

UNIT -2

TRADE MARKS

Introduction:

Although there was some use of trademarks or symbols in the Middle East and Far East several centuries ago, contemporary (modern) trademark law can be traced back to use of trademarks during the medieval period in Europe by merchants who sought to distinguish the goods they sold from those sold by others by applying a mark or symbol to their goods. By viewing the mark, purchasers would immediately be able to identify the craftsman that made the goods and make an informed decision about the quality of the material. The use of symbols by medieval craftsmen to distinguish and identify their goods is the direct antecedent for the modern use of trademarks.

Definition of Trademark:

The modern definition of trademark is that *“it is a word, name, symbol, or device or a combination thereof, used by a person [including a business entity], or which a person has a bonafide intention to use, to identify and distinguish his or her goods from those manufactured by others and to indicate the source of those goods.”*

PURPOSE AND FUNCTION OF TRADEMARK

Trademarks perform two critical functions in the marketplace: [1] *they provide assurance that goods are of a certain quality and consistency, and* [2] *they assist consumers in making decisions about the purchase of goods.* The main purpose of trademark is to show the difference about the quality of goods and service **For example:** If a trademark such as NIKE could be counterfeited (imitating) and used by another on inferior merchandise (goods), there would be no incentive for the owners of the NIKE mark to produce high-quality shoes and to expend money establishing consumer recognition of the products offered under the NIKE marks.

Thus, protection of trademarks results in increased competition in the marketplace, with both the producer of goods and services and the consumer as the ultimate beneficiaries. Business benefit because they can reap the rewards of their

investment in developing and marketing a product with one fearing another business will deceive consumer by using the same or a confusingly similar mark for like goods, and consumers benefit because they are able to identify and purchase desired and quality goods.

The value inherent in achieving consumer loyalty to a particular product or service through the maintenance of consistent quality of the products or service offered under a mark is called goodwill.

- ❖ they identify one maker's goods or services and distinguish them from those offered by others
- ❖ They indicate that all goods or services offered under the mark come from a single producer, manufacturer, or "source".
- ❖ They indicate that all goods or services offered under the mark are of consistent quality and
- ❖ They serve as an advertising device so that consumers link a product or service being offered with a mark

TYPES OF MARKS

There are four different types of marks. They are:

1. Trademark
2. Service mark
3. Certification mark
4. Collective mark

Trademark & Service mark

The term trademark thus refers to some physical and tangible good, and service mark refers to an intangible service, in common usage the term *trademark* is often used to refer to marks for both goods and service. The key point in this legal description is that a trademark is a visual mark that may use any combination of letters and imagery to aid a company in differentiating itself from other entities.

The purpose of a trademark is to visually represent a person, company, or product, and trademark should be designed to provide easy and definite recognition. The term **mark** will be used as a synonym for both trademark and service marks. The federal statute ((law) an act passed by a legislative body) governing trademark law, the U.S. Trademark Act (Lanham Act, found at 15 U.S.C 1051 et seq.) itself states that the term mark includes any trademark, service mark, collective mark, or certificate mark.

A Certification mark

A certification mark is a word, name, symbol, device, or combination thereof, used by one person to certify that the goods or services of others have certain features in regard to quality, material, mode of manufacture, or some other characteristic (or that the work done on the goods or services was performed by members of a union or other organization). **For example:** Hallmark, ISO mark and in U.S Underwriters Laboratory seals of approval (*Underwriters Laboratory is the largest and best known independent, not for profit testing laboratory in the world based in Northwood, Illinois, UL conducts safety and quality tests on a broad range of products, from firedoor's to CCTV cameras seals of approval*).

Collective Mark

A collective mark is one used by a collective membership organization, such as a labor union, fraternity, or professional society, to identify that the person displaying the mark is a member of the organization. Thus, the FUTURE FARMERS OF AMERICA and AMERICAN BAR ASSOCIATION marks indicate membership in certain organizations. A company may use several marks

For Example: the word: COCA-COLA, the stylized WAVE DESIGN, and the slogan “THINGS GO BETTER WITH COKE”. All of these marks are used on one product and all are protected by the Coca-Cola Company. On some occasions, companies use house marks to establish recognition in a wide range of products or service.

