

Advanced Diploma in Cyber Laws 2022-23 (The laws of Trade marks in cyber space)

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Let's get our basics right

Framework of IP protection

- ☐ Patents
- ☐ Copyright
- ☐ Trademarks (including trade names)
- ☐ Rights of publicity
- ☐ Misappropriation
- ☐ Trade secrets

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Panchkula man gets 3-yr jail for using Airtel logo for fake job offers

A local court awarded three years jail and a fine of Rs 12,000 to a man on Tuesday for forging the Airtel logo in his emails to lure people with fake job offers.

PUNJAB Updated: Mar 29, 2017 19:50 IST



Aneesha Bedi

Hindustan Times, Chandigarh

But why such use?

- ⇒ Response to the expansion of trade
- ⇒ Need for source identification due to increase in repeat order demands from remote customers

Basic International Legal Framework

Required criteria's may vary from country to country but are generally around the following lines:

- ⇒ The sign should have the potential to be distinctive;
- ⇒ it must indicate origin and
- ⇒ thereby distinguish or differentiate the goods or services upon which it is used from others on the marketplace

TRIPs, Article 15

Article 15

Protectable Subject Matter

1. Any sign, or any combination of signs, **capable of distinguishing** the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on **distinctiveness** acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provisions of the Paris Convention (1967).

3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.

4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.

5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.

EU Trademark Directive, Article 2

Article 2

Signs of which a trade mark may consist

A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are **capable of distinguishing** the goods or services of one undertaking from those of other undertakings.

Lanham Act, Section 45

Trademark. The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and **distinguish** his or her goods, including a unique product, from those manufactured or sold by others and to **indicate the source of the goods**, even if that source is unknown.

Trademark Act, Section 2 (z)(b)

(zb) “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: and--

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to **indicate a connection** in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark: and

(ii) in relation to other provision of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person , and includes a certification trade mark or collective mark:

Trademark Act, Section 2 m

(m) “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof :

The Manual (Draft) of Trademarks Practice and Procedure of Indian Trademark Registry, 2015

http://www.ipindia.nic.in/writereaddata/Portal/POGuidelinesManuals/1_32_1_tmr-draft-manual.pdf

Trade Mark Rules 2017

26. **Representation of trademark.** — (1) Every application for the registration of a trademark, and where additional copies of the application are required, every such copy, shall contain a clear and legible representation of the trademark of size not exceeding 8 cm x 8 cm.

(2) Where an application contains a statement to the effect that the applicant wishes to claim **combination of colours** as a distinctive feature of the trademark, the application shall be accompanied with reproduction of the trademark in that combination of colours.

(3) 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;

(iii) 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.

