium of advertisement and helps to create and build the image and identity of the product and its quality in the mind of the public particularly the consumers or the prospective consumers of such goods and services. <https://www.advocatekhoj.com> Law Library.

¹³⁸ Narayan P, *Law of Trademarks (Trade Marks Act 1999)and Passing Off.* (5th E.d.2000., Eastern Book House, New Delhi.)

¹³⁹ Jsander, Marketing &Trademarks: Trademarks are at core of brand and marketing efforts .Marketing is generally the act of promoting and selling products or services. Trademarks typically play a dominant role in marketing and advertising efforts. <https://www.sanderlaw.ca> 16th Feb 2019

these marks. In *Reckitt & Colman of India Ltd. v. Kiwi T.T.K. Ltd*¹⁴⁰, Hon'ble Delhi High Court (S.K. Mahajan, J.) held that “a manufacturer is entitled to make some statement that his goods are the best and also make some statements for puffing of his goods and same will not give a cause of action to other traders or manufacturers of similar goods to institute proceedings as there is no disparagement or defamation to the goods of the manufacturer so doing. However a manufacturer is not entitled to say that his competitors' goods are bad so as to puff and promote his goods”.

This is how the well being of the people as regards their health and life is assured due the link which is formed through advertising and publicity carried on by the trademark proprietor by investing a considerable sum of money. In India there has been a tremendous growth in the field of mass communication and advertisement and publicity of good trademarked products and trademark has played a very important role in advertising the products in India.

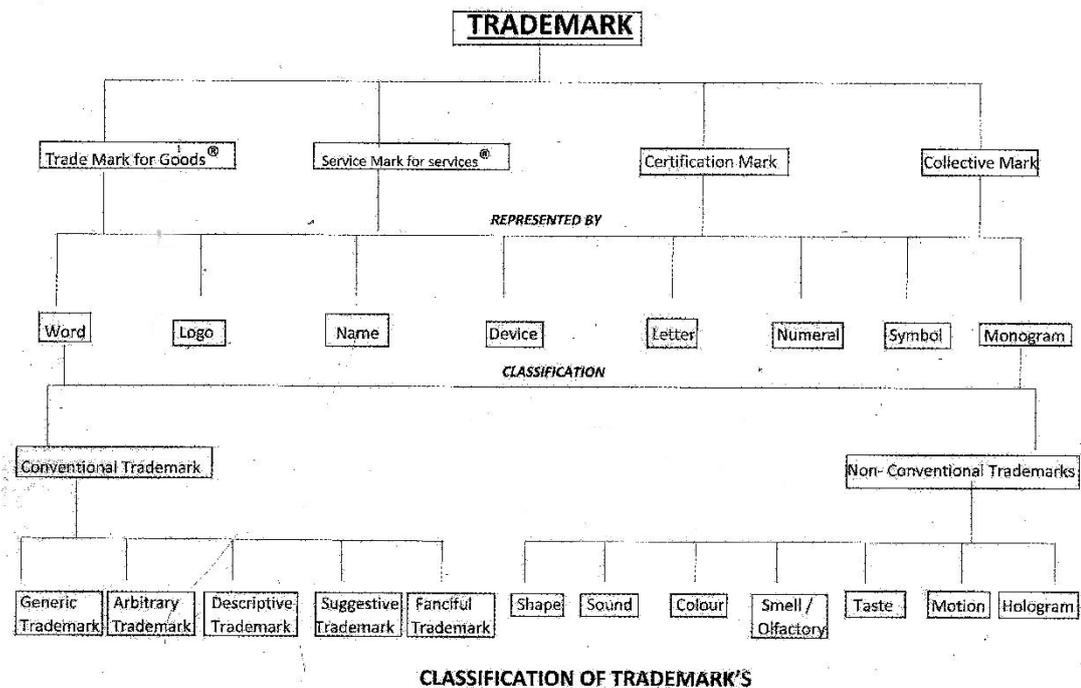
Now having covered the need and importance of the trademark in the life of the consumers and public at large and also in the life of the manufacturer or service provider, let us now see the different classifications and types of trademarks/ service marks.

¹⁴⁰ [63(1996)DLT29,1996(37)DRJ649(1996)114PLR45] also see *Reckitt & Colman of India Ltd. v. Ramachandran & Anr* [CS No.31 In The High Court] (Hon'ble Calcutta High Court (Barin Ghosh J.) laid down five principles for granting an injunction in case of comparative advertising :

1. A tradesman is entitled to declare his goods to be best in the world even though the declaration is untrue,
2. He can also say that his goods are better than his competitors, even though such statement is untrue.
3. For the purpose of saying that his goods are better than his competitors he can even compare the advantages of his goods over the goods of others,
4. He however cannot while saying that his goods are better than his competitors say that his competitor's goods are bad .If he says so, he really slanders the goods of his competitors and their goods which is not permissible,
- 5.If there is no defamation to the goods or to the manufacturer of such goods no action lies, but if there is such defamation an action lies and if an action lies for recovery of damages for defamation, then the court is also competent to grant an order of injunction restraining repetition of such defamation .

2.5 CLASSIFICATION/TYPES OF TRADEMARKS

Generally from legal perspectives, trademark/service mark, can be classified as registered or unregistered, while characteristically speaking their classification can be exhaustive in nature taking different forms and dimensions, right from conventional to un-conventional types and many a time beyond imagination.



Below is the Classification of the different trademarks based on their nature and functionary attributes to it¹⁴¹.

a) Trademark in reference to goods:

Actually the term trademark is used while referring to Goods but practically in day today usage the term trademark is used even while referring to services. For unregistered trademark TM sign is mentioned and for Registered trademark ® is mentioned.

¹⁴¹ J.P. Mishra , *An Introduction to Intellectual Property rights*, (central law publishing, Delhi, 2012)

b) Service Mark in reference to services:

Service Mark is used to refer to services but as mentioned earlier even for services the term trademark is used. In case of Un-registered service mark, (SM) sign is used and in case of registered service mark ® sign is used.

c) Certification Trade Mark:

Section 69 to section 79 speaks about Certification Trademark which is issued by BIS¹⁴². A “Certification trade mark is a mark which distinguishes the goods and services for which it is used while conducting the trade and is certified by the proprietor of the mark as regards the material, quality accuracy, characteristics, origin, mode of manufacture of goods or providing or rendering of services from goods or services not so certified¹⁴³. A Certification Mark is more like Conformity mark and assures the compliance of the Manufacturer with the quality standards and regulations followed by them. Unlike Collective mark the Certification mark can be used by any person who is desirous of using it¹⁴⁴. Any person desirous of making application for registration of Certification trade mark according to section 71(1) has to make the same to the Registrar in form TM-68 or form TM-69 and the draft regulations has to be submitted along with the application along with TM-49. In Indian market there is large number of certification marked product owned by the proprietors from India.

¹⁴² India Today; ‘Different Certification Marks in India and their Meaning’, Certification marks on a commercial product are usually called as a mark of validity or an assurance of the fact that the manufacturer has tested the product and that it meets the given quality standard. E.g. FPO, ISI, Government Of India Stamp. BIS (Bureau Of Indian Standards) Governs all industrial product Certifications in India. It is thus a National Standard organization of India. 1) ISI Mark, 2) AGMARK, 3) FPO, 4) BIS Hallmark, 5) The Non-Polluting Vehicle Mark, 6) Indian Organic Certification. <https://www.indiatoday.in> November 2nd 2018,

¹⁴³ India Today; New Delhi: “Now you have to show proper proof to call your product ‘Organic’ ” : FSSAI. Now organic food will have to comply with food regulator, FSSAI’s draft regulation, to be certified as organic produce. In a bid to ensure that the products that claim to be organic are actually organic, the food regulator, FSSAI, has come out with a draft regulation for organic food products. Organic Foods will have to comply under the National Programme for organic Production (NPOP) administered by the Government or the Participatory Guarantee system for India (PGS-India) run by the agriculture Ministry or any other Standards notified by the food Authority. <https://www.Indiatoday.com> June 27th, 2017.

¹⁴⁴ Dr G.B. Reddy, *Intellectual Property Rights and Law*, Reprint E.d. 2013. Gogia Law Publication Hyderabad.

Examples of certification Trademarks

- a. Wool Mark Company is the owner of 'Wool mark' trademark which is a Certified trademark and this mark assures quality of any person using it on its product that it is of pure woolen.
- b. ISI mark in India is used for assuring Indian standards as regards products.
- c. The 'Asthma and Allergic Friendly Mark' is an International mark which gives assurance to people about the tested products standards which they use.
- d. For agricultural products in India, 'AGMARK' mark is used.
- e. Eco-mark issued by BIS on the product to conform to standards which certify that these products have least impact on environment.

It was held by the court in *Tea Board India v. ITC Ltd*¹⁴⁵ that using 'Darjeeling' which is the 'Certification mark' and 'GI' of the plaintiff amounted to infringement and passing off by the defendant.

d) COLLECTIVE TRADEMARKS

Section 61 (2)g of the Indian trademarks act 1999 defines 'Collective Trademark', A collective trademark¹⁴⁶ is a mark which is owned by many members collectively and this association collectively becomes this Trademark¹⁴⁷, proprietor and such a mark is distinct from the goods and services of others. The organization which registers itself as collective mark should be competent to certify the products of the association. The Collective mark does not sell goods or does not provide services but it helps its members

¹⁴⁵G.A. No.1631 of 2011; A.P.O.T. No.245 of 2011; C.S. No. 250 of 2010.

¹⁴⁶ T.R. Srinivasa Iyengar's, *The Trademarks Act*, (4th E. d. 2011, Universal Law Publishing Co. New Delhi.)

¹⁴⁷ Law Desk India, Legal Resource; 'Collective and Certification Trademark – Perspective of Indian Trademark Laws'.

Article 7 of Paris Convention for protection of Industrial Property deals with the collective marks. It was obligatory for the countries under convention to enact laws for the protection of collective trademarks belonging to association. India itself being the member of the above mentioned convention has incorporated provisions for protection of collective trademarks of associations. Section 61 of the Indian trademarks act 1999 defines collective mark in India. <https://www.hg.org>

to do so by promoting and advertising their product or services. The Members uses the Collective Mark on their product to distinguish their products from others. It has to be noted here that Partnership firm is not coming within the definition of collective trademark. The pre-condition for registering such a mark is that it should not be misleading or should not be registered¹⁴⁸ in any mala-fide intention deceiving the public by giving them an impression that it is something more than collective mark and in such situation the Registrar is at liberty to correct the same or refuse the application all together. While applying for such an mark the association should also submit the regulations as regards the usage of such mark and also the conditions of the use should be expressly mentioned and who are the members who will be using the same. The application once applied will be inspected by the Registry and if the registrar is satisfied and is assured that the requirements has been met may accept the same or if he is not satisfied then he may refuse the application. Once the application is accepted it will be kept open for the public to view the same. The collective trademark collective mark¹⁴⁹ belongs to a group rather than a single person. Form TM -3 is used along with prescribed fees to file collective trademark and to apply for more than one class form TM – 66 is used. In Indian market there are large number Collective trademarked goods and services which are used and consumed by many people from India as well as other parts of the world.

- a) The Institute of chartered Accountants uses the symbol ‘CA’
- b) The Certified Public Accountants uses the mark ‘CPA’
- c) The ‘Melinda’ which is a collective mark is used by members producing Apples.
- d) ‘Turkey the Perfect Protein’ used by National turkey Federation.

¹⁴⁸ Venkateshwaran, *Trademark and Passing Off*(7th E.d. 2018, LexisNexis, Gurgaon Haryana.)

¹⁴⁹ Prachi Gupta, Manupatra; ‘Collective Trademarks; a Overview’; “Collective Trade Marks come in play when products which may have certain characteristics specific to the producers in a given region, linked to the historical, cultural, social conditions of the area . The peculiarity of collective marks is their ownership structure .to qualify as a collective membership mark, the mark must be in general use b members of the collective for the purpose of indicating membership.” <https://www.docs.manupatra.in>

Before going through further, in depth classification of trademarks of this modern 21st Century era, let us go through the different forms of trademarks/service marks which the people all over the world has been universally and commonly referring them in day to day normal parlance and which we can say are the basic trademarks which is known by every person irrespective of their age, education, social and economic conditions. This is the trademark's form which are contained and mentioned in the definition of the Trademarks Act. They are simple in nature and can be understood easily

2.5.1 Forms of Trade Marks/ Service Marks in day today usage:

The different forms of trademarks day to day universally used are 'WORD mark'¹⁵⁰ e.g.: 'Tata', 'LOGO'¹⁵¹, 'NAME' e.g.: 'Mahindra', 'DEVICE'¹⁵², e.g. 'Reebok', 'LETTER'¹⁵³ e.g. 'Mac Donald's M', 'NUMERAL'¹⁵⁴ e.g. '555', 'SYMBOL'¹⁵⁵, 'MONOGRAM'¹⁵⁶ e.g. 'LV(Lui Vuitton) and Like more

¹⁵⁰Lexstart, 'Word Mark' A word mark registers the word a person would want to use and renders stronger and wider protection to that person's business. Once registration is granted for a word trademark, the applicant has the right to use and represent the word in any format or font which grants it extensive protection including exclusive rights to the word as a whole and also allows the applicant to depict it in various formats regardless of its style for all the goods and services in respect of the mark. In other words, by filing a word mark, one would prevent third parties from using one's brand name in any regard. <https://www.lexstart.in>

¹⁵¹ Ibid, 'Logo'/ 'Composite Mark', A logo or a composite mark gives a person the rights in the combination of images, design and words taken together. Therefore, the protection given to the words encompassed in the logo are limited. The rights in the logo are entitled only to the logo as a whole. If one wishes to register a particular stylized appearance or a combination of stylized wording, orientation, shape, colour and design, filing a trademark as a logo would be appropriate. Ideally, separate trademark applications for word as well as logo should be filled to attain the broadest protection for any business. Whether your brand is a word or logo or combination of both, it should be unique or distinctive.

¹⁵²*Reebok International Ltd. v. Sanjay Oberoi & Ors* [05(SE) Saket Court, New Delhi] The Court ordered 'Ex-parte Permanent Injunction' along with 'Compensatory and Punitive damages' against the defendant for infringing the Plaintiff's registered, trademark, label as well as the device, Reebok <https://www.indiankanoon.org>

¹⁵³ Ajay & Amitabh Suman, 'Letter Trademark' There may be cases where the Trade Marks is essentially of letters. There may be cases where Trade Mark is comprised of Single Letter. The letter Trade Mark comprised of single letter and descriptive to the trade are considered as poor trade mark and strong evidence of user required to establish the trade mark right. While the Trade Marks, comprised of more than one letter and not descriptive are considered to be relatively stronger trademarks. In case the letter Trade Mark is comprised of unique device also, it gives strong protection to Trade Mark. <https://www.lawyersclubindia.com>

¹⁵⁴ S. S. Rana, 'Numeral Trademark', The definition of a 'mark' under Trademarks Act, 1999 includes a numeral as trademark. The general criteria required to register a number or numeral is the same i.e. Distinctiveness. <https://www.ssrana.in>

In *Mona Aggarwal & Anr v. Glossy Colour & Paints Pvt. Ltd*¹⁵⁷, Glossy paints who is the respondent is the proprietor of '1001' a numeral trademark since 1946 and the appellant started using '6004' trademark from the year 2011. Delhi High Court's, single bench judge granted injunction against the appellant because the mark was deceptively similar due to the scheme of colour and other features of the mark. The appellant appealed to division bench of Delhi High Court who directed them to the Court's mediation and conciliation centre in which the appellant came to an agreement to withdraw the trademark registration application for '10011' which was opposed by the respondent in the registry earlier.

In *MRF Ltd. v. NRF (NR Faridabad Rubbers)*¹⁵⁸ the High Court observed and held the defendants mark 'NRF' is phonetically same as that of Plaintiff's mark 'MRF' and hence can confuse the consumers. The Court held that the defendants mark is infringement of the plaintiff's trademark 'MRF'.

Now let us discuss each category of conventional as well as Non-conventional trademarks in detail.

2.5.2 Classification of trademarks in this Modern Age:

At the beginning of trademark history the trademarks were more of conventional types which were simple to understand and consider but in this modern period trademark concept has undergone a major paradigm shift which

¹⁵⁵Jane Haskins, 'Trademark a Symbol' You can obtain trademark protection for a Symbol that you use to distinguish your business's goods or services from those of others, for e.g. Nike's 'Swoosh' symbol is a registered trademark. The symbol must be distinctive, unique, and unusual. The less unique your symbol is, the more likely that you will have to show that your symbol has acquired a 'Secondary Meaning' which means that people see your symbol, they automatically think of your goods or services. <https://www.legalzom.com>

¹⁵⁶Wikipedia; 'Monogram', Monograms are often made by combining the initials of an individual or a company, used as recognizable symbols or logos. Some Companies and Organizations adopt a monogram for a logo, usually with the letters of their acronym. For e.g. The Consolidated Edison logo, with a rounded 'E' nested inside 'C' has been described as a 'Classic Emblem', The connected 'CC' company logo created by Coco Chanel is one of the most recognizable monograms Internationally, Louis Vuitton's 'LV' monogram. <https://www.en.m.wikipedia>

¹⁵⁷[C.S. (OS) No.1104 of 2005]

¹⁵⁸ 1998 PTC(18)485(DEL)

are becoming more and more unconventional due to the creative thinking of human being and the development and growth of trade and commerce all over the world due to Globalization and Industrialization which has turned the world into a Global village. Trademarks are classified in to two categories, they are:

I. Conventional trademark

II. Nonconventional trademark

I. CONVENTIONAL TRADEMARKS:

There are different forms of Conventional or so called traditional Trademarks that can be commonly found and which are mostly used by many people all over the World. Trademarks Law of any country including India always gives greater protection to the trademark which is distinct and strong. Conventional trademarks are generally of five categories they are Generic, Arbitrary, Descriptive, Suggestive and Fanciful.

Now let us discuss each category of conventional trademark in detail;

a) Generic/Generalized Trademark

Any trademark gets a secondary meaning due to the extensive usage of the term becomes generic¹⁵⁹ or *Publici Juris*¹⁶⁰ (Of Public Right) in nature. How it becomes generic or gets secondary meaning can be better explained by taking an example of products like Colgate, Coca cola etc where in many times sub consciously we use theses trademarks even if we are buying the like products of some different companies. Below there has been given some of the products getting generalized over a period of time.

¹⁵⁹ Cornish L Lewlyn & Aplin, *Intellectual Property: Patents, Copyrights, trademarks and Allied Rights*, 5thE.d. 2005. Sweet & Maxwell, New Delhi.

¹⁶⁰ Meaning of Publici Juris (Lat) of public right. As applied to thing or right means that it is open to or exercisable by all persons. When a thing is common property, so that anyone can make use of it who likes, it is said to be '*publici juris*' as in the case of light, air and public water. <https://www.legaldictionary.lawin.org>

1) Aspirin: Bayer Company owns this trademark in many Nations except for America who has considered it as a generic mark. In *Bayer Co. v United Drug Co*¹⁶¹ the Court allowed the defendant to use the Plaintiff's Trademark 'Aspirin' as it became generic in nature because it acquired a secondary meaning.

2) Escalator: This Trademark is of American Company by name 'OTIS' which manufactures elevators walk ways which moves etc. This trademark now has become generic mark.

3) Cello tape: Originally Cello tape was a British brand trademark used for tapes which is now generic in nature used in different countries of the world.

Other examples are Pen, Pencil, Radio, Walkman are generic in nature

b) Arbitrary Trademark

Arbitrary trademark is a word or may be some picture or may be image which everyone knows as regards its existence but this type of trademark might be used by the proprietor to an product which truly speaking is not related with this product or does not make any descriptive meaning as to this product like TATA, BATA, APPLE COMPUTERS etc. In *Ahmed Oomerbhoy and anr. v. Shri Gautam tank and ors*¹⁶² Plaintiff is the manufacturer and seller of the edible oil by the name 'Postman' which is a 'Arbitrary trademark' for more than fifty years and the defendant started manufacturing the groundnut oil by name 'Super Postman'. The Court granted the injunction in favour of plaintiff restraining the defendant to use the mark as it resulted in infringement and passing off due to the deceptive similarity of these marks under consideration. The word Postman used by the defendant is Identical with the plaintiff trademark.

¹⁶¹272F.505(S.D.N.Y.1921)

¹⁶² [146(2008)DLT774;LC2008(2)105;2008(36)PTC193(DEL)]

c) Descriptive Trademark

Descriptive trademark speaks about the characteristics and features of the product and these types of marks have meaning and connotation of dictionary¹⁶³. This types of marks are normally not registered but in some way if the proprietor shows that this mark has an distinctive/ secondary meaning and feature than the registration of such mark is likely possible . For example if a proprietor sells T shirts and Jeans by the device and word mark ‘Trendy Jeans & T Shirts’ then this becomes a descriptive trademark. These types of trademark are many times advantageous because the proprietor doesn’t require advertising such trademarks as the name itself speaks about the product. Some more examples are LIC (Life Insurance corporation), ‘Society tea’, Cashew Fenny, ‘The Barber’ a name for salon, ‘Chat Corner’ etc. In *Reddaway and Co ltd v Banham and Co Ltd*¹⁶⁴ the House of Lord decided this leading case on descriptive trademark, in which the plaintiff’s trademark was given protection. The plaintiff was in the trade of producing hair belting by name ‘Camel hair belting’ and when the defendant infringed the plaintiffs mark the plaintiff claimed the right in the name and though the mark was descriptive in nature had acquired a secondary meaning and hence deserves protection. In Indian market we find number of goods and services with descriptive trademarks.

d) Suggestive Trademark

These types of trademark give suggestions as regard the nature /quality the products but in no way does it give description of the product. The consumer or public has to utilize his or her imagination capacity as to know the product. Some of the examples of suggestive trademarks are ‘AIRBUS’, ‘MICROSOFT’, ‘CITIBANK’, ‘PLAY BOY’ a Men’s magazine .

¹⁶³ Section 9(1)(b) of Trade Marks Act 1999: Absolute grounds for refusal of registration –(1) The Trademarks – (b) which consists 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 ; ...shall not be registered : Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive characteristic as a result of the use made of it or is a well known trademark .

¹⁶⁴ [1876]AC199

In *Cadila Health Care Ltd v. Gujarat Co-operative Milk Marketing federation Ltd and ors (The Sugar-Free Case)*¹⁶⁵ the court observed that suggestive trademark need not prove secondary meaning to be protected and deserves to be protected just like a coined trademark.

e) Fanciful Trademark

Fanciful trademark truly speaking makes sense only when this type of mark is used for a specific product. It could be a word mark which might not make any meaning in English or it could be a distinct pictorial device or presentation. Fanciful trademark is considered as one of the strong trademark as it has inherent feature of distinctiveness. To take an illustration 'XEROX' is an example of fanciful word mark which actually does not have any meaning but is considered as a strong and distinct trademark. So also 'QUACKER OATS' is an example of attractive and strong pictorial device mark which is distinct and strong trademark. Some more examples are REAL MANIK name for soft drink, NIRMA for detergents, LUX for soaps, El CONDOR name for whisky etc. In *Playboy Enterprises, Inc v Bharat Malik and anr*¹⁶⁶ the court in this case considered the trademark 'Playboy' which is used for a magazine to be a fanciful and arbitrary trademark which is registered in several nations including India and hence needed protection under the law.

After going through the conventional trademark now let us appreciate the term and types of non-conventional trademarks which are truly speaking this recent 21st Century trademarks which are very creative in nature and at times quite challenging too.

2) NON-CONVENTIONAL TRADEMARKS

In this present era of Internet and Globalization the concept of trademark is becoming more and broader which falls out of the definition of the trademarks

¹⁶⁵ 2009(41)PTC336(DEL)(DB)

¹⁶⁶ [2001 IVAD (Delhi) 356; 91(2001) DLT321; 2001(2) RAJ236]

mentioned in the statutes and taking unconventional form which is remarkable and modern. The Researcher has discussed below some of the Non-Conventional Trademarks which are growing in India as well as other Nations. The Ministry of Commerce along with DIPP¹⁶⁷ plays an important role in framing and implementing IP policies and also endeavors to upgrade trademarks Act in order to give protection to the non-traditional/non-Conventional trademarks in India as a result of this the Trademarks Registry has already revised the Manual of the year 2015 and made changes which has provided requirements and also procedures required for registering the non-conventional trademarks in India. Although we have to understand the practical fact that non-conventional trademark has just taken its root in India and will take a little more period to grow to the fullest.

The following are the various types of non-conventional trademarks which are now used by Indian trademark proprietors in India;

a) SHAPE AS TRADEMARK: Under the provision of trademark act 1999 in India, now shape of the goods, packaging or any 3 dimensional objects which can be represented graphically can be registered by meeting certain required criteria. Shape of good under the trademarks act is statutorily considered as an important element of any proprietor's trademark. It's again a non-conventional trademark registration. The shape must graphically represent itself for registration purpose and should also be distinctive from the goods of other producers. The Registrar will consider the entire procedural requirement needed to register Shape as a trademark whenever applied for registration. The

¹⁶⁷Ranjan Narula & Rachna Bakhru India; 'A Shift in Protection of Non-Traditional Trademarks' The Trademarks Act 1999 replaced the trade and merchandise Marks Act 1958 and comprehensively amended and consolidated the trademark regime. The new act was considered necessary for India's compliance with the Agreement on Trade Related aspect Of Intellectual Property Rights and its obligations as a member of the World Trade Organization. Under the old act, non-traditional trademarks such as colour combinations, three-dimensional (3D) marks, smells, sounds and tastes could not be registered. However under the new act of 1999, since a trademark is now defined as a mark that can be represented graphically and distinguish the goods or services of one party from those of another, the amendments specifically provides for registration of non-traditional trademarks <https://www.worldtrademarkreview.com>

Bombay High court has recognized that the shape of good as trademark while deciding the VODKA case. The shape of the bottle was considered as distinctive and was intrinsic of its reputation. An Exparte injunction was granted against the defendant. The requirement for such registration is that the shape should enable consumers to distinguish the product or packaging from other products.

Examples;

(1) Zippo Manufacturing Company's 3 D shape of the Zippo lighters is a registered trademark.

(2) Lego was the proprietor of shape trademark of red colour lego brick but later on Mega brand was able to prove to the European courts that Lego's trademark was no more valid

(3) Shape of Coca Cola bottle

A Japanese Court gave a judgment in favour of Beverage giant Company, Coca-Cola allowing it to register its bottle shape as a trademark in Japan¹⁶⁸.

(4) Shape of Tyre

In *Apollo Tyres Ltd v. Pioneer Trading Corporation*¹⁶⁹ the Delhi High Court passed an interlocutory order and restrained the defendant from using a tread pattern which is same as the Plaintiff which amounted to infringement of the registered trademark of Apollo.

(5) Shape of Vodka bottle.

Exception: One of the important things has to be understood that if a certain shape is required for technical need then such shape cannot be trademarked¹⁷⁰.

¹⁶⁸Economics Times: Shape of *Coca-Cola* bottle wins official trademark registration in Japan after court fight .TOKYO: The familiar curvaceous shape of the Coca-Cola bottle is now officially registered as a trademark in Japan –this nation's first such recognition of a three dimensional bottle form devoid of any lettering. <https://m.economicstimes.com>

¹⁶⁹ [(CS(OS)2802/2015)]

¹⁷⁰ Arnold Siedma, No Trademark For Coca-Cola Bottle Shape .*Coca-Cola* recently sought a trademark to protect the shape of its bottles. On 24th February, the denial of the application by the General Court of the European Union put an abrupt end to this attempt. This is so because the earlier Coca-Cola Contour bottle had grooves for it bottle which brought distinctness in it where as now they have modified the bottle and the groove part is not there and hence not registrable. <https://www.arnold-siedma.com> 25th February, 2016.

b) SOUNDTRADEMARK:

Sound Trademark is a non conventional type of trademark. Under the trademark act 1999 if the sound is represented graphically on the basis of musical notes either by using words or not can be registered. The sound mark mostly consists of sound graphics or words or notes of music or it may contain all of them. The sound must be truly distinct from other music in order to get it registered. Though it is a difficult task and requires expertise still registry has made an effort on the basis of research and analysis to register number of trademarks on the basis of Sound. In India we can register sound as a trademark by submitting the sound in MP3 format which should not cross half a minute of time and with graphical representation of the sound along with trademark application form should be filed with the trademark registry for registration of the sound as trademark. But there are number of things which cannot take sound as trademark like Nursery rhymes cannot be registered likewise a entire song cannot be registered so also popular music or a simple music etc cannot get trademark .

E.g. (a) In India the first trademark in sound was given to Yahoo which contained a voice of human yodeling Yahoo.

(b) In India the 'ICICI 'bank was the entity to procure registration in sound mark.

(c) Britannia has obtained 4 bell sound trade mark.

(d) NOKIA has taken sound trademark of guitar music.

c) COLOUR TRADEMARK: As per section 10 of the trademarks act 1999 the colour as a trademark can very well be registered by way of single as well as combination of colors provided the proprietor can distinguish the Colour trademark of his products or business organization from others and so also the proprietor should establish the connection of such colour with his product or entity. Mostly colour combination is accepted for registration as compared to single colour. In the case of single colour the proprietor has to show that the

consumer is recognizing such trademark due to its uniqueness and distinctness which is connected with the product. The Colour trademark even if not registered under the act can very well be protected under the common law action of Passing off by proving the reputation gained by such mark. **E.g.** The colour Pink used for VARNISH a Carpet and Upholstery cleaner etc.

In the case **Hindustan Unilever Ltd v Shiv Shankar**¹⁷¹ the Plaintiff is the registered proprietor of the marks WHEEL, ACTIVE WHEEL, which is detergent powder and soap and the packaging displays get up of colour combination artwork which is distinct in nature. The defendant was manufacturing and also selling soaps as well as detergent in the name and style of 4G ACTIVE and ADVANCE WHITE and the packets used for these products were deceptively similar to the one of Plaintiff in the colour combination. The court allowed Ex parte injunction and also appoint special officer to take inventory of the infringing material and also to take into possession of the same.

d) SMELL OR OLFACTORY TRADEMARK: A Smell mark can be applied for registration under the trademark act by representing it graphically but in spite of this there has not been a single smell trademark registered in India as yet. This category of trademark to be registered in India will require a development to be done by Research and development and by deploying experts who can analyze the same scientifically in well equipped laboratories.

- a) Rose odour for pencil, rubber or pages of book.
- b) Unique smell of Perfumery products or liquor etc.

In Re Celia Clarke¹⁷², in United States Of America Reminiscent of plumeria blossom floral fragrance was registered as trademark for a sewing thread.

¹⁷¹ OD29 GA 3085 (2017) CS215 (2017)

¹⁷² Re Celia Clarke, USPQ2d1238(1990)(TTAB)

e) TOUCH TRADEMARK

This is an innovative trademark in which a special and unique touch of either the product or the packaging can be registered as a trademark. Though this types of mark are not so popular but few companies are coming ahead like from liquor industry, pharmaceuticals etc. Although there has not been any trademark registration till date done of the touch mark in India but there is a likely hope in future.

In America, Diageo was initially successful in registering its velvet touch of its Crown Royal bag/pouch but later on the registration was cancelled due to some lapse in registration on the part of Diageo¹⁷³. Later on a wine maker got a ‘leather touch’ registered federally as a trademark and in another case A dispenser with a surface and texture have ‘Pebble grain’ has been uncontestable¹⁷⁴.

f) Taste Trademark:

Taste trademark as the name denotes can be referred to the taste of product i.e. for edible items. Taste trademark can be said to be almost similar like trademark of smell. This is a new form of trademark which is yet to take its root of development in India. Right now it is no so popular in India compared to Foreign Nations.

‘OHIM’ did not allow the pharmaceutical Co. by name Eli Lilly to register as a trademark the taste of strawberries which were artificial¹⁷⁵

g) Motion

The Motion trademarks are possible due to the advancement of multimedia production and these types of registration are done on the basis of sequence of

¹⁷³Touch trademark Update by Steve Baird Posted on articles, Non-Traditional trademarks, product packaging, Touch Trademarks, USPTO on Dec16,2013. <https://www.duetsblog.com>

¹⁷⁴ ibid

¹⁷⁵ WIPO MGAZINE Article0003 Smell, Sound, and Taste –Getting a sense of Non-Traditional Trademarks. February 2009 <https://www.wipo.int>

moving of picture and also drawing. In *Twentieth Century Fox Film Corporation, et al., v. I care TV, et al.*¹⁷⁶ FOX Film Corporation logo which is of 20th Century is a registered trademark in motion in which the floodlights trail in the sky back and forth direction. In this case i care TV was Injuncted from using Fox Co. Trademark.

E.g. United Kingdom's KRAFT Foods got registered trademark of a image moving of confectionery chocolate and also chocolate in the united Kingdom's office of Intellectual property.

e) Hologram

There is no mention of Hologram in the definition of trademark in the Act does not mean that they are excluded , this is because the definition is exhaustive in nature which means that even holograms can be registered if the same can be represented properly .

E.g. The VF (Video Future) got its trademark of Hologram registered by way of GDS video.

Now having covered the different classifications and types of the Trademarks / Service marks, let us now see the development of the Trademark concept and its Law from Indian as well as International perspectives.

2.6 TRADEMARKS EVOLUTION AND THE DEVELOPMENT OF ITS LAW

2.6.1 Development from Global /International Perspective

Speaking from historical point of view the very primitive and oldest form of marking and say branding were the one which were used for marking the Animals for distinguishing them by the farmer so also by the lord and also to

¹⁷⁶ Twentieth Century Fox Film Corporation, et al., v. i care TV, et al. [2000WL255989;53 U.S.P.Q.2d1831]

identify and recognize the owner of the animals¹⁷⁷. During the Stone Age and initial period of Bronze Age there were Cave Paintings done on which animals were depicted¹⁷⁸.

Egyptians used to do Wall Painting art and all this was 4000 years before. Some of the Monogram usage and also heraldic device usage were also practiced from ancient era¹⁷⁹.

In 5000 BC in the Ancient European era on the walls, the painting of the Bison with marking in the caves of Lascaux in the Southern part of France tells us that trademarks were used even during those early times¹⁸⁰.

In Egypt the building and structures built 6000 years back depicts stone-cutters Signature on them as well as show Quarry Marks depiction.

Potters marks were used on in the relics proceeding from the Indus valley and this was used on the vessels in order to identify the person who created the vessels¹⁸¹. The Roman brick makers were first to Stamp the bricks and tiles made by them.¹⁸² This was done by them for identifying the raw material origin or for identifying the maker of the bricks¹⁸³. This type of practice was since 2nd Century BC which was also used by Egyptians and Mesopotamia¹⁸⁴.

¹⁷⁷ W.R. Cornish, *Intellectual Property: Patent Copyright, Trademarks and Allied Rights* (2nd E.d. 1993. Sweet & Maxwell.)

¹⁷⁸ IntaBulletin, March, 1st 2002, Brian J Winterfeidt, Dow, Lohnes & Albertson, *History Of Trademarks Since...4000 B.C.* <https://www.inta.org> visited on august 20th 2018, at 4 P.m.

In Israel, Syria, Greece, Turkey these type of marking were practiced on the olden buildings.

¹⁷⁹ Ancient Egypt; Unique signs or images were incorporated by crafts people into their work to show where a particular product originated and who made it. <https://www.respectfortrademarks.org>

¹⁸⁰ History Of Trademarks; Ancient Europe, Earliest forms of marking <https://www.respectfortrademarks.org>

¹⁸¹ Britannica; Potters mark also called factory mark device for the purpose of identifying commercial pottery wares. <https://www.britannica.com/atrs>

¹⁸² Academia; 'Roman brick stamps'. <https://www.academia.edu>

¹⁸³ Richard Stim, *Intellectual Property: Patents, Trademarks and Copyrights*, (2nd Ed., 2001 .West Legal Studies, Thomson Learning. Inc.)

¹⁸⁴ Russ Ver Steeg, *Ancient Egyptian Roots of Trademarks*, Aug, 16th 2018 .Egyptians and Mesopotamian used this marks to put inscription on tiles and bricks mentioning the Monarch who had built the structure or who was in power during that time. <https://journals.sagepub.com> visited on Oct, 7 2018, at 2 P.m.

During the Roman Empire: the first people to use the trademarks were the black smiths and they used trademarks *Empire on* the swords which were manufactured by them¹⁸⁵. So also Barbers Pole was used to locate the business right from ancient time. An Amphorae were Inscribed with some mark for identification purpose¹⁸⁶. Also the names depicted in the scene of the characters. During the Greek and Roman period of civilization the clay pots made by the people used to mark them as x or *¹⁸⁷

Chinese used to put marks on the pottery made by them. China almost had approximately 5000 years back marked pottery which was discovered. In Greek the mark placed would identify the maker as well as the wholesaler¹⁸⁸.

King Edward I of England: He passed a Law in which it was obligatory for the jewelers to stamp their ornaments of silver and gold in the Goldsmith hall office in London when there was an official trade in the same and this was in the year 1300¹⁸⁹.

¹⁸⁵ 'Brief history Of trademarks' <https://www.tmlawworldwide.com>

¹⁸⁶ Wikipedia Amphora: 'Amphora' is a ceramic, metallic container from new Stone Age period used for transport and storage of various products mostly for wine. So also *titulus pictus* was an inscription which was in commercial nature inscribed on artifacts like amphorae and depicted information as regards the destination, type and origin of the goods, this is more seen on the containers of the pottery of Romans of ancient era. <https://www.en.m.wikipedia.org>

¹⁸⁷ Wikipedia; 'Ancient Roman Pottery' During the Roman Empire 'FORTIS' name was mostly found on oil lamps made of clay and this lamps were simple and was in the period of first 3 century of roman period .Clay lamps having this mark were found in France, Spain, Germany, England and this could be either due to the wide distribution system of the owner of this trademarked clay lamps or it could also be due to counterfeiting of the same . Due to the large and extensive usage of the FORTIS mark on artifacts it became a Generic mark in the production of such clay lamps .At a later stage they used to mark with potters name on them or their Monarch to identify the owner of goods. The engraving done by the people can said to be as old as the Religions. <https://www.en.m.wikipedia.org>

¹⁸⁸ History Of Trademarks; Ancient China ; A seal containing Chinese characters was used in the East Asia to prove identity on documents, contracts, art, or similar items were authorship was considered important. <https://www.respectfortrademarks.org>

¹⁸⁹ Goldsmith Co.; Goldsmith Hall in London, the home of the Goldsmiths' Company assay Office, is where hallmarking began. The Goldsmiths Company was asked to supervise Britain's first marking system to guarantee the fineness of precious metal .If any person counterfeited then such person was given capital punishment. During the Medieval era in England the goldsmiths used to hallmark to certify that these gold items are inspected as regards its purity and this age old practice is still continued in this modern era. <https://www.assayofficelondon.co.uk>

In the Middle Ages: There was an growth in trade and merchandising dating back to 10th Century and in order to indicate and find out the proof of the ownership rights of goods one more trade mark came into existence during that time which was very popular and extensively used by those traders and this mark was called the ‘Merchant Mark’¹⁹⁰. This merchant mark used during that that era was also known and referred as ‘Proprietary Mark’.¹⁹¹

In the 15th Century: There was a Printers Mark usage in Europe and these marks were printed on the books in order to locate and find out the printer of these books e.g. a double shield mark was used by a printer from Germany and this mark was seen on the books which were published in 1462.

During same era in Europe there was a decoration of Emblem on Castles, Palaces so also interestingly on the Taverns and Inns too¹⁹².

East India Company: was chartered by the Queen of England Elizabeth ‘1’ in the year 1600 had its mark which comprised of the following ‘+’, ‘a’, ‘4’ and also EIC and this served as its a Merchant Trademark which appeared on the postage stamp and also on the coins of East India Company¹⁹³.

¹⁹⁰ KANE D Siegrun, *Trademark Law, A Practitioner Guide, 1989, Supplement*, Pg.9-10 Practising Law Institute, New York: Production Mark were being used by guilds in order to establish responsibility to produce superior quality merchandise and also they were co-operating in supporting to enforce territorial trade boundaries. The guilds were building goodwill and reputation through this marks by maintaining the quality of their goods and hence they used to restrict the membership and used to punish the members producing inferior goods .There was a great appearance of Merchants and craft guilds in the 14th and 15th Centuries in Japan and Europe and so also logos and symbols in the form of trademark started appearing for the purpose of identification of goods and services.

¹⁹¹ Medieval Europe; Merchants marks were personal marks tat developed at the beginning of the 13th Century until the end of 16th Century widely used by traders and merchants throughout Europe. Merchant marks are arguably the early trademarks. They displayed the names of traders and offered a guarantee that the goods were of a certain quality. Particularly used by producers of bells and paper (watermarks) <https://www.respectfortrademarks.org>

¹⁹² *ibid*

¹⁹³ Wikipedia; Merchants Mark: A merchant’s mark is an emblem or device adopted by a merchant and placed on the goods or produce sold by him in order to keep track of them or signs of authentication. It may also be used as a mark of identity in other context. <https://en.m.wikipedia.org/wiki>

BAKERS LAW:

During the ruling of King Henry III in the year 1226, the parliament of England passed the first legislation on trademark.¹⁹⁴ Under this law it was obligatory for all the Bakers to use a mark which was distinct in nature on bread loaves manufactured and sold by them during that time¹⁹⁵. In the year 1226 the first legislation which was passed in England was the law which made it compulsory for every baker to put their own mark on the bread made by them¹⁹⁶. In the historical point of view Bread and Beer Assizes Law was an important act as regards the Trademarks¹⁹⁷.

Section 38 of usage of Winchester 1275: antedated made it obligatory for all the Bakers to put their stamps (Sun Sel Sunu) on the breads they used to manufacture¹⁹⁸.

VENETIAN LAW: The first systematic Intellectual Property law was the Venetian Law, 1474¹⁹⁹. Under this statute any new Invention and any produce was to be brought to the report of Republic of Venice in order to get protected from Infringers. In the year 1449 King Henry 6th granted the first patent for making stained glass to John of Utynam and this is a Landmark in patent history.²⁰⁰

There was no separate law to protect trademark during ancient period. They were using different mark to identify their goods from others. Now let us verify

¹⁹⁴ Wikipedia 'Merchant Mark' <https://en.m.wikipedia.org/wiki/trademark>

¹⁹⁵ Aaron Schwabach, *Intellectual Property* (Ed.2007, ABC-CLIO Publisher) p...9.

¹⁹⁶ History Of Trademarks; 'Bakers Law'. England: 1266, Parliament passed its first legislation concerning trademarks. The Bakers Marking Law required every baker to put a unique mark on the breads produced. <https://www.respectforthetrademarks.org>

¹⁹⁷ Sruthi Srinivasan; 'Evolution Of Trademark laws In India' This was done to identify the bakers and any bread found without the mark were confiscated by the officer of abundance and whichever baker would do this wrong would be fined with huge damages. <https://www.altracit.com/publication>

¹⁹⁸ J.S.Furley, 'City Government of Winchester' from the records of 14th and 15th centuries, p.82. These marks were registered by local officer in charge. This was helping in identifying and standardization of the bread and if ever inferior quality product were found, a strict action was initiated and also fine was imposed on the defaulter.

¹⁹⁹ E Stalley & *The Guilds Of Florence*, (Second Ed.) 1906. Methuen & Co.p.440.

²⁰⁰ Adil E Shamoo, David B Resnik, *Responsible Conduct of Research*, (2nd Ed. 2009 Oxford University Press) p.168.

the various enactments made in various countries from time to time to protect trademark.

Development of Trademark Law in the world:

a) France: For the first time the law was introduced in France to protect trademark. In the period 1751 the manufacturer of the furniture in France were told to a mark on their work. The 'Manufacture and goods Mark Act' was passed by France in the year 1857²⁰¹.

In 1883 the Paris Convention which is an international agreement as regards trademark and also property rights of industries with a object of Industrial property Protection was agreed. The initial membership comprised of 11 Countries²⁰². Now the membership of countries recorded 177 in the year 2017.

b) England: 'First and Earliest Landmark development of Passing off in England took place in the year 1617 in the following Landmark Case of Passing off'.

In *Southern v. How*²⁰³ A clothier used to put his mark on the clothes he used to make an in this way he had developed a goodwill and good repute for his business. An infringer used this mark on his clothes and in this way he deceived and made profit in wrong way. The court gave relief on the basis of passing off law.

The 'Merchandise Marks Act 1862' was passed in England. Under this Act it was a Criminal offence if anyone would Copy or make imitation of any other persons trademark with an intention to cheat or defraud other²⁰⁴.

²⁰¹ History Of Trademarks; France, <https://www.respectfortrademarks.org>

²⁰² *ibid*

²⁰³ 79ER400(1618)

²⁰⁴ Lionel Bently and Brad Sherman , '*Intellectual Property Law*' (2nd Rev. E.d. 2004, Blackstone Press)

Industrial Revolution: From the spark and inception of the Industrial Revolution Capitalism cropped in and there was a huge commercial and business activities taking place in the whole world as there was growth of trade and industries and commerce²⁰⁵. Actually this is the time where the Guild system started disappearing and modern era business which is of free trade started developing at a massive stage which was of democratic nature. Now the trademarks which were used more for the purpose of identification of goods and services and not as an obligation during the guilds system of business operation²⁰⁶.

Other Civil Law helped the Trademark Protection : So also along with trademark laws like trade mark acts and passing off action under common law there were many other laws which came into force²⁰⁷.

Trademark Act 1875: United Kingdom enacted Trademark Act 1875, for the first time in United Kingdom in the year 1875, the 'Trade Mark Registration office was started for registering trademarks in UK, which formally was in their Patent office and the registered trademark was having an evidentiary value²⁰⁸. United Kingdom's Trade Marks Act 1938 was the first to make an

²⁰⁵ History: 'The Industrial Revolution', now also known as the first Revolution was the transition to new manufacturing processes in Europe and the US in the period from about 1790 to sometimes between 1820 and 1840. This transition included going from hand production methods to machines, new chemical manufacturing and iron production processes, the increasing of use of steam power and water power, the development of machine tools and the rise of the mechanized factory system. The development of trade and the rise of business were major causes of the Industrial revolution. The industrial revolution began in Great Britain and many of the technological innovations were of British origin. <https://www.history.com>

²⁰⁶ Krylova and Partners; 'Trademark in the Epoch of the Industrial Revolution'. Prior to Industrial revolution, trademarks were of limited use. The industrial revolution which can be called the heyday of the use of trademarks has enabled the use of trademarks as a means of advertising. <https://www.kip.ua/news>

²⁰⁷ Other Laws like Criminal Law which were used for protection of the Trademarks so also Civil laws too started developing in a gradual manner which again helped the trademark owner to stop the infringement.

²⁰⁸ Bently Lionel, *The Making of Modern Trademark Law* :The Construction of The Legal Concept Of Trade Mark(1860-80)in Lionel Bently, Jane C Ginsburg & Jennifer Davis , Trade Marks and Brands :An Interdisciplinary Critique (Cambridge University Press ,2008) : The *Registrable Mark* was defined by Act as a mark or device or a name of a firm or a individual printed in a distinct and a certain way or a signature signed by an individual or any firm or any ticket or label which is distinct .

system for registration on the principle of ‘Intent to Use’ The Trademarks act in force today in England is ‘The Trade Marks Act 1994’.²⁰⁹

United Kingdom’s First Logo Registered: In the year 1886 United kingdom the Bass Brewery was the first in line to register its logo under the Trademarks Act of 1885 which comprised a Triangle and that’s the reason it is considered as the first Registered trademark in united kingdom²¹⁰.

c) United State of America: In 1870, an attempt was made by the Congress to form a regime of federal trademark statute on Copyright clause, but the Supreme Court Struck down this statute of 1870 in the trademarks cases. Later on the trademark statute was passed by the Congress on the basis of Commerce Clause in the year 1881 and at a later stage the in 1905; Trademark Act was duly revised by the Congress²¹¹.

Lanham Act was passed by the congress in the year 1946, this Federal Act at present Governs the trademarks legislation in USA. At the same time USA also has its own State Law protecting the trademarks. At present U.S. has passed Federal Trademark Dilution Act 1995(Revised in 2006).

In USA, in the year 1870 the Averill Chemical Paint Company was the first to register its trademark which had an Eagle and the Ribbon with the following words Economical Brilliant but unfortunately the Supreme Court of USA held that the 1870 Act was unconstitutional.

²⁰⁹ Tamali Sen Gupta, *Intellectual Property Law in India*, (2nd Ed. , 2018 Wolters Kluwer): Truly speaking this act of 1938 became a Model for same types of Legislations in other countries too .This act helped the trademark holder to stop infringer even if no confusion. In fact this act increased the rights of the trademark owner.

²¹⁰ Brookston Beer Bulletin; On Jan 1, 1876, the first trademark was registered in Great Britain. The story is usually told along this line with this from an campaign advertising and media website, where this part of a series on the British History of advertising. “ on the last night of 1875 an employee of the Bass Brewery was standing at the head of a queue and facing the prospect of a chilly start to the new year . On 1st January 1876, the new Trademark Registration Act was coming into effect and the staffer had been told to queue overnight outside the registrar’s office to be the first to take advantage of it. As a result, the distinctive BASS Red Triangle logo is now Britain’s oldest trademark. <https://www.brookstonbeerbulletin.com>

²¹¹ Jeremy Philip and Alison, *Introduction to Intellectual Property Law*, (3RD E.d. 1995 Butterworth’s)

In USA, a Biblical Personality ‘SAMSON wrestling with Lion belonging to J.P. Tolman Company was the trademark which was registered in the year 1884 on May 27²¹². +The Lanham (Trademark) Act is the main statute in the Federal Trademark Law.²¹³

In 1883 in USA The trademark Coca Cola got registered and it is evident that the trademark is modified as well as changed many times.

d) Germany: The first law passed was the Trademark Protection Law and this law came into force in the year 1875 on 1st of May²¹⁴. So also in the year 1875 a steel manufacturing Company by the name KRUPP a 400 year which is a German dynasty and family business registered its three Trains wheel²¹⁵.

So also one of the oldest trademark was used by Lowenbrau Brewery in Munich, Bavaria in Germany in which they used to use Lion mark for their brand²¹⁶.

e) Hong kong: The Nestles top most beverage Co. in Hong kong first launched its Eagle Brand and also got its trademark first Registered in the year 1874.

²¹²The Samson Timeline: Now this Company is called Samson Rope technologies Inc. which is a rope making Company. <https://www.samsonrope.com>

²¹³Richard Raison, Craig Fellenstein, Jaclyn Vassallo , ‘*The History* its Commerce Clause powers the congress passed another trademarks act in the year1881 and the same was revised by the congress in 1905 .at a later stage the Lanham act 1946 was passed and also there were several amendments made and it’s the Primary Federal trademark law in USA . The *Of Trademarks* In accordance to Lanham(Trademark) Act brings prohibition in the case of many wrong doings like trademark dilution and infringement and also advertisement which is false in nature. <https://www.informit.com> 18th March, 2005.

²¹⁴ History Of Trademarks; Germany’s 1st Trademark Protection law, <https://www.respectfortrademarks.org>

²¹⁵ Brookston Beer Bulletin; Wheels which were seamless and placed on top of each other was its logo and label which was registered in German Trade mark Protection Law, 1874 and this steel tyre were strong and unbreakable and were patented by Krupp in the year 1853 in Prussia. <https://www.brookstonbeerbulletin.com>

²¹⁶Wienskini Magazine: This Brewery says that it is the oldest trademark since 1383 and has been using its trademark continuously in the World. Stella Artois 1366 is a Belgian beer initially brewed by the Artois Brewery and now owned by Interbrew International B.V and this beer says that it has been using the trademark continuously since inception. <https://wiesnkini.de/en/magazine/history.Munich.LowenbrauBrewery>

f) Japan: In the year 1884 for the 1st time a law on Trade Marks was passed in Japan²¹⁷ .

g) Australia :recognized the rights and gave consideration to the first user of any mark and not for the first filing of application for registration Under the 1905 Act , a pine tree image and now this registration proprietor is Fisons PLC and this mark is used on chemical substance and this substance usage is in pharmacy and medicinal products²¹⁸ .

h) Africa: ARIPO (African Regional Intellectual Property Organization)

Banjul Protocol has mandated ARIPO to look after the registration and also the administration of the trademarks so registered. In 1993, on 19th November, the Banjul protocol on trademark came into adoption at Gambia. The protocol has been revised to a great extent to meet the TRIPS regulations²¹⁹.

‘Well known trade Mark’ concept according to South African Trademarks Act has been interpreted in two ways.²²⁰ One interpretation says that the product is truly so well known that such marks are given protection even in the places where it is not registered which is based on PARIS convention and another well known trademark concept means the trademark which is to an extent known sufficiently and to prevent its dilution and hence needs to be granted protection.

‘Passing off action’ and Equity Principles were followed by Common Wealth Nations: Passing off Law existed right from the period of Elizabeth 1. There were cases in Court of laws as well as Equity Courts²²¹ .

²¹⁷ History Of Trademarks; Japan, <https://www.respectfortrademarks.org>

²¹⁸ This shows that Australia recognizes and adopts the policy of Prior User Principle while considering the ownership of trademark.

²¹⁹ ARIPO(African Regional Intellectual Property Organization) <https://www.aripo.org>

²²⁰ Roshana Kebrick, The term ‘Well-Known’ in South African trade-mark legislation: some comparative interpretation. <https://www.jstor.org>

²²¹Wadlow, Christopher, ‘*The Law Of Passing Off*’, 1990 Sweet & Maxwell : Passing off action comes under the law of Tort which took its root in United Kingdom in the 17th century and in The development of Passing off law mainly happened in order to protect the goodwill and reputation of the

'Nobody has a right to Represent his goods as that of some else's '.

In the popular case of English precedent the articulation of passing off tort was established ²²²

In the case *Perry v Truefitt*²²³ the court under Lord Langdale held that misrepresentation could be a ground for injunction and no man can sell his goods as though they are of someone else.

Concept of Extended Passing Off: Extended Passing Off concept took place in the English case *Erven Warnink B.V v. J Townend & Sons (Hull)*²²⁴ popularly known as Advocaat Case in which landmark and leading decision was taken by House Of Lords on extended passing off tort of common law which was developed further for the common wealth which was established originally in *Bollinger v. Costa Brava*²²⁵.

It is very true that this Common Law action of passing off has played an important role in the development of trademark law in these Countries and this law influenced other Nation's including India in developing this Law.²²⁶

2.7 TRADEMARK PROTECTION AND DEVELOPMENT IN INDIA

The concept of history and protection of trademark in India has its beginning from a very long time, the researcher has discussed this concept under two broad heads they are;

trademark . India in 19th Century. So also with England and other common wealth countries like New Zealand, Australia etc also follow this law. America adhered to passing off law since 19th Century

²²² Course Hero: A case concerning two types of hair treatment (Perry's Medicated Mexican balm and Truefitt's Medicated Mexican balm . <https://www.coursehero.com>

²²³ [1842]6 Beav,66 .

²²⁴ [(1979)AC731(1980)R.P.C.31] The Court presided b lord Diplock held that wares whose name falsely suggest its quality, characteristic can be prevented selling such products under such name.

See also Reckitt & Colman v. Borden Inc. [(1990)1ALLE.R.873] Also called Jiff Lemon Case .The house of Lord established and reaffirmed the 3 part test to proof Passing off :

a) Reputation & Goodwill b) Misrepresentation c) Damages

²²⁵ [1961] 1 W.L.R. 277

²²⁶ Venkateshwaran, *Trademarks & Passing Off* (7th E.d. 2018 LexisNexis , Gurgaon , Haryana)

A) Trademark protection in India before 1940

B) Trademark protection in India after 1940

2.7.1. Trademark protection in India before 1940

Development of trademark protection in India before 1940 is divided into the following stages.²²⁷

a) Ancient Period

b) British Period

Now let us analyze the development, idea of trademark and protection given to trademark if any during 'Ancient period'.

a) Development of trademark in India during Ancient Period:

The Trademark which is a core of modern trade and commerce shows its existence and presence right from Harappa and Mohenjo-Daro era i.e.; during the period of (3500-2700 BC). So also the use of trademark concept existed during Indus Valley civilization.²²⁸ There existed traders known as Sumerian and these Merchants used to seal stamp their goods and properties such as *Ravi* and *Kot Diji* pottery, ivory, tablets of copper and bronze, bangles, stoneware

²²⁷In the case *Whirlpool Corporation v. Registrar Of Trademarks* Mumbai (26th October, 1998) While explaining the History of Trademarks Legislation the Learned Judge of Supreme Court observed that 'The history of legislation is more than a Century old. The first legislation brought on the Statute-book was the Indian Merchandise Marks Act, 1889 (Act 4 of 1889). This was followed by the Trade Marks Act, 1940 (Act 5 of 1940). Both these Acts were repealed by the Trade and Merchandise Marks Act, 1958. This Act follows the pattern of the Trade Marks Act, 1938 of the United Kingdom. Prior to the enactment of the Trade Marks Act 1940, the disputes or problems, especially those relating to infringement of trademarks or passing off were decided in the light of *Section 54 Of Specific Relief Act, 1877*, while the registration was tackled by obtaining a declaration as to ownership of a trade mark under the Indian Registration Act, 1908. The present 'Trade and Merchandise Marks Act, 1958' provides in Section 129 that any document declaring or purporting to declare the ownership or title of a person to a trade mark other than a registered trade mark. Shall not be registered under the Indian Registration Act 1908.