ACQUISITION OF TRADEMARK RIGHTS

In most foreign countries, trademark rights arise from registering the mark with a governmental entity. The law in the United States is quite different:

trademark rights arise from adoption and *use* of a mark. A person using a mark may have valid and enforceable rights in a mark even though the mark is not registered with the PTO, such an owner will have priority even over a subsequent user who has secured a federal registration for a mark with the PTO. The “use” required to establish trade mark rights is more than token use, it must be public use, while actual sales of products or services are not required, a certain level of presale activity is required. **For example:** *Sales within a company or to personal friends are insufficient to show use, while soliciting [plead for something] and accepting order is usually sufficient to show commercial use.* Thus, a person using a mark may have valid and enforceable rights in a mark even though the mark is not registered with the PTO. Such an owner will have priority even over a subsequent user who has secured a federal registration for a mark with the PTO.

Establishing a date of first use is critical for a trademark owner because priority of trademark rights is measured from this date. If one party first used of mark on September 15, 2015 and another first used a similar mark on October 15, 2015, the prior, or **senior, user** will be able to preclude the **junior user** from using a confusingly similar mark.

For a mark to be registrable, it must be based on use in commerce, meaning the type of commerce that can be regulated by Congress. Generally, the use is based on interstate commerce or commerce between states (although it could be based on commerce between the United State and a foreign country). A purely intrastate use does not provide a basis for federal registration of a mark. A purely intrastate use does not provide a basis for federal registration of a mark. The requirement of interstate (within one state) commerce is satisfied if the goods or services are advertised in more than one state, offered to citizens of more than one state, or offered on the Internet, which is considered use in commerce because it is available to a national audience through the use of telephone lines.

The general rule is that acquisition of trademark rights stem from use, there is one exception to this rule: the **intent-to-use application**. Until 1989, the United States was one of only two countries in the world that required that a mark be in actual use before an owner could file an application to register it.

After an applicant had begun using the mark and then filed an application, the PTO might refuse registration of the mark on the basis it was confusingly similar to a prior mark or was subject to some other defect. The applicant would

then have invested substantial money and time in developing the mark, in using it in commerce, marketing and advertising, and in applying for registration, only to be told the mark was unregistrable. **To remedy this situation**, the Trademark Law Revision Act of 1988 allowed persons to file applications for marks based on a bona fide intent to use the mark in commerce in the future. If the PTO determines the mark is unregistrable, the applicant will not have expended any sums other than the PTO filing fee and can readily file another application for a new mark. Once the mark proceeds to registration, priority is measured from the date the intent-to-use-application was filed, even though that filing date may precede actual use in commerce by more than three years.

Minimal or token use cannot serve as the basis for securing or maintaining a registration, ensuring that an owner does not reserve or “warehouse” a mark by making only sporadic use of it with the intent to block others from using it rather than having a true commercial intent to exploit the mark for sales. The PTO desires to clear its records of unused marks, or “deadwood”, so that such unused marks may be available by others. The use required is “bonafide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark”, 15 U.S.C 1127.

COMMON LAW RIGHTS, FEDERAL REGISTRATION UNDER THE LANHAM ACT, LAWS AND TREATIES GOVERNING TRADEMARKS, AND STATE TRADEMARK RIGHTS

Common Law Rights

The United States, trademark rights arise from use of a mark. It is not necessary to secure permission or registration from any governmental entity to acquire trademark rights. A party who is using a mark without any such governmental registration is said to have a **common law trademark**, it can be enforced in any geographical area in which the mark is used.

Federal Registration

Although there is no requirement that a trademark owner apply for a secure federal registration of mark with the PTO, registration on the PTO’s Principal

Register does offer several advantages:

- ❖ nationwide constructive use effective from the filing date of the application (the public assumed to have notice that the registrant has nationwide priority in the use of its mark as of this date)
- ❖ nationwide notice to the public of an owner's claim to a mark, thereby precluding a later user from claiming it used a mark in good faith in a remote territory and should be able to continue use;
- ❖ the ability to bar importance of goods bearing infringing trademarks
- ❖ the right under the Paris Convention to obtain a registration in various foreign countries based upon the U.S. registration;
- ❖ the right to bring an action in federal court for trademark infringement and recover lost profits, damages, costs, and possibly triple damages and attorney's fees incontestable status of the registration after five years of continuous use subsequent to the registration
- ❖ the right to use the registration symbol with the mark
- ❖ a possible basis to claim priority to an Internet domain name and
- ❖ prima facie (literally, "on its face") evidence of the validity of the registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the mark in connection with the identified goods and services.

