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E.MBA, LL.M, Ph.D, PGDSAPM

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Subhrajit Chanda



BBA. LL.B. (Hons.) (Amity University, Rajasthan); LL. M. (UPES, Dehradun) (Nottingham Trent University, UK); Ph.D. Candidate (G.D. Goenka University)

Subhrajit did his LL.M. in Sports Law, from Nottingham Trent University of United Kingdoms, with international scholarship provided by university; he has also completed another LL.M. in Energy Law from University of Petroleum and Energy Studies, India. He did his B.B.A.LL.B. (Hons.) focussing on International Trade Law.

ABOUT US

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provided dedicated 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

CRITICAL ANALYSIS OF TRADEMARK LAW AND **DOMAIN NAMES**

AUTHORED BY - KHUSHBOO KUMARI & DR. AMIT DHALL

ABSTRACT

In the digital era, trademark law is essential for safeguarding business identification and avoiding customer misunderstanding, especially when it comes to domain names. This essay examines trademark law and domain names critically, concentrating on important topics including domain name registration, infringement, and dispute settlement. It looks at the application of classic trademark law rules to domain names, taking into account the particular difficulties brought about by the Internet's worldwide reach and the quick development of e-commerce. The usefulness of present legal frameworks and alternative dispute resolution procedures in settling domain name disputes is also assessed in this article. It draws attention to the need for a more sophisticated strategy to balance the rights of trademark owners and domain name registrants via a comparative study of case law and international treaties. Finally, taking into account the changing landscape of digital branding and online commerce, the study makes proposals for strengthening the coherence and efficacy of trademark law in the context of domain names.

Because of the recent changes in the way companies function and engage with customers brought about by the Internet, domain names have become an essential part of branding and marketing initiatives. As a result, the complicated and divisive connection between domain names and trademark law has grown. While domain names are the addresses used to access websites on the Internet, trademarks act as indicators of the provenance of products or services

The possibility of misunderstanding between domain names and trademarks is one of the fundamental problems in this field. Trademark law grants exclusive rights to use certain marks in commerce in an effort to protect consumers from confusion. However, since domain names may be registered and used anywhere in the world due to the global nature of the Internet, disputes between trademark owners and domain name registrants might arise.

The growth of “cybersquatting,” the practice of registering domain names that are confusingly close to or identical to trademarks with the intention of making money off the goodwill associated with

such marks, presents another difficulty. In addition to hurting trademark owners, this activity confuses customers and compromises the reliability of the domain name system.

Numerous legal frameworks and conflict resolution processes have been created in order to solve these problems. For example, the Uniform Domain-Name Dispute-Resolution Policy (UDRP) offers a simplified procedure for settling disagreements between trademark holders and holders of domain names. However, others have questioned these processes' efficacy, claiming that they often favor trademark owners while falling short of providing sufficient protection for domain name registrant's rights.

Trademark law and domain names need a more sophisticated and balanced approach in light of these difficulties. This entails taking into account the justifiable interests of those who register domain names and hold trademarks, in addition to the need of fostering innovation and competition in the digital economy. This study seeks to advance knowledge of these matters and aid in the creation of more useful legal frameworks and policies by critically examining the relationship between trademark law and domain names.

Keywords: Trademark, domain name, cybersquatting, UDRP, branding and marketing.

INTRODUCTION

The concept of property is the rudimentary element of life and cannot be examined in isolation. The properties can be meant in two different ways. Any attributes, characteristics, features or kind can be called as properties as also the entities which one possesses can also be called as property. However, the present discussion relates to the properties, which governs people's access to and control of things like land, natural resources, and goods manufactured, ideas, innovations, graphical representations, own write up etc. It is said that the concept of property evolved from the scarcity and necessity felt by the human being.

It is not inaccurate to assert that the legal and customary conceptions of property held by different classes and members of a society reveal its essence and purpose. These property concepts remain unchanged unless there is an imminent or fundamental transformation in the societal fabric. Therefore, in a sense, the history of property relations in a particular society is the history of that society.

Eighteenth Century has laid down various theories of property to describe concept of property.

Institution of property has its own history. It is not exaggeration, if said, there must be as many as theories of jurisprudence related to property as there would be having system of property rights. Many theories on property are laid down by various thinkers like Plato, Aristotle, Aquinas, Hegel, Hobbes, Locke, Hume, Kant, Marx and Mill.¹

According to J. Martin Pederson, property consists of normative protocols that establish a framework for social relations concerning material objects. Property is intrinsically linked to the organization of societies and other social groupings, considering that in actuality, no social relations occur without the use of some form of object as a setting or propping element. Property protocols are the norms, conventions, and customs that govern the conduct of individuals. These protocols, which are frequently interpreted as patterns of responsibilities, rights, authority, and privileges, establish particular liberties or restrictions concerning the utilization of a particular resource or object.²

The property would attribute to concept of having an interest in something and not owning it. Initially, possession was the only concept known to human and gradually since the human was nomad, concept of ownership was developed. He had to go to places in search of food, and wherever he got his survival conditions, he settled down there. Soon, with the passage of time, he could be at a place for a long period of time. And with the changing condition, the concept of possession also changed to ownership. There may be various titles associated with one property. A person may acquire right over property by the virtue of his birth or by the way he acquires it later.

