

# National Conference on Intellectual Property

December 16 & 17, 2016

at



## TRADEMARKS

D. Calab Gabriel  
Managing Partner  
Lex IP Care



Intellectual Property Law Practice

# WHAT IS TRADEMARK?

- **TRADE MARK**

- is a word, device, sign or symbol capable of graphic representation
- indicates the origin of goods and distinguishes the same from those of others
- qualifies a noun - the generic name of a product

E.g: **DABUR, REEBOK, KODAK, PHILIPS, TITAN**

# WHAT IS GI?

- **GEOGRAPHICAL INDICATION**

- is a collective right as opposed to a trademark which is a private right
- identifies a product as originating in a country or a region thereof
- whose quality, reputation or other characteristics are attributable to its geographical origin

EG: CHAMPAGNE, SCOTCH whisky, DARJEELING tea, HAVANA cigars, (product name indicates the origin)

ALPHONSO, FENI, BASMATI

(product is traditionally associated with a particular region)



# TRADEMARKS

# Spectrum Of Distinctiveness

- **GENERIC**
- **DESCRIPTIVE**
- **PERSONAL NAMES**
- **SUGGESTIVE**
- **ARBITRARY**
- **INVENTED**

# Generic Words



- **Common name of a product**
  - **inherently generic; or**
  - **becomes generic : inventor's burden**
- **Is or becomes part of public domain thus not a monopoly**
- **Examples: Enerjex (generic word Energy), Linoleum, Gramophone, Epsom, Asprin, Thermos, Escalator**

# Descriptive Words



- A word which describes the character or quality of the product
- Generally, no protection unless a substantial degree of secondary meaning shown
- Examples: 'It's finger lickin' good'- for food products, Graphite for pencils, Tastee-Freez for ice cream, Needle-Tip for saws & saw blades, Soflens for contact lens (ALL REFUSED)

# Personal Names

- A word which ordinarily denotes a surname or a personal name
- No protection unless a rare surname or secondary meaning is shown
- Examples: Bajaj, Kirloskar, Modi, Godrej

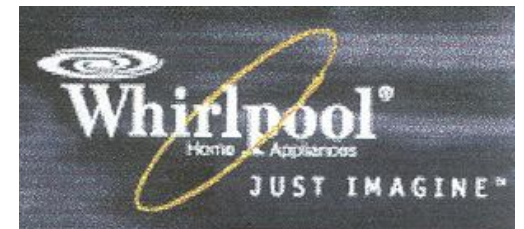




# Suggestive Names



- Ordinary dictionary words, which do not describe the quality/origin/character of goods
- Requires imagination, thought and perception to guess the nature of the product
- Protected on showing of secondary meaning
- Examples: Whirlpool, Surf, Vaporub, Superflame, Safeguard, Limca



# Arbitrary Words

- **Common word having meaning unrelated to the nature of the goods**
- **Protected even in the absence of secondary meaning**
- **Examples: Promise, Prudent, Wheel, Liberty**

# Invented Words

- Made-up mark/coined words having no dictionary or common meaning
- Protected even in the absence of secondary meaning
- Examples: Kodak, Exxon, Liril, Pepsi, Reebok



# ADVERTISEMENT CASE STUDY

## PRODUCT ADVERTISING

- INCORRECT ADVERTISING

WHATS THE NEXT BEST  
THING TO YOUR HOME

### **SAND DANCE**

Sand Dance's homely  
hospitality and idyllic  
surrounding recreate the  
ambience of home.

You can sand dance your way  
into bliss

- WHATS WRONG WITH  
THIS AD

- SAND DANCE IS USED AS  
A NOUN IN THE FIRST  
LINE

No trade mark  
designation indicated  
such as <sup>TM</sup> or ®

The mark is not used  
consistently wherever it  
appears

# PRODUCT ADVERTISING

## CORRECT ADVERTISING

WHAT'S THE NEXT BEST THING TO YOUR HOME?

