

“Remedies Against Trade Mark Infringement: Are Civil Remedies Effective?”

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ABSTRACT

This paper deals with remedies against Trade mark infringement: Are civil remedies effective? Trade mark is a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors. In present situation there is possibility of infringement of TM is increasing day by day because of developments in trading and commercial practices, increasing trade and industry the Indian parliament considered it necessary to bring out a comprehensive statute, the Indian parliament enacted the Trade mark Act, 1999. Infringement of the trade mark arise if another person who is not registered proprietor or registered user uses the same mark or a deceptively similarly mark in relation to the same goods and services for which mark is registered. This paper deals with, if the infringement of TM arises, are civil remedies effective. In what cases civil remedies are effective or have effective strength & in what cases civil remedies are not effective or effective weakness, or what are the challenges are faced by the court which is being hurdles to the effectiveness of civil remedies and what are the solutions to these challenges and my opinion to this particular topic all these things are below I am discussing in this paper.

ABBREVIATIONS

1. **TM** – Trade mark
2. **PTC**- Patent, trademark and copy right.
3. **SC**- Supreme Court
4. **HC**- High court
5. **IPR**- Intellectual property rights

INTRODUCTION

In today’s world, Intellectual property rights systems play a very important role in the modern economic growth and the rapid developments in the fields of science, culture and technology worldwide. This term intellectual property in the broadest sense means a property means a property created by human brain, or all rights resulting from intellectual activity in the field of industrial, artistic, literary, or scientific. When the word property came all the human minds thinks as either movable property (radio, mobile etc.) and immovable property (land, or a land etc.), but the concept intellectual property is very wide and includes Artistic, literary, dramatic,

computers programme, inventions, designs, trademarks etc. The concept of property has undergone change especially after the World War II. New rights and properties like patents, copyright, and industrial designs which came to be known as 'intellectual property rights'.

Intellectual property rights received attention due to their uniqueness character and there is possible of their violation easily. The property whether in the form of a copy right, trade mark, or a trade name or in any other form is easily available to general public and is therefore easily theft or exploited so therefore there are many certain legislation are enacted for such protection for intellectual property rights and this laws give rights upon a person who done the creative work from human intellect.

In this research work I am dealing with the concept relating to remedies against Trademark infringement, are civil remedies effective?

Trademark is a visual symbol which may be word to indicate the source of goods, a word or words, name, logo, label, numerals or combination of colors used etc. It is basically a mark capable of being represented graphically and which is capable of being determined the goods or services which may include shape of goods or combination of colors etc. Trademarks comes under the area of intellectual property rights and the object and purpose of trademark law is to prevent an injury to the goodwill and reputation of the enterprise which owns the trade mark as well as ensuring that consumers are not mislead as to product, service or their resources.

With the tremendous changes in the technology & trade since 1958, various new inventions have brought tremendous changes in the human living & culture. Every consumer purchases his goods or heir services from commercial market only when he is satisfied that the goods and services are of good quality and reputation. The manufacturer or a supplier of goods make it sure that the goods produced by him are similar to those manufactured by others and their distinguished marks are different. With a view to identifying the manufacturer, brand, and quality of goods or services produced by a particular maker or company, in this context trade mark play a very important role in the modern commercial market.

The importance of trade mark was recognized only after the industrial revolution and the need of trade mark laws increased. Than a trade and merchandise marks Act were passed in the year 1958, and it was amended several times. But the Act was not in the satisfactory position to meet the requirements and challenges. But with the developments in trading and commercial practices, increasing trade and industry the Indian parliament considered it necessary to bring out a comprehensive statute, the Indian parliament enacted the Trade mark Act, 1999. The object of trademark law is to prevent an injury to the goodwill and reputation of the enterprise which owns the Trade mark as well as ensuring that consumers are not mislead as to product, services and their sources.

History and evolution of trade mark:

When we go back through in barbarian times many of the peoples could not write or read. At that time symbols were logical method was there for letting people know, what belongs to whom?

Prior the marks were there, and marking of animals were existing so that farmer or lord could determine that what animal belong to whom.

For the first time the trade and merchandise marks Act, 1958 was codified the law relating to trademark and provided for the registration of trademark. This Act was not in the satisfactory position to meet the requirements and challenges and it was amended several times. But in the view of developments in trading and commercial practices, increasing globalization of trade and industry, and need to encourage investment flows and transfer of technology and the need to simplify and harmonise trade mark managements systems and to give effect to important judicial decisions, it has been considered, by the parliament, necessary to bring out a comprehensive legislation on the subject. Accordingly the Trade mark Act, 1999 was passed to replace the Act of 1958.¹ Further India became a party to the agreement on trade related aspects of intellectual property rights (TRIPs Agreement), after signing the treaty it become mandate for us to bring our trade mark Law according with the provisions of TRIPs agreement.

