



INFRINGEMENT OF TRADE MARK AND REMEDIES AVAILABLE FOR INFRINGEMENT OF TRADE MARK.

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Abstract

A trade mark is any phrase, word, symbol or combination of all which is capable of distinguishing the goods or services from one enterprise to the other. The trade mark is the essential element for the growth of business and it is used as the marketing tool for promoting the goods and services. In India trade mark act 1999 deals with the trade marks. The significance of registering trade mark, infringement of trade mark, remedies for infringement of trade mark are discussed in this research paper.

Introduction

Trade mark is considered as intellectual property across the globe. Trade mark includes any name, word, design, logo, symbol, slogan or the combination of all which helps to differentiate from one entity to the other. In India A trade mark which is registered under trade mark act 1999 is called registered trade mark. Violation of exclusive rights which are attached to the registered trade mark is called infringement of trade Mark. violation of rights of unregistered trade mark is called trade mark passing off. The remedies for infringement of trade mark is given under trademark act 1999.

“According to sec 2(zb) trade mark act 1999 “trade mark” means a mark 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; and—

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark; ”

Significance of registration of trade mark

- Registration of trade mark acts as shield for unauthorised use.

- By registering the trade mark no other person can use the similar or same trade mark so that the registered trade will be unique .
- Trade mark helps to trace the products easily as the company of the product is identified quickly.
- Trade mark once registered can be used forever by the registered company just by renewing every 10 years .
- Even if business was not done for certain period if trade mark is registered the trade mark will be protected.
- When a trade mark is registered the remedy for infringement of the trade mark will given easily.

Infringement of trade mark

“Section 29 of trade mark act states about infringement of trade mark clearly as

(1)A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

(2)A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—

(a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

(4) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which—

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

(5) A registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

(6) For the purposes of this section, a person uses a registered mark, if, in particular, he—

(a) affixes it to goods or the packaging thereof;

(b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;

(c) imports or exports goods under the mark; or

(d) uses the registered trade mark on business papers or in advertising.

(7) A registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(8) A registered trade mark is infringed by any advertising of that trade mark if such advertising—

(a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or

(b) is detrimental to its distinctive character; or

(c) is against the reputation of the trade mark.

(9) Where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.”

Essentials for infringement of trade mark

The main two essential elements for infringement of the trade mark are

1. Use of registered trademark by unauthorised person.
2. Usage of mark which is deceptively similar to registered trade mark.

Use of registered trade mark by unauthorised person means when the trade mark is used by the person who is not authorised by registered trade mark holder. If the trade mark is used by the person who is authorised by the registered trade mark holder it does not amount to trade mark infringement. Unauthorised person should use the trade mark for propagating the goods and services which come under the same category of goods or services of the original registered trade mark.

Usage of the mark which is deceptively similar to registered trade mark means a mark is treated as deceptively similar if the mark in the dispute is creating the confusion from the original trade mark to the regular prudent man. The similarity of the trade mark is determined by colour combination, designing, phonetic similarity and the overall visual figure of the mark.

Cases on infringement of the trade mark

1. Izuk chemical works v. Babu ram Dharam

In this case the plaintiff was doing business from 1917. The plaintiff company deals with the products such as herbal henna, henna powder etc which comes under herbal beauty products. Plaintiffs are using the trade mark MOONSTAR with the logo visualising a star resting on moons lap this logo is being used by defendant since 1917 the plaintiff filed the suit on defendant after plaintiff came to know that defendant has copied all the aspects of the product and logo as these acts of the defendant are making the common man confused between two products plaintiff filed case for permanent injunction by observing all these court held that the acts of the defendant amount to infringement of plaintiffs trade mark. further court ordered the permanent injunction against the defendant.

2. Starbucks corporation v. sardar Buksh coffee and co

Starbucks corporation v. sardar Buksh coffee and Starbucks in India on 2001 registered its trademark as work mark pronounced as STARBUGS with a logo which is appeared as crowned maiden with long hair. Defendant in this case initiated the business in 2015 and named it as sardar buksh coffee and co after gaining recognition by the said name in may 2018 the he formed the a private limited company in the name of sardar Buksh private limited and the logo of the defendant is appeared as a circular black band with the words sardar Buksh coffee and co and a turban commander along with wavy lines extending from edges.

