

A
SEMINAR ON
INTELLECTUAL PROPERTY
RIGHTS: RELATING TO
TRADEMARK



RESOURCE PERSON:

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ORGANISED BY:

IQAC
PATTAMUNDAI COLLEGE
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REPORT

A seminar was organised by IQAC, Pattamundai College, Pattamundai on 22.02.2021 on the topic "**Intellectual Property Rights: Relating to Trademarks**". The resource person of the seminar was Dr.Chiranjibi Panda, Associate Professor in Law, Dinabandhu Sahu Law College, Kendrapara. Prof Rabindra Kumar Panda, Reader in History of the college chaired the seminar. Dr. D. Parida, HOD Chemistry and Co-ordinator IQAC gave a key note address on the topic and welcomed the guests on the dais and the participants. Dr. Panda presented his views about various aspects of property rights and its relation to trademarks. 69 no. of students from various departments were participated in the seminar. The meeting was ended with a vote of thanks by Mr. Arabinda Pandab, HOD Department of Mathematics.

Dusharan Prady
22/02/2021

IQAC Coordinator
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Trademark Infringement In India - What is it, Types, Penalties for Infringement

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Introduction

Trademark rights in India are statutorily protected by the Trademark Act, 1999 and also under the common law remedy of passing off. The administration of such protection under the Act is done by the Controller General of Patents, Designs and Trademarks. The Trademark Act, 1999 deals with the protection, registration and prevention of fraudulent use of trademarks. It also deals with the rights of the holder of the trademark, penalties for infringement, remedies for the damaged as well as modes of transference of the trademark.

- ✓ Trademark is defined in the Trademark Act, 1999 as, "*trademark 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 the shape of goods, their packaging and combination of colours.*" Such a mark may include numerous things such as signatures, names, labels, headings etc.

A trademark identifies the brand owner of a particular product or service. Trademarks can be used by others under licensing agreements; for example, Bullyland obtained a license to produce Smurf figurines; the Lego Group purchased a license from Lucasfilm to be allowed to launch Lego Star Wars; TT Toys Toys is a manufacturer of licensed ride-on replica cars for children.^[6] The unauthorized usage of trademarks by producing and trading counterfeit consumer goods is known as brand piracy.

The owner of a trademark may pursue legal action against trademark infringement. Most countries require formal registration of a trademark as a precondition for pursuing this type of action. The United States, Canada, and other countries also recognize common law trademark rights, which means action can be taken to protect any unregistered trademark if it is in use. Still, common law trademarks offer to the holder, in general, less legal protection than registered trademarks.

The essential function of a trademark is to exclusively identify the source or origin of products or services, so a trademark, properly called, indicates the source or serves as a badge of origin. In other words, trademarks serve to identify a particular entity as the source of goods or services. The use of a trademark in this way is known as trademark use. Certain exclusive rights attach to a registered mark.

Trademarks are used not only by businesses but also by noncommercial organizations and religions to protect their identity and goodwill associated with their name.^{[9][10][11]}

Trademark rights generally arise out of the use of, or to maintain exclusive rights over, that sign about certain products or services, assuming there are no other trademark objections.

Different goods and services have been classified by the International (Nice) Classification of Goods and Services into 45 Trademark Classes (1 to 34 cover goods, and 35 to 45 cover services). The idea behind this system is to specify and limit the extension of the intellectual property right by determining which goods or services are covered by the mark, and to unify classification systems around the world.

2. Registration of Trademark

To apply for a trademark a person must adhere to the provisions enlisted under Section 18 of the Act. The Section requires any persons applying for a trademark to apply in writing in the manner that is prescribed for the registration. The application has to contain the name of the mark, goods and services, the class under which goods and services fall, the period of the use of the mark and the personal details of the applicant such as name and address.

4. Classification of Trademarks

Section 7 of the Trademark Act, 1999 requires the classification of trademark according to the international classification of goods and services. There are a total of 45 classes goods and services may fall under in such a classification. The international classification system used is called the Nice Classification (NCL), it was established in 1957 during the Nice Agreement.