Property to Intellectual Property

The preservation of industrial property serves as a mechanism to promote investment, honest trade, and inventive endeavors, rather than as an end in itself. This is all intended to contribute to the improvement of men's safety and comfort, reduction of destitution, and enhancement of attractiveness.

The term IP is developed in about 20th century. Growth of an organization depends largely on its access to resources in the modern times. Economic Growth of nations too depends upon the resources that it can possess or have access to for its use. Before 2nd World War, land was perhaps considered as a prime resource needed for economic growth. The importance of land may not have diminished

¹ Rohas Nagpal, IPR & Cyberspace – Indian Perspective (2009).

² Milton Mueller, Trademarks and Domain Names: Property Rights and institutional revolution in Cyberspace (Telecomm. Pol'y 90, 2012).

absolutely over a period of time, but its importance has declined relatively, though certain countries have been acquiring land in other countries in the recent times to push their economic growth strategy. However, even today, certain countries create war-like situations over piece of land, claiming their ownership. However, today, emphasis among developed as well as developing countries has shifted to another resource, namely, Intellectual Property, the development and acquisition of which have acquired far greater importance among nations, as knowledge has become a prime resource for economic growth.³

Business and Research organizations and countries in the world are spending increasing amount of their GDP on research and development. Pharmaceutical industry is an appropriate example of increasing financial resources allocation for research and development on new drugs, because a discovery of a block buster drug can change the fortunes of pharmaceutical organization. Global scenario on increasing trend on Research and Development funding could be observed from the R&D Magazine study, which states that “global R&D investments will increase by 3.5% in 2016 total of \$1.948 trillion in purchasing power parity (PPP) values for more than 110 countries having significant R&D investments (more than \$100 million)”. Development of Intellectual Property and the protection of Intellectual Property Rights, are the core issues with the idea of developing new products and improving existing products for economic prosperity and enhanced human welfare. Thus protection of intellectual property developed for reaping benefits and encouraging further investment in developing new products, services, and processes have become matters of great significance and concern to countries, business, and research organizations. It must also be stated here that protection of IPR has become increasing concern among nations because of the fact that research evidence clearly demonstrates that Creative pursuits and Innovative activities resulting in new products and services including artistic productions are strongly correlated.

The history of safeguarding intellectual products is extensive; however, it is not until the 16th and 17th centuries that written intellectual property laws and privileges are established, with the first being in Venice (patents) and then England (copyright). Rather than safeguarding the property rights of investors, publishers, or authors, these privileges and laws were established to regulate the printing industry and a particular intellectual product. Historiography demonstrates how intellectual property has been an indispensable component of society since its inception. One of the essential characteristics that delineate property is intellectual property, which serves to safeguard intangible qualities.

³ P. Timmers, *Electronic Commerce – Strategies and Models for Business-to-Business Trading* (John Wiley & Sons, 2000).

Intellectual property encompasses mental creations such as designs, symbols, names, images, and inventions, as well as literary and artistic works.

“Intellectual property” is an umbrella term for a collection of legal doctrines that govern the utilization of various types of concepts and symbols. Intellectual property represents the proprietor's legal claim to a physical product resulting from their creative endeavors.

Intellectual property enables an individual to profit from and invest in his or her own creation. To offer a cursory examination of the legal definition of intellectual property rights, it is essential to reference Article 27⁴. This article establishes the right to protection of material and moral interests arising from the ownership of intellectual property rights related to science, literature, or the arts. The rationales put forth in support of intellectual property generally align with two overarching classifications.

Initially, ethical and moral considerations are frequently invoked by commentators to support intellectual property rights. For instance, it is frequently asserted that copyright is warranted due to the legal recognition of the natural or human rights of authors with respect to the outcomes of their efforts. Similarly, trademark protection serves a valid purpose by safeguarding against the unjust enrichment of third parties through “reaping what they have not sown.”

Vast amounts of literature link the patent system with economic theory. There are numerous property claim theories that incorporate productive activities and ethical objectives. Following are the principles that Justin Hughes extracts from Hegel's Philosophy of Right with regard to the ideal configuration of an intellectual property regime: (a) It is imperative that we allocate greater legal protection to the outcomes of intellectual endeavors that require high expression, such as novel writing, as opposed to those that require less expressive means, such as genetic research. (b) A person's “persona,” which comprises their public image, history, physical appearance, and demeanor, is a significant “receptacle for personality.” As such, it is entitled to extensive legal safeguards, notwithstanding the fact that it is not typically the product of effort. (c) While it is acceptable for authors and inventors to generate revenue, recognition, esteem, and monetary gain from the general public through the sale or distribution of their works in the form of reproductions, they should not be able to waive their right to prevent unauthorized duplication or attribution of their creations. The contemporary rationale for safeguarding intellectual property is grounded in the philosophical framework of Utilitarian theory. Conversely advantageous is the labor theory, which provides the

⁴ Universal Declaration of Human Rights (UDHR).

judiciary with substantial normative validation.

