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AN OVERVIEW OF THE TRADEMARKS ACT, 1999

Prior to statutory enactment of regulations governing trademark law and practice in India, the proprietary rights vested in a trademark were protected through common law principles and principles of equity. Majority of Indian Laws owe their origin to English Laws which were substantially subsumed while formulating Laws for the Indian subcontinent prior to Independence. The passing of the English Act, 1875, which provided for the protection of trademarks in England prompted passing of a similar Bill in India.¹

India's obligations under the TRIPS Agreement for trademark protection include, inter alia, protection of distinctive marks, recognition of service marks, indefinite periodic renewal of registration, deletion compulsory licenses on trademarks, etc. With the advent of the globalization of commerce, brand names, trade names, brands, etc., have achieved immense value which requires uniform minimum standards of protection and effective enforcement procedures, as has been recognized in the TRIPS Agreement. In this context, a thorough review and subsequent repeal of the old Indian Trade and Trademarks Act 1958 was carried out and the new Trademarks Act 1999 was enacted. The said 1999 law, with subsequent amendments, conforms to the TRIPS Agreement and conforms to international systems and practices.

The Trademark Act, 1999 under Section 2 (zb) defines “trade mark” as *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 colors.*

Furthermore, the Act also provided for definition of ‘mark’ under Section 2(m) which *enumerates a mark to include a device, brand, heading, label, ticket, name, signature, word,*

letter, numeral, shape of goods, packaging or combination of colors or any combination thereof.

¹ Iyngar's Commentary on Trade Marks Act; Fifth Edition



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ESSENTIAL FEATURES OF A TRADEMARK

World over the concept of trade marks is more or less uniform. It has two basic characteristics that is

- ✓ it must be distinctive; and
- ✓ it must not be deceptive.

The Trade Marks Act provides, inter alia, for registration of service marks, filing of multiclass applications, increasing the term of registration of a trademark to ten years as well as recognition of the concept of well-known marks, etc.

The Indian judiciary has been proactive in the protection of trademarks, and it has extended the protection under the trademarks law to Domain Names as demonstrated in landmark cases of *Tata Sons Ltd. v Manu Kosuri & Ors*² and *Yahoo Inc. v Akash Arora*³

Definitions and Interpretation

- ‘Assignment’ means an assignment in writing by act of the parties concerned;
- ‘associated trademarks’ means trademarks deemed to be, or required to be, registered as associated trademarks under this Act;
- ‘certification trade mark’ means a mark capable of distinguishing the goods or services in connection with which it is used in the course of trade which are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics from goods or services not so certified and registrable.
- ‘collective mark’ means a trade mark distinguishing the goods or services of members of an association of persons.
- ‘register’ means the Register of Trade Marks referred to in sub-section (1) of section 6
- ‘registered trade mark’ means a trade mark which is actually on the register and remaining in force;

² [90 (2001) DLT 659]

³ [1999 PTC 201].

- ‘registered user’ means a person who is for the time being registered as such under section 49;
- ‘Registrar’ means the Registrar of Trade Marks referred to in section 3;
- ‘Service’ means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters
- ‘trade description’ means any description, statement or other indication, direct or indirect,—

(i) as to the number, quantity, measure, gauge or weight of any goods; or

(ii) as to the standard of quality of any goods or services according to a classification commonly used or recognised in the trade; or

(iii) as to fitness for the purpose, strength, performance or behaviour of any goods, being drug as defined in the Drugs and Cosmetics Act, 1940 (23 of 1940), or —food as defined in the Prevention of Food Adulteration Act, 1954 (37 of 1954); or

(iv) as to the place or country in which or the time at which any goods or services were made, produced or provided, as the case may be; or

(v) as to the name and address or other indication of the identity of the manufacturer or of the person providing the services or of the person for whom the goods are manufactured or services are provided; or

(vi) as to the mode of manufacture or producing any goods or providing services; or

(vii) as to the material of which any goods are composed; or

(viii) as to any goods being the subject of an existing patent, privilege or copyright,

THE REGISTER AND CONDITIONS FOR REGISTRATION

Section 3 talks about Appointment of Registrar and other officers.—

(1) 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.

(2) 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 he may from time to time authorise them to discharge.

Section 4 states about *Power of Registrar to withdraw or transfer cases, etc.*—Without prejudice to the generality of the provisions of sub-section (2) of section 3, the Registrar may, by order in writing and for reasons to be recorded therein, withdraw any matter pending before an officer appointed under the said sub-section (2) and deal with such matter himself either de novo or from the stage it was so withdrawn or transfer the same to another officer so appointed who may, subject to special directions in the order of transfer, proceed with the matter either de novo or from the stage it was so transferred.

Section 5 explains *Trade Marks Registry and offices thereof.*—

(1) There shall be a trade marks registry and the Trade Marks Registry established under the Trade and Merchandise Marks Act, 1958 (43 of 1958) shall be the Trade Marks Registry under this Act.

(2) The head office of the Trade Marks Registry shall be at such place as the Central Government may specify, and for the purpose of facilitating the registration of trade marks, there may be established at such places as the Central Government may think fit branch offices of the Trade Marks Registry.

(3) The Central Government may, by notification in the Official Gazette, define the territorial limits within which an office of the Trade Marks Registry may exercise its functions.

(4) There shall be a seal of the Trade Marks Registry.

Section 6 discusses about the *Register of Trade Marks.*—

(1) A record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein shall be entered all registered trade marks with the names, addresses and description of the proprietors, notifications of assignment and transmissions, the names, addresses and descriptions of registered users, conditions, limitations and such other matter relating to registered trademarks as may be prescribed.

Section 7- Classification of goods and services.—(1) The Registrar shall classify goods and services, as far as may be, in accordance with the International classification of goods and services for the purposes of registration of trade marks.

Section 8- Publication of alphabetical index.—(1) The Registrar may publish in the prescribed manner an alphabetical index of classification of goods and services referred to in section 7.