On the ground of deceptively similar nature of logos and words Starbucks filed a suit against the Sadar Buksh coffee and co. Court observed that both companies it means plaintiff and the defendant are dealing with the same product as it mentioned above the products must be same in case of unauthorised use of trade mark for amounting to infringement of trade mark. And court also observed that the acts of defendant is confusing. And the court ordered the defendant to change the name of outlet from Sardar Buksh coffee and co to Sardharji- bakhsh coffee and co. and court also provided the privilege to the defendant that if any one uses the word mark bakhsh the defendant has right to sue for injunction.

Acts which does not amount to infringement of trade mark

Sec 30 of trade marks act 1999 states the conditions where the trade mark is not said to be infringed.

- When a person uses the trade mark in industrial or commercial matters in accordance to honest practice.
- If the use of the trade mark is not to take any undue advantage and does not harm the reputation and distinctive character of trade mark.
- If the mark is used to indicate the quantity, quality, value, geographical origin, the time when the rendering of services or production of goods or for any other characteristics of the services and goods.
- When the original proprietor of the trade mark uses the trade mark in continuance of the permitted use of the trade mark where he has not removed subsequently or obliterated.
- While registering the trade mark there may be some limitations and condition in those cases if the act of trade mark in dispute come in the ambit of limitation mentioned then such act cannot be considered as infringement of the trade mark.

Remedies available for infringement

There are three types of remedies available

1. Civil Remedy
2. Criminal Remedy
3. Administrative Remedy

CIVIL REMEDY

According to sec 134 of trade mark act any suit can be instituted under this act in the district court or high court within the local limits of their jurisdiction. The registered user or proprietor can institute the suit or proceedings, if there are more than one then they can institute the suit in any person's place of the residence or where they carry business or works for gain personally.

Under sec 135 of trade mark act the court can grant the reliefs for infringement of trade mark under sec 134, the reliefs such as damages, an account of profit under sec 135 (1) and under sec 135(2) the court can give interlocutory or injunction order in accordance with sec 36 - 42 of specific reliefs act 1963 or order xxxix rules 1 and 2 and sec 151 (courts inherent power) under code of civil procedure 1908 for preservation of the goods ,documents which are infringed , discovery of any documents and restraining the defendant from disposition of any assets which will adversely affect the plaintiff this section is all about temporary injunction , permanent injunction , and restraining the unauthorised persons from further use of the trade mark.

Criminal Remedy

Under this the complainant seeks award of punishment to the infringer , for this the complainant file complaint before the magistrate for seeking orders for investigation under sec 156(3) of criminal procedure

code and can also move an application under sec 93/94 of criminal procedure code for issuing general search warrant for general search and seizure.

And under sec 115(4) of trade marks act the procedure for filing a direct complaint before the police officer for infringement of trade mark the starting level police officer empowered for taking complaint under this act is assistant commissioner of police (ACP) or deputy superintendent of police (DSP) . the DSP OR ACP should take an opinion from the registrar of trade mark before taking an action.

Penalties for infringement of trade mark

Under sec 103 of trade mark act if any person falsifies any trade mark or applies for trade mark falsely to the goods or services they shall be punished with imprisonment for a term which shall not be less than 6 months but which may extent to 3 years and with fine which shall not be less than RS 50000 but may not extend to 200000

Under sec 104 of trade mark act states that if any person helps the accused by selling, providing or hiring services of such good for sale or in any other way possible will be punished with the infringement for a term which shall not be less than 6 months but which may be extended to the period of six years and with fine which shall not be less than 6 months but may be extended to 6 years and with the fine which shall not be less than Rs 50000 but which may extent to 200000.

Under sec 105 of the trade mark act any person who has committed the offences provided in sec 103 and 104 of the trade mark act shall be punished for the second and subsequent offence with the imprisonment of the term which shall not be less than 1 year but which may be extended to 3 years and with the fine which is not less than Rs 100000 but may be extended to Rs 200000.

The limitation period for filing the suit for infringement of the trade mark is three years for the date of infringement of the trade mark. If the infringement is continuing in nature then a new action will arise every time an infringement occurs.

Administrative Remedies

Here the trade mark which is deceptively similar can be stopped from filing by the opposition within the four months from the date on which it is published. If the trade mark is registered the person can apply for rectification of register by applying for removal of deceptively similar trade mark.

Conclusion

The trade mark act Provides the Procedure for registering the trade mark and gives at most protection to the trade mark from the infringement. As trade mark is so important it is advised to register the trade mark and the proprietors of the trade mark should know about their rights and remedies attached to their Trade mark.

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