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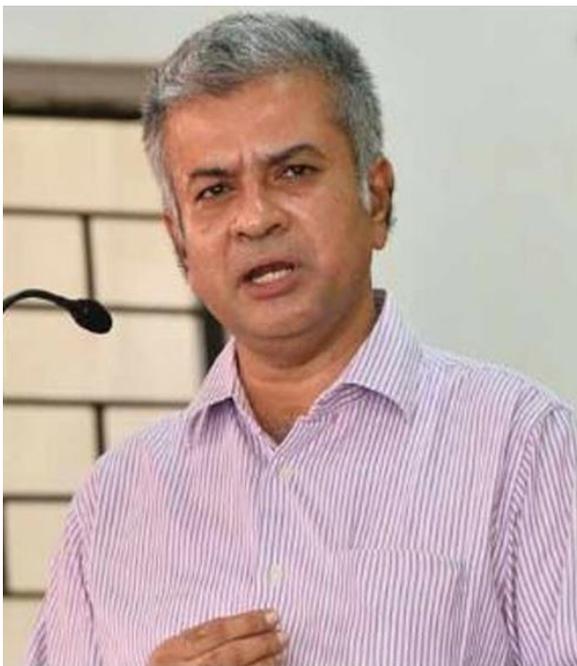
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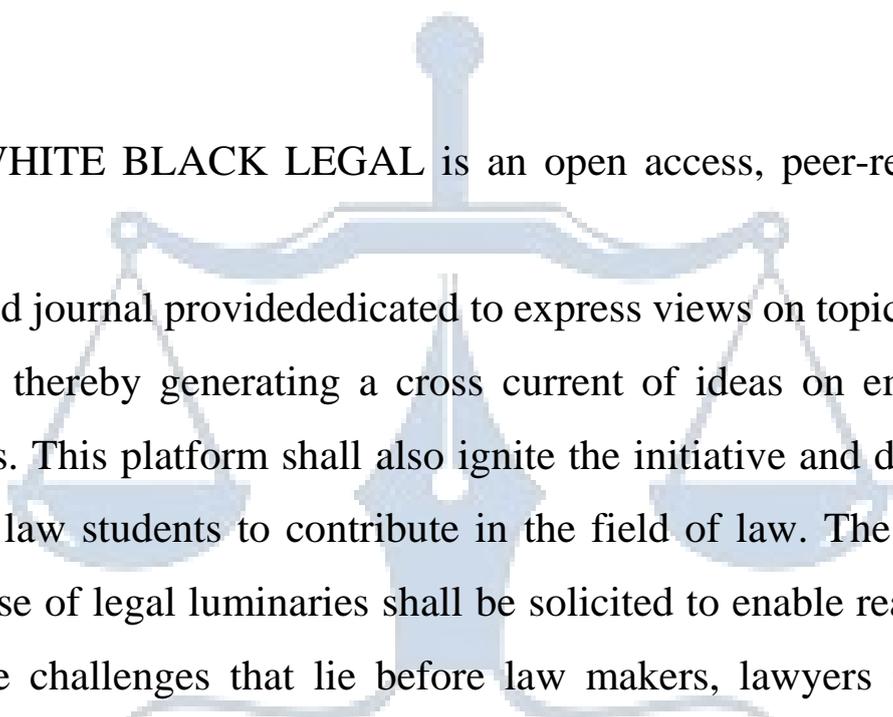


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ABOUT US



WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal providededicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

INFRINGEMENT OF TRADEMARK AND ITS REMEDIES

AUTHORED BY - ARCHIT GUPTA

ABSTRACT

Trademark Registration is becoming increasingly popular as a means of building trust between a product and its consumer. A trademark identifies a brand and communicates its quality to buyers. The Office of the Controller General of Patents, Designs, Trademarks, and Geographical Indications reported 2559756 trademark registrations in 2020- 2021. However, increased trademark registrations have led to an increase in infringement and passing off actions. Trademark infringement and passing off regulations are becoming more global as the world evolves. As trademark registrations increase, it is important to protect the rights of past users and analyze relevant legislation. This research paper examines trademark infringement and passing off regulations, as well as available remedies. The goal is to determine how unregistered trademark users can benefit from current statutory protection. The papers explore how courts have evolved with changing times and whether trademark registration offers a competitive advantage in the global market.