Absolute Grounds for Refusal of Trademark Registration

Section 9 of the Trademark Act, 1999 enumerates grounds on which a trademark registration can be absolutely refused. The Act provides that following marks can be refused:

- ✓ Marks that are devoid of any distinctive character;
- ✓ Marks which serve to designate kind, quality, intended purpose, values, geographical origin or the time of production of goods;
- ✓ Marks which have become customary in the current language or in the established practices of trade;

Exception- Aforesaid mark shall not be refused registration if prior to date of trademark application; the mark has acquired distinctive character or is a well-known trademark.

- ✓ Marks that may cause deception or confusion in public;
- ✓ Mark comprises of matter that is likely to religious sentiments any class of people;
- ✓ Mark comprises of scandalous or obscene matter;
- ✓ Mark is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950;
- ✓ If the mark consists of shape of goods which results from the nature of the goods themselves;
- ✓ Mark consists of shape of goods which is necessary to obtain a technical result;

- ✓ Mark gives substantial value to the goods;

Mark devoid of distinctive character

This requirement entails that a trademark should be of a distinctive character. While determining that a mark is distinctive or not, it has to be seen that the mark does not have a direct and close reference to the character and quality of applicant's goods.⁴ In order to ascertain whether one mark is deceptively similar to another it is not necessary to place the two marks side by side to find out if there are any differences. It would be enough if the impugned mark bears such an overall similarity to the registered mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

The Statute does not lay down the term of use that would be sufficient to determine whether a mark has acquired distinctiveness. However, the legal principle regarding the same has been settled through precedents. The Judiciary has rendered conflicting dictums on the extent of use required while proving acquired distinctiveness of a trademark. In the case of Woodlands Travels and Agencies v. K. Vasudeva Rao and anr.⁵, the Madras High Court stated that a mark cannot acquire distinctiveness by using it for just a few days. User for one year prior to application is not sufficient to acquire distinctiveness under Section 9 to qualify for registration under Section 9, the mark should have acquired distinctiveness by long user⁶.

Earlier, in 1961 in the case of Consolidated Foods Corporation v. Brandon and Company Private Ltd.⁷, the Bombay High Court observed that for the purpose of claiming such proprietorship of a mark, it is not necessary that the mark should have been used for considerable length of time. As a matter of fact, a single actual use with intent to continue such use eo instanti confers a right to such mark as a trademark. A mere casual, intermittent or experimental use may be insufficient to show an intention to adopt the mark as a trade mark for specific article or goods. Another noteworthy observation was rendered by the Calcutta High Court in the case of

⁴ Shakti Vikas Sansthan v. Ayurved Vikas Sansthan, 1991 PTC 34 Del

⁵ 2003 (27) PTC 352 Mad

⁶ Sarda Plywood Industries Ltd. v. Deputy Registrar of Trademarks, 2007 (34) PTC 352 (IPAB)

⁷ AIR 1965 Bom 35

*East End Hosiery Mills Pvt. Ltd. v. Agarwal Textile Mills*⁸, wherein the Court stated that there can be no hard and fast rule, that any particular minimum period of time is required to acquire distinctiveness. In some cases the time to acquire distinctiveness may be larger than in others.

However, the Delhi High Court in the case of *ITC Ltd. v. Britannia Industries*⁹ 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.

What is Secondary Significance of a Trademark?

The law stipulates that a trademark which has secured a secondary meaning or secondary significance shall not be refused registration even if it falls within the categories as enumerated under Section 9. It is settled law that in common language words and names cannot be exclusively appropriated by any trader unless and until such trade names have acquired such a great reputation and goodwill in the market that the common language word has assumed a secondary significance. Secondary significance here would mean that other traders in that line of trade acknowledge that such common word has come to denote the goods belonging to a particular trade as observed in *Vijay Kumar Ahuja v. Lalita Ahuja*¹⁰. Even a common language word can be exclusively appropriated by a party as a trade mark if the said word has acquired a secondary significance but in the case of a word which is coined, fancy, new or meaningless the claim to exclusive appropriation is sustainable without the need to prove existence of secondary significance¹¹.

Relative Grounds for Refusal of Trademark Registration

Section 11 provides that a mark shall not be registered:

If the mark causes likelihood of confusion on part of the public i.e. likelihood of association with the earlier trademark;

⁸ AIR 1971 Cal 3

⁹ AIR 1971 Cal 3

¹⁰ 95 (2002) DLT 3

¹¹ Globe Super Parts v. Blue Supra Flame Industries AIR 1986 DELHI 245

If the mark is identical to a well-known trademark in India and use of the later mark may be detrimental to the distinctive character of the well-known trademark;

If the mark's use in India is liable to be prevented by law of passing off or copyright law;

The provision further envisages that where the goods are of different description refusal will not be justified but registration may be refused if the mark is likely to be deceptive or cause confusion.

In the case of *Bloomberg Finance LP v. Prafulla Saklecha & Ors.*¹², the Delhi High Court observed that Section 2(zg) of the Act defines a 'well known trade mark' in relation to any goods or services to mean 'a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or service would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services'.

In the case of *Rolex SA v. Alex Jewellery Pvt. Ltd.*¹³, the Delhi High Court while determining the relevant section of public in the case took into account the advertising done in the media in India since 1947 and particularly in the years immediately preceding the suit. The Court also took note of registrations obtained to hold that relevant section of the public in India had knowledge of the trademark ROLEX in relation to the watches.

In the *Rolex case*, the Court further opined that over the years and very quickly in recent times, the international boundaries are disappearing. With the advent of the internet in the last over ten years it cannot now be said that a trademark which is very well known elsewhere would not be well known here. The test of a well-known trademark in Section 2(zg) is qua the segment of the public which uses such goods.

Section 12 talks about Registration in the case of honest concurrent use-

In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor

¹² 2013(56) PTC 243

¹³ 2014(60)PTC 131

of the trademarks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

Prohibition of registration of names of chemical elements or international non-proprietary names.

