

Law of Trade Marks – Case Study

- Ashok Leyland obtained Registration of TM for “Luxura” in Class 12 on 24.03.2009
(Applied for on a proposed to be used basis on 20.04.2007)
- Blue Hills launched “Luxuria” Bus Services from Chennai to Bangalore on 12.11.2010
Filed for TM registration of “Luxuria” in 2010 in Class 39 – pending

Case Study – Classification

- Class 12. Vehicles; apparatus for locomotion by land, air or water
- Class 39. Transport; packaging and storage of goods; travel arrangement.
- AL sues for infringement

Law of Trade Marks

- Trade Marks are used by manufacturers/ traders to identify their goods and distinguish them from goods made or sold by others
- Right from the period of Romans it was common for pottery to be impressed with a mark
- The industrial revolution saw an enormous growth in the use of trade marks for advertising
- Very often a trade mark is associated with quality and consumer expectations
- A trade mark should be used or intended to be used in relation to certain goods/ services

Law of Trade Marks

- A trade mark denotes a connection in the course of trade between a manufacturer or goods in question, and thus if the mark is not being used there then there can be no such connection
- Another important aspect is that the mark should be distinctive, i.e. it should be capable of distinguishing the goods and services of one from another
- This requirement of distinctiveness serves as a limitation on the types of words being used as marks
- Ownership of a trade mark gives the owner a restricted monopoly and the owner has a proprietary right in the mark

Law of Trade Marks

Trade Mark Law has the following objectives

1. Protection of business reputation and goodwill
2. Protection of consumers from deception

By fulfilling these two broad objectives this branch of Law strikes at the root of unfair competition

Law of Trade Marks

The function of trade marks

- To identify one's goods and distinguish them from goods sold by others
- To signify that all goods bearing the trade mark come from or are controlled by a single source (badge of origin)
- To signify that all goods bearing the trade mark are of an equal level of quality
- Trade mark is a prime instrument in advertising the product
- A trade mark is the symbol of good will that a business has built-up, in other words it is the commodification of goodwill

Law of Trade Marks

Categories of Marks

Certification Trade Mark Sec 2(1) (e)

- This doesn't indicate the trade origin, but only certifies that goods or services on which it is applied are having certain characteristics of the goods, e.g. ISI, WOOLMARK, CMM LEVEL 5
- Thus a certification trade mark contains certain characters like origin, material, mode of manufacture of goods, mode of performance of services, quality, accuracy etc e.g. 916 Gold, Six Sigma, ISO 9000

Law of Trade Marks

Collective Marks

- Collective mark means a trade mark distinguishing goods/ services of members of association of persons (not being a partnership), from those of others e.g. CII, FICCI, Cellular Operators Association of India
- The owner here is the association of such members
- The use of the mark by members is generally governed by the regulations framed by the association
- While a collective mark indicates trade origin, a certification trade mark indicates some character or quality of goods on which the said mark is embedded

Law of Trade Marks

Trade Mark Sec 2(1) (zb)

- It must be a mark capable of being represented graphically (interestingly the term *mark* has been defined in the Act to include a device, heading, label, name, signature, word, letter, numeral, shape of goods, packaging, combination of colours etc)
- It must be capable of distinguishing the goods/ services of one company from that of others
- It should be used or intended to be used in relation to goods/services



Law of Trade Marks

- The use must be of a visual representation of the mark
- The use should be upon the goods covered by registration
- The use must be for the purpose of indicating a connection in the course of trade between the goods and the manufacturer
- Thus under the new law shape of goods, their packaging and a colour combination may be registered as a trade mark

Law of Trade Marks

Commonly used forms of trade marks

- Word or groupings of letters is the most common type of trade mark, e.g. IBM, GE, ITC
- Logos – Mc Donalds, APPLE
- Pictures or drawings of a character or a scene- Asian Paints' boy

Law of Trade Marks

- It can be combination of letters and design
Netscape, SUN etc
- Slogan from advertising campaigns
“Solutions for a small planet” IBM
“ We bring good things to life” GE
- Combination of colour can be a trade mark
- A product or a container shape can be a trade mark
Coco Cola bottle, Toblerone chocolates

Law of Trade Marks

- Sound can be a trade mark, CNBC's 3 tone bell, has been registered as a trade mark in USA
- Scent can be registered as trade mark in USA

Trade Marks...

