

PAPER 9: SPECIALISATION PAPER 3:

LAW OF TRADE MARKS

Objectives:

Trademarks are recognized as a form of industrial property because trademarks make the goods of manufacturer or trade known to the public and thereby enable them to secure profits through the reputation gained by the mark. Therefore trademarking and branding of goods and services occupy an important and prominent place in modern marketing system in which each and every goods and services is sold under their brand name or trademark. Protection of a trademark is necessary not only for an honest trader but also for the benefit of the purchasing public against imposition and fraud. Hence, it is essential for students to equip them to effectively serve the different interest involved in their professional capacity.

Course Outcome:

On successful completion of the course the student will be able to –

1. trace the evolution and growth of trademark law
2. evaluate the advantages of trademark registration
3. describe the procedure for registration of trademarks
4. address infringement and other related issues of trademark

Course Content:

UNIT: I –Indian and international history of trade marks law, meaning and definition of mark and trademark, functions of a trade mark and different kinds of trademarks: Conventional and non-conventional trademarks, Service Marks, Collective Marks, Certification Marks, Well Known Trademarks; Distinctiveness- Inherent and acquired.

UNIT: II –Basic principles underlying the trade mark law in India compared with that of U.K., U.S. and E.U. The salient features of the Trade Marks Act, 1999. Deceptive similarity, difference between similarity of marks, near resemblance and deceptive similarity of marks, and their effects on trademark protection.

UNIT: III – Registrable and non-registrable marks, registration of marks: procedure for the registration of trade mark, certification marks and collective marks; opposition to registration, grounds for opposition; concurrent registration; effect of registration; rectification of register. Transfer of trade mark- assignment, transmission and licenses and registered users.

UNIT: IV – Powers and functions of Registrar, powers of Central Government, constitution and composition of Appellate Board, powers and functions of Appellate Board; infringement of trade mark- action for infringement, Goodwill and passing off action; distinction between infringement and passing off, offences and penalties, remedies for infringement, threat of legal proceedings and trade libel.

UNIT: V –Salient features of international legal instruments on trademarks law: Paris Convention for the Protection of Industrial Property, 1883 (Relevant provisions); TRIPs Agreement, 1994 (Relevant provisions); Madrid Agreement Concerning the International Registration of Marks, 1891 and Protocol Relating to Madrid Agreement Concerning the International Registration of Marks, 1989; Trade Mark Treaty (TLT), 1994; Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, 1957; Role of international institutions in implementation and harmonisation of trade mark legal system such as WIPO and WTO.

Prescribed Books

1. W.R. Cornish, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, Universal Law Publishing Co. Pvt. Ltd., Delhi (2001).
2. Christopher Wadlow, The Law of Passing Off: Unfair Competition by Misrepresentation, Sweet and Maxwell, 2011.
3. P. Narayanan, Law of Trade Marks and Passing Off, Eastern Law House, New Delhi and Kolkata.
4. A. K. Bansal, Law of Trademark in India, Thomson & Reuter, 2014.

Reference Books:

1. Alan S. Guterman and Bentley J. Anderson, Intellectual Property in Global Markets, Kluwer Law International, London, The Hague, Boston (1997)
2. William Cornish and David Llewelyn, Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, Sweet and Maxwell, London (2003).
3. Hilary E. Pearson and Clifford G. Miller, Commercial Exploitation of Intellectual Property, Universal Law Publishing Co. Pvt. Ltd., Delhi (1997).
4. L. Bently and B. Sherman, Intellectual Property Law, Oxford University Press, Oxford.
5. V. K. Ahuja, Intellectual Property Rights, Lexis Nexis, New Delhi.
6. T.A. Blanco White and Robin Jacob, Patents, Trade Marks, Copyright and Industrial Designs, Sweet and Maxwell, London and N.M. Tripathi Private Ltd., Mumbai.
7. T.A. Blanco White and Robin Jacob, Kerly's Law of Trade Marks and Trade Names, Sweet and Maxwell, London and N.M. Tripathi Private Ltd., Mumbai.
8. Department of Business Laws, NLSIU, Bangalore, International Legal Instruments of Intellectual Property Rights Law, Vols. I&II.
9. Ashok Soni, A Complete Reference of Intellectual Property Laws, Vols. 1&2.
10. Elizabeth Verky, Intellectual Property, Eastern Book Publication Co., Nagpur.
11. V. K. Ahuja, Intellectual Property Rights, Lexis Nexis, New Delhi.
12. N.S. Gopalakrishnan & T.G. Ajitha, Principles of Intellectual Property, Eastern Book Company, 2nd edn., 2014.
13. Lionel Bently & Brad Sherman, Intellectual Property Law, Oxford University Press, 3rdedn., 2008.
14. Ranabhir Singh, Law Relating to Intellectual Property, Vols. 1-3, Universal Law Publishing Co. Pvt. Ltd., Delhi.