Trade mark Act, 1999 was adopted which came into force on September 15, 2003. India also become a party to the Paris convention for protection of industrial property, 1883. The 1958 Act was repealed by Act 1999. The trade mark Act is According with both the International treaties.

SALIENT FEATURES OF TRADE MARK ACT, 1999 OR TO ACHIEVE PURPOSE AND OBJECT, THE PRESENT ACT PROPOSED INTER ALIA THE FOLLOWING, NAMELY:-

- The novel feature of the Act² is introduced that, providing for registration of Trade Mark for service in addition to goods.
- Scope of infringement of trade mark is widened. It provides civil remedies, criminal proceeding and administrative remedies.
- Simplified procedure for registration of trade mark with equal rights.
- Incorporate other provision like amending the definition of 'Trade Marks', providing a single application for registration in more than one class.
- Increasing the period of registration and renewal from 7 to 10 years.
- Making trade mark offences cognizable.

¹ DR.G.B.REDDY'S, INTELLECTUAL PROPERTY RIGHTS AND THE LAW, 266 (11th ed., 2015-16).

² Trade Mark Act, 1999

- Providing for an “appellate board” for speedy disposal of appeals and rectify the applications which under the Act, 1958, lay to the high court.
- Enhanced punishment for Trade Mark offences.
- Protection to the registered user by initiating infringement proceedings.
- Amplifying the powers of the court to grant ex-parte injunction in certain cases and other related amendments to simplify the Trade Mark law and procedure.

MEANING AND DEFINITION OF TRADE MARK

The definition of trade mark is very wide and means, inter alia, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors.³ ‘Trade Mark’ includes any word, name, symbol, configuration, devices, shape of goods, packaging, combination of colors or any combination thereof which one adopts and uses to identify and distinguish his goods from those of others.

‘Mark’ Include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof;⁴

There are three essential of Trade Mark:

- It should be a mark.
- It should be capable of being represented graphically;
- It should be capable of distinguishing the goods or services of one person from those of others.

Some essentials of Trade mark was held in the case of Laxmi V. Patel v. Chetanbhat Shah, AIR 2002 SC 275, that the definition of trade mark is very wide and means, inter alia, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. Mark includes amongst other things name or word also. Name includes any abbreviation of a name.

PROCEDURE FOR ACQUISITION OF TRADE MARK

Under the present Act that is in Trade Mark Act, 1999 have been provided the procedure for and duration of registration of Trade Mark in Chapter II, sections 18 to 26. The register and conditions for registration etc are dealt with, by Chapter, sections 3 to 17.

³ S. 2 (zb), The Trade Mark Act, 1999.

⁴ S. 2 (m), The Trade Mark Act, 1999.

In brief I discussed hereunder about:-

- The procedure for acquisition of trade mark,
- the essential conditions for its registration,
- and the grounds for refusing the registration thereof.

Application for registration⁵

Any person claiming to be the proprietor of a Trade Mark used or purposed to be used by him, who is desirous of registering it, may apply to the registration of his Trade mark.⁶

Therefore either a user or a potential user of a trade mark can apply for its registration with the registrar of trade marks who generally acts as the controller general of patents, designs and Trade Marks also.⁷

In older Act that is the Trade and merchandise Act, 1958 states that single application could not be made for more than one prescribed classes of goods. However under the new Act Trade mark Act, 1999 a single application may be made for the registration of a Trade mark for different classes of goods and services. But the fee payable for such registration should be in respect of each such class of goods and services. This improvement is made by new Trade mark Act, 1999 is more convenient and simple as compared to old Act.⁸

Every application for registration of a trade mark should be filed in the office of trade mark registry within whose territorial limits, the principal place of business in India, of the applicant is situated. In the case of joint applicants, the principal place of business in India, of the applicant whose name is first mentioned in the application, as having a place of business in India determines the jurisdiction of the office of the Trade mark registry. However where the applicant or any joint applicant does not carry on business in India, the application should be filed in the office of trade marks registry, within whose territorial limits the place mention in the address for service in India, as disclose in the application, is situate.⁹

VARIOUS STEPS IN REGISTRATION OF TRADE MARK

The following steps are given in the simplified form, for the registration of a trade mark, under the Trade Mark Act, 1999.

