
NEW TYPES OF TRADEMARK ARE SETTING A NEW TREND IN TRADE OR BUSINESS WORLD**Dr. Chandrakanthi.L**

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A trademark is a mark in any form of it like work, phrase, symbol, design, sound, smell, colour, product configuration, letter, number, or combination of the above adopted and used by a company to identify its products or services. Further it distinguishes them from products and services of others. The adoption of the TRIPS agreement has recognized these new trends in the trademark field with their relevance in the modern day business. There are certain marks, which have influenced the present day business, which runs on the basis of the representation made by the associated marks and the reputation and identification gained by those marks. The TRIPS agreement has mandated recognition and protection to these new trends in the trademark field. State parties with two hands welcomed the new trends by offering protection to these marks.

Introduction

A trademark is a mark in any form of it like work, phrase, symbol, design, sound, smell, colour, product configuration, letter, number, or combination of the above adopted and used by a company to identify its products or services. Further it distinguishes them from products and services of others. It means that trademarks are valuable assets of the traders and businessmen as they identify themselves with the goodwill or reputation of the traders and businessmen. As the consumer become familiar with particular trademark, it works as indicator of quality. However, trademark can be categorized with their identification. It is because of the recent past, in which trademark has witnessed with considerable changes. It is important to know about different trends in the field of trademarks which brought up new types of trademarks such as collective marks, certification trademark, service mark, well known trademark and domain name.

An attempt has been made here know about new trends in the trademark and the new and innovative types of trademarks. The adoption of the TRIPS agreement has recognized these new trends in the trademark field with their relevance in the modern day business. There are certain marks, which have influenced the present day business, which runs on the basis of the representation made by the associated marks and the reputation and identification gained by those marks. The TRIPS agreement has mandated recognition and protection to these new trends in the trademark field. State parties with two hands welcomed the new trends by offering protection to these marks. India has made necessary changes in its trademark law to implement the mandate of the TRIPS agreement having ratified it. Therefore, here it is pertinent to know such new types of trademarks recognized all over the world due to innovative and new trends in the field of trademarks.

Collective Marks

Collective mark means a trademark that distinguishes the goods or services of the members of an association of persons not belonging to a partnership firm. The association or the members of the association collectively own mark.¹ A trademark belongs to an individual, but a collective mark belongs to an association of persons not being a partnership firm. The members of the association are authorized to use the mark, governed by certain regulations and rules of the association to ensure certain consistent standards of genuineness and quality of the product concerned. Collective marks are very useful to persons who produce a particular agricultural product like Basmati rice, Alfanso mangoes. Collective marks should satisfy the test of graphical representation, the test of capacity to distinguish and all other requirements, which are applicable to an ordinary trademark.² Collective marks are protected through registration. For registration application must be made in the prescribed form accompanied by the prescribed under the Trademarks Act.

The application should specify the persons authorized to use the mark, conditions with regard to the use of the mark and also the regulations of the association. The Registrar may accept the application along with regulations, either unconditionally or subject to conditions. He may refuse to accept such regulations, which are open for public inspection. As the collective marks come within the scope of trademark, all the infringement provisions of the trademark apply to a collective mark also. Infringement of collective mark is dealt with the same manner as it is done in case of infringement of trademark. Revocation or cancellation of registered collective mark is done in the same way as it is done in the case of ordinary trademark.³ However, two grounds available for the revocation or cancellation of collective marks are: the manner of use has been misleading the public; failure of the proprietor to observe regulations governing the use of the mark.

Textile trademark

A trademark used or proposed to be used in relation to textile goods is called as textile mark.⁴ Usually numerals and letters are used a textile trademarks. Letters or numerals or any combination there of are registerable as textile marks since they have the capacity to distinguish textile goods. The procedure for registration of textile marks is similar to that of an ordinary or regular trademark. While deciding on the application for the registration of a textile mark the Registrar can hold two marks to be similar even if they satisfy the test under the relevant rules. The textile mark should prima facie distinct from other marks. Use of heading is permitted in case of textile trademarks. Here heading means the lines, usually colored, woven or printed at the end of the cloth sold in the piece.