Well Known Trade Mark Sec 2(1) (zg)

- This means a mark which has become so well known to the substantial segment of public which uses such goods or receives such services
- Thus if a third party uses the said mark in relation to dissimilar goods /services still the public may believe that goods/ services of that person have a connection with the well-known mark

Registration of Trade Marks

Absolute grounds for refusal of registration (Sec 9)

- When a mark is devoid of any distinctive character, i.e when it is not capable of distinguishing the goods/services of one person from those of another, it cannot be registered
Sec. 9(1) (a)

Case law Jeryl Lynn Trade Mark Application, 1999 FSR 491

The registration was sought for medicinal/pharma preparation used for mumps vaccine, the name was chosen in honour of Jeryl from whom the original mumps virus was isolated. The Mumps virus was also known under the same name. The registration failed because Jeryl was only a technical name and has become generic

Registration of Trade Marks

- If the trade mark consists exclusively of marks/signs which denote the kind, quality, quantity, geographical origin, values etc, Sec 9(1) (b)
- If the trade mark consists exclusively of marks/signs which have become customary in the current language or in the bonafide or established practices of trade, Sec 9(1) (c)
- But Sec 9(1) (a), (b) and (c) come with an exception
- If on the date before the application for registration, the trade mark had acquired a distinctive character as a result of use made of it, then it can be registered,
- Similarly if the mark is a well-known mark, then also it can be registered, e.g. Head & Shoulders, Fair & Lovely etc

Registration of Trade Marks

- This would simply mean that any mark which is initially denied registration because of any grounds under Sec 9(1) (a) – (c), will be allowed to be registered later if it has acquired distinctiveness as a result of use
- The following are the factors to be considered by the Registrar in determining whether a mark has acquired distinctiveness or not
 - ❖ Whether the mark contains any descriptive elements of the goods or services?
 - ❖ How intensive and geographically widespread the mark is?

Registration of Trade Marks

- Whether the mark is having a longstanding use?
- The amount invested in promoting the mark
- The proportion of the relevant public which identifies, the goods/services having the mark, as originating from a particular company
- Statements from the chambers of commerce/industry /trade bodies etc

Registration of Trade Marks

- Any mark which will deceive public or cause confusion won't be registered, Sec 9 (2)(a)
- The public might be deceived as to the nature, quality or geographical origin of the goods or services
- Swiss Miss Trade Mark Application, 1997 RPC 219
Application to register “Swiss Miss” for chocolate, cocoa drinks and other milk preparations by a US company was refused because it was likely to cause some people to think that the product originated in Switzerland

Registration of Trade Marks

- If the mark contains any matter likely to hurt the religious feelings of any class or section of Indian citizens, Sec 9 (2) (b)
- In England “Hallelujah Trade Mark” application, 1976 RPC 605, was refused
- If the mark comprises of scandalous or obscene matter then it cannot be registered, Sec 9 (2) (c)
- Then marks coming under the purview of Emblems & Names Act 1950 cannot be registered, Sec 9(2) (d)

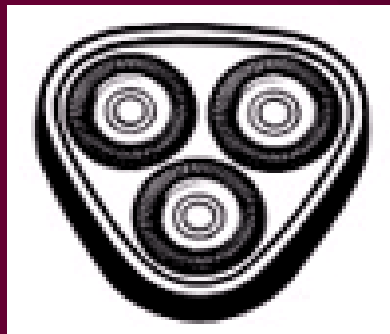
Registration of Trade Marks

- Sec 9(3) essentially deals with Shape Marks
- If a trade mark consists exclusively of shape of goods which results from the nature of goods themselves then it cannot be registered, Sec 9(3)(a), e.g. the shape of a football cannot be registered
- If the trade mark consists exclusively of shape of goods which is required to obtain a technical result Sec 9(3)(b)

Case-law- Koninklijke Philips Electronics NV v Remington Consumer Products Ltd. [2003] Ch 159 – “*capability of distinguishing depends upon the features of TM itself, not on the result of its use*”

Registration of Trade Marks

- Court held that the essential characteristics' of the shape mark i.e. a three-headed rotary electric shaver, performed a technical function and obtained a technical result
- In other words the essential characteristics enabled the user of a Philips three-rotary-headed shaver to enjoy a smooth, safe shave.
- Thus the registration of the shape mark was revoked



Registration of Trade Marks

- If the trade mark consists exclusively of shape which gives substantial value to the goods the it cannot be registered as a trade mark Sec 9(3)(c)
- Consideration should be given to the fact whether the shape gives substantial value, this can be done by comparing the shape to be registered with the shape applied to equivalent articles
- If the shapes of other articles were as good as this one or were as cheap as to be produced then, the said shape to be registered gives no substantial value to the goods.
- In simple words if a shape performed much more efficiently than another shape or was having more visual attraction than another, then it can't be registered as a trade mark