²²⁸ Cristian Violatti, Ancient History, Encyclopedia, and Indus Valley Civilization: The Indus Valley civilization was an ancient civilization located in what is Pakistan and northwest India today, on the fertile flood plain of the Indus River and its vicinity. Two cities in particular have been excavated at the sites of Mohenjo-Daro on the lower Indus and at Harappa, further upstream. The evidence suggests they had a highly developed city life; many houses had wells and bathrooms as well as an elaborate underground drainage system. The Indus Valley Civilization had a writing system which today still remains a mystery. Examples of this writing have been found in pottery, amulets, carved stamps seals and even in weights and copper tablets. <https://www.ancient.eu>

bronze tools etc which were attested with the seal and seal impressions²²⁹. These Seal were mostly square shaped with some symbols on them at the top and in the center animal and again some symbols at the bottom. The animals which were on the seals were elephants, bulls rhinos etc. Almost to a tune of approximately 3000 seals of such traders were discovered during the excavation which happened to be used by the traders and merchants from foreign countries. So also square seals stamp were more widely used in Indus. so also in the western India at lothal port thousands of seals have been found. There was also trading done by Mesopotamian *Traders* by using seals while trading in copper, gold, jewelry²³⁰. There was also a wide usage of trademark seals by *Sindhu traders* on the clay and other goods and ornaments in order to identify and name their goods and properties. The numbers of seals used by Mesopotamian traders were almost approximately 2500 in number which were found in Indus valley. During this period there is no separate legislation to protect the interest of owner's of trademark. After this period changes were introduced and various statutory laws were passed from time to time during the British era to protect and punish the infringers of trademark.

b) British Period:

Most of the trademarks enactments in India are similar to the ones in England and USA with a little difference here and there. As the British were ruling India they introduced their own statutory laws in India from time to time for their own benefit²³¹. It is an interesting and important thing to perceive and

²²⁹Manu Sharma Intense IP knowledge Center; 'History of Indian Trademark Law' Oct, 15th 2018 :<https://www.intenseip.com>

²³⁰ KC Kailasam, *law of trademarks* (3rd Ed. 2013, LexisNexis, Gurgaon Haryana) P.4, 5,6.

²³¹Tejaswinee Roy Chowdhury, Indian Trademark law-comparison with US and EU.

Be it India or US or the EU, all three Countries have made trademark laws adhering to the principles of the TRIPS Agreement, Paris Convention and the Madrid Protocol. The earlier mentioned countries have accepted the following 8 fundamental principles of trademark protection ;

1. Trademark Registration confers upon the proprietor a monopoly right to use but no right can be absolute as some restrictions are to be imposed on the use of certain classes of words /symbols /other representations
2. The registration of trademark should not be interfering with its bona fide use by persons who intend to use it in ordinary sense and ordinary purpose.
3. Since property rights in a trademark are acquired by the use of superior and similar rights obtained by registration, Prior users of a trademark should be protected against any monopoly right.

understand that the Passing off action rights has always been considered and recognized in all of their enactments on the trademark. In Indian history the first Trademark Statute attempt was initiated by the Bombay Mill owners and Bombay Chamber of commerce in 1877 for trademark registration system to be established like that of England Trademarks Registration Act 1875²³². The Bill was introduced by the Government in 1879 but there was division in the opinion and hence the bill was dropped which again was introduced by the Government of India in the year 1880, in which the Selection Committee agreed for registration of Indian mark abroad, which was not agreed and there was heavy opposition and once again the Bill was dropped²³³.

Again in 1902, The Cutlers Company, Sheffield from UK asked and requested for constituting a Trademarks Office in India from Commercial people point of view in England this type of legislation was mandated. England's Chamber of Commerce wanted this as they were afraid that Austrian, Italian, German would duplicate and infringe their Trademark in India²³⁴. Hence Chamber of commerce tried to establish Registration Office in India in 1906 but however the British Government was still reluctant to set up office in India. Fortunately there was a Positive Response in India when United Kingdom places this question again in 1908²³⁵.

4. The two main interests are to be protected are :

a) The Interest of the public, so that the mark to be registered does not mislead the public b) The Interest of the existing traders.

5. As a matter of public policy any public person who wishes to object the registration should be allowed to do the same.

6. The rights of honest concurrent user who uses the registered similar mark in good faith must not be deprived of registration benefit.

7. Use of trademark must be continuous as there will be no logic in giving it any protection if there is a stoppage in the usage of the same.

8. The assigning or transferring of the trademark as to be done only after adhering to certain conditions and limitations. <https://www.ippleaders.in>

²³² Intense IP Knowledge Center; 'History of Indian Trademark Law' Indian trademark law evolution has been over years. <https://www.intenseip.com> Oct 15th 2018.

²³³ Venkateshwaran, *Trademarks & Passing Off*, (6th E.d. 2015, LexisNexis, Gurgaon, Haryana)P. 4,5.

²³⁴ Shodhganga : 'History Of Evolution of Trademark in India' <https://www.shodhganga.inflibnet.ac.in>

²³⁵ Kaiasam & Vedaraman, *Law Of Trademarks*, (3rd E.d.2013, LexisNexis, Gurgaon Haryana) P. 4 to7.

The researcher has enumerated and explained the sequence by which the written/unwritten law on Trademark developed in British India Period;

- a. *The Common Law and Equity Principles*
- b. *Indian Penal Code (IPC) 1860.*
- c. *Specific Relief Act 1877(1963 as amended in 2018)*
- d. *The Sea Customs Act 1878*
- e. *The Indian Merchandise Mark Act 1889*
- f. *Indian Registration Act, 1908.*

a) **The Common Law of ‘Passing-off action’ and ‘Equity Principles’**

Common law is not a statutory law but it evolved through judicial pronouncements in England²³⁶. Even till today this common law is applied in England. The Trademark Law in India developed by following the United Kingdom’s Common law.²³⁷ The Common law right of ‘Passing off action’ was the first and foremost protection available for the protection of Trademark in India²³⁸. ***‘One should not gain or take advantage from the hard-work or idea of other without express permission’***. Before the enactment Action of any Statutory Act on trademark, in India, ‘*Passing off Action*’ which area Common Law of action, right under the *law of Tort* and ‘*Equity Principles*’ were followed in deciding the infringement cases of trademark²³⁹.

²³⁶ A development of the law of passing off is illustrated in the case of *J. Bollinger v. Costa Brava Wine Company Limited* [(1960)RPC 16; (1961)RPC116] where on a preliminary point of law it was held that an action for passing off by use of the name of a locality would lie at the suit of persons alleging that the defendant is causing tem injury by the use of the name, when such name forms part of the goodwill of the plaintiffs, even though they have no exclusive right to use of such name .In this case the injunction against the seller of “*SPANISH CHAMPAGNE*” was granted on the ground that “*CHAMPAGNE*” could only mean “wine produced by “*Methode Champinoise*” in the champagne District of France .

²³⁷ Wikipedia; In Law, Common Law also known as judicial precedent or judge made law or case law is that body of law derived from judicial decisions of Courts and similar tribunal. <https://en.wikipedia.org>

²³⁸ Nishka Tyagi, *Passing Off for Registered and Unregistered Trademarks*. <https://www.mondaq.com>

²³⁹ LEXUNIVERSE, **‘Law of Equity in India’**, For administration of Equity there was never established any separate court in India since most part of the law for application by the court is codified. However the courts act according to the ‘*Principles of Equity, Justice and Good Conscience*’ in the absence of any specific law or usage in matters placed before the court. Principles of Equity are also noticeable in Mohammedan Law. The English Laws also contributed to the development of Equity jurisdiction in India. The Regulation of 1827 laid down a provision which required the East India Company Courts to act according to the principles of Justice, Equity and Good Conscience in absence of any specific law or usage. In most of the laws enacted in India for the guidance of the judges, the

The Law of Passing-off almost made its appearance from the 19th Century onwards.²⁴⁰ Even after enactment of statutes on trademark law the law of passing off is still serving its purpose in protecting and providing remedy to the trademark owner²⁴¹. In the case *Rustom & Hornby Ltd .v. Z. Engineering Co.*²⁴² the Supreme Court held that no person is entitled to sell or present his goods as though they are of someone else.

In another case *Saville Perfumery Ltd. v. June Perfect Ltd*²⁴³ the Court gave a view that in some respect the infringement action under the act and passing off action are same. These laws came to the rescue of the genuine trademark proprietor during that time²⁴⁴.

provision of the rule of Justice, Equity and Good Conscience has been expressly laid down. The principle of Equity has been codified in various laws such as the Specific Relief Act 1877, The Indian Contract Act 1872 etc. <https://www.lexuniverse.com>.

²⁴⁰Shodhganga : 'History Of Passing off Law', www.shodhganga.inflibnet.ac.in visited o 7th Jan 219

²⁴¹Venkateshwaran, K C Kailasam, *Trade Marks & Passing Off*, (6th E.d. 2015, LexisNexis, Gurgaon Haryana) P1187,1195

²⁴² AIR (1970)SC(1649) The Supreme Court reiterated that the – “Gist of passing off action is that A is not entitled to represent his goods as the goods of B but it is not necessary for B to prove that A did this knowingly or with any intent to deceive.

²⁴³ [(1941) 58 RPC 147(161)] “In an action for infringement where the defendant’s trade mark is identical with the plaintiff’s mark, the court will not inquire whether the infringement is such as is likely to deceive or cause confusion. But where the alleged infringement consists of using not the exact mark on the Register, but something similar to it the test of infringement is the same as in an action for passing-off. In other words, the test as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing-off action.”

²⁴⁴ Academia: Passing off is truly speaking a tort which is Economic in nature as it gives justice by protecting the unregistered mark from economic losses committed by the wrong doer. <https://www.academia.edu>

Equity, Justice and good Conscience Principle applied in India

Equity principles of justice and good conscience also played a very important role in the development of trademark law as regards infringement and passing off. This Equity principle gave the liberty to the judges in India to take decisions in the trademark cases in India wherever there was no clarity in deciding the cases on the basis of statutes existing during that time²⁴⁵.

Sec. 93 of Administration of Justice Regulation, contains provision formulated and expressed as regards Equity, Good Conscience and Justice which is promulgated by the Governor General In Council in 1781, July the 5th²⁴⁶.

In *Thomas Bear and Sons (India) v. Prayag Narain*²⁴⁷ on September the 14th in the year 1934, the Allahabad High Court held an observed that in if in dealing with infringement cases on Trademark, if statutory law is not present then the cases have to be decided on the basis of *Equity, Good Conscience and Justice*. The Court also observed that the England's Common law while applying in India in the trademarks cases must be practiced on the principles of Equity, Good Conscience and Justice.

b) The Indian Penal Code 1860{Act No.45 of1860}:

The first statutory law enacted by the British in protection of trademark was Indian Penal Code in the year 1860. The IPC, 1860 had played a significant role in the area of Trademark by providing Punishment for making use of false mark. Various provisions were introduced under this statutory law for the welfare of trademark owner. In the year 1972 the Apex Court of India in *Sumat Prasad Jain v. Sheojanam Prasad*²⁴⁸ applied the provisions of IPC, 1860. In this case the Appellant was infringing the respondent's trademark for

²⁴⁵*Satish Chandra Chakrabarti v. Ram Dayal De* [(59 Ind. Cas 143,)13th July 1920]The Calcutta High Court observed ;'The Principle that in all cases for which no specific statutory directions are given, judges should act according to Justice, Equity and Good Conscience.'

²⁴⁶ Equity, Justice and Good Conscience, <https://www.indiankhanon.org>

²⁴⁷ AIR 1935 All 7

²⁴⁸ [1972AIR2488,1973SCR(1)1050](The issues involved were Property mark, counterfeit, trademark is property mark, trademark use, movable property, cartoon, imitation }

which he was convicted by the Court and upheld the decision of the High Court. The Respondent committed the offence of passing off by infringing the property mark of the complainant. The case was decided under Sections 482²⁴⁹ and 486²⁵⁰ of IPC, 1860. Sections 415²⁵¹ and 463²⁵², says the offence of cheating²⁵³ or an offence of forgery is committed if the act of infringement or passing off someone's trademark is done without that person's permission.

c) Specific Relief Act, 1877{Act No. 1 of 1877}(as amended in 1963)

Besides IPC, 1860 the British Government again enacted another statutory law to protect interest of owner of trademark that is The Specific Relief Act 1877. It is interesting to know that the bill for the same was drafted by the experts of Chancery Law of England. Section 54 of the said Act deals with Perpetual Injunction. In view of this section, Trademark is considered as a Property. If any person misuses the trademark of a genuine owner then the genuine owner can bring injunction against such person, but in the first place the genuine owner's use of trademark must be truthful and sincere.

²⁴⁹ Sec.482 of IPC, 1860: Whoever uses any false property mark shall. Unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year or with fine or with both. Non-Cognizable, Bailable offence, Triable by any magistrate.

²⁵⁰ Sec. 486 IPC: Whoever sells, or exposes or has in possession for sale any goods or things with a counterfeit property mark affixed to or impressed upon any case package or other receptacle in which such goods are contained shall, unless he proves:

(a) That having taken all reasonable precautions against committing an offence against section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and

(b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or

(c) that otherwise he had acted innocently. Be punished with imprisonment of either description for a term which may extend to one year or with fine or with both. Non-cognizable, Bailable Offence, Triable by any Magistrate.

²⁵¹ Sec.415 IPC, **Cheating**; Whoever by deceiving any person. Fraudulently or dishonestly induces the person so deceived to deliver any property to any person or to consent that any person shall retain any property or intentionally induces the person so deceived to do or omit to do anything which he would not or omit if he were not so deceived and which act or omission causes or is likely to cause damage or harm to that person in body, mind, reputation or property is said to cheat.

²⁵² Sec.463 IPC, **Forgery**, Whoever makes any false document or part of a document with intent to cause damage or injury to the public or to any person or to support any claim or title, or to cause any person to part with property or to enter into any express or implied contract or with intent to commit fraud or that fraud may be committed, commits forgery.

²⁵³ Oxford Dictionary; The Oxford dictionary defines the word 'Cheat' as to trick somebody or 'to make somebody believe something which is not true'

Generally action under Passing off Law was inconvenient and difficult and also costly for the owner of trademarks. So also it was difficult and the owner was not successful in combating Infringement.

For the first time Bombay High Court made an observation about the Specific Relief Act in the case of *Re Century spinning& manufacturing Co Ltd Case*²⁵⁴ that even prior to the enactment of the 1940 Act of Trademark an action for infringement was maintainable by the proprietor of the mark and the court under Specific relief Act could grant an Perpetual Injunction and also said that under Section 54 of Specific Relief Act the Trademark is considered as Property²⁵⁵.

In *Commissioner of Income Tax v. Bombay Trust Corporation*²⁵⁶ the Supreme Court affirmed that the Specific Relief Act 1963 has substituted the earlier Specific relief act of 1887 after being repealed and now section 38²⁵⁷ of the 1963 Act is similar to section 54 of the 1887 Act.

After going through the most important statutory general law that includes protection and punishment for trademark infringement. Now let us verify specific law that directly deals with trademark. The first specific law dealing with trademark is Indian Merchandise Marks Act 1889 (IMMA).

d) The Indian Merchandise Marks Act 1889 [IMMA](Act No 4 of 1889)

IMMA Act was the first recorded legislation in India on trademark and the Preamble says that this is act which amends law concerning fraudulent

²⁵⁴ *Chunilal v. Mehta and Sons Ltd v. Century Spinning and Manufacturing Co. Ltd.* (AIR1962SC1314)

²⁵⁵ Chapter 10 Specific Relief Act 1877: Sec. 54: Perpetual Injunction granted when the defendant invades or threatens to invade the plaintiff's right to or enjoyment of property, the Court may grant a perpetual injunction.

²⁵⁶ [(1937)39 BOMLR 18]

²⁵⁷ Chapter 8 of Specific relief Act 1963, Perpetual Injunction granted when: Clause (3) of **Sec.38**: When the defendant invades or threatens to invade the Plaintiff's right to or enjoyment of property, the Court may grant a perpetual injunction.

mark²⁵⁸. This Act was passed by the British in India which covered Trademark issues in India on trademarks violation or

Infringement²⁵⁹. For the purpose of this Act Chapter 18 of IPC was amended and new sections were substituted from Sec. 478 to Sec. 479²⁶⁰. An amendment was also brought in the Sea Customs Act 1878.²⁶¹ Section 10 of the Sea Customs Act, 1878 was substituted as counterfeit trademark will be within the meaning as defined in IPC and false description will be within the meaning as defined in Indian Merchandise Marks Act 1889²⁶². In the case of *Ruppell v. Ponusami Teva*²⁶³ the accused was charged for an offence under the Indian Merchandise Marks Act 1889 of committing an offence of infringing the Trademark of the complainant. The Madras High Court barred the prosecution of the accused under Section 15 of the Indian Merchandise Marks Act.

e) The Sea Customs Act {Act 8 of 1878}

The Sea Custom Act here in after referred as 'Act', came into existence and working in 1878, April the first and the Act was referred and known as 'The

²⁵⁸ PREAMBLE: An Act to amend the Law relating to Fraudulent Marks on Merchandise. Where it is Expedient to amend the law relating to fraudulent marks on merchandise.

(1) This Act may be called the Indian Merchandise Marks Act 1889

(2) It Extends to the whole of British India

(3) It shall come into force on the first day of April 1889.

²⁵⁹ Indian Merchandise Marks Act 1889 [Act no. 4 of 1889]. Fraudulent Marks of Merchandise. **Sec.3** Substitution of new section for **Sec. 478 to 489** of 1889.] An Act to amend the Law relating to IPC (Indian Penal Code), Sec. 478 of IPC now reads as 'A mark used for denoting that goods are the manufacture or merchandise of a particular person is called a trade mark, and for the purpose of this code the expression 'trade mark' includes any trade mark which is registered in the register of Trade Marks kept under the Patents, designs and Trade Marks Act 1883 and any trade mark which is either with or without registration is protected by law in any British possession or foreign state....trade Marks Act 1889 for time being is applicable. **Sec. 480.** Using False Trademarks, **Sec.482.** Punishment for using a false trade mark or property mark, **Sec.483.** Counterfeiting a trade mark or property mark used by another. **Sec.485.** Making or possession of any instrument for counterfeiting a trade mark or property mark. **Sec.486.** Selling goods with a counterfeit trade mark or property mark. **Sec.487.** Making a false mark upon any receptacle containing goods. **Sec.488** punishment for false mark. **Sec.6.** Penalty for applying a false trade description. **Sec.7.** Penalty for selling goods to which false trade description is applied. **Sec.9** Forfeiture of goods. <https://www.wipo.int>

²⁶⁰ Sec. 3 of the Indian Merchandise Marks Act (IMMA) 1889

²⁶¹ Sec.10 The Indian Trade and Merchandise marks act 1889.

²⁶² Anamika Baduri, Trademark, National Law School Bhopal. <https://www.rsir.in>

²⁶³ [ILR22Mad 488] (The High Court of Madras held that as the complainant did not believe the use of the alleged counterfeited trademark had been discontinued after the first discovery and protest in 1883, prosecution of the accused in 1898 under section 15 of the Indian merchandise Marks act 1889 was barred)

*Sea Customs Act*²⁶⁴. The Governor General of India in Council passed this Act giving the assent to the same on March 8th which was applicable to entire British India.

Chapter IV of the Act speaks about the restrictions and also prohibitions on import and export.

Sec.18 (d) Prohibits import in British India of any sort of goods by route of land or by sea counterfeited trade mark goods or if the goods are having false trade description . Counterfeited goods means as per the meaning of IPC 1860 and false trade description as defined by the Indian Merchandise Marks Act.

18(e) Prohibition of goods which has been produced outside British India and United Kingdom here in after 'UK' and such goods are trademarked or named which are purporting to be the trademark or the name of dealer or manufacturer from British India or from UK but in reality it is not so and it is untrue.

The Indian Merchandise Marks Act 1889's Sec.10 (1) made a substitution of the above mentioned two clauses d, e of Sec.18 of the Act.

The Supreme Court in *East India Commercial Co. Ltd v. The Collector Of Customs*²⁶⁵ held and observed that if any person imports or exports goods in India which as per Chapter IV of the Sea Customs Act 1878 are prohibited then these goods shall be confiscated and the person committing such wrong shall be given an penalty.

The above mentioned Sec. 18 of the Act is similar to the reverse passing off concept wherein the infringer gives an impression that he is manufacturing or selling or dealing with goods as though these merchandise are of some else's.

²⁶⁴ The Sea Customs Act 1878 has been repealed b the Customs act 1962(52 of 1962)

²⁶⁵ 1962AIR1893, 1963 SCR(3)338

This shows that the Sea Customs Act 1878 played a vital role in prohibiting the infringement of trademark of people living in India during that era which clearly indicates that there was protection given to the producers and business merchants residing in India during British era.

f) Indian Registration Act 1908

The Indian Registration Act 1908 was a help to the trademark proprietors in the sense that this Act gave recognition to trademark by confirming its ownership by giving a declaration of the same to the trademark proprietor²⁶⁶. So the trademarks used to get some advantage for legal purpose to prove their ownership.²⁶⁷

In the case *Whirlpool Corporation v. Registrar of Trademarks*²⁶⁸ the Court While explaining the history of trademarks legislation observed that registration of the Trademark was secured by obtaining a declaration as to ownership under the Indian Registration Act, 1908.

After going through the development of trademark legislations dealing with the prohibition of infringement and passing off made in India before 1940, let us now witness the remarkable progress and development of trademark law after 1940.

2.7.2 Trade Mark Protection in India after 1940

Most important legislations were passed in India after 1940 which helped and contributed to the development of trademark law are as follows;

- a) *The Trademarks Act, 1940*
- b) *The trademarks (Amendment) Act 1941*

²⁶⁶ Sanjana Tripathy, "Registration of documents under the registration Act 1908".<https://www.spicyip.com>, visited 14th February, 2017 at 15.00 pm

²⁶⁷ Manu Sharma, 'History of Indian Trademark Law', Indian trademark law evolution over the years. A declaration as to the ownership of the trademark provided as registration under the Indian registration act 1908.

²⁶⁸ [1998(8) SCC1]

- c) *The Trademarks (Amendment) Act 1943*
- d) *The Trade and Merchandise Marks Act, 1958*
- e) *The Customs Act, 1962*
- f) *The Trade Marks Act 1999*
- g) *The Trade Marks Amendment Act 2010*
- h) *The Trade Marks Rules, 2017*

a) The Trade Marks Act 1940

The first statutory enactment passed by British Government in India on Trademark was the Trademark Act 1940.²⁶⁹ This Act was passed to resolve all the problems related to the trademarks which were based on the English Trademarks Act, 1938. This Act which was truly required by the business world due to increasing growth of trade and commerce in the economy. This Act covered only registration of goods and not services. The period of registration would remain for seven years²⁷⁰. The 1940 Act was similar to the United Kingdom's Trademarks Act 1938. This act came into force in 1942. This Act joined hand in hand with the Common Law' Passing off Action to protect the trademarks of the people. This Act had the provision for Registration of the trademarks in the Trademarks Registry which was established accordance with the enactment of the 1940 Act²⁷¹. This helped the commercial group to register the trademarks of the goods and also available statutory protection and Rights along with the rights under Common Law.²⁷²

²⁶⁹ The Trade Marks Act 1940 [Act NO 5 OF 1940 An Act to provide for the registration and more effective protection of trademarks] (Source: Commonwealth Legal Information Institute; <https://www.commonlii.org>)

²⁷⁰ Ch.3 Sec.18 (1) Duration and renewal of registration, 7 years.

²⁷¹ Irene G. R. Mosses. 2nd November 1946, 'The Law and Practice under the Trade Marks Act, 1940'; At a time when India is about to become self-governing and replace outside influences b Incite it is not uninteresting to note that only so recently as 1940 India adopted, almost entirely, the English law relating to the registration of trade marks. It is, however, somewhat startling to realize that a country with such strong commercial interests as India should have managed without registered trademarks until that date, and that traders were obliged to rely on cumbersome and expensive passing off actions to protect their name and goods. Apparently until after the First World War attempts at legislation in that direction met with only lukewarm encouragement, and it was out until the twenties that the matter received popular support from the Indian commercial public. <https://www.nature.com>

²⁷² Supra note. 200

In the case of *B.S. Ramappa and anr v. V. B. Monappa and anr*²⁷³ in the year 1921 Father (of appellant and respondent) coined the trademark '*Taj double bavta mark*' the meaning of *bavta* is flag in Marathi. Father passed on the business to elder son Monappa who was carrying on the business successfully using the same trademark. In the mean time the younger son managed to get the same trademark of his father registered in his own name falsely under the Trademarks Act 1940 in his own name. The judge held that registration was obtained fraudulently by the younger son and came up with a decision that the registration of this trademark will be under both brothers name and both will be joint owner of this mark.

As per Sec. 20(1) of the Act which is one of the interesting provision states that even an unregistered trademark owner could file infringement suit provided such mark was in use since 25th February 1937 by such unregistered trademark owner or by the predecessor of such unregistered trademark and who provided evidence in the registry within five years coming of this Act in force can make an application to the Registrar for registration²⁷⁴.

Sec. 25 of the Act recognised and saved vested rights of the Prior User and could not be sued even by the registered proprietor even if such marks were unregistered.

Further the Act allowed both the registered as well as unregistered trademark owner to assign and transmit the trademark with or without goodwill.

²⁷³ AIR 1970 Mad 156

²⁷⁴Sec. 20(1) of Trademark Act 1940:No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark unless such trade mark has been continuously in use since before the 25th day of February,1937 by such person or by a predecessor in title of his and unless an application for its registration made within 5 years from the commencement of this Act, has been refused and the Registrar shall on application in the prescribed manner grant a certificate that such application has been refused.

Sec. 38 of the act recognizes the right of well known trademark owner and hence allows such proprietor to do defensive registration of such well known trademark in other classes too.

Sec. 46 and Sec. 47 of the Act provided for Rectification or correction could be done either by filing application in the High Court or to the Registrar.

The Act had a special provision in case of textile goods for which a special branch was instituted in the Bombay trademarks registry to undertake the registration of the textile goods.

Furthermore in this Trade Marks Act 1940 there was a provision for passing off action in Sec. 20(2) which says that nothing in this act will affect the right of action against any person for passing of his goods as the goods of someone else²⁷⁵. This means that the Prior User either un- registered or registered could avail the remedy under the common law, the right to file a passing off suit in the case of Infringement of the genuine trademark. The most important advantage was that if there would be an infringement then the trademark owner could utilize two different types of remedies, he could file a Statutory Infringement suit and also can take a Passing off action against the infringer and this truly helped the business people to protect their reputation and goodwill of their brand name.

²⁷⁵ Trade Marks Act 1940: Ch.1. Preliminary, **Sec.3.** Application of other laws not barred , Ch.2. Register and conditions for Registration (Distinctiveness requisite for registration), Limitation as to colour or deemed to be registered for all the colours , prohibition of certain marks, use of names of chemical elements barred, identical/similar mark prohibited, registration of parts of trademarks and of trademarks as series, Associated trademark provision. Ch.3 Procedure and duration of Registration, Jointly owned trademarks Ch.4. Effect of registration, **Sec.20** (1) No action for infringement of unregistered trademark. **Sec.20** (2) Provision for passing off action **Sec.21.**rights conferred by registration (The exclusive right to se of trade mark in relation to those goods. **Sec.25.** saving for vested rights of Prior User. Ch.5.**Sec..28.** Assignment and Transmission of trademarks and give effectual receipts of the same.Ch.6. Use of Trademarks and Registered users, defensive registration of well known trademarks, **Sec.39** (1) Registered Users. Ch.7. Rectification and Correction of register. Ch. 8. Certification trademarks Ch.9. Special provisions for textile goods. Ch.10. Offences and Restraint of Use of Royal Arms and Emblems. Ch.11. Miscellaneous

b) The Trademarks (Amendment) Act 1941 {Act No. 27 of 1941}

The Amendment of the 1940 Act was brought by this Amendment Trademarks Act of 1941 herein after referred as the Act to introduce certain required changes and insertion of certain provisions in the Act, for improvisation of the same.

Sec.4; Instead of the word 'trade mark registry' the 'trade Marks Registry' were inserted.

Amendment of Sec. 53 of 1940 act was brought by this new Act where after the following words 'to the Registrar', the words 'or the Bombay Registrar as the case may be' were introduced.

In Sec.63 a novel section was brought by bringing in Bombay a separate Registry of trademark and this registry was introduced in order to facilitate trade mark registration of the textile goods and this move was to encourage the registration of the same and a register shall be maintained by a officer appointed by the Central Government and this officer so appointed shall be called the Registrar of textile trademarks at Bombay who will be referred as the Bombay registrar according to the amended act of 1941.

If there is any conflict arising between the Bombay registrar and the registrar due to the jurisdictional issues then the Central government will give the direction to resolve the same and also to dispose of the case.

So we see here two registrars, one is the registrar and the other one is the Bombay registrar and both are required to keep transparency in their working by sharing the records maintained by them in relation to the registration of textile goods . If any trademarks are refused for registration then both shall enter the same in their respective register which shall be open for public inspection subject to certain conditions.

c) The Trademarks (Amendment) Act 1943 {Act No. 15 of 1943}

The Trademarks Act 1943 (Amendment) Act here in after referred as the 'Act' was passed to further amend the Act of 1940. By bringing the amendment certain changes were introduced for better administration and functioning of the Act.

Sec.4. of the 1940 act was amended and 'at Bombay' was inserted in the place of 'The controller of patent and Design'

The provision was made as regards the appointment of Deputy Registrar of the trademarks by the Central Government and the Registrar shall exercise Superintendence and direction on such Deputy Registrar so appointed.

Trade Mark Registry seal was provided by this amendment to the registry.

By inserting a novel Sec. 4 (a) Trademark registry branch was started in Calcutta for the purpose of encouragement in registration of trademarks.

Sec. 64 was substituted by new provisions where in some required restriction on textile goods were inserted in the section like registration of line heading will not be considered so also registration of certain numeral or letters or even the combination of the same shall be permitted in subject to certain conditions of registration under the Act.

Sec.65 of the 1940 Act was substituted with new section and introduce 'refused textile marks list' and this was for maintain the trademarks refused by the register due to certain condition and such entry in this register will be maintained by the trademarks registry which shall be open for inspection by the required public .

There were also certain omissions made of certain terms and words which were not required by this amendment.

In Sec.69. of the Act a immunity was provided to the proprietor of trademark which is having or contains any title to emblem, device arms , shall not be affected by this section and he will continue to use the same as his rights will not be affected .

Sec. 74(A) which is a new section was inserted and made provision as regards the cost of Registrar as to the High Court proceedings which will be the discretion of the High Court but the registrar will not be told to pay cost of parties.

Sec.84 was newly added by this amendment which reads as any proceeding at patent or at Bombay registry will be considered to have taken place at Trademarks Registry.

The next statutory legislation which was made in India after 18 years and also after India's Independence is The Trade and Merchandise Marks Act 1958. In between the Act of 1940 and The act of 1958 only two amendments were passed by the legislature.

d) The Trade And Merchandise Marks Act 1958

The reason for passing the Trade and Merchandise Marks Act 1958 was due to the need for development of trade and commerce and all businesses hence it was necessary to review the Trademarks Act 1940, though it served its purpose. After conducting the review the trademarks enquiry committee in 1958 gave the Lok Sabha its report but in the report contains different point of view and standpoint on most of the vital and principal matters. Because of this reason the Government of India made a request to review the same to Sir Justice Raja GopalaIyengar, who made certain important recommendation which forms the foundation of the Trade and Mercantile Act 1958. It provided for registration and better protection of trademarks, it made substantial alteration in the previous law of 1940 and consolidated in one piece, the Indian Merchandise

Marks Act, 1889 and other trademark related provisions this Act came in force on November 27th in the year 1959. It was amended a number of times. The same 1958 Act was extended to Goa, Daman and Diu by Regulation from 1st November 1964. Goa got liberated from Portuguese rule in the year 1961²⁷⁶.

The following are the most significant features of the Act of 1958. They are;

a. Exclusive usage on registration: This Act provides for Registration of the trademark only for goods under its Registry for the proprietor of trademark.

b. Protection to the proprietor of the trademark: 1958 Act safeguards the interest of the proprietor, once registered by prohibiting and stopping the infringer from committing such an offence by providing remedy to the

²⁷⁶ The Trade and Merchandise Marks Act, 1958[Act NO. 43 of 1958(17th October, 1958)]. An Act to provide for the registration and better protection of trademarks and for prevention of the use of fraudulent marks on merchandise. Ch.1.Preliminary. Ch.2.The Register and Condition for Registration. **Sec. 4(1):** The Central Government shall appoint Controller General Of Patent Design and Trademark who shall be called the Registrar. **Sec. 5(1) :** For the purpose of this Act there shall be established a Registry which shall be known as the Trade Marks Registry. **Sec.6.Register Of Trade Marks. Sec.8.** Registration to be in respect of particular goods. **Sec.10.** Limitation as to colour. **Sec.11.** Prohibition of registration of Certification Marks.**Sec.12:** Prohibition of registration of identical or deceptively similar trade marks.**Sec.13:** prohibition of registration of names of chemical elements. **Sec.14.** Use of names of living persons or persons recently dead.**Sec.15.** Registration of parts of trademarks and series.**Sec.17.** Registration subject to disclaimer. Ch.3. Procedure For and Duration of Registration. **Sec.18.** Application for registration. **Sec.20**Advertisement of application 3 months, **Sec.21 (1):** Opposition to registration within 3 months of advertisement.**Sec.24 (1) :** Jointly owned trade mark. **Sec.25.** duration, renewal and restoration of registration; the registration shall remain in force for a period of 7 years which can be renewed accordingly.**Ch.4.Effect Of Registration , Sec.27(1)** No action for infringement of un-registered trademark. **Sec.27 (2):** Nothing in this act shall **footnote276continued** : affect or prevent an right of action against any person for passing off goods as the goods of another person or the remedies in respect thereof. **Sec.28.**Rights conferred by registration. **Sec. 29(1)** Infringement of trade marks.**Sec.33.** Saving for vested rights. No action will be taken on prior user by a registered trademark proprietor r registered user. **Sec.34.** Savings foe use of name, address or description of goods. **Sec.35.** Savings for words used as name or description of an article or substance. Ch. 5. Assignment and transmission **Sec.36.**power of registered proprietor to assign and give receipts. **Sec.37.** Assignability and transmissibility of registered trademark with or without goodwill of business. **Sec.38.** Assignability and transmissibility of unregistered trademark is possible only with goodwill of business not otherwise.**Sec.44.** Registration of assignments and transmissions. Ch.6.Use Of trade Marks and Registered Users **Sec.45.** Proposed use of trade mark by company to be formed.**Sec.46.**Removal from register and imposition of limitation on the ground of non-use.**Ch.7.** Rectification and Correction of The register. **Sec.56** Power to cancel or vary registration and to rectify the register. Ch.8. Certification Trade Marks Ch.9. Special Provisions For Textile Goods. Ch.10. Offences, Penalties And Procedure. **Sec.77 (1):** Falsifying and falsely applying Trade Marks. **Sec.78.** Penalty for applying false trademarks, trade descriptions, etc.**Sec.79.** Penalty for selling false trademark / trademark description goods. **Sec.81.** Penalty for falsely representing a trademark as registered. **Sec.82.** Penalty for improperly describing a place of business as connected with the trade Marks Office. **Sec.85.** Forfeiture of goods .**Sec.88.** Offences by Companies. **Sec.94.**Punishment of abetment in India of acts done out of India. Ch.11. Miscellaneous.

proprietor of the trademark to take an infringement action, further any type of a fraud or deceit can be prevented and stopped.

c. Passing off action: The Act of 1958 contains a separate provisions under *Section 27(2)* states that nothing in this Act would affect the right of action against any person passing off his goods as the goods of someone else or the remedies in respect in respect of the same.²⁷⁷

Besides the above direct enactment to protect the infringement of trademark, there was one more enactment which does not directly deals with trademark but it contains few provisions that prohibited entry of infringing trademark in import and export of goods.

e) The Customs Act 1962{Act 52 of 1962}

The Customs Act 1962 here in after referred as ‘Act’ came in existence legally in the year 1963 February the 1st. This is the first custom Act which was enacted after India’s independence which repealed the then Customs Act of 1887 enacted by British India during British rule in India.

This Act also like the earlier Customs Act provided to prohibit import and export of goods those infringed the trademarks in India.

The Customs Act 1962 prohibited Importation of Goods which infringed the Indian trademarks and empowered the authorities to seize and take into custody such goods²⁷⁸. The Custom Act 1962 empowered the Central Government to prohibit either import or export of any goods for the purpose of protection of

²⁷⁷Sec. 27(2) of the 1958 act is similar to Sec.20 of the Trade Marks Act 1940 but only with the exception to the protection for old trademarks i.e. In Sec.20 of the 1940 Act the proprietor of the old trademark which is unregistered could file infringement suit complying to certain rules and the same provision was excluded under Sec.27 of the 1958 Act.

²⁷⁸ Customs Act 1962: Sec. 11 of the Act empowers the Central Government for the purpose mentioned in section 11(2) to prohibit import or export of goods. For e.g. the compliance of imported goods laws which are applicable to similar goods produced or manufactured in India. Protection of patents, trademarks and copy rights, prevention of deceptive practice, implementation of any treaty, convention with any country, any other purpose conducive to the general public.

trademark, copyright, patent rights. Under Sec.111 and 113 of the customs act, the Customs has power to confiscate goods those were either imported or exported improperly in India²⁷⁹.

In the past couple of times the Central government under Sec.11 of the Customs Act has issued notification for the prohibition of importation of infringing goods. In the year 1964 the central government issued a notification in order to prohibit import of goods with false trade description as well as having false trade mark and also involved passing off of the trademark.²⁸⁰ During this period the Customs act 1962 came to the rescue of genuine trademark proprietor by helping them to take an action on the trademark infringers and stop infringement of the genuine trademarks.

The Calcutta High Court in *Bank Of India and anr v. The National Iron and steel Co.*²⁸¹ held that even if Sec.11 is not applicable but a liability can be imposed independently by Sec.111 of the Customs Act 1962.

Act of 1958 was repealed taking in to account the changing conditions a global market level and the Indian Parliament introduced a new legislation in 1999 to protect interest of proprietor of trademark.

f) The Trade Marks Act 1999

India enrolled its membership in World Trade Organization (WTO) in 1995. With increasing globalization and the spate of multinational corporations and to fulfill the obligation under Trade Related Aspects of Intellectual Property Rights (TRIPS) the Trademark, Act, 1999 was enacted²⁸².

²⁷⁹The Proprietary . The Commissioner Of Custom [W.A. No.956 of 2011]

²⁸⁰ Jayant Kumar, Enforcement of Intellectual Property Rights through Customs. <https://www.mondaq.com> 2nd June, 2009

²⁸¹ AIR1973Cal354

²⁸² The Gazette Of India, Part 2, Published by Authority [No 60] New Delhi, Ministry Of Law, Justice and Company Affairs .Legislative Department. New Delhi, the 30th December, 1999/PAUSA 9. 1921(Saka) THE TRADE MARKS ACT 1999, No 47 of 1999. 'An act to amend and consolidate the law relating to trademarks, to provide for registration and better protection of trademarks for goods

The Trademark Act 1999 came into existence in the year 1999 and World Trade Organization had given recommendation for the same in order to be in compliance with TRIPS Agreement. This Act of 1999 replaces the Trade and Merchandise Act 1958. Act of 1999 was anytime a development and improvement over the 1958 Act. The Trademark Act 1999 came into force in the year 2003 on 15th September by repealing the Trademark Act 1958 which has transformed and brought a great difference and change in the trademark law in our country India. Later on in the year 2012 there came into existence Trademark Rules 2012 which were repealed in the year 2017 and right now the governing rules are Trademark Rules 2017. First let us look into the objectives of the t of 1999.

Objectives of Trade Mark Act 1999:

- 1) The Object of the 1999 Act is to confer the protection to the owner and user of the trademark for his goods by registration. By protection it meant a much better, than all the previous legislation.²⁸³

- 2) Provision of legal remedies for enforcement of trademark rights and for the prevention of the use of fraudulent marks trying to infringe the genuine trademark in different ways²⁸⁴.

‘Trademarks Act 1999(as amended in 2010) and the Rules of 2017 Administers and regulates the statutory trademark law in India which is presently in force²⁸⁵.

and services and for prevention of the use of fraudulent marks’ The Trademarks Act 1999 comprises of 9 Chapters ;

Chapter I. Preliminary, Chapter 2. The Register and Condition for Registration, Chapter III. Procedure For And Duration Of Registration, Chapter IV. Effect Of Registration 4(A) Special Provision Relating To Protection Of Trade Marks Through International Registration Under The Madrid Protocol. 5. Assignment And Transmission 6. Use Of Trade Marks And Registered Users 7. Rectification and Correction of the Register 8. Collective Marks 9. Certification Marks. <https://www.ipindia.nic.in>

²⁸³ The Objective of the Trade Marks Act 1999 is to register trademarks applied for in the country and to provide for better protection of trademark for goods and services and also to prevent fraudulent use of the marks . <https://www.ipindia.nic.in>

²⁸⁴ B. L. Wadehra, *Patents, Trade Marks, Copyrights Designs & Geographical Indications*, 3rd E.d. 2006, Universal Law Publishing Co. Pvt. Ltd. Delhi. P. 214 to 217

²⁸⁵ Venkateshwaran, *Trademarks & Passing Off*, 6th E.d. 2015, LexisNexis, Gurgaon Haryana, at P.1009, 1078, 1336.

Features of Trademark act 1999(No 47 of 1999)30th December 1999.

Though this Act was passed in 1999 by receiving the President's assent to the same and the Rules were approved in the year 2002, but the Act came into force in the year 2003 on September the 15th²⁸⁶. The trademark Act 1999 is in much aspect same like the trademark Act of the United Kingdom so far as the approach is concerned²⁸⁷.

- 1) **Concept of Service Mark** : This concept was first time introduced in the act of 1999(Rules 2002) by providing the registration of the mark related to services which means the service sector now can register their mark under the act of 1999 trademark and avail protection for the same which is a Novel step in the legislation²⁸⁸ as earlier the service marks were protected by filing an passing off action and other laws prevailing in India like IPC etc .
- 2) **Sec.29: Infringement**: definition of infringement under the Act of 1999 has been given a broader meaning to cover different forms of infringement by envisaging different kinds, types and ways the infringement of trademark/ service mark could take place. This in turn will help the genuine trademark proprietor in enjoying her or his proprietary rights in the trademark.
- 3) **Single and simplified Register**: is now maintained by the Registry at Mumbai for smooth and simple procedure and functioning²⁸⁹.

²⁸⁶V.Ramu & V. Anuradha <https://www.vramu.com>

²⁸⁷ In *Registrar of Trademarks v. Ashok Chandra Rakhit Ltd* (1955)2S.C.R. 252,p.259;AIR1955SC558 (It was held by Supreme Court that ‘‘ As the law of trademarks adopted in our Act merely reproduces the English law with only slight modifications, a reference to judicial decisions on the corresponding section of the English Act is **apposite** and must be helpful’’ At the same time conditions peculiar to India must be borne in mind in applying any doctrine of English law, and that English decisions which turn or partly turn on questions of fact can only be applied with care and circumspection. The general principle founded as it is on justice and equity is the same in both countries. The English cases may be instructive as showing the way in which such a question should be approached, but the actual decision depending as they do on what purchasers would be likely to think in England are not a guide in India.

²⁸⁸ Sec.2(2)(z) of TM Act 1999(Rules 2002)

²⁸⁹ Sec.9(1)(a) of TM Act 1999(Rule 2002)

- 4) Wider/Broader definition of Trademark/Service Mark:** According to the trademarks Act 1999, even shape of the goods and packaging can be registered as a trademark. So also there is a scope for inclusion of some more concepts to consider it as trademarks though it is not expressly mentioned in the definition of the Act²⁹⁰.
- 5) Well-Known trademark concept introduced:** This act has defined the concept of 'Well-known trademark' and has also given better protection to the same²⁹¹. This Statute will take into consideration that if any attempt is made to register a mark by imitating a well known trademark, such registration will not be done on the basis of established refusal grounds²⁹².
- 6) Abolishment of defensive registration:** Defensive registration which was provided by the 1958 act is no more available in the Act of 1999 and any such earlier registration will lapse after 5 years of the coming in force of the present Act or will lapse on the expiry of such marks registration period, whichever takes place earlier²⁹³.
- 7) Renewal period enhanced:** Earlier the renewal period of trademark registration was 7 years where as now it has been made 10 years as per the Act of 1999²⁹⁴. This means that the registration validity will remain in force for 10 years which means that the new Act has given more extra 3 years compared to all the previous acts in India.
- 8) Single Application for Multiple Trademarks:** Under the new Act of 1999, it is now allowed to register one mark for different or multiple

²⁹⁰ Sec.2 (2)(zb)of the TM Act 1999.

²⁹¹Sec. 2(1)(zg)of the TM Act 1999.

²⁹² Sec.9, Sec.11 of the TM Act 1999; Refusal grounds.

²⁹³ Sec. 159 of TM Act 1999; defensive registration under Sec 47 of the TM Act 1958 will cease to have effect...

²⁹⁴ Sec.25 of the TM Act 1999

classes just by filing a Single Application²⁹⁵. This made the trademarks registration process faster and convenient as the proprietor does not have to do the formality of filing different application forms separately.

9) Registered User: Under the TMA 1999 the registered user can now register them easily due to the simplified registration system and procedure established by the Act of 1999²⁹⁶.

10) Collective Mark: The Association who are proprietors of Collective Mark can now register their mark under the provision of the Trademark Act 1999²⁹⁷.

11) IPAB (Intellectual Property Appellate Board) Under the Act IPAB was constituted which hears the appeal arising from the decisions of the Registry in cases of opposition, Registration etc²⁹⁸. So also the IPAB²⁹⁹ hears and decides Rectification proceedings filed by the parties to remove the registered mark which is not genuine and prior in usage. Earlier Act had empowered the High court in such matters but the new Act of 1999 has given this authority to the IPAB, so also the all the cases pending in the High Court shall be transferred to the IPAB³⁰⁰.

12) Criminal Remedies /Action: can be instituted under Sec. 103 to Sec.105 of the Trademarks Act 1999. The Act as made these offences cognizable.

13) Assignment and Transmission by Unregistered Proprietor: The present Act permits the unregistered trademarks owners to assign and transmit their trademarks with or without the goodwill of the business as

²⁹⁵ Sec.18(2) of the TM Act 1999

²⁹⁶ Sec.49 of the TM Act 1999

²⁹⁷ Sec. 61 to Sec. 68, Chapter 8 of the TM Act 1999.

²⁹⁸ Sec. 83 to Sec.100 of the TM Act 1999

²⁹⁹ K.C. Kailasam, *Law Of Trademarks* (3rd E.d.2013, LexisNexis, Gurgaon, Haryana.)P. 735,740.

³⁰⁰ Sec. 100 of the TM Act 1999

compared to the earlier Acts which allowed assigning or transmitting only with business goodwill³⁰¹.

14) Classification of goods and services at International level: has been followed by the 1999 Act³⁰². India is following NICE classification of goods and services, which is International and which was formed by a Agreement, 'NICE' in the year 1957³⁰³.

15) Exparte-Injunction: The court in certain cases may grant an Exparte injunction under Sec.135 (2) of the Act 1999³⁰⁴.

16) Trademark Act 1999 brought amendment in the Companies Act: In order to stop any person using another's trademark to form a company or enterprise, an amendment has been brought in Sec.20 and Sec.22 of the Companies Act by the trademark Act under Sec.158³⁰⁵.

g) Trademark Amendment Act 2010[40 of 2010]

Trademark Act 1999 was amended by the amendment Act of 2010 as there was a need felt for developing the trademarks law at an International level

Some of the important features and reasons to bring such an amendment was for the following:

- I. **India to become member of protocol of Madrid** so that India can avail the advantage if International registration of trademarks and this was the decision of the Government of India.

³⁰¹ Sec. 39 of the TM Act 1999

³⁰²Intepat Team, Sec.7of the TM Act 1999 provides that the Registrar shall classify goods and services in accordance with the international classification of goods and services for the purpose of registration of trademarks. <https://www.intepat.com> July 28 2016.

³⁰³ WIPO: Nice Classification, <https://www.wipo.int>

³⁰⁴ In *Satish Kumar Garg v. M/S Garg Agency* [Suit. No: 105/2005 (29 Nov 2007)] The Court passed an *Exparte judgment* under Sec.134; Suit for Infringement etc) and Sec. 135; relief in suits for infringement of the 1999 Act.

³⁰⁵ As indicated in the schedule under Sec.158 of the Trademarks Act 1999. Also see Sec. 27(5) which enacts that such use will constitute an infringement of a registered trade mark under the Act.

- II. **Protect of the trademark internationally** by availing registration under the protocol of Madrid.
- III. **Fixing a specific time limit of 4 months for filing of opposition** and taking off the discretion given to the registrar in deciding the time of the opposition period.
- IV. **Sec.45: Registration of the Trademark Assignment** process was made simple and quick in order to facilitate such registrations.
- V. **Complete omission of chapter 10:** This chapter contained special provisions in the matter of textile and since this was not necessary at this stage and it had already served its purpose during that time, the same was omitted by this amendment Act 2010.

h) Trademarks Rules 2017

Trademark Rules 2017 came into force since March 6 of 2017 in order to bring simplicity in the procedure of registration system and bring a positive change in its administration most importantly by Digitization³⁰⁶ and E-filing. Taking into consideration India's Commitment to the TRIPS agreement 2017 Rule³⁰⁷ have been framed by the legislature of India. Accordingly the Act 1999(as amended in 2012) has been made in compliance with the International Standards.

Features of this Trademarks Rules 2017

- i. **Registration of 'Sound Marks' and other Non-Conventional Trademarks:** Like Colour mark, Smell mark has been represented in

³⁰⁶ Oxford Dictionary <https://en.oxforddictionaries.com>

³⁰⁷Shreeja Jain, New Delhi: 'Experts Welcome New Trademark Rules', ; The Union Government's new trademark rules, notified on Monday, are lauded by practitioners and experts as a step in the right direction . The rules focus on larger number of digital filings and reducing procedural steps b bringing down the number of forms from 74 to 8 . The rules also bring about clarity in the process of registering a mark as a 'Well-Known Trademark' Experts and practitioners have found this change to be positive as it will allow bigger brands especially one with trans-border reputation, to file applications claiming that they have achieved the standing of Well-Known mark . "At an elementary level, it makes a lot of difference because now you'll have to recognize trans-border reputation and well-known marks in other jurisdiction" said Dev Robinson, Partner and National practice head for Intellectual Property Rights, ShardulAmarchand Mangaldas & Co a Law Firm. <https://www.livemint.com> 8th March, 2017. 08:06 P.m.

this Act and certain criteria has been established to determine the same graphically³⁰⁸.

- ii. **3D Marks are made registrable:** Shape of goods and packaging in Form TM-A³⁰⁹.
- iii. **On-Line Application:** In this rule introduction of online filing of application to register trademark/service mark was undertaken³¹⁰.
- iv. **‘Well Known Trademarks’ determination procedure was established:** as well known Trademark concept has been given importance and recognition and has also set up an criteria for its registration and protection and has been given immunity to file Infringement proceeding on the infringing marks even if they represent different goods and services³¹¹. E.g. TATA is a well known trademark which cannot be used for goods and services even if they are not produced by TATA like no one can manufacture pens or pencils or razor or garments in this name being a well known trade mark. It is interesting to note that DPIIT will keep a record of well-known trademark/service mark records at its end³¹². This will definitely improve India’s status in protecting world famous marks³¹³.

³⁰⁸Intepat Team Sound Mark Application; such application has to be filed on form TM-A with the sound in Mp3 format and also provide the musical notes in the application. www.mondaq.com

³⁰⁹Ibid: File in Form TM-A

³¹⁰Supra (Note: 225) 10% discount is given for the applicants as incentive to encourage them and also go paperless.

³¹¹ Rule 124; Under form TM-M, any person can make request to enlist a mark as well-known along with statement of case, document and evidence with one lakh fee.

³¹² Times of India : Mumbai , LubnaKably TNN, March 8 2017, *India Inc Can Now Register Trademark As ‘Well-Known’* : In a significant development, the Trade Mark Rules 2017 – which were notified on March 6th – permit

companies to apply for their Trademarks to be recognized as a ‘Well known’ one .In simple terms, a well known trademark is one that is well recognised and any infringement could result in misleading the public .Prior to this notification, an trademark was held as ‘well-known’ b the courts only consequent to a dispute regarding its use, such as when another party applied for registration of the same or similar trademark.

“While many Indian Companies who have already registered their trademarks will continue to get protection against the registration of conflicting marks, the rules will be boon to foreign Companies that do not have a registered trademark in India but at the same time wish to protect themselves . at times entry of some of some companies may be restricted . Yet through the process of registration of ‘Well-Known Trademarks’, it will now be easier for the publication to protect its globally recognised trade name. This should also reduce the cost of opposition as the registrar will cite the registered ‘Well-Known Trademarks’ as conflicting marks to subsequent applications “ explains Gowree Gokhale, partner and head of IPR practice at Nishith Desai associates .

³¹³Supra(note:228) Earlier India had a poor score in protecting well-known trademarks.

- v. **Benefits for Small and Start-ups business enterprises:** TM Rules 2017 has been provided concessions for registering their marks³¹⁴.
- vi. **Registration procedure can be expedited:** Under the new Rule of 2017 the registration procedure and process can be done in an expedite manner by paying extra fee which will quicken the process of examination followed by hearing a lastly registration³¹⁵. But this facility is available only on online registration and not otherwise.
- vii. **Reduction in Forms:** As the forms required for the process of registration earlier 74 forms were required but now only 8³¹⁶.
- viii. **Hike in fee structure:** The fees has been increased to Rs.9000 which was 4000 Rs. Earlier.
- ix. **Email considered as a Service mode:** This is a huge development as applications and other documents can be emailed to the Trademark Registry³¹⁷
- x. **Less Adjournment:** The new rules under number fifty number rule has reduced the adjournments to a great extent which will expedite the opposition proceedings³¹⁸.
- xi. **Compulsory filing of User Statement :** This Statement will contain the details of the use of the trademark by the applicant/proprietor of trademark³¹⁹

³¹⁴ Supra note. 225; for start-ups, Rs.5000 for physical filing and Rs. 4500 for e-filing and for others Rs. 10000 for physical filing and 9500 for e-filing.

³¹⁵ Ibid, Rule 34; DIPP extended the provision relating to expedited processing of application for registration of trademark up to registration stage which so far was available up to examination stage.

³¹⁶ Supra note. 225: All kinds of trademarks application whether single class, multiclass or collective marks, they are filed through the same form.

³¹⁷ Rule 14(2017) reads as (1) Applications may be delivered by hand or sent through the post by prepaid letter or may be delivered by hand or sent through the post by a prepaid letter or may be submitted electronically in the manner as laid down by the Registrar.

(5) The Registrar after informing the public in the journal may accept applications or other documents online through the gateway provided for this purpose or in case of documents not requiring the payment of a fee Through email to a designated email address for the purpose'[Rule 18(2017) also talks about E-mails(Service of Documents by the Registrar)]

³¹⁸ Rule 50(2017) says ; 'No party shall be given more than two adjournments and each adjournment shall not be for more than thirty days '

³¹⁹ Rule 25(2017) reads as (1); "An Application to register a trademark shall, unless the trademark is proposed to be used, contain a Statement of the period during which and the person by whom it has been used in respect of all goods or services mentioned in the application .

- xii. Opposition Filing Indian as well International Registration:** There have been remarkable changes brought in Opposition filing and hearing by the New Rule of 2017 which will help the Registry to decide the cases as early as possible³²⁰.
- xiii. Online Search engines:** are also available on the website of the Trademark Registry in which the interested parties can search the name or device of any product or services before choosing any mark for the purpose of Registration. So also the Journal of trade or service mark can also be viewed on the website of the Trademark Registry.
- xiv. Filing Of Evidence gets no Extension:** Under the new rules while filing evidence one does not get Extension and this truly helps to expedite the matter as early as possible³²¹.
- xv. Video Conferencing:** Concept has been introduced for Hearing which is very convenient for people who are from far distant places³²². So also this is approach is more cost effective and time saving³²³.

Conclusion

Thus the whole Trademarks Act, 1999 has come long way to protect Trademarks. It had removed the inconvenient provisions of the old acts and has fostered the rights of the traders and other service providers significantly. It has

(2); "In case the use of the trademark is claimed prior to the date of application, the applicant shall file an affidavit testifying to such use along with supporting documents."

³²⁰ 2017 Rules defines opposition as 'Opposition means an opposition to the registration of a trademark or collective trademark or a certification trademark as the case may be and include an opposition to grant of protection to an International registration designating India and opposition to alteration of registered trademark'

³²¹ Rule45(2017) reads as "If an opponent takes no action under sub-rule(1) within the time mentioned therein, he shall be deemed to have abandoned his opposition "

The same reasoning holds for 'Evidence in support of Application' (Rule46(2017))

³²² Rule115(2017) reads as 'Provide that the hearing may also be held through video-conferencing or through any other audio-visual communication devices and in such cases the other audio-visual communication devices and in such cases the hearing shall be deemed to have taken place at the appropriate office . 'hearing shall be deemed to have taken place at the appropriate office . '

³²³ Video Conferencing System: Office of CGPDTM has introduced the Web Video Conferencing System with the help of which Applicants/ Authorized agents can conduct structured meetings/hearings. As a result improved communications, participants are more in sync, decisions are able to be made faster and productivity increases. The Activity Aims to :

a) Strengthen the existing Hearing System
 b) Reduce distance barriers, time & efforts
 c) Improve communication and discussions. <https://www.ipindia.nic.in>

also catered the development in the trading and commercial practices, increasing globalization of trade and industry, the need to encourage the investment flows and transfer of technology, need for simplification and harmonization of trademark management system and give effects to important judicial decisions. Since India as a member has signed International treaties and Conventions like Paris Convention and TRIPS Agreement India had to bring the trademark legislation in par with these International Commitments.

Government Role has played a very Positive Role in upgrading and developing the Registry and other offices by Modernizing and Computerizing the same which has to be truly applauded by the Businesses in India for extending such a Cooperation and Support.