According to the NCL, there are 45 classes under which goods and services fall. Classes 1 – 34 are for goods and the classes 35 – 45 are for services. You can find the Nice Classification in this link [here](#)

5. Opposing a Trademark Registration

The members of the public are given the opportunity to oppose the registration of a Trademark during its registration process. The person filing the opposition of registration maybe anyone, it could be a customer, competitor or any member of the public. In the process of registration of a trademark, the mark will be advertised in the Trade Mark Journal, upon this advertisement anyone can file an opposition to it during a period of three months. This period of three months may be extended by no more than one month in special cases. The filing of the opposition has to be done at the Trademark Registrars Office and not at the Intellectual Property Appellate Board (IPAB).

While filing an opposition, one must include the following:

1. Details of the trademark application against which opposition is being filed.
2. Details of the earlier mark that the registering mark is infringing upon. It could be an already registered mark or a mark that is still undergoing its registration.
3. Details of the filing party.

Grounds upon which such opposition is based on.

3. Infringement of Trademark

India being a mixed market, has many industries that operate under the free market concept. The competition in the market system is extreme. For any enterprise to thrive in the open market, they have to create brand recognition and brand value. The simplest way through which this is achieved is via trademarks. The need for trademarks can be considered a three-prong approach to represent goods or services

- Helping consumers recognise the source by:
- Helping consumers determine the quality
- Helping consumers make a purchasing decision

Once such value is attached to the trademark, it is imperative to protect it from misuse and infringement by others.

1. What is Trademark Infringement?
2. Types of Trademark Infringement
3. Penalties for Trademark Infringement

1. What is Trademark Infringement

The Trademarks Act, 1999 (hereinafter referred to as the Act) is the legislation that protects trademarks in India. The Act lays down the rules dealing with registration, protection and penalties against infringement regarding trademarks. Trademarks are given the status of intellectual property across the globe. There are many organisations, both international and national, that endeavour to protect intellectual properties such as trademarks. In India, the organisation that deals with the protection of trademarks are the Indian Patent Office administered by the Controller General of Patents, Designs and Trademarks.

In simple words, trademark infringement is the unauthorised usage of a mark that is identical or deceptively similar to a registered trademark. The term deceptively similar here means that when an average consumer looks at the mark, it is likely to confuse him/her of the origin of the goods or services.

2. Types of Trademark Infringement

When looking into trademark infringement, one must know that there are two types of infringement:

1. Direct

infringement

Direct infringement is defined by Section 29 of the Act. There are a few elements that have to be met for a direct breach to occur; they are as follows:

- **Use by an unauthorised person:** This means that violation of a trademark only happens when the mark is used by a person who is not authorised by the holder of the registered trademark. If the mark is used with the authorisation of the holder of the registered trademark, it does not constitute infringement.
- **Identical or deceptively similar:** The trademark used by the unauthorised person needs to either be identical to that of the registered trademark or deceptively similar to it. The term 'deceptively similar' here only means that the common consumer 'may' be confused between the marks and may think of them being the same. The operational word here being 'may', it only needs to be proven that this is a possibility and does not require proof of actually happening. As long as there is a chance of misrecognition of the marks, it is enough for proving infringement.
- **Registered trademark:** The Act only extends protection to trademarks that have been registered with the trademark registry of India. In the case of breach of an unregistered mark, the common law of passing off is used to settle disputes. It is a tort law that is used where injury or damage is caused to the goodwill associated with the activities of another person or group of persons.
- **Class of goods or services:** For the infringement of the trademark, the unauthorised use of the mark has to be used for the propagation of goods or services that fall under the same class of the registered trademark.

2. Indirect infringement

Unlike direct infringement, there is no provision in the Act that deals with indirect infringement specifically. This does not mean that there is no liability for indirect infringement. The principle and application of indirect infringement arise from the universal law principle. It holds accountable not only the principal infringer but also anyone that abets, induces that direct offender to infringe.