Registration of Trade Marks

Relative grounds for refusal of registration

- A trademark which is identical to an earlier trademark cannot be registered on similar goods/services covered by earlier trademark, if there is a likelihood of confusion in the minds of the public which may include a likelihood of association with the earlier mark Sec 11(1)(a)
- A trademark which is similar to an earlier trademark cannot be registered on identical or similar goods/services covered by earlier trademark, if there is a likelihood of confusion in the minds of the public which may include a likelihood of association with the earlier mark Sec 11(1)(b)

Registration of Trade Marks

- Normally the likelihood of confusion requires an appreciation of the visual, phonetic or conceptual similarity of the marks based on the overall impression given by them
- Perception of the average customer is very important
- Generally a customer sees a trade mark as a whole and doesn't analyse its individual details
- Whether two marks can cause confusion can be judged by considering the following factors

Registration of Trade Marks

- In *British Sugar plc v James Robertson & Sons Ltd.* (1996) RPC 281, The facts are such that British Sugar who had registered the trade mark “Treat” for sauces and syrups filed an infringement case against the defendant who was using the name “Robertson’s Toffee Treat” to market their sweet spreads,
- The court narrated the following factors, to determine whether goods are similar or not.
- Respective uses of respective goods
- Respective users of respective goods
- Physical nature of goods
- Respective channels of trade

Registration of Trade Marks

- In case of consumer items found in super markets (self serviced), whether they are kept in same or different shelves
- Whether market research companies classify the goods as same or different sectors
- Thus in the said case the court held that syrups and sweet spread were not similar goods

Registration of Trade Marks

After analysing various case-laws the following factors have become important in determining the likelihood of confusion between two marks

- The judge has to step into the shoes of an average customer who is reasonably well informed, circumspect and observant, but who has an imperfect recollection of an earlier mark because very often he doesn't get a chance to compare the marks directly
- An average customer perceives the mark as a whole and doesn't analyse its individual merits

Registration of Trade Marks

- The overall impression of the mark is important
- Lesser degree of similarity between marks may be offset by a greater similarity between goods and vice versa
- If the mark is more distinctive the chances of confusion are also very high

Transpay Trade Mark (2001) RPC 191

- The application to register *Transpay* as a trade mark was objected by *Transcheque*
- Court held that although both had the same prefix ‘Trans’, the suffix was different and the public was unlikely to be confused

Registration of Trade Marks

A trade mark which is identical or similar to an earlier trade mark cannot be registered for a dissimilar goods,

- if the earlier mark is a well-known mark, and the use of the second mark without due cause will take unfair advantage of the earlier mark, which can be detrimental to the distinctive character of the earlier trade mark, Sec 11(2)
- This ground is being raised under opposition by an interested party, the Registrar will decide whether a Mark is well-known or not

Registration of Trade Marks

The following factors have to be considered by the Registrar to determine whether a Mark is well known or not

- Knowledge or recognition of the trademark in the relevant section of public
- Market share, intensity, geographic extent, duration of use of the trade mark
- Investments made to promote the trade mark
- Successful enforcement of rights associated with the trade mark

Registration of Trade Marks

- Thus in the case of a well-known mark there is no requirement of any confusion in the minds of the public

Here the law perceives two possibilities

- Firstly the applicant to register the subsequent mark which is identical or similar to the well-known mark will use it to capture some of the goodwill associated with the earlier mark, so as to ride back on that reputation, thus he is getting a good launching pad
- Secondly the later mark will be used to tarnish the value of the earlier one, like a famous trade mark used in an inferior product/service

Registration of Trade Marks

What if the subsequent applicant has a valid /due cause ?

- In such cases the second mark will be allowed to be registered on dissimilar goods, irrespective of the existence of a well-known mark
- Paco/ Paco Life in Colour Trade Marks 2000 RPC 451
- The word Paco was common to the applicant's mark and the well-known mark
- The applicant chose it because it was the founder's name
- The court held that, such use of the mark was with a valid cause, and hence the registration was allowed

Registration of Trade Marks

- A trademark shall not be registered if its use in India is to be prevented by the Law of Passing off or by the law of copyright, Sec 11(3)
- Signs/marks used in trade may be protected by forms of IPR other than trade marks,
- E.g. a logo which is original may be protected under the laws of copyright
- A trade name or logo may be unregistered but still it can be protected under the laws of passing off.