CHAPTER III

**CRITICAL ANALYSIS OF
INFRINGEMENT AND PASSING
OFF WITH REMEDIES**

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3.1 INTRODUCTION

In general context the term Infringement, we mean breaking, violating or contravening some rule or Law or disobeying the same. When we use the term infringement in context to trademark or service mark it simply means that one person is using the trademark of someone else without that person's permission in order to sell goods or to give or provide any service for monetary gains. Here we see that such person i.e. the infringer has not broken any terms of agreement or has not disobeyed any authority but has trespassed someone's intellect, idea or creativeness and is trying to gain monetary advantage at the cost of genuine trademark proprietor. In other words infringement is a sort of trespass on a person's intellectual property which is intangible in nature. So also unfair advantage taken of someone else's trade name/mark also amounts to infringement.³²⁴ Unauthorized usage of trademark owned by others gives rise to infringement.³²⁵ Violation and Infringement of Rights of trademark owner in India and other Nations are happening in two was, they are;

A. Infringement of Registered Trademarks®

B. Infringement of Un-Registered Trademark™

We have to understand that in the above both cases the right of action varies, which means that in the former case the proprietor of the trademark can sue the infringer by filing a *Infringement suit* under the Trademarks Act 1999 as amended in 2010 here in after referred as 'the Act' which is the Governing Law on trademarks in India, so also if any person has applied for registration of a

³²⁴ Institute of Company Secretaries of India, *Intellectual Property Rights Law and Practice*, Module 3, 2013, Tan Prints, Delhi.

³²⁵ Dr M.K. Bhandari, *Law relating To Intellectual Property Rights*, (3rd Ed. 2012, Central Law Publication, Allahabad) p. 193.

trademark which is conflicting with the registered trademark of such proprietor the proprietor can oppose such conflicting trademark in the Trade Marks Registry by filing an opposition application and stop it from getting registered but in case if the conflicting mark gets registered or is already registered then the genuine proprietor who is prior in use of such mark can file an rectification application in the IPAB and remove such conflicting mark from the register of trademark/service mark by cancellation of the same so also such registered trademark proprietor can simultaneously take a Common law action by filing a *Passing off* suit under the law of tort.³²⁶

Whereas in the later case, the proprietor can take an action only under the common law by filing an passing-off suit, as such a proprietor cannot file an infringement action under the Act for the reason that such proprietor's trademark is not registered under the Act. We have to also take into consideration that Courts in India has been following the *Chancery Courts* principle of Equity, Justice and Good Conscience while deciding the cases of passing off under the law of tort and infringement suit under the Act.

Besides these two remedies there are also reliefs under other statutes which an infringed trademark owner can avail in India and this will be discussed in the Remedies part of this chapter. Besides this the researcher highlighted the preamble of trademark legislations in India, concept of infringement, elements of Infringement, different ways of Infringements, Prior User's Rights under Trademark Legislations, Infringement of Domain Names, Dual Rights of Registered Trademark owner in infringement action, Passing off action, Concept of passing off, Trademark Act and Passing off action, elements of Passing off, Trans-border Reputation doctrine, Cyber-World and Passing off action, Extended Passing off, Passing off Well-known Trademark.

³²⁶ Dr Meenu Paul, *Intellectual Property Laws* (2nd Ed. 2006, Allahabad Law Agency, Delhi) P.361, 362

3.2 Preambles of Trademark Legislations vis-a-vis Infringement and Passing off:

Preamble of any statute is very important as it gives an orientation as to what is the aim and objective of any statute. Preamble might consist of a single sentence, but it gives the whole idea of an Act or legislation, so let us now verify the preamble's of different Trademark statutes passed in India in order to understand what was the legislatures aim and objective as to protect the trademarks in India from infringement and passing off from the hands of unscrupulous people in the country.

The Preamble of an Act is one of the most important thing as it mentions the objective and aim of passing a statute, the researcher has explained the aims and objectives of passing the trademark statutes by analyzing the preamble of all the trademark Acts passed in India right from 1889 i.e. from British India era and the preamble clearly shows the intentions of passing such statutes, which is, better protection of trademarks from infringement and passing off and prevention of fraudulent marks by the trademark authorities in order to curtail and eliminate the menace of infringement and passing off, of the genuine trademarks in India.

The Preamble of Indian Merchandise Marks act 1889 Act reads out that this Act was passed with an aim of bringing amendment with any statute dealing with fraudulent mark on merchandise and this refers to the trademarks.³²⁷The Act brought amendments in the provisions of Indian Penal Code (IPC) 1860³²⁸,

³²⁷ Passed by Governor General of India in Council on 1st March 1889. [**Preamble:** An Act to Amend the Law relating to Fraudulent Marks on Merchandise.]

³²⁸**Sec.3** of the Act of 1889 specified the amendment incorporated under Indian Penal Code 1860 for the following sections

Sec.482: Whoever uses a false trade mark is punished with imprisonment which may extend to 1 year or with fine or with both.

Sec. 483.IPC: Whoever counterfeits any trademark shall be punished with imprisonment for a term which may extend to 2 years or with fine or with both.

as well as the Sea Custom Act 1877³²⁹. Trademarks act 1940 Preamble specified two important things, Registration and Effective Protection of Trademarks³³⁰. Trade and Merchandise Marks Act 1958, Preamble spoke about the following aims which the Act wanted to achieve in order to prevent infringement and passing off.³³¹

Now let us analyze the preamble of the most important legislation passed in Indian trademark's history, the Trademarks Act 1999 which revolutionized the

³²⁹**Sec.2(3)** 'False trade description' means a trade description which is untrue in respect of goods and any alteration in the same by way of addition, effacement makes description untrue and this trade description is also trademark.

False Trade Mark: Whoever marks any goods or any case, package or other receptacle with any mark thereon in a manner reasonably calculated to cause it to be believed that the goods so marked or any goods contained in an such receptacle so marked are the manufacture or merchandise of a person whose manufacture or merchandise they are not, is said to use a false trade mark.

We can understand on the basis of Preamble that the intention of the framers of this act of 1887 was to protect trademarks of goods from getting counterfeited and also protect the business people from misuse and fraudulent use of their trademarks and trade dress by falsifying the same. This counterfeiting of Indian trademarks and false description of trade is nothing but an act of Infringement and passing off.

³³⁰**Preamble:** An Act to provide for the registration and more effective protection of trade Marks.

- a. **Registration ;** The Preamble Of the Act speaks about the registration of the trademark which was first time provided by the Statute in India, as earlier such registration was not available. The reason beyond providing such registration system was to give legal identity and recognition to the trademark. Main focus is to take an action in the event of infringement or passing off of a genuine trademark by initiating an infringement suit in the Court and also to oppose at the Registry and file for rectification in the High Court of the conflicting and infringing trademarks under the act.
- b. **Effective Protection of Trademarks:** The Preamble of 1940 Act aimed for more effective protection of the trademarks than any other statute, passed before and this was aimed because for the first time a registration system was provided for the registration of the Trade marks in India during British rule. The Preamble aims at effective protection of the trademark due to many other provisions in the Act which can help the genuine trademark owner to protect hers or his trademark from infringement and passing off. The Act also says that it will function in harmony with the other laws which were applicable during that era for trademarks.

³³¹**TMMA 1958;** Enacted by the Parliament on 17th October 1958. **Preamble:** An Act to provide for the registration and better protection of Trade Marks and for prevention of the use of fraudulent marks on merchandise.

See; **Objective** and **Aim** of the Preamble:

- a. **Registration:** The Preamble mentioned about registration of the trademark for goods so that the proprietor can protect its genuine trademark from infringement.
- b. **Better Protection of Trademark:** In number of ways the Act provided for protection of the trademarks from infringement and passing off like filing a infringement suit if the mark is registered or file a passing off action in case of unregistered trademark. The Act gave primary priority to the Prior user, who in spite of being unregistered could not be sued even by registered trademark proprietor.
- c. **Prevention of Fraudulent Mark's usage :** In order to achieve this aim of the preamble the Act, empowered the Registrar of the trademark to take prompt and judicious decision while dealing with Opposition. The act also empowered the High Courts to decide the matter related to Rectification of trademarks.

law of trademark in India and this legislation was passed, taking into consideration, India's obligation with International treaties and agreements.

TRADE MARKS ACT 1999

This is the present law applicable in India with amendments in the year 2010. The Preamble of the Act of 1999 speaks about the following aim and objectives the legislation wants to achieve in the area of trademarks law.³³²

The most important objectives of this Act mentioned in the preamble are registration; better protection, prevention of fraudulent mark use, let us briefly understand these objectives briefly;

a) Registration: The preamble firstly mentions about the registration of the trademark for both goods as well as services. One of the intentions of the Act in providing for registration of the trademark under the Act was, to avail the right to file an infringement suit by the owner of the trademark against the infringer for infringement of her or his genuine trademark.

b) Better Protection: The preamble of the 1999 Act speaks about giving better protection to the trademark/service marks which means that the intention of the legislature is to protect the trademark from infringement and passing off act of the infringer. To give better protection, the Act has provided many ways by which an aggrieved party can seek remedy in order to safeguard and protect his or her trademark. In order to achieve this aim the Act has facilitated even the unregistered trademark owner to take an action of passing off if any person infringes or passes off such genuine unregistered trademark or service mark. The Act also has maintained harmonious relationship with other statutes which time is being applicable in the area of trademark in India and the Act has not barred the application of such other laws.

³³²Enacted by Parliament on 30th December 1999, **Preamble:** An Act to amend and consolidate the law relating to trademarks, to provide for registration and better protection of trademarks for goods and services and for the prevention of the use of fraudulent marks.

c) Prevent Fraudulent Marks Usage: So also the preamble aims at prevention of fraudulent mark's usage in the country which again means that the intention of the Act is to curtail and completely stop the fraudulent proprietors of trademark from the act of infringement and passing off of the trademark/service mark³³³. For preventing the fraudulent mark, the Act has provided with Authorities like the Trade Marks Registry and Intellectual Property Appellate Board (IPAB) to administer this Act and also to prevent the registration of the fraudulent trademark in the process of Opposition and Rectification and other powers they have under the Act. Now let us study and examine the concept of infringement in detail.

3.3 MEANING OF INFRINGEMENT

As per Oxford dictionary Infringement means breaking the terms of Agreement or Law. So the true meaning of the term Infringement means violating or breaking of Law or Agreement. For example if a person as a tenancy agreement takes flat from landlord for domestic purpose to reside in it and later on uses the same for Commercial purpose, then such person is violating the terms of Agreement.³³⁴

The term trademark is not defined separately under the legislation. As per trademark legislation Infringement of Registered trademark in India is defined under *Section 29*³³⁵ of the Trademarks Act 1999 which says that a registered trademark is said to be infringed by any person, who not being the registered proprietor of the mark or being a person authorized by the owner for its use, uses in the course of trade, a mark which is identical with, or deceptively similar to the mark in relation to goods and services which are same in respect

³³³ Supra note. P. (Dr Meenu Paul, *Intellectual Property Laws*)

³³⁴ Oxford: A name, symbol or design that any company uses for its products and that cannot be used by anyone else. '*BigMac*' is Mc Donald's best known trademark.

³³⁵ **Sec.29.**A registered trade mark is infringed by a person who, not being a registered proprietor or the registered user, uses in the course of trade, a mark which is identical or deceptively similar in relation to the same goods or services in respect of which the trade mark is registered.

of which the trademark is registered. After going through the concept of infringement, now let us verify the elements of infringement.

Let us now understand what constitutes an act to be termed as Infringement under the Act in order to initiate an infringement action against the infringer of the Trademark.

3.3.1 Elements of Infringement:

The essential elements of Infringement are; registered trademark, Unauthorized Use, Identical or deceptively similar trademark, Trademark used in the Course of business/trade, Representation of the trademark, Trademark should belong to certain class of goods or services³³⁶. Now let us study these each elements separately;

a. Registered Trademark:

If a plaintiff wants to sue any person for infringement of trademark then firstly the plaintiff's trademark should be registered under the trademarks act, this is the primary requirement for filing an infringement suit under the statute trademarks act.

b. Unauthorized Use

The right of action to the registered trademark owner is available to the plaintiff provided the plaintiff has not permitted or given any authority to the defendant or else the plaintiff loses his right to sue under the act. For e.g. If the Plaintiff has permitted the defendant the right to use the trademark owned by plaintiff under an agreement and subsequently the defendant violates some of the conditions of the contract then the plaintiff cannot sue the defendant for infringement under the trademarks Act as he was already permitted to use it but the plaintiff can take an action under the contract Act and specific relief Act.

³³⁶ Dr M. K. Bhandari, *Law Relating to Intellectual Property Rights*, (3rd Ed. 2012, Central Law Publications, Allahabad)

c. Identical or deceptively similar trademark

The trademark used by the defendant must be the one which is either deceptively Similar³³⁷ or the identical one so as to sue him for an act of infringement.

In *Horlicks Ltd. & Ors v. Kartik Sadhukan*³³⁸ the Delhi high Court restrained the defendant from using the trademark 'Horlicks' for confectionery product as it was *deceptively similar* to the mark plaintiffs registered trademark 'HORLICKS' the producer of infant's food products, food of energy boosting nature, biscuits etc.

d. Trademark used in the Course of business/trade

The defendant must use this infringed mark in the course of business for the products or services for which the similar or identical mark of the plaintiff is registered.

e. Representation of the trademark

While using the mark there must be some sort of representation made by the defendant in the form of issuance of bills, invoice, publicity campaign, and advertising.

f. Trademark should belong to certain class of goods or service

It is to be noted that in order to file an infringement suit the plaintiffs mark should be one which deals with business and should fall in one of

³³⁷**Marks Held to be Similar :**

- a. In *Decon Laboratories Ltd. v. Fred Baker Scientific Ltd.* (2001(RPC)17) Decon Ahol and Decon Phase were considered *identical* to the registered trademark Decon.
- b. The mark 'Andal' to be deceptively similar to 'Ambal' (AIR 1970 SC-46)
- c. The trademark 'Simatul' likely to cause confusion and deceptively similarity to 'Cibatul' (AIR 1978 Gujarat 216)
- d. The mark 'Formis' could not be registered, being likely to create confusion with the trademark 'Charmis' (AIR 1979 Cal. 133)
- e. The trademark 'Trevicol' was held to have phonetically deceptively similarity to 'Fevicol' (AIR 1989 Delhi 155)
- f. In *Chanel Ltd. v. Sunder Chemicals Agarbati Works (P) Ltd.* (2003(26)PTC(52)DEL), the trademark 'Shanelle' was held to be phonetically and deceptively similar to the mark 'Chanel'

³³⁸ 2002(25)PTC(125)DEL

the classification or else he cannot firstly register his or her mark and obviously there is absolutely no point of right for infringement suit under the act³³⁹.

Once the above essential requirements are satisfied the registered trademark owner can file a case for infringement of trademark before the appropriate Authority. Now let us look to various ways of infringement.

3.3.2 Different Ways of Infringements:

Truly speaking there are different forms, a infringement of trademarks which can take like Cyber squatting, Counterfeiting, naming a product or company by another's trademark etc. In India the Courts have framed various test and parameters from time to time so as to find out what truly amounts to infringement. The Courts after analyzing vast number of cases that have come down with such a finding so that there remains no safe exit for the infringer to wash his hands clean after the act of infringement. Before we go through the test made by the courts to determine infringement we have to understand one of the most important thing and that is what is the impact on the consumer when she or he purchase such infringed product, is there any confusion or deception created in their mind and if this is true then it does amounts to infringement. In the case *Astra Ideal Ltd v. TTK Pharma Ltd*³⁴⁰ the Bombay High court held that actual confusion is not required to be proved even if there is likelihood of confusion it amounts to infringement.

The following are the various methods of infringement of trademark as per Court pronouncements they are, Identical Mark for Identical Goods or Services, Similar Mark for Identical Services or Goods, Identical Mark for Similar Goods or Services, Similar mark for similar Goods or Services,

³³⁹Sec. 7 of Trade Marks Act 1999 provides that the Registrar shall classify goods and services for the purpose of registration of trademarks. Trade Marks Act has adopted *Nice Classification* of goods and services for registration of trademarks in India. There are all together 45 classes of which, class 1 to class 34 covers Goods and class 35 to class 45 covers Services.

³⁴⁰ AIR 1992 BOM 35, BOM CR 298

Likelihood of Confusion, Test of Similarity of Ideas, Anti dissection Rule, Initial Interest of confusion. Now let us analyze all these modes;

a) Identical Mark for Identical Goods or Services

Sometimes an Identical mark is used by the infringer for Identical Services or Goods for example infringer uses a mark by name Godrej to make safety door locks. Here he is using identical mark of Godrej Company and hence is liable for infringement action by Godrej Company which is the registered proprietor of the goods falling under the specific classification.

In *Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories*³⁴¹, the honorable Supreme Court held that in an action under infringement the onus is placed on the Plaintiff to prove and establish the defendant's use of the trademark in the business trade of goods is deceptively similar to the Plaintiffs Registered Trademark.

b) Similar Mark for Identical Services or Goods

The infringer may in other case use similar mark for Identical Services or Goods for example the infringer uses the mark 'Goldrij' to make locks etc. In this case the infringer uses the mark which is similar to the original mark Godrej. This is also amounting to infringement and the Company Godrej can sue the infringer for infringement of their registered trademark Godrej. In *Lakme v. Like Me (Subash Trading)*³⁴² Delhi High Court restrained the defendants from the use of *Likeme* trademark as it was is deceptive and creates confusion as it is phonetically similar to the plaintiffs trademark which is registered and also the range of products used by both are same and hence amounts to infringement.

³⁴¹ 1997PTC(17)(DB)779

³⁴² 1996 PTC (16) (567) Del

c) Identical Mark for Similar Goods or Services

There is one more case where the infringer uses Identical Mark for Similar Services or Goods for example the infringer uses Godrej mark to make Entrance gates then he is committing an act of infringement.

In the case *Atlas Cycles Industries v. Hind Cycle Ltd*³⁴³ the Delhi High Court held that in Trademark infringement proceedings the identical feature or the resemblance of the defendants copied mark has to be established by the plaintiffs either phonetically or visually or in some other ways and hence is capable of creating confusion or deception as regard the Plaintiffs registered trademark.

d) Similar mark for similar Goods or Services

Still in another case a similar mark is used by infringer to make Similar Services or Goods for example the infringer uses Goldrij to make Entrance gates.

e) Likelihood of Confusion

According to Supreme Court the Likelihood of Confusion has to be judged from Unwary Consumers eyes that are having Intelligence which is Average and Recollection capacity which is Imperfect³⁴⁴. The Common Man has been considered by the court while forming the test of likelihood of confusion and the common man might or will not be able to distinguish the two marks in detail hence the threshold was considered taking into account an average common man³⁴⁵. In *National Sewing Thread Co. Ltd. v. James Chadwick and Bros*³⁴⁶ under the Trade Marks Act 1940 the Supreme Court held that whether there is likelihood of deception or confusion has to be seen by the Registrar in deciding any case.

³⁴³ ILR (1973) (393) Del

³⁴⁴ The trademarks 'Beplex' and 'Beplex' are phonetically and visually similar and likely to create confusion and deceptively similarity.(AIR 1984 P&H 430)

³⁴⁵ P Narayan, *Intellectual Property Law* (3rd E.d.2017, Eastern Law House Pvt. Ltd) P. 198, 199.

³⁴⁶ AIR(1953)SC(357)

Burden of proof:

- a. The burden of proof is on the applicant who has applied the mark for registration, that there is no likelihood of deception or confusion which such mark will create on registration³⁴⁷.
- b. If any likelihood of deception or confusion can arise on the registration of applicant's trademark, the burden to prove so relies on the opponent which means that the opponent has to show to the court that there is likelihood of deception and confusion in the applicant's applied trademark.³⁴⁸

When the point comes as to the purchase of Expensive Goods the court believe that the test should be one that is more discerning one being the goods or services costly it is obvious that the customer will find out everything in detail but the exception is when people purchase online.

Consumers brain is considered to be more conducive to distinct trade mark so also packaging of the product.' sometimes the consumer don't remember the product due to the lack of accurate judgment and might remember a part of it or a certain feature of it and hence confuse the infringer's product as original hence the court intervenes and sees that there is no confusion from customers point of view.

The Consumer will not take the products and Compare them together, he or she might just glance the product and just remember slightly the previously seen genuine trademarked product and mistake for the wrong product of infringer hence the Court takes account of these things from consumers point of view and also sees whether there is phonetic similarity i.e. whether while pronouncing they sound alike or not and visual similarity exists between the plaintiffs and defendants mark.

³⁴⁷ ibid

³⁴⁸ ibid

f) Test of Similarity of Ideas

So also there is a chance that the infringer can copy the idea expressed in the trademark label³⁴⁹. For e.g. the plaintiff's energy drink label has a picture of young teenagers dancing and the defendant for his energy drink shows a similar type of dancing youth picture in his energy drink label then over here he's copying the similar idea of plaintiff to infringe his mark and hence is liable for infringement suit by plaintiff.

In *Kiran Gupta v. Pizza Hut International*³⁵⁰ the Honorable Court held that the Appellants trademark 'Pizza Ghar' is deceptively similar in idea to the respondent's world famous trademark, 'Pizza Hut'.

In the case *Bhatia Plastic v. Peacock Industries*³⁵¹ the Honorable Court held that the trademark of defendant by name 'Peacock' is deceptively similar in idea to the trademark, 'Mayur', owned by the plaintiff³⁵².

g) Anti dissection Rule

This rule is taken into account by the Court while Composite Mark are under consideration the Composite mark consists of distinctive part which indicates the source of the mark that who is the owner, origin of goods or services etc and Non distinctive part which is more of generic nature and belongs to world. COCA (distinctive) COLA (Generic) in many cases defendant is allowed to use non distinctive feature of the Composite Mark.

Exceptionally Sometimes the Court applies the rule of Anti dissection where the Court does not separate the Composite Mark and considers such mark as One Mark or Whole Mark and hence considers the overall effect how the mark looks even if the defendant uses non distinctive feature of the composite mark.

³⁴⁹ Dr. B.L. Wadehra, *Patents Trademarks Copyrights Designs And Geographical Indication*(3rd E.d.2006,Universal Law Publishing Co. Pvt. Ltd. Delhi) P.206,207

³⁵⁰ 2004(28)PTC(279)

³⁵¹ 1995(PTC)150

³⁵² See also: *Mem v. Cussoms* (1974(RPC) 7) English leather was held to be an Infringement of Imperial Leather.

Sometimes the defendant tricks by just adding some extra matter while infringing the plaintiffs mark just by adding suffix or prefix but the court considers this still as infringement without giving importance to the added matter by which the defendant wants to hide his wrong and this is considered only in case of the Statutory Infringement suit and not passing off action.

h) Initial Interest of confusion

Sometime the infringer might not copy the mark in an identical manner but might make the mark at a glance to give an impression that it is the same mark of the original trademark proprietor for example a mark by name 'Balaj' may be displayed on website to sell two wheeler motorbike of lesser price and infringe the well known trademark of original BAJAJ Company and the customers or people while casually viewing the internet might just feel that it is original Bajaj and then purchase something displayed for sale on the internet because they got initially curious that it is the original Company and it was a sort of Initial Interest Confusion which took place in their mind.

It is pertinent to note that Actual Confusion need not be proved by the Plaintiff in the Infringement proceedings and plaintiff has to proof likelihood of confusion by the use of infringers mark. In the famous case *Bata v. Bata*³⁵³ in 1980 Bata the manufacturer of shoes sued a Company for marketing foam products under the name and style Bata. The Learned Judge of Allahabad High Court came up with a reasoning that it is possible that the customer buying this foam material will not question the dealer or person selling the same that whether this is manufacture by the BATA Shoe Company and hence case was decided in favour of BATA Shoe Company.

The Bombay High Court in *London dairy v. London Derry* held that accept for the phonetic similarity rest of the things in this marks are different and also held that there is no similarity as regards the Visual or structural point is

³⁵³ *Bata India Ltd v. Pyare Lal & Co.* (Air 1985 AII 242)

concerned and there is no deceit or any misrepresentation and being difference in colour combination, the goods itself trade dress, price factor the Judgment was decided in favour of Londonderry which is a manufacturer of inexpensive Confectionery.

‘Medicines and Drugs’ trademarks infringement

The Court conducts a stricter test while deciding a trademark case in relation to pharmaceutical products as it is a question of human and living beings health and life³⁵⁴. So the Judges take utmost care and caution while deciding the same as they are of opinion that even Doctors while prescribing medicine might while writing quickly and in hurry be confused to distinguish ³⁵⁵ . In *USV Ltd. v. IPCA Laboratories*³⁵⁶ the Madras High Court stopped the defendant by an decree of interim injunction from using the trademarks ‘PIOZED’ in classification of Pharmaceutical products of medicine as this mark was infringing Plaintiffs trademark ‘PIOZ’ by reason of being deceptively similar³⁵⁷.

In *Glaxo Group Ltd. and Anr v. Pawn and Pawn Chemicals*³⁵⁸ the Delhi High Court the Plaintiff’s trademarks, ‘Ostacalcium Vet’ and ‘Ostacalcium’ would get infringed if the defendant would use the trademark ‘Oscal Vet D 3’ in producing veterinary products and ordered a permanent injunction against the defendant to stop using the disputed mark.

³⁵⁴See: *American Home Products Corp. and Anr v. Lupin Laboratories Ltd* ((1996) IPLR (61)): The Rival trademarks ‘Rolac’ and ‘Tolorac’ were held to be deceptively similar, in medicinal preparation.

³⁵⁵See, *Bio-Chem. Pharmaceuticals Industries v. Astron Pharmaceuticals* [2003(26)PTC(677)(Reg.)] The Delhi High Court observed “ Leave aside general public sometimes the doctors who write prescriptions themselves will not be able to read distinctly who write in hurry, the chemist who sells the drug is surely bound to be confused. Many persons who think faster than their hands move, do suffer from missing a letter here and there and in case the doctors innocently with the fast moving thought process and slow moving hands omits ‘O’, then instead of a medicine prescribed the other medicine is surely to be given.”

³⁵⁶ 2003 (26) PTC 21 (MAD)

³⁵⁷ Ibid; the pronouncing of the word PIOZ and PIOZED will be one and the same since ‘ED’ in PIOZED will have no sound effect at the time of pronouncing it.

³⁵⁸ 2003(27) PTC (234) DEL.

1) Phonetic Similarity deception

Many a times the infringer infringes a genuine trademark by a tactic of Phonetic similarity. Phonetic similarity takes place when a word while being pronounced or being heard anywhere sounds like an already existing trademark for e.g. The word 'Nirma' and 'Nima' sounds same while hearing or pronouncing. In *Geepee Ceval Proteins and Investment Pvt. Ltd. v. Saroj Oil Industry*³⁵⁹ the Delhi High court held that the defendant's use of trademark 'Chambal Deep' is phonetically as well as deceptively similar to the Plaintiff's trademark, 'Chambal'.

In *Alfred Dunhill ltd. v. R.P.S. Chawla*³⁶⁰ it was held by the Honorable Court that there is phonetic similarity in the Plaintiff's mark 'Dunhill' and the defendant's mark 'Sunhill' and hence the court restrained the defendant by injunction.

Besides the above modes of infringement, infringement may be held in the following circumstances like, Advertisement and Business papers, Tarnishing of product's image by Infringement, 'Company Name' formed by Infringement, let us now discuss the same;

2) Advertisement and Business papers

So also using a trademark mark of others by copying on Advertising Material and Trade Correspondence like envelopes etc and business papers like letter heads writing material, Paper Stamp, Rubber Stamp etc by any person amounts to Infringement and is liable for an action under the Trademarks Act.

3) Tarnishing of product's image by Infringement

Sometimes there are instances that a products image can get tarnished due to infringement of certain reputed trademarks for goods and services.

³⁵⁹ 2003(27) PTC (190) DEL.

³⁶⁰ 2004(29)PTC(30)

In *Lucas Bols v. Colgate Palmolive*³⁶¹ it was held that Lucas Bols by using the trademark, Klarein, infringed Colgate Palmolive's trademark Claeryn. This case was considered as an illustrative judgment in the matter of tarnishing of product by chancery division courts³⁶².

4) 'Company Name' formed by Infringement

If a Company Name is formed under the Companies Act by infringing trademark of Plaintiff then the plaintiff can sue such a person for infringement and so also an action is liable under the Companies Act 2013 against such an infringer.

Sometimes the infringer prints the mark on goods or packaging of some other person who is the Registered Proprietor and in this fashion commits the act of infringement.

While some other infringers Imports or Exports goods by infringing the mark of somebody else in this case he can be sued under the Trademarks Act and also under the Customs Act too.

The Delhi High Court in *Atlas Cycle Ltd. v. Atlas Products Pvt. Ltd*³⁶³ Restrainted the defendant from using the name 'House of Atlas' as doing this amounted to infringement of plaintiff's registered trademark 'ATLAS' in the year 1952 for the manufacture of bicycles because the defendant's trademark was deceptively similar to the plaintiff.

³⁶¹ 1976(7) I.I.C (420)

³⁶² 2000 (F.S.R) 767 : 2000 (ETMR) 1071

³⁶³ 2002(25) PTC (563) BOM (Respected Justice made the following observation:-In my opinion the bare use of word ATLAS by the defendant qua the articles manufactured, marketed by the plaintiff, namely, bicycles and bicycle parts etc eve in conjunction with the words 'House of 'is like to cause confusion or deception in the minds of purchaser, thus constituting infringement of plaintiff's trademark 'ATLAS'.

In the case *Pay Pal v. Pay tm*³⁶⁴, the PayPal which is a USA business pioneer in the field of digital business has accused the Pay tm for copying their logo by using the colour combination of two tones in the Pay tm trademark like theirs.

3.3.3 Rights of Prior user under Trademark Legislations:

This is one of the important sections, saving the right to the ownership and usage, of the Prior User which prevails over and above the registered owner/user and which was protected by the legislature while passing all the Acts right from the year 1940 till date. The framers of law had a visionary and advance mind to incorporate such provision in the Act during that era and their deed is truly to be appreciated and applauded. This section gives a strong immunity to the genuine prior User even if his mark is unregistered, it says that under no circumstances the ownership right of prior owner can be mishandle or retrained by the registered trademark owner even if such prior users trademark is identical or resembling the registered trademark in same goods. The provision under this section of prior users principle becomes very important or else the second user of the prior users trademark would register its trademark registry and would have file an infringement suit under the Act or would have taken passing off action against such prior user and hence would have caused great injustice and trouble to such genuine proprietors because man a times people don't register their trademarks due to financial constraints etc. Trade Marks Act 1940 gave a strong protection to the prior user b not getting affected by eve a registered trademark proprietor³⁶⁵, so also there was protection of rights of prior user in the Trade and Merchandise Marks Act 1958³⁶⁶. Under

³⁶⁴ PayPal and Paytm Trademark Dispute, <https://www.bananaip.com>

³⁶⁵**T M A 1940:** There is a separate provision which protect the interest of Prior user. **Sec.25** of the 1940 Act deals with Prior User. This Sec. protected the rights of the unregistered prior user b not entitling even the registered trademark owner to file suit or interfere a prior user in an ways under the Act even if such mark was identical or deceptively similar to the one which was registered. The first Trademark Act which was a complete state first of its kid I India truly helped the genuine trademark proprietors in India to save the names of their product and businesses. If this provision was not there then the registered trademarks would overpower the genuine prior user's trademarks which would be very unfair.

³⁶⁶**T M M Act 1958:** The Legislature while passing the new Act in post independence era maintained and protected the Rights of Prior User's Trademark even if such prior user's trademark would resemble or was identical to the registered trademark with regards to goods only.

this Act the registered trademark owner was not entitled to interfere with prior users right in relation to trademark³⁶⁷.

Now after analyzing the right of prior user in the first act passed in post independence era let us now move towards the second statute passed during the post independence era, the Trademarks Act 1999 which is one of the important legislation in life of trademarks law in India which has brought a paradigm shift in this area of Law.

Trade Marks Act 1999

The legislature while passing this trademarks Act 1999 maintained and protected the rights of prior user by carrying forward the principle established by all the previous legislations which is truly a very intelligent move by them.

Under **Sec.34** of the TMA 1999 it was provided that even the registered trademark owner is not entitled to restrain or interfere any person who is prior user in time, then the registered owner even if such prior user's trademark resembles or is identical to the registered mark with regards to the goods or and protected the right of prior user which was protected by the earlier Act. In this Act also there was a provision under Sec.33 which says that, the registered trademark owner/user is in no way entitled to restrain or interfere any person or a predecessor in title who is prior user of the unregistered mark, even if such trademark is deceptively similar or identical with the registered trade mark under the Act. So it goes without saying that the legislatures were truly wise not to neglect the principle of prior use which was set by the earlier legislation

³⁶⁷**Sec.34TMA1999:** Savings for vested rights- Nothing in this Act shall entitle the proprietor or a registered user of registered trademark to interfere with or restrain the use by any person of a trademark identical with or nearly resembling it in relation to goods or services in relation to which that person or the predecessor in title of his has continuously used that trademark from a date *Prior-*

- a.* to the use of first mentioned trademark in relation to those goods or services be the proprietor or a predecessor in title of his ; or
- b.* to the date of registration of the first mentioned trademark in respect of those goods or services in the name of the proprietor of a predecessor in title of his or her ; whichever is the earlier and the registrar shall not refuse (on such use being proved, to Register the second mentioned trademark by reason only of the registration of the first mentioned trademark.

in the pre independence era and this act of them is truly to be appreciated as it has helped the genuine trademark owners to save their proprietary right in their trademarks. There are many courts judgments in India which clearly shows that it is a settled principle of Law in the area of trademarks protection that the rights of prior user of trademark prevails over and above that of the registered proprietor / registered user³⁶⁸.

In an interesting case *M/s RJ Components & Shafts v. M/s Deepak Industries Ltd*³⁶⁹ the Delhi High Court held that prior user of a trademark shall override the subsequent user of trademark even if the second user has got registration for its mark. So the court gave consideration for the principle of Prior User by giving it superiority above the second user of the similar or identical registered trademark.

Further, the Supreme Court in *S Syed Mohideen v. P Sulochana Bai*³⁷⁰ held and considered under the act that the right of prior user is superior then registration of the mark and hence prior user cannot be interfered by subsequently registered proprietor.

In *Neon Laboratories Ltd v. Medical Technologies Ltd and Ors*³⁷¹ the Supreme Court said a registered proprietor of any trademark does not have right to stop use of identical mark of another person if he is prior in usage.

From the above it is very clear that the companies or any person who wants to register any of their mark should search properly if there exist a similar mark even if it is not registered but is in usage before the registration of their mark.

³⁶⁸ See: In *Senor Laboratories ltd. v. Jagsonpal Pharmaceuticals Ltd* (1998(18) PTC (449) DB); Injunction against prior user was not considered proper. In *Usha Intercontinental Ltd v. Usha Television Ltd.*(1997(PTC)240-A) : Injunction was granted in favour of prior User.

³⁶⁹ CS(OS) 900/2002 & CC 2/03

³⁷⁰ 2015(2) RCR(Civil) 810

³⁷¹ Civil Appeal No. 1018 of 2006.

Infringement of Domain Names

In India Domain names are acquiring popularity in this 21st Century due to the advancement in the E-Business Concept as a result people are advertising their businesses and products with the help of Domain name and this helps to them to promote and sell their products with the help of the same. In this modern era domain name plays a role of trademark as most of the dealings and communication takes place on internet for the purpose of buying and selling of goods and services.³⁷² Domain name helps in national as well as international dealing hence it acquires a significant status in representing the businesses. In India there are many goods and services marked on the website and which has the market worldwide.

In an interesting case of *Rediff Communication v. Cyber booth & Anr*³⁷³ the Bombay High Court made an observation and said Domain name is as valuable and important as the Company's asset.

In a Landmark Case *Yahoo Inc v. Akash Arora & Anr*³⁷⁴ of Cyber Squatting, the Delhi Court in held that Domain Name performs the function which is same as the Trademark and hence deserved the same protection thereof.

In the case *Acqua minerals Ltd. v. Pramod Borsey and Anr*³⁷⁵ the Delhi High Court decided the case in favour of the plaintiff and also passed an order in which the plaintiff could get the Domain name 'Bisleri.Com' and 'Bisleri' infringed by the defendants, in its name by contacting the registration authority.

³⁷² Economic Times: Indian domain Name plaints up 60% in 2015, Country ranks 11th, US tops WIPO list, Cyber Squatting is abusive registration of trademarks as domain names where individual or company attempts to usurp the reputation of the established domain name of brand, Indian owners filed 30 cases with WIPO in the year 2010 where else in 2015v India filed 59 i.e.2 times more than the earlier . Eric Wilbers director at WIPO Arbitration and Mediation Centre told TOI. WIPO'S Director General Francis Gury said 'Brand owners face the possibility of further abuse of their trademarks in Domains, both old and new and they continue to rely on WIPO's Cyber Squatting Dispute Resolution Procedures. WIPO helps consumers to find authentic Web Content and enhance the reliability of the Domain name system' <https://www.economictimes.com>

³⁷³ 1999(4) CR(278)BOM

³⁷⁴ 1999(19) PTC (201) DEL

³⁷⁵ [(2001)(2)CTMR(226)DEL:AIR (2001)DEL(463):2001(93)DLT(203):(2001)PTC(619)

The Honorable Court passed an order of injunction against the defendants and restrained the defendant from using plaintiffs registered trademark as domain name³⁷⁶.

3.3.4 Dual Rights of Registered Trademark owner in infringement cases:

In case of Registered owner of trademark has dual rights. One under the Statute and another under the Common law but it is important to note that statutory rights can be claimed by registered trademark owner whereas the unregistered trademark owner has Rights under the Common law.³⁷⁷

The registered trademark owner besides claiming statutory rights under the Act also has common law rights which they claim as regard the goodwill and reputation of their trademark. The right to remedy in case of infringement can be availed only on the registration of the trademark which entitles him to stop the infringer from infringing. He can also ask for ex-parte injunction against the infringer.³⁷⁸

In *Devi Pesticides Pvt. Ltd. v. Shiv Agro Chemicals Industries*³⁷⁹ the Madras High Court passed an injunction order against the defendant restraining the defendant from using the trademark 'SUPER BOOM' which is deceptively similar to the Plaintiffs registered trademark 'BOOM PLUS' and also a prior user. The court also held that this amounted to as well as infringement

³⁷⁶ Supra note: 50; The Court held 'Unless and until a person has a credible explanation as to why did he choose a particular name for registration as a domain name or for that purpose as a trade name which was already in long and prior existence and has established its goodwill and reputation there is no other inference to be drawn than that the said person wanted to trade in the name of the trade name he has picked up for registration or as a domain name because of its being an established name with widespread reputation and goodwill achieved at huge cost and expenses involved in the advertisement'.

³⁷⁷ KC Kailasam & Ramu Vedaraman, *Law Of Trade Marks* (3rd Ed. 2013. LexisNexis, Gurgaon, Haryana) : 'Advantages Of Combining Two Actions'; The scope of a passing off action is wider than an infringement action. If one action fails there is a chance of the other succeeding. In an infringement action the validity of the registration may be challenged or that the registration does not extend to the goods/services for which the impugned mark is in use etc. The plaintiff may raise a general plea that the defendant's wrongful action or conduct has led or is calculated to lead to deception amounting to Passing off.

³⁷⁸ *ibid*

³⁷⁹ 2006(32)PTC(434)Mad(DB)

according to Sec.29 (5) of trademark act and passing off as the plaintiff's trademark is registered under the Act.

Trademark's, 'Get up and Design' infringement

Sometimes there might not be a similarity in the word mark or name of the company or the logo or monogram but there could be similarity in design and get up of label or packaging of the product or branding which may amount to deceptive similarity between the genuine original product and the other such infringing brand. There many genuine trademarks in India whose appearance in terms of get up and design were tried to be copied and infringed by the infringers but the administrative authorities as well as the Courts have always stopped their usage.

In *Tata Tea Ltd. v. Suruchi Tea Company*³⁸⁰ there was a similarity while visually watching the two products due to the get up look which the respondent used was similar to the appellant's product design. The Court quashed the earlier order of the Registrar of accepting and giving registration to the respondent. The court ordered the respondent to mention mark 'Suruchi Tea' and the make the application in the registry.

3.3.5 Liability under Trademark Act:

Trademark Act imposes liability on different actions of the infringer so that he should not be left scot free and take advantage of someone's Goodwill and Reputation which has been earned by honesty and effort.

It is important to know that unlike Passing off action, in Infringement suit the plaintiff does not have to prove the reputation of her or his Trademark, as long as the proprietor of such a mark has got it registered in the Trademark Registry and holding the certificate of the same. Besides this the rights of prior user are also protected under trademark legislation.

³⁸⁰ 2004(28)PTC(83)BOM

3.4 PASSING OFF

According to Cambridge dictionary the meaning of Passing off is an illegal act of selling a product which is similar to another Company Trademark which the Company has already protected it legally³⁸¹.

Passing off is tortuous act in which a person while manufacturing or selling goods or while providing services, does so by creating an misrepresentation that these goods or services are owned by somebody else. Usually the person whoever passes off, does this by using trademark of others in a direct manner e.g. Using identical mark or in an indirect way e.g. using deceptive similarity by visual manner or by phonetic manner etc.

The another type of rights a trademark owner can avail are Common law Rights and upon this right of the trademark owner being infringed he or she can initiate an Action for Passing off.

It prevents the *goodwill* of a person from being *misrepresented* by someone else. It prevents one person from misrepresenting the goods or services of another person and also prevents someone falsely misrepresenting that his or her product is having association with another person even though this is untrue. It protects the *reputation* and goodwill of the trader rather than its product. Passing off action protects the economic asset of the proprietor of trademark.

3.4.1 Concept of Passing off

Passing off action is an Intellectual Property Right and can be initiated if the infringer copies somebody else's registered or unregistered trademark, this right of action is not a statutory right of action, *it is a tort developed by the common law*. Though this is not a statutory action and is not defined under the Act, but still the trademarks legislation right from 1940 till the present Act of

³⁸¹ Cambridge dictionary, <https://www.dictionary.cambridge.org>

1999 has always recognized and given due respect to Passing off action of the genuine unregistered trademark owner by expressly mentioning in the provision that nothing in the Act will affect the right of unregistered trademark owner to file an passing off action in case of infringement of its unregistered trademark.

The Act has respected the rights of unregistered trademark proprietor by expressly providing that even the registered trademark owner will not affect and stop the unregistered prior trademark owner from using the same. Nowhere the trademarks Act is conflicting or contrary with the passing off action and in fact they both are complimentary with each other. E.g. A registered trademark is not able to stop identical or similar mark infringing it b using the same for different classification of goods and services. In such a case Passing off action comes to the rescue of such trademark because such action can be taken even if the products are different. Hence there is a harmonious relation between these two laws in India and other nations.

‘Passing off is more importantly used when the infringement suit under the act is not so likely to succeed’. Passing off helps the infringement suit by going hand in hand and they both help each other to patch up or fill the gap if there is any loop holes to succeed the case.

*In Info Edge Pvt. Ltd. v. Shailesh Gupta*³⁸² the observation was made by the Delhi High Court that though the passing off law is a common law action, is also given under the Trademarks Law a Statutory identity and recognition.

*In Bengal Waterproof Ltd. v. M/s Bombay Waterproof Manufacturing Co. and Anr*³⁸³ The Supreme Court held the use of trademark, ‘DACKBACK’ by

³⁸² 2002(24)PTC(355)DEL

³⁸³ AIR 1997 SC 1938

the Respondent was an act of passing off as it was similar to the Appellants trademark, 'DUCKBACK'.

In *Manish Vij v. Indra Chugh*³⁸⁴ the Delhi High court held that under the Trademarks Law when the trademark of one person is used by another, the passing off action takes place.

In the above cases according to the judges the term 'use' means use of trademark by the unauthorized use, which means that the person neither is registered user or an assignee.

In *Bajaj Electricals Ltd. v. Metals and Allied Products*³⁸⁵ the Bombay High Court held that the use of trademark Bajaj for utensils by the defendant which is identical to the plaintiffs trademark, 'Bajaj' would amount to *passing off* as the trademark Bajaj has been widely used by plaintiff for electrical products.

3.4.2 Trademark Legislation and 'Passing off action':

There have always been provisions in the entire Trademark Acts passed in India since 1940 for protecting the unregistered trademarks by initiating a passing off Action. This provision is of utmost importance because otherwise there would have been infringement of many genuine prior user's unregistered trademarks in India and as a result of this there would be a great hardship and injustice towards such unregistered trademark owners. Without this provision there would be a great confusion in the whole country as any person would infringe the unregistered trademark of prior user. So the legislature has truly done a remarkable, important and a very sensible thing by not interfering with the right of action of the unregistered trademark proprietor of initiating a passing off action in case his or her trademark is infringed by any person, whether registered or unregistered trademark proprietor.

³⁸⁴ 2000 (24) PTC51 (DEL)

³⁸⁵ AIR(1988)BOM(1967)

The researcher has analyzed and discussed the important provision by studying the different legislations which were passed in India for protecting the rights of action of the unregistered trademark owner in the event of passing off their trademark which were unregistered under the Act.

The Trade Marks Act, 1940, Sec. 20(1) and the Trade and Merchandise Marks Act 1958, Sec.27 provided for passing off action similar to Sec.27, of the 'Trademark Act of 1999'³⁸⁶.

This shows that the infringement and passing off cases were taken care of very well by giving the genuine proprietors to safeguard their trademarks by resorting to different laws in the country.

The plenary reading of the above section makes it very clear that the act has said that though an unregistered trademark owner has no right to initiate an infringement suit under the Act but such owner has every right of action against any person for passing off such owner's goods or services.

This means that the all the Acts passed in India has always shown a great concern towards the unregistered genuine proprietor by declaring that such owner can avail remedy by initiating action against passing off. The acts passed in different years were not silent as to the rights of unregistered trademark owner; in fact they have recognized such owner's remedy under the Act. It would have been a great troublesome and hardship if the Act would say that registered trademark owners rights prevails over unregistered trademark owner or if it would say infringement action under the Act overrides passing off action of the unregistered trademark owner. All the Acts on trademark passed

³⁸⁶Sec. 27: Trade Marks Act 1999: No action for infringement of unregistered trademark.

1. No person shall be entitled to institute any proceedings to prevent or to recover damages for the infringement of an unregistered trade mark.
2. "Nothing in this Act shall be deemed to affect the right of action against any person for passing off goods or services as goods of another person or as services provided by another person or the remedies in respect thereof"

in India has truly and intelligently recognized protected the rights of the True and Real owner of the trademark mark by giving priority to the prior use of such genuine trademark whether registered or unregistered.

In the landmark *JiffLemonCase: Rekitt & Colman Ltd. v. Borden Inc*³⁸⁷ the UK Court laid down the following three things that are important in passing off actions. They are known as Classic Trinity Principle. Same principles are applied in India to some extent in case of passing off. The important things are:

- I. **Goodwill** : Plaintiff has to show that he has Goodwill And this is a force which attracts the consumers and prospective customer towards the product and this passing off action right can be claimed only by the usage of the product considering that passing off right is not in the property of the good but in the use of the same which builds goodwill for the same and that goodwill gets protection only on the usage .Goodwill is territorial in nature³⁸⁸ .

- II. **Misrepresentation**: plaintiff has to show that Misrepresentation made by the defendant to the people that the goods or services which he sells are those of Plaintiff. This relates to the deception created .The business or product under consideration can be different and not the same but even though if the goods are same then off course the case will tend to be strong.³⁸⁹

³⁸⁷ (1990) 1 All E.R. 873

³⁸⁸ See in; *Commissioner of Inland Revenue v. Muller & Co.'s Margarine Ltd.*[(1901) A.C (217) According to Lord Macnaghten, 'Goodwill is a very easy thing to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. Goodwill has no independence existence. It cannot subsist by itself. It must be attached to a business. Destroy the business and the goodwill perishes with it, though elements remain which may perhaps be gathered up and revived again'.

³⁸⁹See; *Hoffmann-La Roche and Co. Ltd. v. Geofferey Manners and Co. Pvt. Ltd.*[AIR(1970)SC(202); (199)(20SCC716] The Supreme Court observed and explained the expression false representation etc, 'You make a false representation to him and thereby cause him to believe a thing to be true, which is false. You may not do it knowingly or intentionally, but still you do it, and so you deceive him'

III. Damage: Plaintiff has also to show that this act of defendant has Caused Damage or Likely to cause damage to the Plaintiffs Goodwill. That there has been a loss of sales due to the defendants act and also there is dilution of the goods or services³⁹⁰.

In the English case *Erwen Warnink BV v. Townend & Sons*³⁹¹ Sir Lord Diplock laid that there are 5 elements under Passing off Tort. They are as follows

1. Misrepresentation
2. Made in the Course of trade by any person
3. To the Prospective Customer or the final or ultimate Consumer of his product
4. Which Injures another traders Goodwill or Business
5. Actual Damage is caused to a trader's goodwill or business who has initiated an action of passing off or who will initiate such an action.

While referring to the classy trinity principles in *Cadila Health Care Ltd. v. Cadila Pharmaceuticals*³⁹² a full bench of Supreme Court held that in India, the English Courts laid down Principles, in entirety cannot be applicable. The Indian, Courts have to understand the situation difference between India and England. The purchaser of both the countries cannot be equated.

The Supreme Court in landmark case *Cadila Health Care v. Cadila Pharmaceutical*³⁹³ laid the test as regards the act of passing off in which the court made an observation the action of passing off is based on a certain principle which says that no person *is* entitled for a right to give representation

³⁹⁰ See; *Athletes Foot Marketing Associates Inc. v. Cobra Sports* [(1980) RPC (343)] Passing off is a tort and the gist of the action is damage .If there can be no damage therefore there can be no action. Proof of actual damage is not essential in establishing a case of passing off in every case.

³⁹¹ 1979(2)AER 927

³⁹² 2001(PTC)300SC

³⁹³ 2001(PTC)300SC

that his goods are of someone else. Which also mean that no person can make sale of his product as if it is of some other person. Further the court held that three elements are essential to constitute passing off action as specified by the UK judiciary. Three elements are good will or reputation, misrepresentation³⁹⁴ and injury or loss.

3.4.3 Actual damage' not necessary Element for Infringement /Passing Off

It is a settled principle the plaintiff need not show the damages he actually suffered as a result of business, loss or due to any other reason. It is enough to show that there is a probability of suffering damages and such damages should be related to business loss like is goodwill can get suffered due to damage caused by the act of defendant.

3.4.4 Defendant might trade in different type of goods or services than Plaintiff's

The essence of passing off action is that it can be initiated against the defendant even if such defendant passes off plaintiff's trademark for goods or services other than the one Plaintiff deals with. This unique feature makes a genuine proprietor to protect and safeguard hers or his hard earned trademark from getting misused intentionally or unintentionally by others. If the passing off remedy was not available in India then the genuine trademark owner's trademarks would be at stake as the infringer would use the trademarks of others for some different product and would escape easily by committing such wrong. So also unscrupulous traders and dealers would use genuine trademarks to sell duplicate and low quality products in the Country and this could adversely affect the health and life of the people living in India.

³⁹⁴ See: *Te Maharashtra R.S.D.M. Ltd. v. Ideal Vitamin Food Products Ltd.*[1999(1) Arb.L.R.369, PTC 402 (BOM); The basis for passing off action is a false representation made by the defendant. The plaintiff must I order to succeed in obtaining temporary injunction in passing off action make out *Prima Facie* case on the basis of pleading and available material. And not the least that the user of the said trademark or trade name by the defendant is likely to deceive, confuse or mislead in the public mind resulting in injury to the plaintiff's goodwill, reputation and business'.

In *SIA Gems and Jewellery Pvt. Ltd. v. SIA Fashion*³⁹⁵ the Bombay High Court held that in order to pass an order of injunction against defendant, practice of activities of common nature between the plaintiff and the defendant is not a condition necessary or precedent. What has to be seen is that whether there is really any likelihood of deception or confusion that can happen to the consumer or public at large and also damage to the plaintiff due to the act of misrepresentation by the defendant.

It has to be noted that in order to take a statutory action by a registered trademark owner under the Act the infringing trademarked, 'goods or services' have to fall in same classification as that of Plaintiff's except for well known trademarks.

We have to but understand that all the trademarks in India are not well known in fact majority of them are in one state or for that matter belonging to one locality but still it needs a protection as this is a proprietary right of every trademark proprietor.

In *Yahoo Inc v. Sanjay Shah*³⁹⁶ the Delhi High Court restrained the defendant from using plaintiffs registered trademark 'YAHOO', for manufacturing Gutka', chewing tobacco etc by passing a decree of permanent injunction and also held that the plaintiffs trademark cannot be used by the defendants for any types of goods or services.

In the case *Ciba Geigy Ltd. v. Surinder Singh*³⁹⁷ the Delhi High Court restraint the defendant's use of trademark Cibaca in the manufacture of filters used in vehicles as this was passing off plaintiffs trademark Cibaca and Ciba used in pharmaceutical products.

³⁹⁵ 2003(27) PTC (227) BOM.

³⁹⁶ 2006(32)PTC(157)DEL

³⁹⁷ 1998 PTC(18) (545) DEL

3.4.5 TRANS-BORDER REPUTATION DOCTRINE

Trans-border reputation of a product means a reputation formed beyond the border or geographical boundaries of a country. The uniqueness of this doctrine is that, though the goods or services of a certain trademark proprietor are not manufactured or sold in India, still, such trademarks are very popular in India as a result of the extensive publicity and advertisement of such products in India. Though such products trademarks are not registered in India, still the proprietor can oppose the registration of identical or deceptively similar mark of such trans-border reputed products. The protection which otherwise is enjoyed by the unregistered trademarks in India is given to such highly reputed trademarks having trans-border reputation. TMA 1999 also in India through Madrid Protocol and as a signatory of TRIPS agreement protect Indian trademarks for goods and services at an international Platform so we have to appreciate the Indian Parliaments effort for safeguarding the trademarks originating in India in World Market Economy.

In the Landmark case *N. R. Dongre & Ors v. Whirlpool Corporation & Ors*³⁹⁸ the Supreme Courts division bench in this case upheld an Passing off Action against an a proprietor with registered Trademark and the court held that in the action of passing off the trademarks registration is not relevant. And out of registration in no way does any novel right arises that apart from one which is already there in the Common law rights which is even without registering the mark. Reputation and goodwill was the right which was considered in the common law even before statutory enactment coming into force. Earlier before law being codified in India the ownership as a right to trademark was only by usage. This right is unaffected and interfered by the statutory enactment and is protected and saved by Section 27(2) and also section 33 of the Trademarks act 1999.³⁹⁹

³⁹⁸ 1996(16)PTC 476 DEL(DB)

³⁹⁹ Ibid; In this case the Court has taken the view that even advertisement of trade mark without existence of goods in the market is also to be considered as use of the trade marks.

The above Whirlpool Case is a Landmark judgment which gave rise to the Trans-border Reputation doctrine in this case the injunction was granted by Delhi high which was upheld by the Supreme Court. The main point of law was whether passing off action would lie in India even though the goods were not sold in India and whether the reputation and goodwill from passing off law has to be considered only where the actual usage is taking place⁴⁰⁰. This is one of the case law which helped to increase the radius of Passing off action from a local area to the entire globe which means that today the passing off action has acquired a status of International action.

The International Reputation of a Trademark makes the Owner entitled for obtaining Injunction in cases of Trans-Border Reputation ,hence the unregistered trademark which is protected in India by passing of action is also is extended to International Trademarks in India.

In *Milmet Oftho & Ors v. Allergen Inc*⁴⁰¹ the Appellant was not manufacturing products in India but was manufacturing in many counties of the world and here it was a point of law do be decided if a foreign company had a right to retrain the use of trademark outside its country and the court held that the appellant having word-wide reputation in the mark OCUFLOX the court decided the case in favour of the appellant.

Defendant's jurisdiction immaterial

Now days, due to the development of technology and media the publicity can be spread all over the Nation in few seconds. There is tremendous growth and development in the field of mass communication and advertisement which helps the product to gain publicity, popularity and reputation all over the Nation and world at large. The plaintiff might not carry his or her trade in

⁴⁰⁰See also; *Times Warner Entertainment Co. v. A.K. Das* [1997(PTC) (17)463] The court held that if the presence of the plaintiff in India is recognised holding that it has acquired a trans-border reputation and if it is found that the trademark sought to be adopted by the defendant is to deceive the same would definitely lead to erosion of the reputation of the plaintiff.

⁴⁰¹ 2004 (12) SSC 624

certain places where the defendant passes off such plaintiff's trademark in goods or services. In *Apple Computers v. Apple Leasing*⁴⁰² it was decided and an observation was made that in today's era due to the free flow of communication and information by way of advertisement through different medias like Television, magazine etc it is not a required element that the plaintiff should trade or conduct any business in a place or jurisdiction where the defendant makes unauthorized use or passes off plaintiff's trademark and where such defendant can be issued injunction by that jurisdiction Court of law.

Defenses against Passing-off action:

The following are the defenses available to the defendant to get relief against passing off action filed by the plaintiff.

- a) **Delay and acquiescence:** This means that action should not be taken after too long which also means the plaintiff should not sleep over his right of action.

Section 33 of the Trademark Act, 1999 speaks about Acquiescence, which says that if the trademark owner knows that someone is infringing his or her trademark in goods or services but does not take any action on this infringement and continues to keep quiet for a period of 5 years then such proprietor cannot claim such rights anymore.⁴⁰³ This principle is simple as it requires the genuine trademark owner to initiate the process of action as soon as such proprietor notices or comes across any person infringing its trademark. This can be done by sending a simple notice to the infringer telling such infringer to stop such act of infringement or else a suite of infringement and passing off would be started.

⁴⁰² (1993)IPLR (63); 1992(1) Arb. L. R. (93) DEL.

⁴⁰³Sec.35 Trade Marks Act 1999 : **EssentialsOfAcquiescence**

1. Ignorance of the other user about the proprietors to the title to the trademark.
2. Knowledge of unauthorized use of his trademark by the other.
3. No objection from the proprietor of the trademark despite the knowledge of unauthorized use of his trademark by the other.
4. The other person used it over a period of time.