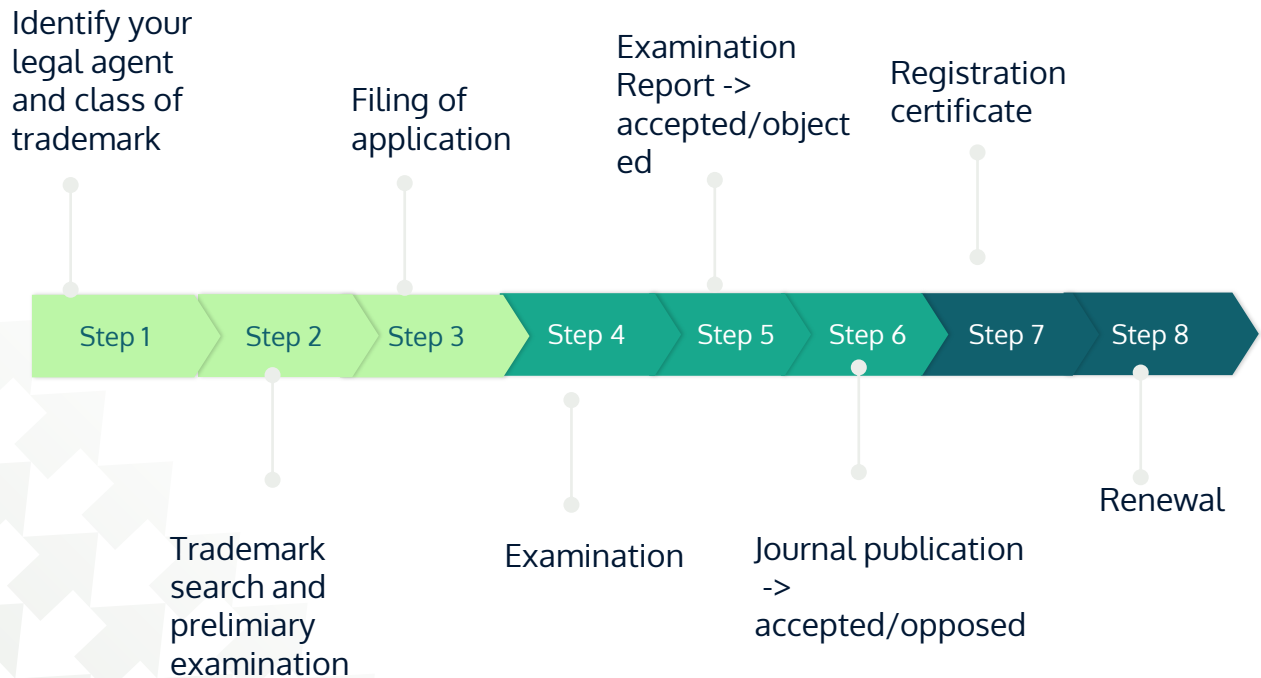
(4) (i) Where an application for the registration of a trademark consists of **shape of goods** or its packaging, the reproduction furnished shall consist of at least five different views of the trademark and a description by word of the trademark.

(ii) If the Registrar considers the different views or description of the trademark referred to in clause (i) do not sufficiently show the particulars of the shape of goods or its packaging, he may call upon the applicant to furnish a specimen of the goods or packaging, as the case may be.

(5) 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.

(6) If the Registrar is not satisfied with any representation of a trademark, he may at any time require another representation satisfactory to him to be substituted before proceedings with the application.

Trademark Registration process



But why registration ?

- ⇒ Right to exclusive use (Section 28)
- ⇒ Right to Seek Statutory Remedy Against an Infringement (Section 28)
- ⇒ Right of Registered Trademark holder of Identical Trademark (Section 28)
- ⇒ Right to Assign (Section 37)
- ⇒ Right to Seek Correction of Register
- ⇒ Right to Alter Registered Trademark

How to select the most appropriate enforcement route?

- ⇒ Civil remedies, Code of Civil Procedure 1908 (CPC)
 - Temporary/Permanent injunction
 - Mareva injunction
 - John Doe order
 - Damages/Accounts of profit
- ⇒ Criminal remedies (Chapter XII, Section 102)
 - Imprisonment with/without fine
- ⇒ Administrative remedies
 - Objection

Let's review some concepts

What is trademark?

The sign should have the potential to be distinctive; it must indicate origin and thereby distinguish or differentiate the goods or services upon which it is used from others on the marketplace

What can be registered?

Conventional v Non-conventional marks.

How to register?

Search->File->Examination->Publish->Registration

Why register?

Exclusive right and ownership.

How to enforce my rights in a court of law?

