

Guidelines to be followed for a Strong Trade Mark

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Abstract: *Trade Mark plays a crucial role in the Modern Business and Commerce. It gives the required identity to the Goods /Services. It is imperative that these Marks are Non-controversial and incapable of being challenged by other players or competitors. While choosing the Trade Mark (Brand Names) certain guidelines should be kept in mind. Scrupulous Adherence of these guidelines would help an Organization to enjoy the Brand Equity that has been created and accumulated over the years in perpetuity and save considerable costs on Litigation, settlement etc.*

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1. Introduction

Many are under an impression that when a Trade Mark is registered under the Trade Marks Act by the owner would by itself give them the required right and monopoly to exploit such Trade Mark. This is not fully true. Registration of Trade Marks under the respective laws of the country will only act as prima-facie evidence of Registration in view of the Certificate of Registration provided by the authority. There is something more than this. It is necessary to take various safeguards for getting necessary protection and enforcement of the rights. When a Trade Mark is registered under the Trade Marks Law it is necessary to ensure that there are no prior adopters of the registered Trade Mark. It means when a person/organization has not registered its Trade Mark but using the said Trade Mark without registration would have a prior lawful right than the registered owner. Therefore it ought to be ensured that there is no prior adopter(s) of the Trade Mark before usage of the same for commercial application. This is required to ensure that these prior-adopters should not resort to the Process of Law seeking relief in the form of Injunction and other reliefs from the appropriate Courts. In addition the prior adopter of the Unregistered Trade Mark can initiate "Passing-off" Proceedings even when his Trade Mark is not Registered. Whereas a prior adopter who has a Registered Trade Mark can prevent others, from using his registered mark by initiating "Infringement" proceedings against such user.

Mere registration of the Trade Mark alone is not a panacea for the Trade Mark holder to protect himself. Registration or Non-Registration, a Trade Mark Owner should always be vigilant by keeping his eyes and ears open. A Trade Mark derives strength only when the same is put on use. Keeping a Trade Mark, Registered or Unregistered, unused for many years would result in challenges of losing monopoly over the Trade Mark. Thus the strength of a Trade Mark depends on the usage and also taking effective steps in protecting the Trade Mark from its unauthorized usage in any form. If one's Trade Mark is used unauthorizedly or misused or likely to be misused or infringed it is necessary to initiate necessary action immediately for such misuse or unauthorized usage. The remedies available could be either criminal or civil remedies. It is always necessary for anyone to take effective and timely remedies for misuse of such Trade Marks. If that is not done then the bonafide Trade

Mark holder may be denied the required relief on account of laches and delay by the redressal forums and courts.

Section 2 (zb) of the Indian Trade Marks Act, 1999, defines Trade Mark as "trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours". A mark can include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any such combinations. Thus a Trade Mark can be of different kinds not just the words or it combination.

The following guidelines given below serves as a guide for building a Strong Trade Mark for anyone who already uses or want to use Trade Marks or Service Marks for the purposes of their Business.

2. Coined / Distinctive Words

While going for a Trade Mark, it always better to go in for a Coined or a Distinctive Mark. If one chooses to have a common dictionary word, such Trade Marks will already be in existence in the same class or different classes of products. Therefore having a coined distinctive word would always be a better bet in selection of an ideal Trade Mark.

3. Invite Costly Litigation and Loss of time

A Trade Mark which comprises of a Common/Non distinctive/Dictionary/ or any Laudatory Epithet may not give Monopoly over the Mark & could invite costly Litigation. This will force the prior adopter /identical owner to file a case against the present user/owner. This will also bring the existing commercial operations of the new user to standstill due to the prohibitory orders issued by the Courts leading to loss of money.

4. Necessity to have a National or Global Search

It is always necessary to make a National Market Search / Global Market Search to overrule the existence of the proposed Trade Mark before adaptation. This Search will

help to be clear on the Marks already in use and adopt the Marks not in use.