Certification Trademarks

Certification trademark is a mark, which certifies that goods or services on which it is used meet certain very specific standard of quality. It is a mark capable of distinguishing the goods or services certified by the proprietor of the mark with respect to its origin, material used type of manufacturing of goods, kind of performance of services, quality and accuracy.⁵ A mark used by the manufacturer or the service

¹ Introduced in the Trademarks Act, 1999

² Sections 9, 10, 11 of Trademarks Act, 1999

³ Section 63(2) of the Trademarks Act, 1999

⁴ Clauses 22 to 29 of fourth schedule of Trademarks Act, 1999

⁵ Section 2 (1) (e) of Trademarks Act, 1999

provider to certify his goods or services are eligible to be registered and protected.⁶ The proprietor of the mark certifies that goods or services on which it is used possess certain characteristic. As certification mark should be capable of being represented graphically.⁷ The definition of the trademark under the new Trademark Act of India includes certification mark.⁸ Here the proprietor will not use the certification trademark for his own goods; he licenses others to do so. Hence, a certification trademark cannot be registered in the name of person who undertakes on a trade in goods of the kind certified or a trade of the services of the kind certified. For the registration of certification trademarks an application should be made in the prescribed form accompanied by the prescribed fee and the draft of the regulations for its use. The Registrar has to consider the competency of the applicant to certify the goods in respect of which the mark is to be registered.⁹

The Registrar may accept or refuse the application for registration. If he accepts, then he may approve the draft regulation with or without modifications either unconditionally or subject to any conditions or limitations, as he thinks necessary. If the application is accepted, the Registrar shall advertise the claimed shall advertise the claimed mark to invite oppositions if any.¹⁰ The draft regulation of the certified trademark shall contain details with regard to the conditions, which should be satisfied by the proposed user of the mark before seeking certification by the proprietor of the certification mark. Registrar has got power to impose any other conditions on the user, which he deems fit and necessary. Application and regulations are open for public inspection. Any person aggrieved by the registration of certification marks may appeal to the Registrar. The Registrar on the appeal by the aggrieved person may cancel or vary any entry in the register in the following circumstances:

- a. Where the proprietor is no longer competent to certify the goods or services in respect of which the mark is registered;
- b. Where the proprietor has failed to follow the regulations prescribed;
- c. Where the registration is no longer in the public interest;
- d. Where the registration required to be varied in the public interest.

The proprietor of the mark may assign or transfer the certification mark with the consent of the Registrar. Any person who uses the certification mark without the consent of the proprietor infringes the mark. However, the following acts do not constitute infringement of the certification mark:

- ❖ Where the mark is used in any manner beyond the proprietor or in circumstances in which the registration does not extend to;
- ❖ Where the proprietor has consented to the use or the use certified by the proprietor where such use is not contrary to the regulations;
- ❖ Where the use of the mark in relation to goods or services adopted to form part of, or accessories to other goods in relation to which the mark has been used without infringement if the use is reasonably necessary to indicate that the goods are so adopted.

⁶ See chapter IX of Trademarks Act, 1999

⁷ Section 2(1) (2b) (ii) of Trademarks Act, 1999

⁸ Sections 2(1) (m), 9, 10, 11 of Trademarks Act, 1999

⁹ Section 74 of Trademarks Act, 1999

¹⁰ Section 21 of Trademarks Act, 1999

Service Marks

Today marks are not only used with respect to goods manufactured but also the services. Service marks are signs used to identify and distinguish the services of the user with that of the others.¹¹ Service means service of any description made available to potential users in connection with the business such as banking, communication, education, financial insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repairs, conveying of news information and advertising.¹² Service marks are registrable in the same way in which a regular mark is registered. Further protection and enforcement of service marks is also no different with that of regular marks.