The field of intellectual law and its aggregate and distributive economic significance, as well as its national and international scope, has become a significant arena for debate among interest groups, legislators, and various civil society organizations over the last two decades. The increasing controversies among governments and nations and the internationalization of legal arrangements and institutions in this domain are manifestations of the national interests highlighted by the transnational character of informational products.

A public benefit is an item or service that possesses the economic quality of non-exclusivity. It is impossible to prevent any individual from benefiting from the production of the commodity, regardless of whether they pay for it or not. As free commuters, individuals typically abstain from paying for the product in the expectation of gaining access. The failure to exclude free riders leads to the distortion of market signals and ineffectual resource allocation. By instituting a framework of precisely delineated intellectual property rights, this challenge may be mitigated.⁵

The objective of intellectual property is to strike a harmonious equilibrium between an individual's exclusive right to an invention and its broad application, while also recognizing and compensating the owner for their work. Simultaneously, it serves to partially offset the tendency of such rights to restrict the enjoyment of those creations by the general public. A nation's technological and economic progress will cease in the absence of intellectual property protection. Intellectual property pertains to information that can be simultaneously incorporated into an infinite number of physical replicas located in various parts of the globe.

Intangible property is classified as personal property. Patents, trademarks, copyrights, industrial designs, geographical indications, layout designs of integrated circuits, and trade secrets are all encompassed within the term intellectual property. It pertains to assets that lack a corporeal form. It encompasses a broad spectrum of subject matter. Industrial property and copyright constitute the two principal subfields of intellectual property.

Industrial property encompasses a wide range of intellectual creations, scientific breakthroughs, artistic or commercial designations, trademarks, service marks, and protection against unfair competition. It also includes intellectual property rights arising from artistic, scientific, or literary endeavors.

⁵ Amanda Michaels, *A Practical Guide to Trade Mark Law* (Sweet & Maxwell, 2002).

Intellectual property law establishes exclusive rights over an extensive and varied array of creations, including but not limited to fashion designs, pharmaceuticals, genetically modified animals and plants, novels, computer programs, paintings, films, television broadcasts, and performances. Additionally, it grants protection to the emblems that are affixed to products and services.

Trademarks

According to the “search costs” theory of Landes and Posner, trademarks are valuable because they reduce the amount of money consumers spend on searching, thereby increasing economic efficiency.⁶ The rationale for a trademark system is that it incentivizes manufacturers and merchants to offer superior quality goods for sale. Furthermore, it incentivizes them to disseminate information regarding the qualities of those products to the general public. A trademark, to slightly oversimplify, is a word, symbol, or other signifier that is employed to differentiate a product or service manufactured by one company from those manufactured or provided by other companies. Therefore, the abbreviations SANKA, XEROX, and BIB-the Michelin Man refer to decaffeinated coffee produced by General Foods Corp., dry copiers manufactured by Xerox Corporation, and Michelin Company tires, respectively. The emblem of a series of paperback books published by Penguin Books is a stylized penguin; the manufacturer of Perrier bottled water has registered a distinctive green bottle as its trademark; and OwensCorning has registered the color pink as a trademark for residential insulation.

A word, sign, or symbol expressed through a picture, emblem, combined letters or numbers which is used to distinguish goods and services of an organization from other are referred to as Trademark.⁷

The power of attraction of trade-marks and other “famous brand names” is now recognized as among the most valuable of business assets. However, whatever their commercial evolution, the legal purpose of trade-marks continues to be their use by the owner “to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others” A mark is a guarantee of origin and inferentially, an assurance to the consumer that the quality will be what he or she has come to expect.

Trademarks can be used as a “proxy for innovative effort such as the launch of a new or improved product’ because when a firm introduces an innovation, it is often marketed with trademarks.

⁶ . Ashwani Kumar Bansal, Law of Trade Marks In India, (Thomson Reuters 3rd edn., 2014).

⁷ Ashwani Kumar Bansal, Law of Trade Marks In India, (Thomson Reuters 3rd edn., 2014).

Registration with the authorities is one of but not mandatory condition for protection. A proprietor of a trademark may prohibit the use of any mark, whether identical or similar, by a third party that may cause confusion regarding the origin or sponsorship of the goods and services associated with it. The protection of trademarks remains in effect for as long as the mark remains in use and maintains its unique quality. The judiciary develops a variety of doctrines to prevent trademarks from being replicated or diluted.

Justification for the protection of trademarks are frequently brought into question because of the expansion of trademarks through increased scope of subject matter (shapes, sound, smells) and new types of infringement (wellknown mark protection) and the pressure to expand trademark law's reach even further.

