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Trademarks- Protection and it's Enforcement – An Overview

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Saisunder N.V
Partner- Eshwars,
Advocates

saisunder@eshwars.com

WHAT IS A TRADEMARK?

CAPABLE

**OF GRAPHICAL
REPRESENTATION**

WHICH CONSISTS

OF DISTINGUISHING

- DEVICE
- NAME
- SIGNATURE
- WORD
- LETTER
- NUMERAL
- SHAPE OF GOODS
- PACKAGING
- COMBINATION OF COLOURS
- ANY COMBINATION OF THE ABOVE

NEED FOR A TRADEMARK- WHY??

Identifies the source of that particular products/services

Trivia- Is it mandatory to register a brand name to claim a Trademark right legally??

BRAND TRIVIA



Reliance

Connecting India



Few More Examples

- Device -

Annapoorna

- Shape of goods –



- Logo-





UNCONVENTIONAL TRADEMARKS

SOUND MARKS



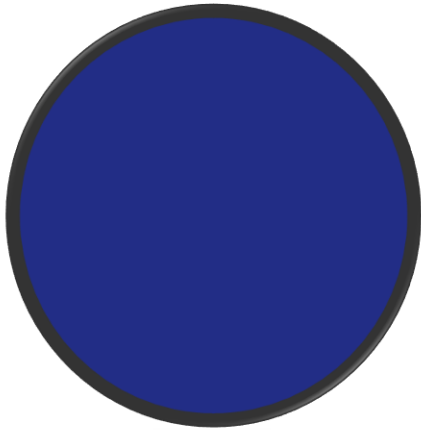
Other Eg: MGM Lion Roar, Yahoo yodel, Engine sound of Bullet Motorbikes

Graphical representation of Musical note

Copyright Vs. Trademark- Artistic Work in a logo

UNCONVENTIONAL TRADEMARKS

COLOUR TRADEMARKS



Does a Single Colour qualify as Trademark in India?

TRADEMARK VS. COPYRIGHT

TRADEMARK

LOGO/DEVICE
MARK

SOUND MARK

COPYRIGHT

ARTISTIC WORK

MUSICAL WORK

Should I opt for protection both as a Trademark and as Copyright?- Is it permitted?

COLLECTIVE MARK VS. CERTIFICATION MARK

COLLECTIVE MARK

Mark owned by an organization and used by its members to identify themselves as associated with the organization

CERTIFICATION MARK

Mark which shows the material, mode of manufacture of goods or performance of services, quality, accuracy, or other characteristics

CA, CS, CPA, ICWAI

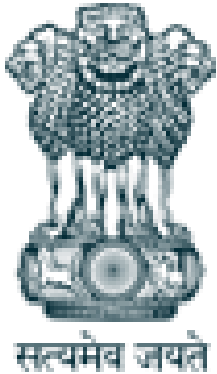
BIS, AGMARK, FSSAI

Is Tirupati Laddoo or Darjeeling Tea a trademark? Or is it a Geographical Indication (GI)?

TRADEMARK REGISTRATION- WHY??



INDIAN TRADEMARK LAW



Controller General of Patents, Designs & Trade Marks

Office of the Registrar of Trade Marks

<http://ipindia.nic.in/trade-marks.htm>

POINTS TO REMEMBER- SELECTING A GOOD TRADEMARK

- Distinctive capability- Coined or Fanciful and Arbitrary
- Should not describe the goods or services
- Cannot be a term or word that is customary in the current language or in the bona fide and established practices of the trade.

DONT'S

- Violates any religious sentiments
- Contains Scandalous or Obscene matter
- Prohibited marks
<https://ipindiaservices.gov.in/tmrpublicsearch/prohibitedmarks.aspx>
- International Non-proprietary names (in case of pharma products)

EXCEPTIONS

- If the trademark has acquired distinctiveness before the filing of Applications due to extensive usage.
- If it is a well-known trademark.

It has to be proved by adducing sufficient documents before the Trademarks Registry.

SELECTING A GOOD TRADEMARK- LEGALLY SPEAKING..!