Civil and criminal remedies

Domain Names & Trademark Law

Domain Names



Source: Google Images

Domain Name System

www.google.com

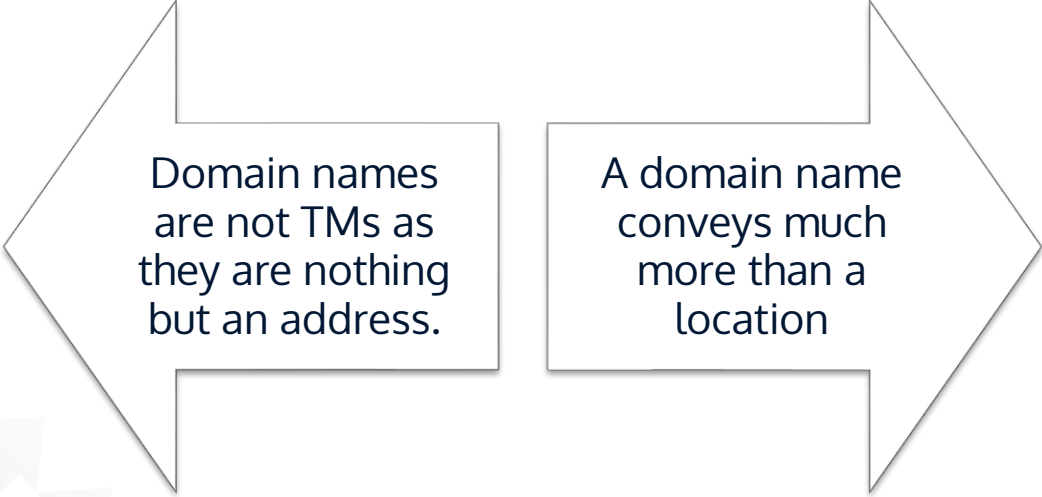
Second Level Domain
(SLD)

Top Level
Domain
(TLD)

Generic Top
Level Domain
(gTLD)

Country code
Top Level
Domain
(ccTLD)

But are domain names even trademarks to begin with ?



Domain names
are not TMs as
they are nothing
but an address.

A domain name
conveys much
more than a
location

What trademark law would apply to domain names ?

- ⇒ Infringement that causes a likelihood of confusion
- ⇒ Infringement that dilutes the value of a trademark.

Challenges to traditional trademark law posed by domain name registration on the internet

1. Geographic overlap in space
2. Technological Limitations on the internet
3. Interplay of trademark law and domain name registration

Yahoo! Inc. Vs. Akash Arora & Anr, 1999

Delhi High Court



The Internet Corporation for Assigned Names and
Numbers (ICANN)