There are two types of indirect infringement:

- **Vicarious liability:** According to Section 114 of the Act, if a company commits an offence under this Act, then the whole company will be liable. Therefore not only the principal infringer but, every person responsible for the company will be liable for indirect infringement, except for a person who acted in good faith and without knowledge of the infringement. The elements for vicarious liability are:-
 - When the person can control the activities of the principal infringer
 - When the person knows of the infringement and contributes to it
 - When the person may derive financial gains from the infringement

The only exception to vicarious liability of a company for infringement is when the company has acted in good faith and had no idea about the infringement.

- **Contributory infringement:** There are only three basic elements to contributory infringement:-
 - When the person knows of the infringement
 - When the person materially contributes to the direct infringement
 - When the person induces the principal infringer to commit infringement

In the case of contributory infringement, there is no exception as there exists no chance of the contributory infringer to act in good faith.

3. Penalties for Trademark Infringement

In India, the infringement of a trademark is a cognisable offence which means that the infringer may also face criminal charges along with civil charges. It is also not required by the Indian law for the trademark to be registered for the institution of civil or criminal proceedings. As mentioned before this is due to the common law principle of passing off.

In the case of trademark infringement, the court may award the following remedies:

1. Temporary injunction
2. Permanent injunction
3. Damages
4. Account of profits (damages in the amount of the profits gained from the infringement)
5. Destruction of goods using the infringing mark
6. Cost of legal proceedings

In the case of a criminal proceeding, the court dictates the following punishment:

1. Imprisonment for a period not less than six months that may extend to three years
2. A fine that is not less than Rs 50,000 that may extend to Rs 2 lakh

Salient Features Of Trademark Rules, 2017

With effect from 6th March 2017, the new trademark rules came into existence. The intention is to simplify the whole trademark registration process and make it hassle-free and quick. It would in turn is expected to expedite the overall process of trademark administration.

E-filing and addition of email as an important part of address can be seen as an effort to further promote digitization. Along with these some other noteworthy features of the new rules are:

1. **Sound marks are made registrable:** The new trademark rules mentions, "Where an application for the registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in the MP3 format not exceeding thirty seconds' length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations". Such application has to be filed on Form TM – A with the sound in a MP3 format. It is necessary to provide the musical notes in the application.

2. **3D Marks are made registrable:** It includes shape and packaging of goods. This kind of application is also filed in Form TM-A.

The new trademark rules mentions in this regard:

Where the application contains a statement to the effect that the trademark is a three dimensional trademark, the reproduction of the trademark shall consist of a two dimensional Graphic or photographic reproduction as follows, namely:—

i) the reproduction furnished shall consist of three different view of the trademark;

ii) where, the Registrar considers that the reproduction of the trademark furnished by the applicant does not sufficiently show the particulars of the three dimensional trademark, he may call upon the applicant to furnish within two months, up to five further different views of the trademark and a description by words of the trademark;

where the Registrar considers the different views or description of the trademark referred to in clause (ii), still do not sufficiently show the particulars of the three dimensional trademark, he may call upon the applicant to furnish a specimen of the trademark.

3. **E-filing is promoted:** As a token of encouragement a discount of 10% is provided for e-filing. This can be seen as a move to promote digitization and go paperless.

4. **Provisions pertaining to Well-known mark:** As mentioned in Rule 124, any person can make a request to enlist a mark as a well-known mark along with statement of case, evidence and documents. The fee for it is Rs. 1, 00,000. The Department of Industrial Policy and promotion shall now maintain a list of well-known marks. It means that a brand can now apply for being included into this list on form TM-M after payment of fees of Rs 1 lakh. This change in particular may also help to improve the reputation of India's IP system and the country's poor score for protection of famous marks.