Laws and Treaties Governing Trademark

There are several laws and treaties governing trademark, including the following:

Lanham Act The federal statute governing trademark rights is the **Lanham Act** (also called the United States Trademark Act and found at 15 U.S.C § 1051 et seq.), enacted in 1946 and named for Congressman Fritz Garland Lanham (D.Tex.), the then chair of the House Patent Committee (which also proposed legislation relating to trademarks) who introduced the legislation. In addition to providing for federal trademark protection, the Lanham Act also includes statutes prohibiting unfair competition. The Lanham Act has been amended numerous times. Perhaps the most significant amendment occurred with the Trademark Law Revision Act of 1988, which provided the following two critical changes: allowing for a trademark application based on the applicant's intent to use a mark in the

future. Rules of practice and procedure relating to trademarks are found at Title 37 of the Code of Federal Regulation (C.F.R).

North American Free Trade Agreement (NAFTA) came into effect on January 1, 1994, and is adhered to by the United States, Canada, and Mexico. The NAFTA resulted in some changes to U.S. trademark law, primarily with regard to marks that include geographical terms. The NAFTA was built on the success of the Canada-U.S Free Trade Agreement and provided a compliment to Canada's efforts through the WTO agreements by making deeper commitments in some key areas. This agreement has brought economic growth and rising standards of living for people in all three countries.

Madrid Protocol It is a legal basis is the multilateral treaties Madrid (it is a city situated in Spain) Agreement concerning the International Registration of Marks of 1891, as well as the protocol relating to the Madrid Agreement 1989. The Madrid system provides a centrally administered system of obtaining a bundle of trademark registration in separate jurisdiction. The protocol is a filing treaties and not substantive harmonization treaty. It provides a cost-effective and efficient way for trademark holder. It came into existence in 1996. It allows trademark protection for more than sixty countries, including all 25 countries of the European Union.

Trade-Related aspects of Intellectual Property Rights (TRIPS) is an international agreement administered by the World Trade Organization (WTO) that sets down minimum standards for many forms of intellectual property (IP) regulation as applied to nationals of other WTO Members. It was negotiated at the end of the Uruguay Round of the General Agreement on Tariffs and Trade (GATT) in 1994.

The Doha declaration is a WTO statement that clarifies the scope of TRIPS, stating for example that TRIPS can and should be interpreted in light of the goal "to promote access to medicines for all." Specifically, TRIPS requires WTO members to provide copyright rights, covering content producers including performers, producers of sound recordings and broadcasting organizations; geographical indications, including appellations of origin; industrial designs;integrated circuit layout-designs; patents; new plant varieties; trademarks; trade dress; and undisclosed or confidential information. TRIPS also specifies enforcement procedures,remedies, and dispute resolution procedures.

Trademark Law Treaty Implementation Act (TLTIA) effective in late 1998 simplified several requirements relating to trademark registration and maintenance. **For example:** at present, the applicant need only submit one specimen showing how a mark is used rather than three, as was previously required. Additionally, a trademark applicant need no longer state the manner in which the mark is used. Finally, TLTIA established a six month grace period for filing a renewal for a trademark registration.

Federal Trademark Dilution Act The **Federal Trademark Dilution Act of 1995** is a United States federal law which protects famous trademarks from uses that dilute their distinctiveness, even in the absence of any likelihood of confusion or competition. It went into effect on January 16, 1996. This act has been largely supplanted by the Trademark Dilution Revision Act of 2006 (TDRA), signed into law on October 6, 2006.

Anticybersquatting Consumer Protection Act. 15 U.S.C. § 1125(d), is an American law enacted in 1999 that established a cause of action for registering, trafficking in, or using a domain name confusingly similar to, or dilutive of, a trademark or personal name. The law was designed to thwart “cybersquatters” who register Internet domain names containing trademarks with no intention of creating a legitimate web site, but instead plan to sell the domain name to the trademark owner or a third party. Critics of the ACPA complain about the non-global scope of the Act and its potential to restrict free speech, while others dispute these complaints. Before the ACPA was enacted, trademark owners relied heavily on the Federal Trademark Dilution Act (FTDA) to sue domain name registrants. The FTDA was enacted in 1995 in part with the intent to curb domain name abuses. The legislative history of the FTDA specifically mentions that trademark dilution in domain names was a matter of Congressional concern motivating the Act. Senator Leahy stated that “it is my hope that this anti-dilution statute can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others”.

