



Trademark Infringement: Protect your Brand

A trademark is a product or service's brand, emblem, or symbol. Customers recognize a person's or company's product or service through its trademarks. Trademarks are important for any business since they help to build goodwill and keep clients intact with the company. The Trademarks Act, 1999 (the "Act") governs trademarks in India. The Trademarks Act, 1999 allows a product or service's trademark to be registered.

The registration of trademarks is optional under the Act and is not required. The owner of a trademark gains much from trademark registration. One of these advantages is trademark infringement protection. When someone uses a trademark without the permission of the trademark owner, it is called as trademark infringement.



Infringement of a trademark

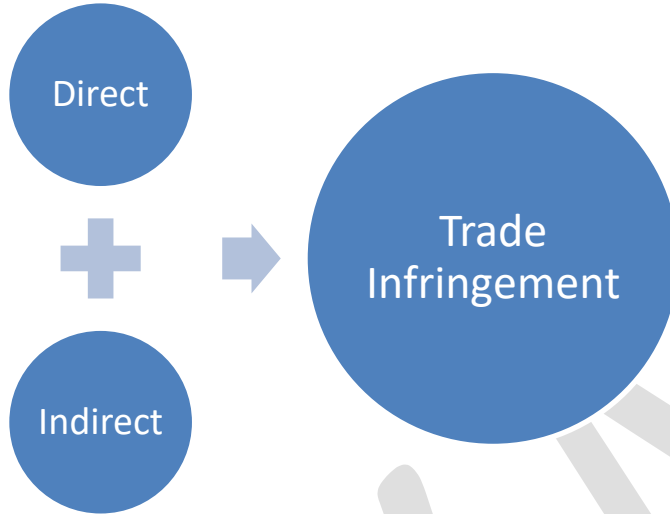


Infringement of your registered trademark arose when someone uses your brand without your permission or authorization, as defined by Section 29 of the Act. Trademark infringement, on the other hand, it necessitates registration of trademark. Someone who uses a trademark that is deceptively similar to or identical to your trademark is liable for trademark infringement under the Act.

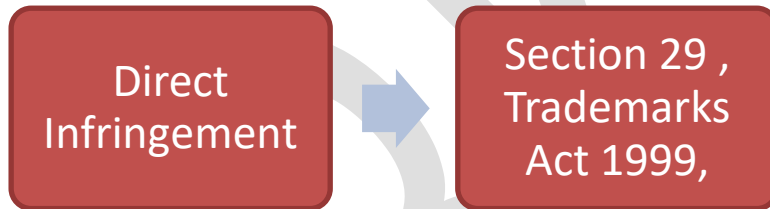
A trademark is deceptively similar or identical to another trademark if consumers believe the trademarked brand/products are the same as your brand/products and sold and provided in the market by your business chain.

There are lots of remedies available for aforesaid infringement one of them is to file a lawsuit against the infringer. Before filing a trademark infringement lawsuit against someone who is using your trademark, make sure to check the following things:

- ✓ Is your trademark protected by law?
- ✓ Is your trademark being utilized for the same products or services like yours?
- ✓ Is the person that is utilizing your trademark is in the same line of business or industry as you?
- ✓ Is the geographical area in which the trademarked products/services are distributed the same as the geographical area in which your products/services are distributed?
- ✓ If a reasonable buyer looked at the trademarked products/services, would they think they were comparable to or confused with yours?



Let's take a look at the parts that make up Trademark infringement:



Following is the Crux of Section 29 of the Trademark Act, 1999:

1. **Unauthorized person** - This refers to someone who is neither the registered trademark's owner nor licensee or Assignee.
2. **'Identical' or 'Deceptively similar'** - Two trademarks would amount to identical or deceptively similar if there is a probability that the public may get confused between them and consider them as if they belong to same group or business line.