⁵ S.18, The Trade Mark Act, 1999

⁶ S.18(1), The Trade Mark Act, 1999

⁷ S.3(1), The Trade Mark Act, 1999

⁸ S.18(2), The Trade Mark Act, 1999

⁹ S.18(3), The Trade Mark Act, 1999

1. The procedure of the registration begins with the filing of an application for the registration of the trade mark in the respect of goods or services in the prescribed form with the competent registrar of trade marks.
2. After receiving the application, the registrar may either refuse or accept the application. The acceptance may be either absolute or conditional subject to such modifications, conditions, amendments or limitations, if any, condition is deemed to be fit by the registrar.
3. When an application has been accepted for the registration has been accepted either absolutely or subject to certain conditions, the next logical step for the registrar is to advertise the said application.¹⁰ The purpose of the advertisement is to give opportunity to all the interested person to oppose the registration of trade mark if their trade or other interest are likely to suffer because of the registration of trade mark.

Once it is advertised in the trade mark journal, it will be open to other trade mark owner and proprietors to oppose the registration on the ground of misleading or deceptive similarity and passing of etc. further if the trade mark is deceptively similar or exactly alike or identical to another trade mark which lead to confusion on the part of the public etc. Then the registrar may cause the application to be advertised before acceptance.¹¹

4. Any person who claims and interest in the registration of trade mark may oppose the registration by giving a notice in writing in the prescribed manner and by paying prescribed fees within three months from the date of advertisement or re-advertisement of an application for registration. The time for the registration may be extended by the registrar, not exceeding one month in aggregate.¹²

When the registrar receives the notice of opposition, he is required to serve a copy of the notice to the applicant for registration.

Than within two months from the date of receiving such notice from registrar, the applicant should send to the registrar his counter statement of the grounds on which he relies for his application.

If he fails to submit the counter statement within the prescribed period, it will be deemed as if he had neglected or left or abandoned his application.

When the third party prefers an opposition and the applicant files his counter-statement, they are required to produce any evidence to the registrar, who should give an opportunity to both of them to be heard.

¹⁰ S.20, The Trade Mark Act, 1999

¹¹ S.11(1) & (2), The Trade Mark Act, 1999

¹² S.21, The Trade Mark Act, 1999

After considering their case, based on application, counter-statements, opposition and oral representation etc., the registrar should decide whether and subject to what conditions or limitations, if any, the registration is to be permitted.

GROUND ON WHICH TRADE MARK CAN BE REFUSED¹³

Those trade mark which lack distinctive or uniqueness character, it is the absolute ground for refusal of registration.

Such mark which are deceive in nature for public or cause confusion also to public is a ground for refusal of registration.

The mark which is likely to hurt religious sentiments, is a ground for refusal of registration.

The trade mark which consists of only mark or indications to designate the kind, quality, and value etc of goods and service, or which have become customary in the bonafide and established practices of trade cannot be registered or absolute grounds for refusal of registration.

RIGHTS CONFERRED BY REGISTRATION OF TRADE MARKS

Chapter 4th of the trade mark Act, 1999 deals with the effect of registration.¹⁴ Registration of trade mark confers many rights in the proprietor of the trade mark. It may be seen that the rights conferred are not absolute they are subjected to other provisions of the Act and to any conditions and limitations to which registration is subject.

THE RIGHTS CONFERRED BY REGISTRATION¹⁵

The exclusive right to use of trade mark in relation to goods and services in respect of which the trade mark is registered.

The right to obtain relief in respect of infringement of the trade mark.

NO ACTION FOR INFRINGEMENT OF UNREGISTERED TRADE MARK¹⁶

No person shall be entitled to institute any proceeding to prevent, or to recover damages for the infringement of an unregistered trade mark.

¹³ S.9, The Trade Mark Act, 1999

¹⁴ S.27 to 36, The Trade Mark Act, 1999

¹⁵ S.28, The Trade Mark Act, 1999

¹⁶ S.27, The Trade Mark Act, 1999

Other rights:-

- Registered proprietor of a trade mark, he has a right to apply for correction of register to correct any error in the name, address or description of the registered proprietor.
- A registered user may institute proceedings for infringement in his own name.
- The proprietor of a trade mark also has the right to file suit for infringement of his right and he can obtain the reliefs in the nature of :- injunctions, temporary or permanent, damages and account of profits:

REMEDIES FOR THE INFRINGEMENT OF TRADE MARK

Infringement of trade mark is a violation of exclusive rights full of regard to trade mark. Infringement may arise or occur when one party ‘the infringer’ uses a trade mark which is similar or alike or confusingly similar to a trade mark possess or owned by another party in connection to services or product which are alike or similar to the services or products which registration covers.

Under the trade mark Act, 1999, both civil and criminal remedies are available against infringement and passing off.

WHAT IS INFRINGEMENT?

It is a violation of the exclusive right granted to the registered owner of the trade mark to use the same. Infringement of the trade mark arise if another person who is not registered proprietor or registered user uses the same mark or a deceptively similarly mark in relation to the same goods and services for which mark is registered.¹⁷

In totality of the impression of the trade mark produce should be such as to cause confusion or deception in the mind of the purchasers.