History and Development of Trademark

Ancient potters used trademarks for the first time approximately 3500years ago to identify the source of origin by scratching the creation at bottom.one respected legal writer stated many years ago, citing only an 1857 book for pottery and porcelain collectors as a reference, that pottery was invented in China in 2698 B.C.' The same date appears in many subsequent articles as if it were gospel. But other writers, who either had not read this particular material or chose to ignore it, tell us of Stone Age pottery dating back to 5000 B.C.,' of pottery found in Egyptian tombs of the First Dynasty, i.e., round 3500 B.C. ;' and of potters' marks at least four thousand years old.⁸

Over time, trademarks evolved from their inception and were initially acknowledged by the courts in the English case of 1618, known as Southern v. How.Diverse interpretations exist regarding the origin of the trademark issue in this particular case, as the reference is to an unreported case from the past that denied trademark rights. Priority of appropriation is the only criterion for establishing a trademark, not originality, discovery, invention, or any other intellectual or laborious achievement in the literary sense.

With passage of time, different methods of identification and distinction were developed. Loved ones and pets were given names. Craftsmen applied names or symbol to identify their goods. In 10th Century, simple leaner design marks appeared which were known as merchant marks. These marks are used to prove ownership over the goods whose owners were missing due to unforeseen incidents like ship wrecks, pirates or other disasters. However, early commerce was very limited to only few

⁸ Supra 7.

people as only few traders' needed marks for identification. However, it is difficult to confirm that those marks can be considered as trademarks.

The origins of trademark law can be identified in the advent of the industrial revolution, which made possible the production and distribution of products on a massive scale. As a result of the advent of a competitive market economy, manufacturers initiated the practice of affixing distinctive symbols, insignia, or devices to their products in order to differentiate them from comparable commodities produced and sold by other entities.⁹

During the Middle Ages, two fundamental types of marks were prevalent: the Merchants Mark and the Production Mark. The Production mark was utilized to denote the origin, whereas the Merchants mark indicated ownership. Guilds implemented production marks as a means to ensure product quality and regulate entry into a specific trade. Thus, identifying markings on products have been utilized since antiquity. The primary intent was to signify ownership. As commercial trade evolved, trademarks came to fulfill an additional purpose, which was to identify the origin of products that were being offered for sale in the marketplace. During the Roman era, trademark usage was prevalent; however, it appeared that the onus was on the deceived buyer to initiate legal proceedings against a trademark infringer. In medieval England, the guild system spawned the first widespread use of trademarks. The utilization of distinctive production insignia was mandatory for products produced by the local guilds. A new purpose for production marks ultimately emerged as a consequence of the development of more intricate distribution systems and the expansion of markets across different geographies. Potential buyers were able to discern the origin of the products through the use of the marks, enabling them to base their decisions not only on the repute of the immediate vendor but also that of the manufacturer. Thus, manufacturers, distributors, and other vendors utilized the medieval production mark to transform into the contemporary trademark that signifies their products and services in the marketplace.

Under the expansive view that prevails in most industrialized countries today, trademark can be any symbol that identifies a unique product or service. The conventional definition of trademark is just that; a distinctive mark to trade under, to identify the one or the other individual or organization. The trademarks are verbal or visual expressions of a brand—the name of a company or product, the way in which the name is written, the shapes and colours associated with it. Although the media of communication are constantly evolving and it would therefore be a mistake to limit the definition of

⁹ Supra 7.

trademarks to what has been the convention, this is still the basic definition.

Contesting policies have historically engaged in a struggle over the law of unjust competition. Preserving the public's interest against deception constituted the fundamental policy. Furthermore, the plaintiff's concern regarding the protection of the results of his efforts from being misappropriated must not be overlooked. However, there is also the public-beneficial policy of promoting competition. Underpinning trademark law are the principles of economic efficacy, consumer protection, property rights, and universal justice. Presently, the decision of whether or not to utilize a trademark rests with the vendor. The purpose of contemporary trademarks is not to establish proprietorship, as was the case with ancient proprietary marks. In contrast, they serve as a benefit to the producer. Therefore, trademarks, as an integral element in a highly competitive market landscape, have gained increasing importance in recent times.¹⁰

The objective of trademark law is two folds. One is to protect the consumers from counterfeiting goods or inferior quality goods and another is to protect the reputation of trader or manufacturer who has produced and acquired distinctiveness. In fact, trademark laws facilitate consumers in searching and locate products with expected qualities, easily and at cheaper way which makes market more competitive. On the contrary, when taken to an excessive degree, trademark law may have the opposite effect: it may solidify market monopolies held by dominant firms and hinder the ability of competitors to enter new markets. Constant effort has gone into the development of trademark law to strike a balance between preserving the informational value of marks and preventing their exploitation to obfuscate competitive data.

There are various treaties and convention executed in past to protect trademarks so that the growth and development can be made possible.