Section 13 states that No word—

(a) which is the commonly used and accepted name of any single chemical element or any single chemical compound (as distinguished from a mixture) in respect of a chemical substance or preparation, or

(b) which is declared by the World Health Organisation and notified in the prescribed manner by the Registrar from time to time, as an international non-proprietary name or which is deceptively similar to such name, shall be registered as a trade mark and any such registration shall be deemed for the purpose of section 57 to be an entry made in the register without sufficient cause or an entry wrongly remaining on the register, as the circumstances may require.

Section 15 Registration of parts of trade marks and of trade marks as a series

Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and the part as separate trademarks. Each such separate trade mark shall satisfy all the conditions applying to and have all the incidents of, an independent trade mark. Where a person claiming to be the proprietor of several trade marks in respect of the same or similar goods or services or description of goods or description of services, which, while resembling each other in the material particulars thereof, yet differ in respect of—

(a) statement of the goods or services in relation to which they are respectively used or proposed to be used; or

(b) statement of number, price, quality or names of places; or

(c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or

(d) colour, seeks to register those trade marks, they may be registered as a series in one registration.

Section 16. Registration of trade marks as associated trademarks.—Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods or services is identical with another trade mark which is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may, at any time, require that the trademarks shall be entered on the register as associated trademarks.

Where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration in the name of the same proprietor, in respect of goods and services which are associated with those goods or services, or goods or services of that description, sub-section (1) shall apply as it applies as where there is an identity or near resemblance of marks that are registered, or are the subject of applications for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services.

Where a trade mark and any part thereof are, in accordance with the provisions of sub-section (1) of section 15, registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trademarks.

All trademarks registered in accordance with the provisions of sub-section (3) of section 15 as a series in one registration shall be deemed to be, and shall be registered as, associated trademarks.

On application made in the prescribed manner by the registered proprietor of two or more trademarks registered as associated trademarks, the Registrar may dissolve the association as respects any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark were used by any other person in relation to any of the goods or services or both in respect of which it is registered, and may amend the register accordingly.

Effect of registration of parts of a mark.

- ✓ When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.
- ✓ When a trade mark—

(a) contains any part—

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

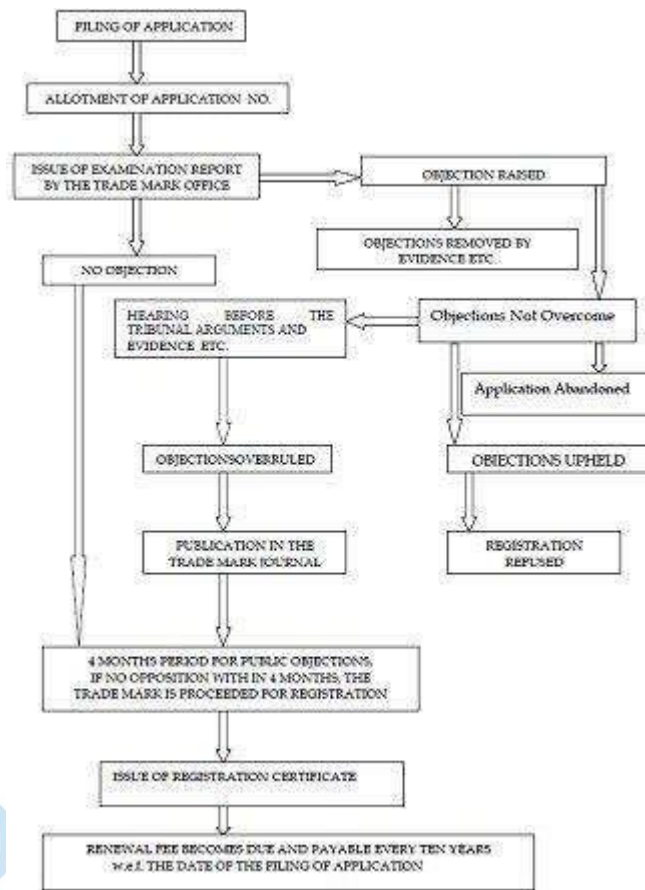
Some of the epoch- making inclusions in the Trademark Act, 1999 include:

- ✓ Provision was made for trademark registration in respect of services in addition to goods;
- ✓ Statutory protection was extended to well-known trademarks;
- ✓ Widened the scope and purview of 'trademark' in India;
- ✓ Provision for registration of 'collective marks';
- ✓ Incorporated provision to prevent use of trademark as a corporate or trade name by third party.

Two essential ingredients for Trademark registration-

- The Mark is Capable of Being Represented graphically- This essential requisite for qualification as a valid trademark merely implies that the mark should be capable of being put on the register in a physical form and also being published in the Journal
- It is capable of Distinguishing Good and Services of One Person From Those of Others- This requisite of a trademark primarily enumerates that a trademark must be distinctive i.e. it should not be devoid of a distinctive character.

PROCEDURE FOR AND DURATION OF REGISTRATION



Section 18- Application for registration.

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar for the registration of his trade mark. A single application may be made for registration of a trade mark for different classes of goods and services and fee payable therefor shall be in respect of each such class of goods or services. Every application shall be filed in the office of the Trade Marks Registry within whose territorial limits the principal place of business in India of the applicant or in the case of joint applicants the principal place of business in India of the applicant whose name is first mentioned in the application as having a place of business in India, is situate:

The Registrar may refuse the application or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit. In the case of a refusal or conditional acceptance of an application, the Registrar shall record in writing the

grounds for such refusal or conditional acceptance and the materials used by him in arriving at his decision.

Section 19- Withdrawal of acceptance

Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied—

(a) that the application has been accepted in error; or

(b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not been accepted.

Section 20- Advertisement of application

When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted together with the conditions or limitations, if any, subject to which it has been accepted, to be advertised in the prescribed manner.