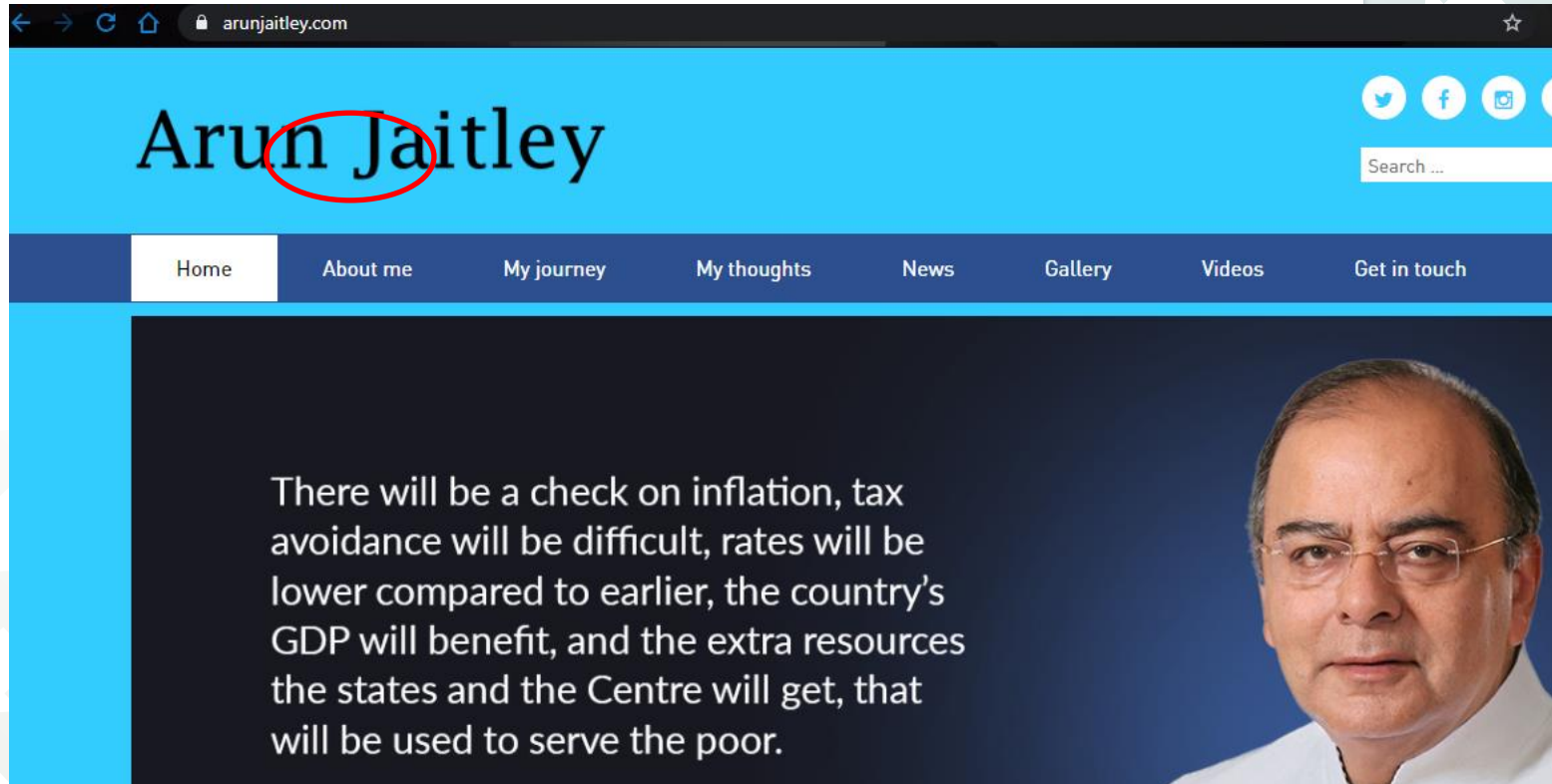


The Uniform Domain-Name Dispute-Resolution
Policy (UDRP)

Cybersquatting & Domain Names

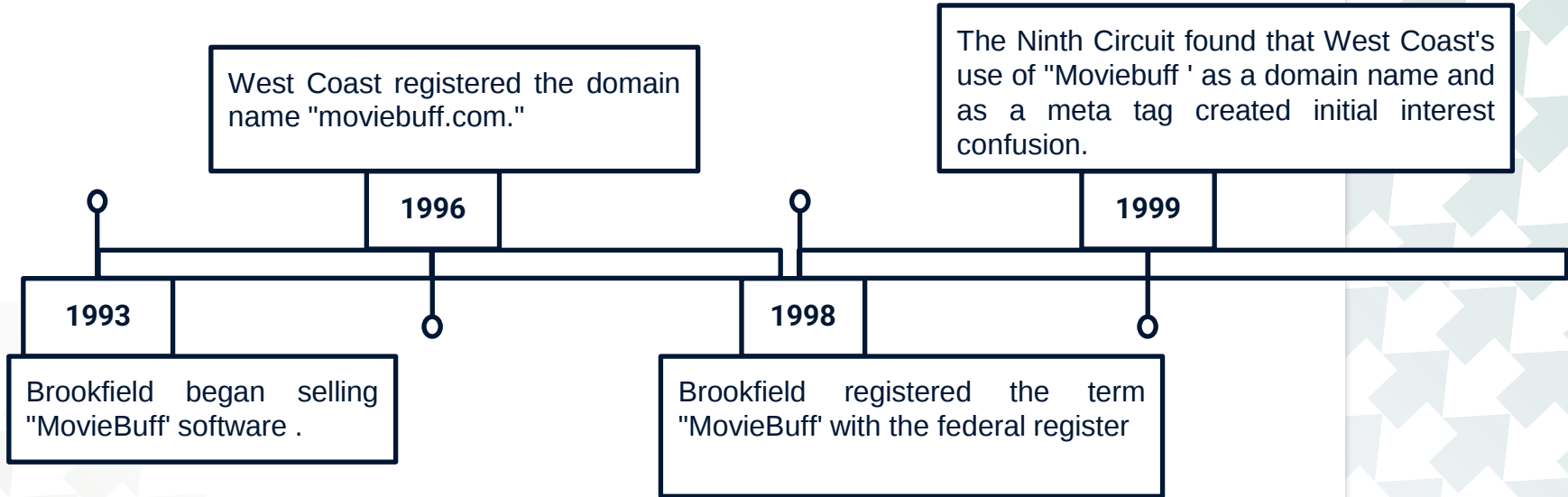
Cybersquatting is a practice where individuals buy domain names reflecting the names of a existing companies, with a sole intention to sell the names back to that company to attain profit when they want to set up their own website.