Justification and Need for protection of trade mark

In today's highly competitive marketplace, trademark protection is an absolute necessity, as each owner desires his mark to be distinctive, memorable, and readily distinguishable from the competition. Establishing such a trademark is a challenging endeavor, and despite this, infringement results in significant financial losses for the proprietor. As the famous American historian and educator Daniel J Boorstein quotes “An image is simply not a trademark, a design, a slogan or an easily remembered picture. It is a studiously crafted personality profile of an individual, corporation,

¹⁰ Supra 7.

institution, product or service”. Therefore, each mark represents an individualistic persona that must be treated with respect in order to preserve benevolence.¹¹

- 1. Economic justification for protection of trade mark :** A trademark is solely an economic symbol that enables a consumer to distinguish commodities or services that were previously deemed adequate and to reject those that were deemed unsatisfactory. It promotes economic efficiency overall by decreasing the expenses associated with browsing and making purchasing decisions for customers and by encouraging the production of high-quality goods. The function of trademarks in our free market economic system is vital. Marks assist consumers in discerning the expected quality of commodities and services by designating the source of those items. As a result, they aid in the identification of products and services that satisfy the specific expectations of each consumer. Permitting trademark counterfeiting unrestrictedly would deprive trademark owners of the motivation to invest in quality control, promotion, and other essential endeavors that are critical for the establishment of robust marks and brand identities. This outcome would give rise to significant anticompetitive ramifications.
- 2. Quality justification for protection of trademark :** Trademarks establish liability. It would be difficult to detect errors or low-quality products on the part of a vendor in the absence of marks. As a result, trademarks provide an incentive to uphold a favorable reputation regarding the consistent quality of products. Protection of the investment made by the trademark proprietor in the integrity of the mark and the products or services it signifies is a fundamental objective of trademark law. A modest degree of image differentiation additionally incentivizes producers to uphold sufficient quality standards and aids consumers in discerning products that are dependable and of superior quality. The economic term “free rider” is applied to an infringer who “reaps where he has not sown.” By misleading consumers regarding the origin and quality, the infringer is benefiting from the senior user’s mark and reputation in the context of trademark law. A “free rider” of this nature is an economic parasite who legally requires enjoinder. There is no incentive to differentiate one’s own products and services if everyone can profit from the successful seller's mark and reputation.
- 3. Advertising justification for protection of trademark :** A trademark, being a form of advertising, serves the purpose of establishing the identity of the product and the producer's

¹¹ Harish Chandra, *Cyber Laws and Its Protection*, (PHI Learning India, 1st edn., 2012).

name in the minds of individuals who view the advertisement. This enables them to subsequently apply the information they gain and share it with others who share similar desires and requirements for the product. With the proliferation of geographical markets and the escalation of distribution system intricacy, trademarks emerged as a significant advertising tool. When the proprietor of a trademark effectively cultivates a positive perception of his mark in the marketplace, the mark itself may emerge as a significant catalyst for increased sales. Under trademark law, this capacity of a mark to generate benevolence via advertising has also been acknowledged.

International Treaties & Agreements on Trademarks

WIPO administers following treaties and convention along with National and Regional Laws to set International Legal Framework.¹²

Paris Convention for the Protection of Industrial Property (1883)

Paris Convention for the Protection of Industrial Property (The Paris Convention) applies to industrial property which includes patents, utility models, industrial models, trademarks, service marks, trade names, indications of source or applications of origin and the repression of unfair competition.

The substantive provisions of the Convention fall into three main categories 1) national treatment 2) right of priority 3) common rules. The Paris Convention was concluded in 1883 and then was revised at Brussels in 1900. It was thereafter revised in 1911, 1925, 1934, 1958 and in 1967, and was amended in 1979. India is a signatory to the convention. There are 177 countries who are contractual parties to this convention.

Madrid Agreement Concerning International Registration of Marks

The Madrid System for the International Registration of Marks is governed by two treaties: Madrid Agreement, 1891.

Madrid Protocol, 1989

The Paris Convention was amongst the initial attempts to provide extraterritorial protection to

¹² Dr.B.L.Wadehra, Law Relating To Intellectual Property (Universal Law Publishing Co. 4th edn., 2009).

intellectual property but it did not provide mechanism for filing and registering trademarks. In furtherance of the objectives of the Paris Convention, Madrid Agreement was adopted in 1891 to institute international regulations managing trademark applications. It acts as a single window system, wherein, one can file trademark application in one language and pay fees once to get protection in all territories member countries as required. It is not very effective and efficient system.

Per Contra the Madrid System consists of two treaties, the Madrid Agreement of 1891 and the Madrid Protocol which was adopted in 1989 with an aim to address the failures of the Madrid Agreement. A substantial lacuna embedded in the Madrid agreement which hindered participation of major countries in the agreement. Many countries were reluctant to the provision declaring that if the trademark registration gets cancelled or invalidated in the domestic country, then registration in all other countries will stand non est.¹³

The States that are party to the Madrid Agreement and/or to the Madrid Protocol are called the Contracting Parties and collectively form the Madrid Union. The Madrid system comprising of Madrid Agreement and Madrid Protocol is emerging as the definitive and most widely accepted contemporary international agreement system. About 55 countries are contractual parties to Madrid Agreement for Marks and 100 states are member state to Madrid Protocol. The Madrid protocol makes Madrid system more flexible and compatible with domestic laws and organization which are not party to the agreement. Madrid Agreement and protocol are governed by the WIPO. The applicant selects in the international application all the Contracting Parties in whose territory the mark has to be protected.