CATEGORIES OF MARKS

Although marks can consist of words, symbols, designs, slogans, or a combination thereof, not every term is protectable. Even among marks that are protectable, some marks are stronger than others. In determining strength of marks, courts recognize several categories of marks. In ascending order of strength and protectability, the five categories are:

- ❖ **A Generic Mark** Generic "marks" are devices which actually name a product and are incapable of functioning as a trademark. Unlike descriptive marks, generic devices will not become a trademark even if they are advertised so heavily that secondary meaning can be proven in the mind of consumers. The rationale for creating the category of generic marks is that no manufacturer or service provider should be given exclusive right to use words that generically identify a product. A valid trademark can become generic if the consuming public misuses the mark sufficiently for the mark to become the generic name for the product. The prime examples of former trademarks that became the generic name for a product are ASPIRIN, XEROX and CELLOPHANE.

- ❖ **A Descriptive mark** (or more properly, "merely descriptive marks") are devices which merely describe the services or goods on which the mark is used. If a device is merely descriptive, it is not a mark at all, since it does not serve to identify the source of the goods or services. No trademark rights are granted to merely descriptive marks. Misdescriptive marks are equally weak. As explained in connection with suggestive marks above, descriptive marks are often difficult to distinguish from suggestive marks. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice can be very difficult. Merely descriptive marks can be registered federally on the Supplemental Register (see the Bit Law discussion on federal registration of trademarks for more information). The descriptive mark will not register in PTO until the consumer links the mark with a single source. That learned association is called **Secondary meaning** or acquired distinctiveness. The PTO assumes

that secondary meaning has been acquired after five years of consecutive and exclusive use of a mark. Secondary meaning can be demonstrated by a significant level of advertising, sales and consumer survey evidence, to prove that when consumers encounter a mark.

For Example: The following imaginary marks could be considered merely descriptive for computer peripherals:

- ✓ FAST BAUD for modems (describing the quickness of the modem);
- ✓ 104 KEY for computer keyboards (describing the number of keys on a keyboard);
- ✓ LIGHT for portable computers (describing the computer's weight); and
- ✓ TUBELESS for computer monitors (even if misdescriptive for a monitor that contains tubes).

- ❖ **A Suggestive mark** are marks that suggest a quality or characteristic of the goods and services. Despite the fact that suggestive marks are not as strong as fanciful or arbitrary marks, suggestive marks are far more common due to the inherent marketing advantage of tying a mark to the product in a customer's mind. Suggestive marks are often difficult to distinguish from descriptive marks (described below), since both are intended to refer to the goods and services in question. Suggestive marks require some imagination, thought, or perception to reach a conclusion as to the nature of the goods. Descriptive marks allow one to reach that conclusion without such imagination, thought or perception. Putting this distinction into practice clearly is one of the most difficult and disputed areas of trademark law.

The following marks can be considered suggestive:

- MICROSOFT (suggestive of software for microcomputers)
- NETSCAPE (suggestive of software which allows traversing the "landscape" of the Internet)
- SILICON GRAPHICS (suggestive of graphic oriented computers)

- ❖ **Arbitrary Marks** An arbitrary mark utilizes a device having a common meaning that has no relation to the goods or services being sold.

Examples of arbitrary marks include:

- ✓ APPLE (for computers)
- ✓ LOTUS (for software)
- ✓ SUN (for computers)
- ✓ CROWN (For Television)

- ❖ **Fanciful Marks** are devices which have been invented for the sole purpose of functioning as a trademark and have no other meaning than acting as a mark. Fanciful marks are considered to be the strongest type of mark. Examples of fanciful marks are: EXXON, KODAK and XEROX.

PROTECTABLE MATTER

Slogans, Letters and Numbers

A word or other groupings of letters is the most common type of mark **For Examples:** APPLE, SILICON, GRAPHICS, NETSCAPE, IBM, NBC. Slogans from advertising campaigns are also used as trademarks. Example slogans which have strong trademark rights attached **For Example:**



Nike

Alphanumeric symbols (letters and numbers) may be protectable as long as they are not merely descriptive. If the numbers or letters describe something about the product or service offered under the mark, however, they will not be registrable unless proof of secondary meaning is shown. Thus, the mark “VT220” for computer hardware peripherals was held merely descriptive and unregistrable because “VT”

Video Terminal and 220 was a mere model number.

