

## **LL.B. IV Term**

### **Paper : Intellectual Property Law-I**

**(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 tying in

Market Power and Dominance

Horizontal and Vertical Restraints on licensee 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)

Madrid Agreement, Madrid Protocol, 1989 amended on Oct 3, 2006 and Nov 12, 2007,

The Trade Marks (Amendment) Bill, 2009

## 2. Trade Marks Law

[Legislation :Trade Marks Act, 1999, in force from 15<sup>th</sup> Sep., 2003]

**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

*N. R. Dongre v. Whirlpool Corporation*, (1996) 5 SCC 714

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 1
2. *The Imperial Tobacco Co. of India v. The Registrar of Trade Marks*, AIR 1977 Cal 413 8

3.	<i>Geep FlashLight Industries v. Registrar of Trade Marks</i> , AIR 1972 Del 179	18
2.2.	<b>S.9(2) -- Nature of mark as to deceive the public or cause confusion'</b> Wide power – no mention of marks or goods Note, that under 1958 Act it was covered under the expression Deceptive Similarity	
	4. <i>Sunder Parmanand Lalwani v. Caltex (India) Ltd</i> , AIR 1969 Bom 24	22
	5. <i>Sony Kabushuki Kaisha v. Samrao Masker</i> , AIR 1985 Bom 327	
3.	<b>Relative Grounds for Refusal – S. 11</b>	
3.1	<b>Later trade mark similar with Earlier Trade Marks –S.11(1)</b> 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 <i>Jelineks Appln</i> , (1946) 63 RPC and <i>Panda Case</i> )	
	6. <i>K. R. Krishna Chettiar v. Sri Ambal &amp; Co</i> , AIR 1970 SC 146	41
3.2	<b>Earlier Trade mark – if a Well Known Trade Marks - S.11(2)</b> 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. <i>Carrefour v. V. Subburaman</i> , 2007(35) PTC 225 (Also on passing off – )	45
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	

<b>4.</b>	<b>Passing off, Infringement and Exceptions to Infringement Action</b>	
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	
8.	<i>Parley Products v. J P &amp; Co</i> , AIR 1972 SC 1359	60
9.	<i>Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd</i> , 2001 PTC 541 (SC)	64
10.	<i>Carrefour v. V. Subburaman</i> , 2007(35) PTC 225	
11.	<i>Bata India Ltd. v. Pyare Lal &amp; Co.</i> , AIR 1985 All 242	
12.	<i>Milmet Oftho Industries v. Allergen Inc.</i> , (2004) 12 SCC 624	79
13.	<i>Balakrishna Hatcheries v. Nandos International Ltd</i> , 2007(35) PTC 295(Bom)	82
14.	<i>Health and Glow Retailing Pvt. Ltd v. Dhiren Krishna Paul, Trading as Health and Glow Clinic</i> , 2007(35) PTC 471(Mad)	
15	<i>Kapil Wadhwa v. Samsung Electronics Co. Ltd.</i> , 194(2012)DLT23; MIPR2012(3)191	99
4.4	Exceptions –S.30	
16.	<i>Hawkins Cookers Limited v Murugan Enterprises</i> , 2012(50)PTC389(Del)	123
<b>5.</b>	<b>Trade Mark Dilution and Contemporary Areas (S.11(1), S.29(4), S.29(8))</b>	
17.	<i>ITC Limited v Philip Morris Products S.A.</i> , 2010(42) PTC 572 (Del)	128
	<b><u>Protection of Trade Dress &amp; colour combinations; Tarnishment of Trade marks/Comparative Advertising/Disparagement See Also S 29 (8)</u></b>	
18.	<i>N Ranga Rao v. Anil Garg</i> , 2006 (32) PTC 15 (Del)	147
19.	<i>Pepsi Co Inc v. Hindustan Coca Cola Ltd.</i> , 2003 (27) PTC 305 (Del) (DB)	169
20.	<i>Dabur India Ltd. v. Colgate Palmolive</i> 2004 (29) PTC 401 (Del)	181

6. **Exhaustion of IPR** - Art. 6 TRIPs, S.29(6) Trade Marks Act, 1999, S. Patents Act, 1970
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
  21. *Pioneer HiBred v. Pioneer Seeds*, 1990 IPLR 17
  22. *Baker Hughes Ltd v. Hiroo Khushalini*,  
 1998 PTC 580; 2004 PTC 153 (SC)
  23. *MTV Holdings v. Mistrale Publishing Pvt. Ltd.*,  
 2005 (30) PTC 489 (Del)
  24. *Gujarat Bottling v. Coca Cola*, AIR 1995 SC 2372

### 3. Geographical Indications

**[Legislation: The Geographical Indications of goods (Registration and Protection) Act, 1999, in force from 15<sup>th</sup> Sep., 2003]**

1. Definitions- ‘Geographical Indication’ (S.2(e)), ‘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 (Ss.18-19)
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
  - 25. *Bharat Glass Tube Limited v. Gopal Glass Works Limited*, 2008 (37) PTC 1 (SC) 191
  - 26. *Reckitt Benckiser(India) Ltd v. Wyeth Limited*, 2010 (44) PTC 589 (Del (DB)) 208
  - 27. *Samsonite Corporation v. Vijay Sales*, 1998 (18) PTC 372 (Del)

#### Books Recommended

- Ashwani Kr. Bansal, *Law of Trade Marks in India* ( 2009)
- Ashwani Kr Bansal, *Law of Designs, GIs*, ( 2011 )
- P. Narayanan, *Law of Trade Marks and Passing off* (6<sup>th</sup> ed., 2004)
- Kailasam, *Law of Trade Marks and Geographical Indications* (2<sup>nd</sup> ed. 2009)
- V.K. Ahuja, *Law Relating to Intellectual Property Rights* (2009)
- P. Narayanan, *Copyright and Industrial Designs* (2007)
- Latha R Nair & Rajendra Kumar, *Geographical Indication- A search for Identity* (2005)
- WIPO Background Reading Material on Intellectual Property