The international application is submitted through this office itself, which certifies it and forwards it to WIPO to conduct a formal examination. If approved, the mark is recorded in the International Register and it is published in “WIPO Gazette of International Marks”. WIPO then notifies IP offices in all the countries where the applicant wishes to protect the mark.

These IP offices take a decision regarding grant of trademark rights as per their legislations. WIPO records the decision of the IP offices in the International Register and then notifies the applicant. India did not accede to the Madrid Agreement but submitted to the Madrid Protocol on 8th July, 2013, hence becoming a part of the Madrid System.¹⁴

Nice Agreement (1957)

¹³ Kamlesh N. Agarwala and Murali D. Tiwari , IT and Indian Legal System (New Delhi, MacMillan, 2002).

¹⁴ Kamlesh N. Agarwala and Murali D. Tiwari , IT and Indian Legal System (New Delhi, MacMillan, 2002).

A classification of products and services for the purpose of registering trademarks and service marks is referred to as the Nice Agreement. Every member state of the Nice Agreement is required to utilize the Nice Classification for trademark registration purposes, either as the primary classification or as a subsidiary classification. Furthermore, in official documents and publications pertaining to mark registrations, each country must include the class numbers of the goods or services for which the trademarks are registered. There are eleven services and thirty-four classes for products on the classification list. 84 contracting parties are signatories to this agreement.

Vienna Agreement (1973)

Vienna Agreement is classification of marks consist of figurative elements. The classification includes 29 categories, 145 divisions and about 1700 section in which figurative elements of marks are classified.¹⁵ There are 32 contracting parties to this agreement.

Singapore Treaty (2006)

A contemporary and dynamic international framework for the harmonization of administrative trademark registration procedures is upheld by the Singapore Treaty. Expanding upon the foundations of the trademark law treaty, the Singapore treaty addresses more recent advancements in the realm of communication technologies and encompasses a broader scope of application. It is the first international instrument to recognize non-traditional marks and address trademark law. In total, 46 parties have entered into this agreement.

Trademark Law Treaty (1994)

The Trademark Law Treaty (TLT) streamlines and establishes standards for the registration of trademarks at the national and regional levels. This is accomplished by streamlining and harmonizing specific aspects of those processes, thereby reducing the complexity and increasing predictability of trademark applications and the administration of trademark registrations across multiple jurisdictions. The TLT examines a range of provisions pertaining to trademark office renewal, post-registration modifications, and application for registration. The provisions are clearly defined for smother filling of an application. About 54 countries are contracting parties to this treaty.¹⁶

¹⁵ Supra 14.

¹⁶ Supra 14.

Nairobi Treaty (1981)

The Nairobi Treaty safeguards the Olympic emblem, which consists of five interlaced rings, from unauthorized and unapproved commercial use, including use in advertisements, on merchandise, as a trademark, and so forth. A significant consequence of the Treaty is that in the event that the International Olympic Committee authorizes the use of the Olympic symbol in a State party to the Treaty, the National Olympic Committee of that State shall be entitled to a portion of the revenue generated by the IOC in exchange for granting such authorization. This treaty has as contracting participants fifty-two nations.

Indian Trademark Law

The origins of trademark law can be traced back to the year 1860. In India, no official trademark statute existed prior to 1940. Section 54 of the Specific Relief Act of 1877 addressed matters pertaining to infringement and passing off actions, while the Indian Registration Act of 1908 regulated the registration of property rights through the acquisition of a declaration regarding the ownership of a trademark. In 1940, in alignment with the English Trademarks Act, the Indian Trademarks Act was enacted with the objective of fortifying the safeguarding of trademarks. The Trademark and Merchandise Act of 1958 superseded the Trade Marks Act of 1940 in response to the expansion of commerce and trade. The provisions of this all-encompassing Act encompassed trademark registration and protection, as well as criminal liability for the fraudulent use of trademarks and other insignia on merchandise.

Following this, the Trademarks and Merchandise Act of 1958 was superseded by the Trademark Act of 1999, which underwent the requisite alterations to conform to the provisions outlined in the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), which is a component of the General Agreement on Trade and Tariffs (GATT), to which India is a signatory. The primary aim of the 1999 Act is to provide safeguards for trademark users, establish regulations and conditions pertaining to trademark acquisition, and outline legal recourse for the enforcement of trademark rights.

Statutory or common law trademark law is fundamentally founded on three principles: distinctiveness, deceptive similarity of marks, and similarity of products. At present, the Trade Marks Act of 1999 governs trademarks in India; the Trade Marks Act of 1958 has been repealed.