In *Amritdhara Pharmacy v. Satya Deo Gupta*⁴⁰⁴ the use of trademark 'Amritdhara' by the petitioner was since 1903 and the same was registered in 1940. At a later stage the respondent started making use of a trademark 'Lakshmandhara' in the business similar to the petitioner in Uttar Pradesh and also filed for registration and the petitioner were aware of the respondents mark advertisement in the registry of trademark but took no action on the same. The Supreme Court held that the respondent can take the plea of Acquiescence and allowed the respondent not only to use the same but also to go for registration of its trademark for sale in UP only.⁴⁰⁵

b) No deception

When there is no deception on the part of the defendant the act of the defendant does not amount to passing off. If the defendant is able to prove that there is nothing which shows that the defendants act or product contains an element which gives rise to passing off wrong. Just because a suit has been filed by the plaintiff on the basis of reputation and goodwill, against the defendant does not mean that the defendant has in reality committed the wrong. If the plaintiff fails to prove that the defendant has passed off its product then the plaintiff loses the case. In the case *K. Narayanan and Anrv. S.Murali*⁴⁰⁶ the Apex Court held that passing off action cannot be initiated just if someone has applied the trademark for registration in the registry and the appellant cannot seek for injunction to restrain the respondent on that basis only as other requirements are not present to initiate such action of passing off.

Added matter principle not applicable: In case of Passing off it added matter principle, does not involve for e.g. if the defendant take support of prefix or suffix or trade dress in order to show that he has not copied the plaintiffs mark

⁴⁰⁴ AIR1963 SC 449

⁴⁰⁵ Sec.10(2) of Trade Marks Act, 1940

⁴⁰⁶ Civil Appeal No.4480-4481 of 2002 decided on 5th August, 2008.

and the consumer due to this will not get confused. **E.g.** If the infringer designs a product like ‘Bye **TaTa** Bye’ or ‘Worth Reliance’ or ‘**Apple** Tree’ either for similar goods or services or different products can amount to infringement or passing off. These are some of the examples which the researcher has highlighted but Courts in India has passed large number of injunction orders against the wrong doer for passing off the goods and services of genuine trademark proprietors.

In *Wockhardt Ltd v. Torrent Pharmaceuticals Ltd & Ors*⁴⁰⁷ the honorable Supreme Court resettled the principle of trademark law. The respected Court observed that action of passing off even though based on the deceit still fraud is not an element compulsory for right of action and the mental state of defendant is having no relevancy as regards cause of action of passing off. And so also the Supreme Court did not exercise Article 136 of the Constitution on the defendants’ side because the defendant already started using other mark.

In *Mahendra and Mahendra Paper Mills Ltd. v. Mahindra and Mahindra Ltd*⁴⁰⁸. The Supreme Court took a decision and held that Confusion or Deception likely hood must be decided by the courts and not by any witness as such witness is not entitled to decide the same.⁴⁰⁹

3.4.6 Cyber World and Passing off Action

The Delhi High Court in *Tata Sons Ltd & Anr v. Fashion id ltd*⁴¹⁰ on the basis of evidence and taking into account jurisprudence of trademark law granted permanent injunction on the defendant for using Domain name of the Plaintiff which is Tata Infotech the name was a part of Tata Group of Companies which is pioneer in Information Technology. The court said the principles of passing

⁴⁰⁷ Civil Appeal No. 9844 of 2018/SLP(C)No.9878/2018

⁴⁰⁸ 2000 (24) PTC (1) SC

⁴⁰⁹ Ibid. ‘‘All factors which are likely to cause or ally deception or confusion must be considered in combination; that broadly speaking factors creating confusion would be, for e.g. the nature of the market itself, the class of customers, the extent of the reputation, the trade channels, the existence of any connection in course of trade, and others’’

⁴¹⁰ 2005 (30) PTC 182(DEL)

off would apply to the domain infringement fully and passing off action should be available to the domain name which is distinct and the court also said that Internet too is like a Market where goods and services are sold and bought and hence the defendant were stopped by injunction from using the domain name tatainfotecheducation.com and was directed to give this domain back to the Plaintiff.

3.4.7 Passing off Service Mark of Club

There are many instances in India where the Service marks gets infringed and passed off by the infringers. Earlier before enactment of TMA 1999 service marks were not given statutory protection under the Act and they were protected only by passing off Action but now the proprietors of service marks files a passing off as well as infringement suit against the infringer provided such service mark is registered in the service category of Nice classification followed by TMA 1999.

In the case *International Association of Lions Clubs v. National association of Indian lion*⁴¹¹ the Bombay High Court passed an order of interim injunction against the defendants for forming a club by using the name 'Lion' and passing off the plaintiffs international level name and trademark 'Lions Club'.

Plaintiffs own control over its goodwill can be lost by defendants act (Lego Case)

This is a situation where if the defendant is allowed to infringe and passoff plaintiffs trademark, over a period of time there arises a condition where consumers and public starts believing knowingly or un knowingly that the defendant is the true owner and not the plaintiff and this situation takes place because the consumers mind gets brain washed due to some sort of Psychological effect. The result of this situation is that the plaintiff who is the true owner of such trademark loses its control on such trademark.

⁴¹¹ 2000(25)PTC(84)BOM

In *Lego System Aktieselskab and Anr v. Lego M. Lemelstrich Ltd*⁴¹² the Court observed the Principle that it is very well natural and apparent that whenever passing off takes place, the customers of the plaintiff moves and shifts to buying defendants products thinking that they are plaintiff's goods or services which also means that the defendant has taken undue and unauthorized advantage of plaintiff's reputation and goodwill⁴¹³.

3.5 EXTENDED PASSING OFF

There rises one more type of passing off where if a certain Quality of the Goods or service is misrepresented and in this manner causes injury to the Goodwill of the plaintiff. This means that here the action is not based on the traditional or classical principle of passing off where the 3 element of passing off are considered but this action is based and taken if any persons act or selling of a product causes harm and injury to the Quality of hard earned Goodwill. This means the traditional passing off concept has been enlarged and extended to base the cause of action by taking into account the goodwill's quality of the plaintiff's trademark in goods and services.

In *Erven Warnink v. Townend & Sons*⁴¹⁴ the popular Advocate Case, the defendant were sued for making a similar but not identical drink of the plaintiff called Advocaat but the defendant were in a position to sell and market this similar drink as Advocaat which belonged to the plaintiff .

Celebrities make use of Extended Passing off Action for the enforcement of Personality Rights whenever people use their names in some context without procuring their permission.

⁴¹² 1983(FSR) 155

⁴¹³ *Legocase*; for e.g. A customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of plaintiff's plastic toy construction kits for is children if he believed tat it was made by the defendant. The danger I such a case is that the plaintiff loses control over his own reputation.

⁴¹⁴ 1979 (AC) 731

3.6 Passing off Well Known Trademark;

In *Kamal Trading Co. v. Gillette U.K. Ltd*⁴¹⁵. The Bombay High Court held that ‘7 O clock’ trademark in blades is a very well Known all over and if the same trademark is used in the business of tooth brush then it will amount to passing off.

The Amendment of Section 39 says that that the Unregistered Trademark now can be transmitted or assigned along with goodwill or without it of the business and this amendment has made the legislation in line with TRIPS Agreement’s Article 21.

Sometimes in a business dealing, where there is a sale of a property located in a particular geographical region the purchaser along with such property also acquires certain rights connected with such regions.

In *Bloomfield Co. Ltd v. Bagaria Business (P) Ltd*⁴¹⁶ the Calcutta High Court held that it is a settled principle of Law that with a transfer of property’s title, its goodwill also gets transferred. In this case a tea estate in the name ‘Bloomfield’ from Darjeeling was transferred by the plaintiff to the defendant and when the defendant started using the name Bloomfield, the plaintiff brought an action of passing off upon which the court decided the case in favour of defendants as the defendants acquired all the geographical rights to use the disputed name and also as the right to goodwill was divested by the plaintiff on such sale.

3.7 Reverse Passing Off

Reverse passing off is a situation where the defendant sells the plaintiff’s products as his Own⁴¹⁷. The defendant does this by removing the plaintiff’s

⁴¹⁵ 1988(PTC) 1.

⁴¹⁶ 2002 (25) PTC (40) Cal.

⁴¹⁷See in *Dastar v. Twentieth Century Fox Film Corp.*, 539 U.S.23 (2003); Mr. Justice Scalla of the United States Supreme Court stated “Passing off or Palming off , as it is sometimes called occurs when a

trademark and then affixes or labels the product with defendant's own trademark and creates an impression that these products are produced by the defendant⁴¹⁸. In *Sheila Mahendra Thakkar v. Mahesh Naranji Thakkar*⁴¹⁹ the Bombay High Court made an observation that reverse passing off is a misrepresentation which is actionable in nature and this action follows the principles of passing off.

In *Zee Telefilms Ltd. and Anr v. Sundial Communications Pvt. Ltd. and Ors* an observation was made by the High Court of Bombay that Passing off involves passing off goods and services of one person as that of another person whereas Reverse passing off involves passing off goods and services of another person as mine.

Reverse passing off concept highlights and brings into the notice that product also has a value and same can be misused and infringed by the defendant in a sense that the defendant in this case wants to sell the plaintiff's product as the defendant's own created or manufactured product by either affixing or by using any other mala-fide idea or by labeling such plaintiff's product as the defendant's own product.⁴²⁰

Since there is no provision for dealing with reverse passing off under the Act, hope in the near future the legislature takes into account to control and prevent this menace of reverse passing off too and they make provision under the concept of reverse infringement under the statute as a situation can arise where

producer misrepresents its own goods or services as someone else's. Reverse passing off as its me implies is the opposite: The producer misrepresents someone else's goods or services as his own."

⁴¹⁸ K.C. Kaillasam & Vedaraman, *Law Of Trade Marks* (3rd Ed. 2013, LexisNexis, Gurgaon Haryana) P.415.

⁴¹⁹ 2003(27)PTC(501)

⁴²⁰ See also *Gloag & Sons Ltd. v. Welsh Distilleries*⁵ The complaint of plaintiff was that defendants who were manufacturing Welsh whisky were using *Scotch Whisky* and therefore activities of the defendants would dilute the reputation and goodwill attached to the Scotch whisky because by selling Scotch whisky as Welsh whisky the defendants would be achieving a reputation for Welsh whisky which truly belongs to Scotch whisky so that in the end the reputation which belongs exclusively to the latter would be shared by Welsh whisky as well.

the infringer reverse passes off registered trademark in goods or services in a certain classification of goods or services.

3.8 Distinction between Infringement and Passing off Action

It is a well known fact that an infringement suit is a statutory right of the registered trademark proprietor whereas passing off action is a common law right of action which can be resorted to by unregistered as well as registered proprietor of a trademark. In *Kaviraj Pandit Durga Das Sharma v. Nav Rattan Pharmaceuticals*⁴²¹ the Supreme Court held and differentiated between infringements and passing off action as the latter is a remedy under Common Law and the former is statutory relief under the Act to protect and get the exclusive right in the trademark.

Infringement action can be taken under the statute only to stop infringement of certain goods or services falling under certain classes where else passing off action can be initiated even if the infringing goods or services belong to different classes hence we can say that the passing off action is wider in scope than the infringement action. In India there are scores of case laws which tell us that whenever an infringement suit is filed, such suit is always accompanied by a passing off action and this is also evident that if by chance if the infringement suit under the statute fails then passing off has succeeded. We can say that passing off action always like a true companion walks with an infringement suit but the vice versa is not true always.

3.9 REMEDIES FOR INFRINGEMENT AND PASSING OFF

In India as the business world has developed Nationally as well as Internationally so also the Infringement of Trademark has also risen up to a great extent. In order to curb this menace of Infringement there are different *Remedies* available in India under different Legislations and judge made law

⁴²¹ AIR1965 SC980, 1965 SCR(1)737

available for protection of trademark which is registered as well as un-registered.

The Researcher has analyzed these remedies which are available by studying the relevant statutes and other laws as this is very significant for the safeguard of the Trade Mark or Service Mark from being misused or infringed by the infringer. In case there is an infringement action under Civil Law as well as Criminal law can be enforced together. Without a relief for infringement and passing off of the product, it would affect the business world very badly as there would be rampant and merciless miss use of genuine proprietors trade and service marks by unscrupulous persons practicing unfair trade in the society harming the health and economy in India as well as the world at large. The Delhi High Court in *Novarits AG & Anr v. Dr Mukundakam Sharma*⁴²² stopped the defendant from using NOVERAN in producing products of pharmaceutical business, by way of injunction as its use was similar to the Plaintiffs pharmaceutical products trademark 'Vovran'.

The above case sets an example that the infringer is not hesitated or ethical enough that even the medicine business is not spared, if the point of infringement comes, even at the cost of other people's health and life. In this context a great amount of gratitude and appreciation goes to all the Legislatures and Law makers in India and other countries too for framing a complete law to tackle and eliminate the menace of infringement and passing off. The following are the various remedies for infringement and passing off action.

- A. Civil Remedy
- B. Criminal remedy under the Trademarks Act as well as under IPC
- C. Administrative remedy
- D. Other Remedies under specific legislations
 - a. Customs Act 2013
 - b. Companies Act 1962

⁴²² 2003(26)PTC(226)Madras.

- c. File Complaint with ‘IN Registry’ which solves the dispute in accordance with the IN Dispute Resolution Policy (INDRP) which appoints an Arbitrator.

3.9.1 CIVIL REMEDIES

All Trademarks legislation in India provided to file Infringement/ Passing off action. It is interesting to know that the right of action in case of infringement of trademark was provided in the most earliest statute by the framers of the statute during the pre-independence period right from 1887 till 1958.⁴²³ Trademark law was amended in the year 1999. Under this law also similar provisions are laid down for the protection of trademark. Trademark Act of 1999 contains provision for civil remedy in case of infringement as per **Sec.135**: Whenever any person files a civil suit he mostly files it in order to get a relief for the act of infringement by the Infringer *Sec.135* of the Trademarks Act 1999 speaks of Remedies and reliefs the trademark proprietor may avail in case of infringement and passing off of such proprietor’s trademark.

Sec.27 (1) of the Trademarks Act 1999 entitles a registered trademark proprietor to file a suit in order to stop the infringer from infringing its registered mark and also to claim and get the damages. The Court which is not lower than District court can grant the relief in such matters⁴²⁴.

⁴²³**a)** Indian Merchandise Marks Act 1889, the earliest Act during the British India period in which there was provision to initiate action in the court of law in the event of infringement of the trademarks by way of counterfeit and false description of trademarks.

b) Trade Marks Act 1940, contained provisions to initiate legal proceedings in the event of infringement of trademark.

c) Trade and Merchandise Marks Act 1958 as a similar provision in Sec. 58 as in Sec.27 of Trademarks Act 1999.

⁴²⁴ Passing off Action – Title to Sue in Representative capacity: There are two factors in this respect :

1. Does the Plaintiff have an interest which will entitle him to bring proceedings.
2. If the Plaintiff as some interest is that interest the same interest as those that e seeks to represent?

See *Scotch Whisky Association and Anr v. J.D. Vintners Ltd.*[1997 EUR L.R. 446]The Vice-chancellor recorded at P.452. ‘It is as I understand it, accepted by the plaintiff that the association does not have a cause of action in passing off. If that it is accepted, it is, in my opinion, rightly accepted. I cannot see on what basis a trade association can maintain a passing off action base upon conduct which constitutes a passing off by the defendant of its products for those of the members of the trade association’.

Person eligible to file the suit: Following persons are eligible to file infringement or passing off suit before the appropriate court for civil remedy;

- a) **Registered Owner:** Proprietor who has registered his trademark or whoever is his legal successor.
- b) **Assignee:** By giving a prior notice to the owner of trademark, a registered user or assignee can also file a suit⁴²⁵.
- c) **Legal heir:** Legal heirs of the owner of trademark can file a suit.
- d) **Joint owner/proprietor:** In case of joint owner of trademark, any of the joint owners can file such suit.
- e) **Foreign Proprietor:** In case of infringement in India, of trademark of a foreigner, then such proprietor can file a suit in India.

Persons liable for an infringement Action:

- a) **Infringer:** Whoever passes off or infringes a trademark of any person will be liable to be sued either for infringement or passing off or both.
- b) **Agent of Infringer:** The Agent of the person who infringes the trademark while selling or trading with plaintiffs trademark in goods or services and this can cover selling as well as manufacturing on behalf of the Primary infringer
- c) **Master who instructs:** If any master orders or gives instruction to his servant in an employment to commit the wrong of infringement or passing off then such master is liable for an action under the statute as well as under common law of passing off.
- d) **Promoters/Directors of Company:** In a Limited Company the promoters or the directors of such Company in case they are personally involved in commitment of infringement or also if they gave direction to commit such an act. For e.g.

⁴²⁵ See: In *Ihlee v. Henshaw*[(1886) (3)RPC] it was held that the plaintiffs who were unregistered assignees of the trademarks, could maintain an action for infringement and that the registration of the assignment was not a 'condition precedent on the part of the assignee to suing'

1. If such designated person of high rank at the time of formation of such company uses a company name by infringing someone else's registered trademark or unregistered trademark as the case maybe.
2. If the directors or promoters gives instructions to the subordinates to conduct the business of manufacturing or selling by infringing someone else's trademark either registered or unregistered, such promoters or directors can be sued.

Jurisdiction to avail civil remedy for Infringement and Passing-Off

Sec. 134: District Court jurisdiction;

Before going through the different reliefs provided by the trademark law, we must also be aware that the suit for infringement and passing off cannot be instituted in a court which is below and lower than district court. In *Allied Blenders Distillers v. Parag Distillers*⁴²⁶ the Delhi High Court had to decide on a territorial jurisdiction taking into consideration *Quia Timet* were the honorable court held and decided that there is no imminent of the defendant selling the product in Delhi just because the defendant is presently selling the said product in Andhra Pradesh and hence there is no cause of action in Delhi for the plaintiff.

Appeal on Infringement/Passing off decision/order; The Researcher has enumerated the different courts in India where infringement and passing off action can be initiated right from the filing of suit up to the appeal.⁴²⁷

District Court (Original Jurisdiction)

⁴²⁶ FAQ(OS)No.49/2017 & CM No. 6951-54/2017

⁴²⁷ Enforcement Of Trademark Rights in India:

- a) The Supreme Court of India is the Apex court of Indian Judicial system.
- b) Subordinate to it are the 24 High Courts that together form the second tier of the Indian Judiciary. Most of the significant trademark and other Intellectual property case law over the last 3 decades have originated from the decisions of the high Courts of Delhi, Bombay, Calcutta and Madras.
- c) The 3rd tier of the Indian judicial system consists of over 600 District courts. <https://www.thelawreviews.co.uk/Chapter/1143664/india>

Aggrieved proprietor can file a suit in district Court if anyone infringes such proprietor's trademark in goods or services.

High Court (Single Bench)

A District Court of original jurisdiction's order or decision can be appealed in the Original jurisdiction of High Court.

High Court (Division bench)

When a single bench of High Court gives a decision or judgment, an appeal can be made against such decision to the Division Bench of High Court and this is 1st Appeal, regular.

Supreme Court

In Supreme Court by filing a Special Leave Petition (SLP), the judgment of such 1st appeal division bench of High Court can be very well challenged.

Now let us look in to the relief the court can grant in case of infringement and passing off. The relief may be permanent in nature or temporary in nature. This relief is in the form of injunctions. Besides injunction court has awarded new reliefs like Anton Pillar order, Mareva injunction etc.

1. Injunction

This is the most important relief any genuine trademark proprietor would want to get so that he permanently stops the infringer forever from infringing his or her trademark. This normally is the last stage of courts proceeding wherein the court takes this decision after giving both the parties fair hearing and also after going through the records and evidences so that there is no injustice done on

either of the litigants⁴²⁸. The researcher has explained some of the most important and known permanent reliefs given by the court of justice in India in the infringement and passing-off cases⁴²⁹.

A. Perpetual Injunction: In case there is an infringement action filed the court may restrain a defendant permanently forever from Infringing the Trademark of the defendant. Mostly this injunction is passed once the suit is decided finally⁴³⁰. Mostly this injunction is granted after the Interim order or even sometime where no such temporary order is passed at all⁴³¹. Any person who initiates a infringement or passing off action always aims for an permanent injunction as the genuine trademark owner always wants to stop the infringer from committing the wrong of infringement forever wherein the plaintiff does not mind even if cost is not recovered from defendant but what is more important for the plaintiff is stopping the defendant permanently from using the plaintiffs trademark in an unauthorized manner. In *Rupa & Co. Ltd. v. Dawn Mills Co. Ltd*⁴³² the Gujarat High court granted injunction against Rupa Co. for using ‘Don’ mark and infringing Dawn Mill’s ‘Dawn’ a registered trademark and also said that this is a very fit case for such an action. Here this is more of a case of Phonetic similarity where in the pronunciation sounds deceptively same. There are many judgments passed by the Indian courts including the

⁴²⁸ The trademark ‘Destro’ and ‘Destrol’ were held to be deceptively similar and hence Injunction was granted. See *Vijay Grover v. Biocure Laboratories* [2002(24)PTC (438) DEL: (2002) (95) DLT (614)]

⁴²⁹ ‘Registered Trademark If not used’ In *Cluett Peabody & Co. Inc. v. Arrow Apparals* ((1998)PTC(18) (156)) the court held that ‘It is true that registration of the mark confers proprietor rights even if the mark is proposed to be used and it is not actually used but if the mark is registered and it is not prima facie used for thirty years, then the court should be slow in granting injunction’

⁴³⁰ See *Smith Kline Beecham Plc v. Lalitabhai Pael* [2004(28)PTC(330)DEL] The Delhi High Court held that the defendant’s trademark, ‘Letnez’ which is the reverse form of plaintiff’s mark ‘Zentel’ is closely Similar and the court granted permanent injunction against the defendant. Both parties’ goods are Pharmaceutical products.

See *Burger King Corp. v. Gurpreet Singh Sekhon & Ors* (CS (OS) No. 959 2015DEL) A highway restaurant infringed Burger Kings trademark and continued to do the same, the court in this case appointed a local commissioner to visit the restaurant and physically paint over wherever the name appeared, including all along the highway.

⁴³¹ Maintain Status Quo: See *A lfred Dunhill v. Sunoptic* ((1979) FSR(337) (P.376)) The Court observed that a order of injunction ma sometime require preservation of *Status Quo* or more fully *Status quo ante* means simply the existing state of things , existing before a particular point of time and which may well vary in different cases.

⁴³² AIR(1998)Guj.247

Apex Court where in permanent injunctions were granted when trademarks were infringed or passed off by phonetically similar trademarks.

The Bombay High Court in *Pizza Hut International LLC v. Pizza Hut India Pvt. Ltd.*⁴³³ passed an decision and held that Pizza Hut International, is having an reputation world over and hence injunction was passed against the defendant.

The Delhi High Court in *Intel Corporation v. Divakaran Nair and Ors*⁴³⁴ passed an order of Permanent injunction against the defendant for coining a mark as Art Intel and by this act infringing a trademark 'INTEL' owned by Plaintiff. This is a case of infringement by using an identically similar trademark by deceptively making use of the word 'Art' as a suffix before the infringed mark Intel.

B. Interim Relief/ Temporary Relief

When there is a likelihood of the Suit for infringement going for a long period of time the Plaintiff would always want some Interim relief. Many a time a Court in India does not decide the case urgently as the court has to follow the principle of Natural Justice and decide the case on merits taking into consideration the facts and evidences of each case. So in such a situation there is a possibility many a times that the Court passes a order of temporary injunction so that the defendant is stopped from committing further wrong but if the defendant successfully convinces the court that such defendant as some right in the disputed trademark, then there is ever likelihood that the Court may vacate such temporary injunctions.

⁴³³ 2003(26) PTC (208) Bom.

⁴³⁴ 2006 (33) PTC (345) DEL

Exparte order / Interlocutory injunction

The Governing Act of trademark provides for ex-parte injunction in certain genuine cases so as to prevent delay in action for e.g. If someone is infringing or passing off a pharmaceutical trademark, or a trademark which deals with food and drink products, or if someone is infringing the trademark of insurance or finance companies, then the court considers urgency of situation and passes a ex-parte order of injunction or any other relief.

Sec.135 (2) in certain cases of infringement and passing off suit the Indian Courts have started passing ex-parte order against the defendant as this is now permitted under the Act. The Judge has to record the reasons for passing such order.

In *Prabhu Shankar Aggarwal v. Anand kumar and Deepak Kumar*⁴³⁵ the Delhi High Court held that while exercising the power of passing ex-parte injunction the court must be pass such decision cautiously.

Grounds to set aside or vacated Ex-parte Injunction

Many a time there are possibilities that sometimes the defendant is innocent and is being sued without committing the wrong of infringement or passing off. In such situation the defendant can vacate the injunction under the provision of Civil Procedure Code.

Sec. 39(4) of Code of Civil Procedure provides for setting aside or discharging of the Ex-Parte injunction if the aggrieved defendant in the court files an application with the valid defense that the plaintiff has concealed the true facts and as also misrepresented the true facts of the case and has managed to get the injunction in its favour⁴³⁶.

⁴³⁵ 2002(24)PTC(292)DEL

⁴³⁶Sec. 39(4) CPC 1908 : Orders for injunction may be discharged, varied or set aside;

a. Provided that if an application for temporary injunction or in any affidavit supporting such application a party has knowingly made a false or misleading statement in relation to a

In the case *Apple v. Rohit Singh*⁴³⁷ the Delhi high court's division bench on appeal passed an order of setting aside and vacating the Exparte order of injunction given against the appellant 'Apple' and also the court held that while taking a decision in trademarks cases only in an prima-facie case such order of Exparte injunction can be granted.

Ex-parte injunction truly speaking is against the principle of Natural Justice where fair hearing has to be given to both the party and the Court in India should follow the principle of *Audi Alteram Partem* which means the court should always hear the other side and then only pass an order. There are many time such Exparte injunctions are being misused by the plaintiff by misrepresenting the facts to the honorable court. Hence such injunction should not be encouraged by the court in India as it can cause hardship to the common man who is innocent and has not committed wrong but yet is being enjoined by an Exparte order.

C. Mareva Injunction

Whenever a court order is passed, there are chances that the defendant might dissipate its own assets with an intention to defeat the courts order⁴³⁸. But the court has to be satisfied and convinced by the plaintiff that there is a prima facie reason for the same and that there exist a great threat and danger that the defendant is likely to dispose, destroy, deal and dissipate its own asset to eliminate the proof in order to weaken the courts judgment or order to recover costs or remedies etc against such defendant⁴³⁹.

material particular and the injunction was granted without giving notice to the opposite party, the court shall vacate the injunction unless for reasons to be recorded, it considers that it is not necessary so as to do in the interest of the parties.

- b. Provided further that where an order for injunction has been passed after giving to a party an opportunity of being heard, the order shall not be discharged, varied or set aside on the application of that party except where such discharge, variation or setting aside has been necessitated by a change in the circumstances or unless the court is satisfied that the order has caused undue hardship to that party.

⁴³⁷ FAO(OS)(COMM) (11)(2016)DEL

⁴³⁸ Sec. 135(2)(c) Trade Marks Act 1999

⁴³⁹ Thomas Philip, *Mareva Injunction*- Overview : *Mareva Injunction* has come a long way since its inception in the English Jurisprudence some time in 1975, are essentially a species of interlocutory

The Delhi High Court in *WWF v. Vinayak S* froze the defendant's Bank account for selling WWE merchandise online.

2) Anton Pillar order:

This order is Ex-parte which directs to inspect the defendant's premises and prevents the defendant from destroying the evidence of 'Infringing goods'⁴⁴⁰. The Court appoints a local Commissioner *Under CPC* under *Order 26* to inspect premises and make the required noting and a report is made and such goods are kept with defendant with a condition that he cannot dispose them has to produce the same in the Court whenever ordered. For the first time such order was passed by the court in UK. Indian courts also adopted the same Anton Pillar Order in case of trademark infringement.

In *La Chemise Lacoste v. R. H. Garments*⁴⁴¹ the Delhi High Court passed an order of permanent injunction against the defendant and stopped the defendant from using trademark, CHEMISE LACOSTE, CROCODILE Device and LACOSTE trademark permanently and also ordered the defendant to hand over whatever remaining stock like packaging, moulds etc with such mark to the plaintiff and also destroy the same.

3) Discovery Orders/Norwich Pharmacal Order, given by the Courts for the purpose of disclosing information or disclosing some required documents⁴⁴². When information to establish infringement is not within the

injunction which seeks to restrain a defendant (personally or through his or her agent) from dealing, removing or disposing assets which may be necessary to meet a plaintiff's claim. In essence it is preventive relief which restrains a defendant who has assets within the jurisdiction of the court from dissipating those assets before a judgment can be obtained. <https://www.lexisnexis.com>

⁴⁴⁰See *Bucyrus Europe Ltd. v. Vulcan Industries Engineering Co. Pvt. Ltd.* ((2005) (30) PTC(279) CAL-DB) The Calcutta High Court held that Anton Pillar order can be passed in the following situations;

- I. Where the plaintiff is having an extremely strong *prima facie* case.
- II. Where the actual or potential damage to the Plaintiff is very serious.
- III. Where it was clear that the defendant possessed vital evidence.
- IV. There was real possibility that the defendant might destroy or dispose of such material so as to defeat the ends of justice.
- V. The purpose of Anton Pillar order is the preservation of evidence.

⁴⁴¹ 2006(32)PTC(481)DEL

⁴⁴²**Discovery Order:** Discovery is possible only after legal proceedings have commenced. Under the provision of Order 11 Rule 1 of the code of Civil Procedure 1908, discovery can be by interrogatories,

reach of the plaintiff like Customs record etc and when such information is required to take legal action who has wronged by committing infringement or passing off⁴⁴³. In the case *Bridgestone Corp v. Tolins Tyres*⁴⁴⁴ a Norwich Pharmacal order was passed by the Delhi High Court and asked the custom officer in Raxaul to give the information and documents as regard defendant's export. The defendant was exporting to Nepal by infringing the plaintiff's trademark by using the deceptive mark 'Bridestone' and yet not admitting and denying the same⁴⁴⁵. This infringement involves a phonetic similarity also.

Burden Of Proof; The burden to prove that the defendant's mark is infringing the plaintiff's registered trademark is that of the plaintiff and this has been laid down by the Supreme Court in *Kaviraj Pandit Durga Dutt v. Navratna Pharmaceutical Laboratories*⁴⁴⁶ by holding that in order to establish that the defendant's mark is identical or is deceptively similar to the plaintiff's trademark, the onus will be on the plaintiff. This is a fair principle set by the Apex Court as it would be a injustice on the defendant if without committing an infringement or passing off, such defendant is wrongly sued by the plaintiff and in spite of this if the defendant had to prove that he or she has not committed such wrong. That is why the Supreme Court of India has laid the burden of proof on the shoulder of plaintiff' was is supposed to come to the court with a very clean hands.

delivered with the leave of the court, for the examination of the opposite parties. So long as interrogatories are relevant, they can be allowed.

<https://www.thelawreviews.co.uk/Chapter/11434/india>

⁴⁴³*Norwich Pharmacal Order*: Is a Court Order for disclosure of documents and this order was granted against 3rd party which has been innocently mixed up in wrongdoing, forcing the disclosure of documents or information. <https://www.en.m.wikipedia.org>

⁴⁴⁴ CS(Comm.)No.(375) 2016 DEL

⁴⁴⁵*See, Louis Vuitton v. Pankaj Sharma*. This case was filed against e-commerce websites that were offering for sale counterfeit products bearing LV trademarks, the Court directed one of the defendant i.e. HDFC Bank Ltd. , New Delhi, to disclose to the plaintiff the particulars of the account holder through which the relevant transactions were being conducted. Similarly the Department of Telecommunications and the Ministry of Electronics and Information Technology were also directed to file in the Court in a sealed cover the details of the registrants of the impugned websites. The Department of Telecommunications and the Ministry of Electronics and Information Technology were also directed to immediately block access to the said impugned websites.

⁴⁴⁶ A.I.R. 1965 S.C. 980

After going through the perpetual or temporary relief for violation of infringement and passing off. Now let us understand the idea and kinds of damages.

4) Damages

In case the plaintiff suffers any loss due to use of the registered trademark without obtaining permission or consent court can award damages to the plaintiff. Court can award the following types of damages:

a) *Compensatory Damages*

The Court may pass an Order directing the defendant to pay damages to Plaintiff as Compensation. Here due to the misuse by the defendant done of the trademark of the Plaintiff the damages might be even more than the Actual profit earned by the defendant and this is calculated by taking into consideration the Actual loss suffered by the plaintiff because of the Unlawful Act of the defendant.

In the case *Yahoo Inc. v, Sanjay Shah*⁴⁴⁷ the Delhi High Court passed a decree of 5, 05,000 damages along with the proportionate cost to be given to plaintiff by the defendant.

b) *Punitive damages*

Whenever an action has Criminal Propensity Punitive damages are given to deter the Infringer from committing such wrong act. These types of damages are awarded by the courts whenever the defendant contempt's the earlier passed judgment against such defendant. In other words when a injunction is issued against the defendant to stop committing a particular wrong and still if the defendant continues doing the same then the court passes such order of punitive damages for disobeying and disrespecting the Law. These types of punitive damages are passed by the Indian court in the matters of trademark

⁴⁴⁷ 2006(32)PTC(157)DEL

infringement cases many a times. This truly helps in safeguarding the proprietary rights of the genuine trademark owner as the infringer knows that consequences of committing the wrong and hence does not take it granted as he would have to pay a huge sum of money. In *Whatman International Ltd. v. P. Mehta & Ors*⁴⁴⁸ the Delhi Court passed a judgment awarding a decree to the plaintiff of a punitive damage of Rs.1,85,00,000/- and the defendants were told to pay this amount to the plaintiff in a period of 3 months time. This judgment was given by the court in the month of February 1st, 2019. This exemplary damages was given because the defendant contempt of the court order in which the court had passed an order interim injunction to stop selling the counterfeited goods but despite of this the defendants continued the practice of selling the same and showed disrespect to the court order.

In *Cartier International AG & Ors v. Gaurav Bhatia & ors*⁴⁴⁹ the Delhi High has granted Rs One Crore as Punitive damages against the Defendant for using the Plaintiffs trademark, the Plaintiff got this order Ex-parte.

The Delhi High Court in *Time Incorporated v. Lokesh Srivastava & Anr*⁴⁵⁰ passed an order of Ex-parte Permanent Injunction and restrained the defendants from infringing plaintiffs registered trademark 'TIME' and 'TIME ASIA' by adopting the name 'TIME ASIA SANSKARA'. Also the court ordered the defendants to pay 5 lakh as damages and another 5 lakh as punitive damages to the plaintiffs. The court in the favour of plaintiffs also ordered the rendition of accounts by the defendants from the year 1999 till the judgment dated 3rd January, 2005.

⁴⁴⁸ CS(COMM) 351/2016 & I.A. 5235/2018.

⁴⁴⁹ 2016(65)PTC(168)DEL.The Delhi court awarded Rs10000000(151000\$Approx) in Plaintiffs favour and the Plaintiff have been also granted permanent injunction restraining the Defendants from selling or offering for sale any goods bearing the Trademarks of the Plaintiffs or any other similar mark .

⁴⁵⁰ 2006(131) CompCas (198) Delhi,116(2005)DLT(599)2005(30)PTC(3)Del; 'the award of compensatory damages to a plaintiff is aimed at compensating him for the loss suffered by him whereas punitive damages are aimed at deterring a wrong doer and the like minded from indulging in such unlawful activities . Whenever an action has Criminal Propensity also the punitive damages are clearly called for so that the tendency to violate the laws and infringe the rights of others with a view to make money is curbed “

Exceptions to Damages

Sec. 135(3) of the Act has expressly provided the exceptions to the damages prayed for by the plaintiff in the court in the matter of infringement or passing off. This means that if the defendant shows that the mark for which she or he has been sued for is falling in one of the following⁴⁵¹ :

- I.** Certification Mark
- II.** Collective Mark
- III.** Unaware that the plaintiff was the registered trademark owner.
- IV.** Ceased to use the impugned mark as soon as he was aware of the plaintiff's ownership in the registered trademark.

5) Accounts of Profits

In this case the Court may pass an order directing the defendant to hand over the money earned by infringing the trademark of the plaintiff. It is important to note that while calculating the Accounts of profits the damages suffered by the Plaintiff is irrelative and is truly calculated only on the actual profit made by the defendant by selling the infringing goods.⁴⁵² The court will pass such orders by verifying the account books maintained by the defendant. In *TI Diamond Chain Ltd. v. Santos Singh*⁴⁵³ the Delhi High court restrained the defendants from the use of trademark 'Diamond Super' and 'Diamond' as it caused infringement of the plaintiff's trademark. The court also passed an order of rendition of the accounts as regards the profit made by the defendant.

6) Delivery up of the things which infringes like Advertising, products etc which has to be handed over to the plaintiff by the defendant as per the Court Order.

⁴⁵¹Sec. 135(3) Trade Marks Act 1999.

⁴⁵²*Time Incorporated v. Lokesh Srivastava And Anr* (2006(131)CompCas(198)DEL(116)(2005)DLT(599) 2005(30)PTC(3)DEL)

⁴⁵³[(2004)(28)PTC(400)DEL]

In *Toyota Jidosha Kabushiki Kaisha v. Deepak Mangal and Ors*⁴⁵⁴ the Delhi High Court after passing permanent injunction order against the defendant restraining them from using plaintiff's registered trademark 'TOYOTA', 'TOYOTA DEVICE', 'INNOVA' and other trademarks, also ordered the defendants to deliver the infringing goods and packing so also other material to the plaintiff for the purpose of destroying and erasing the same and so also ordered a sum of Rs. 10 lakh punitive damages to be paid to the plaintiff by the defendant also the payment of fee of the counsel and actual cost were to be paid by the defendant incurred by the plaintiff. The judgment was passed by the court on the principle of *Justice, Equity and Fair play*.

Defences for a suit in infringement and passing off: In the cases where the defendant is sued unreasonably without committing a wrong such defendant can always protect his or her rights on the basis of the following defensive ground.

- a) **Sec. 30** lays down different acts of a person not amounting to infringement and these acts, under this section can be a defensive ground for any person if such person falls in one of these acts.
- b) If any person without knowledge of the existence of some ones, trademark uses in good faith, such other persons trademark honestly over a long period concurrently with the true owner then such person can plead such innocent act, as a defense in an action for infringement.
- c) Whether registered or unregistered a Prior User cannot be sued for an infringement even if such prior user's trademark is identical or deceptively similar to the trademark which used later then such prior user.
- d) If the person who is sued has got a concurrent registration for such sued trademark then this becomes a defense for such sued trademarks proprietor.

⁴⁵⁴ CS (OS) No. 2490/2009.I.A. No. 14981/2014.

- e) Description of goods, Name, address etc used in a bonafide manner b the defendant gets protection under the trademarks Act.
- f) Many times the court debars a plaintiff due to the conduct of such plaintiff, from taking an action of infringement or passing off e.g. Acts like delay, acquiescence, latches etc.
- g) The defendant can plead the Goods or Services are not same and are different and so also the nature of the Goods and service is not alike.
- h) There is no deception/ confusion created at all and is absent completely.

Contempt by the defendant

In India there is a high respect to the courts order which has to be followed by every citizen and if any person disobeys such an order that it is called contempt of such court order and such person can be punished by imprisonment or fine or both. In a situation where the court passes an order of permanent or interlocutory injunction or any other decree against the defendant and if the defendant contempt's such order by disobeying the same or continuing with the wrong of infringement or passing off, then the court may pass an order of detention against such defendant in a prison⁴⁵⁵. In *Esso Sanitation v. Mascot Industries*⁴⁵⁶ the Delhi High Court held that that the judgment debtors use of the trademark 'Osso' was contempt of the court order as the court earlier had restrained and stopped the use of the plaintiffs trademark 'Essco' as the use of 'Osso' mark was deceptively similar to the plaintiffs trademark. The court detained the defendant in the Prison under civil order as the defendant even after giving a opportunity to stop continued using the disputed mark.

⁴⁵⁵ Order 39 of CPC 1908

⁴⁵⁶ (1982)PTC(302)DEL

Intention to deceive/ Fraud are not necessary Element in Infringement/Passing-off Action: This has been laid down by Supreme Court and other courts in India while deciding the infringement and passing off suits⁴⁵⁷.

The Supreme Court in *Parle Products (P) Ltd. v. J. P. & Co. Mysore*⁴⁵⁸ made observations that it is sufficient to consider the essential and important features of the trademark of plaintiff and defendant, so as to decide if the infringing mark of the defendant is deceptively similar to the plaintiff's trademark.

Tests for infringement and passing off action

Tests for infringement and passing off action as regards likelihood of Deception /Confusion are same. In simple words this means that even if there is a minute possibility that deception could happen or confusion could take place by use of certain trademark in goods or services then this can amount to infringement or passing off or both. In *Ruston and Hornsby Ltd. v. The Zamindara Engineering Co.* the Supreme Court held that in passing off action and in infringement action, likelihood of deception and likelihood of confusion test are same.

In *Daimler Benz Aktiengesellschaft v. Hypo Hindustan*⁴⁵⁹ the Delhi High Court single judge held that 'Benz' trademark is well recognised in the Automobile business worldwide and if a conflicting mark to Benz is used for undergarments business it would amount to confusion in the market and the Division Bench confirmed this decision and which was again upheld by the

⁴⁵⁷ ibid

⁴⁵⁸ A.I.R. 1972 S.C. 1359, see also, *Laxmikant Patel v. Chetanbhai Shah* [2002(24) PTC (1) S.C.]The Supreme Court stated as follows; The 3 Elements of Passing off are the :

1. Reputation of Goods.
2. Probability of Deception.
3. Likelihood of Deception.

In this case the Supreme Court, further held that "Passing off cases are often cases of deliberate and Intentional Misrepresentation, but it is well settled that fraud is not a necessary element of the right of action and the absence of an intention to deceive is not a defense in an action for passing off though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception."

⁴⁵⁹ AIR(1994)Deli(239)

Supreme Court. Here the defendant made use of a identical trademark to deal with goods of different classification but was injuncted as the plaintiffs trademark is a well known trademark all over the world.

General Principles to avail remedies:

Limitation Period for filing an Infringement and Passing off Suit: The *Limitation Act 1963* lays down the period for filing the suit in case of Infringement which is 3 years from the occurrence of Infringement. In ***Timken Co. v. Timken Services Pvt. Ltd***⁴⁶⁰ the Delhi High court held if a person continuous to commits deceitful act then every new act a fresh cause of action takes place for the plaintiff. Hence every time a person commits an act of passing off goods as of others continuously, every such time an infringement of trademark takes place and since the infringement of trademark which is also a breach, is recurring, a fresh cause of action takes place.

Sec.22 Limitation Act 1963; Says that whenever a tortuous action of passing off is committed, it is continuous wrong , and every time defendant commits this wrong a new cause of action starts and a new limitation period starts right from the new act of defendant.

Apprehension is sufficient for of passing off: Quia Timet Suit.

The trademark proprietor need not wait till the infringer makes actual sale of goods or services or whether there is damage to the business actually occurs in reality b the use of deceptively similar trademark. The defendant can start the action even at a initial stage where there is apprehension of passing off. In ***Mars Incorporated v. Kumar Krishna Mukerjee & Ors***⁴⁶¹ the Delhi High court granted an injunction against the defendant for forming a company in the name Mars Foods Pvt. Ltd. which amounted to the infringement of plaintiff's international famous trademark. Though the defendant didn't start production

⁴⁶⁰ CS(OS)3/2010/IA 21/2010.

⁴⁶¹ 2003(26)PTC(60)DEL

or any sale of any product from this Company, the Delhi High Court passed an order of injunction against the defendant⁴⁶².

Remedy under Copyright and Trademark Law

Sec. 134(2) of Trademarks Act 1999 and Sec. 62(4), Sec. 64 of Copyright Act 1957 enables any person who is aggrieved to take action for Copyright and Trademark Infringement as there are also people who register their trademark as an Artistic work under Copyright Act and also because every trademark in it has a Copyright but vice versa might not be there in every case.

Simultaneously as both these Sections gives additional Jurisdiction which is more than the normal ground which is availed in Section 20 of CPC 1908.

Foreign Trademark and Indian Courts

The Indian courts under the trademarks law as always given equal protection to both domestic as well as foreign trademarks proprietors by following the rule of Law which can be apparently seen and understood by the judgments passed by the courts and also by the Trademark's administrative authorities under the trademarks legislation⁴⁶³. This is very important and appreciating thing done by the courts as India is a an signatory to TRIPS and also Madrid protocol where in India has as a reciprocity signed to protect the trademarks of members of these agreements, hence by passing fair judgment and giving utmost justice to the trademark proprietors of foreign countries, the TMA 1999 is playing a vital role in achieving the objectives of the Act and TM Rules of 2017. In the case *Hyundai Corporation v. Rajmal Ganna*⁴⁶⁴ the Delhi High Court made an observation that goodwill as crossed the physical boundaries and also that

⁴⁶² Ibid; The Court also held that ‘‘to expect the aggrieved party to wait and watch for the opening of business or manufacturing or sale of goods under the apprehended infringement of trademark is too much. A stitch in time always saves nine and that is what the essence of Quia Timet Action is.

⁴⁶³ See, The Supreme Court in the landmark *MilmentOphthoIndustries&Orsv.AllerganIncorporation* [2004(28) PTC (585) SC] laid down the principles thus ‘In the present case, the marks are the same they are in respect of pharmaceutical products. Te mere fact that the respondents have not been using the mark in India would be irrelevant if they were the first in the world market ...’

⁴⁶⁴ 2007(35)PTC(652) DEL

goodwill has reached all over the world and it is no more restricted to a certain country. In this case the defendant made a dishonest use of plaintiff's 'Hyundai' trademark.

Defendant Masking Concept: Courts direction to Registry to follow Measures;

This is a sort of trick of the plaintiff where in order to hide the matter to the main defendant from the cause list, one more defendant is created and the main defendant is masked in order to get Ex-parte injunction at the first hearing itself for the reason that the main defendant's Advocate is absent⁴⁶⁵. In *Bata India Ltd. v. Chawla Boot House and Anr*⁴⁶⁶ the Delhi High Court observed and noticed this practice of defendant masking by the Plaintiff and due to this, the registry of trademarks, was given a direction to follow Measures which are very strict so that this practice of defendant masking is controlled in the matter of all Intellectual property cases.

Once trademark is registered plaintiff can be amended

Sometimes the aggrieved unregistered trademark proprietor initiates a passing off action on the infringer and later on once the said trademark gets registered the aggrieved proprietor also files an infringement suit under the Act⁴⁶⁷. In the case *Panchranga International v. Som Nath*⁴⁶⁸ the Delhi High Court observed that the proper, just and necessary amendments can and must be allowed for the adjudication but due to this the nature of suit should not be changed and it should be allowed for a cost.

⁴⁶⁵ Aditi Gupta, The Practice Of Defendant Masking: A Mistake Or A Strategy?, <https://www.mondaq.com> 11-06-2019.

⁴⁶⁶ DE/1368/2019 see also *Microlube India Ltd. v. Maggon Auto Centre and Ors*(2008(38)PTC(271)DEL) the court identified and criticized the strategy of Defendant Masking and directed the plaintiffs to come to court with clean hands.

⁴⁶⁷ See: *Time Warner Entertainment Co. v. A. K. Das* [2003(26) PTC (222) DEL]: The Delhi High Court held that "an amendment application can be entertained even after the close of the case for judgment and before the judgment is announced.

⁴⁶⁸ 2004(29)PTC(433)DEL

Besides the Civil and Administrative remedies the plaintiff can avail Criminal remedies under the trademark legislation.

3.9.2 CRIMINAL REMEDY

‘Criminal’ and ‘Penal’ remedy was provided under all the Trademark’s Legislation passed in India since 1889.⁴⁶⁹ Similar remedy is available even under the Act of 1999 under various provisions. It is truly interesting to know that along with Civil and Administrative relief the framers of the Law also made provision for penal action in the event of infringement of trademark. The researcher has analyzed the penal provision passed by all the trademarks legislation in India, right from 1889, the British India period.

A) TMA 1999 contains Penal Provisions

This is the governing Act on trademark in India and this Act provides for a criminal action in case of infringement in the following manner;

Chapter 12 of the Trademarks Act 1999 has Remedies for Criminal Action in case of Infringement as well as Passing off of a trademark. The Criminal proceedings can also be availed if any person’s trademark or service mark is infringed as this action gives a deterrent effect for the wrong doer.

⁴⁶⁹ See; Indian Merchandise Marks Act 1889 (Act No. 4 of 1889) The earliest Act dealing with the trademark related issues was this Act, which contained and provided for penalty reliefs in the Court of Law in the matter of using false trademarks and counterfeiting of the trademark and also applying false descriptions.

See; Trademarks Act 1940, Penalty Provisions, **Sec. 67.** False entry in the Register: This section provided for the penalty in case of false entry done by any person in the trademarks register shall be punished to a term of 2 years or shall be fined or it could be both.

Sec. 68. Trademark Falsely represented as Registered: If an act is committed of this nature then punishment was imposed on such act with imprisonment for a period of 6 months or such an act attracted a fine or both.

See; Trade and Merchandise Marks Act 1958, Penalty Provision; **Sec. 78** Deals with Falsification and False Application of Trademark **Sec. 78.** Imposes penalty for falsely applying trade description or trademarks to goods and provides punishment of imprisonment for period up to 2 years or fine or both.

Sec. 79. Provides penalty for selling goods with false trade description or false trademark and punishes with imprisonment which can go up to 2 years or fine or both. And if the offence was related with Drugs under the Drugs Act 1940, Imprisonment could go up to 3 years with or without fine. **Sec. 89.** Speaks about Cognizance of offence: Under this Sec., the Court can take cognizance of offence on complaint in writing by or officer authorized by the Registrar. The Registration of the Trademark was not compulsory for Criminal Action.

Whenever a Person who is aggrieved seeks criminal action he does so in order that the infringer gets punished. Following are the provisions from Sec. 101 to 104 and Sec. 115 and punishment as per trademark legislation.

According to **Sec.101:** Applying a mark or trade description to Goods or Services. Apply it to goods itself or use it in relation to the Services or apply to package by which goods are sold or have been exposed for sale or was in possession for sale or for trade or manufacture, sign advertisement catalogue etc.

As per **Sec.102:** Explains about falsely applied and falsifying trademarks it says when a person makes a mark or uses a mark similar or deceptively similar mark as that of the plaintiff without his assent or when a person falsify a genuine trademark by alteration or addition etc or applies or uses to Goods or services or its packaging . Burden of Proof that the Accused had consent of the proprietor lies on the defendant.

Sec. 103of the Act, Deals with falsifying or falsely applying of trademarks or trade descriptions.

Sect.104of Trademarks Act 1999 speaks about the Criminal Remedy and Penalty. It says Imprisonment of six month and which is extendable to 3 years and also provides for fine of Rs 50000 and which may go up to Rs 2 Lakh and Section105 speaks about the enhanced punishment.

Sec.115of the Act Contains provision for Search and Seizure power which is executed by the Police but the opinion of the Registrar of the Trademark is required for the same. Section 120 speaks about punishment for abetment in India of acts committed outside India.

Besides the above provisions dealing with criminal action against the defendant under the trademark law the plaintiff can avail criminal remedies under criminal law provisions such as Criminal Procedure Code 1973, Indian Penal Code, 1860. The first remedy is action can be taken by the police, filing of the complaint to Magistrate and action against unknown party.

B) Police Action

The Police are given authority take action under Section 156 of Code of Criminal procedure here in after known as CRPC in which the police can take a Cognizable Action.

C) Filing of complaint with Magistrate

In the situation where the Police do not agree to take such an action of lodging an FIR then the affected party can approach a Magistrate as per CRPC.

Sec. 190 of CRPC states that though there is no direct mentioned provision in Trademark Act about the offences as Cognizable but in Code Of Criminal Procedure 1973 Recognizes the offences in trademarks Act as Cognizable since the offence in the Trademark act is punishable up to 3 years.⁴⁷⁰

Sec. 115(4) of TMA.1999: Says that for a criminal action opinion of the registrar i.e. compulsory which in a way is not possible due to some other reasons and there is no obligation on the part of the registrar to do so and hence Lodging a complaint before Magistrate is more of a Convenience to the Party who is Aggrieved because the Magistrate can trial the Person infringing the trademark by issuing such a person summons and in this case it is not necessary to obtain a opinion from the Registrar of the trademark.

⁴⁷⁰ Code of Criminal Procedure 1973 The First schedule table 2 “any offence which is punishable with imprisonment for 3 years is cognizable, non-bailable offence and triable by the Magistrate of First Class.

Sec. 93 and Sec. 94 of Cr PC 1973: Action of unknown party

This sections enables one to take legal action in the form of search and seizure against the infringer whether such a infringers Identity is revealed or not and this is truly an advantage of taking a Criminal action over civil suit .It has truly to be agreed that Criminal action is quite effective in nature. Now let us understand the remedy available under IPC, 1860.

D) Remedy under Indian Penal Code (IPC) 1860

There are provisions in the Indian Penal Code here in after referred as IPC, which can come to the rescue of genuine trademark proprietor in case there is infringement of such proprietors Trademark, the researcher has enumerated and explained briefly some of the important sections under IPC in this context. Now we have to understand that under IPC there are many sections which can be used to stop as well as punish the infringer for infringement or passing off wrong .To protect the interest of genuine proprietor IPC, 1860 contain the following provisions, they are Cheating, forgery, Applying false property mark, Counterfeited property mark. Let us study each of them separately as under;

Cheating: This section of the said code speaks about ‘Cheating’⁴⁷¹ . Infringement also contains element of cheating in a sense that the infringer uses another person’s trademark without any permission and authority and exploits it commercially hence such infringer can be booked under Sec.415 of IPC.

IPC, Forgery: This section of IPC is also applicable in the offence of infringement of trademark for goods or services.⁴⁷²

⁴⁷¹**Sec.415 IPC, Cheating;** Whoever by deceiving any person. Fraudulently or dishonestly induces the person so deceived to deliver any property to any person or to consent that any person shall retain any property or intentionally induces the person so deceived to do or omit to do anything which he would not or omit if he were not so deceived and which act or omission causes or is likely to cause damage or harm to that person in body, mind, reputation or property is said to cheat.

⁴⁷²**Sec.463 IPC, Forgery,** Whoever makes any false document or part of s document with intent to cause damage or injury to the public or to any person or to support any claim or title, or to cause any person to part with property or to enter into any express or implied contract or with intent to commit fraud or that fraud may be committed, commits forgery.

False Property Mark: This section punishes any person who commits the offence of applying false property mark and this section can punish if an act of infringement is committed as infringing someone's mark and using the same for selling the goods and services is like applying a false mark for the simple reason that this false property mark in true sense is the genuine mark of someone else⁴⁷³.

Counterfeited Property Mark; This section of IPC punishes any person who uses counterfeited property mark for the sale of goods. This section is applicable to the offence of Infringement as there is sale of goods by application of counterfeit mark.⁴⁷⁴.

Exceptions in case of Infringement and Passing off:

Sec. 112: contains the exceptions for infringement action which does not amount to infringement in certain cases, they are as follows;

- a. In ordinary course of business he was employed
- b. He had no interest in sale
- c. He had no reason to believe that his act was infringing
- d. He cooperated with the prosecution and provides all information of person who was the owner of such goods.

⁴⁷³Sec. 482 of IPC, 1860: Whoever uses any false property mark shall. Unless he proves that he acted without intent to defraud, be punished with imprisonment of either description for a term which may extend to one year or with fine or with both. Non-Cognizable, Bailable offence, Triable by any magistrate.

⁴⁷⁴Sec. 486 IPC: Whoever sells, or exposes or has in possession for sale any goods or things with a counterfeit property mark affixed to or impressed upon any case package or other receptacle in which such goods are contained shall, unless he proves:

- (a) That having taken all reasonable precautions against committing an offence against section, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the mark, and
- (b) that on demand made by or on behalf of the prosecutor he gave all the information in his power with respect to the persons from whom he obtained such goods or things, or
- (c) That otherwise he had acted innocently. Be punished with imprisonment of either description for a term which may extend to one year or with fine or with both. Non-cognizable, Bailable Offence, Triable by any Magistrate.

3.9.3 ADMINISTRATIVE REMEDIES UNDER THE TMA 1999

In case of infringement of any genuine person's trademark, whether registered or unregistered and which is in the process of registration can broadly avail two types of administrative remedy to prevent such trademark from getting registered under the Act, namely:

A. Opposition

B. Rectification

A. Opposition: This is a Remedy which is provided under the Act and is a Proceeding which is Administrative in nature. The Registrar of the trademark conducts and administers this proceeding under the Trademark Registry. Any infringing trademark can be prevented from getting registered by the proprietor of genuine trademark by filing an opposition application during the advertisement period which is 4 months.

In *Anglo French Drug Co .v. Brihans Laboratories* it was held that for an opposition proceeding to get success, the establishment by the opponent that its mark by usage got a good reputation and there will arise confusion in the mind of the public if the applicants mark gets registered.

The following Provisions under the Trade Marks act 1999 dealing with opposition are worth considering and analyzing;

As per **Sec. 21** of Trade Marks Act 1999 Act, during the registration process when the trade mark is advertised for opposing the same by any person interested, the Registry gives 4 months for the aggrieved party to file an opposition. Hence if any person tries to register a mark which is similar or deceptively similar to the Prior Users trademark either registered or unregistered can always oppose such marks during this opposition period of 4 months. This Act of 1999, provided for opposition of Good's trademark as well as service trademark which is definitely an improvement as compared to the

previous legislations of 1940 Act and 1958 Act, as the service mark definition was not included in them. In *Aggarwal Sweet Palace v. Assistant Registrar of Trade Marks*⁴⁷⁵ the respondents applied for trademark 'Aggarwal Sweet Corner' under the user date, 1st June, 1984, which was opposed by the appellant on the ground that this mark was deceptively similar and also identical to its trademark, Aggarwal Sweet Corner which is being used from 1986 under same classification of the opponents. The Assistant Registrar after asking the applicant for some disclaimer later disallowed the application and the Deputy Registrar overruled the same as the evidence sufficiently was produced by the applicant. The same when went for appeal to IPAB, the Board upheld the decision of the Deputy Registrar and dismissed the appeal.