Key Words: Intellectual Property Rights, trademark, well- known trademark, prior use, transborder reputation.

I INTRODUCTION

The establishment of brand loyalty is significantly influenced by trademarks. The primary goal of trademark law is to prevent unwarranted competition by protecting the use of designs, logos, domain names, and other elements that significantly distinguish a company's goods. Therefore, for the independent business, concentrating on brand name insurance is equally important. The term "trademark" has a broad definition and refers to any mark that may be visually represented and that can be used to differentiate one person's goods or services from another. This can include the shape of goods, their packaging, and colour combinations. Unauthorized use of a brand name constitutes trademark infringement. In the commercial or business sector, it occurs when a person other than the registered holder uses the same mark in relation to identical goods and services for the registered mark.

II ESSENTIALS OF INFRINGEMENT

- Copying any fundamental element or the full mark with a few additions and alterations.
- Use it for trade, commercial, or professional purposes.
- Infringing marks should be printed or displayed regularly in accounts or advertisements.
- Verbal use of a trademark name is not infringement.
- If Infringing mark is identical to registered trademarks.
- Unfair use of registered trademark.
- If items are imported or exported under a registered trademark.
- If advertising is not for legitimate commercial or company purposes.
- Use of Spoken words and visual representation of registered marks.
- Use of a recognized trademark for packaging goods.
- If the registered trademark creates confusion in the mind of individual.

III TYPES OF TRADEMARK INFRINGEMENT

Direct Trademark Infringement- Direct infringement happens when a registered trademark's exclusive rights are exploited without authorization. It is a form of trademark infringement under the Trademark Act. It contains the following elements:

Unauthorised Access:

1. When someone uses a registered mark without permission from the registered mark without permission from the registered trademark owners, this is considered trademark infringement.
2. It is not considered infringement if the mark is used with the permission of the registered trademark holder.

Identical or Deceptively Similar:

1. The illegal person's trademark must be identical to or confusingly similar to the registered trademark. The term "deceptively similar" merely means that the average client could be confused by the marks and mistake them for one another.
2. The Keyword here is "may", and it only needs to be proven that this is a possibility, not that it will occur. It is sufficient to prove infringement if the marks are likely to be

misidentified.

Registered Trademark:

1. Only trademarks registered under India's trademark registration system are protected by the Act. The common law of passing off is used to settle disputes when an unregistered mark is violated.
2. It is a tort law that is used when an individual or group of individuals is harmed or has their goodwill damaged as a result of their activities.