**SAND DANCE**™

Holiday Resort AT

**SAND Dance**™ Resorts  
homely hospitality & idyllic  
surroundings blend to  
recreate the ambience of  
home.

**SAND Dance**™ Resorts  
offer you the best in  
comfort

## POINTS TO NOTE

SAND DANCE used as an  
adjective to qualify the noun  
“Holiday Resort”

Consistent use of the mark

Trademark designation  
indicated with the symbol™

# ADVERTISEMENT CASE STUDIES

- **"HAVE YOU CHERRY BLOSSOMED YOUR SHOES TODAY?"**

**What is wrong with the above ad?**



# **ADVERTISEMENT CASE STUDY PRESERVING LEGAL STATUS OF MARK**

**XEROX CORPORATION PLACED THE FOLLOWING AD**

**We interrupt our advertising for a word from our lawyers**

**Xerox is a tradename and a registered trademark. As a tradename, it stands for Xerox Corporation. As a trademark, it identifies our products. And it shouldn't be used when referring to anybody else's copier, duplicator, paper or whatever. (Let them use their own name.) Lawyer or not, remember that. O.K.? We return you now to our regular scheduled advertising**

**XEROX**

# Did you know the following started life as trademarks?

- ASPRIN
- CELLOPHANE
- THERMOS
- ESCALATOR
- GRAMOPHONE
- LINOLEUM
- YO-YO

**ENDED UP BECOMING GENERIC NAME FOR  
THE PRODUCTS**

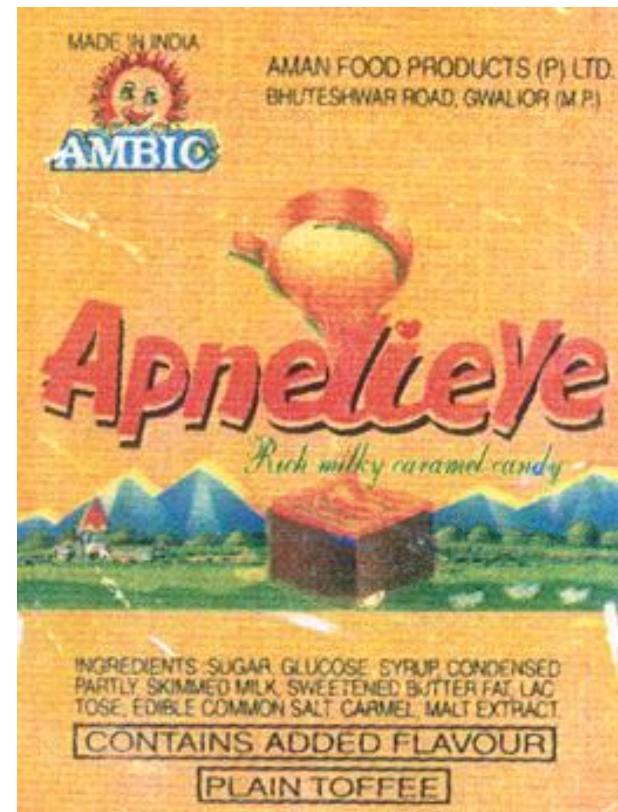
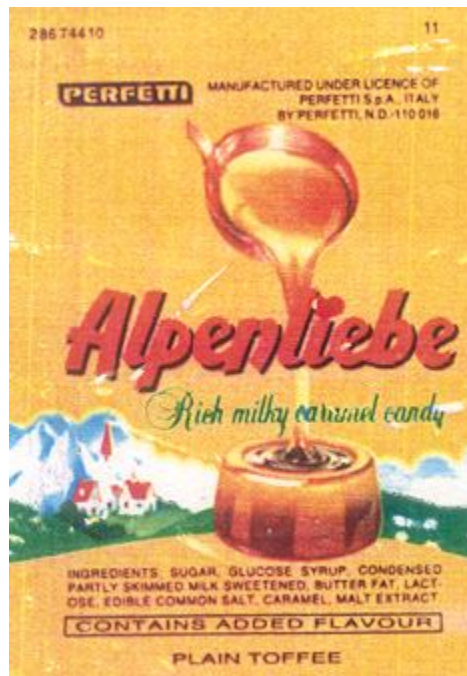