Logos and Symbols

Logos are probably the next most common form of mark. A logo can be described as a design which becomes a mark when used in close association with the goods or services being marketed. The logo mark does not need to be elaborate; it need only distinguish goods and services sold under the mark from other goods and services. Examples of logo marks are:

McDonald's double arches:



NBC's peacock style design:



Apple Computer's Apple:



Names of performing Artists

A mark that merely serves to identify an artist or entertainer is not registrable. However, if the owner of the mark has controlled the quality of the goods or services, and the name of the artist or group has been used numerous times on different records (thereby representing an assurance of quality to the public), the name may be registered as a trademark. Thus, GOO GOO DOLLS and BOB BYLAN have been registered for musical sound recordings.

Domain Names

Domain names, for example, *www.ibm.com*, are registrable as trademark or service marks only if they function as an identification of the source of goods and service. Thus, *www.oakwood.com* has been registered for real estate leasing service and *www.eilberg.com* was refused registration because the mark merely indicated the location on the Internet where the applicant's web site appeared and it did not separately identify the applicant's legal services. Another complication with domain name registration is that the PTO has held that businesses that create a web site for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity. Thus, *www.amazon.com* is registered for providing online chat rooms and bulletin boards. It is not registered in connection with offering books or other goods for sale.

Shapes and Containers

A product or container shape can also serve a source identifying function and therefore can be an enforceable trademark. A product or container shape may also be subject to a design patent (see the BitLaw discussion of design patents to see an analysis of the similarities and differences between design patents and trademark protection for product shapes). Historically, trademark protection was not granted to product shapes until the consuming public recognized the shape as indicating the source of the product. In other words, the product shape was required to obtain secondary meaning. However, recent court decisions may mean that an inherently distinctive product shape can be a protectable trademark even before secondary meaning is obtained. Examples of product shapes and configurations that likely enjoy trademark status include: Ex:Coca-cola Bottle.

Trade Dress

Trade dress is the overall commercial image (look and feel) of a product or service that indicates or identifies the source of the product or service and distinguishes it from those of others. It may include the design or configuration of a product; the labeling and packaging of goods; and/or the décor or environment in which services are provided.

Trade dress can consist of such elements as size, shape, color and texture to the extent such elements are not functional In many countries, trade dress is referred to as “get-up” or “product design” Only nonfunctional trade dress can be protected Because trade dress is often protected through the law of unfair competition

Color

The color of an item can also function as a trademark The Supreme Court held in the 1995 case of *Qualitex Co v Jacobson Products Co*, 115 SCt 1300 (1995) that the green-gold color of a dry cleaning press pad can function as a trademark Before this decision, the argument was often made that color alone could not be considered a trademark, since granting trademark status to colors would soon lead to the depletion of the number of colors available for an object

The Court in *Qualitex* rejected arguments based on this depletion theory, reasoning that alternative colors would usually be available for competitors In those cases where alternative colors were not available, courts could deny trademark protection in those circumstances where color depletion may actually occur

Fragrances, Sounds, and Moving Images

A sound can also be a trademark or a service mark The three tone chime of NBC has been registered as a service mark Sound trademarks recently were in the news when Harley-Davidson announced that it was attempting to register the exhaust sound of a Harley- Davidson motorcycle with the US Patent and Trademark Office (USPTO)

Harley-Davidson was reacting to moves by competitors to duplicate the Harley sound in competing motorcycles Hearings in front of the USPTO have been scheduled to determine whether Harley-Davidson can register the sound A fragrance can function as trademark if it is distinctive and not functional

For example: in *In re Clarke*, 17 USPQ2d 1238 (TTAB1990), a floral fragrance was allowed as a trademark for sewing thread and embroidery yarn and was not functional when used in connection with those goods The roar of the MGM lion and Woody Woodpecker’s distinctive laugh are also registered Finally, the Internet has given rise to applications for marks that consist of moving images, such as Microsoft company’s spinning EXPLORER GLOBE

Design and Ornamentation

A design can function as a trademark as long as it is distinctive rather than merely functional or ornamental. Some designs are protected on their own, such as Nike's famous "swoosh" design, the alligator that appears on shirts, and Betty Crocker's spoon. If the design is merely background material, however, and does not create a separate commercial impression, or if it consists solely of some simple geometric shape, such as an oval or square, it cannot be protected without proof of secondary meaning.