Class of Goods or Services

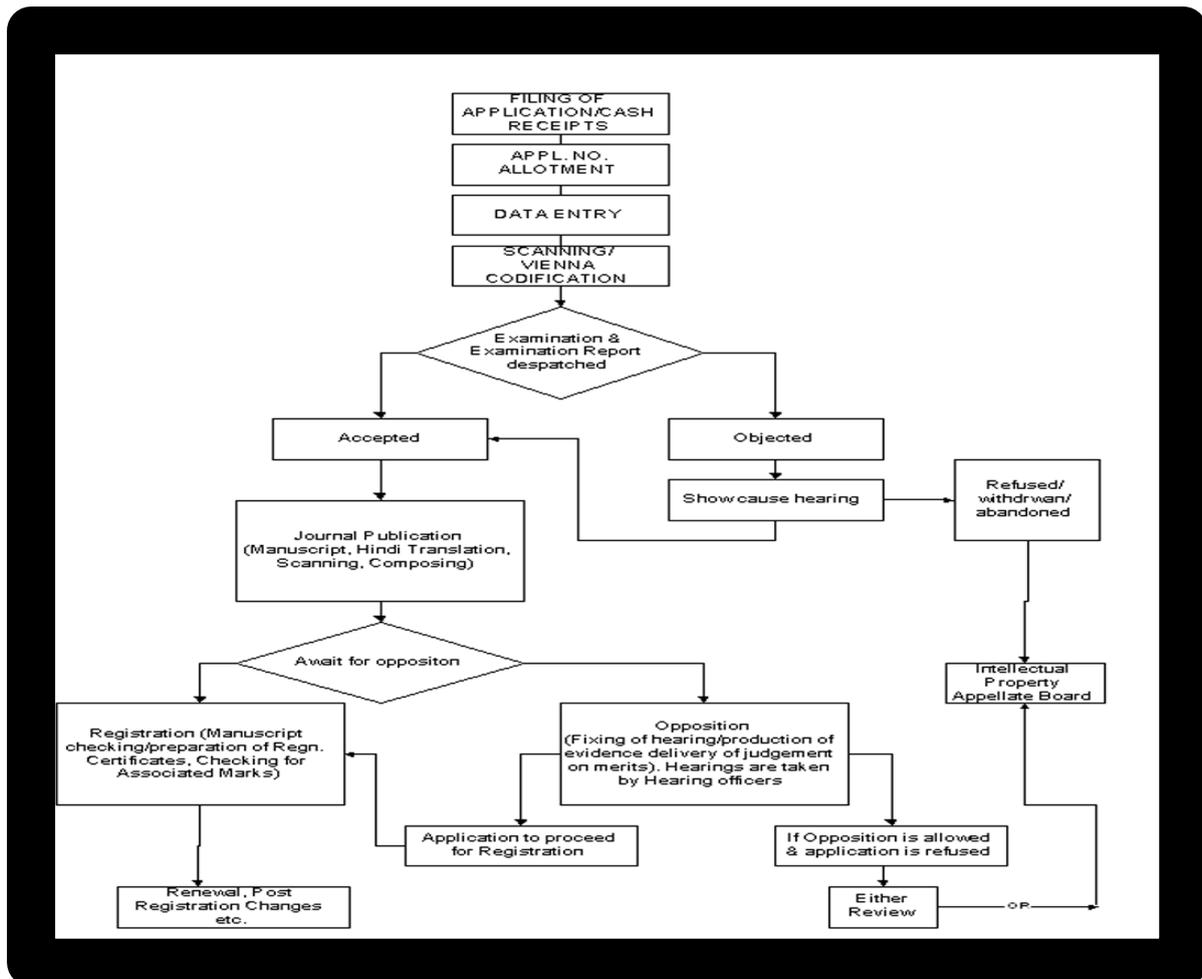
According to trademark law, an unapproved use of a mark must be to advertise goods or services that belong to the same class as the registered brand in order for it to be deemed a trademark infringement.

Indirect Trademark Infringement

In contrast to direct infringement, indirect infringement is not specifically covered by the Act. This is not to imply that indirect infringement is not a possibility. The two categories of indirect infringement are as follows:

Contributory infringement- It consist of just two components, when someone knows that a brand is being violated yet does nothing to stop it. When the individual makes a significant contribution to the direct violation. Since the contributing infringer has no exception in the case of contributory infringement.

Vicarious liability occurs when a person is held responsible for the actions of another. When the person has control over the conduct of the direct infringer. When someone benefits from the infringement. When a person is aware of the infringement and contributes to it. If a corporation violates the Act, the entire corporation is responsible. Everyone in the company will be held accountable for indirect infringement, not only the prime infringer. The only exemption is someone who acts in good faith and has no knowledge of the infringement.



TRADEMARK REGISTRATION PROCESS FLOWCHART

1V REMEDIES AVAILABLE AGAINST INFRINGEMENT OF TRADEMARK

There are three kinds of remedies that protect the registered trademark:

1. Civil remedies
2. Criminal remedies
3. Administrative remedies

Civil Remedies

1. Interlocutory injunction

An interlocutory injunction is an impermanent command that remains in effect while the matter is pending in court. This is the most important remedy for trademark infringement. An interlocutory directive can prevent a party from committing conduct that may violate the plaintiff's rights.

2. Damages

Financial compensation is provided to individuals who have suffered misfortune as a result of another person's actions.