Registration-

- When an application for registration of a trade mark has been accepted and either—

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favor of the applicant, the Registrar shall, unless the Central Government otherwise directs, register the said trade mark within eighteen months of the filing of the application and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall be deemed to be the date of registration. On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof, sealed with the seal of the Trade Marks Registry.

- Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice to the applicant in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice. The Registrar may amend the register or a certificate of registration for the purpose of correcting a clerical error or an obvious mistake.

Section 24 Jointly owned trademarks.—

Nothing in this Act shall authorize the registration of two or more persons who use a trade mark independently, or propose so as to use it, as joint proprietors thereof.

Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

(a) on behalf of both or all of them; or

(b) in relation to an article or service with which both or all of them are connected in the course of trade, those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

Section 25- Duration, renewal, removal and restoration of registration.

- The registration of a trade mark, after the commencement of this Act, shall be for a period of ten years, but may be renewed from time to time in accordance with the provisions of this section.
- The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and subject to payment of the prescribed fee, renew the registration of the trade mark for a period of ten years from the date of expiration of the original registration or of the last renewal of registration.
- At the prescribed time before the expiration of the last registration of a trade mark the Registrar shall send notice in the prescribed manner to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in

that behalf those conditions have not been duly complied with the Registrar may remove the trade mark from the register.

- Where a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar shall, after six months and within one year from the expiration of the last registration of the trade mark, on receipt of an application in the prescribed form and on payment of the prescribed fee, if satisfied that it is just so to do, restore the trade mark to the register and renew the registration of the trade mark either generally or subject to such conditions or limitations as he thinks fit to impose, for a period of ten years from the expiration of the last registration.

Section 26- Effect of removal from register for failure to pay fee for renewal.

- Where a trade mark has been removed from the register for failure to pay the fee for renewal, it shall nevertheless, for the purpose of any application for the registration of another trade mark during one year, next after the date of the removal, be deemed to be a trade mark already on the register, unless the tribunal is satisfied either—
 - that there has been no bona fide trade use of the trade mark which has been removed during the two years immediately preceding its removal; or
 - that no deception or confusion would be likely to arise from the use of the trade mark which is the subject of the application for registration by reason of any previous use of the trade mark which has been removed.

EFFECT OF REGISTRATION

Trademark Passing Off

The Trademark Act, 1999 under Section 27 provides for the remedy of passing off for misuse of an unregistered trademark by the Defendant. It enumerates that no person shall be entitled to institute any proceeding to prevent infringement of an unregistered trademark. The law further entails that the provision shall not affect the rights of action against any person for passing off goods or services as the goods of another person or as services provided by another person, or the remedies in respect thereof.

Section 27 of the Act recognizes common law rights of the trademark owner to take action against any person for passing of goods as the goods of another person or as services provided by another person or remedies thereof. The remedy made available under Section 27 protects the rights of the proprietor of an unregistered trademark to register complaint against another person for passing off his goods as goods the goods of proprietor. An unregistered proprietor of trademark can also oppose an application for registration on grounds as enumerated under Section 11 of the Act.

In *Century Traders v. Roshan Lal Duggar & Co*¹⁴ it was observed that in an action of passing off, the Plaintiff has to establish prior use to secure an injunction and that the registration of the mark or similar mark in point of time, is irrelevant.

The Supreme Court in the case of *Cadila Healthcare Ltd. v. Cadila Pharmaceutical Ltd*¹⁵., laid down the test of passing off and observed that a passing off action depends upon the principle that nobody has a right to represent his goods as the goods of some body. In other words a man is not to sell his goods or services under the pretence that they are those of another person.

As per Lord Diplock in *Erwen Warnink BV v. J.Townend & Sons*¹⁶, the modern tort of passing off has five elements, namely a misrepresentation made by a trader in the course of trade to prospective customers of his or ultimate consumers of goods or services supplied by him which is calculated to injure the business or goodwill of another trade (in the sense that this is a reasonably foreseeable consequence), and which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.

Further in the case of *Corn Products Refining Co. v. Shangrila Food Products Ltd*¹⁷., it was observed that the principle of similarity could not to be very rigidly applied and that if it could be prima facie shown that there was a dishonest intention on the part of the defendant

¹⁴ AIR 1978 Delhi 250

¹⁵ 2007 (35) PTC 95 Del

¹⁶ 1979 (2) AER 927

¹⁷ (1929) 4 RPC 11 (2)

in passing off goods, an injunction should ordinarily follow and the mere delay in bringing the matter to Court was not a ground to defeat the case of the plaintiff.

Section 28 Rights conferred by registration-

The registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

The exclusive right to the use of a trade mark given shall be subject to any conditions and limitations to which the registration is subject.

Where two or more persons are registered proprietors of trade marks, which are identical with or nearly resemble each other, the exclusive right to the use of any of those trademarks shall not be deemed to have been acquired by any one of those persons as against any other of those persons merely by registration of the trademarks but each of those persons has otherwise the same rights as against other persons as he would have if he were the sole registered proprietor.

Trademark Infringement

Section 29 of the Act provides remedy in cases of trademark infringement. The statutory provision also enlists the circumstances under which a mark is infringed:

Infringement of a mark occurs when a person not being registered proprietor uses a mark which is identical or deceptively similar to a registered mark in relation to goods or services in respect of which the trademark is registered.

When a person not being a registered proprietor uses a registered trademark which because of its identity with registered trademark and similarity with goods or services is likely to cause confusion in public.

In Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories¹⁸; when a person not being registered proprietor of a mark uses mark which is identical or similar to the registered trademark in relation to similar goods or services and the registered mark has a reputation in India.

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

A registered trademark is infringed by any advertising of that trademark if such advertising takes unfair advantage and is detrimental to its distinctive character.

When mark adopted by Defendant is identical to Plaintiff's registered trademark

If on comparison of the trademarks of the two parties in case the trademark adopted by the Defendant is identical to that of the Plaintiff, the Plaintiff may not be required to prove anything further. Section 29 of the Trademarks Act, 1999 statutorily mandates so as well. However, when the two marks are not identical, then the plaintiff would be required to establish that the mark used by the defendant so nearly resembles the plaintiff's registered trademark as is likely to deceive or cause confusion in the minds of the consumer public.