Infringement

- Sec 29 deals with infringement

If anybody other than the trademark owner uses the mark in the course of trade

- By affixing it to the goods or packaging
- Offering the goods for sale, marketing, stocking them for such purposes
- Importing the goods with the said mark
- Using the mark on business letters or advertisements, then there will be infringement

Infringement

- If a trade mark is identical to an earlier registered trade mark and is used on similar goods covered by it, then there will be infringement if the public is likely to be confused or is likely to have an association with the earlier mark, Sec 29 (2) (a)
- Baywatch Production v Home Video Channel, (1997) FSR 22
- Makers of the popular television program “Baywatch” sued the producers of “Babewatch” an adult film

Infringement

- Baywatch was registered for video discs and tapes
- Here the signs and logos were totally different and hence there was no confusion
- Thus there was no infringement
- In NAD Electronics Inc v NAD Computer Systems Ltd. (1997) FSR 380
- The plaintiff had a registered trademark NAD for CD players and sound systems
- The defendant used the word “NAD” on computer systems
- This was held to infringe as many computers were bundled along with CD-Rom drives and sound systems

Infringement

- If a mark or sign is similar to an earlier registered trade mark and is used on identical or similar goods covered by the earlier mark, then there will be infringement if the public is likely to be confused or is likely to have an association with the earlier mark, Sec 29 (2) (b)

Infringement

- Sec 29(4) deals with trade marks having reputation
- In such cases if anybody uses any identical/similar mark in relation to dissimilar goods, there will be infringement if such use without any valid cause tries to take unfair advantage of the mark having reputation or is detrimental to the distinctive character of the said mark

Infringement

Infringements by advertisement, Sec 29(8)

A trademark is infringed by advertisement of that by somebody, if during the said advertisement

- The other party tries to take an unfair advantage of the mark or
- Such advertisement is against the honest practices in industry or commerce or
- Such advertisement detrimentally affects the distinctive character of the mark or
- Such advertisement causes any bad reputation to the trademark

Rules regarding deceptive similarity in drug names:

Tradenames contain a part of the chemical name, so that the product may be identified with a particular chemical substance:

API Ciprofloxacin: *ALCIPRO, CIPRO, CIPROBID, CIPROLET, CIPROVA*

API Clopidogrel – *CLOPILET, CLOPIGREL, CLOPITAB, CLOPIJOY*

In *USV Ltd. v. Systopic Laboratories Ltd.*, 2004 (1) CTC 418, the Madras High Court had to held that "PIO" and "PIOZ" containing the API, Pioglitazone were not deceptively similar. As "PIO" has become publici juris and that there could be no monopoly over it.

IF the name is derived or coined form the name signifying the API used in the medicine, no distinctiveness or exclusiveness can be claimed by the manufacturer in respect of that part of the name.

MIPR 2010 (1) 0217Acme : Pharmaceutica;s Vs Torrent Pharmaceuticals –
‘*Aroxyl*’ not infringing ‘*Droxyl*’ – both derived from Cefadroxil –
Use indicates kind and quality and is not infringement in view of
Section 30 (2)

As regards other combinations, the law as applied to other products
will apply:

Ranbaxy Laboratories Limited vs V. Anand Prasad.
2004 (28) PTC 438 IPAB

**Brands are vehicles for
pharma to reach emotions
of the consumer**

Pfizer's Viagra

resemblance to Niagara:

Honeymoon

connection between water and sexuality..

English vie, 'to fight,' and similar to other words like vigour, vitality, and victory.

The balance of the name, '-agra,' suggests aggression. Initial [v] scored as one of the fastest, biggest, and most energetic sounds in language in Lexicon's sound symbolism research.

CIALIS

Lilly ICOS's Cialis differs from Viagra in looks, feel, and meaning. If Viagra is about individual sexual performance on one end of the spectrum, Cialis is about relationships and sensuality on the other..

Natural..that it might name a flower (as in chysis, or 'baby orchid,' or cynorchis, the 'dog orchid') or a love

The sounds of Cialis are soft and smooth, almost feminine, and far less aggressive than those of Viagra.