Product – Water Heater

Trademarks proposed for adoption:

Quick Heat 

Freedom 

Aqwarm 

CONDUCTING A PRE-ADOPTION SEARCH IS ESSENTIAL

WHAT IS A CLASS?

- Classes 1 to 34 – Products/goods
- Classes 35 to 45 – Services

<http://euipo.europa.eu/ec2/>

← → ↻ ⓘ Not secure | euipo.europa.eu/ec2/ ★ 👤

TMclass FAQ Help Tutorials English (en)

Classification Tools ▾ Classification Resources ▾ Translation Tools ▾ My List: You have made no selection

Search term

Language English (en) ▾	Search term Search term (E.g. Milk)	Nice Class 1-45 📄	HDB (Harmonised Database) ▾ ⓘ <input checked="" type="checkbox"/>	Office Databases <input type="checkbox"/> WIPO <input type="checkbox"/> ARIPO (AP) <input type="checkbox"/> IPA (AU) <input type="checkbox"/> BRUIPO (BN) <input type="checkbox"/> CIPO - OPIC (CA) <input type="checkbox"/> ILPO (IL) <input checked="" type="checkbox"/> CGPDTM (IN) <input type="checkbox"/> IPPD (JO) <input type="checkbox"/> DIP (KH) <input type="checkbox"/> MIPPO (MO)	<input type="button" value="Search"/> <small>Browse terms</small>
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TRADEMARK SEARCH

ipindiaservices.gov.in/tmrpublicsearch/frmmain.aspx



Government of India
Ministry of Commerce & Industry
Department of Industrial Policy & Promotion
Controller General of Patents Design & Trade Marks
Public Search of Trade Marks



[Class Details](#) | [Well Known Marks](#) | [Prohibited Marks](#) | [Vienna Code Classification](#) | [International Non-Proprietary Names\(INN\)](#) | [Help](#)

Key Word	Value	
Wordmark	<input type="text"/> <input type="button" value="Start With"/>	
Class	<input type="text"/>	<i>*Enter one class at a time</i>
Goods Description	<input type="text"/>	<i>*Will be available soon</i>

Best View in Resolution of 1024x768 or later. Enable Javascript for Better Performance.

TRADEMARK REGISTRATION

Application



Examination
Stage



Hearing
Stage



Advertisement



Registration

SYMBOLS – TM, SM & R

TM & SM

- Unregistered mark.
- Not mandatory but it is wise to use



- Regulated by Indian law
- Registered mark

REGISTRATION VALIDITY & RENEWAL

- ❖ Ten years
- ❖ Renewal is perpetual
- ❖ Non-filing of renewal request leads to removal of trademark from the Register.

Remedies

An infringement suit is a statutory remedy available for enforcing the rights of a registered trademark.

Civil Remedies-

- a) Injunction
- b) Damages
- c) Account of profits together with or without an order for delivery, or destruction or erasure of the infringing products

Criminal Remedies-

- a) Cognizable Offence
- b) Criminal proceedings can be initiated

DOMAIN NAME DISPUTE RESOLUTION & TRADEMARK PROTECTION IN INTERNET SPACE

TERMINOLOGIES

ICANN

- Internet Corporation For Assigned Names And Numbers

DNS

- Domain Name System

gTLD's

- Generic Top Level Domain Names – .com, .info, .net

CCTLD's

- Country Code Top Level Domain Names – .co.in, .com.sg

TLD Registry Operator

- Keeps master data of all registered domains

Domain Registrar or Registrar

- Godaddy etc.

TERMINOLOGIES

Registrant or Domain Registrant

- A Person who registers a domain name

UDRP and Rules

- Uniform Domain Name Dispute Resolution Policy- Applicable to gTLD's

INDRP and Rules

- .IN Domain Name Dispute Resolution Policy- Applicable to .in ccTLD

Other Domain Name Dispute Resolution Policies and Rules for specific ccTLD's- .usDRP, .auDRP etc.,

Cybersquatting

Reverse Domain Name Hijacking / Reverse Cybersquatting

WHOIS Data

WHOIS DATA PAGE

This Registry database contains ONLY .EDU domains. The data in the EDUCAUSE Whois database is provided by EDUCAUSE for information purposes in order to assist in the process of obtaining information about or related to .edu domain registration records.