The Supreme Court in the case of Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories¹⁹ held that in an action for infringement the onus would be on the Plaintiff to establish that the trade mark used by the defendant in the course of trade in the goods in respect of which his mark is registered, is deceptively similar.

How can the Plaintiff establish that the Defendant's mark is identical or resembles the Plaintiff's mark?

This issue was elaborately discussed by the Delhi High Court in the case of Atlas Cycle Industries Ltd. v. Hind Cycles Limited²⁰, wherein the Court stated that in a case of trademark infringement, the plaintiff may establish that its trademark is identical with or so nearly

¹⁸ 1997 PTC (17)(DB) 779

¹⁹ 1997 PTC (17)(DB) 779

²⁰ ILR 1973 Delhi 393

resembles the plaintiff's work either visually or phonetically or otherwise, that it is likely to deceive or cause confusion in relation to the case in respect of which the plaintiff got his mark registered. Thus, if the essential features of the trade mark of the plaintiff have been adopted by the defendant, the fact that there are some additional features in the defendant's mark which show marked differences is immaterial in an action for infringement.

The Bombay High Court in the case of *Thomas Bear And Sons v. Prayag Narain*,²¹ held that in judging the probability of deception, the test is not whether the ignorant the thoughtless, or the incautious purchaser is likely to be misled, but we have to consider the average purchaser buying with ordinary caution.

The Supreme Court's decision in the case of *James Chadwick & Bros. Ltd. v. The National Sewing Thread Co. Ltd.*²² can be regarded as an essential obiter dicta which aided in streamlining the interpretation of trademark infringement law in India. The Court in the case stated that in an action of alleged infringement of a registered trade mark, it has first to be seen whether the impugned mark of the defendant is identical with the registered mark of the plaintiff. If the mark is found to be identical, no further question arises, and it has to be held that there was infringement. If the mark of the defendant is not identical, it has to be seen whether the mark of the defendant is deceptively similar in the sense that it is likely to deceive or cause confusion in relation to goods in respect of which the plaintiff got his mark registered. For that purpose, the two marks have to be compared.

Difference between Trademark Infringement and Passing off

The difference between a passing off action and an action for trademark infringement was expounded by the Delhi High Court in the case of *Cadbury India Limited and Ors. v. Neeraj Food Products*²³ as under:

- ✓ An action for passing off is a common law remedy whereas an action for trademark infringement is a statutory remedy.

²¹ (1940) 42 BOMLR 734

²² 1953 SCR 1028

²³ 2007 (35) PTC 95 Del

- ✓ Passing off action in essence is an action of deceit that is, a passing off by a person of his own goods as those of another whereas in case of infringement, the Plaintiff on account of being registered proprietor of the disputed trademark, claims to have an exclusive right to use the mark in relation to those goods.
- ✓ The use by the defendant of the trademark of the plaintiff may be prerequisite in the case of an action for infringement while it is not an essential feature of an action for passing off.
- ✓ If the essential features of the trademark of the plaintiff have been adopted by the defendant, the fact that the getup, packing and other writing or marks on the goods or on the packets in which the defendant offers his goods for sale show marked differences or indicate clearly a trade origin different from that of a registered proprietor of the mark, would be immaterial for the case of infringement of the trademark. The liability of the defendant for such infringement may be absolute. In the case of passing off, the defendant may escape liability if he can show that the added material is sufficient to distinguish his goods from those of the plaintiff.

The distinction between passing off and infringement was examined by Judge Clauson in the case of Listen Ltd. V. Harley²⁴, wherein he opined that if you are restraining the infringement of a registered mark, you can restrain the man from using the mark; but, restrain him from selling the articles under the label containing that word without clearly distinguishing his goods from the goods of the Plaintiff is quite a different thing.

The Supreme Court in a recent case of S. Syed Mohideen v. P. Sulochana Bai²⁵, stated that passing off right is a broader remedy than that of infringement. This is due to the reason that the passing off doctrine operates on the general principle that no person is entitled to represent his or her business as business of other person. The said action in deceit is maintainable for diverse reasons other than that of registered rights which are allocated rights under the Act.

²⁴ (1929) 4 RPC 11 (2)

²⁵ 2016 (66) PTC 1

SPECIAL PROVISIONS RELATING TO PROTECTION OF TRADE MARKS THROUGH INTERNATIONAL REGISTRATION UNDER THE MADRID PROTOCOL

Application of Act in case of international registration under Madrid Protocol.—These provisions shall apply to international applications and international registrations under the Madrid Protocol.

DEFINITIONS-

- ✓ ‘Application’ in relation to a Contracting State or a Contracting Organisation, means an application made by a person who is a citizen of, or is domiciled in, or has a real and effective industrial or commercial establishment in, that Contracting State or a State which is a member of that Contracting Organisation, as the case may be.
- ✓ ‘basic application’ means an application for the registration of a trade mark filed under section 18 and which is used as a basis for applying for an international registration;
- ✓ ‘basic registration’ means the registration of a trade mark under section 23 and which is used as a basis for applying for an international registration;
- ✓ ‘Common Regulations’ means the Regulations concerning the implementation of the Madrid Protocol;
- ✓ ‘Contracting Organisation’ means a Contracting Party that is an intergovernmental organisation;
- ✓ ‘Contracting Party’ means a Contracting State or Contracting Organisation party to the Madrid Protocol;
- ✓ ‘Contracting State’ means a country party to the Madrid Protocol;
- ✓ ‘International application’ means an application for international registration or for extension of the protection resulting from an international registration to any Contracting Party made under the Madrid Protocol;
- ✓ ‘International registration’ means the registration of a trade mark in the register of the International Bureau effected under the Madrid Protocol;
- ✓ ‘Madrid Agreement’ means the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 14th day of April, 1891, as subsequently revised and amended;

- ✓ 'Madrid Protocol' means the Protocol relating to the Madrid Agreement Concerning the International Registration of Marks adopted at Madrid on the 27th day of June, 1989, as amended from time to time.