Sec. 21 of TMA 1999; Speaks about who is entitled to file such opposition proceedings in the Registry of trademark and it mentions that any person can file for opposition by giving a opposition notice. Person comprises of Natural person as well as legal person e.g. Partnership firm, Company etc and they might be from India as well as abroad, Which means even a foreign natural or legal person can file such opposition.

Sometimes it can happen that two or above two person might join hand together and file such opposition, mostly this happens when their contention and issues are same.

Grounds for filing an Opposition:

In case there is infringement and passing of a genuine trademark, the proprietor can oppose if such mark is advertised in the trademark journal and stop such infringing mark from getting registered on the following grounds;

- a. Identical/Deceptive:** The applied trademark for goods or services is Identical/Deceptively Similar to the genuine trademark which has filed opposition.

⁴⁷⁵ 2005(30)PTC(336)IPAB

- b. Bad Faith:** The opposed mark is applied by the opponent in bad faith and is not having Bona-fide intentions in applying the said trademark.
- c. Deceit/Confusion:** There is a likelihood of deceit or confusion, which can get created if the opponent's trademark gets registered.

These are some of the grounds which have been mentioned by the researcher but the Registrar decides each case differently taking into consideration other factors connected with the case.

Actual damage irrelevant in Opposing; It is to be noted that in order to conclude and decide whether the applicant's trademark is likely to create confusion or whether it will deceive the consumers, the likelihood of damage to the business or trade of the opponent is not relevant or is immaterial⁴⁷⁶.

Let us now analyze and study the opposition provisions provided by all the trademarks legislations passed in India since 1940.

OPPOSITION PROVIDED BY ALL THE TRADEMARKS LEGISLATIONS IN INDIA;

It is very interesting to know and understand that the opposition proceedings which are available under the Trademarks Act 1999 were also provided in the first complete legislation passed in pre-independence era, the Trade Marks Act 1940 and also in the first Act passed in the post independence era, the Trade and Merchandise Marks Act 1958⁴⁷⁷.

⁴⁷⁶ Hack's Appl, (1940)(58)RPC(91)P.107

⁴⁷⁷ **See; TradeMarksAct1940: Sec.10.** Dealt with, Registrar's prohibition of Identical or Similar trademark by objecting conflicting mark. **Sec. 15.** Speaks about Opposition to Registration by the aggrieved party during advertisement period.

See; TradeandMerchandiseMarkAct1958: Sec.11. Dealt with Prohibition of certain trademarks if such marks would lead to deception and confusion.

Sec. 12. Dealt with, Prohibition of registration by the Registrar by objecting the conflicting mark Applications.

Sec. 21. Dealt with the Opposition, in which the aggrieved party could within 3 months file for opposition if the applied trademark was deceptively similar or confusing. **See; Usha Rani v. Registrar Of Trademarks & Anr (2004(29)PTC(647)IPAB)**Deputy Registrar allowed the opposition by the respondent No.2 against the appellant against the registration application of the trademark 'Úsha' in

In *Rudi Roller Flour Mill (P) Ltd. v. Kewal Krishan Kumar, Samay Pur Delhi*⁴⁷⁸ the Registrar in opposition hearing held that ‘Shiv Shakti’, which is the opposed mark compared to ‘Shakti Bog’ which is the Opponent’s trademark. Is not deceptively similar. Hence the objection raised by the opponent under Sec.12 (1) of Trade and Merchandise Marks Act 1958 was dismissed by the Registrar. And when the opponent challenged the Registrars order in the Delhi high Court, the said Court upheld the order of the Registrar.

In *Group Pharmaceuticals v. Alkem Labs*⁴⁷⁹ the Registrar of the trademark refused the registration of the trademark ‘Metro-D’ in medicine business of pharmaceutical, on being opposed by the owner of trademark ‘Metro-N’ in same classification , the reason for refusal to the said trademark was likelihood of deceit by the average intelligence and ordinary prudence customers.

The Registrar of trademarks in *Toshiba Appliances Co. v. Kabushiki Toshiba*⁴⁸⁰ ,under Sec.11 (a) of the Trade and Merchandise Marks Act 1958 disallowed by refusal for electrical appliances, the trademark TOSIBA, on the opposition brought by Kabushiki Toshiba proprietor of a well known trademark, ‘TOSHIBA’ in electrical goods in India as well as Abroad⁴⁸¹. It was held by the Registrar that this act of the applicant was dishonest in making such application and under Sec.12 (3) it was not accepted as Concurrent User.

In, *Torrent Pharmaceuticals Ltd. v. The Welcome Foundation Ltd*⁴⁸² the Asstt. Registrar from Trade Mark Registry refused TROVIREX trademark of the applicant upon being opposed under Sec. 21 of Trade and Merchandise

switch fuse, electric switch, switch gear etc and rejected by an order in 1994 the application of the appellants for registration of the trademark under (Class-9) of Trade & Merchandise Marks Act 1958, so applied, as the respondents are already registered proprietors of the trademark ‘Usha’ under different classifications including class 9. The Appellant made an appeal to the High court and the same got transferred in the IPAB upon which the Appellate Board held that the intention of the appellants was not bona-fide and hence upheld the decision of the Registrar and dismissed the Appeal.

⁴⁷⁸ 2002 (25)PTC(555)DEL

⁴⁷⁹ 1996 PTC(16)117

⁴⁸⁰ 2002(24) PTC (654) Reg.

⁴⁸¹ Sec.11 (a) TMMA 1958; Prohibition of mark if the use of which would be likely to Deceive or cause Confusion.

⁴⁸² 2002 (24) PTC 580 (GUJ)

Marks Act 1958, by Welcome Foundation due to the reason that it was deceptively similar to their trademark, ZOVIREX, a registered trademark of the Welcome Foundation in the classification of preparation of medicinal products. When the applicant appealed to the Gujarat High Court against the Assistant Registrars order, the appeal was dismissed.

Plaintiff as well as Defendant are applicant for registration;

Sometimes there is a situation where both the litigants in a suit are applicants of a trademark in registry where they both claim to be the owner of the same mark. Looking at such situation the Apex Court in India has laid down some principles which are ought to be followed by the court before passing an injunction order in favour of either litigant.

In the case, *Uniply Industries Ltd v. Unicorn Plywood Pvt. Ltd.*⁴⁸³ the Supreme court held that the courts should follow restrictions while passing a decree of injunction, when both plaintiff and defendant, both have filed an applications for registration of the same mark in the trademark registry. In this case for the claim of similarity in the trademark, the plaintiff and the defendant both filed a suit against each other.

Following are the advantages for the registered trademark owner to protect his mark from any type of violation as per 1999 Act;

a. Change in opposition period: As per this 1999 Act, the period of opposition was 4 months whereas in the earlier Act it was 3 months which means now the interested party is getting more 30 days to file the opposition before the trademarks registry.

b. Online filing: The opposition can now be filed on-line, which means that any person can file it from wherever he is situated or resides, in another words he does not have to personally visit the trademarks registry for filing such oppositions which ultimately saves time and cost of travelling.

⁴⁸³ [2001PTC417(SC):(2001)(5)SCC(95):AIR(2001)SC(2083)]

In *Hindustan Development Corpn v. Registrar*⁴⁸⁴ the Registrar of trademark objected and refused the word 'RASOI' as trademark for manufacture of oil under Sec.9 of the trademarks Act 1999 as this trademark referred to the goods character directly.

In *Tata Chemicals Ltd. v. Deputy Registrar of Trade Marks*⁴⁸⁵ the defendant in 1994 applied for the registration of the trademark 'TATA' under the Co. M/s Tata Pressure Cooker Manufacturing Co. and claimed the user date to be 1981 and the Plaintiff, 'TATA Chemicals' opposed the same, upon which the objections of plaintiffs were rejected and the registration applied by defendant was allowed. This decision was appealed in the Delhi High Court where the Court quashed the registration application of the defendants and held that House of TATA had great reputation and it would amount to deception and confusion in case the defendant would use identical mark of Plaintiff.

c. Video Conferencing: Third important advantage as regards the opposition provided by this Act is that the hearing in certain cases can be done through video conferencing.

Now after understanding the Opposition remedy provided by the governing Act of 1999 let us now analyze the Rectification proceeding which is now administered by the IPAB;

⁴⁸⁴ A.I.R.1955 Cal. 519

⁴⁸⁵ 2003(27)PTC(422)DEL, Rationale ;

- The plaintiff proved that House of Tata was in existence since 19th century founded by late Sir Jamshed Ji Tata . Since the name was not descriptive it had limited protection under the Act.
- The trademark TATA is a 'well known' and is exclusively associated in the minds of public with the HOUSE OF TATA.
- Plaintiff showed that House of Tata had 50 Companies out of which about 7 are overseas and had a annual turnover of approximately 16000 Crore.
- Plaintiff was able to prove that defendant Co. products were likely to cause confusion or deceive and also their mark was Colourable imitation of the mark of plaintiff.
- Since Tata was not the sir name of defendants how these persons picked up the word TATA as their trademark remained a mystery.
- Even though the defendants used the trademark since 1981, the cannot register the said trademark as it was not an honest use and taint cannot be purified by continuous use.

B. Rectification Remedy Provided by IPAB

In case the infringer manages to get his infringed mark registered in the Trademark Registry then the Prior proprietor of the trademark can file Rectification proceedings before the IPAB and get the infringers mark rectified from the Register of the Trademark.

Intellectual Property Appellate Board [IPAB]

First time in India under the trademarks legislation, Trademarks Act 1999 an Appellate Board, a quasi-judicial body just like other tribunals was constituted and established independently.⁴⁸⁶ This Appellate Board is called the 'Intellectual Property Appellate Board' here in after referred as IPAB to hear and dispose of the litigation as regards registration. In case an infringing trademark in goods or services gets registered then the genuine proprietor of such trademark appeals to the IPAB by filing rectification .Once the rectification is filed the IPAB decides the case and comes out with a decision.

The IPAB is playing a positive role in eliminating infringement and passing off of trademarks in the country by taking sensible and cautious decisions at Appellate jurisdiction so that there is no chance given to the infringer to escape from Law.

In *S.K. Patel v. Deputy Registrar of Trade Marks*⁴⁸⁷ the Deputy Registrar disallowed the appellant, Nirma Chemicals Works the proprietor who originally coined the trademark 'Nirma' which is their house mark, 20 years back, to oppose the trademark 'Nirma' applied for registration in class 23 under the Trade and Merchandise Marks Act 1958, by the respondent No.3 and the Deputy registrar passed an order and directed to register the same upon which the aggrieved appellant appealed to the Deli High Court but was transferred to the IPAB under Sec.100 . The IPAB allowed the opposition of the appellant and rejected the application of the Respondent No.3

⁴⁸⁶ Dr. M.K. Bhandari, *Law Relating To Intellectual Property Rights* (3rd Ed.2012,Central Law Publications Allahabad) P.210,211

⁴⁸⁷ 2004 (29) PTC (634) IPAB

Appeal Period: The aggrieved party can appeal in prescribed form, fee and evidence to the IPAB within 3 months from the order of Registrar, once the registrar takes decision or passes such order.⁴⁸⁸ In *Sarda Plywood Industries Ltd. v. Tac Construction Materials Ltd*⁴⁸⁹ the IPAB rejected the registration decision of the Registrar for the proposed to be used, trademark, ‘Duracem’ in class 19 which consist building material etc as it was infringing the registered trademark ‘Duracem’ in same classification being deceptively similar.

Exception to Appeal; In some genuine cases the IPAB considers and accepts the filing of appeal even after 3 months provided the appellant gives satisfactory reasons for the delay.

Hearing: Once the date and place of hearing is fixed and the notice is given to both the parties’ ad by chance if one of party to the proceedings do not appear, then the Appellate Board may either hear the matter on merits or say Exparte⁴⁹⁰. Sometimes the Board might even dismiss the matter⁴⁹¹. In *JVC Industrial Corporation v. Victor Company of Japan Ltd and Anr*⁴⁹² the respondents opposed the trademark ‘JVC’ applied by the appellant in class 9. The respondents are the registered proprietor of the mark ‘JVC’. In opposition hearing, the impugned trademark was rejected by the Assistant Registrar upon which the appellant set aside the order of Assistant Registrar by filing a review petition with the Deputy Registrar. After this the appellant filed an appeal to Delhi High Court and after this the Court instructed the Deputy Registrar of the registry other then the Deputy registrar to hear the matter again, but this time a Assistant Registrar other than the earlier Registrar heard the matter again and held that there could be amongst average consumers confusion if registration

⁴⁸⁸ Intepat Team, *Filing An Appeal Against The Decision Of Te Registrar*, <https://www.mondaq.com> 15th November, 2017 (The Procedure to file an Appeal may be found in the ‘Intellectual Property Appellate Rules, 2012’ which are drafted by DPIIT under Ministry Of Commerce And Industry.

⁴⁸⁹ 2003(27)PTC(391)DEL

⁴⁹⁰ Ibid; If the case is dismissed on an Exparte decision, the IPAB may restore or set aside the decision based on a petition filed within 30 days from the date of an order(or on the terms the board sees fit)

⁴⁹¹ Rule 2(m): The Principal Seating Jurisdiction at Chennai or at Delhi, Mumbai, Kolkata or Ahmedabad, where the head office or the branch office of the Trademark Registry is located.

⁴⁹² 2005(31)PTC(315)IPAB

takes place, which was challenged by the appellant again. The IPAB held that the Assistant Registrar is very competent to hear the matter instead of Deputy Registrar and nothing is wrong in that by virtue of the powers they equally enjoy and the Appellate Board held that the respondents trademark is 'well known' in India and upheld the order of Assistant Registrar favoring the opposition filed by the respondents. Let us now study the rectification provisions provided by the different Trademark Legislations passed in India.

RECTIFICATION PROVISIONS UNDER ALL TRADEMARKS

LEGISLATIONS:

Rectification of trademarks is administered and monitored by the *IPAB* at present under the Governing Trade Marks Act 1999, was always provided in all the earlier statutes along with their amendment passed in India⁴⁹³. Both under TMMMA 1958 and Trade Marks Act 1940, Rectification was required to be filed either in High Court or Registrar and the tribunal of the same would decide the matter.

This means that even during those times the genuine trademark owner could file for rectification and remove the fraudulent mark which was infringing the genuine trademark of actual prior owner, from the register of the trademark

⁴⁹³**See;** Trade Marks act **1940: Sec. 46;** Dealt with Rectification provision in which the aggrieved party could apply to the Registrar or the High Court for cancellation of the registered trademark if such mark would infringed the aggrieved party's trademark. Unlike the present day Act of 1999, which provides with IPAB to administer Rectification proceedings, the rectification under the Act of 1940 was administered by Registrar and the High Court under their respective Tribunals.

Trade and Merchandise Marks Act **1958:Sec.56:** Dealt with the Rectification of the Register in which the Act provides for filing of rectification application by the aggrieved trademark proprietor to cancel the registration of Trademark if such mark infringed the aggrieved proprietors trademark. Here too such rectification were filed with the registrar or the high Court and the same was decided b their respective Tribunals. **See; Amritpal Singh v. Lal Babu Priyadarsi & Assistant Registrar ((2005)(30)PTC(94)IPAB)** The respondent filed application in the year 1994 for registration of the trademark 'Ramayan' for dhoop, agarbatties, perfumes etc and the Assistant Registrar allowed the registration of the same which was opposed by the Appellant under the Trade and Merchandise Marks Act 1958.The Assistant Registrar rejected the objections raised and accepted the mark for registration upon which the appellant for cancellation of the registration filed an appeal in IPAB in the year 2004 and the Appellate Board cancelled the registration of the impugned trademark under **Sec. 9(2)(b)** of Trade and Merchandise Marks act 1958 by holding that the Registrar made a mistake in registering the impugned trademark.

See; **Sec. 9(2)(b)** of Trade & Merchandise Marks Act 1958, forbids registration of trademarks, if it contains or comprises any matter likely to hurt the religious susceptibilities of an class or section of the citizen of India.

maintained by the Registrar. Over a period of time and till date, this truly has helped the aggrieved party in getting relief from infringement and passing off, of their trademark.

In *The Enfield India Ltd. v. Deepak Engineering Syndicate*⁴⁹⁴ upon filing of application for registration in the year 1985 of the trademark 'Bullet' in the classification of oil, diesel and also engines and parts thereof under the Trade and Merchandise Marks Act 1958, the said mark was opposed by the Appellant Enfield India. The Assistant Registrar in 1994 decided the case in favour of respondent No.1 after rejecting the opposition. The appellant filed an appeal in the High Court and the same appeal was transferred to the IPAB under Sec100⁴⁹⁵ of Trade Marks Act 1999 and the IPAB and the appeal of appellant was allowed and the registration application of the Applicant no.1 was rejected. let us study and analyze the rectification proceedings administered under the Governing Act of India at present i.e. Trade Marks act 1999 which truly has brought an revolution in the in the law relating to trademark in India.

Trade Marks Act 1999

Under the TMA 1999 Chapter VI deals with the rectification proceedings which the aggrieved party can file in the event of infringement of hers or his trademark for goods or services by the registered trademark owner under the Act. This Act of 1999 brought two major positive changes namely;

1. Rectification of Service Mark was provided for the first time in the History of trademark.
2. The administration of rectification was delegated to the Intellectual Property Appellate Board (IPAB) which, as the name says, an Appellate board established by the Central Government by notification in Official

⁴⁹⁴ 2006(32)PTC(397)IPAB

⁴⁹⁵Sec 100 Trademarks Act 1999: Transfer of pending proceedings to Appellate Board-All cases of Appeal against any order or decision of the Registrar and all cases pertaining to rectification of Register, pending before any High Court shall be transferred to Appellate Board from the date as notified by the Central Government in the official Gazette and the Appellate Board may proceed with the matter either *denovo* or from the stage it was so transferred.

gazette. Now no more does this authority and power with the high Court which means that now this Act has been well equipped to look into the total affairs and administration relating to trademark.⁴⁹⁶

In *E.I. Dupont De Neumors Co. USA v. Zip Industries Ltd*⁴⁹⁷ the Registrars decision was upheld by IPAB, in which the Registrar dint allow the opponent's opposition for 'Tufflon' trademark for the fasteners.

Let us now read the Section under this 1999 Act, which deals with the rectification of the trademark for goods and services. **Sec. 57** of the Act deals with rectification of register.

It state the aggrieved trademark/ service mark proprietor can in a prescribed manner make an application to the IPAB, the tribunal for rectification of the register and cancellation of such conflicting trademark which infringes such proprietors trademark for being identical or deceptively similar.

In *Fena Pvt. Ltd. v. Nipa Chemicals Pvt. Ltd*⁴⁹⁸. the IPAB board held and set aside the order of Registrar for registration of the trademark, 'Nipa' as the disputed mark was deceptively similar to the appellants trademark 'Nip' and also both the parties goods were same, i.e. Cleaning powder and Detergent soap.

The tribunal after giving fair hearing shall dispose of the matter either in favour of the aggrieved party or the registered trademark proprietor as the case may be.

⁴⁹⁶**Sec.83:** The Central government shall, by notification in the Official Gazette, establish an Appellate Board to be known as the Intellectual Property Appellate Board to exercise the jurisdiction, powers and authority conferred on it by or under this Act.

⁴⁹⁷ 2004 (28) PTC (174)IPAB

⁴⁹⁸2004 (28) PTC (371) IPAB

In *New Nandi Seeds Corporation v. M.V. Subbaiah*⁴⁹⁹ the Appellate Court passed an order to expunge the trademark 'NANDI' used by the respondent as the respondent was found to be not a concurrent and an honest user of this mark.

Phonetic Similarity: In Appellate jurisdiction the IPAB, takes into account all the possibility in which an infringing trademark can make an attempt to get it registered. Hence at a later stage the IPAB makes sure that such mark is removed from the Register of trademark due to the different deceptive similarity the mark might consist of like Structural, Phonetic etc. In *Beecham Group Plc. V. S.R.K. Pharmaceuticals*⁵⁰⁰ the IPAB held that the Registrars decision was not right in registering the trademark in Pharmaceutical medicine, 'Lymoxyl' for infringing the trademark 'Amoxil' in same classification as the mark was similar in phonetic and also structural wise. This is a case of deceptive similarity and phonetic similarity as while pronouncing, both the trademark it sounds the same.

It has to be taken into account that if a party has sued another party for infringement in the court of law and simultaneously filed for rectification in the IPAB, then the Supreme courts guidelines are that the rectification proceedings should be decide first and then the court of laws proceedings and till the rectification is not done with, the Court proceedings shall remain in stay.

Medicine products

The IPAB as well as the Trademark Registry are deciding the cases as regards the similarity of the trademarks more diligently whenever the trademark for goods or services involve medicinal drugs from pharmaceutical industry as this is something which is connected with life of human and other living beings⁵⁰¹.

⁴⁹⁹ 2004 (29) PTC (347) IPAB

⁵⁰⁰ 2004 (28) PTC (391) IPAB.

⁵⁰¹ K. C. Kailasam, & Vedaraman, *Law Of Trademarks* (3rdEd. 2013, LexisNexis, Gurgaon Haryana) P.342,343

In *American Home Products Corporation v. K.V.Chennamallu*⁵⁰² the IPAB mentioned some of the important factors, which has to be taken into consideration while deciding the pharmaceutical products in relation to judging trademark similarity⁵⁰³.

Foreign Country's Market

Sec.1 very clearly says that the Act is applicable to India, which means within the territory of India its applicability is and does not cover markets of foreign countries. In the case *Berkefeld Filter Anlagenbau GmbH v. Registrar of Trade Marks*⁵⁰⁴ the IPAB held that the trademark Act has a jurisdiction which is territorial but it can prevent the exportation of goods contain, infringement of others trademark, so also this Act can curtail such imports infringing the trademark of trademark proprietors from India.

⁵⁰² 2004(28)PTC(154) (The Trademark 'Prexmin' was held to be deceptively similar to 'Premarin', both goods fall in one classifications, 'Pharmaceutical products')

⁵⁰³ Supra note: 113:Following Factors are to be considered in deciding similarity while deciding Pharmaceutical medicine;

1. The class of purchasers and in case of medicines, it is purchased by both literate and illiterate residing in villages as well as towns and also by a man of average intelligence and imperfect recollection.
2. Potential harm may be far more serious in case of medicines than in the case of other medicinal products.
3. Even in case of prescription drugs prescribed by doctors and disposed by chemists, confusion and mistakes are likely when marks which look alike and sound alike are marketed.
4. Medicines are sometimes ordered over telephone. Hence if there is phonetic similarity, it enhances the chances of confusion or mistake by the pharmacist. Sometimes in hospitals, drugs may be requested verbally under critical conditions to treat patients.
5. Prescriptions are hand written and many times it is not unmistakably legible if the rival mark appears too much alike then there are chances of confusion or mistake by the pharmacist while dispensing the medicine.
6. The drugs have a marked difference in the composition with completely different side effects. Even if rival drugs are for curing the same ailment, there is possibility of harm resulting from any kind of confusion and the consumer can have unpleasant if not disastrous results.
7. Even though the physicians and the pharmacists are trained people yet they are not infallible and in medicines, there can be no provisions for mistake since even a possibility of mistake may prove to be fatal.
8. In case of medicines, whether there is any probability of confusion should not be speculated, but that if there is an possibility of confusion the use of confusingly similar marks should be enjoined.
9. Confusion by the use of similar marks which are used for different diseases for medicinal products could have disastrous effect on health and in some cases life itself.
10. In a country like India, where a small fraction knows English and for whom different words with slight difference in spelling may sound phonetically same and who cannot pronounce the marks correctly, the use of deceptively similar marks could cause confusion.

⁵⁰⁴ 2005(30)PTC(345)IPAB

3.9.4 INFRINGEMENT REMEDY UNDER CUSTOMS ACT

Remedies are also available under the Sea Customs Act, 1887 in case there is infringement or counterfeiting of Indian manufactured good's trademark which can be availed b the aggrieved party if such genuine person encounters an injustice happening with his or her trademark rights.

It is truly interesting to know that under all the Customs Act, since from 1887, there were provisions as regards prohibition as to the import and export of counterfeiting trademark goods of Indian origin.

Let us firstly study the first Customs Act, Customs Act 1887 which contained the provisions infringement of trademark for Goods.

A) Sea Customs Act 1887

The following are the important provisions dealing with the infringement of goods while importing and exporting.

Sec.18; Speaks about the prohibition of importation and exportation of the counterfeited and false trade description goods. Further the same section also prohibits goods which has been produced outside British India and United Kingdom and infringing trademarks of British India or from UK.

Sec.45.Trade Marks Act 1940Spoke about the usage of trademarks in exporting trade and has the provisions for dealing with the same. So also custom related affairs as regards the counterfeited importation of the goods were covered by the *Sea CustomsAct1878*.

The Supreme Court in *East India Commercial Co. Ltd v. The Collector of Customs*⁵⁰⁵ held and observed that if any person imports or exports goods in India which as per Chapter IV of the Sea Customs Act 1878 are prohibited then

⁵⁰⁵ 1962AIR1893, 1963 SCR(3)338

these goods shall be confiscated and the person committing such wrong shall be given an penalty.

Now having discussed the infringement provision in the customs act 1887, let us now study the provisions for the same under the Customs Act 1962 which was passed post independence era in India;

B) Customs Act 1962;

The Customs Act 1962 here in after referred as the Act, was enacted India's post-independence and which repealed the then Customs Act of 1887 enacted by British India during British rule in India.

This Act also like the earlier Customs Act provided to prohibit import and export of goods those infringed the trademarks in India and empowered the authorities to seize and take into custody such goods.⁵⁰⁶

The Custom Act 1962 empowered the Central Government to prohibit either import or export of any goods for the purpose of protection of trademark, copyright, patent rights.

As per **Sec.11** Central Government has power to prohibit import and export of goods if they do not comply with the Law of land and if such trade is in contrary with patents , trademark, copyright etc or if such trade practices deception and contravenes treaty, convention etc.

Sec.11of the Act : **Confiscation of improper Imported Goods;** This section speaks about confiscation of imported goods if they are improperly imported in India by any route and if they are prohibited as they are contrary to the

⁵⁰⁶ Customs Act 1962: Sec. 11 of the Act empowers the Central Government for the purpose mentioned in section 11(2) to prohibit import or export of goods. For e.g. the compliance of imported goods laws which are applicable to similar goods produced or manufactured in India. Protection of patents, trademarks and copy rights, prevention of deceptive practice, implementation of any treaty, convention with any country, any other purpose conducive to the general public.

provisions under customs law or any other law of the land and Sec.112 provides with the penalty for the same. Here we have to understand that any other law include trademark law and if these imported goods infringe the trademark of the Indian manufactured goods then obviously they are contravening the trademark legislation of India and hence are liable to be confiscated by the customs.

Sec.113 of the Act Confiscation of improper Export Goods; This section speaks about the prohibition of goods which are being improperly exported by air or sea or by any other route and this prohibition can be if such goods export is contrary to any law existing in India or is contradicting the provisions of this customs Act itself. So also Sec.114 provides for the penalty for the offence committed under Sec.113.

The Calcutta High Court in *Bank of India and Anr v. The National Iron and steel Co.*⁵⁰⁷ held that even if Sec.11 is not applicable but a liability can be imposed independently by Sec.111 of the Customs Act 1962.

The Intellectual Property Rights (Imported Goods) Enforcement Rules 2007

In the year 2007 government of India made enforcement Rules. This Rule's notification is empowered prohibit import of the infringed goods⁵⁰⁸.

Under Customs Act the Intellectual Property Rights Enforcement Rules of 2007 are followed and under the provision of this rule the right holder in India can do the registration of the trademarks belonging to them with the authorities of the custom.

⁵⁰⁷ AIR1973Cal354

⁵⁰⁸ Government; Vide Notification No: 49/2007-Customs(NT) 8-5-2007

In the event of importation of a counterfeited good the right holder is required to file notice with the Custom Commissioner of the port where such import can take place⁵⁰⁹.

Apart from this the officers are also given power to either destroy or they can dispose the same. These rules also have provision prohibiting the re-export of the goods of infringing nature which is in the state of unaltered.

On the basis of such registration the custom officers has authority even without the orders from the court can seize the infringing goods at the border.

TRIPS Provides for Border Measures (Article 51-60)

In TRIPS Agreement from Article 51 up to 60 there are Measures to be followed at Borders in order to get IPR infringement protection. India is following these Measures being a Signatory of the TRIPS.⁵¹⁰

Custom 2007 Rules; Prohibition of Export of infringing goods; The Government under the said notification of 2007 prohibits, infringing goods export if these goods contravene the following provisions specific provision of Trademarks Act 1999;

Sec.139 Trade Marks Act 1999: If the goods to be exported do not meet the parameters of this section by not complying with whatever indications they

⁵⁰⁹ Rules 2007 *wide* notification No.47/20007-Customs (NT) dated: 8-5-2007. These rules inter alia provides for;-

- I. The filing of the notice by the right holder.
- II. Registration of the said notice by the customs.
- III. Time limit for right holders to join proceedings.
- IV. Single point for registration of the notice filed by the right holder.
- V. Adequate protection to the rightful importer.
- VI. Suo-moto action by the customs in specified circumstances.
- VII. Disposal of the Confiscated goods.
- VIII. No action against goods of non-commercial nature contained in personal baggage or sent in small consignments intended for personal use of the importer.

⁵¹⁰ Annex IC of the Marrakesh Agreement Establishing the WTO(World Trade Organization)

were supposed to apply as per this section as per the specified manner of the said notification but, have failed to apply the same.

Sec.81 Trade Marks Act 1999: If the exported goods were I a specified manner, required to be stamped as per the Trademark Rules 2002 but failed to do so.

Notification of 2010, 30th June

The 2010 Notification, prohibition of the following goods have been notified as per the following Sections of Trade Marks Act 1999⁵¹¹

Sec. 102 Trade Marks Act 1999; If the False trade Mark are applied to the goods as defined by section 102 of the trademarks Act.⁵¹²

Sec.2 (1) (i) Trade Marks act 1999; If the imported goods a applied a trade description which is false under this section. So also the matter falling in 2(za) Clause (2) and Clause (3) of the Trade Marks Act 1999⁵¹³.

IPR Cell in Custom House

In order to administer and implement the regime of Intellectual Property Rights a cell of IPR has been established at each Custom⁵¹⁴. This is truly an innovative step undertaken at Customs for the protection of trademarks as well as other Intellectual Property Rights so as to assure that there is no infringement of Indian trademarks takes place at the time of import or export.

⁵¹¹ Government; Vide Notification No: 51/2010-Customs(NT) 30-6-2010

⁵¹² Act No. 47 of 1999.

⁵¹³ Act No. 47 of 1999.

⁵¹⁴ Intellectual Property Rights(Imported Goods) Enforcement rules 2007, <https://www.wipo.int>

3.9.5 REMEDIES UNDER COMPANIES LEGISLATION

The Company Law helps the registered trademark proprietors to safeguard their trademark from infringement and passing off, if any person tries to form a Company by using such genuine proprietor trademark. Let us firstly analyze the said provision under the Companies Act 1956 and later we will study the same under the Companies Act 2013⁵¹⁵.

A) Companies Act 1956 contains the following;

The Companies Act 1956 here in after Co. Act 1956, contains provisions for rectification of Company's name if such name infringes an ones registered trademark. The researcher has explained below the provisions dealing with the same;

Sec.20: Undesirable name cannot be use to registered a Company: If any person wants to register a company in a particular selected name but if the Central Government forms an opinion that this selected name is undesirable then this company cannot be formed in that selected name⁵¹⁶.

The Central may consider a company's name undesirable if such name is identical or resembles too closely with the company's name which already exists.

The Court Kerala High Court in *Prof. D. Aravindakshan v. Union of India*⁵¹⁷ held that the petitioners proposed name 'Agastya Bio Tech' is identical with the existing name and hence is undesirable under Sec.20 (20(1) of the Co. Act 1956 and hence upheld the order of Registrar of Companies Kerala.

⁵¹⁵, Dr. G.K. Kapoor, Sanjay Damija, *Company Law And Practice*, (20th Ed. Taxman Publications(P)Ltd. New Delhi)

⁵¹⁶ Sec.20. Co. Act. 1956

⁵¹⁷WP(C). No. 4134 of 2014 (N)

Sec.22 provides for rectification Company's Name if in case such company's name has been registered for the first time or might be second registration and if the Central Government has a opinion that such registered name is either identical or it resembles too nearly to a already existing company which was already registered earlier. In such case the Central Government will tell such person to change such identical name and register in a new name and if the person defaults in doing so then such person shall be punished by fine fined⁵¹⁸. The Gujarat High court in *Pino v. M/S.P. Diesels Ltd*⁵¹⁹ took a decision under Sec.20 and Sec. 22 of the Companies Act 1956 and held that Respondents Company 'Pino Bisazza Glass Pvt. Ltd.' does not resemble too nearly with the Petitioners Company 'Bisazza Indian Ltd.'

In *Pvt. Ltd. v. Of Corporate Affairs & Anr*⁵²⁰ the Bombay High Court held that the direction given by the respondent No.1, 'Regional Director Ministries of Corporate Affairs', to the petitioner, 'Intelgain Technologies' on behalf of respondent No.2, 'M/s B.K. Barve and Co.', for change of name, under Sec. 22 of the Co. Act was not without illegality or infirmity.

Amendment in Companies Act 1956;

According to Sec 158 trade Marks Act 1999 and there has been an amendment under the Companies Act 1956 of Sec 20 which now provides that if any person tries to form a Company by using a Name, which is already some ones registered trademark or is applied for registration then such name will not be registered and in such case, the Registrar of the trade mark will have to be approached and consulted in order to confirm the same⁵²¹.

⁵¹⁸, Dr. G.K. Kapoor & Sanjay Dhamija, *Company Law and Practice* (20th Ed. Taxmann's Publications (P.) Ltd. New Delhi.)

⁵¹⁹ Special Civil Application No. 4876 of 2003.

⁵²⁰ WP 5173 (2012) BOM

⁵²¹ Manisha Singh, 'Redressal of Trade Mark Infringement under Companies Act'. <https://www.mondaq.com> 14-09-2007.

B) Companies Act 2013

The Companies Act which is a recent enactment dealing with Company Law in India also deals with infringement in a situation where such infringed trademark is used to register a Company in its name. The researcher has highlighted below important Sections dealing with the same;

Sec. 4 and Sec. 16 of the Companies Act 2013 are similar and corresponding to Sec. 20 and Sec. 22 of the former Companies Act of 1956.

As per **Sec. 4** of Co. Act 2013 ; If a person proposes to name a Company which such person wants to form under the Companies Act 2013 or may be such person wants to rename his or her existing Company in either situation, the Registrar of the Companies here in after ROC before accepting such name shall search under the search engine of Trademark Registry online and find whether such proposed name is infringing by reason of being identical to any ones existing trademark either registered or is applied for registration in any classification and if so then the ROC rejects such proposed name even if the activity of business of the proposed name is different.

Sec. 16 of the Co. Act 2013; Speaks about remedial measure which a registered trademark owner can take in case any person forms a Company or changes the existing name by infringing such proprietor's trademark. Such aggrieved proprietor can within 3 years apply to the Government, application mentioning about such registered Companies' infringing name or change in name, in either case, ask for rectification by giving direction for the same due to the reason that such Co. name is either identical it could even be that it resembles the aggrieved proprietors trademark too closely or nearly.

Once such infringing Co. gets direction, within 6 months period, it will change its name and in the event of failure to follow the direction and change such

infringing name, the owner of such Co. may be penalized under the penal provision of the Co. Act and also for defaulting the same repeatedly⁵²².

Now let us see ahead the remedy provided by .in Registry in India through its dispute resolving mechanism, working under NIXI if any person infringes or passes off Domain name.

3.9.6 Remedy by. IN Domain Name Resolution Policy (IDNRP)

This is an organization which is belonging to ‘National Internet Exchange Of India’ here in after referred as NIXI and which does the registration of the domain name which consist ‘.in’ at the end of its name . This organization has a dispute resolving mechanism with matter related to domain names. In case of disputes this organization appoints arbitrator and conducts arbitration proceedings as per the Arbitration & conciliation act 1996. The decision awarded can be further challenged by an appeal to the Court of justice.

This resolution policy is playing a positive role in combating the infringement and passing off of the genuine trademark in the domain name. Most of the times Domain name is either the proprietors business name or products name, in other words, actually domain name means trademark and hence an ample protection is required and the same is provided by IDNRP in India.

In *Gulshan Khatri v. Google Inc*⁵²³ the Appellant started using the domain name ‘googlee.in’ which is the similar mark belonging to the Respondent and hence the Delhi High Court dismissed the petition of the appellant asking to set the arbitral order given by NIXI (National Internet Exchange Of India) which directed khatri to give the Domain name to the respondent back as it was a infringing the respondents domain name ‘google’ and hence the court of appeal

⁵²² NV Saisunder and Srividya Sundaresan, India Jurisdiction Report : Remedies against infringing names, <https://www.worldipreview.com> 24-05-2019

⁵²³ [OMP (COM)497/2016]

did not interfere with the Arbitral order of NIXI as Khatri did this with bad faith.

The Courts in India encourages the fair working of NIXI and IDNRP by not interfering the orders passed by such domain dispute resolving organizations as they are helping hands of the Courts and also statutory authorities in fighting the infringement and passing off wrong committed by the infringer by using the domain names of others.

CHAPTER IV

STATUTORY AUTHORITIES

UNDER THE TRADEMARKS ACT

CHAPTER IV

STATUTORY AUTHORITIES UNDER THE TRADEMARKS ACT

4.1 INTRODUCTION

It would be very difficult to achieve the objective and aims of the trademarks legislation without the Statutory Authorities which plays an important role right from implementation of policies and strategies, to the execution of administrative remedies so as to prevent registration of infringing and fraudulent trademarks in goods and services in India. It is important and interesting to know that the concept of authority under the trademarks legislation was right from the passing of Trade Marks Act 1940 and again to the passing of TMMA 1958 and till date under the governing Act TMA 1999 but with the only difference that earlier the functions and administration of Intellectual Property Appellate Board (IPAB) was under the Registry of the TM and under the High Court where as now the they are performed by IPAB under the governing Act.

The Researcher has enumerated and explained in detail the different statutory authorities which look after the day to day functioning and administration of Trademarks Act 1999 in goods and services and other Intellectual Properties here in after referred as IP under their specific Acts.

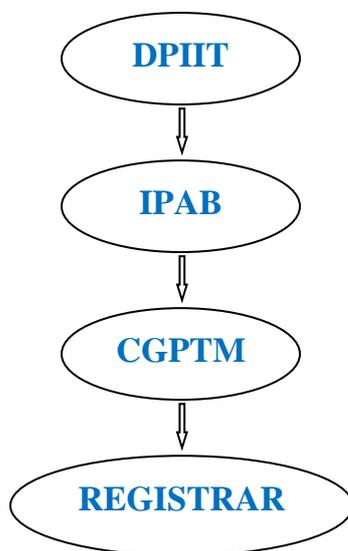
4.2 Authorities in Trademark Administration;

The following are the Authorities which look after the administration and functioning and implementation of the Trademarks Act 1999. It is to be noted that DPIIT is under the direct control of Government whereas other authorities mentioned below apart from DPIIT, are provided by the TMA 1999 and looks after the day today administration of the Trademark registry office and IPAB. The other Authorities too are established by central Government. Unlike the trademark Registrar and IPAB, DPIIT does not conduct hearing of proceedings

but plays a very important role in framing policies and strategies for development of trademark and other IPRs.

- A. 'DPIIT' (Department for Promotion of Industry and Internal Trade)
- B. Intellectual Property Appellate Board (IPAB)
- C. Controller General of Patents, Design & Trade Marks (CGPTM)
- D. The Registrar of Trademarks

The Statutory Authorities under the Trademark Act 1999 here in after referred as TMA 1999 enumerated above has been explained below with the help of diagram;



The above figure shows the different Authorities which looks after the administration of TMA 1999.

The Government through Ministry of Commerce plays a very important role in the development of Intellectual Property Rights under its body, 'DPIIT' (Department for Promotion of Industry and Internal Trade) Which was earlier called 'DIPP'(Department of Industrial Policy and Promotion) and this Government body in turn looks after the functioning of 'Intellectual Property Appellate Board' here in after called as 'IPAB', 'Controller General of Patents Designs and Trademarks' here in after 'CGPDTM' and the Trade Mark

Registry under the Registrar. Hence in India we have a well organized system which looks after the implementation and administration of Intellectual Property Rights with special reference to Trademark.

DPIIT which is the top most authority looks after the formulation of strategies, policies and development of trademark and other IPRs in India; it also keeps a vigil on the other Authorities as to the functioning and administration by these authorities while dealing with trademark and other IPRs.

This Government body does not undertake hearing of trademark related issues or any IPR matter or cases as this organization looks after the framing of policies and strategies which can help the Trademark Authorities like IPAB, CGPD TM and the Registrar of Trade Marks.

Next to DPIIT comes IPAB which is the highest Appellate body under the Trademark Act 1999 and all the appeal goes finally to this Board. One more important aspect which the Board looks after is Rectification proceedings under the Act.

Then comes the another important Authority, 'CGPD TM' which also plays a very important role in development of trademark law and its implementation and under the Act the Controller also is a Registrar of the Trademarks and finally last but not the least, 'Registrar under the Trademarks Registry' who looks after the administration of registration process and opposition proceedings of the trademarks for goods and services under the Act.

Now let us discuss each Authority separately as to their role in the administration and implementation of the Trademarks Act in India. The first authority is DPIIT which we will discuss and study in detail.

4.2.1 DPIIT

Now let us firstly analyze the first important Government body, DPIIT which looks after the Policy making and administration of trademark and other IPRs in India.

Earlier till 2000 it was called DIPP that was established in the year 1995. DIPP was reconstituted by a merger of DPIIT in the year 2000 and now known as DPIIT.

DPIIT operates its activities under Government's, Ministry of Commerce and Industries. DPIIT coordinates with WIPO as it is nodal agency of the same.⁵²⁴ Let us now understand the role of DPIIT in relation to trademark and other IPR development:

DPIIT's Role in IPR

The most important role of DPIIT is to create awareness, administration and policy formation in the functioning and development of trademarks and other IPRs.

- a) **Nodal Authority:** DPIIT is the Nodal Authority which formulates and also implements Intellectual Property Rights here in after referred as IPRs policy, which recognizes the significance of the Intellectual Property here in after referred as IP in this modern business world⁵²⁵.

⁵²⁴Current Affairs Today: The DIPP (Department of Industrial Policy and Promotion) has been renamed as Department for Promotion of Industry and Internal Trade (DPIIT). This will also work under the Union Ministry of Commerce. The order issued by President states that the department would deal with matters related to start-ups, facilitating ease of doing business among others. The subject matter of internal trade which was under the ambit of the Ministry of Consumer affairs has been transferred to the newly named department. With this new mandate both Internal and External trade has been brought under a single Ministry (Ministry Of Commerce and Industry). This will ensure better coordination and help in promoting the growth of both segments of the trade. This step has been taken as for long time Confederation of All India Traders Association (CAIT) was demanding for a separated Ministry of Internal Trade. <https://www.currentaffairs.gktoday.in>

See; DIPP has been changed to Department for Promotion of Industry and Internal Trade (DPIIT) vide Gazette Notification No. S.O. 507 (E) Dated 27th January 2019 (DPIIT) is also responsible for Intellectual property rights relating to patents, designs, trademarks and GI of goods and it also oversees the initiative relating to their promotion and protection. <https://www.en.m.wikipedia.org>

⁵²⁵ Global Launch of Global Innovation Index 2019 on 24th July 2019 in New Delhi to be organized by the WIPO in association with <https://www.dipp.gov.in>

- b) Policy formation:** DPIIT comes out with IPRs comprehensive policy in the matter related to trademarks along with Design Patent, Geographical indication (GI)
- c) Creates Awareness:** DPIIT also plays an important role in creating Awareness of IPRs with the help and assistance of WIPO. The Researcher also has explained the steps undertaken by DPIIT in trademark protection and development and Awareness.
- d) Administration:** DPIIT administers TMA 1999 legislation along with other IP legislations under its statutory subordinate offices by framing different strategies and developmental plans for the smooth functioning of the Trademarks legislation in India⁵²⁶ .

In order to implement different policies and strategies as mentioned above DPIIT laid a National IPR Policy in India of which certain important benefits have been enumerated and explained by the researcher below;

National IPR Policy by DPIIT

In order to promote creativity and innovation in Intellectual Property Rights a policy at National level has been formulated since 2016 with its objectives as follows;

- a) Effective IPR Legislation:** Strong IPR law on trademarks and other intellectual properties so as to protect the proprietary rights of genuine trademark owner as to the exclusive use of its trademark without getting infringed or passed off by wrong doer in India and also empowering and developing the office of IPAB, CGPDTM and Registry of Trademarks.

⁵²⁶ Annual Report (2017-18) ; The associated rules are administered through the office of the Controller General Of Patents, Designs And Trademarks (CGPDTM). The Intellectual Property Appellate Board (IPAB) provided de rre Trademarks Act 1999 as been set up in Chennai. www.ipindia.nic.in

b) IPR benefits: Create awareness of benefits of Intellectual Property Rights from cultural, economic as well as social context. Trademark being an important Intellectual Property, sooner a person is aware of its benefits the better it is so that every concerned person is aware of hers or his right in trademark and also knows how to protect the same under the trademarks act and all other Law in India. Knowledge of the same is imparted in schools so that majority of the children are aware of its benefit in the society.

c) Service Oriented Approach: Modernization of administration of Intellectual Property Rights with an objective of providing service oriented approach in the country. The ministry of Commerce under the Authority and Responsibility of DPIIT has upgraded the IP infrastructure at an international level as India is a signatory to TRIPS, Berne Convention, Madrid protocol and many others treaties . All this is done in order to provide a professional service in IPR at National as well as International Level. The CGPDTM'S and Trademarks Registry's offices has been computerized and made on-line in order to bring transparency in its working.

d) To fight infringement: DPIIT functions under the direct control of Central Government which plays a strategic role in combating infringement with the help and coordination of the Departments which are working under it by implementing the provisions of the trademark Act 1999. This is done by registering the genuine trademarks through the registry of trademark and also protecting them from unscrupulous traders by providing different administrative remedies under the Act to traders who are genuine proprietors of their respective trademarks in goods or services so that the trademark law achieves its purpose in letter and in spirit.

e) Human Resource Development: Development of human resource in IPR for training, conducting research, educating others in the area of Intellectual Property Rights so that the present generation becomes IPR generation who are well versed with the latest knowledge in the area of trademarks and other IPRs. The more training and education the staff gets in the field of Trademark Law,

more they are in a position to impart the same knowledge to the society at large as this is need of the hour as many of the people directly connected with the businesses or not are having a very limited or no knowledge of trademark and the rights and remedies there to.

CIPAM established by DPIIT: In order to implement IPR policies at National level DPIIT has established Cell for IPR Promotion and Management herein after ‘CIPAM’ which also includes creation of IPR awareness at College and school level along with industrial level. In 18 states of India CIPAM has conducted IPR road shows⁵²⁷. CIPAM in association and collaboration works with National Internet Exchange of India (NIXI) to stop the websites which are infringing the trademarks and other IPRs. The people of India in all walks of life must be totally aware of their rights in the trademark they own and also in other Intellectual Properties.

Steps undertaken by DPIIT in Trademark Law

Let us now go through the significant role played by DPIIT in the area of Trademarks and other IPRs development by implementing different policies and strategies;

a) Technological & Human Resource development: Several steps are taken such as hiring of extra manpower and also conduct different training program for the staff and officers who looks after the functioning of the administration of the DPIIT. So also technological advancement to register the trademarks earliest⁵²⁸. All this is done in order to bring in a professional functioning of the intellectual property law and also to maintain a service oriented approach to the people who are dealing with IPRs.

⁵²⁷DIPP which is now (DPIIT) and CIPAM organized National Workshop on Enforcement of IPR from 22 to 24 August 2017 for State Police officials, Public Prosecutors and representatives from Industry and Academic field.

⁵²⁸ Economic Times: Secretary in the Department of Industrial Policy and Promotion (DIPP) said that as the Economy is growing at a faster pace, focus on innovation and Intellectual Property Rights (IPR) are fundamental. He also assured that steps were taken by the department which has helped to improve the IPR regime substantially.
<https://www.m.economictimes.com>

b) Augmentation of Examination process: So also the number of examiners has also been increased considerably in order to conduct systematic examination of all the trademark registration applications in the registry and see if the mark applied for registration does not conflict with the prior user's registered trademark, and if so object such registration as this second registration would give rise to infringement and passing off, of the earlier registered trademark.

c) Expedite Registration process: The processes and technologies has been re-engineered for the examination and registration of the trademarks which obviously and positively helps registration of genuine trademark which ultimately makes such mark legally strong in protecting its rights under the statute by instituting an infringement proceedings against the infringer of such registered trademark.

d) Training Programmes for Judges: High Courts judges, 30 in number in Bhopal were trained in association with WIPO⁵²⁹ so that judges are aware of the advancement in the Intellectual Property Law. This training is conducted taking into consideration the latest development and trends taking place in Trademark and other IP laws. This is one of the important move taken as this type of training increases the knowledge of the judges and also increases their confidence in deciding the trademarks cases and other IP cases too.

e) MSMEs Training: This training was imparted in order to understand how to use the Madrid protocol as there are many MSMEs who would like to conduct trade and dealings at an International level and hence they require to register their trademark in one or more than one Country besides their registration in India.⁵³⁰

⁵²⁹ IP Annual Report 2018: This training was conducted in November from 16 to 18, 2017.

⁵³⁰ NIIPM (National Institute of Intellectual Property Management) Works for building awareness among MSMEs in the field of Intellectual Property Rights..

See; ByKarriSankaraRao, Abdol Rahman Noorinasab NIPO (National Intellectual Property Organization) : is an umbrella initiative destined to put India on the map of intellectual superpowers. NIPO's Mandate includes developing policy initiatives in the area of IP; harnessing Intellectual Property assets & Knowledge to generate economic wealth, help, & assist individuals & organizations in capacity building and work as a platform for development, promotion. Protection, compliance & enforcement of Intellectual Property & Knowledge including through interactions with other

f) Development of IPAB: There have been different schemes in order to strengthen Intellectual Property Appellate Board and also development in terms of infrastructure for smooth and effective functioning of the Appellate Board.

Now having discussed the role of DPIIT in the area of trademark and other Intellectual Properties, let us now analyze the role and functioning of IPAB in the execution of trademark law while performing its appellate jurisdiction while hearing the appeals and also in dealing with rectification proceedings.

4.2.2 INTELLECTUAL PROPERTY APPELLATE BOARD (IPAB)

Intellectual Property Appellate Board here in IPAB mainly deals with appeals and rectification proceedings filed by the aggrieved party against the registration order and other orders passed by the Registrar of trademarks. Appeals from Controller General will be preferred to IPAB within the prescribed time limit. It is very important to note that earlier before passing Trademarks Act 1999, the rectification proceedings were conducted by the Registrar of trademark and the High Court in India there was no separate appellate body to hear rectification matter before 1999. The TMA 1999 has provided an independent body 'IPAB' formed by the Central Government for conducting rectification proceedings of trademark in relation to goods and services so as to expedite such matters as early as possible⁵³¹.

Objective of IPAB

The objective of the IPAB is speedy disposal of the appeals as well as Rectifications Application and makes every effort to meet and achieve the aim of the trademark Act of preventing the registration of infringing and fraudulent

organizations in India and abroad which are active in this field can record your website under intangible asset provided you meet all the recognition criteria. IOSR Journal of Business and Management (IOSR-JBM) e-ISSN: 2278-487X, p-ISSN: 2219-7668. Volume 15, Issue 2(Nov. –Dec. 3013), PP 13-21. <https://www.iosrjournal.org>

⁵³¹Sec.32 of TMA. 1999. Bar of Jurisdiction of Courts: No Court or other authority shall have or be entitled to exercise any jurisdiction, power or authority in relation to the matters referred to in Section 31(1).

trademarks. In order to meet this objective the Board should make every effort for smooth functioning of its administration by appointing all the Board members timely⁵³².

Establishment of IPAB: According to Sec. 83 of TMA 1999 the Central Government by giving a notification In the Official Gazette established the Appellate Board called Intellectual Property Appellate Board and here by after referred as IPAB which is an highest appellate administrative body *in* the year 2003 on 5th September in order to conduct hearing against the order and decision of the Registry of Trademarks under the TMA 1999 and Geographical Indications of Goods Act, given by the Registrar⁵³³. IPAB also deals with one of the most important aspect, which is ‘Rectification’, filed by the genuine trademark owner when someone else copies such trademark and has files for registration of the same. The procedure to be followed for filing rectification has been laid down in the TMA 1999⁵³⁴.

Jurisdiction to hear Appeal: In the year 2007 from 2nd April onwards the IPAB has been given Authority to hear and also decide the Appeals arising out of orders and decisions made by the Registrar of trademarks and the CGPDTM⁵³⁵. Also appeals pending in the High Courts are also transferred to IPAB⁵³⁶.

⁵³² The Hindu Times: About 630 cases of Trademarks, patents, and Geographical Indication are said to be pending before the Bench. After a gap of 2 years, the Chennai Bench of IPAB has started hearing cases much to the relief of the Industry. Hence there was a backlog of cases. As many as 142 cases mainly for admission and some withdrawal petition were listed for hearing on Monday and Tuesday. Intellectual Property Lawyers were relieved that hearing resumed. <https://www.thehindu.com> 27th Feb. 2018, 01:05.

⁵³³ Sec.83 TMA 1999; Establishment of Intellectual Property Appellate Board (Weft, 15-09-2003) Notification: SO 1049 (E).**See** Statement of Objects and Reasons: To achieve the purposes for which the trademark law was re-enacted, it was proposed, inter alia, to provide for an Appellate Board for speedy disposal of appeals and rectification applications which then lay before the High Courts. Accordingly the IPAB was established by the Central Government.

⁵³⁴ Procedure for filing Rectification : The following things are important while filing rectification;

- a. Application filed must be in triplicate and in form TM-26, or the form TM-43(for Collective or Certification Trademarks)
- b. A clear and crisp statement of grounds, associated with the application.
- c. Evidences to support the rectification or removal of the specified trademark. <https://www.trademarksindia.net>

⁵³⁵ Original Application for Rectification of Register of Trade Marks can be filed before IPAB under ;

Sec. 91 TMA1999 speaks about the appeal which can be made to the IPAB by the aggrieved person against the decision of the registrar or order of the registrar⁵³⁷.

‘Infringement Action, Passing Off Action and Criminal Offences untouched by IPAB, which simply means that the District and High Court’s Jurisdiction will remain the same as earlier without being perturbed⁵³⁸. As regards the same, the Parliamentary Committee had made a recommendation to enlarge the IPAB’S Jurisdiction and that also give the Board, Constitutional setup and Status.⁵³⁹

a. **Sec.47 or 57** of the TM A, 1999.

b. **Sec. 125** of the TMA1999.

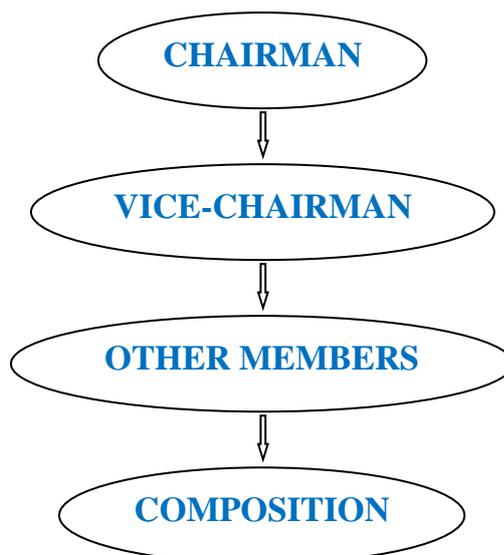
⁵³⁶ Subject to **Sec. 117G** of IPA, all cases that are related to decisions or orders of the Controller which are pending in the High Court must be transferred to IPAB.

⁵³⁷**Sec.31:** Appeals to the Appellate Board –Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made there under. May prefer an appeal to the Appellate Board within 3 months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal.

See: Trade Marks Rules, 2002: Appeals from an order or decision of the Registrar of Trademarks issued under Rule162 of the Trademarks Rules 2002 can be filed before the IPAB.

⁵³⁸Supra note 3. The definition of Appellate board in the present enactment has been modified as ‘Intellectual Property Appellate Board’, compared to Clause 84 of the 1993 Bill which the Board was to be designated as ‘Trade Marks Appellate Board’ which means the current modification implies that the appeal not only under the trademarks Act, but also in respect of all Intellectual Property matters which would include, Patents, Designs, Copyrights, Geographical Indications etc can be made in IPAB.

⁵³⁹ **Ibid. Gist of Recommendation;** The Committee has been informed that 42nd Amendment to the constitution in 1976 inserted a new Part 14 A of the Constitution with a view to establishment of Tribunals for reducing litigation. Decision of such tribunal can be challenged only under Article 136 of the Constitution before the Supreme Court. The Committee therefore without persisting for an urgent addition of a special clause recommends that the Government should include provision for establishment of the Appellate Board envisaged in Part 14 A of the Constitution for the said purpose. The Committee is of the opinion that if required, Government should bring forth an Amendment to the relevant provision of the Constitution for implementing the recommendation of the Committee in letter and spirit. The Committee trusts that the Government would take a positive action in this regard in due course.



The Appellate Board is headed by the Chairman who is the head of the IPAB and also has Vice-Chairman and Central Government appointed members. Benches discharge the functions and duties of the Board with the authority given to them to exercise the power under the TMA 1999⁵⁴⁰.