Growth of Trade Marks

The trademark concept emerged, and it subsequently obtained legal protection both domestically and internationally. India lacked an official trademark law prior to 1940. A number of issues concerning infringement, passing off, and the like were resolved through the implementation of section 54 of the old Specific Relief Act of 1877. To complete the registration process, an ownership declaration for the trademark was obtained in accordance with the Indian Registration Act of 1908. In 1940, in response to the aforementioned issues, the Indian Trademarks Act was enacted. This was in accordance with the Trademarks Act of England. Following this, there emerged a growing demand for enhanced and efficacious trademark protection measures due to the substantial expansion of trade and commerce. As a result, the Trademark and Merchandise Act of 1958 superseded this Act. It facilitated the registration and enhanced safeguarding of trademarks, as well as the prohibition of deceptive mark usage on merchandise. Additionally, this legislation permitted the registration of trademarks, granting the rightful owner the exclusive usage of the symbol. The primary aim of implementing this legislation was to facilitate the registration process and enhance the safeguarding of trademarks.¹⁷ The Indian Government subsequently ratified the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS) in 1994. In accordance with the World Trade Organization's recommendation, the Trademark Act of 1999 was implemented in place of the Act of 1958, bringing the Indian Trademark Law into conformity with the TRIPs obligation. The primary aim of this legislation is to grant legal safeguards to the proprietor of the trademark on their merchandise, establish prerequisites for procurement, and establish legal recourse for the enforcement of trademark rights.

Concept of Trade Mark Under Trade Marks Act, 1999 :

A trademark is an identifiable symbol or design that can be graphically represented and serves to differentiate the products or services of one individual from those of others. Examples of such symbols or designs include the form of the goods, their packaging, and color combinations. Thus, a Trademark should be distinctive and not descriptive.

A mark includes:¹⁸

¹⁷ Julius Stone, *The Province and Function of Law*, (Delhi: Universal Law Publishing Co. Pvt. Ltd., 2000).

¹⁸ Milton Mueller, *Trademarks and Domain Names: Property Rights and institutional revolution in Cyberspace* (Telecomm. Pol'y 90, 2012).

Device : It pertains to the visual depictions. Animals, wildlife, and architectural structures comprise this category. It is possible for a collection of devices to acquire a unique identity. e.g. The device of a bamboo grove or the phrase "Bans Ka jungle" appears unique, while the device of a bamboo extract derived from a specific species of bamboo appears descriptive. If part of the device is distinctive and part non-distinctive, device is looked as a whole. Examples of logos and devices that have become trademarks are :

1. In Diamond T Motor Car's Application⁵ THE DEVICE OF A DIAMOND BORDER WITH WORD "Diamond" and letter "T" inside within a diamond device border, in respect of motor vehicles.
2. Mac Donald's double arches,
3. Apple computers' bitten apple,
4. NBC's peacock etc.

Letter : An "letter as a mark" is an identity composed of letterforms that possesses the inherent qualities of uniqueness and distinction. Kalium Meta Sulphit (KMS) was officially registered as a trademark. The letter forms have proven to be extremely beneficial components for the development of an effective mark by the designers. Notable examples of trademarks consisting of letter marks include IBM, GM, 3M, ELBEE, and others.

Numerals : Registration of numerals as trademarks is possible with proof of user. for instance, 555, 501 represents a manufacturer or company and assigns it an identity. Today, logos are emblems associated with a specific company that symbolize qualities such as quality, elegance, and so forth. Popular examples include Maruti, Benz, B.M.W., and others.

Brand : The term "brand" pertains to the types of marks that are affixed to products or services through a marking process that constitutes the trademark. This suggests that the symbols replicate the trademark in their entirety. For instance, Cycle brand safety matches, McDonald's for restaurants, and agarbattis.

Label and Ticket : It refers to a composite mark comprised of multiple elements, such as words and devices, that is typically affixed to the merchandise itself via painting. The label may include material that lacks the distinctiveness of the trademark as well. An item may be affixed with a label called a ticket via a thread. The precise differentiation between a label and a ticket, nevertheless, remains ambiguous.

Name : A name consists of the letters that represent an individual's given or given name, surname, personal name, abbreviation, or the name of a sect, caste, or tribe.

Colour : One may register a color combination as a trademark. Color has also been deemed capable

of being registered and, therefore, protectable in the United States.

Before the House of Lords was the registration as a trademark of ten colour combinations used on various drug capsules to differentiate the sustained release medications contained within. Purported medications were accessible via prescription. There was evidence that these hues had become synonymous with the appellant's product due to extensive marketing and sales. It was determined that colored capsules, which had acquired distinctiveness through usage, were eligible for trademark protection.

Shape : In order for a product's form to qualify as a registered trademark, it must not serve a functional purpose. A shape can be functional if it influences the efficacy or usability of a product. If the shape of a non-functional object has become associated with the manufacturer in the minds of the purchasing public, then that shape may qualify as a trademark. Therefore, a shape may be registered even if it is ornamental and not functional; it serves no other purpose.