Section 36C- Trade Marks Registry to deal with international applications.—Notwithstanding anything contained in sub-section (3) of section 5, an international application shall be dealt with by the head office of the Trade Marks Registry or such branch office of the Registry, as the Central Government may, by notification in the Official Gazette, specify.

Section 36D- International application originating from India.—Where an application for the registration of a trade mark has been made under section 18 or a trade mark has been registered under section 23, the applicant or the registered proprietor may make an international application on the form prescribed by the Common Regulations for international registration of that trade mark.

ASSIGNMENT AND TRANSMISSION

- ❖ *Power of registered proprietor to assign and give receipts.*—The person for the time being entered in the register as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power to assign the trademarks and to give effectual receipts for any consideration for such assignment.
- ❖ *Assignability and transmissibility of registered trademarks.*—Notwithstanding anything in any other law to the contrary, a registered trade mark shall, subject to the provisions of this Chapter, be assignable and transmissible, whether with or without the goodwill of the business concerned and in respect either of all the goods or services in respect of which the trade mark is registered or of some only of those goods or services.
- ❖ *Assignability and transmissibility of unregistered trademarks.*—An unregistered trade mark may be assigned or transmitted with or without the goodwill of the business concerned.
- ❖ *Registration of assignments and transmissions.*— Where a person becomes entitled by

assignment or transmission to a registered trade mark, he shall apply in the prescribed manner to the Registrar to register his title, and the Registrar shall, on receipt of the application, register him as the proprietor of the trade mark in respect of the goods or services in respect of which the assignment or transmission has effect, and shall cause particulars of such assignment or transmission to be entered on the register.

- The Registrar may require the applicant to furnish evidence or further evidence in proof of title only where there is a reasonable doubt about the veracity of any statement or any document furnished.
- Where the validity of an assignment or transmission is in dispute between the parties, the Registrar may refuse to register the assignment or transmission until the rights of the parties have been determined by a competent court and in all other cases the Registrar shall dispose of the application within the prescribed period.
- Until an application under sub-section (1) has been filed, the assignment or transmission shall be ineffective against a person acquiring a conflicting interest in or under the registered trade mark without the knowledge of assignment or transmission.

USE OF TRADE MARKS AND REGISTERED USERS

Section 46- Proposed use of trade mark by company to be formed-

No application for the registration of a trade mark in respect of any goods or services shall be refused nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark if the Registrar is satisfied that—

- (a) a company is about to be formed and registered under the Companies Act, 1956 (1 of 1956) and that the applicant intends to assign the trade mark to that company with a view to the use thereof in relation to those goods or services by the company, or
- (b) the proprietor intends it to be used by a person, as a registered user after the registration of the trade mark.

Section 47- Removal from register and imposition of limitations on ground of non-use-

A registered trade mark may be taken off the register in respect of the goods or services in respect of which it is registered on application made in the prescribed manner to the Registrar or the Appellate Board by any person aggrieved on the ground either—

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods or services by him or, in a case to which the provisions of section 46 apply, by the company concerned or the registered user, as the case may be, and that there has, in fact, been no bona fide use of the trade mark in relation to those goods or services by any proprietor thereof for the time being up to a date three months before the date of the application; or

(b) that up to a date three months before the date of the application, a continuous period of five years from the date on which the trade mark is actually entered in the register or longer had elapsed during which the trade mark was registered and during which there was no bona fide use thereof in relation to those goods or services by any proprietor thereof for the time being.

Section 48 Registered users-A person other than the registered proprietor of a trade mark may be registered as a registered user thereof in respect of any or all of the goods or services in respect of which the trade mark is registered. The permitted use of a trade mark shall be deemed to be used by the proprietor thereof, and shall be deemed not to be used by a person other than the proprietor.

Section 49-Registration as registered user.- Where it is proposed that a person should be registered as a registered user of a trade mark, the registered proprietor and the proposed registered user shall jointly apply in writing to the Registrar in the prescribed manner.

RECTIFICATION AND CORRECTION OF THE REGISTER

Section 57 talks about Power to cancel or vary registration and to rectify the register-

- On application made in the prescribed manner to the Appellate Board or to the Registrar by any person aggrieved, the tribunal may make such order as it may think fit for cancelling or varying the registration of a trade mark on the ground of any contravention, or failure to observe a condition entered on the register in relation thereto.

- Any person aggrieved by the absence or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Appellate Board or to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as it may think fit.
- The tribunal may in any proceeding under this section decide any question that may be necessary or expedient to decide in connection with the rectification of the register.
- The tribunal, of its own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any order referred to in sub-section (1) or sub-section (2).
- Any order of the Appellate Board rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly

Section 58 talks about Correction of register.

The Registrar may, on application made in the prescribed manner by the registered proprietor,—

- ✓ correct any error in the name, address or description of the registered proprietor of a trade mark, or any other entry relating to the trade mark;
- ✓ enter any change in the name, address or description of the person who is registered as proprietor of a trade mark;
- ✓ cancel the entry of a trade mark on the register;
- ✓ strike out any goods or classes of goods or services from those in respect of which a trade mark is registered, and may make any consequential amendment or alteration in the certificate of registration, and for that purpose, may require the certificate of registration to be produced to him.

COLLECTIVE MARKS

Section 61 Special provisions for collective marks- In relation to a collective mark the reference in clause (zb) of sub-section (1) of section 2 to distinguishing the goods or services of one person from those of others shall be construed as a reference to distinguishing the goods or services of members of an association of persons which is the proprietor of the mark from those of others.

Section 62. Collective mark not to be misleading as to character or significance.—A collective mark shall not be registered if it is likely to deceive or cause confusion on the part of public in particular if it is likely to be taken to be something other than a collective mark, and in such case the Registrar may require that a mark in respect of which application is made for registration comprise some indication that it is a collective mark.