# Assignment



- **Registered mark may be assigned with or without goodwill**
- **Unregistered mark not assignable except along with goodwill unless:**
  - **assigned with a registered mark covering identical goods and**
  - **assigned to the same person at the same time**
- **Assignment must be recorded**

# PERFETTI



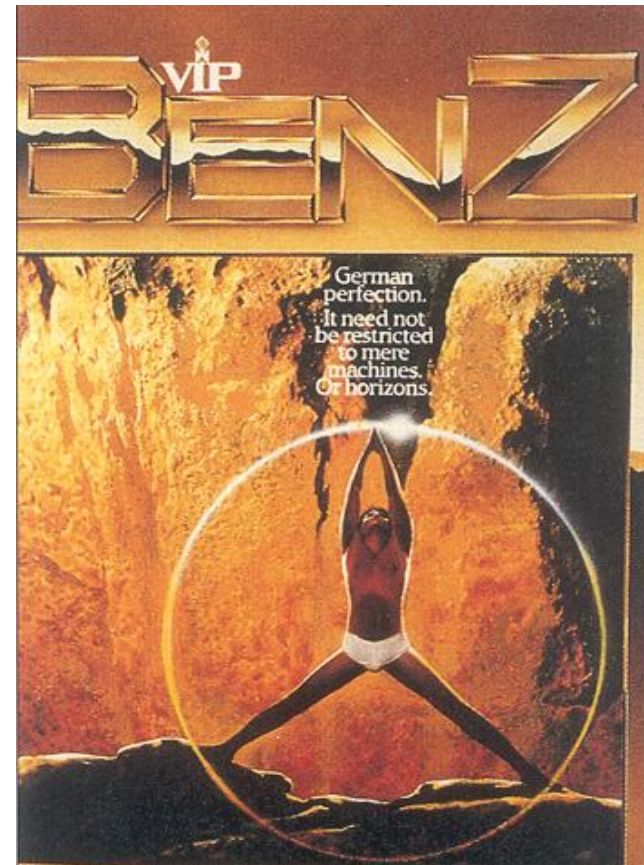
# SMIRNOFF



# TACO BELL



# MERCEDES BENZ



# GLENFIDDICH



# Enforcement

## Criminal Remedies



- Available irrespective of registration
- Classified as a non- cognizable offence for products other than foods and drugs
- Complainant may seek:
  - search and seizure of spurious goods
  - destruction of such goods upon conviction
  - prison term
- Example: Rayban Vs. Raybon

- **The Act permits registration of the shape of goods as a Trade Mark, excluding:**
  - **Shapes resulting from nature of goods.**
  - **Shape necessary to obtain a technical result.**
  - **Shapes which give substantial value to the goods.**
- **Single multi-class application permissible.**
- **Service marks can be registered for any category of services.**



- **Registration valid for 10 years; subject to renewals**
- **Common law licensing recognized**
- **An unregistered mark may be assigned with or without goodwill**
- **Recognition of well known marks for rejection/restraint even in respect of dissimilar goods/services**
- **Exhaustion of rights principle extended to lawful acquisition and further dealings in goods bearing the registered mark by or with consent of the proprietor**

- **Infringement action widened to include Passing off situations such as**
  - **similar goods/services on proof of likely public confusion**
  - **dissimilar goods/services on proof of reputation & detrimental effect on the mark**
  - **use as part of a corporate name in respect of the same goods**

- **Search & seizure available on direct complaint to the Police subject to confirming opinion of Registrar**
- **Enhanced prison terms and fines for first and subsequent convictions.**

**Thanks**