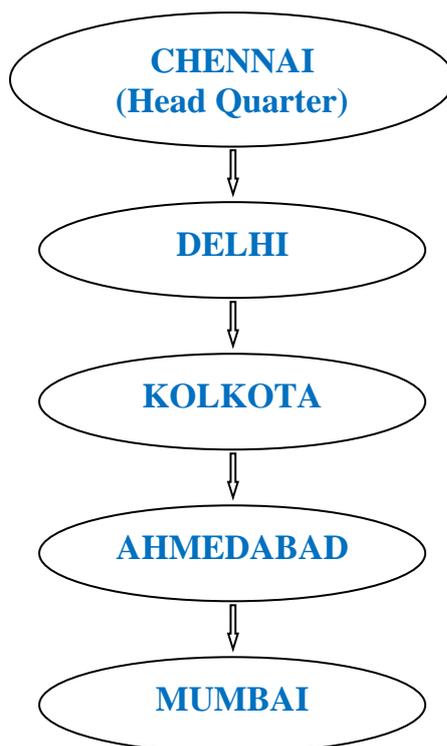
Bench of IPAB while discharging the duties shall have one technical person as a member along with another member who discharges Judicial functions⁵⁴¹.

Since there are benches which discharge the duties and functions of the appellate board there are transfer of members from one bench to another and this transfer is undertaken by the Chairman.

In any decision making if there arises disagreement between the judicial and the technical member then taking into consideration the Chairman's vote or opinion either judicial member side or technical member side will form the Majority or the case will be decided.

⁵⁴⁰Economic Times: By Khomba Singh, Madras High Court: 'Certain provision in the Trademarks Act unconstitutional'. The Madras High Court declared as unconstitutional a subsection of TMA 1999 which qualifies a member of India Legal Service to the post of Vice-Chairman of IPAB. By PTI/updated Mar. The bench also made it clear that recommendation of Chief Justice of India to the post of IPAB Chairman be given due consideration by the Appointment committee of the Cabinet. 12th 2015 02:55 AM. <https://www.economicities.com>

⁵⁴¹ Economic Times: 'IPAB Centre likely to come up in Mumbai, Delhi and Kolkata', The Delhi High Court has asked the Ministry concerned for setting p permanent Centres of Intellectual Property Appellate Board(IPAB) in these three cities . This follows a Public Interest Litigation b a group of lawyers, who complained about the logistic delays in resolving disputes. <https://mwww.economictimes.com> 3rd May, 2011.



Place of Sitting of IPAB

The Headquarter of IPAB is at Chennai and there are 4 benches operating in four different places of India, namely Delhi, Kolkata, Ahmedabad and Bombay. In each bench of the Board comprises of;

1. Judicial Member (one)
2. Technical Member (one)
3. Other Members.

In any sitting of the bench in decision making will have these important members to taken decision and functioning of the Appellate board⁵⁴².

⁵⁴²Live Law: By Akansha Jain, 'Pained To See IPAB Tech Member Post Lying Vacant For Years, Deli High Court Invokes 'Doctrine of Necessity', The Delhi HC was faced with a painful situation as it learnt that the post of technical member (trademark) in IPAB is lying vacant since 05 December 2018. Justice Midha noted "About 3935 cases are pending adjudication before IPAB across all Benches. Cases relating to Trademarks and other IP are not being taken p as there is no Technical Member relating to those specialties. <https://www.livelaw.in> 15th July, 2019, 2:25 PM.

Limitation period: Once the person is communicated the decision or order is made known to the aggrieved person by the CGPDTM or Registrar of the trademark, such person gets 3 months from the date of communication of such order⁵⁴³.

Exception: To the rule of limitation period of appeal is that the Appellate board may consider such appeal even beyond the period of 3 months if the appellant satisfies the appellate board that there was a sufficient cause for delay upon which the board shall condone such delay.

Grounds for filing Rectification: The Researcher has enumerated some of the grounds for filing rectification proceedings by the aggrieved party in context with infringement and passing off of such aggrieved persons prior in used trademark in goods or services. It has to be noted that these are some of the grounds but the IPAB may decide the case taking into consideration facts and circumstances of each case. The following are some of the grounds for rectification proceedings;

1. **Fraud:** The aggrieved person can file for rectification on the ground that the registration was procured by fraud. If the aggrieved person is able to produce evidence in this regards then the appellate board will definitely struck off such conflicting and disputed trademark from the trademarks Registry by passing an order on the same.
2. **Misrepresentation:** The genuine trademark owner can initiate a rectification proceedings on the ground that the impugned registered trademark proprietor obtained such registration by misrepresenting the facts relating to such registration e.g. At the time of filing registration, such person represented that he or she is the prior user of such trademark in the classification in which the said mark got registration but in reality it was not true and that some other person was the prior

⁵⁴³Sec.117A (4) of the Trade Marks act 1999.

user. Based on the evidence as regards the same the appellate board shall pass the order for cancellation of the said trademark's registration from the registry of trademark.

- 3. Well-known Trademark:** If any trademark manages to get registration under the act and this mark happens to be identical or deceptively similar to a well known trademark and prior in use, then the proprietor of such well known trademark by filing rectification in the IPAB can remove such second user's trademark from the trademarks Registry even if such disputed second users trademark falls in some different classification of goods and services.

Functioning of the appellate Board while administering Appeal:

- a. Filing of Appeal:** Once the appellant files an appeal from the order of CGPDTM or Registrar of Trademarks or for Rectification of trademark for goods or services in IPAB, under **Sec. 57** of TMA 1999 in a prescribed form and time the process starts.
- b. Hearing and Passing of Order:** Once the Appellate board passes decision or any order after conducting a fair trial by hearing both the parties, taking into consideration the evidence and facts of each case, each and every such order or decision once passed shall be sent to the Registrar who shall do the noting of the same in the records of the Registry.
- c. Implementation of order by Registrar:** The Registrar shall execute the decision passed by the IPAB by bringing an effect to the Appellate Boards order and also do the necessary changes in the entries of the Register and also rectify the Register as per the Boards order.

IPAB's Role in Combating Infringement and Passing Off

Though the IPAB has no statutory powers to try Infringement proceedings directly like courts does but still the Board does play a very important role in preventing the registration of infringing marks in the rectification proceedings administered by it, which means that the appellate board does not allow the registration of ;

- a. Identical Marks :** If any person files an rectification application against a registered trademark proprietor to struck off such mark from the register of the trademark registry then the IPAB looks whether the impugned trademark is identical with the appellants trademark and if so then it sees who is the prior user of this disputed trademark and if both these points are in favour of the appellant who has filed the rectification then the IPAB passes an order for cancellation of such impugned trademark for infringing the genuine trademark owners right.
- b. Deceptively Similar:** In a rectification proceeding many a time the disputed trademark might not be identical with the appellant's trademark but it might be deceptively similar and due to this it can amount to infringement or passing off of the genuine trademark. In this situation also the IPAB will pass an order for cancellation of such infringing trademark.
- c. Confusing Trademark:** There are some registered trademarks which can create confusion in the mind of public and consumers, when these marks are compared to genuine prior used trademarks in a certain class of goods and services. Taking into account this fact the IPAB cancels the registration of such disputed and conflicting trademark of the second user since such marks infringes the prior users proprietary right of exclusive usage in the her or his trademark.

- d. Prevents Passing off:** Marks which can pass off the goods or services as those of other person are struck off or cancelled by the IPAB in a rectification proceedings so as to prevent confusion and deception in the market. The appellate board makes sure while deciding the cases on rectification that no person makes good at the cost of another person's loss.

Functions and Powers of IPAB

The researcher has enumerated the powers and different functions of the IPAB in its administration under the Act which helps the smooth functioning of the day today work of the board in providing justice to the aggrieved party. The TMA 1999 has established the IPAB and also has empowered the board to carry these functions so that the objective of the Act is achieved.

1) Power to regulate proceedings

IPAB being an autonomous body can very well regulate its proceedings as well as it can decide about the time and place, taking into account the facts and figures of each case⁵⁴⁴.

2) Power of Civil Court

Under the Code of Civil Procedure the IPAB is parallel in power to a Civil Court. For example:

- a. Receiving Evidence:** It can receive Evidence as and when required for the purpose of deciding the case.
- b. Issuance of Commission:** In the case of witness examination the Board can issue Commissions so as to arrive at a just and proper decision under the Act
- c. Requisitioning Public Record:** This is also one of the important powers which the Appellate board exercises of requisitioning public

⁵⁴⁴ IPAB is not bound by the procedure laid down in the Civil Procedure Code but is guided by the principles of Natural justice. Sec. 92 of Trademarks Act 1999.

record as and when it is necessary for understanding the facts of the case properly.

- d. Punishment:** IPAB can punish in a case where a person gives evidence which is false in nature as the principle must be followed by any person that he or she should come with clean hands at the Court.
- e. Making Rules:** The Appellate Board while conducting proceeding or making procedure can make rules as regard the same⁵⁴⁵.
- f. Transfer of Cases:** The Cases can be transferred from a bench to another by IPAB's Chairperson by the power vested in him as regards the same.
- g. Considered as Civil Court:** The IPAB will be considered as a Civil Court in the case of prosecution of any person , if a contempt of authority of the public servant is done by such person and if such a person commits offence under Section 195 of Criminal Procedure Code 1973 .

*IPAB Rules BSA a Well Known Trademark in Tube Investment of India Ltd. v. BSA Group SDN. BHD.*⁵⁴⁶ The IPAB ruled and held that TI's BSA is a Well Known Trademark and the Board also ordered to remove the trademark registered by the Malaysian Company from the Register of the Trademark.

The IPAB said that the TI has been in the manufacture of bicycles in the name BSA has been in the Market for five decades in India and also is the registered proprietor of 25 Trademark of BSA mark in India as well as other Counties too.

⁵⁴⁵The Intellectual Property Appellate Board (Procedure) Rules, 2003 were made by IPAB to regulate its proceedings in exercise of powers conferred upon it. The decision of the Board shall be final and binding.

⁵⁴⁶ IPAB 16 July 2018. *Tiv.BSAMalaysianGroup*; Tube India (TI) a group Company from Chennai owned by Murugappa Group and the manufacture of BSA bicycles filed a rectification petition against the Malaysian Company BSA Group alleging BSA trademark which is in similar service is unfairly remaining in the records of Trademark Registry and thus appealed to the IPAB for removal of it . <http://www.bananaip.com> weekly trademarks news

See; IP India Annul Report 2018: The process of determining well known trademark has been laid out for the first time.

After going through the functions of IPAB, let us now look into the limitations of the Board which the researcher has examined and mentioned as below;

Limitation of IPAB

Though IPAB is the highest appellate body in the administration under the TMA1999, with wide ranging powers, still it as limitation in the administration which the researcher as highlighted below;

- a. **Manpower :** Practically it evident that there were no vacancy filled of even important key dignitaries who looks after the administration of IPAB e.g. The Technical member required for taking decision on Trademark issues etc⁵⁴⁷.
- b. **Delay:** Due to the shortfall of manpower, there has been lot of delay taking in deciding the rectification proceedings by the IPAB which gives a unprofessional outlook for the same. Many a times it takes years for a case to be finally decided b IPAB due to which the aggrieved appellant suffers loss I man ways.
- c. **Purpose of Act is defeated:** The saying that not providing justice in proper time is like providing justice not at all. The objective of the Act is registration of genie trademark and prevention of fraudulent and infringing trademark for goods and services and if there is lacuna and loopholes in the administration then the Act will be just a paperwork and formality.
- d. **Reluctant in filing Rectification:** Due to all above reasons the aggrieved person is reluctant to file rectification as there is lot of time and cost involved in the same and as a result she or he has no option but to let go the injustice suffered by such aggrieved party.

⁵⁴⁷ Spicy IP: By Shamnad Basheer; after more than a year of speculation, retired Delhi High Court Justice Manmohan Singh has been appointed as the Chairperson of the IPAB. <https://www.spicyip.com> May 29th 2016.

See; Times of India, Chennai; By A Subramani /TNN: Trademark and patent disputes pending for years before the IPAB will suffer some more delay as the National body has now been reduced to a headless and one member institution. <https://www.m.timesofindia.com> May 14th 2016.

- e. Foreign trade affected:** Due to all these shortcomings the foreign reputed Companies are reluctant to start trading in India due to the fear of infringement and no timely action and protection by the authorities under the Act. India is Signatory to TRIPS and Madrid protocol and many other International agreements and conventions and if our IPAB is performing in this style then it is quite alarming that we will give a very wrong impression to the other Nations of the World and which will adversely affect International trade and commerce between India and other nations.

Next important restricted limitation on the power of IPAB is the power of High Court.

High Court can exercise judicial review on IPABs Decisions; Any high court within whose jurisdiction an order or decision is taken by IPAB, such order can be reviewed judiciously by such High Court⁵⁴⁸. The Constitution of India gives power of judicial review on lower courts⁵⁴⁹.

Special leave for appeal vis a vis Supreme Court: The Constitution of India has empowered the apex court of the Country to give the appellant a Special leave against order of IPAB and any other tribunals in India⁵⁵⁰

Next important Authority which the researcher is going to discuss is the CGPDTM which plays one of the significant role in the administration of Trademarks Act to achieve the aim and objective of the same.

⁵⁴⁸ Jashvaidya Word Press: In contrast to the powers of High Court, Sec. 109(5) of TMA 1999 had done away with the 2nd Appeal mechanism in relation to IPAB and Sec. 95 of the Act restrained the IPAB from passing ex-parte interim orders pending appeal. Therefore it was contended that the Parliament did not transfer all the powers of the High Court to the IPAB. Thus even though the High Court may have power of review, the same did not extend to the IPAB. However it was submitted that the IPAB had a limited power to review procedural errors but could not review on merits. <https://www.jashvaidya.wordpress.com>

⁵⁴⁹ Ibid .Article.227 of Indian Constitution: The High Courts in India derive their Power of Judicial Superintendence over the decision of all Subordinate Courts and Tribunals.

⁵⁵⁰ Article.136 of the Constitution of India 1950.

4.2.3 CONTROLLER GENERAL OF PATENTS, DESIGN AND TRADE MARKS (CGPTM)

Controller General of Patents, Design and Trademarks herein after referred as CGPTM which is the administrative body of IP Laws such as Patent Act, Design Act, Registrar of Trademarks Act and Trademarks Act and GI Act under the TMA 1999 and the office of CGPDTM is in Mumbai IPR⁵⁵¹.

Amendments in the Trademarks Rules 1999 notified in March 2017 contains provisions for simplification of procedural formalities for registering the trade marks in a simple manner by introducing a user-friendly system.

The main office of Trade Marks Registry is in Mumbai, and there are four branch offices at Chennai, Delhi, Kolkata and Ahmadabad. GPDTM has been continuously endeavoring to strengthen the IP System in India also meeting International obligation and staying in par with the Global Development in IPR. CGPDTM reports to the DIPP as regards its functioning Mumbai⁵⁵².

The head of the registry offices of trademark is Controller General of Patent Design and Trademarks who also is Trademarks Registrar and CGPDTM delegates the power of Registrar to officers in the Registry.⁵⁵³

⁵⁵¹ Ibid. Sec. 3 of TMA 1999, the Central Government by notification in the Official Gazette appoints Controller General of Patents, Designs and Trademarks and who shall be the Registrar of the trademarks for the purpose of the Act.

⁵⁵² The entire Intellectual Property offices works and functions under the control and superintendence of CGPDTM. Day to day operation of activities of GGPDTM involves wide range of functions and activities right from receiving of applications for granting IPSs to the International relations internationally with regards to IPRs. Rajiv Gandhi National Institute Of Intellectual Property Management, Nagpur, also operates and works under the control and Superintendence of CGPDTM. www.cgpdtmrecruitment.in

⁵⁵³ Presently all the functions of the Trade marks Registry are performed through an Automated Trade Marks System. The Central Server of TMR is at Intellectual Property Office (IPO) Building in Delhi and Disaster recovery server is at IPO, Mumbai. All branches of the Trade marks Registry are connected to the main server in Delhi with Virtual Private Network (VPN). All the actions done by the office staffs through the TMS are recorded in the Central server on real time basis. <https://www.ipiindia.nic.in>

Registries and Departments under CGPDTM

The various different registries and Departments which are working under the control of CGPDTM for smooth administration of trademark and other intellectual property rights are as follows;

1. Patent Office at Kolkata, Mumbai, Chennai
2. Trade Marks Registry in Mumbai, Chennai, Delhi, Kolkata and Ahmadabad.
3. Design Office in Kolkata.
4. Geographical Indications registry in Chennai.
5. Rajiv Gandhi National Institute of Intellectual Property⁵⁵⁴.
6. Copyright office in Delhi.

The Government of India through the Ministry of Commerce has played a positive role in protection of IPR by developing and strengthening the IP system in India. On 12th May the 2016, the National IPR policy was launched which comprises of main objectives of IPR.

Functions of CGPDTM

It is the duty of CGPDTM to provide efficient and transparent service to the public. The most important function of CGPDTM under the TM Legislation is as follows:

- a. **Smooth Functioning:** An efficient and transparent IP administration builds trust amongst the IP owners who file their applications. The most important objective of IP framework is processing of these applications filed and also providing satisfactory services. CGPDTM with its office has been continuously endeavoring to strengthen the IP System in India considering and also meeting International obligations and remaining in

⁵⁵⁴ Annual Report IP India 2018. IP awareness and training programmes are regularly conducted at Rajiv Gandhi National Institute of Intellectual Property Management (RGNIPM) Nagpur which has been specially established to strengthen IP awareness and also education and research in the Country.

par with the Global Development in the field of IPR. The office plays an important Role in the smooth delivery of public services⁵⁵⁵.

- b. Financial Assistance and support:** Is provided by CGPDTM for creating programmes on awareness in the area of Intellectual Property. This is done at national as well as well as international level workshops are conducted, also seminars and many symposia are also conducted and all this is done with the association with JPO and WIPO.
- c. Awareness programmes:** Are conducted by CGPDTM at School level as well as University and Industry level in association and collaboration with Industries⁵⁵⁶.
- d. Technology Up-gradation:** It has taken many initiatives to upgrade the IT System in the offices of Intellectual Properties by up-gradation of digital and On-line System and a 24 hour service through the official website of Intellectual property India which can be utilized by any person from any part of the world.
- e. International Division:** Initiatives have also been undertaken by the office of CGPDTM for improving and developing its International Division. International Search system so also Preliminary Examination Reports are provided under International Searching Authority (ISA)

⁵⁵⁵ Intra Bulletin; O.P. Gupta, ‘As a Controller General one of the biggest challenge is registration of IP including trademarks. Te trademark registry has enhanced its activities, automation of processes relating to registration already implemented. Intensive training of examiners and other staffs, also setting p of quality control mechanism so applications are filtered and re-examined thereby increasing the number of acceptances and all these steps have resulted in reduction of first examination pendency to less than 5 months currently and will be brought down to one month or less before March 2017. <https://www.inta.org> Vol.71. No.19. Nov. 1st 2016.

⁵⁵⁶ 41 awareness programmes were held by CGPDTM in collaboration with Industry Association in the year 2017 for schools, universities and industries across 18 states as a part of awareness campaign. During 2017-18 the office of CGPDTM has conducted 46 such IP programmes. <https://www.ipindia.com>

Let us now study another important authority under the trademarks legislation, the Registrar of TM, who has the first authority and power either to register or not to register the applied trademarks for goods or services under the Act. Let us examine the role played by the Registrar in the achieving the objective of the Act of giving protection to the trademarks in India by curtailing the use of Infringing trademarks by preventing registration of such mark and registering the genuine trademarks.

4.2.4 THE REGISTRAR OF TRADEMARKS

Trademarks Registry here in after referred as TMR was established in the Year 1940 under the Trade Marks Act 1940 and its first Office was started at Mumbai. The Primary object of this Registry was the Registration of the trademarks and also the protection of the trademarks from infringement and passing off by way of deception and fraudulent use in the Country. The Government from then on till now under this Governing legislation of TMA 1999 has always appointed a statutory officer in charge and head of the registry known as ‘Registrar’⁵⁵⁷. Who is the key authority, who has the responsibility and duty of registering the trademark for goods and services and also protecting the genuine trademarks from infringement/passing off by not allowing the registration of identical, deceptively similar, fraudulent trademarks by denying the registration of the same by being vigilant on the same⁵⁵⁸. The trademarks Act has vested many powers in the Registrar so as to carry his duties and

⁵⁵⁷Sec. 3 TMA 1999: Appointment of Registrar and other officers:

- I. The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.
- II. The Central Government may appoint such other officers with such designations as it thinks fit for the purpose of discharging, under the superintendence and direction of the Registrar, such functions of the Registrar under this Act as the Registrar may from time to time authorize them to discharge.

⁵⁵⁸Economic Times: ‘Amul goes offensive against other brands using its name’, A case has been filed in the Gujarat High Court against the Trade Mark Registries in Delhi, Mumbai, Kolkata, Chennai and Ahmedabad for allowing the registration of Amul or similar sounding names as trademarks.

functions of the registry and also to achieve the aim and object enshrined in the preamble of the Act⁵⁵⁹.

The Researcher has explained the Role, Authority, and Functions of superintendence and Responsibilities, delegation of power of the Registrar of Trademarks. The Registrars Function of Superintendence and Direction has also been explained in this chapter. The Registrar's Powers of Civil Court as well as other Discretionary Powers and Residuary Powers Cases are also explained in this Chapter.

Composition of Registry

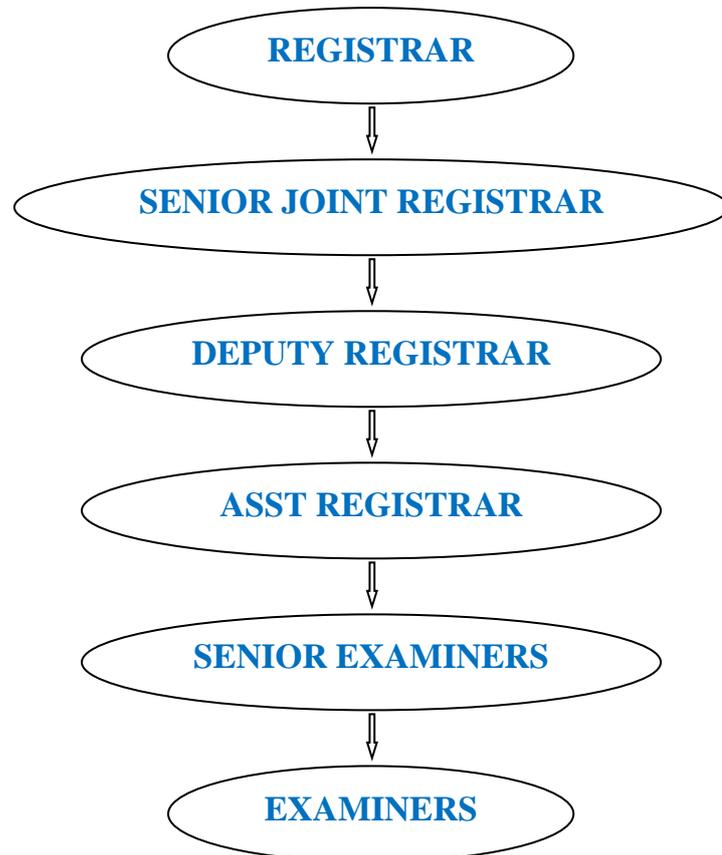
The following flow chart clearly indicates the Authorities under the trademark registry in a Hierarchical order wherein right at the top is the Registrar of the trademarks who is followed by Senior Joint Registrar and then comes the Deputy Registrar who is finally followed by the Assistant Registrar of the Registry and this statutory officers comprises the Registrar division of the trademarks Registry. Then follows the hierarchy the Senior Examiners and other Examiners. All these authorities play a significant role in the smooth functioning of the Registry of trademarks.

Apart from the Registrar who is the head of the Registry, other statutory officers appointed by the Central Government performs the functions of the Registrar as and when the duties and responsibilities are delegated to them by the Registrar for the smooth function of the Registry. It has to be noted that though the duty of performing the functions of the Registry is delegated to the officers of the Registry, the Registrar maintains the responsibility of his superintendence over the Registry functionaries and for this the Registrar issues all the required Directions to the officers of the Registry as and when they required.

⁵⁵⁹ TMA 1999(Act No. 47 of 1999) Preamble: An Act to amend and consolidate the law relating to trade marks, to provide for registration and better protection of trade marks for goods and services and for the prevention of use of fraudulent marks.

Below chart depicts the Hierarchy of Trademark Registry for the purpose of registration and administration of trademarks various administrative officers and staff members are appointed by the Central Government.

Hierarchy in the Trademarks Registry



Registry's Place of sitting: The main headquarter of Trade Mark Registry is in

1. **Mumbai** and other Branches are located in:
2. **Kolkata**
3. **Delhi**
4. **Chennai** and
5. **Ahmedabad.**

Powers and functions of TMR

The function and Responsibility of the Registrar of Trademarks is that he has a Statutory Authority to;

1) **Registration:** One of the most important function and responsible duty of the registrar is the Registration of the Trade Mark for Goods or Services. Unlike former Trademark Act passed in 1940 and 1958 the present TMA 1999 provides for registration of service mark which is a great development in the area of trademark protection as there was no statutory protection in the earlier trademark legislation. This means that a proprietor of a service mark prior to 1999 could not bring a statutory action in the situation if anyone would infringe such proprietor's service mark⁵⁶⁰.

2) **Power to refuse the trademark registration :** Sec.11 of the trademarks act mentions the following relative grounds for refusal of registration of trademarks by the Registrar;

a. Identical/deceptively similar: If the applied trademarks identify with the existing trademark and also due to the similarity of the goods and services. In *Enfield India Ltd v. Deepak Engineering Syndicate*⁵⁶¹ Application of Deepak Engineering for Mark Bullet in class 7 for oil product was rejected as the opponent Enfield's 'Bullet' a well Known 'Registered Trademark' in class 12 was being infringed.

⁵⁶⁰Economic Times Mumbai: By Lubna Kably, TNN: 'India Inc can now register trademark as well known' In a significant development, the Trade Mark Rules 2017- which were notified on March 6th – Permit Companies to apply for their trademark to be recognised as a well-known one. In simple terms, a well known trademark is one that is well recognised and any infringement could result in misleading the public. Prior to this notification any trademark was held as Well-Known b Courts only consequent to a dispute regarding its use, such as when another party applied for registration of the same or similar trademark . <https://www.economictimes.com> Mar. 8th 2017 11:39 AM.

⁵⁶¹ 2006(32)PTC(397)IPAB

- b. Deceive/Confusion:** There is likelihood of confusion due to the similarity with the earlier mark for goods and services which means that even if there is no actual confusion between the earlier trademark and the applied trademark but still if there is any smallest chances of confusion which can take place in the mind of the average consumer then the Registrar may reject registration of such trademark. The Act does not allow the deception of any person by tactics of infringer and hence empowers the Registrar not to register such deceiving trademarks for goods and services.
 - c. Well Known trademark:** The trademark cannot be registered if the similar trademark is registered by a different proprietor and who's the goods and services are different but the earlier trademark is well known trademark. This is for simple reason that the trademarks Act protects the rights of a proprietor of a Well known trademark because such reputation is earned by efforts and intelligence which also involves high cost in terms of advertisement etc.
 - d. Malafide Intention:** If the applicant does not have a bona-fide intention in the registration of its trademark and is doing this with a wrong intention to take advantage of someone else's trademark by planning to infringe or pass off the same then obviously such trademarks can be opposed by the aggrieved party
 - e. Contrary to Indian Law:** The applied trademark cannot be registered if the same is contradictory to the law in India.
- 3) Superintendence and Direction:** The Registrar is shouldering a responsibility of issuing direction to all the authorities working in the registry as to the functioning and administration of the registry work so

also the registrar performs the function of Superintendence on the registry work delegated to the authorities⁵⁶². These two functions bring in discipline in the registry and also adds value to the services provided by the Authorities⁵⁶³.

- 4) Discretionary Powers:** He carries with him Powers to carry the functions and objective of the Registry which also gives him Discretionary Powers while carrying on his duty. e.g. Withdrawal of application;

The Registrar is at liberty to withdraw the acceptance given by him if he had received it by mistake or if the applicant has not adhered to the amendments which he had earlier agreed to comply with and hence the Registrar can decide the matter as he deems it to be decided taking into account the necessary factors and conditions. In *Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd*⁵⁶⁴ the Supreme Court held and decided that the discretion exercised in passing the order by the Registrar was proper.

- 5) The Registrar also has Powers of Civil Court to;** The Registrar appointed under the act has powers equal to Civil court, the following powers can be exercised by the Registrar as Civil Court;

- a. Receive evidence:** orally as well as in affidavit form required to take decision on any matter.
- b. Administration of oath:** The Registrar has a power to ask any party or witness to the proceedings before the Registry to administer oath whenever required.

⁵⁶² Sec.7(2) of TMA 1999

⁵⁶³ Supra note. 3 ; Sec.7. Trade Marks Act 1999.

⁵⁶⁴ 1955AIR 558, 1955SCC (2) 252

c. Attendance of witness: The Registrar can ask to a person who is witness to the proceedings to attend as and when required.

d. Procure document: Ask for any documents under section 111 of the Act in certain cases⁵⁶⁵.

6) Review of own decisions taken by the Registrar: The Registrar has a power to review order issued by the registry by the registrar or any other authority, the registrar can review the strategies and functions.

In *Thungabhadra Industries Ltd. v. The Government of Andhra Pradesh*⁵⁶⁶ the Supreme Court observed a principle that the power to review by the registrar is correction of any apparently seen error in the records. But if any reasoning of mind has to be applied then it cannot be said as review. Review has to be understood as correction of error only and if the entire decision is wrong and changing this decision has to be appealed to higher authority.

7) Power to Withdraw or Transfer Cases: This includes the power to withdraw the case from any officer and either transfer it to another officer or the registrar may try the case on its own without any prejudices by writing Order.⁵⁶⁷ The reasons for the same has to be recorded, either Novo or from the stage it was withdrawn recorded⁵⁶⁸.

⁵⁶⁵ In *National Carbon Inc.* (AIR 1934. CAL. 725)

The Procedure of Code of Civil procedures are not applicable to the proceedings before the Registrar, though the Principles of Natural Justice underling the code must be of course observed by the Registrar.

⁵⁶⁶1985(5)SCR174at186

⁵⁶⁷**See;** *Hari Chand & Ors v. Deputy Registrar*(1984 PTC(272)DEL) It was held that transfer of cases after hearing was concluded, judgment reserved, but not communicated, for re-hearing b some other officer was without jurisdiction even when the hearing officer ad o objection and had expressed that the matter be reheard by some other hearing officer.

⁵⁶⁸**See;** *Raipur Development Authority v. Chohamal Contractors* (AIR (1990) SC (1426) (1989) (2) SCC (721)); The Supreme Court observed that ‘Recording of reasons serve a Statutory purpose, e.g. It excludes chances if Arbitrariness ad assures degree of fairness in the process of decision making.

- 8) Determine as to the class of goods or services:** The Registrar has an authority to determine in which classification does the goods or services fall in. *NICE Classification* a system which has been mentioned by WIPO to classify different Goods as well as Services by an NICE Agreement which helps in keeping uniform applying trade mark application Internationally. India too follows NICE Classification for filing Trademark Application Nationally as well as internationally. Class 1 to class to 34 comprises of goods and Class 35 to 45 comprises of services⁵⁶⁹.
- 9) Registration Certificate:** The Registrar has Power to Issue the Registration Certificate once all the procedure is followed by the Applicant and once the trademark for goods or services is obtained.
- 10) Remove/Revoke Registration:** This can be done in two ways; one by filing an application by the concerned interested person that so and so trademark is in the register in a wrong way and another is that in a *Suo motto* power vested the registrar empowers the registrar to issue the removal notice to any person owning such impugned trademark.
- 11) Ratify and change:** The Registrar has power to Ratify as well as make Changes and correct the omission or error in the application or the register.
- 12) Show Cause:** The Registrar in case if any person misrepresents falsely that a registered trademark belongs to him but in reality it is not true, then the registrar have every power to issue a Show Cause notice to such a person.

⁵⁶⁹Sec.7. of TMA 1999 : Classification of Goods and Services –

- I. The Registrar shall classify goods and services, as far as ma be, in accordance with the International Classification of Goods and Services for the purposes of registration of trademarks.
- II. Any question arising as to the class within which any goods or services falls shall be determined b the registrar whose decision shall be final.

In *Prabha Singh Jaswant Singh v. B Mohammed Yousuff*⁵⁷⁰ the Appellant was falsely representing the Trademark MAHARAJA as Registered Owner and the Appeal was heard against the order of the Assistant Registrar. IPAB (Intellectual Property appellate Board), Dismissed the Appeal.

13) Can help to initiate Police action: The Registrar can help to initiate a police action under section by issuing a certificate of opinion that this is a case of infringement⁵⁷¹.

14)Transmission of Interest to Successor: Death of Party if a person to the proceeding dies before the proceeding gets over then the Registrar on request may transmit the interest of the deceased person to his Successor in request⁵⁷².

15)Objection notice: may also be given by the Registrar if the mark is not distinct and is conflicting with the registered trademark or with a well known trademark then the Registrar may issue a notice of Objection to the concerned Applicant informing the same⁵⁷³.

16)Advice on Distinctiveness: If a person is interested in registration of a trademark can always file an application to the registrar of the trademark seeking for an advise preliminary as to the applied trademark as to its distinctiveness⁵⁷⁴.

After going through the functions and the powers of the TMR let us now examine and understand the Authority of registrar to delegate its functions and powers to the Subordinates officers and staff members;

⁵⁷⁰2006(33)PTC(2169) IPAB

⁵⁷¹Sec.103,104,115(4) TMA1999

⁵⁷²Sec.130 TMA1999.

⁵⁷³ Iyenger's, *The Trademarks Act* (4th Ed.2011, Universal Law Publishing Co. New Delhi)

⁵⁷⁴Sec.133 (1) TMA. 1999

Delegation of Authority by the Registrar

Administration of Trademark registry is very responsible and accountable job which can be handled only by professionals, selected and appointed personnel. The Registrar has all the power to delegate some or most of his functions and required powers to the officers below the Position of registrar for the smooth administration of the Registry. But it has to be bore in mind that whenever such authority and powers are delegated to these authorities it equally becomes their duties and responsibility to be accountable for performing such functions of registry and they cannot act ultra vires in another words beyond certain things or power.

- I. **Deputy/Assistant Registrars:** The Registrar also has authorized officers to a position of Assistant Registrar to perform his functions related to the Registry matter generally⁵⁷⁵.
- II. **Senior Examiners/Examiners :** are also authorized to carry on the functions in certain urgency like Hearing Session in case of Registration Application of the trademark and also various other matter too⁵⁷⁶.

Registrar is a Tribunal

This is according to section 2(1)(ze) which defines Tribunal as the Registrar or The Appellate Board⁵⁷⁷. In *The Registrar of Trade Marks and Ors v. Kumar Ranjan Sen and Ors*⁵⁷⁸ the Calcutta High Court decided and held that whenever an proceedings are conducted by a registrar of the trademark such Registrar becomes a Tribunal and his proceedings cannot be interfered by any court till a decision is pronounced by such registrar. But there can be an appeal to the order passed by such registrar.

⁵⁷⁵Sec. 3(2) Trademarks Act 1999

⁵⁷⁶ Venkateshwaran , *Trademarks & Passing Off*, (6th Ed. LexisNexis, 2015, Gurgaon, Haryana)

⁵⁷⁷ Supra note 3. P.84. Sec. 2(1) (ze)

⁵⁷⁸AIR 1966 Cal 311

Well known Trademark

The Registrars decision has been upheld by the IPAB that a well known Trademark cannot be copied even for different classification product as it is a settled Law. In *Enfield India Ltd v. Deepak Engineering Syndicate*⁵⁷⁹ Application of Deepak Engineering for Mark Bullet in class 7 for oil product was rejected by the Registrar as the opponent Enfield's 'Bullet' a well Known 'Registered Trademark' in class 12 was being infringed.

Let us now briefly go through the different positive changes which have been brought under the trademark Act in the administration and functioning of the statutory Authorities. These changes has taken place due to the passing of TMA 1999 and TM Rules 2017

Changes in the Trademarks Law in relation to Authorities

In India as per the changing business environment in the field of IPR and as per the innovation and transformation of business concepts and ideology, the Act under its Authority has brought innovation and remarkable improvement in the administration and day to day functioning of the Authorities under the trademarks Act. The Researcher has highlighted the various developments which have taken place in the trademark registration in India with the enactment of TMA 1999 and also as a result of passing new rules in 2017 on TM. Another reason for the development framing of new innovative rules is India's commitment to TRIPS, Madrid protocol and other IPR International agreements and conventions since India is signatory to all these treaties and conventions.

⁵⁷⁹ (2006)(32)PTC (397) IPAB. Chennai. Also see *National Detergents v. Nirma Chemical Works*((1992)PTC(273))

Taking into account the development of technology, fast registration and disposal of TM applications by the appropriate Authorities under the TM Law, the Government has introduced the following changes from time to time:

1. **Pendency reduced:** Trademarks pendency reduced from 14 months to less than month. Online filing has increased to 80%. The reason for this remarkable improvement is that there has been automation and up-gradation done in the administration of the Registry and IPAB.
2. **Single and simplified Register:** is now maintained by the Registry at Mumbai for smooth and simple procedure and functioning instead of maintaining Part A and Part B which is a lengthy procedure. Due to this registration process has become easy and quick⁵⁸⁰.
3. **Trademark Rules 2017:** Trademarks (Amendments) Rules notified in March 2017 is the most important step taken by the Legislature as this rules have further improved the working of the trademarks registry to give a more service oriented approach to traders, business enterprises, startups , small manufactures , international trademark proprietors and the public at large.
4. **Determination of well Known trademark:** The process has been laid down for determining a ‘Well Known trademark’. This act has defined the concept of ‘Well-known trademark’ and has also given better protection to the same⁵⁸¹. This Statute will take into consideration that if any attempt is made to register a mark by imitating a well known trademark, such registration will not be done on the basis of established refusal grounds⁵⁸².The well-known trademark owner has a right to prevent and sue any person using his well-known trademark even for other categories of goods and services belonging to any classifications.

⁵⁸⁰ Sec.9(1)(a) of TM Act 1999(Rule 2002)

⁵⁸¹Sec. 2(1)(zg)of the TM Act 1999.

⁵⁸² Sec.9, Sec.11 of the TM Act 1999; Refusal grounds.

5. **Single application:** Under the new Act of 1999, it is now allowed to register one mark for different or multiple classes just by filing a Single Application.⁵⁸³ This is truly encouraging and motivating for the proprietors who are trading in different trade of manufacturing and providing services.
6. **Concessions to start-ups:** Concession in Trademarks Applications for the Start-ups which helps and encourages the new entrant to register her or his trademark.⁵⁸⁴
7. **Video Conferencing** was included in the Hearing on request and this is a innovative thing in the development of Registry in giving a service oriented approach to the applicants of the trademarks.
8. **Rise in Disposal:** The disposal of Trademark Applications in 2017-18 jumped to over 5.5 lakh from 1.1 lakh in 2015-16⁵⁸⁵. Improvement in the examination and disposal of IPR applications and the commerce and industry ministry taking steps to strengthen the intellectual property rights regime.
9. **Rise in Registration:** of these Applications has risen up to over 3 Lakh in 2017-18 from 65000 in 2015-16. These figures tells us that in India there are scores of applicant of trademarks who want to register their trademark for goods and services which also includes foreign applicants.

⁵⁸³ Sec.18(2) of the TM Act 1999

⁵⁸⁴ 50% lower fares for filing Trade Mark Applications by Individuals/Startups/ Small Enterprises vis-à-vis Companies.

⁵⁸⁵Financial Express: At World IP day these facts and figures were mentioned b Secretary of DIPP a top Government Official, Mr. Ramesh Abhishek who also mentioned that there is a dramatic improvement in the examination and disposal of IPR Applications and the Commerce and Industry Ministry taking steps to strengthen the Intellectual Property Rights Regime <https://www.financialexpress.com> PTI April 27th 2018, 3:31 P.m.

10. Procedural Improvement and Development: Has also been highlighted by the Researcher in Trademark Administration in India under the Act such as:

- a. **On-line Search:** Provision of Online Search System as regards the Classification of goods and services in which any interested person can cross check whether the mark in which such person is interested is already owned and registered by 3rd person. The applicant should also check out the period of use of such registered trademark owner. If the period of use of such applicant is earlier then the registered trademark owner and if such applicant is truly interested in the said trademark then the applicant should carry on with the registration process as such applicant has priority being prior user of such trademark.
- b. **Automation in registration process:** Automatic Registration and Renewal of the Trademarks. Trademarks registry is at present totally computerized and is now on-line. All the details of registration process are provided by the registry's website⁵⁸⁶. Right from filing of application to registration procedure can be viewed by the applicant on-line. The registered trademark owner or the applicant can now keep a watch if any person is trying to register a similar or identical mark as that of the registered trademark proprietor or the applicant and if any person does so then such person can be opposed by filing an on-line opposition application in the registry against such impugned mark.
- c. **Electronic Journal:** Publication of the Trademark Application details in the Trademark Registry's electronic Journal on every Monday on the official website where the applicant can always view the status of the applied trademark and the applicant does not have to personally visit the Registry for the same. This saves time and cost of the applicant.

⁵⁸⁶ www.ipindia.nic.in Office of Registrar of Trade Marks.

The above changes were introduced for faster, better and transparent transaction in dealing with trademark registration in India. In this chapter the researcher has analyzed the various authorities established by the Central Government for proper administration and registration of the genuine trademarks and prevention of Infringing and fraudulent trademark in India and in lieu of this the researcher mentioned and examined the powers, functions, composition etc of the Authorities.

In the next Chapter the researcher has analyzed the functions of TM Authorities in practice in dealing with the opposition and rectification proceedings.

CHAPTER V

FUNCTIONING OF AUTHORITIES

UNDER THE TRADEMARKS ACT

IN RELATION TO OPPOSITION

AND RECTIFICATION

PROCEEDINGS

CHAPTER V
FUNCTIONING OF AUTHORITIES UNDER THE
TRADEMARKS ACT IN RELATION TO OPPOSITION AND
RECTIFICATION PROCEEDINGS

'Law of any Country has meaning and value only when it is implemented so as to meet its purpose'

5.1 INTRODUCTION:

Goa is a beautiful and tiny state with touristic attraction. Being a tourist destination we can observe floating population from India and abroad. Goa is having population of 15 lakhs and majority of people are involved in business and trade. Tourist visit Goa and do lot of business or shopping activity. Goa is also being one of the literate State in India. Trade is one of the most attractive livelihoods for the public in Goa there is a need to find out at what extend the traders and business community aware about the trademark legislation and remedies in case of infringement of their rights. For this purpose, the researcher collected data, compiled and analyzed the data in this chapter.

Implementation of the law depends on the functioning of the authorities in implementing and protecting rights of stake holders in letter and spirit. In order to implement and protect the trader's rights various authorities are established as per the Trademark Act, 1999 as amended. The most important authorities involved in registration and protection of rights of traders/proprietor of trademark are Trade Mark Registry (TMR), Controller General of Patent, Design and Trademark (CGPDT and Intellectual Property Appellate Board which deals with appeals. These three authorities are involved in registration, opposition, rectification and grant of trademark certificate.

In this chapter the researcher collected statistical data from IPR official website especially in the matters related to trademark opposition and rectification. Further he also collected empirical data from various stake holders involved in trademark related activities.

For the purpose of convenience and better understanding this chapter is divided in to two parts. Part - I deal with statistical data and Part – II deals with empirical data. First let us verify the statistical data.

5.2 Part – I

To collect statistical data, the researcher visited TMR office at Mumbai and went through the official website of intellectual property with special reference to trademark. Data collected from the department is compiled, tabulated, analyzed and shown in the form of graph wherever it is possible.

The first table indicates the data collected for last ten years that is from 2007 to 2018. The data shows the total number of IPR applications filed in various field and the disposal rate.

In this chapter the Researcher has collected latest official Information provided by the Controller General of Patent, Design and Trademarks (CGPDTM) from the trademark office. The data has been analyzed, enumerated and shown in the form of tables and graphs.

Now let us look into the statistical data collected and analyzed in the form of tables and graphs.

PART 1
STATISTICAL DATA

1. Filing of trademarks applications before the Registry:

The below table indicates number of trademarks filed, examined by the examiners, registered trademarks and disposal of trademark by the trademark registry.

Table No. 1

YEAR	FILED	EXAMINED	REGISTERED	DISPOSAL	FILING INCREASE %
2007-08	123514	63605	100857	97200	
2008-09	130172	105219	102257	40969	5.39%
2009-10	141943	25875	67490	76310	9.04%
2010-11	179317	205065	115472	132507	26.33%
2011-12	183588	116263	51735	57867	2.38%
2012-13	194216	202385	44361	69736	5.78%
2013-14	200005	203086	67876	104756	2.98%
2014-15	210501	168026	41583	83652	5.24 %
2015-16	283060	267861	65045	116167	34.46%
2016-17	278170	532230	250070	290444	- 1.72%
2017-18	272974	306259	300913	555777	- 1.86 %
TOTAL	2197460	2195874	1207659	1625385	
%	30	30	17	23	

Table No. 2

Details shown in the above table are shown in the simplified format

(2007-2018)	
FILED	2197460
EXAMINED	2195874
REGISTERED	1207659
DISPOSAL	1625385

The above table No 1 and 2 highlights the trademark trends from year 2007 to 2019 in which the total number of applications filed are 2197460, applications examined are 2195874, trademark registered are 1207659 and the total applications disposed are 1625385.

Analysis of the table No. 1 indicate that there is a 5.39% increase in filing in 2008-09 compared to the year 2007-08 as regards the filing, so also there is an 9.04% increase in the year 2009-10 compared to the year 2008-09, there is 26.33% increase in 2010-11 compared to 2009-10, there is 2.38% increase in 2011-12 as compared to 2010-11, there is an 5.78% increase in 2012-13 as compared to 2011-12, there is an 2.98% increase in the year 2013-14 as compared to 2012-13, there is an 5.24% increase in the year 2014-15 as compared to 2013-14, there is an 34.46% increase in the year 2015-16 as compared to 2014-15, there is an -1.72% decrease in the year 2016-17 as compared to 2015-16 and again there is 1.86% decrease in the year 2017-18 as compared to the year 2016-17. The details of the above tables are also depicted in the form of bar graph (Fig. No. 1)

So also the applications filed accounts for 30%, the applications examined accounts for 30%, the Registration of the trademark accounts for 17% and the

disposal of the total application accounts to 23% during that particular period of time.

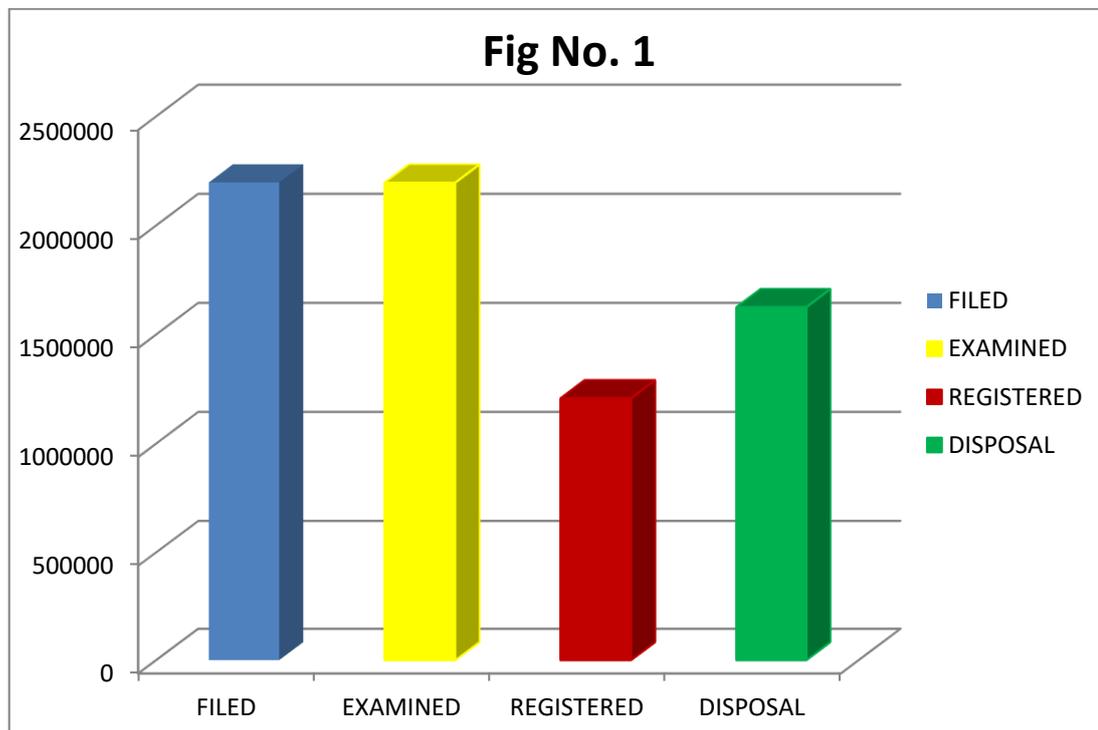


Fig No.1 shows the Trademark applications filed, examined, registered and also heard and disposed from 2007 to 2018.

The Table No.1 indicates that part (a) of **Hypothesis No.2** proposed by the Researcher is not true, as it clearly shows that the functioning of the Administrative Authority under the Trademarks legislation namely the Trademark Registry is satisfactory. The table indicates that disposal rate is 68%. Hence the hypothesis proposed is disproved.

3. Opposition and Rectification proceedings before the Registry:

Two important Authorities under the trademark act are Trade Marks Registry and IPAB, the former looks after registration of the trademark and in this process undertakes opposition hearing if any and the later is an appellate administrative body which undertakes Rectification proceedings and hears appeal against the orders of Registrar .Opposition hearing is heard by the

registrar before the trademark gets registered where else Rectification proceedings takes place after the trademark gets registered and once an rectification is filed by the aggrieved party against the registered trademark for goods or services.

The Researcher has collected the data of Opposition and Rectification proceedings as regards the filing and disposal or hearing of the same from the Annual report of Intellectual Property India official website which includes 10 years data.

Table No. 3

2007-08		
HEARING PLACE	OPPOSITION/RECTIFICATION/IP FILED	OPPOSITON/RECTIFICATION/IP HEARING
Mumbai	6013	321
Kolkata	1685	2147
Chennai	3400	1549
Delhi	4615	2201
Ahmedabad	1763	481
TOTAL	17476	6699
%		38%

In the above table No. 3 of 2007-08, it shows that in Mumbai the filing is highest and in Kolkata it is the lowest whereas the hearing is highest in Delhi and lowest in Mumbai.

Table No. 4

2008-09		
HEARINGPLACE	OPPOSITION/RECTIFICATION FILED	OPPOSITON/RECTIFICATION/ IP HEARING
Mumbai	5988	1294
Kolkata	1654	5288
Chennai	5213	774
Delhi	6527	1168
Ahmedabad	2024	651
TOTAL	21406	9175
%		42%

In the above table No. 4 of (2008-09) year it shows that in Delhi the filing is highest and Kolkata it is the lowest, whereas the hearing is highest in Kolkata and lowest in Ahmedabad

Table No. 5

2009-10		
HEARING PLACE	OPPOSITION /RECTIFICATION FILED	OPPOSITON/RECTIFICATION/ IP HEARING
Mumbai	7208	1162
Kolkata	814	4754
Chennai	1989	697
Delhi	4179	1052
Ahmedabad	1842	586
TOTAL	16032	8251
%		51.46%

In the above table No. 5 of (2009-10) year it shows that in Mumbai the filing is highest and in Kolkata it is the lowest whereas the hearing is highest in Kolkata and lowest in Ahmedabad.

Table No. 6

2010-11		
HEARING PLACE	OPPOSITION /RECTIFICATION FILED	OPPOSITON/RECTIFICATION/ IP HEARING
Mumbai	6265	679
Kolkata	1002	355
Chennai	3069	383
Delhi	9459	151
Ahmedabad	2244	205
TOTAL	22039	1773
%		8.04

In the above of Table No.6 of (2010-11) year it shows that in Delhi the filing is the highest and in Kolkata it is the lowest whereas the hearing is highest in Mumbai and lowest in Delhi.

Table No. 7

2011-12		
Place of Hearing	Opposition/Rectification IP Filed	Opposition/Rectification IP Hearing
Mumbai	1939	864
Kolkata	649	922
Chennai	1284	223
Delhi	4232	385
Ahmedabad	1618	289
TOTAL	9722	2683
%		27.59%

In the above table No.7 of (2011-12) year it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is the highest in Kolkata and is the lowest in Chennai.

Table No. 8

2012-13		
TRADEMARK REGISTRY	OPPOSITION/RECTIFICATION FILED	OPPOSITION/RECTIFICATION HEARING
Mumbai	3240	1716
Kolkata	996	1136
Chennai	2633	1520
Delhi	4414	2278
Ahmedabad	1818	1187
TOTAL	13101	7837
%		59.81%

In the above table No. 8 of (2012-13) it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is highest in Delhi and is lowest in Kolkata

Table No. 9

2013-14		
PLACE OF HEARING	OPPOSITION/RECTIFICATION FILED	OPPOSITION/RECTIFICATION HEARING
Mumbai	3664	5713
Kolkata	1094	317
Chennai	2109	3179
Delhi	4832	1308
Ahmedabad	2841	1574
TOTAL	14540	12091
%		83.15%

In the above table No.9 of (2013-14) it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is highest in Mumbai and is lowest in Kolkata .

Table No. 10

2014-15		
PLACE OF HEARING	OPPOSITION/RECTIFICATION FILED	OPPOSITION/RECTIFICATION HEARING
Mumbai	3664	5713
Kolkata	1094	317
Chennai	2109	3179
Delhi	4832	1308
Ahmedabad	2841	1574
TOTAL	14540	12091
%		83.15%

In the above table No. 10 of (2014-15) it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is highest in Mumbai and is lowest in Kolkata.

Table No. 11

2015-16		
PLACE OF HEARING	OPPOSITION/RECTIFICATION FILED	OPPOSITION/RECTIFICATION HEARING
Mumbai	4019	7643
Kolkata	1523	3099
Chennai	1979	1780
Delhi	7828	23903
Ahmedabad	3561	2421
TOTAL	18910	38846
%		205%

In the above table No. 11 of (2015-16) it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is highest in Delhi and is lowest in Chennai.

Table No. 12

2016-17		
PLACE OF HEARING	OPPOSITION/RECTIFICATION FILED	OPPOSITION/RECTIFICATION HEARING
Mumbai	6726	7649
Kolkata	1695	4002
Chennai	5498	1776
Delhi	16885	7914
Ahmedabad	3078	2561
TOTAL	33882	23902
%		70%

In the above table No.12 of (2016-17) it shows that in Delhi the filing is highest and in Kolkata it is the lowest, whereas the hearing is highest in Delhi and is lowest in Chennai.

Table No. 13
10 Years Trademarks Opposition /Rectification / Interlocutory
Applications Filed and Disposed

(2007-2017)			
YEAR	IP/OPP/RECTIFICATION FILED	IP/OPP/RECTIFICATION	
		HEARING	PERCENTAGE %
2007-08	17476	6699	38%
2008-09	21406	9175	42%
2009-10	16032	8251	51.46%
2010-11	22039	1773	8.04%
2011-12	9722	2683	27.59%
2012-13	13101	7837	59.81%
2013-14	14540	12091	83.15%
2014-15	14540	12091	83.15%
2015-16	18910	38846	205%
2016-17	33882	23902	70%
TOTAL	181648	123,348	67.90%

Note: IP means Interlocutory Applications filed during their specific years

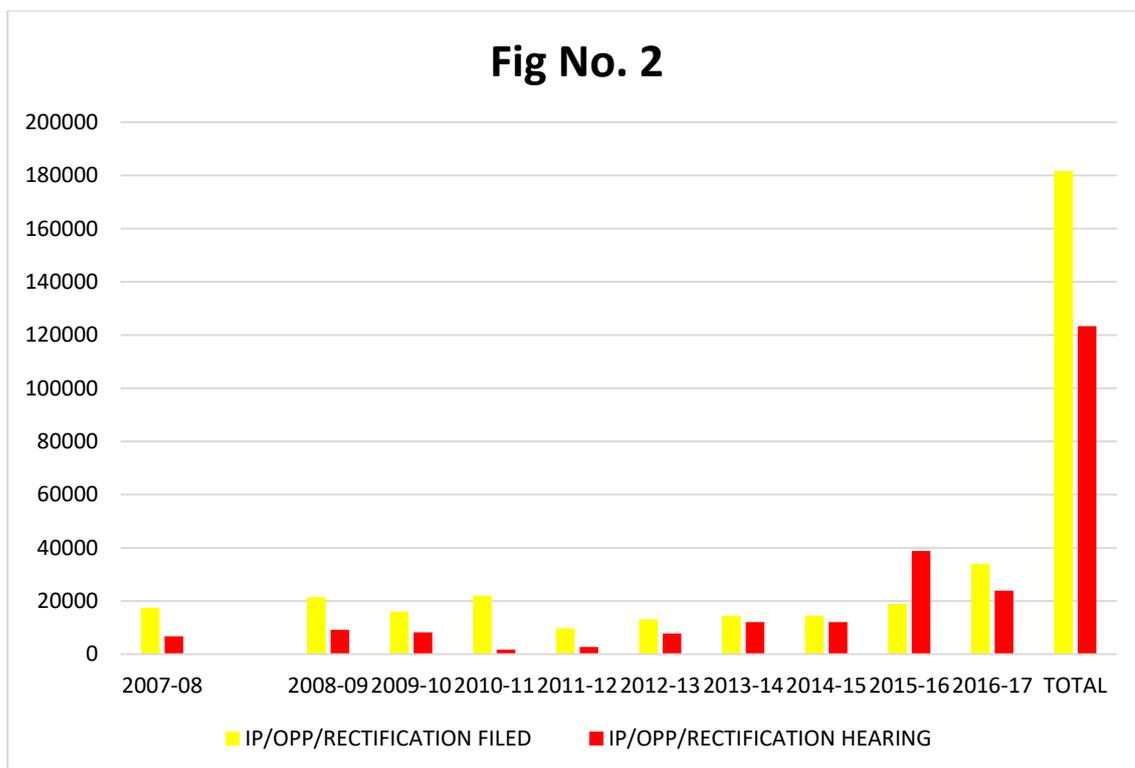
The above table No. 13 shows us the Number of Opposition /Rectification/IP applications filed and heard/disposed during the period (2007 to 2017) year with the percentage of their respective years. In the year 2007-08 the applications filed were 17,476 and the applications heard were 6,699 which is coming to 38%. The year 2008-09 shows 21,406 filed and 9,175 applications heard which is 42%. The year 2009-10 shows 16,032 applications filed and 8,251 applications heard which comes to 51.46%.