Containers : Containers fall within the definition of a mark. The two-dimensional marks are customary and general in form for the trade usage. However, the products be it in two or three dimensional are protectable like the other subject matter

Non-Conventional marks

Marks that incorporate letters, words, numbers, logos, symbols, images, or a mix of these components are considered traditional marks. Hence, the unconventional markings rely on all five senses: sight, hearing, smell, taste, and touch. The expansion of trade and commerce has put pressure on brand owners to find ways to differentiate their goods from the competition. Therefore, a non-conventional mark is one that deviates from the usual criteria of being seen primarily by visual means. There is no provision in Indian legislation for non-conventional marks like smell, sound, taste, moving image, texture image, hologram etc. However, such kind of marks are being registered worldwide and goods bearing such marks are appearing in Indian market also. In this regard, Yahoo's Yodel is the first sound trademark to be registered in India. The Non-conventional marks stated supra are the emerging trends in Indian Trademark sphere and the aspect of their protection has been discussed in this thesis in a separate chapter namely Emerging trends in trademarks and protection granted by Judiciary.¹⁹

¹⁹ Hasan A. Deveci, —Domain Names: Has Trade Mark Law Strayed From Its Path?!, International Journal of Law and Information Technology, Vol. 11 No. 3

Kinds of Trade marks :

- “1. Service Mark
2. Collective Mark
3. Certification Mark.”

Service Mark :

To identify and differentiate the services of one provider from others and to designate the source of services, any combination of words, names, devices, symbols, or any combination thereof is used or intended to be used as a mark in commerce. Real commodities are exempt from the use of service marks. The delivery of services is the only aspect they address. Advertising, publicizing, and selling a product or service all rely on it. It also describes the quality or standard that the service mark stands for. The letters SM stand for it. Services in the areas of housing construction, management, and investment, advertising, and promotion are only a few examples.

Collective Mark :

A collective mark is defined as a distinctive identifier that differentiates the products or services of the members of an association of individuals, of which it is the owner, from those of other entities. The ‘CA’ symbol employed by the Institute of Chartered Accountants and the ‘CPA’ mark designating members of the Society of Certified Public Accountants are merely a few examples.

Certification Mark :

A certification mark is a distinctive symbol or mark that signifies the certification of specific qualities of the products or services associated with that mark. A certification mark is an indication that the owner of the mark has provided assurance regarding the quality, accuracy, origin, materials, and method of production of the products or services being referred to, as well as other relevant attributes. The Certification Mark is registered in accordance with the Trademarks Act of 1999. Entities that wish to apply for registration must possess the requisite “competence to certify” the products in question. Hence, the proprietor of the certification mark ought to be an advocate for the goods to which the mark pertains.

Domain Names as Trade mark :

A domain name is the location in cyber space where a website is hosted; it is used by every online company. As both the manufacturer and the customer are geographically distant, it is essential for firms to have web sites online. The Internet has grown into an indispensable tool for businesses, and as a result, every company is expanding internationally. The domain name is very helpful for internet users while searching for the products and services they want. In this way, domain names have evolved into advertising and identification tools for businesses. Names have “gone up in value faster than any other product ever known to human,” according to Microsoft co-founder Bill Gates. Just as a trademark is useful in physical commercial transactions, a domain name is useful in online ones as well. It is not uncommon for the name of a well-known company or individual to be stolen and used fraudulently. It has occurred to Google, Maruti, and Tata.

Therefore, a distinctive web address that can differentiate a company's goods and services from those of other companies and serve as an online identifier for those goods and services can be registered and protected as a trademark, provided it meets all the requirements for trademark registration. Hon’ble Bombay HC in Rediff Communications Ltd, restrained the defendants from using the domain name ‘RADIFF’ or any other similar name by granting an injunction and held that “when both domain names are considered there is every possibility of internet users being confused and deceived into believing that both domain names belong to one common source although the two belong to two different persons.”

Categories of Trademark on the basis of its Spectrum of Distinctiveness :

A trademark has to be distinctive. Otherwise, it cannot be registered. In this regard, Courts in United States have been consistently following the principles laid down by Judge Friendly in the case of *Abercrombie and Fitch Co. v. Hunting World, Inc*²⁰ as to the distinctiveness of a mark before it acquires the status of a trademark. Accordingly, Abercrombie test (spectrum of distinctiveness) categorizes the marks into three classes : a. inherently distinctive; b. non-inherently distinctive; and c. marks with no distinctiveness.

Arbitrary, fanciful and suggestive marks

²⁰ 189 U.S.P.Q. 759.

Although arbitrary markings are widely understood, they are unrelated to the goods or services they are used on. Their use is unusual and unexpected, which broadens the protection. Since they have no other significance, whimsical marks are created or produced specifically to be used as trademarks for goods or services. As a result, it receives the broadest protection and develops individuality in the most comprehensive sense. Although there is more safety and suggestive markings are intrinsically descriptive, connecting with them requires imagination or perception. They provide an account of the attributes or nature of the goods or services. A suggestive brand allows the customer to use his imagination or impression of the items, whereas a descriptive mark provides straight information about the product or service.

Sometimes, the random, fantastical, and provocative markings are referred to as “technical trademarks.” These marks may be registered even in the absence of any evidence of “secondary meaning,” or proof that the general public really understands these phrases or symbols to identify the source of the products or services. The technological trademarks has inherent trademark value from the beginning. There are three factors that led to the endowment. First, the name itself suggests that it will unavoidably be interpreted as a trademark by the general public. The second is that rivals are still free to describe their products or services even after one supplier appropriates a nondescript phrase for trademark purposes. The third is that initial consumers and any rivals need to know for sure if the word is a trademark.

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W H I T E B L A C K
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