US Patent
4255431
on omeprazole -
racemic mixture



Evergreening

Purple as
symbolics of
dependable
magic
Distress
resolution,
fear reduction

WO patent 94/27988
on esomeprazole –
s-enantiomer



"the purple pill"

TRADEMARKS AND BRAND

‘Just Jockeying’ describes the attitude of today’s youth, their lifestyle, their spirit – a combination of being happy with one’s self, confident of what they want, what they are doing, not afraid of expressing themselves – all this cloaked in subtle humour and summed up in two words – Just Jockeying”

Inner beauty



What to do with



1. science kit or learning toys for children
2. Spin-off another series – animation, movies or comics
3. Software avatars: to teach or search - e-learning characters
4. Games character: such as Lara Croft Tomb Raider
5. Packaging
6. Books: Harry Potter guide to dating
7. Colouring books, stickers, Candy bar, gift wrapping
8. Breakfast cereal
9. Perfume, toiletries, accessories

<i>Firm Name</i>	<i>Annual Licensing Revenues (\$ bil.)</i>	<i>Typical Deals</i>
Disney Consumer Products	\$21.0	Toy and apparel licensing for Disney movies and characters such as <i>Star Struck</i> , <i>Alice in Wonderland</i> .
Warner Bros. Consumer Products	\$6.0	Toy and apparel licensing from movies such as <i>Harry Potter</i> , <i>Toy story</i> .
Nickelodeon & Viacom Consumer Products	\$5.2	Toy and apparel licensing for TV programs such as <i>SpongeBob</i> .
Marvel Entertainment	\$5.0	Toy, game licensing for <i>Fantastic 4</i> .
Major League Baseball	\$4.7	Baseball-related video games, toys.

Cyber Property Jurisprudence

- Domain names are the addresses of the computers connected to the Internet
- Just as every office or residence in the real world has an address, each server connected to the Internet has a unique identification number called the Internet Protocol address
- In order to make the Internet address system user friendly, the numeric IP Address system has been overlaid with a system of domain names, which can be easily remembered
- Thus when an internet user enters an easy to remember domain name like www.nalsarlawuniv.org, the computer converts that into a unique numeric address that corresponds to [nalsarlawuniv.org](http://www.nalsarlawuniv.org), i.e. 202.53.64.243

Cyber Property Jurisprudence

- The Domain Name System (DNS), allows for 2 categories of top level domains, generic top level domains (gTld) and country code top level domain (ccTld)
- gTld are .com, org, .net, .edu, .mil, .gov, .int, .aero, .info, .biz etc
- ccTld is a two letter country code, .au for Australia, .in for India
- Domain names themselves consist of 2 separate parts, a top level domain name and a second level domain name
- E.g. **nalsar.org** consists of a top level domain name **.org** and a second level domain name **nalsar**

Cyber Property Jurisprudence

- Domain names were originally intended to perform only the function of facilitating the connectivity of computers through Internet
- But at a later stage they began to be used as a form of business identifier, simply because they are easy to remember and use
- Businesses started to realise the significant potential of web sites as an important medium of facilitating e-commerce
- By using trade and service marks as their domain names, businesses hope to attract potential customers to their websites and increase their market visibility
- At this stage conflicts began to arise between trade marks and domain names

Cyber Property Jurisprudence

- One of the main reasons for the conflict is that, there is no connection between the system for registering trade marks and domain names
- Trade Marks are administered by a public authority on a territorial basis, which gives rise to certain rights to the trade mark owner within that territory
- In the case of a trade mark registration the applicant will have to satisfy certain norms under the concerned law
- Normally a trade mark will be refused registration if there already exists an identical or similar mark, or if the said mark has the potential of deceiving or confusing the general public

Cyber Property Jurisprudence

- Whereas domain names are administered by non governmental entities and the domain name so registered has a global presence
- Domain names are registered on first come first served basis
- This would simply mean that any person can own the domain name variant of a famous trade mark, if he is the first person to apply
- During the early days of Internet, many individuals had infact registered the domain name versions of some famous trade marks and had charged huge amounts from them for selling back these domain names.
- This practice is popularly called as Cybersquatting

Cyber Property Jurisprudence

- During the initial days there was lack of coordination between various parties who were managing the Internet
- Initially Internet was funded and managed by an agency of the US government called the National Science Foundation
- Later on Internet Assigned Numbers Authority (IANA) for set up for formulating the policies and standards for the management of the DNS
- NSI another private US company was responsible for the worldwide registration of domain names
- Thus there were different entities operating, so it became difficult to create a special plan to deal with the unique problem pertaining to trade marks and domain names

Cyber Property Jurisprudence

- Later on in 1998 the US government made a proposal to the WIPO to conduct a study on the problematic interface between domain names and trade marks and suggest a remedy, this proposal was supported by the other member states of WIPO
- In 1999 a body called ICANN (Internet Corporation for Assigned Names and Numbers) was established to manage the DNS
- ICANN is responsible for coordinating the management of the DNS by overseeing the distribution of unique technical identifiers used in the Internet's operations, and delegation of Top-Level Domain names (such as .com, .info etc.).