The EDUCAUSE Whois database is authoritative for the .EDU domain.

A Web interface for the .EDU EDUCAUSE Whois Server is available at: <http://whois.educause.edu>

By submitting a Whois query, you agree that this information will not be used to allow, enable, or otherwise support the transmission of unsolicited commercial advertising or solicitations via e-mail. The use of electronic processes to harvest information from this server is generally prohibited except as reasonably necessary to register or modify .edu domain names.

Domain Name: ICSI.EDU

Registrant:

Institute of Company Secretaries of India
ICSI House,C-37
Sector-62
Noida, Uttar Pradesh 201301
India

Administrative Contact:

Domain Admin
Institute of Company Secretaries of India
ICSI House,C-37
Sector-62
Noida, Uttar Pradesh 201301
India
+91.1204522008
asit.rath@icsi.edu

Technical Contact:

VENKATA SUDHAKAR CHINTA
The Institute of Company Secretaries of India
ICSI House,C-37
Sector-62
Noida, 201301
India
+91.1204522019
sudhakar.venkata@icsi.edu

Name Servers:

NS16.GOFORHOSTING.COM
NS15.GOFORHOSTING.COM
NS14.GOFORHOSTING.COM
NS13.GOFORHOSTING.COM

Domain record activated: 07-Sep-2001
Domain record last updated: 05-Jul-2019
Domain expires: 31-Jul-2020

DOMAIN NAME DISPUTE RESOLUTION- UDRP PERSPECTIVE

Mandatory
Administrative
Arbitration
Proceeding for
gTLD's

Conducted
before one
of the
Administrat
ive Dispute
Resolution
Service
Providers

•WIPO, Arab
Center for
Domain Name
Dispute
Resolution,
Asian Domain
Name Dispute
Resolution
Centre

WHAT IS THE LEGAL BASIS OF UDRP? THE DOMAIN NAME REGISTRATION AGREEMENT

6. DISPUTE RESOLUTION POLICY

You agree to be bound by our current Dispute Resolution Policy. This policy is incorporated herein and made a part of this Agreement. You can view the [Uniform Domain Name Dispute Resolution Policy](#) online. You agree that GoDaddy may from time to time modify its Dispute Resolution Policy. GoDaddy will post any changes to its Dispute Resolution Policy at least thirty (30) days before they become effective. You agree that by maintaining your domain name registrations with GoDaddy after the updated policy becomes effective that you agree to the Dispute Resolution policy as amended. You agree to review GoDaddy's website periodically to determine if changes have been made to the Dispute Resolution Policy. If you cancel or terminate your Services with GoDaddy as a result of the modified Dispute Resolution policy, no fees will be refunded to you. You also agree to submit to proceedings commenced under ICANN's Uniform Rapid Suspension System, if applicable.

You agree that if a dispute arises as a result of one (1) or more domain names you have registered using GoDaddy, you will indemnify, defend and hold GoDaddy harmless as provided for in this Agreement. You also agree that if GoDaddy is notified that a complaint has been filed with a governmental, administrative or judicial body, regarding a domain name registered by you using GoDaddy, that GoDaddy, in its sole discretion, may take whatever action GoDaddy deems necessary regarding further modification, assignment of and/or control of the domain name deemed necessary to comply with the actions or requirements of the governmental, administrative or judicial body until such time as the dispute is settled. In this event you agree to hold GoDaddy harmless for any action taken by GoDaddy.