Section 67. Infringement proceedings by registered proprietor of collective mark.—In a suit for infringement instituted by the registered proprietor of a collective mark as plaintiff the court shall take into account any loss suffered or likely to be suffered by authorised users and may give such directions as it thinks fit as to the extent to which the plaintiff shall hold the proceeds of any pecuniary remedy on behalf of such authorised users.

Section 68 discusses about Additional grounds for removal of registration of collective mark.—The registration of a collective mark may also be removed from the register on the ground—

- (a) that the manner in which the collective mark has been used by the proprietor or authorized user has caused it to become liable to mislead the public as a collective mark; or
- (b) that the proprietor has failed to observe, or to secure the observance of the regulations governing the use of the mark.

CERTIFICATION TRADE MARKS

Section 70 states about Registration of certification trademarks.

It states that a mark shall not be registrable as a certification trade mark in the name of a person who carries on a trade in goods of the kind certified or a trade of the provision of services of the kind certified.

Applications for registration of certification trademarks.—An application for the registration of a mark as a certification trade mark shall be made to the Registrar in the prescribed manner by the person proposed to be registered as the proprietor thereof, and accompanied by a draft for the regulations to be deposited under section 74.

Section 74 explains Filing of regulations governing use of a certification trade mark.-

There shall be filed at the Trade Marks Registry in respect of every mark registered as a certification trade mark regulations for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods or services and to authorise the use of the certification trade mark, and may contain any other provisions which the Registrar may by general or special order, require or permit to be inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the certification trade mark in accordance with the regulations); and regulations so filed shall be open to inspection in like manner as the register as provided in section 148.

(2) The regulations so filed may, on the application of the registered proprietor, be altered by the Registrar.

(3) The Registrar may cause such application to be advertised in any case where it appears to him expedient so to do, and where he does so, if within the time specified in the advertisement any person gives notice of opposition to the application, the Registrar shall not decide the matter without giving the parties an opportunity of being heard.

Section 75. Infringement of certification trademarks.—The right conferred by section 78 is infringed by any person who, not being the registered proprietor of the certification trade mark or a person authorized by him in that behalf under the regulations filed under section 74, using it in accordance therewith, uses in the course of trade, a mark, which is identical with, or deceptively similar to the certification trade mark. in relation to any goods or services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken as being a use as a trade mark.

Section 77- Cancellation or varying of registration of certification trademarks.—The Registrar may, on the application in the prescribed manner of any person aggrieved and after giving the proprietor an opportunity of opposing the application, make such order as he thinks fit for expunging or varying any entry in the register to a certification trade mark, or for varying the regulations, on any of the following grounds, namely:—

- (a) that the proprietor is no longer competent, in the case of any of the goods or services in respect of which the mark is registered, to certify those goods or services;
- (b) that the proprietor has failed to observe any provisions of the regulations to be observed on his part;
- (c) that it is no longer to the public advantage that the mark should remain registered;
- (d) that it is requisite for the public advantage that if the mark remains registered, the regulations should be varied.

78. *Rights conferred by registration of certification trademarks.*— Subject to the provisions of sections 34, 35 and 76, the registration of a person as a proprietor of certification trade mark in respect of any goods or services shall, if valid, give to that person the exclusive right to the use of the mark in relation to those goods or services.

(2) The exclusive right to the use of a certification trade mark given under sub-section (1) shall be subject to any conditions and limitations to which the registration is subject.

APPELLATE BOARD

Composition of Appellate Board

The Appellate Board shall consist of a Chairman, Vice chairman and number of other Members, as the Central Government may deem fit. The jurisdiction, powers and authority of the Appellate Board may exercised by Benches thereof. A bench shall consist of one Judicial Member and one Technical Member. They shall sit at a place specified by notification made by central government in the official Gazette. The Chairman may-

- ✓ discharge the functions of the Judicial Member or Technical Member of the Bench to which he so appointed. Chairman can also discharge the functions of the Judicial Member or the Technical Member for any other bench.
- ✓ transfer a Member from one Bench to another Bench.
- ✓ authorize the Vice chairman, the Judicial Member or the Technical Member appointed to one Bench to discharge also the functions of the Judicial Member or the Technical Member of another Bench.

The Central Government may by notifying from time to time, make provisions as to the distribution of the powers of the Appellate Board amongst the Benches. Central government may also specify the matters to be handled by each of the benches. If any question arises as to whether any matter falls within the powers of a Bench, the decision of the Chairman shall be final.

If the Members of a Bench have different opinions on any point. Then they shall state the point of difference. They shall also make a reference to the Chairman. The Chairman shall either hear the points or refer the case for hearing on such point or points by one or more of the other Members and such point or points shall be decided according to the opinion of the majority of the Members who have heard the case, including those who first heard it.

Qualifications for appointments as Chairman, Vice-Chairman, or other Member

1) A person shall not be qualified for appointment as the Chairman unless he –

- ✓ is, or has been, a Judge of a High Court, or
- ✓ has held the office of a Vice-Chairman for at least two years.

(2) A person shall qualify for appointment as the Vice-Chairman, if he-

- ✓ has held the office of a Judicial Member or a Technical Member for at least two years, or
- ✓ has acted as a member of the Indian Legal Services and
- ✓ also has held a post in Grade 1 of that Service or any higher post for at least five years.

(3) A person shall qualify for appointment as a Judicial Member, if he has-

- ✓ acted as a member of the Indian Legal Service and
- ✓ held the post in Grade 1 of that Service for at least three years,
- ✓ held a civil judicial office for at least ten years.

(4) A person shall qualify for appointment as a Technical Member, if he or she has practiced as an advocate of a proven specialized experience in trade mark law for at least ten years,

(5) The President of India shall appoint the Chairman, Vice-Chairman and every other Member.