Cyber Property Jurisprudence

- In 1999 WIPO submitted its report to ICANN and suggested some remedial measures to solve the trade mark domain name conflicts
- ICANN adopted the WIPO report and it is presently known as Uniform Domain Name Dispute Resolution Policy
- According to this policy all domain name holders are required to submit to a mandatory administrative proceeding in case of a third party complaint citing any of the following grounds
 - (i) the said domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
 - (ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and
 - (iii) the said domain name has been registered and is being used in bad faith.

Cyber Property Jurisprudence

Evidence of Registration and Use in Bad Faith.

- (i) circumstances indicating that the domain name holder has registered the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the out-of-pocket costs directly related to the domain name; or

Cyber Property Jurisprudence

- (ii) The domain name holder has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name,
- (iii) The domain name holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) The domain name holder has intentionally attempted to attract, for commercial gain, Internet users to his web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of his web site or location

Cyber Property Jurisprudence

What are the defences available

- (i) If the domain name holder has used or has made preparation to use the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) If the domain name holder is commonly known by the domain name, even if he has not have acquired no trademark or service mark rights; or
- (iii) If the domain name holder is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Cyber Property Jurisprudence

- **Remedies.** The remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to the cancellation of the said domain name or the transfer of the domain name registration to the complainant
- UDRP became applicable from December 1999 and has become a big success
- ICANN has appointed many dispute resolution providers to resolve the disputes in accordance with UDRP.
- WIPO is an approved dispute resolution provider and adjudicates the maximum number of disputes
- Most of the multinational corporations including GE, Pfizer, Vodafone, Coca-Cola etc have made use of the ICANN Policy

Cyber Property Jurisprudence

- Lots of Indian companies including Tata, Satyam, Times of India, Mahindra and Mahindra have successfully used the ICANN policy against cybersquatters
- US is the first country to draft a special law to deal with Cybersquatting titled “Anticybersquatting Consumer Protection Act 1999”
- The said Act targets the bad faith registration of a domain name and has provisions to protect the names of living individuals, in rem proceedings, monetary remedies etc

Cyber Property Jurisprudence

Reverse Domain Name Hijacking

- This will happen when a party uses the ICANN policy in bad faith to attempt to deprive a registered domain name holder of a domain name
- Here two legitimate parties are involved in a dispute over a domain name, where each party claims to be the true owner on account of an identical or similar mark being used as part of its business
- In such cases the burden of proof on the complainant is much higher than that is required in the ordinary cases where the complainant has a clear right

Cyber Property Jurisprudence

- Apart from the ICANN mechanism, the trademark holder can also use the remedy under passing off
- In common law countries passing off action is invoked to protect trade marks from being misused
- In India, many domain name cases have been decided by the courts by invoking the passing off doctrine, e.g. Yahoo v Akash Arora, (1999) PTC 201, Rediff Communications v Cyberbooth (2000) PTC 209,Buffalo Networks P Ltd. v Manish Jain, 2005 (30) PTC 242(Del) etc
- Recently the Supreme Court invoked the passing off doctrine in a domain name dispute, Satyam Infoway Ltd. v Sifynet Solutions Pvt. Ltd. 2004 (28) PTC 566 SC

PVS Giridhar & Sai, Advocates



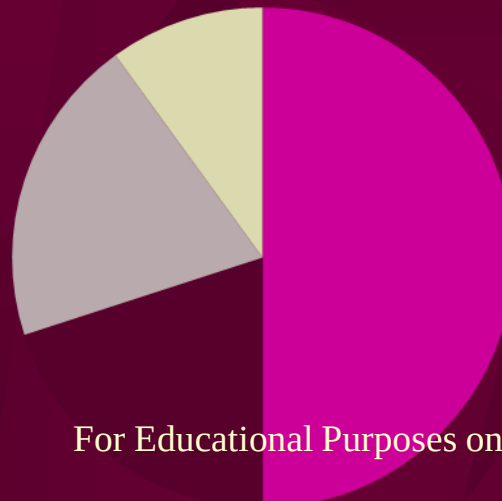
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Preventive Legal Solutions – PLS

Offshore Legal Department –OLD

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Service Profile

- Litigation and ADR
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Any Questions?

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