The year 2010-11 shows 22,039 applications filed and 1773 applications disposed which is 8.04%. The year 2011-12 shows 9,722 applications filed and 2,683 applications heard which 27.59% is. The year 2012-13 shows 13101 applications filed and 7,837 applications heard which 59.89% is. The year 2013-14 shows 14,540 applications filed and 12,091 hearing of application which comes to 83.15%. In the year 2014-15, 14540 applications were filed and 12091 applications were disposed which is approximately 83%. The year 2015-16 the filing of applications was 18,910 and disposal of applications were 38,846 which is 205% and this was due to the disposal of backlog application. In the year 2016-17 the applications filed were 33,882 and the applications heard were 23,902 which are 67.90%.

If we analyze we come to a understanding that the total applications filed during this 10 years are 1,81,648 and during these years 1,23,348 applications were heard and disposed which is approximately 70% which is a good disposal.

HypothesisNo.3 which says that the functioning of Authorities namely Registry and the IPAB is not satisfactory is being proved wrong here because table No. 13 clearly shows that in those 10 years of time there is almost 70% of matter disposed by the same authorities which is reasonably good.

The first part of the **Hypothesis No 5** which says that the rights of trademark owner are not fully protected under the act as there is a delay in giving them justice by the Administrative Authorities under the trademarks legislations also being **proved wrong** as per the indication shown by table 13.



(Bar graph representing IP/Opposition/Rectification filed and heard for 10 years.)

Explanation about Places

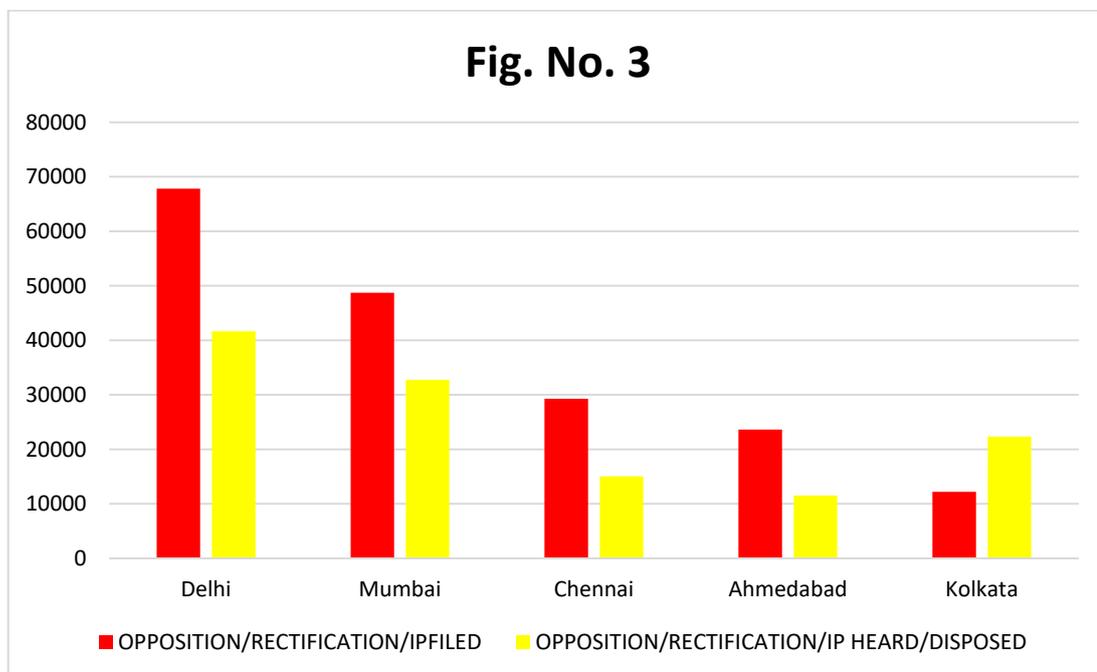
The below Table no.14 contains the details of different places of Trademark Registry and IPAB branches in which the opposition and Rectification proceedings took place and the table highlights the Opposition/rectifications filed as well as disposed off from 2007 to 2018.

The below table provide full picture of all the places like Delhi, Mumbai, Chennai, Ahmedabad and Kolkata from where the data is compiled, gathered and analyzed in single table in relation to trademark opposition filed, disposed and its percentage.

Table No. 14

PLACE WISE APPLICATIONS FILED FROM THE YEAR 2007 to 2018

PLACE	OPPOSITION/RECTIFICATION/IPFILED	OPPOSITION/RECTIFICATION/IP HEARD/DISPOSED	DISPOSED PERCENTAGE
Delhi	67803	41668	61.45 %
Mumbai	48726	32754	67.22 %
Chennai	29283	15060	51.42 %
Ahmedabad	23630	11529	48.78 %
Kolkata	12206	22337	183 %
Total	181648	123348	68 %



The above table No.14 and fig No.3 shows place wise filing of opposition/Rectifications/IP applications as well as the hearing and disposals of the same. At Delhi the filing is 67,803 and hearing is 41,668 which is almost 61.45%, at Mumbai the filing is 48,726 and hearing is 32,754 which comes to 67.22%, at Chennai the filing is 29,283 and the hearing is 15,060 which is 51.42%, at Ahmedabad the filing is 23,630 and hearing is 11,529 which comes to 48.78%, at Kolkata the filing of applications comes to 12,206 and applications heard and disposed comes to 22,337 which is 183%, here the number is high due to the disposal of the backlog pending applications by the Trademark Registry and the IPAB.

IPR includes various subject matters like Patent, Trademark, Designs, Copyright etc. the below table indicates the most important field in which applications are filed and disposal rate.

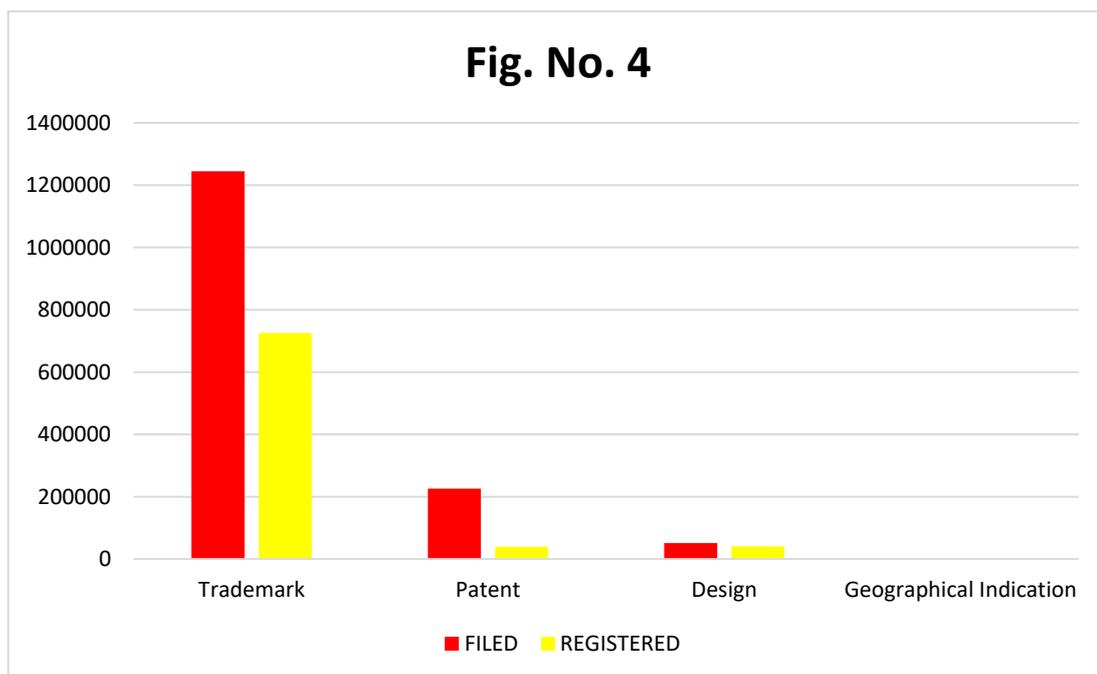
Table No. 15

**05 Years Comparative Study of Different Intellectual Properties
Performance in India (2013-14to 2017-18)**

Area of IPR	FILED	REGISTERED	Regd %
Trademark	12,44,710	7,25,487	58.28
Patent	2,25,916	39,413	17.44
Design	51,054	40,525	79.37
Geographical Indication	206	127	61.65
Total	15,21,886	805551	52.93%

The Table No. 15 and fig No.4 gives details of different Intellectual Properties namely Trademark , Patent , Design , Geographical Indication with reference to their filing and their registration in India in which the Trademarks Application

filing which is 12,44,710 and Registration is 7,25,487 which is 58.28% and is the highest followed by Patent filing which comes to 2,25,916 and Registration which is 39,413 which is 17.44% and then comes Design of whose the filing is 51,054 which is and registration is 40,525 which is 79.37% and lastly GI (Geographical indication) whose filing is 206 and registration is 127 which is 61.65%



PART 2
ANALYSIS OF EMPERICAL DATA

To cross verify the statistical data Researcher also collected data from relevant stake holders in the field of trademark by Random sampling through Questionnaires structured, Interview structured as well as unstructured and Observation.

Table No. 16

Sl. No	Stakeholder	Total
1.	Traders	985
2.	Students	207
3.	Advocates	192
4.	Officials of TMR	10
5.	Judges	04
6.	Police	14
7.	Other Professionals	43
8.	General Public	45
	Total	1500

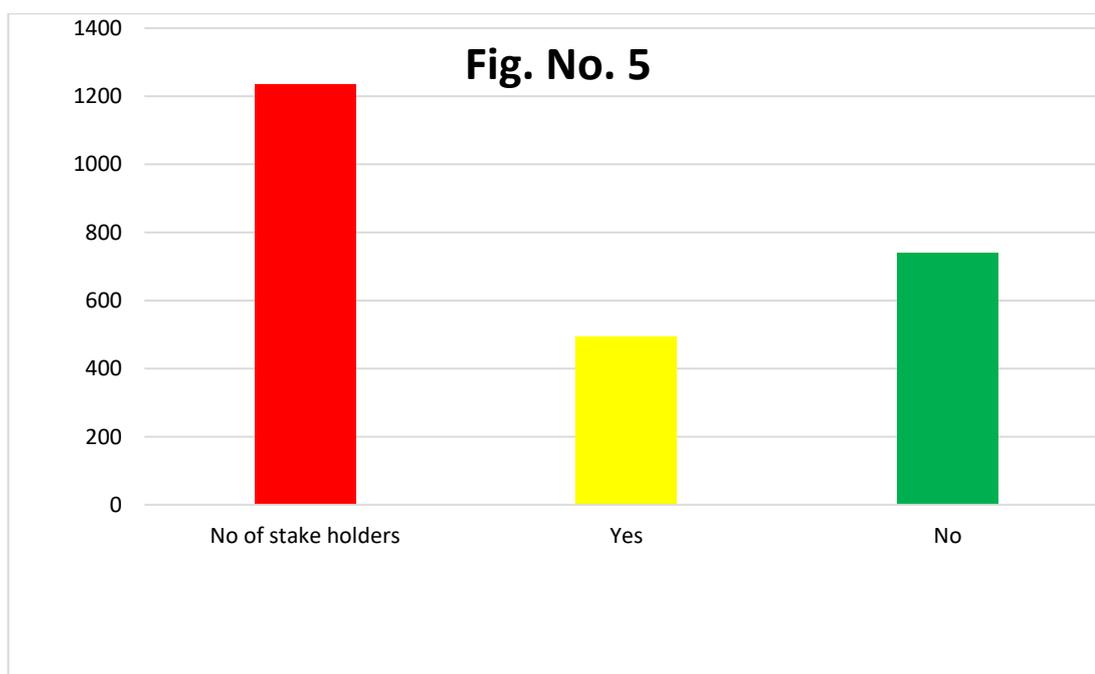
1. Awareness of Trademark Registration:

The Researcher collected the data from stake holders like traders, students, and professionals and compiled, analyzed and shown in the following table.

Table No. 17

No of stake holders	Yes	No
1235	494	741
Percentage	40%	60%

Above table No. 17 and fig 5 clearly shows that out of 1235 stakeholders 494 are aware which is 40% and remaining 741 are not aware which is 60%⁵⁸⁷.



Hypothesis No 1 proposed by the researcher; Data shown in fig. no 5 proves that the hypothesis No 1 is true which says that there is lack of awareness as

⁵⁸⁷ As regards the awareness of registration of trademark, as shown in Table 17 and fig No. 5 many of the people interviewed are absolutely unaware, as they many a time get confuse and think that trademark and copyright is one and the same. This gives us a understanding that people has to be informed through some ways as regards the Registration of Trademark for goods and services.

regards the trademark law in India as we understand that 605 of the people interviewed are unaware of registration of trademark for goods and services.

2. Awareness of Infringement and Passing off of Trademark

To find out how many Proprietors/Owners and Public are aware about Infringement and passing Off of the trademark the Researcher collected the data from stake holders like traders, students, and professionals. Collected data is compiled and analyzed and shown in the following table.

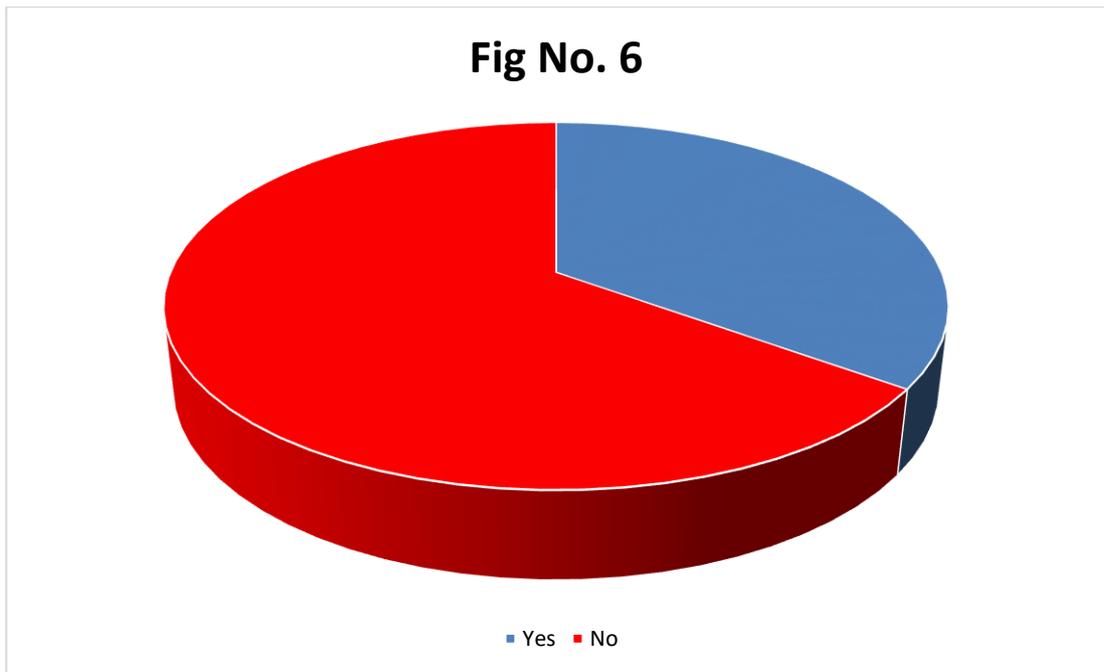
Table No. 18

No of stake holders	Yes	No
1235	432	803
%	35%	65%

Explanation

Table No.18 and fig 6 clearly shows that out of 1235 stakeholders 432 are aware which is 35% and remaining 803 are not aware which is 65%⁵⁸⁸.

⁵⁸⁸ Table No.18 and fig.6 makes us understand that the percentage of unawareness as regards the infringement and passing off wrong is quite alarming which means that many people in the business community don't even know that their proprietary right in the trademark is being violated and infringed. Something should be done so that awareness is spread at the grass root level as regards trademark law.



The **Hypothesis No 1** proposed by the researcher is **proved** right as per the indication showed in the (Fig. No 6). This proves that there is lack of awareness amongst the stake holder and the public as regards the trademark and its law.

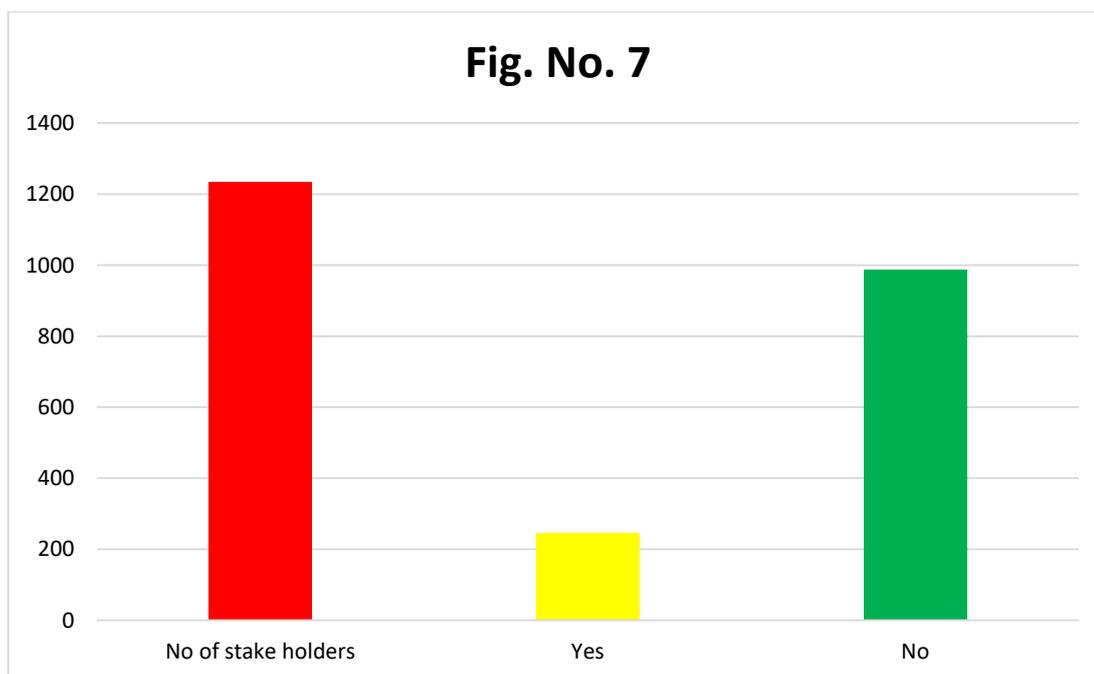
3. Awareness of online Registration of Trademark facility:

The Researcher collected the data form traders, students, and professionals and the collected data is compiled, analyzed and shown in the following table.

Table No. 19

No of stake holders	Yes	No
1235	247	988
Percentage	20%	80%

Table No.19 and fig. 7 clearly shows that out of 1235 stakeholders 247 are aware which is 20% and remaining 988 are not aware which is 80%⁵⁸⁹.



⁵⁸⁹ Table 19 fig 7 makes us understand that almost 805 of the people interviewed are unaware of the facility of online provided by the registry and this awareness is amongst the IPR lawyers and few professional and big business houses only and not amongst the masses. It is truly need of the hour to think as to how this awareness can be spread amongst the people in general.

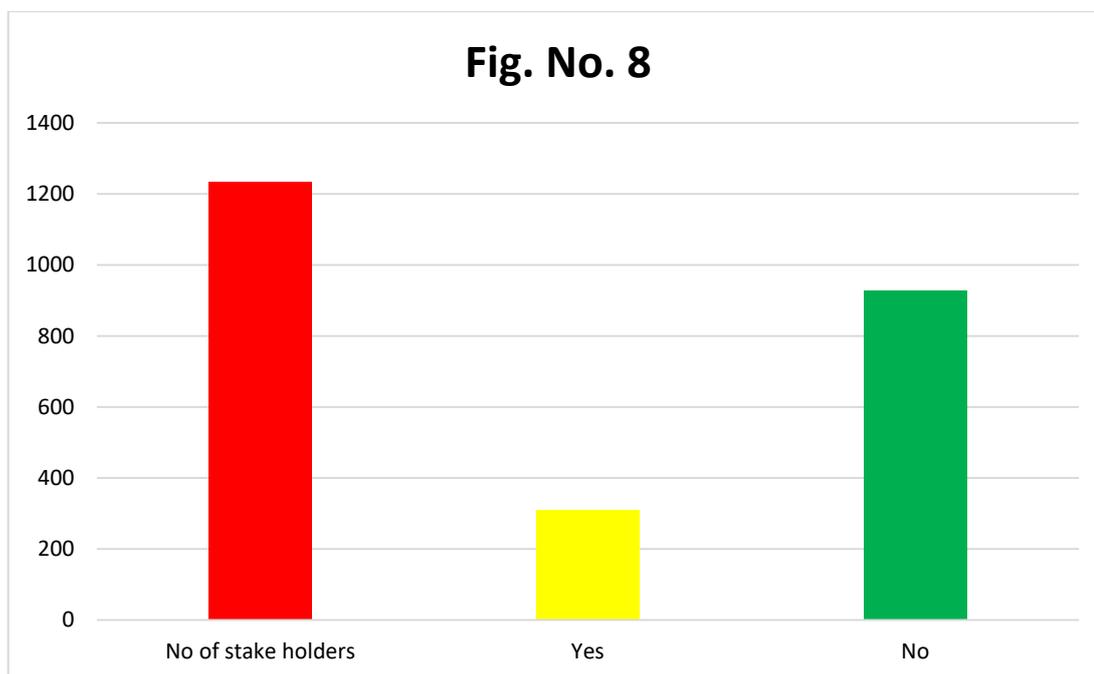
4. Knowledge of Infringement and Passing off Remedy:

The Researcher collected the data form stake holders like traders, students, and professionals and compiled, analyzed and shown in the following table.

Table No. 20

No of stake holders	Yes	No
1235	309	927
Percentage	25%	75%

The above table clearly shows that out of 1235 stakeholders 309 have knowledge which is 25% and remaining 927 does not have knowledge which is 60%⁵⁹⁰.



⁵⁹⁰ Table 20 fig 8 tells us that there is a very high level of ignorance amongst the people as to the remedial measures in case of infringement and passing off wrong and there is need to educate people as regards the same as most of the interviewed people are silent on same.

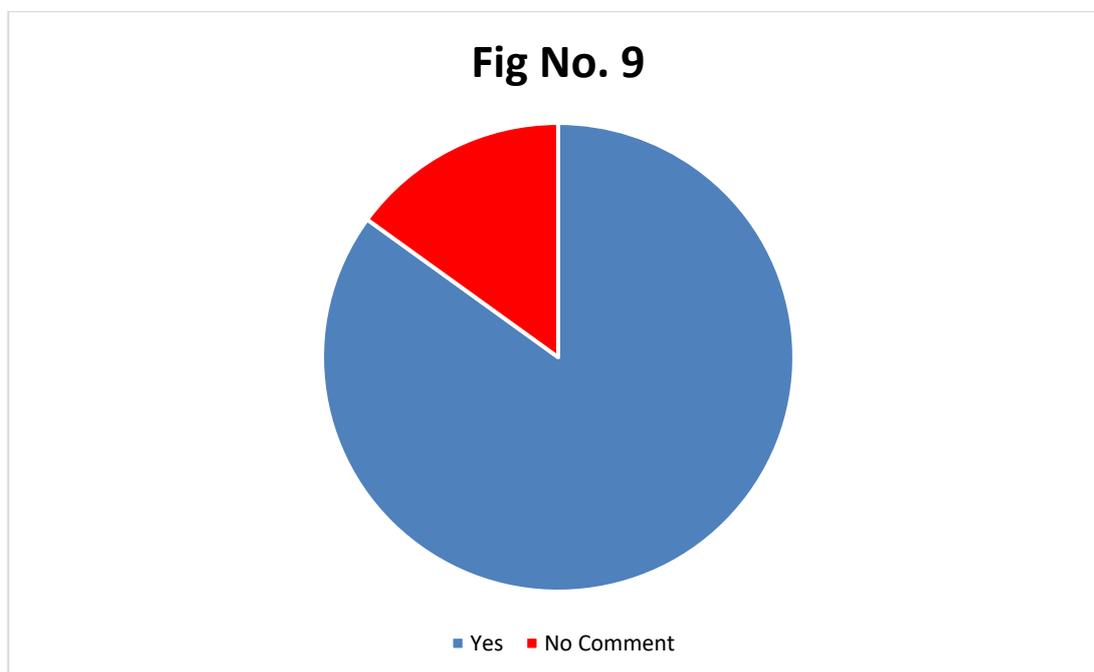
5. Trademark helps in providing quality to product and services

This information was collected from Traders, Public, other Professionals and Lawyers.

Table No. 21

No of stake holders	Yes	No Comment
1220	1037	183
Percentage	85%	15%

Table above clearly indicates that out of 1220 stakeholders 1037 agree which are 85% and remaining are not commenting which are 15%. Majority of the people agree that trademark provides quality for products⁵⁹¹.



⁵⁹¹ Table 21 and fig 10 gives us a very positive finding where in it shows that majority of people interviewed are aware that trademark does help us in providing quality product which also gives us inference that people are aware of the trademark concept .On oral interview and market survey by personal observation the researcher has found out that people are aware of the trademark concept mostly through advertisement, publicity and direct buying.

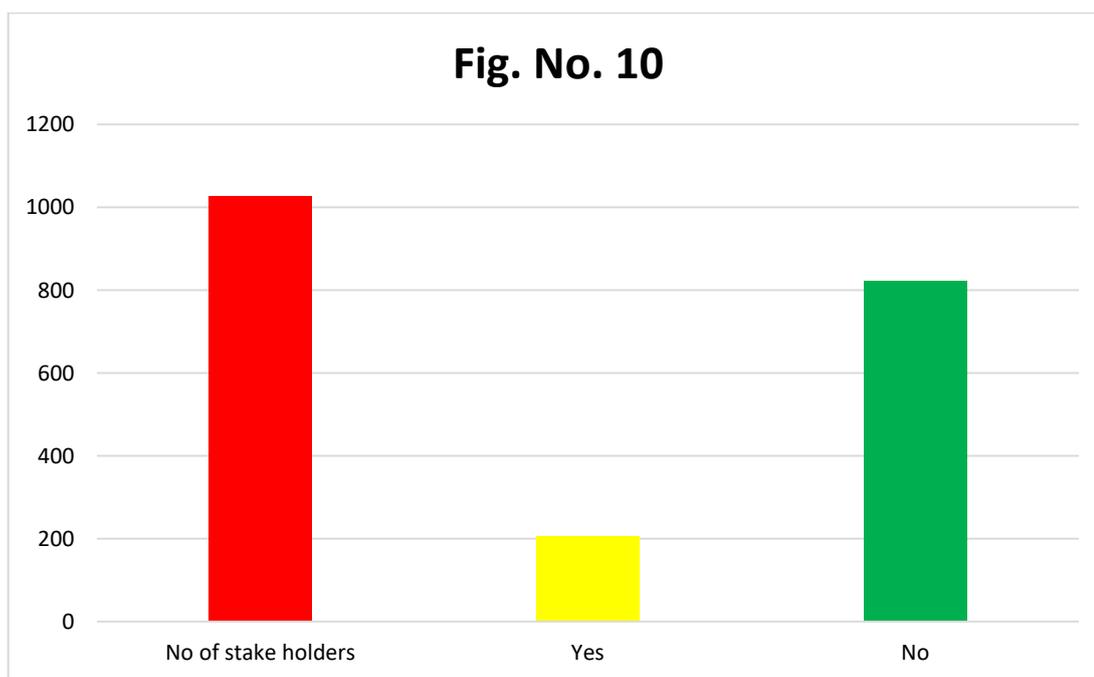
6. Awareness about criminal remedies for infringement

This data was collected from Traders/owners and Other Professionals.

Table No. 22

No of stake holders	Yes	No
1028	205	823
Percentage	20%	80%

Table No.22 clearly shows that out of 1028 stakeholders 205.6 are aware which is 20% and remaining 822 are not aware which is 80%⁵⁹².



⁵⁹² Table 22 ,Fig 9 makes us understand that there exist a very poor awareness as regards the Criminal remedial measures amongst the people interviewed by the researcher and based on market survey done by oral interview. The people who knows about such remedy are either lawyers or professionals and big business enterprises and not the common business person.

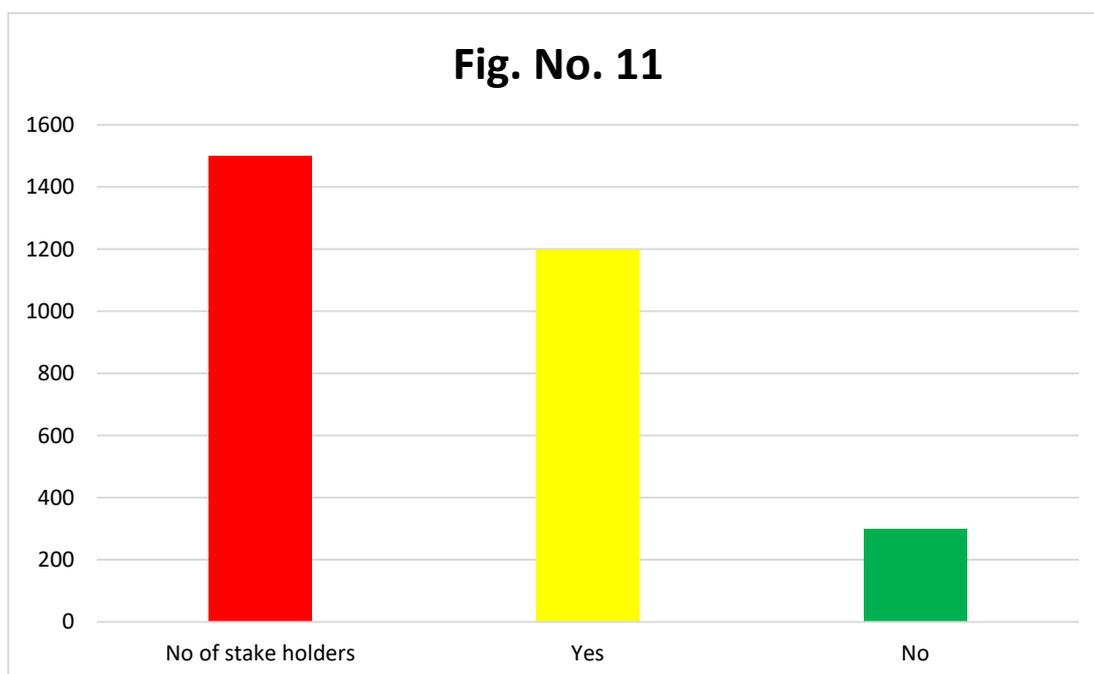
7. Need for creating more awareness in the society regarding trademark law

This data was collected from Traders/ owners, Students, Other Professionals, Advocates, Judges, Police and Trademark Authorities.

Table No. 23

No of stake holders	Yes	No
1500	1200	300
Percentage	80%	20%

Table No. 23 clearly shows that out of 1500 stakeholders 1200 agree which is 80% and remaining 300 are does not agree which is 20%⁵⁹³.



⁵⁹³ Table 23 and fig 11 tells us that there is huge want of awareness amongst the people which is required to be created by Government. Trademark authorities along with other support of Companies, universities, schools etc.

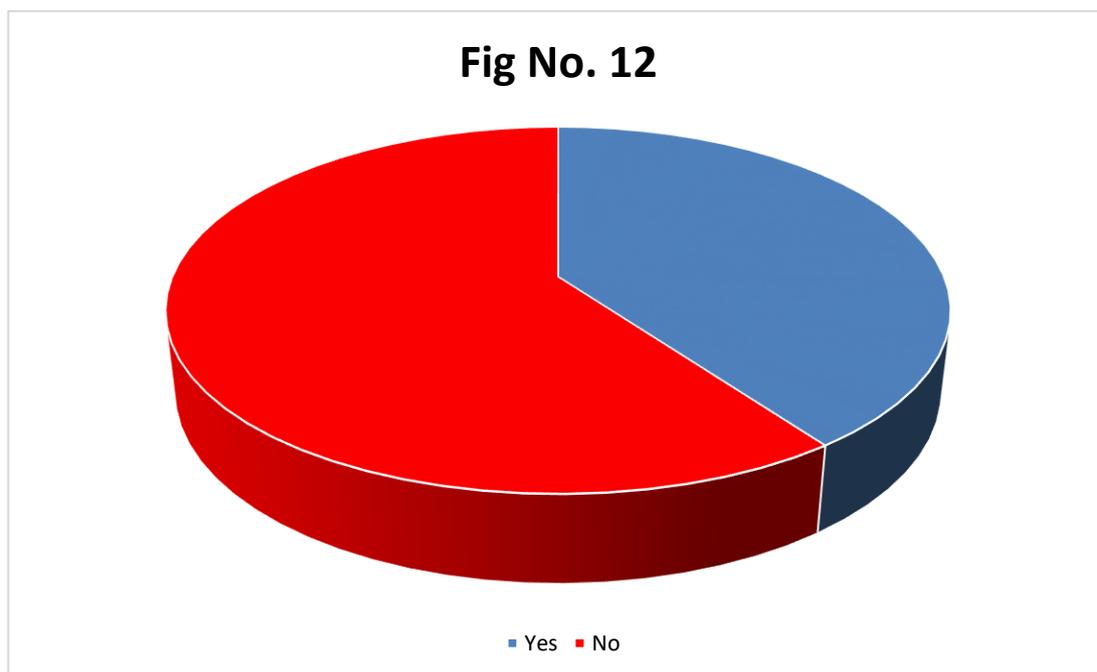
8. IPAB's jurisdiction vis a vis Infringement

For the purpose of IPAB and its role in the matters of trademark data was collected from Advocates, Judges and Trademark Authorities. The same was shown in the below table

Table No. 24

No of stake holders	Yes	No
206	82	124
Percentage	40%	60%

The above table clearly shows that out of 206 stakeholders 82.4 agree which is 40% and remaining 123.6 does not agree which is 60%⁵⁹⁴.



⁵⁹⁴ Table 24 and Fig 12 makes us understand that the IPAB should not be allowed to try Infringement suit, on of the reason could be that due to the shortage of staff in IPAB it is not able to perform its own Core duty of administering Rectification proceedings and appeal arising from the order of Registrar of Trademarks. And if the responsibility of Courts is given to IPAB then there will be a big Chaos and backlog of infringement cases in IPAB.

9. Trademarks Act should include provisions for passing off

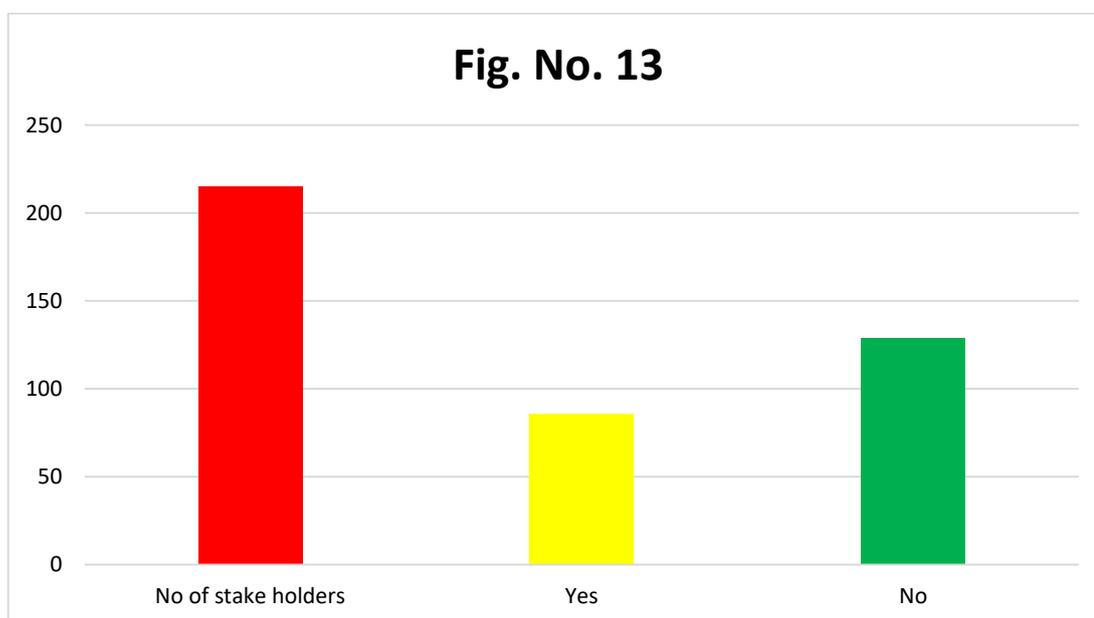
To verify the idea of passing off to be included under the trademark law data was collected from Advocates, Judges and Trademark Authorities.

Table No. 25

No of stake holders	Yes	No
206	83	124
Percentage	40%	60%

The above table clearly depicts that out of 206 stakeholders 82.4 agree which is 40% and remaining 123.6 does not agree which is 60%⁵⁹⁵. This highlights that 60% of the stake holders believes that there is no need to add passing off under trademark legislation.

This indicates the **Hypothesis No. 4** proposed by the researcher **partly disproved**. Because the ratio is 40:60.



⁵⁹⁵ Table 25 and Fig 13: One of the reason for not agreeing to include passing off in trademark Act may be because the professional must be thinking that once passing off is made a part of statutory action then the legislature might restrict passing off action under the statute only for goods and services falling under same classification and not other classification of goods and services. And second reason is that if statutory action fails then the common law remedy may succeed hence there is always a cushion effect when passing off action is initiated through common law.

10. Trademark legislation has achieved its Objective

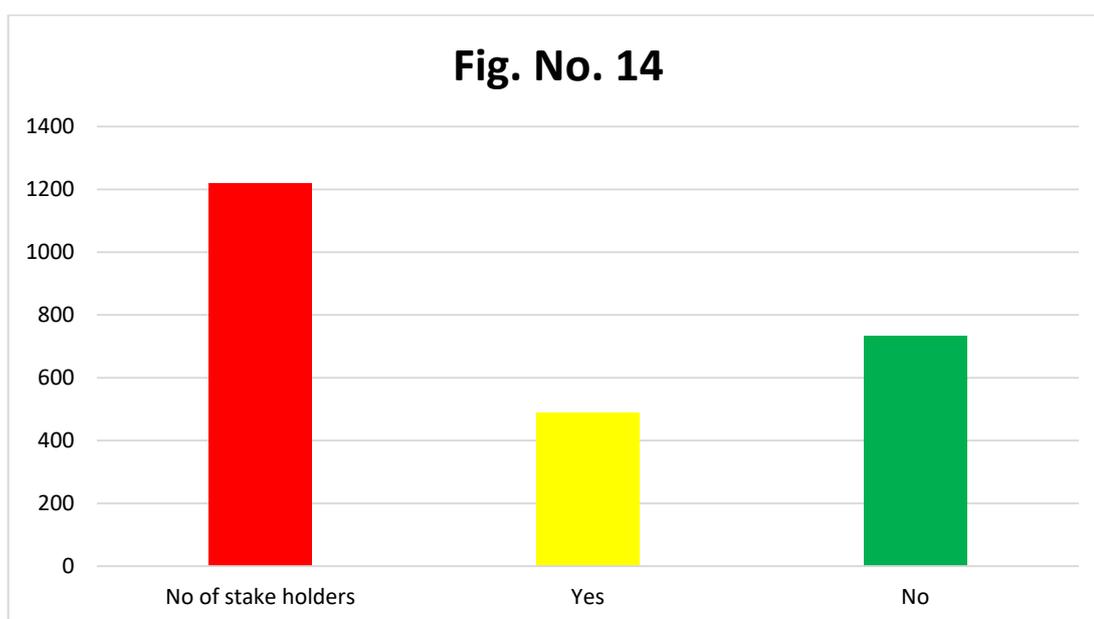
The importance of any legislation depends on the satisfaction of stake holders. In order to find out the achievement of trademark legislation objectives the researcher collected data from the Traders, lawyers, other professionals.

Table No. 26

No of stake holders	Yes	No
1220	488	732
Percentage	40%	60%

Table No. 26 clearly shows that out of 1220 stakeholders 488 agree which is 40% and remaining 732 does not agree which is 60%⁵⁹⁶.

As per these findings the **Hypothesis No 2 (a)** which says that the Act has failed to achieve its objective to give utmost protection proves to be true because almost 60% of the stakeholders do not agree that the Act has achieved its objective fully. This hypothesis is **proved**.



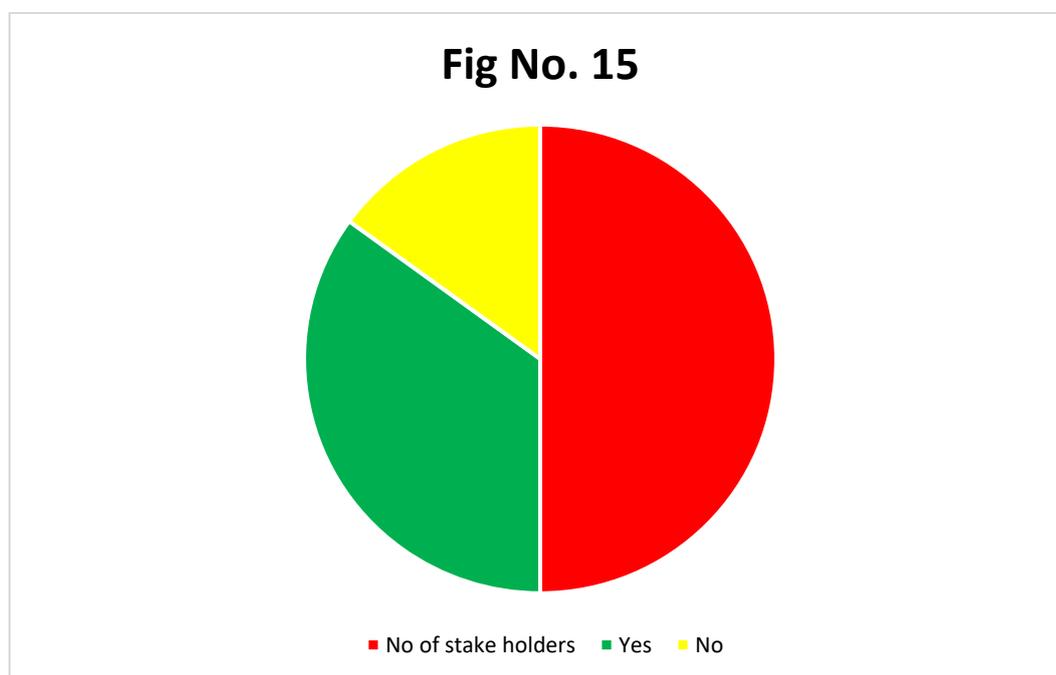
⁵⁹⁶ Table 26 and Fig 14 tells us that the opinion of different people interviewed is that due to many reasons the Act has not achieved its object in total. It could be due to delay by the authorities and courts in providing satisfactory justice in time.

11. Satisfaction of the stake holder in relation to Infringement and Passing off action

In order to find the rate of satisfaction of traders in availing justice from the appropriate authorities under the trademark legislation the following data was collected by the researcher from the traders, lawyers, and other professionals. Questioner were given to 1220 stake holders but as some could not follow the question only 200 Lawyers and 250 traders and other professionals answered this question.

Table No. 27

No of stake holders	Yes	No
450	315	135
Percentage	70 %	30%



Hypothesis 2(b) is proved to be wrong that Infringement and Passing-off action under the Trademarks Legislation has not been totally satisfactory and successful in achieving its goal that is providing justice. The above table No.27

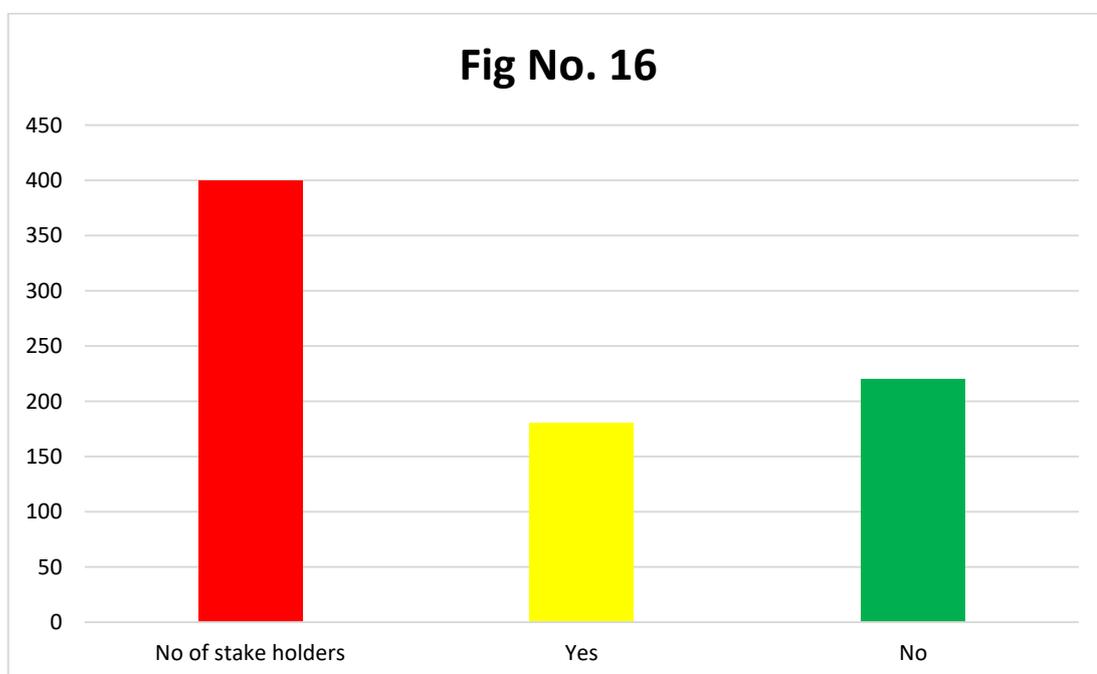
and Fig 15 clearly shows that out of 450 stakeholders 315 agree which is 70 % and remaining 135 does not agree which is 30 %⁵⁹⁷. This indicates that majority of the stake holders are satisfied by the Infringement and Passing off action in India.

12. There is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India.

This Questionnaire was circulated with 1200 stake holders but was answered by 200 lawyers and 200 traders and professional from other fields as some of them did not understand the question.

Table No.28

No of stake holders	Yes	No
400	180	220
Percentage	45%	55%



⁵⁹⁷ Table and Fig makes us understand that these action are not meeting the expectation of these interested person in terms of remedial justice and to an extent they are facing hardship due to time and cost involved in the litigation process where in it takes years for the court to decide such cases and till then the infringer continues to infringe genuine trademark.

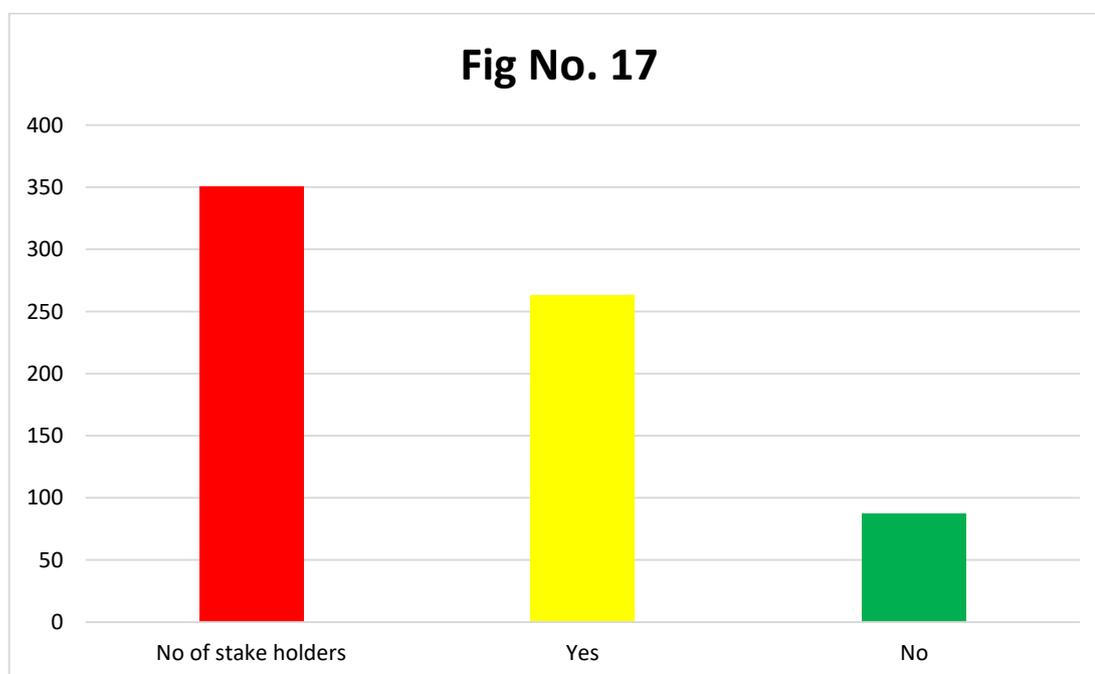
Hypothesis 2(c) is proved to be wrong that there is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India. As the above table No.28 and Fig 16 clearly shows that out of 400 stakeholders 180 agree which is 45 % and remaining 220 does not agree which is 55%.

13) Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation.

200 Lawyers and 150 traders and other professionals answered this question.

Table No. 29

No of stake holders	Yes	No
350	263	87
Percentage	75%	25%



The above Table No.29 and fig 17 clearly shows that 25% disagree i.e. 87 and 75% agree i.e. 263.

Hypothesis 4(a) is proved to be right that Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation as 75% of the stake holder agreed where else only 25% disagreed.

14. IPAB vis-a-vis ex-parte orders

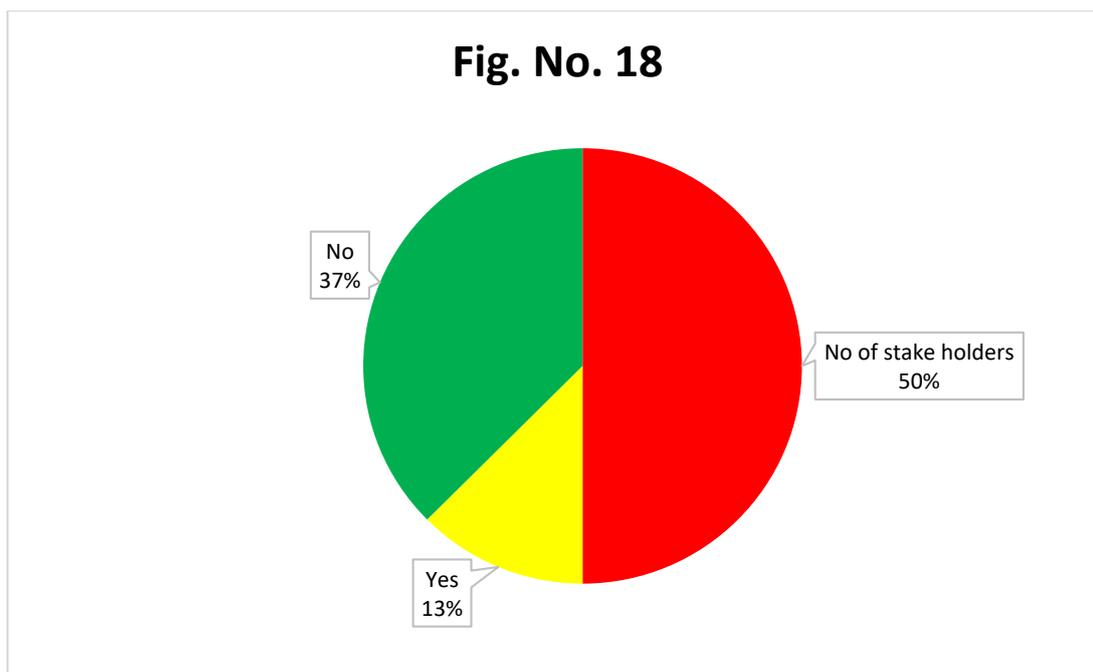
In order to find out the achievement of trademark legislation objectives the researcher collected data from the Traders, lawyers, other professionals. Out of 1220 stakeholders many of the stake holders could not answer this quarry as a result the number of stakeholders is reduced to 750. They are not able to understand the question and left to provide answer.

Table No. 30

No of stake holders	Yes	No
750	188	562
Percentage	25%	75%

In above Table 28 and Fig no. 16 it is evident that only 25% of the stake holder agrees and remaining 75% does not agree that IPAB should be given power to pass Ex-parte orders⁵⁹⁸.

⁵⁹⁸ Table 28 and Fig 16 clearly tells us that majority stake holder wants a fair hearing and does not want IPAB to pass an Ex-parte order as they believe that injustice can be caused to them if the appellant misrepresents the facts of the case and convince IPAB to pass an order.



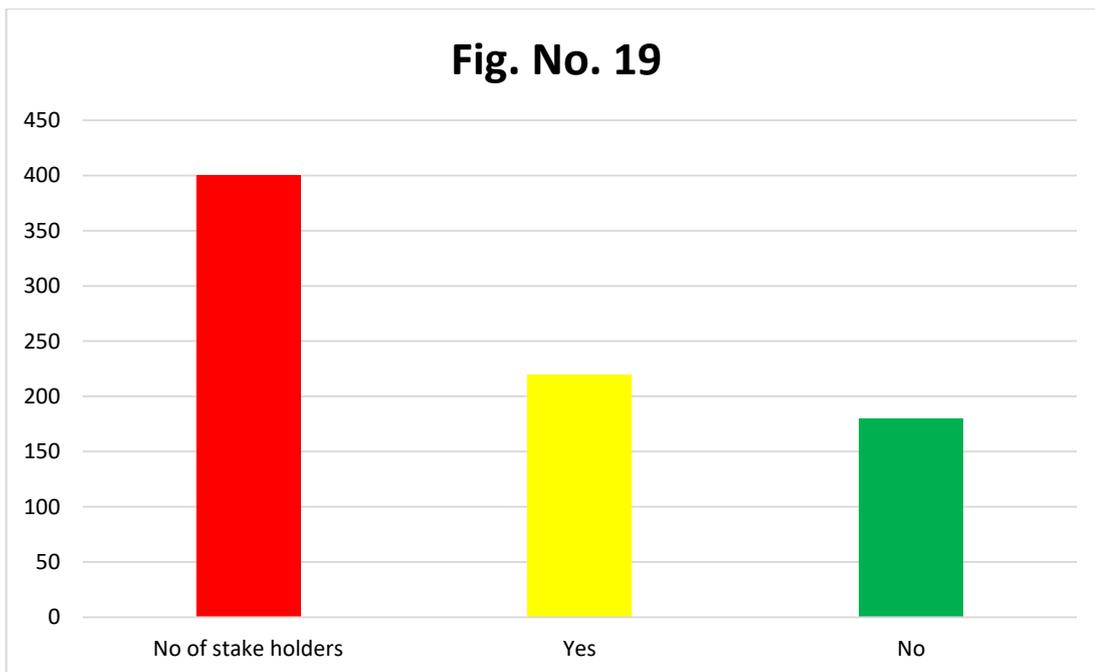
15. Trademark act 1999 is more effective and successful than all the previous Acts passed in India.

In order to find out the answer for the same the researcher collected data from the Traders, lawyers, other professionals. Out of 1220 only 400 attempted and answered this question as others could not answer the same, lawyers were 200 in number and remaining 200 were traders and professionals.

Table No. 31

No of stake holders	Yes	No
400	220	180
Percentage	55%	45%

It is clearly seen that out of 400 hundred persons 55% agrees and remaining 45% are not agreeing.

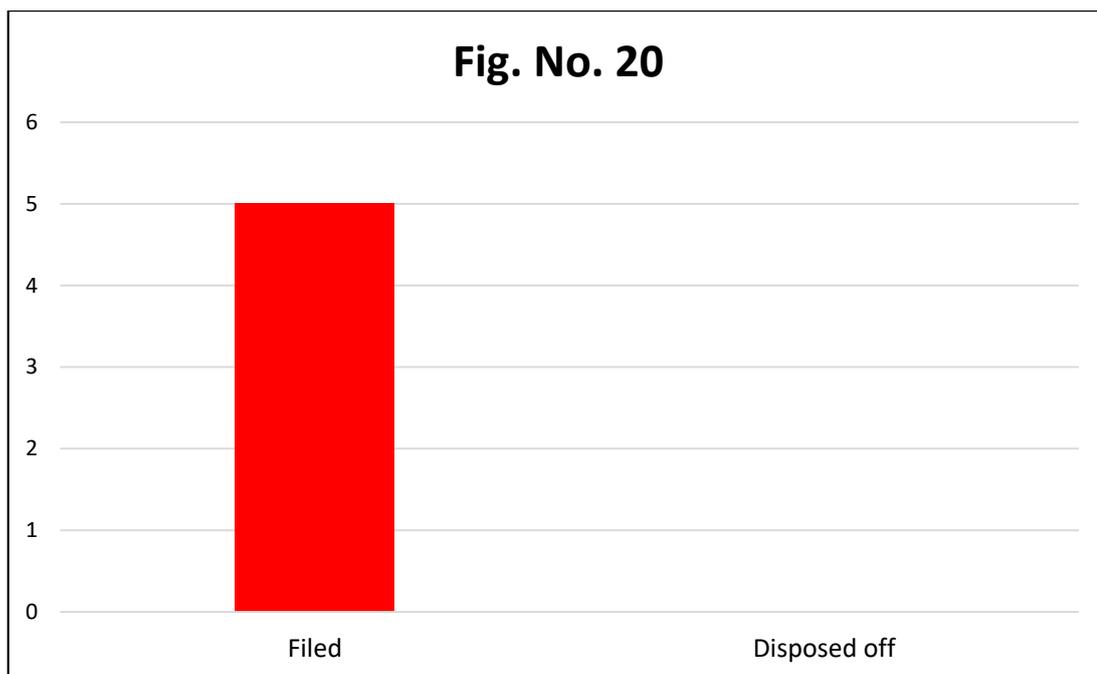


16. Infringement cases filed in Goa State from 1-1-2009 to 30-03-2019 in the District Court of Goa

Beside the empirical data the researcher also collected data through Right to Information to verify number of infringement cases filed and disposed in the State of Goa. The below table indicates the infringement cases filed in Goa State from (1-1-2009 to 20-3-2019) in the District Court of Goa.