For example, the PTO refused registration of two parallel colored bands placed at the top of socks as pure ornamentation. Merely decorative subject matter and pure ornamentation cannot be registered because they do not identify and distinguish goods or services and thus cannot function as trademark.

SELECTING AND EVALUATING A TRADEMARK

Selecting a Mark

The selection of mark occurs in a variety of ways:

- companies hold contests and encourages employees to create a mark for a new product line or service
- Companies engage sophisticated research
- Branding firms that will conduct surveys and create a mark and a logo or design for the company
- There are name creation software programs that help individuals and companies create marks

Once the mark is selected, it must be screened and evaluated for use and registrability, if failed then it leads to wastage in expenditure of time and money in advertising, using, and applying for a mark that is rejected for registration by the PTO or, in the worst case scenario, might subject the owner to damages for trademark infringement and unfair competition.

Reviewing a Proposed Mark

Once a mark is selected, it should be carefully scrutinized to ensure that it will not be excluded from protection under the Lanham Act

Firstly they have check whether the mark contains scandalous (giving offence to moral sensibilities and injurious to reputation)

- Whether consent from a living person will be required,
- Whether the mark is generic,
- Whether it is statutorily protected
- Whether the mark is descriptive of some feature of the goods and services offered under the mark,
- It also see that the mark includes foreign terms
- Many law firms specializing in trademark work use a questionnaire form or data sheet to gather questionnaire form or data sheet to gather basic information from clients about their marks

THE TRADEMARK SEARCH

Scope of search

There are a variety of sources that can be reviewed to locate potentially conflicting marks

There are literally millions of marks registered or applied for at the PTO, and thousands of journals, trade magazines, directories, telephone books, Internet sources, state records, and state trademark registrations that might contain other marks or business names, a computer assisted or online search is the most effective method of searching

Both LEXIS and WESTLAW, the computer-assisted legal research system, offer access to vast databases that may point out conflicts

One of the best known databases is TRADEMARKSCAN product OF Thomson & Thomson

Conducting the trademark search

The trademark searching is a two-step process:

a preliminary search is conducted of the records of the PTO to make a quick determination as to whether the mark may be available or whether there is conflict that would preclude use of the mark It is also called a knockout search

If the results of the preliminary or knockout search indicate a mark may be available, a comprehensive search of other sources (including state trademark records, telephone directories, Internet records, and trade journals) is then conducted

Step One: The Preliminary Search

There are a variety of sources that can be used to conduct an initial trademark search, including online subscription services, CD-ROM, the Patent and Trademark Depository Libraries, and the PTO website search services Following are some resources commonly used for conducting a preliminary search:

Electronic Database and CD-ROM

TRADEMARKSCAN is a database owned by Thomson & Thomson, a renowned trademark search firm, which provides information on all active registered trademarks and service marks The TRADEAMRKSCAN database is primarily used as a quick screening tool to determine the availability of a new mark

DIALOG is another database offered by Thomson & Thomson Its database includes trademarks from the United States plus numerous foreign countries as well as patent and copyright information It provides online training and practice and free practice searching at the following web site:
<http://trainingdialogcom/onlinecourses/trademarks>

SAEGIS is an entire suite of services provided by Thomson & Thomson that allows online worldwide trademark searching as well as searching of domain name registries and websites to locate common law uses of proposed marks

TRADEMARKCOM is an online search service offered by Micro Patent LLC, offering a variety of searchable databases, including federal marks, and common law uses of potentially conflicting marks

LEXIS and WESTLAW, the computer-assisted research system, offer access to vast trademark databases that may disclose potentially conflicting marks

Many law firms subscribe to one or more of these services so they can perform an initial screening search in-house

PTO Web Site : Perhaps the easiest and least expensive way to conduct a very preliminary search is to review the records of the PTO (<http://www.uspto.gov>) and its free public searching called Trademark Electronic Search System (TESS)

Step Two: The Comprehensive Search

A separate professional trademark search firms are existing for the companies when their need of searching the trademark. These companies review the records of the PTO (go through existing and pending application) , review state trademark office records for state trademark registration, and they perform a “common law” search of various journals, directories, press releases, domain names and Internet references to locate unregistered names and mark

These professional search firms can save considerable time and money and more importantly, provide a more thorough search than that which an individual can conduct on his or her own, they also check for identical and phonetically equivalent marks for similar goods and services and will also check for foreign equivalents.