5. **Separate Fees structure for an individual/startup/small enterprise and for others:** There is a difference of around 50 % in the official fee structure of individual/startup/small enterprise and others. While for individual/startup/small enterprise fee is 5000 for physical filing and 4500 for e filing, it is 10000 for physical filing and 9000 (for e filing) for others. Here the meaning of Small Enterprise is:

a) in case of an enterprise engaged in the manufacture or production of goods, an enterprise where the investment in plant and machinery does not exceed the limit specified for a medium enterprise under clause (a) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006 (27 of 2006); and

b) In case of an enterprise engaged in providing or rendering of services, an enterprise where the investment in equipment is not more than the limit specified for a medium enterprise under clause (b) of sub-section (1) of section 7 of the Micro, Small and Medium Enterprises Development Act, 2006.

Explanation: "enterprise" means an industrial undertakings or a business concern or any other establishment, by whatever name called, engaged in the manufacture or production of goods in any manner pertain to any industry specified in the first schedule to the Industries (Development and Regulation) Act, 1951 (65 of 1951) or engages in providing or rendering or any services or services in such an industry.

Small Manufacturing Enterprises: The investment in plant and machinery is more than twenty five lakh rupees but does not exceed rupees 5 crores (Rupees five crores only).

Medium Manufacturing Enterprises: The investment in plant and machinery is more than rupees 5 crores but not exceeding Rs.10 crores (Rupees ten crores only).

Small Service Enterprises: The investment in equipment is more than 10 (Ten lakh rupees) but does not exceeds rupees 2 crores

Medium Service Enterprises: The investment in equipment is more than rupees 2 crores but does not exceed rupees 5 crores.

Indian applicants need to furnish their financial statements in order to claim their entity status

"Startup" means

i) an entity in India recognized as a startup by the competent authority under Startup India initiative,

ii) In case of a foreign entity, an entity fulfilling the criteria for turnover and period of incorporation / registration as per Startup India Initiative and submitting declaration to that effect.

Explanation: In calculating the turnover, reference rates of foreign currency of Reserve Bank of India shall prevail.

An entity will be identified as a startup:

I) Till up to five years from the date of incorporation.

II) If its turnover does not exceed 25 crores in the last five financial years.

III) It is working towards innovation, development, deployment, and commercialization of new products, processes, or services driven by technology or intellectual property.

Seminar on "Intellectual Property Rights Relating to Trademarks"

Organised by IQAC(22-02-2021)