Arun Jaitley v. Network Solutions Pvt Ltd and others, 2009



Brookfield Communications, Inc. v. West Coast Entertainment, 1999

United States Court of Appeals for the Ninth Circuit



Initial interest doctrine : Initial interest confusion refers to situations where the consumer is confused as to the *source of a good or service*, but the confusion is cleared up prior to purchase. Many courts now use this theory as a basis for trademark infringement.

Initial Interest Doctrine & Internet: It investigates whether consumers looking for the trademarked product get diverted from the correct link to the trademark owner's website, *not necessarily causing infringement but amounting to unfair advantage* taken of the trademark's goodwill by the search engine.

Court uses the following analogy:

- ⇒ “Suppose West Coast's competitor (let's call it 'Blockbuster') puts up a billboard on a highway reading—West Coast Video: 2 miles ahead at Exit 7—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store by the highway entrance, they may simply rent there.”

Rescuecom corp. v. Google Inc, 2009

United States Court of Appeals for the Second Circuit



What is an Adword ?



casio watches



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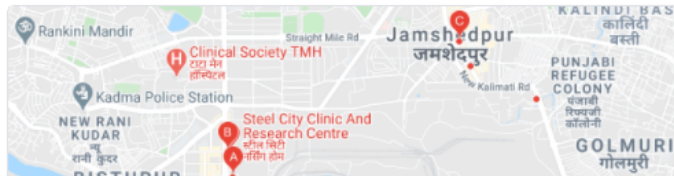
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Facts

Rescuecom

1. Google attempted to “free ride” on the association with Rescuecom's trademark
2. Google's sponsored links lure consumers away from their original searches
3. Google's search interface with sponsored links at the top and right side of the screen modify the user's original search.
4. Google uses Rescuecom's trademark internally to trigger competitors' advertisements for sponsored link

v/s

Google

1. Fair use
2. AdWords simply uses competitors' marks for comparative advertising purposes. Its practices constitute fair business practices and lead to increased choice for consumers

Legal Context:

Section 1114, Lanham Act:

- ⇒ There must be a valid trademark
- ⇒ The defendant must have used the trademark in commerce without the permission of the trademark owner.
- ⇒ This use must be likely to cause customer

Use in commerce. The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in

the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Section 1127, Lanham Act

Initial interest doctrine : Initial interest confusion refers to situations where the consumer is confused as to the source of a good or service, but the confusion is cleared up prior to purchase. Many courts now use this theory as a basis for trademark infringe

Initial Interest Doctrine & Internet: It investigates whether consumers looking for the trademarked product get diverted from the correct link to the trademark owner's website, not causing infringement but amounting to unfair advantage taken of the trademark's goodwill by the search engine.

Held:

- ⇒ Google uses other companies' trademarked terms outside of its internal algorithm by selling and suggesting trademarks such as Rescuecom. Such a sale constitutes “use in commerce”
- ⇒ Yet, the Court carefully noted that its decision did not address whether Rescuecom will be able to prove that Google violated the Lanham Act and caused likelihood of confusion.

Hèrmes Int'l v. Rothschild



Any questions?

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