(6) If the Members of a Bench differ in opinion on any point, they shall state the point or points on which they differ, and make a reference to the Chairman who shall either hear the points

himself or refer the case for hearing on such point or points by one or more of the other Members and such point or points shall be decided according to the opinion of the majority of the Members who have heard the case, including those who first heard it.

Penalty For Applying For An Unauthorized Trademark

An individual is considered to be applying for a trademark wrongfully if:

- ✓ Falsifies any trademark.
- ✓ Maliciously applies to products or services.
- ✓ Produces or disposes of or has in their possession, any dye, block, machine or any other instrument for the sole purpose of falsifying.
- ✓ Application of any incorrect trade descriptions to products or services.
- ✓ Applies to any products which were a prime indication of the country or place in which they were particularly produced or the name and address of the manufacturer or individual for whom the products are manufactured is necessary to apply.
- ✓ Any kind of tampering or alteration is an indication of the original which is applied to any other product.

In case of any of the above offences, an individual is punishable with imprisonment for a time period of minimum six months which can also extend to three years with an additional fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees.

Penalty For Selling Products or Services with Unauthorized Trademark

Any individual who either sells products or services through an unauthorized trademark or false trade details is considered to be a punishable act with imprisonment for a term of not less than six months and up to three years. A fine of fifty thousand to a maximum amount of two lakh rupees.

However, an individual can be safe from being punished if he/she proves that they have taken all possible precautions against committing an offence and while committing the offence they were not aware of the original and had no reason to suspect the genuineness of the applied trademark. In accordance with the law and on behalf of the prosecutor, they shall give all the information in

their control with regard to the person from whom they obtained any such products or services. Or that, he/she otherwise had acted innocently.

Incorrectly Representing The Trademark As Registered

If an individual for any reason falsely represents an unregistered trademark as registered in regard to any products or services; then he/she by law is punishable with imprisonment for a term which may extend to three years or with fine, or both.

Penalty for improperly describing a place of business as connected with the Trade Marks Office.

If any person uses on his place of business, or on any document issued by him, or otherwise, words which would reasonably lead to the belief that his place of business is, or is officially connected with, the Trade Marks Office, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

Penalty for falsification of entries in the register

If any person makes, or causes to be made, a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or produces or tenders or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be punishable with imprisonment for a term which may extend to two years, or with fine, or with both.

DOMAIN NAME DISPUTES AND CYBER-SQUATTING

Cybersquatting is the act of registering a domain name that is same as, or confusingly similar to, the trademark of another with the intention of selling (at a profit) the domain name to the trademark owner.

Definition of cybersquatting can be summarized in Manish Vij v. Indra Chugh²⁶, where the court held : ‘an act of obtaining fraudulent domain name registration with an intent to sell the domain name to the lawful owner of the name at a premium.

²⁶ AIR 2002 Del 243

In *Rediff Communication v. Cyberbooth and Anr*²⁷. plaintiff, Rediff Communication Limited was an on line media company carrying on the business of communication and providing services through the internet since 6th January 1997. On 8th February 1997, Plaintiff registered the domain name 'REDIFF.COM', with Network Solutions, Inc. In March, 1999, Plaintiff learnt that the Defendants have obtained registered the domain name 'RADIFF. COM.' Plaintiff filed a suit for permanent injunction restraining the Defendants from using the mark/domain name 'RADIFF' or any other similar name as to pass off or enable others to pass off their business or goods or services as for the business or goods or services of the Plaintiff. The court is prima facie satisfied that the only object in adopting the domain name 'RADIFF' was to trade upon the reputation of the Plaintiff's domain name. The argument that the field of activity is different is also without any substance as the field of activity of Plaintiff and the Defendants is clearly similar and overlapping. A domain name is more than an Internet address and is entitled to the equal protection as trade mark.

Uniform Domain Name Dispute Resolution Policy of ICANN (UDRP)

Uniform Domain Name Dispute Resolution policy (UDRP) was adopted on 24th October, 1999 by ICANN realizing the potential threat presented by Cybersquatting. The policy offers an expedited administrative proceeding for trademark holders to contest abusive registrations of domain names, which may result in the cancellation, suspension or transfer of a domain name by the registrar.

Under the UDRP, a complainant is required to file a complaint with a "Dispute resolution Service Provider" approved by ICANN. Currently, the World Intellectual Property Organization (WIPO), the National Arbitration Forum (NAF), the CPR Institute for Dispute Resolution, Asian Domain Name Dispute resolution Center (ADNDRC) and eResolution Consortium are the only authorized providers. Each of these providers in turn has their own set of supplemental rules which have to be adhered to by a complainant who opts for that particular provider.

The policy applies to registrations in the .com, .net and .org categories and is incorporated by reference into the registration agreement that the registrant had with the registrar at the time of registering its domain name. By virtue of the incorporation of the UDRP into the registration

²⁷ AIR 2000 Bombay 27

agreement, the registrants submits itself to the jurisdiction of the approved dispute settlement resolution provides and binds itself to the UDRP.

CONCLUSION

Hence to encapsulate, when a person gets his trade mark registered, he acquires valuable rights by reason of such registration. Registration of his trade mark gives him the exclusive right to the use of the trade mark in connection with the goods in respect of which it is registered and if there is any invasion of this right by any other person using a mark which is the same or deceptively similar to his trade mark, he can protect his trade mark by an action for infringement in which he can obtain injunction, damages or an account of profit made by the other person. The purpose of the Act is, thus, to protect the interest of the proprietors of the registered trademarks and the rights and duties created in relation to the rights of individual owners. The entire Trademarks Act, 1999 eliminates the inconvenient provisions of the old act and of course has fostered the rights of the traders and other service providers significantly. Also, the Act is a consolidated effort to bring the law at par with International practices. It is a kind of a warning to the infringers. It can be rightly said that this Act caters to the developments in trading and commercial practices, increasing globalization of trade and industry, the need to encourage investment flows and transfers of technology, need for simplification and harmonization of trademark management systems which further gives effect to relevant judicial decisions.

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