REPRESENTATIONS

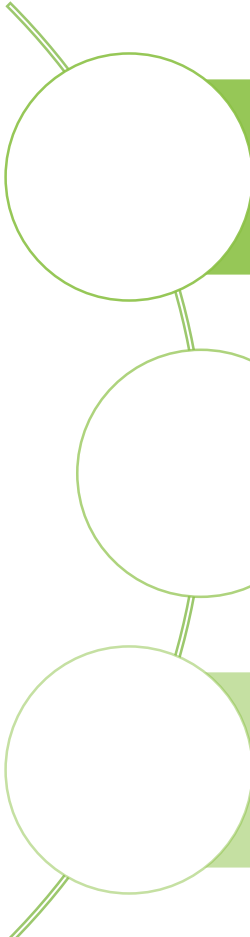
UDRP

The registration of the domain name will not infringe upon or otherwise violate the rights of any third party

Not registering the domain name for an unlawful purpose

Not knowingly use the domain name in violation of any applicable laws or regulations

ESSENTIALS- OF UDRP ACTION

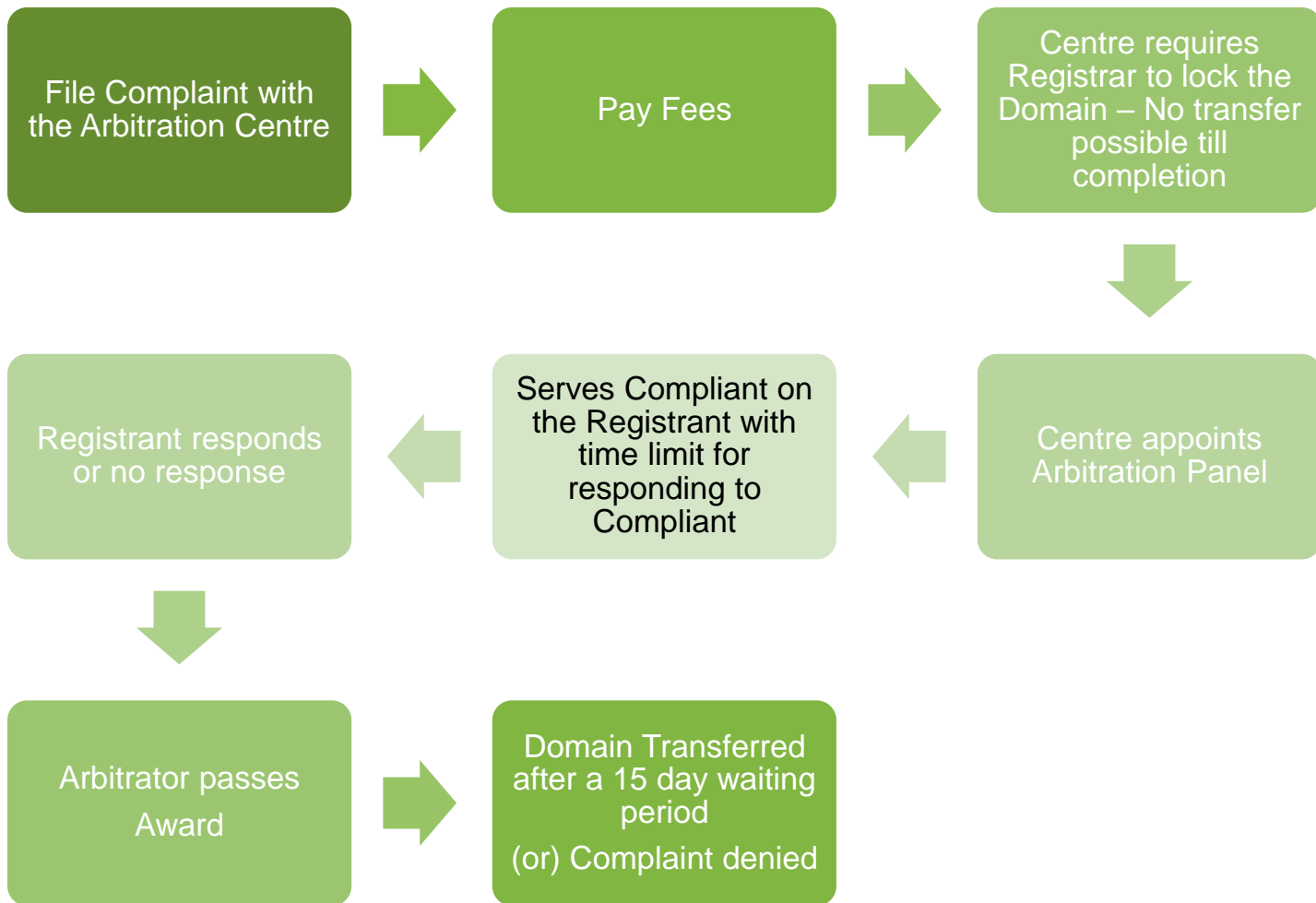


demonstrate that the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; AND

prove that the registrant lacks rights or legitimate interests in the domain name; AND