They will charge for the searching of the marks. The report is typically divided into three sections: results gained from reviewing PTO registrations and applications; results gained from reviewing state trademark records; and the common law results

TRADEMARK REGISTRATION PROCESSES

Preparing the application

Once a mark has been selected and evaluated for use and registrability, an application for federal registration of the /mark should be prepared and filed

- An application is provided by PTO
- The name of the applicant
- The citizenship of the applicant
- The address of the applicant
- The address of the applicant
- An identification of the goods and or services offered under the mark
- A drawing of the mark
- A verification or declaration signed by the applicant or agent or attorney
- The application is based on actual use of the mark or the owner's intent to use the mark
- The process of moving an application through the PTO is called prosecution [(law) the institution and conduct of legal proceedings against a defendant for criminal behavior
- The application must be in English
- Electronically filed application are provided by the PTO
- Self application is also be prepared as the letter size (namely 8 ½ inches by 11 inches) paper, typewriter, double-spaced, with margins of at least 1 ½ inches at the left and top of the pages

- The application should be written on only one side of the paper
- The filing and prosecution of trademark application are governed by the TMEP [Trademark Manual of Examination Procedure]
- The PTO introduced an electronic filing system in 1998
- The Trademark Electronic Application System [TEAS] Permits applicants to file numerous documents electronically
- PTO considers the electronically filed document after transmission

The applicant : The mark can be made only by the owner of the mark or, in the case of intent –to-use application, by a person who has a bonafide to use the mark in commerce

Application may be natural persons or business entities such as corporation, partnership, association, unions or other organization

Government entities such as nations, states municipalities and other governmental bodies.

The applicant name must be in correct legal form

- A mark should be identified in the application by the name set forth in its articles of incorporation
- Clients often make mistakes in their corporate names or in the punctuation
- The certificate of registration will issue in the name of the application as set forth in the application
- If the application is a person or business that conducts business under a fictitious [fake] business name, the application will be rejected
- Clients often make mistakes in their corporate names or in the punctuation
- The certificate of registration will issue in the name of the application as set forth in the application

- If the application is a person or business that conducts business under a fictitious [fake] business name, the application will be rejected
- The applicant is a partnership For example: “Balboa Gardens Partnership”, the application should be made by the partnership itself and the state in which the partnership was organized
- A trademark or service mark application is usually filed in the name of one party
- The PTO has been reluctant [unwilling] to accept application by joint applicants
- A joint venture or a partnership cannot be joint applicants

Identification of Goods or Services

The application must identify the goods and/or services offered or to be offered under the mark that is the subject of the application Careful consideration must be given to drafting this part of the application Goods and services are categorized by the PTO into forty-five separate classes, called International Classes because many other nations use this same classification system established by WIPO Until 1973, the PTO used a different classification scheme, called the United States Classification Scheme Each class requires a filing fee of \$335 A detailed listing of the International Classes with numerous examples is found in Chapter 1400 of TMEP, available on the PTO’s web site If a mark is used for more than one class of goods or services, the applicant may either file a combined application, listing all of the goods and services Some attorneys prefer to file separate application believing that a defect in regard to one class of goods or services in a combined application will hold up registration for the mark in all class.

The PTO requires that the identification of goods or services be as clear, accurate and concise as possible Once the application filed, no other item can be added in the process of registration, a separate application should be applied

REGISTRATION

- ✓ A registration will issue about twelve weeks after publication in the official gazette

- ✓ If no notice of opposition is filed to the application
- ✓ For an ITU [Intent-to-Use] application registration will occur after publication in the official Gazette
- ✓ The PTO will issue a certificate of registration for the mark
- ✓ The term of the registration is presently ten years from the date the mark is registered
[for registration issued before November 16, 1989, the term is twenty years]“TM” for
Trademark & SM for service mark

Trade Marks law of India

The Trade Marks Act, 1999 and the Trade Marks Rules, 2002 govern the law relating to Trade Marks in India. The Trade Marks Act, 1999 (TMA) protects the trade marks and their infringement can be challenged by a passing off or/and infringement action. The Act protects a trade mark for goods or services, on the basis of either use or registration or on basis of both elements.

Who can apply for Trademark?