Table No.32
(1-1-2009 to 20-3-2019)

Particulars	Number of Cases
Filed	5
Disposed off	Nil



The above Table 32 and fig 20 clearly shows that the filing of the cases relating to trademark infringement is very less in Goa's district Court i.e. only 05 in number where as the disposal is absolutely nothing i.e. Nil. The researcher believes that the reasons could be the following:

- a. The infringement and passing off of the trademarks in Goa is negligent in number.
- b. Proprietors are not taking any action due to the lack of awareness of their proprietary legal rights in their trademarks.
- c. The infringed trademark owner does not want to file a suit as filing of suit involves cost factor and time factor.
- d. Another finding the researcher has done is that most of the enterprises and businesses person's are having names which are their personal names, Sir names ⁵⁹⁹ as well as other names and person using these

⁵⁹⁹ Personal names e.g. Shirodkar jewelers, Shirodkar General Store Shirodkar Bicycles. Shah Construction, Shah Enterprises, Kamat Construction, Kamat Super Centre. D'souza Group, D'souza Restaurant.

names have lot of sentiments in these names and hence no one goes to sue anyone as certain understanding develops between them.

The next chapter which is the outcome and finding of the extensive research and analysis conducted by the researcher in the area of infringement and passing off right from their concept to protection by resorting to varied remedial measures available in India . The proceeding and the last chapter deals with the conclusions and suggestions for the improvement of trademark registration and protection process in India in relation to infringement and passing offgoods and services at all level.

CHAPTER VI

CONCLUSIONS AND

SUGGESTIONS

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CONCLUSIONS AND SUGGESTIONS

6.1 INTRODUCTION:

The Indian Trademark Legislation at present which is Trademark Act 1999 is the outcome and positive development of all the earlier legislation which were passed during their era. We can say that today's trademark legislation is in par with International level as India is a signatory to TRIPS and other International Treaties and Conventions. So in a way we can say that our present trademark legislation is a complete law on trademark but it doesn't mean that we cannot develop it more. No Law is constant by nature as there are new challenges so also innovations has to be brought into this law from time to time as it is required.

The present trademark act if we study and analyze is remarkably good as most of the aspect related to trademark has been covered and taken into account which also includes the 'Service' mark which was not there in the earlier legislations passed in India. The Rights of Prior user has also been safe guarded even if the same prior users mark is unregistered. The Act also has recognized the freedom of unregistered Prior user to file a passing of action against any person infringing such trademark.

Having a good legislation is one thing and implementation of the same is another thing. Though the Trademark Act is remarkable, but its implementation by the Authorities, Courts and the stake holders and public at large is not happening the way it should happen.

The Researcher after conducting intense research in the area of Trademark law namely '**Critical Analysis of Infringement and Passing off under the trademark law in India**'.

The researcher has come out with valuable findings with the help of doctrinal as well as empirical study and analysis of the same. Based on his study the researcher has come up with valuable and practical suggestions and inputs for the better implementation of trademark legislation with special relation to infringement and passing off.

6.2 Verification of Hypothesis:

Since the inception of the Trade Mark Legislation in India, the Trade Mark law has not achieved its Objectives and Aims, like;

***Hypothesis1:** The awareness and knowledge of trademark and its law is considerably less amongst traders (public) and hence there is increase in Infringement and Passing off of the Trademark or Service Mark.*

Hypothesis1 proved right as per the indication showed in **Table No. 17 and fig 5** which clearly shows that out of 1235 stakeholders 494 are aware of *Registration* of Trademark which is 40% and remaining 741 are not aware which is 60% and also by personal interaction done by the researcher with different people in the society as many a time people get confuse and think that trademark and copyright is one and the same. This proves that there is lack of awareness amongst the stake holder and the public as regards the trademark and its law.

Also Table No.18 and fig 6 clearly shows that out of 1235 stakeholders 432 are aware of Infringement and passing off Trademark, which is 35% and remaining 803 are not aware which is 65%. This gives us an understanding that the percentage of unawareness as regards the infringement and passing off wrong is quite alarming which means that many people in the business community don't even know that their proprietary right in the trademark is being violated and infringed. Something should be done so that awareness is spread at the grass root level as regards trademark law.

Table 20 fig 8 tells us that out of 1235 stakeholders 309 have knowledge of Infringement and Passing off remedy which is 25% and remaining 927 does not have knowledge which is 60% which gives us an understanding that there is a very high level of ignorance amongst the people as to the remedial measures in case of infringement and passing off wrong and there is need to educate people as regards the same as most of the interviewed people are silent on same.

Table No. 23 and fig 11 clearly shows that need for creating more awareness in the society regarding trademark law as out of 1500 stakeholders 1200 agree which is 80% and remaining 300 are does not agree which is 20% which means that there is huge want of awareness amongst the people which is required to be created by Government through Trademark authorities along with support of Companies, universities, schools etc.

TableNo. 22 clearly shows that out of 1028 stakeholders 205.6 are aware about criminal remedies for infringement which is 20% and remaining 822 are not aware which is 80% which makes us understand that there exist a very poor awareness as regards the Criminal remedial measures amongst the people interviewed by the researcher and based on market survey done by oral interview. The people who knows about such remedy are either lawyers or professionals and big business enterprises and not the common business person.

Table32 and fig 20 clearly shows that the filing of the cases relating to trademark infringement is very less in Goa's district Court i.e. only 05 in number where as the disposal is absolutely nothing i.e. Nil. This could be due to less awareness prevailing amongst different people residing here or could be because of negligent number of infringing and passing off cases happening in Goa.

Hypothesis2 This Act has failed to achieve the Object of giving utmost Protection to the Owner of the trademark and Service Mark due to following;

(a) At the time of Registration many complaints were filed in relation to opposition and rectification causing hardship to traders in obtaining trademark.

The **Table No.1** indicates that part (a) of Hypothesis No.2 proposed by the Researcher is not true, as it clearly shows that the functioning of the Administrative Authority under the Trademarks legislation namely the Trademark Registry is satisfactory. The table indicates that disposal rate is 68%. Hence the hypothesis proposed is disproved.

(b) Infringement and Passing-off action under the Trademarks Legislation has not been totally satisfactory and successful in achieving its goal that is providing justice to the registered Trademark Owner / Prior User of the Trademark by bringing prompt action on the Infringer of the Trademark.

Hypothesis 2(b) is proved to be wrong that Infringement and Passing-off action under the Trademarks Legislation has not been totally satisfactory and successful in achieving its goal that is providing justice as **TableNo.27** and Fig 15 clearly shows that out of 450 stakeholders 315 agree which is 70 % and remaining 135 does not agree which is 30 %. This indicates that majority of the stake holders are satisfied by the Infringement and Passing off action in India.

The researcher has also studied and examined number of case laws in India relating to Infringement and passing off right from District Courts up to Supreme Courts which shows that relief has been given to the genuine trademark proprietors. Infringement and passing off action in India has served the trademark proprietor from so many decades.

The researcher after examining and extensively studying all the legislations passed in India has found out that it is evidentiary, that action on infringement

of trademark in India was provided right from the passing of IMMA 1889 and continued the same with enactment of TMA 1940 and TMMA 1958 up to now in the Governing Act i.e. TMA 1999. So also Passing off action of the registered trademark owner has always been recognised and has been accepted by all the statutory trademarks legislations passed in India.

So also the rights of prior user has always been protected in India by all the Legislations passed in India and also by the judgment passed by different Courts in India and also by the Authorities under the trademarks Acts right from 1940 TM Act up to now under the TMA 1999.

The Authorities of trademark have also played its direct as well as indirect role in curtailing infringement and passing off also. The Registry does not allow the registration of conflicting as well as fraudulent trademarks and in this way prevents infringement and passing off of genuine prior used trademarks for goods or services in India.

The extensive study of the decisions of IPAB reveals that the IPAB is deciding the cases by giving fair hearing to the party to the litigation in the cases related to rectification ad orders passed by the Registrar of the trademarks. Varied judgments and orders passed by the Appellate board tells us that IPAB has provided justice to the genuine trademark owners since its inception in TMA 1999 because earlier the rectification was dealt by the Registrar ad the High Court under the 1940 and 1958 Act on trademarks. The case laws examined by the researcher reveals that even during that period justice was done to the genuine trademark owner of goods.

(c) There is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India.

Hypothesis 2(c) is proved to be wrong that there is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India as **Table No.28 and Fig 16** clearly shows that out of 400 stakeholders 180 agree which is 45 % and remaining 220 does not agree that there is delay and uncertainty in getting justice from the Courts in the cases of Infringement and Passing off in India which is 55 %. So also Based on the study of many different judgments passed by different Courts in India the researcher has found out that Courts have always taken a reasonable time for deciding the infringement and passing off suits and has also provided utmost justice to the genuine trademarks for goods and services in India within reasonable time. Even if there arises delay, it takes place because of the adjournment asked by either party or both the party to the litigation and it is not the lapse of Court. The Courts in India conducts Infringement and Passing off cases by giving the same fair hearing to both the parties and hence takes a reasonable time required to pass a proper order so that innocent person should not be unjustified by passing a wrong order in haste.

Hypothesis 3. *The functioning of the Administrative Authorities under the Trademarks legislation namely the Trademark Registry and Intellectual Property Appellate Board (IPAB) is not satisfactory due to delay in the Registration of the Trademarks on the part of Registry and also in disposal of matters by IPAB and the Registry and hence the trademark owners are not satisfied as it leads to economic loss and hardship and also loss to the Reputation of Trademark Proprietor.*

The Table No.1 and graphical representation in **fig.1**, indicates that the hypothesis No. 3 proposed by the Researcher is not true, as it clearly shows that the functioning of the Administrative Authority under the Trademarks legislation namely the Trademark Registry is satisfactory. The table indicates that disposal rate is 68%. Hence the hypothesis proposed is disproved.

So also based on the extensive study of different opposition cases heard and decided by the Registrar of Trademarks, the researcher has come up with the finding that there is a proper procedure which is followed by the Registry of trademarks in registering a trademark for goods or services and so also a proper reasonable required time is given for the same in order to prevent registration of the fraudulent trademarks. The registry cannot perform its functions in haste and then come with a wrong decision.

So also the different judgments passed by the Appellate Board tell us that the genuine trademark owners have been always given justice by IPAB while deciding the cases.

4) The Researcher proposes that;

- a. Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation.*

Hypothesis 4(a) is proved to be right that Passing-off action is more comprehensive in relation and wider in scope compared to Statutory Action of Infringement under the legislation as 75% of the stake holder agreed i.e. 263. where else only 25% disagreed i.e. 87.

Based on the extensive study of varied case laws on passing off and infringement and with oral and written interviews conducted with different legal professionals and legal authorities and traders by the researcher we can positively say that passing off action is wider the infringement suit in a sense that passing off action can be taken even if the infringer deals in different goods or services. e.g. Plaintiff conducting business in goods can bring a action on defendant conducting business in services if the plaintiff can prove that the defendant has committed a act of passing off .

So also on the principle of Trans-border publicity passing off action can be brought against defendant passes off a foreign trademark. And in case of Extended passing off action can be taken if the defendant harms the quality of the genuine product by passing off the same.

b. Trademarks Act needs to be amended by incorporating passing off provisions to make it more comprehensive and suitable as per the changing conditions in the society.

The Table 25 and Fig 13 clearly depicts that out of 206 stakeholders 82 agree that trademarks Act should include provisions for Passing off, which is 40% and remaining 124 does not agree which is 60% This highlights that 60% of the stake holders believes that there is no need to add passing off under trademark legislation.

This indicates the Hypothesis No. 4 proposed by the researcher partly disproved as the ratio is 40:60.

One of the reason for not agreeing to include passing off in trademark Act may be because the professional must be thinking that once passing off is made a part of statutory action then the legislature might restrict passing off action under the statute only for goods and services falling under same classification and not other classification of goods and services. And second reason is that if statutory action fails then the common law remedy may succeed hence there is always a cushion effect when passing off action is initiated through common law.

Hypothesis 5) *The Rights of trademark owner are not fully protected and there is a delay in giving them justice by the Administrative Authorities under the trademarks legislation as well as Judiciary in India.*

Table No.1 and **fig 1** indicates that the hypothesis No. 5 proposed by the Researcher is not true that the rights of trademark owner are not fully protected by the Administrative Authorities and there is delay in giving justice, as it clearly shows that disposal rate is 68%.

Table No. 31 and **fig 19** indicates us that out of 400 hundred Advocates and traders and professionals 55% agrees that Trademark Act 1999 is more effective and successful than all the previous Acts passed in India and remaining 45% are not agreeing and this analysis tells us that there is a good opinion formed by majority of the people.

So also hypothesis No. 5 proves to be wrong on the basis of extensive study and examination conducted by the researcher of all the legislations on trademarks passed in India right from British era and also all the judgments passed by different Courts in India right from District Courts up to Supreme Courts it is evident that the Administrative Authorities has always played a vital role in protecting the rights of trademark owners while dealing with registration process and procedure right from the enactment of TMA 1940 and later by enacting TMMA 1958 and now under the Governing TMA 1999.

It is evident that IPAB has passed number of judgment in favour of such prior user while deciding different cases on Rectifications and other appeals from Registrar of trademarks.

The Registry of Trademark under the administration of the Registrar has always protected the genuine trademark owner who was prior in use from getting infringed or passed off by not registering the conflicting and fraudulent trademarks and by registering the genuine trademarks and giving them protection.

The rectification function of IPAB was conducted by the Registrar and the High Courts during the era of TMA 1940 and TMMA 1958 , and even during those times Justice were given to the genuine trademark proprietors.

At present The IPAB has played a great role in giving utmost justice to the genuine trademark proprietor of goods or services.

The researcher has made extensive study of different case laws right from District Courts up to Supreme Courts on passing off and infringement and where scores of judgment have been decided in favour of genuine trademark owners. Hence based on the different landmark judgments by different Courts of Law in India we can always understand that Rights of trademark owners have been always safeguarded by the courts in India, So also as per the oral interview conducted by the researcher with many people like professionals, businessman, officers etc are positive about the TMA1999 and believes that it will definitely bring down infringement and passing off cases in India.

6.3 RESEARCH QUESTIONS ANSWERED

The researcher has answered the Important Questions related to the research study which are truly important to seek and achieve the outcome of the study.

1. Is the law relating to Infringement and Passing off Action in India is serving its purpose and objective entirely?

The Law relating to infringement and passing off is serving its purpose entirely as the Trademark Act 1999 and the TM Rules 1999 has provided protection of the genuine trademarks and works in the prevention and curtailing of fraudulent trademarks in the Country by providing different remedies for the same. There are lots of innovative rules and principles and concepts have been introduced under the TMA 1999 which has elevated the Act at an International level.

2. Has the Trademarks Act 1999 fulfilled its Object especially in reference to Infringement and Passing off Action and whether The Rights of Prior User really protected under the legislation in India?

Under the Trademark act 1999 there are huge number of judgments passed by the District courts, High Courts, as well as the Apex Court in India which has protected the rights of genuine trademark owners as well as prior user of trademark in goods and services. So also the Administrative authorities under the Act has always played a positive role in registering genuine trademarks and preventing and rectifying fraudulent and infringing trademarks.

3. Are the Courts in India providing justice to the aggrieved parties at a Satisfactory Level in the cases of Infringement and Passing off and is done so within reasonable period of time?

The Courts in India has played an important and positive role in giving utmost justice to the trademark proprietor within the time reasonably required by the Courts which is evident by the scores of case laws decided by different Courts in India on Infringement and passing off. Many a time delay is caused due to the parties to the litigation seeking adjournments etc.

4. Is the Trade Mark Registry functioning up to the mark to achieve its objective especially in the process of opposition and is the Infringement and Passing off concept taken into account while registering the Trademarks or Service marks?

It is evident by records that the Trademark Registry is performing to satisfactory level under the Trademarks Act 1999 and makes just decisions while hearing the opposition matters and by prevention of conflicting and fraudulent trademarks. The Registry obviously makes sure that the infringing trademark which can pass off genuine trademark is not allowed registration and the registry passes its opposition

judgment against such infringing trademarks. The Registry is now well equipped with technological advancement and is operating online through its official website.

5. Does the IPAB give appropriate justice while hearing the Rectification proceedings in relation to the Infringement of trademark and within the reasonable time limit and whether it has achieved the object of the Trademarks Act 1999?

There are large numbers of judgments and orders passed by the IPAB in favour of genuine trademark proprietors and also in favour of prior user and have passed many orders to strike off the infringing trademarks from the trademark registry. Majority of the cases are decided within reasonable period of time but in certain situation sometime delays does happen due to some genuine reasons.

6. Does the Statutory Authorities recognize the rights of Prior User in reality while deciding on the registration and rectification of the trademarks?

Prior users rights has been always recognized by all the legislations passed in India so also the Governing Law, TMA 1999 too has safeguarded the rights of prior user and the statutory Authorities plays a very important role in protecting such rights during Opposition and rectification proceedings before the Trademark registry and the IPAB respectively and this is evident with the large number of judgments passed by these Authorities.

7. Has the Trademarks Legislation in India achieved its overall Objectives in the matters relating to Infringement and Passing off Action.

Truly speaking the Trade Marks Act 1999 is a complete legislation on the trademark law and has provided with preventive and remedial measures through the statutory authorities as well as the Courts. This

Act has recognized the action of Passing off and has also recognised the rights of prior user to an extent that even a registered trademark owner cannot touch a prior user. This Act protects the rights of foreign trademark which is genuine and well known as India is signatory of TRIPS agreement and also Madrid protocol and many other conventions. TMA 1999 is truly a unique piece of legislation which is very close to achieving most of the objective it has enshrined in its Preamble.

6.4 Suggestions/Recommendations:

The following are the important suggestions/recommendations of the researcher which may help the students and academicians in their study on this area of research and these suggestions may also contribute in developing this law and practice in future.

1. The analysis of data proves that around 30% of the stakeholders like Proprietors/Owner, traders, students, and professionals and the general public are not awareness of Trademark law and its registration. It is duty of the government, its ancillary authorities and NGOs to create awareness at grass root level through seminars, workshops, colloquiums, skits, street plays etc. awareness is important to implement the law in practice.
2. All the educational institutions in India has to teach trademark law to the business groups and traders mostly start ups, small and medium businesses, wherever possible with vernacular language of that particular region or place so that they understand the concept well.
3. Government should help the small traders in filing infringement cases against the infringer, because majority of the traders are financially backward to fight the case before the judiciary.

4. Judges to be trained in the matters relating to trademark so that it will help them in disposing the infringement matters as early as possible. Technical experts are required to assist the judges in giving advice for quick disposal of matters.

After going through the literature and interaction with the officials the researcher proposes the following recommendations for amending the trademark legislation

1. Passing off remedy is available under the common law but not under trademark law. The remedy is only civil in nature. For better protection of passing off there is a need to incorporate separate provision dealing with passing off under the trademark law.
2. The jurisdiction and scope of Trademark Registry and IPAB should be increased by enlarging their powers. The Trademark Registry along with registration of the trademark should also be empowered to try Rectification of the trademark and the IPAB should be empowered to try Infringement and Passing off suits by bringing necessary amendment in the trademark legislation taking into consideration the changing condition in the society .
3. To increase the disposal of hearing from 70% to 90% and above, the Ministry of commerce should try and establish in majority of the States in India, such Trademark Registry and IPAB to undertake proceedings. Such a step will encourage all section of the Society to defend their trademarks in Registry as well as the IPAB because of the economical reasons there too as it becomes inconvenience and difficult to defend their mater because of their locations which is far away from their business locality .

4. Most of the trademarks in India should be recognized as Well known trademark so that they can be protected at National level with respect to goods and services.
5. Besides civil, criminal and administrative remedies, The Trademark Law should incorporate new provisions in relation to nonmonetary remedy and ADR methods in order to avoid litigation before the judiciary.

For greater implementation of trademark law government should put into operation the following suggestions.

1. The Government can come up with a special scheme for certain businesses which are below certain income limit in which such people get free legal aid to defend and protect their genuine trademarks in the court .
2. Government should undertake initiative to set up a registration process centre at every states and main business places which will help to keep a proper check on the registration system in the country and this is required in every major city so that the registry of a particular state caters to the registration process of the people residing in that state. Doing this will help each state to give a personal touch to their residents. Instead of centralizing the registration and litigation process in one state it is much better to decentralize the same.
3. Increase the staff in the respective Trademark offices and thereby speed up the process and reduce the time period for filing a notice of opposition/rectification procedure and bring in better disposals of applications and hearing at Registry as well as IPAB. 24 hour service should be provided wherein night working conditions should be

developed on shift basis so as to expedite the processing of trademark applications examination etc which should be done during this time.

4. The Government should help the small and less income business person to get their trademark registered free of cost, so also provide free legal service to defend and fight the litigation in the court of law as it is very important to understand that all these small businesses also contributes to the Exchequer by way of different taxes and levis and that these small businesses play a big role in building our Country's Economy to a great extent.
5. Special Court rooms and bench should be established which deals only with Intellectual Property cases on an urgent basis as Trademark and other Intellectual Properties play a very significant role in building up our Nation Economy and standard of living.
6. Efforts should be put by the Judiciary and the Government to build up the infrastructure of the Courts in India so as to increase its efficiency more so that a time will come that people will be totally satisfied in their performance and this can happen only when the courts are more organized and developed though they are truly efficient even now. There is always an extra scope for improvement in the management and functioning of the Courts and this can be achieved b systematic planning of the working of the courts and making sure that they are not overloaded with Cases.
7. Trademark being recognized not only at national level but it is having importance at international level. Hence there is a responsibility on the State to protect trademark in India. Government should establish opposition system and rectification processes in each state as businesses are mushrooming each and every locality of every state.

8. All the state should take responsibility and ensure that the proprietor of the trademark should be protected by other different government bodies like Registrar of Companies (ROC), Municipal Corporation, and Village Panchayats at the grass root level. These authorities can play an active role to avoid infringement of trademark.
9. Encourage the aggrieved consumer to file a complaint in consumer forum whenever they are cheated by traders or manufacturers by selling infringed goods and services.
10. Consumer Act should be amended to make a provision to file a case if the consumer becomes victim of buying a infringed or passed off goods or services from a infringing company or trader etc.
11. Knowledge of trademark and its law should be imparted in schools at a very early age as every student in some way or other is connected with IPR many of them might require the protection of their rights in the trademark and other IPRs either in business, art, culture or social field. A lesson on trademarks and other IPR should be included in the syllabus of school children so that they are educated in the field of IPR at a very young age.
12. Suo moto action should be allowed by parliament to be taken by police, courts, municipal corporations etc in case of infringement and passing off cases getting noticed in the society.
13. IPR association should be formed in a society or locality wherein infringement by any member of such association should not be allowed or encouraged by bringing in more and more people from different profession and callings.

14. Awards / appreciation certificates must be given for small innovation in IPR and distinct trademarks in goods and services as this can motivate and give inspiration to become creative in business thinking and the menace of infringement is reduced to a very great extent in India.
15. Trademark registry and IPAB should exclusively deal with trademarks, right from registration up to rectification should be decided only by the Trademark authorities set up in every state administered by ethical and upright officers and no appeal should be allowed once the authorities decide the case. In other words Trademark must be a subject of statutory authorities under the Trademarks Act 1999 only.

6.3. Conclusions:

The present trademark law if we study and analyze is remarkably good as most of the aspect related to trademark has been covered and taken into account which also includes the 'Service' mark' which was not there in the earlier legislation. The Rights of Prior user has also been safe guarded even if the prior user's mark is unregistered. The Act also has recognized the freedom of unregistered Prior user or a genuine trademark owner to file passing off action against any person infringing or passing off her or his trademark. Having a good legislation is one thing and implementation of the same is another thing. Though the Trademark Act is remarkable, but its implementation by the Authorities, Courts, different stake holders and public at large is not happening the way it should happen. The positive part is that the Country has a protective law Statutory as well as under Common Law in the area of Infringement and Passing off trademark in goods and services mark and the same advantage should be positively taken by the different stake holder in the Society so as to make this law more effective and useful as the TMA1999 has all the required provisions to stop and prevent fraudulent and infringing trademarks from getting registered. The courts too have played their important role by coming up with landmark judgments by passing innovative decisions and enlarging the

definition of Infringement and passing off from Indian as well as international perspective taking into account India's agreement and commitment to International treaties and conventions.

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ANNEXURES

ANNEXURES – I

Questionnaires to the Traders

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

Name:

Designation /Shop Name:

Place:

Please tick your Answers in the option provided below:

1. Are you aware about the need for Registration of trademark?
A. Yes. B. No.

2. Do you know what is Infringement and Passing off of Trademark?
A. Yes. B. No.

3. Are you aware that there is Online facility for registration of Trademark?
A. Yes. B. No.

4. Do you know what action has to be taken in case of Infringement and Passing off Trademark?
A. Yes. B. No. C. Doubtful.

5. Do you think Indian Laws are sufficient to curb Infringement and Passing off?
A. Yes. B. No.

6. Is there need for strict laws on infringement?
A. Yes. B. No.
7. How is the procedure for registration of Trademark?
A. Simple B. Moderate. C. Complicated.
8. What are the main reason behind not registering the Trademark?
A. procedure is complicated and lengthy.
B. No awareness regarding Trademark Registration and its importance.
C. Any other reason.
9. Can you give any other Suggestions as regards Trademark and its Protection?
- 1.
 - 2.

ANNEXURES - II

Questionnaires to the Students

QUESTIONNAIRE TO THE PROFESSIONAL COLLEGE STUDENTS ON TRADEMARK

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

Name:

Designation /Shop Name:

Place:

Please tick your Answers in the option provided below:

1. Are you aware about the need for Registration of trademark?
A. Yes. B. No.

2. Do you know what is Infringement and Passing off Trademark?
A. Yes. B. No.

3. Are you aware that there is Online facility for Registration of Trademark?
A. Yes. B. No.

4. Do you know what action has to be taken in case of Infringement and Passing off Trademark?
A. Yes. B. No. C. Doubtful.

5. Do you think Indian Laws are sufficient to curb Infringement and Passing off?
A. Yes. B. No.

6. Is there need for strict laws on infringement?
A. Yes. B. No.
7. How is the procedure for registration of Trademark?
A. Simple B. Moderate. C. Complicated.
8. What are the main reason behind not Registering the Trademark?
A. procedure is complicated and lengthy.
B. No awareness regarding Trademark Registration and its importance.
C. Any other reason.
9. Can you give any other Suggestions as regards Trademark and its Protection?
- 1.
 - 2.

ANNEXURES - III

Questionnaire to the Lawyers

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

Name:

Designation:

Place:

*Please **tick** your answers in the options provided below:*

1. Do you think that public is aware about the need for Registration of trademark?
A. Yes. B. No.

2. Do you want trademark officer to create awareness about registration of trademark?
A. Yes. B. No.

3. Online facility for filing trademark application will make work easier?
A. Yes. B. No.

4. Is the procedure for registration?
A. Simple. B. Moderate. C. Complicated.

5. Do you think there is need for amendment of procedures?
A. Yes. B. No.

6. Do you think Indian Laws are sufficient to curb infringement?
A. Yes. B. No.
7. Is there need for strict laws on infringement?
A. Yes. B. No.
8. Is the procedure for registration of Trademark?
A. Simple B. Moderate. C. Complicated.
9. What are the main reason behind not registering the Trademark?
A. procedure is complicated and lengthy.
B. No awareness regarding Trademark Registration and its importance.
C. Any other reason.
10. Is there need for separate courts to conduct matter of Infringement cases?
A. Yes B. No.
11. Any other suggestion you would like to give for speedy and simplified procedures for functioning of Trademark Registration?
- 1.
- 2.

ANNEXURES - IV

Questionnaire to the Trademark Registry

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

Name:

Designation:

Place:

Date and Time:

Please kindly **tick** your answers in the options provided below

1. Trademark ensure consumer to distinguish the goods of particular brand from similar goods? A. Yes. B. No.
2. Is there a need to register TM under Trademarks legislation?
Yes / No
3. Trademark registration ensures traders interest
Agree Disagree Strongly Agree Strongly Disagree
4. Mention the most significant reason for Trademark registration?
A. Brand recognition. B. Obtain relief of infringement.
C. Avoid confusion.
5. Do you think enough steps are taken by the trademark authorities to conduct awareness programs regarding trademarks?
A. Yes. B. No.

6. Do you have sufficient funds to conduct awareness about registration of trademark?

A. Yes. B. No.

7. Online facility for filing Trademark application will help to simplify and expedite the work of applicant?

A. Yes. B. No.

8. Is the procedure for registration?

A. Simple B. Complicated. C. Moderate.

9. Is the trademark registration activity increasing?

A. Yes. B. No.

10. Reasons for delay in registration

A. Lack of infrastructure B. Complicated procedure
C. Time consuming D. Examiners are not trained

11. Is there a need to amend the procedures?

A. Yes. B. No.

12. Main reasons for infringement of the Trademarks?

A. Lack of awareness. B. Complicated procedures.
C. High fees. D. Less centres for registration.

13. Are the Indian laws are sufficient to curb infringement of a Trademark?

A. Yes. B. No.

14. Is there a need for more office/forum/court for speedy disposal of infringement related matters?

A. Yes.

B. No.

C. Cannot Say.

15. Any other suggestion:-

1.

2.

ANNEXURES - VI

Questionnaire to the Judges

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

*Please **tick** your answers in the options provided below*

1. Do you think that public is aware about the need for Registration of trademark?
A. Yes. B. No.

2. Is the procedure for registration?
A. Simple. B. Moderate. C. Complicated.

3. Do you think there is need for amendment of procedures?
A. Yes. B. No.

4. Do you think Indian Laws are sufficient to curb infringement?
A. Yes. B. No.

5. Is there need for strict laws on infringement?
A. Yes. B. No.

6. What are the main reason behind not registering the Trademark?
A. procedure is complicated and lengthy.
B. No awareness regarding Trademark Registration and its importance.
C. Any other reason.

7. Is there need for separate courts to conduct matter of Infringement cases?
A. Yes B. No.

8. Any other suggestion you would like to give for speedy and simplified procedures for functioning of Trademark Registration?

1.

2.

ANNEXURES - VII

Questionnaire to the Police

The information procured shall be used only for this Research purpose and the Respondent is free to put any condition to the Researcher as to the provided data at the time of interview.

Kindly Note: This was mentioned orally to the stake holder.

Name of the Officer:

Designation:

- 1) Are there any remedies under IPC in case there is an infringement of Trademark? If so what are they?

- 2) Under section 103 and 104 of Trademarks Act a criminal proceedings can be initiated against infringer and the police can search and seize the counterfeited products, are these types cases reported here?

- 3) The genuine proprietor of the Trademark can file a criminal complaint to the police under section 156 of Code of Criminal Procedure, if his Trademark is infringed, have you'll ever received such complaints?

- 4) Are there any cases reported as regards the infringement of the Trademark? If so how many in a year?

- 5) Please give some valuable suggestion as to the Trademark and its protection

APPENDIX

APPENDIX - I
Types of Trademarks

1) GENERIC TRADE MARK



Escalator

2) ARBITRARY TRADE MARK



Apple for Computers , Real Manik for Beverage

3) DESCRIPTIVE TRADE MARK



4) FANCIFULL TRADE MARK



5) SERVICE TRADE MARK



6) COLOUR TRADE MARK



7) SHAPE AS TRADE MARK

APPENDIX - II

Court of the Principal District &
Sessions Judge, North Goa,
Near Panaji Residency, Panaji-Goa. 403001.

No. DSC/432/RTI/2019/ 3167

Dated: 20th March, 2019.
29 Phalguna, Saka-1940.

To,
The Public Information Officer,
District & Sessions Court,
North Goa, Panaji.

Sub: Information under the Right to Information Act, 2005

Ref: Your letters bearing No.DSC/RTI Act/6/2019/21
dated 27/02/2019

Sir,

With reference to the above, forwarding therein copy of an application, dated 26/02/2019, filed by Vinod Gajanan Shirodkar, r/o Betal and Manik Sadan, Miramar, Panaji, Goa, seeking information on the point no.4 (a) & (b), as under: -

4 (a). For the last ten years, i.e. from 01/01/2009, till date number of cases filed for infringement and passing off under Trade Marks Act, 1999 in the District Court.

Ans. **5 Nos.**

4 (b). For the last ten years, i.e. from 01/01/2009, till date number of cases disposed under Trade Marks Act, 1999 in the District Court.

Ans. **NIL**

Yours faithfully,

20/3/19
Asst. Sheristedar (Statistics)
District & Sessions Court,
North Goa, Panaji

APPENDIX - III**Names of the Shop / Traders Interviewed**

1	Pink Panther	31	Zuari View
2	Image Salon	32	Suresh Pal The Consultant
3	Tivrekar Traders	33	S.G. Enterprises
4	V. S. Zone	34	Hotel Treehouse Club
5	Tarcar Trading co.	35	Gurukrupa Ayurvedics
6	Sheetal Despande	36	Akhil Gomantak Maratha Samaja
7	Punjab Sind Food India Pvt Ltd	37	Kaju Darbar
8	V.P Traders	38	Netzone Cyber Café
9	Purohits Sweets	39	Chandu Farmacy
10	World Of Titans	40	Alson Agencies
11	Sunrise Bar & Restaurant	41	Daren Wine Shop
12	Balaji Super Market	42	Sunil Wines
13	Atmaram Wine Stores	43	Cecol (A)
14	Ashish Wine Stores	44	Crisan Wines
15	Shree Damodar Wine Stores	45	Rodrigues Wines & Gen Merchants
16	Liquor Unlimited	46	Stop N Shop
17	Rose Enterprises	47	T.A Harijan & Sons
18	Railo Wines	48	Biba
19	M/S C. Marquis & Sons	49	You & Me
20	Shubham Electricals	50	Car Spa
21	J.M. Fabrication	51	Books & Stationary Shop
22	Lanjekar Wines	52	Damu & Sons
23	Golden Wine Store	53	Poonam Collection
24	Rupa Wine Store	54	Luis & Company
25	Your Choice Wine Shop	55	R.N Collection
26	Govekar Wine & General Store	56	Zoom Center
27	Topnotch Wine	57	Sangeeta Shop
28	Venisha Wine Shop	58	Veer Shop
29	Dikshel Wine Stores	59	Prachita Shop & Canny
30	Webworld Stores	60	Royal Food & Pastry

61	Borkar Wine Stores	94	Excellect Mobile Centre
62	Shantadurga Variety Stores	95	Srisha Traders & Co./Partner
63	Sonu Wine Shop	96	Caitan Fernandes/Designer
64	Shekar Wine Store	97	Technician/Labbaik Auto Motor
65	Girish Egg Centre	98	Galaxy Battery
66	M/S Kanekar Wine Stores	99	Super Trading Co.
67	Casa Narvekar	100	Das Furniture Works
68	Goes General Stores	101	Dhondiraj Enterprises
69	Kensan Wine Mart	102	Tee & Cee Enterprises
70	Gurukrupa Jewellers	103	Asha Furniture Palace
71	Suraj Book Stall	104	Kunal Hardware
72	J.K Wine Mart	105	Sagar Family & Restaurant
73	Ramesh. W. Store	106	R.N Parodkar, Steel Furniture Shop
74	Hill Rock Wine Store	107	Bhavani Traders
75	Akshay. W. Store	108	Baker Point
76	Omkar Caterers	109	Anand Trading
77	Tukaram. W. Store	110	Gajanan Plywood
78	Camroon Kingdom	111	Medal Electricals
79	Sattari Liquor Traders	112	Laximi Agencies
80	S.M. Naik Wine Stores	113	Mario Gallery
81	Liquid Bank	114	Fallery Enterprises
82	Le-Jardin Bar & Rest	115	Solar Enterprise
83	Sahil Wines	116	Auto Shine
84	Capital Wine Stores	117	Mahalaxmi Palace
85	Sunder Enterprises	118	Bhartia Computers
86	MNS Mini Mart	119	Photo Dimensions
87	Starlight Bar & Restaurant	120	Gholba Home Store
88	City Stores	121	New World
89	Top Bar	122	Vega Auto Spares
90	Selection Fashion	123	Royal Décor
91	Marietta General Stores	124	Shree Damodar Plywood
92	Bar & Restaurant Godinho	125	Atom's Family Restaurant
93	Kamalavati Distributor	126	Royal Hardware

127	Pandharinath Krupa	160	Damodar Furniture
128	Care Store	161	Ganesh Xerox
129	Sohan General Store	162	Hotel Prasad
130	Miranda General Store	163	J.K Bake Sweets
131	Hanuman Store	164	Vishal Hardware
132	Deena Stores	165	Khooji Fashion Centre
133	Omkar Electricals & Gen Stores	166	Mumbai Diesel
134	Sai Store	167	Raj Dhiraj
135	Aqua Garden	168	Choice Caterers
136	Atchut .V. Teli	169	The Perfect Fit Fashion Collection
137	Hotel Anand Ashram	170	Duffe Agency
138	Moyo Medico	171	Cental Wine
139	Tukaram Stores	172	Angela Collection
140	Fatima Stores	173	Arrow
141	Arolkar General Store	174	And Stores
142	Hanuman Store	175	Diamond Hardware Store
143	My Own Store	176	Godrej Interior
144	Glow Store	177	IFB Point Porvorim
145	Muskaan. G. Stores	178	Pepperfry Studio Porvorim
146	Baggi Stores	179	Party Zone
147	Durga General Stores	180	Shetye Tradelinks
148	Roadside Stores	181	V-TECH
149	Lakshmi General Store	182	Wrangler
150	Super General Stores	183	Calvin Klien
151	Mobile Store	184	Shree Ram Stationary
152	Krishna General Store	185	Shri Sidhivinayak Electricals
153	St. Anthony Stores	186	Dunkin Donuts (Porvorim)
154	Black Pepper	187	Naresh Electricals
155	Veggie Deli	188	Imperial Home Appliances
156	Shaken & Stirred	189	Mark & Spencer
157	Dessert & More	190	Blackberry's
158	Taco bite	191	Asian Paint Shop
159	Zibb's Frankie	192	Genius Technology

193	National Highway Store	226	Cremeux
194	Happy General Store	227	L.P sports
195	Vivo Store	228	Crystal Madular Kitchen
196	Pepe Jeans	229	Toy Town
197	Big Bazar	230	LEE
198	Shoppers Stop	231	Inspirations
199	Will's Lifestyles	232	Krishna Clothing
200	Tommy Hilfiger (Porvorim)	233	Big Daddy
201	Max	234	Bata Stores
202	Dunkin Donuts	235	Simonias Bakery
203	The Yellow Chilli	236	Dunkin Donuts
204	Pan Ashian Hut	237	Aurelia
205	Ritz Classic	238	DM Max
206	Mac Donald's	239	CRO
207	Levis	240	Archies
208	United Colours Of Benetton	241	Time Collection
209	Hindu Pharmacy	242	Bagza Store
210	Tommy Hilfiger (Panjim)	243	Mangal Gift Shop
211	Lawrence & Mayo	244	Dessert & More
212	Partner/Angleys	245	U.S Polo
213	U.S Polo	246	Soch
214	Nike	247	Pepe Jeans
215	Reymond Store	248	KFC (Porvorim)
216	Fingerlicious	249	NJO'S WAFFLE
217	Padma Gadi Store	250	Bargain Book Hut
218	Men Saloon	251	Nirvana
219	Prince Dry Cleaners	252	Broadway Book Centre
220	Akruti Enterprises	253	Alcis
221	PVG Marketing Service	254	Archies Ltd
222	Levis(panjim)	255	Level 3
223	Orra	256	Blackberry's
224	Champs	257	And & Global Desi
225	Roopa Stores	258	Westside

259	Anthony Store	292	Time Collection
260	Janni Gas Service	293	Shoppers Stop (porvorim)
261	Yashoda Store	294	Mufti
262	Zareena Towers	295	UCB
263	786 Communication & Stores	296	Prestige
264	Surya Store	297	SK Kaju
265	Pradeep Sharma	298	Puma
266	Arnav Enterprises	299	Deal
267	Café Tadoo	300	SUS Shop
268	Home Zone	301	CW Store
269	Kamaxi Wine	302	Very
270	Sports World	303	Manyavar
271	Horizan Electricals	304	Bharne
272	Fabindia	305	Bharne Fashion & Lifestyle
273	Nike (Porvorim)	306	Cotton World
274	Louis Philippe Store	307	Lee
275	Vip Point	308	Govekar & liquor Palace
276	Veggie Deli	309	Yug & Vansh Wine Shop
277	Shaken & Stirred	310	Ganadish Wine Store
278	The Pet Shop	311	Chopdekar Wine Store
279	Babaji Bakery	312	Goltekar Wine Store
280	Patkar Chemist & Druggist	313	Wildcraft
281	Datta Communication Centre	314	Kajuwala
282	Mayur Gents Salon	315	Warrick Traders
283	Royal Parts	316	Sai Electronics
284	OPPO Global Cellular	317	Unitendor Press
285	Blue Dart	318	Govind Raj
286	Anvekar Jewellers	319	Baba Collection
287	Beena Store	320	Builder Home
288	Joom's Collection	321	I Space
289	Ajay Amit Traders	322	Hallmark
290	Vibrom Mobiles	323	Akxada Counto
291	Abha Fashion	324	Woodland

325	Rohan Traders	358	Weaves Furnishing
326	Baskin Robbins	359	Flavour 24
327	Monginis	360	Sai Bearing Company
328	Wellness Forever	361	Colours
329	Mini Store Express	362	Jai International
330	Gitanjali	363	Mohan Enterprises
331	Sharti Enterprises	364	Ashapura Mobile World
332	Nisha Classic	365	Mobilia Classica
333	Duclo Bhubo Sales	366	Computer World
334	Nikon	367	Vivo Welcome Mobile World
335	Zara Mens Wear	368	Forest
336	Bhoomi Collection	369	Forest Essentials
337	Shilson Company	370	Souza & Paul
338	Lucky Corner	371	Prestige Furniture
339	Lagu Bandu	372	Innovations
340	Bliss Blossoms	373	Gangar Eyenation
341	Shreyas Fashion	374	Vishnudas Narotamdas
342	Ceberb	375	Nagvekar Jewellers
343	Kwallity Walls	376	Body Shop
344	Mahalaxmi Store	377	Go Colours
345	Hellois Watch Shop	378	Akbar Travels Of India Pvt Ltd
346	Touch & Wear	379	Csa Madhav
347	Belon Shoes	380	Vastra
348	Menezes & Sons	381	Javeri's
349	Little Wonder	382	Leena Watches
350	Gift Corner	383	Brandes Garments
351	Red Rose	384	Big Mishra Pedha
352	Rainbow Photo Studio	385	The Mobile Centre
353	Choice	386	Govind Vaigankar General Store
354	Budge Enterprises	387	Umesh Betodkar General Store
355	Chintamani	388	Rajpurohit Sweet Mart
356	Sunrise Craft Centre	389	Banglore Iyenger Workshop
357	Heirlooms The Heritage Boutique	390	Jai Ambe Sweet Mart

391	Associated Enterprises	424	Shri Sai Restaurant
392	La Mode Clothing	425	Rich Merchant General Store
393	Javed Habib	426	Shree Mahadev General Store
394	Sheetal Garments	427	Hayyat Restaurant
395	Prestige Xclusive	428	Damodar General Store
396	Cave Craft	429	Just Shop
397	Jeans Shoppe	430	Kitchen Bar & Restaurant
398	UP Traders	431	Sujay Bar & Restaurant
399	S.G Enterprises	432	Raj Store
400	Ganekar Jewellers	433	Shri Shiv Shakti
401	Jeans Centre	434	Chavan Store
402	Baron	435	Salsar Balaji General Store
403	Aj Costa	436	Laximi Veg. Restaurant
404	Monsoon	437	Damodar Restaurant
405	Sainath Jewellers	438	Cake Palace
406	Seerdoon Trading Co.	439	Hot Chips
407	Mobi Café	440	Suza Sweet & Cold Drinks
408	Panjim Paper & Stationary	441	Hotel Everest Café
409	Kamcon Traders	442	Laxmi Marketing
410	Ashapura Hardware	443	Kailash General Store
411	Himalaya	444	Bजारंगभाली General Store
412	Godrej	445	Trupti General Store
413	S.G Fiesta	446	Jackson Wine
414	Bhavan Hardware	447	Rajat Laxmi Store
415	Dhiraj Electronics	448	Kishore General Store
416	M Branca	449	D.M Bar & Restaurant
417	Fashion Hub	450	Joyvito General Store
418	Party Shop	451	Pooja Store
419	Manak Gem	452	Vaibhav Laximi Store
420	Mukta Pearls	453	Aniket General Store
421	ICICI Bank Ltd	454	Tip-Top General Store
422	Spin Salon & Spa	455	Pint Mont Wine Store
423	Hotel Novatel	456	Akshay Traders

457	Candolim Deck	490	CA Alvaris
458	Britto's	491	Ramesh Dhond & General Store
459	Cape Town Café	492	Ruchira Bar & Rest
460	Viva Goa Hotel	493	Sam Enterprises
461	Rita Bar & Restaurant	494	Sitara Wine Store
462	Mishra Pedha	495	DS Wine
463	Woodland Hotel	496	Anandi Wine Store
464	Dream's Saloon & Spa	497	Sip & Dip Wine Store
465	Remmy Studio	498	Manisha Wine Store
466	Pankar Store	499	Hotel Vilena
467	J.K Kavlekar Store	500	Camroon Kingdom
468	Suraj Book Stall	501	Golden Wine Store
469	Newton Super Market	502	R.K Wine Store
470	Jk Dry Fruits	503	Rajesh Bar
471	Couture	504	Pinnacle Wine Mart
472	Lawande Sons	505	Ferns Bar & Rest
473	Optometrist/Specta Opticals	506	Rajiv Bar
474	Titan Eye Plus	507	Pereira Pick & Pay
475	Farooq Laliee	508	Saguna Bar
476	Anand Naik	509	Putu Wine
477	Laxmi Store	510	Umesh Naik
478	The Image Optic	511	Dessai Mart
479	Manthi	512	Reham Shaikh
480	Eyefye	513	Sita Store
481	My Shop General Stores	514	Marashca Wine
482	Waffels Bar	515	Goa Rajee
483	Kudos	516	Amy's Wine
484	Shawarma King	517	Honda Showroom
485	Peppy	518	Siddhai Wine
486	Samsanite	519	Ramnath Spirit
487	MB Veromoda, Jack & Jones	520	Goa Rajee
488	Mario Gallery	521	Salcete Pharmacy
489	HW Smart Casuals	522	Prisnal Wine

523	Ayesha Fashion Pvt.ltd	556	Shiv Samarth
524	Sai Optician	557	Rajee Honda
525	Partner Amit Shah	558	Mac Bar & Rest
526	Romano Opticals	559	Honda Rajee
527	Declo Bhubo (ROCA)	560	Dessai Store
528	Frank	561	Vaz Wine Shop
529	Branganza Stores	562	Sho Faz Galaxy
530	Light Shop	563	Syska LED
531	Vishal Store	564	Desi Lassi
532	Donald Vaz-My Shop	565	Bonzor Tiles
533	Star Grocery	566	Gastronut
534	All Round Stores	567	Lenovo
535	Jack & Jill Stores	568	Ambika Jewellers
536	Amigo	569	TNS Jewellers
537	All Round Stores	570	Jockey
538	Hassan & co.	571	Gauri Handicraft
539	Chumbak	572	Pharmacia We Care
540	Fashion Consultant	573	Cotton Cottage
541	Deep Mart Goa	574	Shree Lalita Silk
542	Hush Puppies	575	Superfast Xerox
543	Aurelia	576	Danken
544	Specto Opticals	577	Purohit Sweet
545	Jamson Galaxy	578	Ashish Enterprises
546	Lisha's cosmetics	579	Chart Street
547	Hair Cutting Salon	580	Bharat Hardware
548	UK Dry Fruits	581	Queen's Bury
549	Hari Om Art & Craft	582	Buqay Arabic Concept
550	Radhe Eye Visanoi	583	Ganesh Sitaram Khatkhate
551	Sun Enterprises	584	MD Costa & Co.
552	M.S.B Caculo	585	Mahalaxmi Auto Accessories
553	Mobile Planet	586	Samco Trading Company
554	Parijat	587	Shree Laxmi Multibrand
555	Hotel Aroma	588	Shree Kalika

589	Mario Gallery (uttkarsha)	624	G & G Enterprises
590	Nutan Readymad	625	Rao Engineers
591	Hotel Sunrise	626	National Ice cream
592	Sunrise Gold	627	Krish Anand Store
593	EYEFYE Opticals Shop	628	Million Hari
594	Benz Home Décor	629	Sean Enterprises
595	Susheela Palace	630	Kamaxi General Store
596	A 1- Car Accessories	631	Sahi Damodar General Store
597	Shri Anant Wine	632	Mohammad Rafique Store
598	Premavati Wine	633	Asif Store
599	Govind Enterprises	634	Vaigankar Store
600	Builder Home	635	Saba Ceol Poil
601	Divya General Store	636	Om Sai Store
602	Prabhat General Store	637	Mahalaxmi General Store
603	Goa Stationary	638	Pankaj Cold Drink General Store
604	M/S Goa Central Press	639	Rudresh Cold Drinks
605	Gaurish Liqour Agencies	640	Rebello General Store
606	Peter General Store	641	Gauri General Store
607	Nandita Wines	642	Shree Damodar Sweet & Gen Store
608	Deep Wines	643	Purohit Sweet Mart
609	M/S Kamaxi Liquor Traders	644	Vignesh Cold Drink
610	Sundha Bhavani Sweets	645	Mini Super Market
611	Prashant General Store	646	Sai Krupa General Store
612	M.G General Store	647	Ambika General Store
613	Pooja General Store	648	Misquit General Store
614	Parth Wine Store	649	Ji Colaco General Store
615	Shivank Retailers	650	R.N. Borkar General Store
616	Shantadurga Hardware	651	Sarita Traders
617	Ganesh Bakery	652	Ashirwad Hotel
618	Shaneshwar Marketing	653	Bombay Café
619	Sunda Sweets	654	Merg Store
620	Hanuman Cold Drinks	655	Vasant Bhavan
621	Kakodkar Agro Pet Pvt Ltd	656	Prasad Hotel
622	Purohit Sweet Corner	657	Borkar Store
623	Datta Marketing	658	Rich Merchant

659	Hanuman Sweet Shop	695	Damu Cold Drinks
660	Hotel Guimaka Classic	696	Prakash Bar
661	Babu-Juice Centre	697	Brynet Bar & Rest
662	Tell Me Centre	698	Sudha Bhavani Sweets
663	Purohit Sweet Mart	699	Casa Monterio
664	Jai Hanuman Shopping Centre	700	Sauza & Son's Bakers
665	My Bros Food K/Academy Canteen	701	City Bar
666	Bombay Sweet Palace	702	Banias Pan Branch
667	Corina Bar & Restaurant	703	Banarasi Dairy
668	Sunrise Swwets	704	Dackel Restaurant
669	Gautam Bldg Panjim	705	Vasco Inn Bar & Restaurant
670	Keshav Sinai Kunde & com.	706	Aqua Fish Emporium
671	Mukund Kamat Genral Store	707	Alankar Bar & Restaurant
672	Shirodkar Sai Enterprises	708	Coelho Bar
673	Shirodkar Modern Tailors	709	Cream Centre
674	Hanuman General Store	710	Sweet & Cream Pure Veg Rest
675	Viva Goa	711	Annapurna Logging & Restaurant
676	MHTH (Motor Health Insurance Hub)	712	Mary Bar
677	Lawande Super Market	713	Sanjay Bar
678	Bajaj Allianz Gen Insurance co. Ltd	714	Udupi Prassanna
679	ICICI Lombard Gen Insurance co.Ltd	715	Palvara Drink Corner Bar & Rest
680	HDFC ERGO General Insurance co.Ltd	716	Swad Restaurant
681	Go Digit	717	Solanki Sweets
682	IFFCO TOKIO General Insurance Co.ltd	718	New Banarasi
683	SBI General Insurance co. ltd	719	Shivsagar Sweets
684	Navin Studio	720	Sandhya Café
685	National Insurance Co. ltd	721	Bombay Sweet Mart
686	United India Insurance Co.ltd	722	Manthan Kajuwala
687	The New India Insurance Co. ltd	723	Adarsh Restaurant & Bar
688	Oriental General Insurance Co.ltd	724	Pavitra Restaurant
689	Cholamandalam Gen Insurance Co.ltd	725	Shankar Sweet Mart
690	Shirodkar Hotel	726	Jai Hanuman Sweet Mart
691	Shree Invesment	727	Pals Cold Drink
692	Milind Decorators	728	Sweet Palace
693	Navtara Hotel	729	Mahalaxmi Sweets
694	R.S.L Enterprises	730	Desserts N More

731	Ruchik	767	79 The Pet Shop
732	Ruchira Bar & Restaurant	768	Carpenters Choice
733	Café Tadoo	769	Suthar N Co.
734	Café Bhonsle	770	Javali Uniform Centre
735	Café Bappa	771	Cotton World
736	Classic Bussiness Centre	772	Power Resources
737	Suraj.Com	773	Crasto's
738	Escola Reality Pvt Ltd	774	Gajanan Ceramics
739	Café Coffee Day	775	Golden Collection
740	Baron Showroom	776	Artorium
741	Loja Dhond	777	Nkis Computers
742	Saivijay Wine Store	778	Virru Virgincar & Son's
743	Aram Wine Shop	779	Xpert
744	Francis Picado	780	Bharat Plywood & Laminate
745	Goes Store	781	Sky Motors
746	Kavlekar Wine Store	782	Star Motors
747	Korgaonkar Wine Store	783	Escapology Goa
748	Magdaline Wine Store	784	Agarwal Oak Leaf
749	N.R Venture	785	Pratik's Photos
750	Casa Narvekar	786	109 Degree F
751	Narvekar Wine Store	787	Lulu Fashion
752	Cold Corner	788	Body Building India
753	Rupesh Wine Store	789	Sleep Well World
754	Ansh Wine Store	790	Suyog Wood & Ply
755	APM Bar	791	Tarus
756	DG Wine	792	Bold & Beautiful
757	Jerry Store	793	Srinivas Trading Company
758	Florintine Bar & Restaurant	794	Falcon's Bio-Med Solutions
759	Las Viegas Super Centre	795	Vastra
760	Shree Ganesh Wine	796	Mahalaxmi Ice-cream
761	Roopa Wine Store	797	Pretty Ladies
762	Capital Wine	798	S.N Traders
763	Fiasdia Wine Store	799	S.N Traders
764	Golden Wine Store	800	Shubhalaximi Graphics
765	Yamuna Wine Store	801	U & Me
766	Tukaram Wine Store	802	Arhish Agro Associates

803	Wine Palace	839	Pogaddo Electricals
804	Sunder Enterprises	840	Ashish Agro Associates
805	Fiesta Wine	841	Amigos Tours N Travels
806	Akroid Wine Store	842	Mix & Match
807	Shree Damodar Wine Store	843	Yanisha
808	Jk Wine Mart	844	Umrao's Garment
809	Paresh Wine Shop	845	Pretty Women
810	Ashish Wine Store	846	G & M Collection
811	Borkar Wine Store	847	Prince Creation
812	Web World Store	848	Lovely Collection
813	Shantadurga Wine Store	849	Uma House & Décor
814	Sonu Wine Shop	850	Fashion Deck
815	Liquor Unlimited	851	T & A Collection
816	Menezes Enterprises	852	Mustafa Collection
817	Railo Wine	853	Nisha Classic
818	Rose Enterprises	854	Tik & Tok
819	Atmaram Wine	855	Dappers Fashion & Style
820	Laxmi Wine Store	856	Juri & Jonncy
821	Balaji Super Market	857	Kaveri Silk Saree
822	MNS Mini Mart	858	Mayanath Fashion
823	Venisha Wine Stores	859	Cotton Kings
824	Salgaonkar Wine Store	860	Renee Nicci
825	Savitri Wine	861	Just Casuals
826	Vihaan Wine Store	862	Kiran Bar
827	Govekar Wine Store	863	Proprieter
828	Dj Wine Store	864	Arrow Bar
829	Amancio Wines	865	Hanuman Store
830	Ramesh Wine Store	866	Rama Store
831	Super Quality Bazar	867	Egal Bar
832	Kenson Wine Mart	868	Royal Restaurant
833	Satpurush Wine Store	869	Hotel Kamal Palace
834	Kanekar Wine & General Store	870	Sayyed Mussa Store
835	Welcome Bar	871	Pharmacy Cleona
836	Lapaz Bar	872	J.B Bakery
837	Dhuler Tavern	873	B.V Talaulikar
838	Blue Diamond Bar & Rest	874	Anita Hotel

875	Bar Central	888	Panjim Inn Restaurant
876	Sunder Enterprises	889	Quinch Corner
877	Tanuja Enterprises	890	Magnem Super Market
878	Manorama Enterprises	891	Sunrise Sweet Mart
879	SM Naik	892	Kamaxi Store
880	Sawant Distilleries	893	Yamuna Super Market
881	Sattari Liquor Traders	894	Surya Kaju
882	Rajaram Bar	895	Laxmi Store
883	Sai Bar & Rest	896	Naik Store
884	Lajekar Wine	897	Kishore Café
885	Walke Wines	898	Hotel Grand Chef
886	Madera Liquor	899	Natasha Hotel
887	Aram Bar & Rest		