LL.B. IV Term


(General Principles, Enforcement, Abuse of Intellectual Property Rights (IPR’s) and International Conventions, Law of Trade Marks, Domain Names, Geographical Indications and Designs)

1. Introduction to Intellectual Property and its Abuse
   1. General Principles of Intellectual Property Rights
      Nature and Concept of IPR, WTO/TRIPs
      Brief evolution of IPR and its importance in present context
      Types of Intellectual Property
      Enforcement of Intellectual Property Rights (Art. 9-39 TRIPs), by various national laws
   2. Abuse of Intellectual Property—Concept, Redress under Art.40 TRIPs and Competition Law
      Refusal to license
      Conditions of Exclusive Grantback
      Coercive Package Licensing or tieing in
      Market Power and Dominance
      Horizontal and Vertical Restraints on licencee Abuse of Dominant Position by right holder

3. International legal instruments relating to IPR
   Paris Convention, 1883 and TRIPs
   Reciprocity and Priority
   Concept of Minimum Standards
   Concept of National Treatment
   Concept of Most Favoured Nation (MFN)
   The Trade Marks (Amendment) Bill, 2009
2. **Trade Marks Law**


**Note:** Students should note that some cases are decided under the previous Act of 1958 (the meanings assigned to words and expressions under the old Act are to be understood and may be applied to the provisions of new Act of 1999 also)

1. **Introduction**

1.1 Definitions/meaning of: ‘Mark’ S.2(1)(m); ‘Trade mark’ S.2(1)(zb); ‘Service’ S.2(1)(z); ‘Goods’ S.2(1)(j); ‘Package’ S.2(1)(q); ‘Well known trade mark’ S.2(1)(zg) and Functions, General Principles, Need for Protection of Trademarks, Registered and Unregistered Trade Marks

1.2 Use of trade mark on goods/services– S.2(2)(b) & (c), 29(6),

1.2.1 Use in Advertisements –declared as use and ground for protection even without goods/services


1.2.2 Protecting Domain Names as Trade Marks

   *Satyam Infoway Ltd v. Sifynet Solutions Pvt. Ltd*, AIR 2004 SC 3540

1.2.3 Trade Mark for Services

   *Balakrishna Hatcheries v. Nandos International Ltd*, 2007(35) PTC 295(Bom)

   *Health and Glow Retailing Pvt. Ltd v. Dhiren Krishna Paul, Trading as Health and Glow Clinic*, 2007(35) PTC 471(Mad)

2. **Registration of trade mark for goods/services**

   Procedure (S.18 -23), Grounds of Refusal (S.9 & 11), Prior/Vested Rights, Rectification of register (S.57)

2.1 **Absolute Grounds for Refusal of Registration** - S.9(1) Distinctive character in 9(1)(a), 8 types of Descriptive, laudatory marks or indications or words in S.9(1)(b), customary or bonafide practices of trade- – clause 9(1)(c), Proviso to S.9(1) - Acquired Distinctive character and well known marks

   1. *M/s Hindustan Development Corporation Ltd v. The Deputy Registrar of Trade Marks*, AIR 1955 Cal 319

   2. *The Imperial Tobacco Co. of India v. The Registrar of Trade Marks*, AIR 1977 Cal 413
3. Geep FlashLight Industries v. Registrar of Trade Marks, AIR 1972 Del 179

2.2. S.9(2) -- Nature of mark as to deceive the public or cause confusion’
Wide power – no mention of marks or goods
Note, that under 1958 Act it was covered under the expression Deceptive Similarity


3. Relative Grounds for Refusal – S. 11
3.1 Later trade mark  similar with Earlier Trade Marks –S.11(1)
Identity or similarity of Marks resulting -- in likelihood of confusion or – Association with earlier Mark ( Dilution ) and Identity or similarity of goods/services- Overlap with s 9(2)
Determination of Similarity of goods/services (See Jelineks Appln, (1946) 63 RPC and Panda Case)