Any person claiming to be the proprietor of a trade mark used or proposed to be used by him may apply in writing in Form TM-1 for registration. The application should contain the trade mark, the goods/services, name and address of applicant and agent (if any) with power of attorney, period of use of the mark and signature. The application should be in English or Hindi. It should be filed at the appropriate office.

Jurisdiction for filing application

A trade mark application should be filed at the appropriate office of the Registry within whose territorial limits, the principal place of business in India of the applicant is situate. In the case of joint applicants, the principal place of business in India of the applicant will be that of the person whose name is first mentioned as having a place of business. If the applicant has no principal place of business in India, he should file the application at that office within whose territorial jurisdiction, the address for service in India given by him is located. No change in the principal place of business in India or in the address for service in India shall affect the jurisdiction of the appropriate office once entered.

Location and Jurisdiction of Trademarks Office

1) Trade Marks Registry, Mumbai (Head Office)
Intellectual Property Bhavan, Near Antop Hill Head Post
Office, S.M. Road , Antop Hill, Mumbai 400037
Tel: 022-2410 1144, 24101177, 24148251, 24112211
Fax: 24120808, 24132295
Jurisdiction: State of Maharashtra, Madhya Pradesh and
Goa.

2) Trade Marks Registry, Delhi
Intellectual Property Bhavan, Plot NO.32, Section 14,
Dwarka, Delhi
Tel. 011-28082915/ 16/17 Fax:
Jurisdiction: State of Jammu & Kashmir, Punjab, Haryana,
Uttar Pradesh, Himachal Pradesh, Union Territory of Delhi
and Chandigarh

3) Trade Marks Registry, Kolkata,
CP-2, Sector V, 5th floor, I.P.Bhavan, Salt Lake, Kolkata-
700091
(Telfax. 033-23677311)
Jurisdiction: State of Arunachal Pradesh, Assam, Bihar,
Orissa, West Bengal, Manipur, Mizoram, Meghalaya,
Sikkim , Tripura and Union Territory of Nagaland, Andamar
& Nicobar Island.

4) Trade Marks Registry, Ahmedabad,
15/27 National Chambers, 1st floor,
Ashram road, Ahmedabad - 380 009.
Tel: 079-26580567
Jurisdiction: The state of Gujarat and Rajasthan and Union
Territory of Damman, Diu, Dadra and Nagar Haveli

5) Trade Marks Registry, Chennai
IP building, GST Road, Guindy
Chennai-600032
Tele: 044-22502041, Fax: 044-22502042
Jurisdiction: The state of Andhra Pradesh, Kerala, Tamil
Nadu, Karnataka and Union Territory of Pondicherry and
Lakshadweep Island.

E-filing of Trademark application

E-filing is the service provided by the Trademark Registry in order to enable customers to apply

for a Trade Mark on-line allowing from the applicant's browser to:

- Complete an electronic application form;
- Provide the associated attachments;
- Complete the necessary payment details

Procedure for e-filing

In order to submit an electronic application form, following steps should be followed -

- 1) Acquire Class 3 Digital Signatures from (n)Code Solutions or Tata Consultancy Services (TCS) or SafeScript from Sify . The Procedure for getting the Digital Signature and the location of their Offices is available at their website.
- 2) For users (Proprietors/Agents or Attorneys), already registered with TMR (Trademark Registry) Office India can complete online registration by providing a desired User ID, their User Type (Proprietor/Agent/Attorney) and User Code.
- 3) For Users who are not registered as Proprietor / Attorney with TMR Office, they can search and fill online form to obtain User code (Party Code).
- 4) Secure Login into the system with created User Id and the Digital Signatures.
- 5) Obtain a New Reference Number for New Application. Use this option when the applicant wants to apply for a new Trademarks Application.
- 6) Update Application Details: Use this option to edit / update the application details along with relevant images and attached documents. Final Submission to TMR-India with Digital Signature is included in this option after which application cannot be edited.

- 7) The Cases which are Digitally Submitted to TMR, India are available for online payment. The applicant can pay for more than one application in a single transaction. Once the payment is realized as confirmed by the Payment Gateway, an acknowledgement receipt for the fees paid is generated by the system indicating the Receipt Number, Application Number and Date of Filing.
- 8) An applicant can also view online History and status of the applications filed by him/her by clicking Status of Filed Application.
- 9) An applicant can also view the online status of e-Payments.