3. Anton Piller Orders

This order is issued when there is a high risk of the respondent obliterating significant evidence in their charge. An injunction allows a person to access another person's property to get evidence for a court lawsuit, particularly in cases of trademark and copyright infringement.

4. Account of profits

This remedy is available as an alternative to damages for defendants who gained from unfair conduct.

Criminal Remedies

Criminal complaints are filed under section 103 and 104 of the Trademarks Act of 1999. In criminal proceedings, trademark infringement offenders may face imprisonment for at least six months and up to three years, as well as fine ranging from 50,000 to 2 lakh rupees. The Trademark Act of 1999 defines trademark infringement as a cognizable offense. Police can submit a First Information Report (F.I.R.) and conduct an investigation.

1. The Time Limit

There is no time restriction on how long you have a filed a lawsuit because trademark infringement is a persisting crime.

2. Jurisdiction for Suit

The Trademarks Act of 1999 determines jurisdiction for trademark infringement lawsuits. Trademark infringement lawsuits cannot be filed in courts below the district court level. A trademark proprietor may file a lawsuit in a district court located within the municipality.

Administrative Remedies

Opposing the registration of a confusingly similar mark can help defend the mark when the Trade Mark Registry is deciding whether to issue it. The trademark registration examiner makes inquiry. A third party will always oppose the already-registered mark in the trademark journal by filling a trademark opposition after the registration process is finished. Another administrative alternative is to correct a trademark that has already been registered. In a sense, this helps to resolve trademark ambiguity. Since the remedy has an administrative nature, it is

carried out by keeping an eye on the business dealings of the products that utilize the infringing trademark. Consequently, in order to stop the import and export of goods bearing a trademark that is inherently false, both prohibited.

DOMAIN NAME AND TRADEMARK

DOMAIN NAME - A domain name is a human-readable address used to access website on the Internet. It serves as a user-friendly identifier making it easier to locate and remember specific web pages. Domain Name is a part of Domain Name System (DNS) which is managed by the Internet Corporation for Assigned Names and Numbers (ICANN). Any name registered under the DNS became a domain name. For example, lawshiko.com is a domain name.

PURPOSE-

Trademark Function- It helps businesses use the domain name as a trademark, making it easier for customs to remember and visit the website. In case of People Interactive (India) Pvt. Ltd v/s vivek sors the Bombay high court defined a domain name as the “dominated address” of business on the Internet.

V CASE LAWS ON TRADEMARK INFRINGEMENT

- **Medley Pharmaceuticals Ltd. v. Winsome Laboratories Ltd**
Under the trademarks “Nimaid” and “Nimaid- P,” the defendants were manufacturing and selling identical pharmaceutical products. It was determined that the defendant’s and plaintiff’s products names were comparable. The same drug was present in both forms. The court determined that the plaintiff’s mark was registered and they were given protection.
- **Lark Laboratories Ltd v. Nabros Pharma Pvt. Ltd**
In this case the defendant copied the registered trademark of plaintiff and carried out breach of infringement. The court granted injunctions against the defendant.
- **Ashwini Chemical Works, Hyderabad v. Aswini Homeo Pharmacy**
In this case the plaintiff we're not the prior user of being “ASWINI” trademark. The trademark used by defendants was “ASWINI”. Both plaintiffs as well as defendants were using the same product. Therefore, the court granted injunctions preventing defendants from using similar trademarks.
- **Dell Computer Corpn. v. Arun Kumar**

In this case plaintiff was the registered owner trademark “DELL” in more than 130 countries. It had received immensely position. The defendant used the trade mark and failed to abstain despite of being legal notices and summons. The suit was decreed against the defendant.

VI CONCLUSION

Goodwill and reputation are built up around the marks associated with products. In order to recognize a trader’s unique rights used a mark for his goods and services, trademark law has developed. The plaintiff must demonstrate that the registered mark’s key characteristics have been replicated. When trademarks are used without authorization, the owner of the product or service has a number of options for redress. Therefore, in order to protect the brand from trademark infringement, trademark registration is crucial for the goods and services. Businesses might employ confusingly similar markings to draw customers to their stores, and counterfeiters can use them to pass off bogus goods as authentic.

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