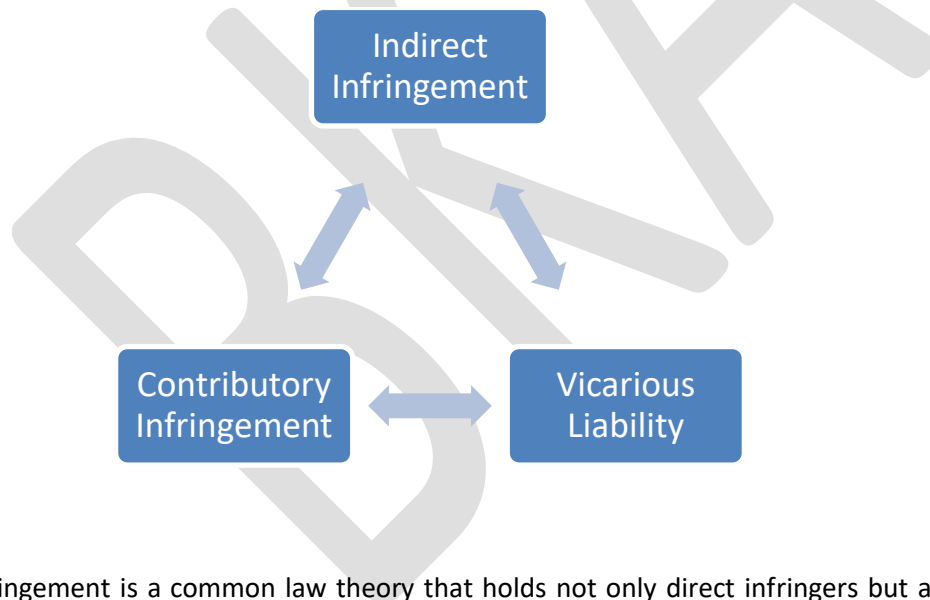
3. **Registered Trademark** – The term infringement aligns with the registered trademark only, which means remedy of infringement only to be availed by the owner of the registered trademark owner. Unregistered trademark would amount to passing off the trademark.

4. **Goods/Services** - To show infringement, the infringer's goods/services must be identical to or similar to the goods represented by the registered Trademark.

Infringement occurs when a registered trademark's exclusive statutory rights are used without their prior permission. The above infraction is a direct infringement.

In India, there is another type of trademark infringement which known as indirect infringement or Secondary liability.

What is Trademark Indirect Infringement?



Indirect infringement is a common law theory that holds not only direct infringers but also those who incite direct infringers to commit infringements liable. Contributory infringement and vicarious liability are two types of indirect infringement, often known as secondary liability.



In two situations, a person may be held accountable for contributory infringement:

1. When someone is aware of the infraction.
2. When a person materially aids or encourages a direct infringer to infringe.

In the following situations, a person will be held vicariously liable:

1. When the individual has the power to control the direct infringer's conduct.
2. When a person receives a monetary profit as a result of the infringement.
3. When a person is aware of the violation and actively participates in it.

In most cases, vicarious liability pertains to employer-employee relationships and similar situations. Section 114 of the Trademarks Act makes a passing reference to this. If a company violates the Act, every individual who is accountable for the company is held culpable, according to this clause.

Exception: Someone who behaved in good faith and was unaware of the violation.

In general, indirect infringement occurs when a person, while not directly infringing on a trademark, causes another person to do so.

With the rise of the e-commerce business, accountability for indirect infringement is becoming increasingly essential, as it holds all parties responsible.

What would not amount to Trademark Infringement?