3.2 Earlier Trade mark – if a Well Known Trade Marks - S.11(2)
Prohibition of registration even for different goods/ services
Factors for determination - 11(6) to 11(9)
Effect of Trade marks registered or used in good faith – S.11(11), effect of Acquiescence

7. Carrefour v. V. Subburaman, 2007(35) PTC 225
(Also on passing off – )

3.3 Refusal of registration on grounds of passing off or under law of copyright – S.11(3)
3.4 Prior/ Vested Rights
Honest and Concurrent user – S.12, Prior user of mark and vested rights– S. 34, Name, Place of Business, Address or Description of Character or Quality of Goods or Services– S.35, Acquiescence – S. 33
4. Passing off, Infringement and Exceptions to Infringement Action

4.1 Enlargement of Infringement protection – S. 29
4.2 For same, similar or different goods/services
4.3 Difference between passing off and infringement
   Passing off- for similar goods/different goods/transborder reputation
9. Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd, 2001 PTC 541 (SC)
10. Carrefour v. V. Subburaman, 2007(35) PTC 225
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4.4 Exceptions –S.30
16. Hawkins Cookers Limited v Murugan Enterprises, 2012(50)PTC389(Del)

5. Trade Mark Dilution and Contemporary Areas  (S.11(1), S.29(4), S.29(8))
17. ITC Limited v Philip Morris Products S.A., 2010(42) PTC 572 (Del)

Protection of Trade Dress & colour combinations; Tarnishment of Trade marks/Comparative Advertising/Disparagement See Also S 29 (8)
19. Pepsi Co Inc v. Hindustan Coca Cola Ltd., 2003 (27) PTC 305 (Del) (DB)
20. Dabur India Ltd. v. Colgate Palmolive 2004 (29) PTC 401 (Del)

7. **Licencing of Trade Marks** – Ss.48 - 53
   - Permission of Central Government not required in 1999 Act
   - Necessity of Actual Quality Control
   - Paradox of Quality Control
   - Supremacy of Licencing Agreement
       1998 PTC 580; 2004 PTC 153 (SC)
       2005 (30) PTC 489 (Del)

3. **Geographical Indications**
   
     1. Definitions- ‘Geographical Indication’(S.2(c)), ‘Indication’(S.2(g)), ‘Goods’ (S.2(f)), ‘Producer’(S.2(k)), Certification Trade Mark, Collective Marks
     2. Concept of Indication of source, Geographical Indication and appellations of origin, Community Right
     3. Kinds of Geographical Indications and Registration
        - Procedure for Registration(Ss. 3-8, Ss. 11-17)
        - Grounds for Refusal of Registration of GI’s (S.9)
        - Registration of homonymous Geographical Indications (S.10)
        - Duration of protection and renewal(Ss18-19)
     4. Infringement, penalties and remedies(Ss. 20-23, Chapter Ss. 37-54, Ss. 66-67, Rules for allowing use of registered GI by authorised users)
     5. Conflict of GI’s with Trade marks (Ss. 25-26)
4. Industrial Designs Law

[Legislation: The Designs Act, 2000]

4.1 Need for protection of industrial designs
4.2 Subject matter of Protection - Design, S.2(d), Original, S.2(g), new or original, appeal to eye, copyright S.2(c)
4.3 Copyright in Design (duration) – S.11
4.4 Registration of design for articles – Ss.3-9 (No provision for opposition)
5.5 Cancellation of Design- S.19

1.6 Piracy or Infringement of copyright in Designs – S.22
1.7 Overlap of Design, Copyright and Trade Marks

26. *Reckitt Benckiser(India) Ltd v. Wyeth Limited*, 2010 (44) PTC 589 (Del (DB)) 203
27. *Samsonite Corporation v. Vijay Sales*, 1998 (18) PTC 372 (Del)

Books Recommended

- WIPO Background Reading Material on Intellectual Property