5. Not to use an Identical / Deceptive / Similar / Well Known / Sounding Marks

Though Trade Mark, gives territorial Monopoly, it always important not to use an Identical / Deceptive / Similar / Well Known / Sounding Marks as in existence in any part of the World. By adhering to this rule we will not infringe the rights of others and therefore one will not invite any disputes.

6. Trade March Search in the Trade Marks Registry

It is always necessary that a Legal Trade Mark Search is conducted in the Trade Marks Registry, in the respective / identical classes of the proposed Trade Mark, to overrule its existence. This Trade Marks Registry Search should be in addition to the Market Search already discussed above.

7. Registration of Trade Mark is not mandatory for its usage

Many are under wrong impression that Registration of a Trade Mark is mandatory for usage of a Trade Mark. This is not so. Registration of Trade Mark gives some advantages and the Registration Certificate will act a prima-facie evidence to prove the Registration of the Trade Mark. Similarly Non-Registration does not attach any disadvantages to a Trade Mark.

8. Usage of the Trade Mark is a key to ensure monopoly

The strength of a Trade Mark lies only on usage and its period. Non-use of a Trade Mark over a period of time may make the Trade Mark to lose it Monopoly, notwithstanding its Registration.

9. Renewal of the Registered Trade Mark:

If a Trade Mark is available for adaptation, it is necessary to ensure Usage of the Mark for maintaining its Monopoly and also Registration of the same immediately before the Trade Mark Registry, for extra protection. In the event when a Trade Mark is registered it is necessary that the Registered Mark has to be renewed periodically without fail for maintaining its monopoly by paying the required fees to the Trade Marks Registry.

10. Maintaining a Repository of Archives

To prove the usage of the Trade Mark it is essential to maintain an Archive with respect to its Sales Figures, Advertisement & Publicity Expenses, Press Clippings, Copies of Hoardings, Advertisement, Recordings of Radio & Television Advertisement, Vouchers / Bills of the Trade Mark for ready use in the Legal Proceedings to get a

favorable order and also to defend ourselves when the need arises.

11. Seeking Professional Help

Many think that it is not necessary to consult Lawyers/Experts/Practitioners of Trade Mark and seek Professional Support or Advise in case of Trade Mark Pissues/problem. Such a mindset will put one into greater problem. Therefore it is always better to clarify the Doubts by seeking Professional help or advice from Professionals of Good Standing. If this is missed then the outcome will be sometimes very costly.

12. Future Scope of the Study

The above article brings out the entire gist of Trade Mark practices /requirements that needs to be adhered to have a Rock Solid Trade Mark in their portfolio. Trade Mark Law and Practice is very dynamic in nature. Every day we find new developments that emerge in the Trade, Business and Commerce across the World. There seem to be no boundaries within the Countries and People can access information openly. Newer avenues of Business in the form of Ecommerce and the Cyber Sale have brought new developments in the Trade Mark field like Domain Names, Cybersquatting and Phishing etc. Therefore the Trade Mark Law and Practices will also change in line with those developments. Nevertheless the basic Nitti gritty of the Trade Mark will remain the same.

Author Profile

The Author is a Legal, Chartered/Company Secretary and Management Professional, with over 24 years of Solid Corporate Legal Exposure in diverse industries like Hospitals, Leather, FMCG, Information Technology, BPO, and Cement. Well Conversant with all aspects of Corporate Laws, Indirect Taxation Laws, Labour & Employment Laws, Statutory Regulations / Compliances, IPR Laws, Mergers and Acquisitions, International Customer Contracts end to end management. Experience in Strategic Planning, Legal & Commercial Affairs, Contracts Management, Corporate Re-structuring, Corporate Secretarial Affairs, Litigation Strategy and Management (Both Inland and Overseas), Corporate Affairs, People Management and General Administration. Have a successful history of reducing legal expenses through Compliance /Due-diligence and strategizing, managing outside counsel in litigation matters in hundreds of cases. Continuous Post Acquisition Support to entities so acquired in United Kingdom and United States of America. Successful in Leading various IPR Cases including, Trade Marks, Copy Rights, Patents and Designs both in India and Overseas.