Well known Trademarks

Well known trademark¹³ means a mark which has become well known to the substantial segment of the public familiar with a particular type of goods or services for which it is used. The use of such mark in relation to other goods or services 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 person using the mark in relation to the first mentioned goods or services.¹⁴ It is Registrar of trademarks who has got authority to determine whether a mark is a well known mark or not after considering the following:¹⁵

- ❖ The knowledge or recognition of the alleged well known mark in relevant section of the public including knowledge obtained as a result of promotion of the trademark;
- ❖ The duration, extent and geographical area of any use of that trademark;
- ❖ The duration, extent and geographical area of any promotion of the trademark including advertising or publicity and presentation at fairs of exhibition of the goods or services in which the trademark appears;
- ❖ The duration and geographical area of any recognition or any publication for registration of that trademark to the extent they reflect the use or recognition of that trademark;
- ❖ The record of successful enforcement of the rights in that trademark, in particular the extent to which the trademark has been recognized as a well known trademark by the court or registrar under that record;
- ❖ The number of actual or potential consumers of the goods or services;
- ❖ The number of persons involved in the channels of distribution of the goods or services;
- ❖ The business circular dealing with the goods or services to which the trademark applies.

Registrar shall protect a well-known trademark against identical or similar trademark. He has to take into consideration the bad faith involved either on the part of the applicant or on the part of the opponent affecting the right relating to the well-known trademark. A mark does not become well known trademark on the following grounds:

The trademark has been used in India;

¹¹ Originated in the Trademarks Act, 1999

¹² Section 2(1) (2) of Trademarks Act, 1999

¹³ See supra note, 11.

¹⁴ Section 2(1) (zg) of Trademarks Act, 1999

¹⁵ Section 11 (6) to (9) of Trademarks Act, 1999

The trademark has been registered;

The application for registration if the trademark has been filed in India;

The trademark is well known in or has been registered in or respect of which an application for registration has been filed in any jurisdiction countries other than India or

The trademark is well known to the public at large in India.

Domain Names

Modern day commercial organization does like to have its presence felt in the cyber space. Modern day business is marketed through internet and business entities provide online services or information online to the customers. Therefore, there is a need for these organizations to establish their presence in the cyber space, which could be launched after registered the name of the website known as domain name, which will be generally the name of the company or the business. Customers could access the business of any particular entity through these domain names. In the internet or the virtual world the domain names are performing all the functions, which has been previously done by a trademark in the real or physical world. When it comes to the advertising and marketing domain names perform the job on a global basis since internet has got no boundaries and virtually is present everywhere across the world. Domain name is highly capable of distinguishing goods or services of a particular firm or company in internet.

One should not choose domain name only from a marketing standpoint but also from legal perspective to avoid the legal conflicts in the trademark law. Names that identify products or services in the market place could be registered as trademarks.¹⁶ Distinctive trademarks are protected under law.¹⁷ Distinctive words, names and services qualify as trademarks.¹⁸ The first commercial user of a trademark owns it in the case of legal conflict with a later user. One trademark legally conflicts with another when the use of both is likely to confuse customer about the products or services, or their origin.¹⁹ If an infringement is found to exist, the alter user will have to stop using the mark and may even be held liable to the trademark owners for damages.²⁰ Applying these cardinal rules to one's domain name selection, one can loose his chosen domain name if the owner of an existing trademark can prove before judge or arbitrator that the use of the domain name given rise to alike hood of customer confusion. Confusion in this context means the following two different statutes:

- It means that goods, which a customer purchases, are different from the goods, which he originally intended to buy;
- When customers have a wrong impression that a product or service is organized, sponsored. Approved, managed or is having some connection with a business they re quite familiar within other words the customers are confused about source of the product or service.

Domain Name Litigation

¹⁶ Blancowhite, T.A., and Robin Jacob-Kerly's Law of Trademarks and Trade names, (1986), London: Sweet and Maxwell, chp. 1.

¹⁷ Section 9(3) of Trade and Merchandise Marks Act, 1958 defines the term 'distinctive'.