establish that the registrant has registered and uses the domain name in bad faith

UDRP PROCESS



DECIDED CASES...PERSONALITY

**Donald J. Trump v.
Fountainhead
Entertainment LLC**

- 2004
- trumpice.com
- Apprentice – he sells TRUMP ICE

**Donald J. Trump v. Daniel
Maciel**

- 2005
- trumplending.com
- trumploans.com

**Donald J. Trump v. Sandra
Long Consulting**

- 2007
- trumplogos.com

**Donald J. Trump v.
Mediaking LLC d/b/a
Mediaking Corporation
and Aaftek Domain Corp.**

- 2007
- trumplasvegas.com

DECIDED CASES...PERSONALITY

Donald J. Trump v. Domain-Holdings

- 2011
- trumpinternationalscotland.com
- trumpscotland.com
- trumpuk.com

Donald J. Trump v. Daniel Maciel

- 2011
- trumpabudhabi.com, trumpbeijing.com, trumpindia.com
trumpmumbai.com

Donald J. Trump v. Point Pub Liquors

- 2012
- trumpwine.com

Donald J. Trump v. Scott Stephens

- 2015
- trumpestates.com

UDAY KOTAK

- **Kotak Mahindra Bank Limited v. Richard Brown [2008] www.udaykotak.com**
- The uncontradicted evidence of the Complainant in this case is that the commercial community identifies the Complainant with the bank which he founded and which Kotak Mahindra Bank Limited continues to operate under his leadership. He is seen by the media and the public, particularly in India, as the alter ego and driving force behind the company. He retains a substantial shareholding. He is identified with its achievements. The enterprise has a clear interest in protecting his name for commercial use, in view of the Complainant's association with the bank and the fact that it trades under its registered mark KOTAK, his surname.

ATHENA INFONOMICS

www.athenainfonomics.com

Service Provider engaged to register. Who engages a person in Canada (Renji Mathew) to register

Canadian registers in individual name. Refuses to transfer, seeks compensation.

Long drawn correspondence entered into to establish bad faith. UDRP filed and ordered to be transferred. (2017)

UNMAIL.COM


Complainant adopted the mark in 2015. Domain registered by Respondent in 2013.



Respondent alleges reverse domain name hijacking by Complainant.



Appears that employee of complainant has approached Respondent for acquisition prior to the complaint, in 2015.



Panel records finding of RDNH

Thank You

N.V Saisunder

saisunder@eshwars.com

+91 99949 98880

Website: www.eshwars.com

Eshwars House of Corporate & IPR Laws

#4, Aishwarya, 12B/177, 6th Street, Kumaran Colony, Vadapalani, Chennai- 600026, India
E: info@eshwars.com T +91-44-4204 8235/ +91-44-4204 8335

6th Floor, Khivraj Complex II, #480, Anna Salai, Nandanam, Chennai-600035, India
T: +91-44-42048235, +91-44-42115635 Hand Phone: +91- 98400 56343

KOCHI:

4TH FLOOR, CENTRE A, ALAPATT HERITAGE
BUILDING,
M.G ROAD, KOCHI - 682035
MOBILE: +91 81138 63483

HOSUR:

NO. 88, 1ST FLOOR, OPP. GOVERNMENT
HOSPITAL,
DENKANIKOTTAI ROAD, HOSUR- 635109
BOARD: 04344-612661

NEW DELHI:

C-360, LGF, Defence Colony, New Delhi -
110024
MOBILE: +91 9840056343