PATTAMUNDAI COLLEGE, PATTAMUNDAI, KENDRAPARA, ODISHA

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2	Subhrangi ^{Sirupa} Meharana	BC19-020	Subhrangi Sirupa Meharana
3	Pritisha Panda	BA19-027	Pritisha Panda.
4	Ananya Tripathy	BA19-077	Ananya Tripathy
5	Sonali Priyadarshan Parida	BSC(B)19-122	Sonali priyadarshan parida
6	Gayatri Jena	BSC(B)19-091	Gayatri Jena
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8	Priyatama Parida	BC19-109	Priyatama Parida
9	Sushree Rajashree Borik	BA19-246	Sushree Rajashree Borik
10	Suvasini Sureshita Das	BA19-194	Suvasini Sureshita Das
11	Keishna Nayak	BA19-185	Keishna NAYAK.
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13	Biswapriya Sahoo	BA19-007	biswapriya sahoon
14	Amisha Panda	BS-19-019	Amisha Panda
15	Smruti Rekha Das	BS-19-105	Smruti Rekha Das
16	Bhagya Shree Rout	BS-19-111	Bhagya shree Rout.
17	Ashwinyanandini Pradhan	BS-19-085	Ashwinyanandini Pradhan.
18	Lipsa Sahoo	BA-19-068	Lipsa Sahoo
19	Subhasmita Sahoo	BA-19-063	Subhasmita Sahoo
20	Preetinibedita Pradhan	BA-19-022	Preetinibedita Pradhan
21	Sangita Behera	BA-19-153	Sangita Behera
22	Sushree Suchitra Das	BS(B)19-112	Sushree Suchitra Das
23	Lisa Malik	BA-19-105	Lisa malik
24	Sourhamitra Das	BA-19-47	Sourhamitra Das
25	Pranati Nayak	BA-20-88	Pranati Nayak
26	Ankita Sahoo	BA-20-87	Ankita Sahoo
27	Subhasmita Nayak	BA-18-113	Subhasmita Nayak
28	Sangita Sarangi	BA-18-009	Sangita Sarangi
29	Jayshree Nayak	BA-18-128	Jayshree Nayak.
30	Archana Bai	BA-18-038	Archana Bai
31	Sasmita Senapati	BA-19-025	Sasmita Senapati
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36	Sudhisudha Mishra	BS(P) 19-014	Sudhisudha Mishra
37	Asima Nath	Bcp)-19-30	Asima Nath.
38	Subhashree Khuntia	BSCP)-19-108	Subhashree Khuntia
39	Sruvidheepa Nayak	BS(B)-19-106	Sruvidheepa Nayak.
40	Shivamita Debata	BS(B)-19-098	Shivamita Debata
41	Suryakanti Bayee	BA-18-014	Suryakanti Bayee
42	Shabini Singh	BA-18-026	Shabini Singh
43	Ransharani Bhojan	BA-18-097	Ransharani Bhojan
44	Kousalya Patel	BA-18-089	Kousalya Patel
45	Madhusmita Tarai	BA-18-095	Madhusmita Tarai
46	Mihishreea Panda	BA-19-252	Mihishreea Panda
47	Subha Smita Nayak	BA-18-123	Subha Smita Nayak
48	Durgasmita Pradhan	BA18-001	Durgasmita Pradhan
49	Namita Padi	BA-18-228	Namita Padi
50	Manaswini Sahoo	BA-18-067	Manaswini Sahoo
51	Soudamini Sahoo	BA-18-187	Soudamini Sahoo
52	Monalisa Biswal	B.com 19-070	Monalisa Biswal
53	Sradhanjali Pali	B.com 19-067	Sradhanjali Pali
54	Kajal Tripathy	B.com 19-074	Kajal Tripathy
55	Mamali Mahakud	B.com 19-033	Mamali Mahakud
56	Saumya Sucharita Panda	B.com 19-032	Saumya Sucharita Panda
57	Pranati Sahoo	BC19-015	Pranati Sahoo
58	Madhusmita Sutar	BA-18-118	Madhusmita Sutar
59	Pratiruti Panda	BA-18-093	Pratiruti Panda
60	Anjana Samal	BA-18-249	Anjana Samal.
61	Tapaswini Pradhan	BA-18-189	Tapaswini Pradhan
62	Nandani Behera	BC-18-126	Nandani Behera
63	Sanali Lenka	BC-18-121	Sanali Lenka
64	Smiti Pragnya Nayak	BA-19-189	Smiti Pragnya Nayak
65	Sradhanjali Samal	BA-19-149	Sradhanjali Samal
66	Tishnu Pradhan	BA-19-102	Tishnu Pradhan
67	Gitanjali Setti	BA-19-249	Gitanjali Setti
68	Seeli Smita Nayak	BA-18-035	Seeli Smita Nayak
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Seminar on "Intellectual Property Rights: Relating to trademarks"

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Organised by Internal Quality Assurance Cell (IQAC)

PATTAMUNAI COLLEGE, PATTAMUNDAI, KENDRAPARA, ODISHA

ATTENDANCE SHEET OF TEACHERS

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1	Ramash Kumar Sahu	Reader in Physics	Ramash Kumar Sahu
2	Dr. Sarat Chandra Das	Reader in English	Dr. S.C. Das
3	Dushman MS	Reader in Chem	Dushman MS
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5	Sarajakanta Nayak	Leet. in English	Sarajakanta Nayak
6	Pitambari Malik	Leet in Chem.	Pitambari Malik
7	Pooja Kumar Das	Leet in Chem.	Pooja Kumar Das
8	Pradyuma Pradhan	Leet in Economic	Pradyuma Pradhan
9	Nirmala Kumar Sahoo	Leet in Math	Nirmala Kumar Sahoo
10	Amrita Mr Das	Reader in DS	Amrita Mr Das