¹⁸ Ibid, section 9(1) stipulates the requisites for registration.

¹⁹ Ibid, section 11(1) prohibits registration of marks which are likely to deceive or cause confusion.

²⁰ Ibid, section 29 (1) deals with infringement.

There is tendency in the domain names field to register the name of the well known or reputed business or commercial undertakings as domain names. Since the business or commercial undertaking prefer to register their names as the domain names to have their presence in the internet they have to purchase the same from the persons who have already registered the same in their names. This tendency of registering the names of the well known commercial undertakings by the persons other than the owners of such commercial undertaking is known as cyber squatting which has become rampant in the contemporary times. In *Cyber Squatter Panavision Int. v. Toeppen , Denis*,²¹ Toeppen registered hundreds of domain names using well known marks of others with the intention of selling or licensing them to the true owners. Toeppen registered the domain name 'Panavision.com' and offered to sell it to Panavision.int for dollars 13,000. The corporation, which owned a federal trademark registration for PANAVISION sued Toeppen for trademark infringement in the internet since Toeppen is using their mark in the internet through registering it has a domain name. It was held in favour of Panavision on the basis that Toeppen's mark. Recently, authorities in India, UK, Taiwan, Italy, Germany and the USA among other jurisdictions have ruled that the act of registered a domain name similar to or identical with a famous trademark amounts unfair competition. In UK, a British court ruled in *Marks and Spencer and Others v. One in a Million*²² that where the value of the domain name consists solely of its resemblance to the trademarks of another the Court can assume the like hood of confusion and unfair competition. It was held that, any account of its similarity to the name, brand name or trademark of an unconnected commercial organization, must expect to find himself in the receiving end of injunction to restrain the threat of passing off and the commercially useless to the dealer. Further the name 'marks and Spencer' could not have been chosen for any other reason than for the reason that it was associated with a well known retailing group.

Besides in *Yahoo.inc v. Akash Arora*²³ and Another defendant launched a website by name yahooindia.com nearly identical to plaintiffs renowned 'yahoo.com' and provided services similar to those of the plaintiff. The plaintiff alleged passing off of services by the defendant by using the domain name yahooindia.com, which is similar to yahoo.com, the domain name of the plaintiffs. The court observed that the service of the plaintiff under the trademark/domain name 'yahoo' have been widely published and written about globally and 'yahooindia' of the defendant are almost similar and there is every possibility and like hood of confusion and deception being caused. Eventually the plaintiffs were granted interim injunction restraining the defendants from using the domain name yahooindia.com. It is very important here to note that when domain names began to conflict with trademarks it gave birth to a new piquant situation. The global community was called upon to resolve the dispute in an amicable manner almost at the same time a non-governmental international organization by name the Internet Corporation for Assigned Names and Numbers (ICANN) was formed to administer the granting and maintenance of domain names. The ICANN is a private sector initiative to assume responsibility for overseeing the technical co-ordination of the Domain Name System.

Conclusion

The new trends in trademarks are recognized as new concepts in the trademark laws. Trademark is essentially a product of competitive economy, where more than one person competed for the manufacture of the same product or providing same kind of service necessitating the marketing of each manufacture or service by a symbol or mark. Today marks have been recognized not only in the goods sectors but also in the service sectors. There also recognized collective marks in respect of collective

²¹ 945 F. Supp. 1296 (CCD Cal 1996) (9th Cir. 1998).

²² (1995 FSR 265).

²³ 78 (1999) Delhi Law Times 285 and (1999) PTC (19) 201.

services or goods produced by an association. Further here recognized certification marks for the purpose of certifying the goods and services with a given quality. There also recognized textile marks meant to be used in the textile sector. On the other hand, well known trademarks are also recognized which are the marks or symbol used in association with a particular type of goods or services generally for a long period and become well known in association with such goods or services. Besides domain names are recognized as the trademark in the internet. In all the above types of trademarks, the trademark law is uniformly applied to offer protection.