Section 30 of the Trademarks Act, 1999 establishes various criteria for determining whether or not a trademark has been infringed. The following are the requirements:

- ♣ When a person uses a registered brand in a commercial or industrial matter in conformity with ethical norms;
- ♣ When the use of a registered trademark is not to gain an unfair advantage or prove that the usage is harmful to the trademark's distinctive character or repute;
- ♣ When a registered trademark is used to describe the quality, type, intended purpose, geographical origin, value, production time, or any other aspect of a service or product.
- ♣ When two or more trademarks are used in the same or similar ways.
- ♣ When a trademark is used in connection with accessories and parts



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- ♣ When a user continues to use a trademark with the agreement of the original owner of the registered trademark, who has not rescinded the consent in such situations, the user cannot be considered a trademark infringer.
 - ♣ When a trademark is used within the parameters of the limitations and criteria set forth when the originally registered trademark was registered with the Registry, it cannot be considered trademark infringement.

Measurable Steps:

- *If one believes one's competition is using the other name to confuse clients and works in the same location as one and this is impacting your sales, one must take legal action against the impostor.*
- *The first step would be to contact a trademark attorney with some experience and then follow their advice.*
- *Typically, such difficulties are resolved by issuing a warning letter to the person that is infringing on your brand name, requesting that they desist from utilizing your trademark logo or phrase.*
- *If the infringement backs off, honors your words, and stops using your brand name, hence the problem is solved amicably, and one can back to their work.*
- *If the imposter ignores your warnings and continues to deceive you, you will have to bring the matter to the attention of the court and pursue legal action as necessary.*
- *In District court of appropriate jurisdiction, file a claim detailing the infringement and the impact it is having on your business; if the violation is occurring in multiple locations, go to the state court.*
- *Make a trademark infringement claim and demand that the accused pay you money for the harm they have caused your company along with the injunction on the act of infringer.*

What is the Process for Obtaining Trademark Infringement Remedies?

The following is the procedure under both civil and criminal law:

1. Criminal Remedy

In the event of criminal proceedings, the court may impose the following remedies on the trademark infringer:

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- ♣ With a minimum sentence of 6 months and a maximum sentence of 3 years of imprisonment;
 - ♣ With a penalty of not less than Rs. 50,000/- (Fifty Thousand) but not less than Rs. 2,00,000/- (Two lakh).
 - ♣ Section 154 of the CrPC (Criminal Procedure Code) allows for the filing of an FIR. If the police officer refuses to file an FIR, the person may make a complaint with the Magistrate under Section 156(3) of the CrPC.
 - ♣ An inquiry will be launched and conducted by a police officer after the FIR is filed or an order is issued by the Magistrate. Seizures and searches of products and services with infringed trademarks may be part of the inquiry.
 - ♣ The benefit of a criminal remedy in the event of trademark infringement is that the victim can bring a lawsuit against an unknown person. The name of distributors and manufacturers is sometimes unknown to the victim, which creates a barrier to launching a criminal complaint against the trademark offender. Sections 93 and 94 of the Criminal Procedure Code provide for the seizure and search of an unknown individual.

2. Civil Recourse

The following are civil remedies for trademark infringement:

- **Damages** -The owner of a registered trademark will be compensated for any harm or damages.
- **Injunctions** -The court has the power to order interlocutory injunction of discovery papers, preventing the defendant from placing any assets that could harm the plaintiff and preserving infringing items and services. An injunction is a court order that restricts the use of a trademark that is infringing.
- **Destruction of Property** - For Trademark Infringement, the destruction of goods and services can also be ordered.

The court has the power to grant interim remedies, which can include:

The nomination of a local commissioner is required for the search and seizure of infringing items, the creation of inventories and account books, and other tasks.

To prevent the infringement from dealing with or disposing of assets, which could affect the plaintiff's capacity to recover costs and damages that have been granted to him.

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The Cost of the Lawsuit:

The court could make the defendant liable to pay appellant, the cost of Law suit.

Conclusion:

In India, there is a growing understanding of the importance of registering a brand name to preserve it. In today's ultra-competitive environment, this is tremendously beneficial when running a business. Having a brand name that people recognize can help you boost sales and increase brand value. This is why you should not take trademark infringement lightly, but rather ensure that no other business benefits from your hard work and persistence.

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