In case¹⁸ Delhi high court held that the trade marks “Energex” and “Enerjase” are dissimilar even though they dealt with the similar product.

In the cases of infringement either of copyright or Trademark normally an injunction must follow. The grant of injunction also become necessary if another person dishonestly uses the trademark itself of any other proprietor or owner of trade mark.

¹⁷ S.29, The Trade Mark Act, 1999

¹⁸ Indo-pharma pharmaceuticals works ltd, v. citadel fine pharmaceuticals ltd., AIR 1998 Del. 347 (348, 352 & 354).

ESSENTIALS OF INFRINGEMENT:-

The following elements must be present in order to constitute infringement of a trade mark:-

- Using a registered trademark by a person other than its registered owner or proprietor or registered user.
- The causing of confusion on the part of public, it create a confusion to a public in relation to goods and services.
- Using either the whole of the registered trademark or an adapted one by making of few additions and alterations.
- The infringing trademark is identical or similar to the trademark already registered.

These all elements are essential to constitute that trade mark is infringed. The most common form of infringement takes place when an trader makes an attempt to take unfair advantage by using the trademark of another owner or proprietor of trade mark which affect the rights of the original owner or user of a trade mark. Therefore using deceptively similar marks to create confusion is the worst form of infringement of trade mark and for that civil remedies are also available against infringer of rights of the original user or proprietor of trade mark.

DIFFERENT FORMS OF INFRINGEMENTS:-

There are different forms of infringement of trade mark:

- It may be using of marks identical or similar to trade marks by unauthorized persons in relation to similar or same trade.
- Using identical or similar marks which are similar of those registered trade mark in non-similar or different trade also would amount to infringement.
- Advertising the registered trade mark of another to promote one's trade also is infringement.
- A registered trademark will also be infringed by the spoken use of words as well as by their visual representation in cases where the distinctive elements of a registered trade mark include such work.
- Taking substantial features of the mark already registered & in use would amount to infringement.
- Printing of labels of owner or plaintiff without any authorization.
- Copying a mark amount to infringement.

PERSON ENTITLED TO SUE FOR INFRINGEMENT:-

The plaintiff file a suit for infringement may be either

- The registered trade mark user or owner, or
- The registered proprietor of the trade mark or his legal successor, or
- Any one of the joint proprietors of the trade mark, or
- An applicant for registration of a trade mark
- A foreign proprietor of a trade mark registered in India when infringement arises in India.

PERSONS LIABLE TO BE SUED

If an infringement action is occurs the person who become liable to be sued are:-

- The agent of an infringer; or
- The infringer himself; or
- In several case the master responsible for his servant's act of infringement; or
- The directors and promoters of a limited company, if they have personally committed or directed the infringing acts.

DEFENCES AVAILABLE IN AN INFRINGEMENT ACTION

When an infringement action has been initiated against the defendant he may set up any following defences, depending upon the circumstances of case and applicability of relevant defence to his case;

That,

- The plaintiff is not entitled to sue, as he has no title or proprietorship;
- The use of trade mark is not infringement or it is protected by the provisions of section 30 which lists out the Acts which do not constitute infringement.

Remedies for trademark infringement

Whenever, a registered trademark is infringed, in order to protect it, the following remedies are available:

1. Civil remedies;
2. Criminal remedies;
3. Administrative remedies;

For the purpose of infringement of an unregistered trade mark, the common law remedy of passing- off action can be invoked.

EXPLANATION TO THE CIVIL REMEDIES ARE CIVIL REMEDIES ARE EFFECTIVE;

1. CIVIL REMEDIES

The court in the cases of trademark infringement grant relief in any suit whether it is infringement or passing off (unregistered trademark), it includes interim injunction and permanent injunction, and either damages or an account of profit in the cases of infringement of registered trademark or unregistered trademark. Whenever a registered trade-mark is violated of infringed the aggrieved person can make the use of the remedies available in a civil court. To restrain the defendants from using the registered trademark of the plaintiff.

Legal proceedings constituted against the infringer by the owner of the registered trademark for the unfair business practices. The two types of remedies are available to the owner or proprietor of the trade mark against the unauthorized use of trademark by the infringer. Civil and criminal remedies are available under the trademark Act, 1999. Civil proceedings initiated before the district court.

In an infringement action, the plaintiff may seek following reliefs, civil remedies of TM are available in following heads:

1. An injunction restraining further use of the infringing mark;

Stopping someone or one person from doing a particular task or activity, it is an action of injunction by a judicial process. It is related to TM infringement. Injunction is an action for restraining a person from unofficial or unauthorized use of TM. The court grant protection to the TM owner.

The injunction may be sought includes the:-

- Anton piller order;
- Mareva injunction
- Interlocutory injunction; &
- Perpetual/permanent injunction

Anton piller injunction order, which is an ex-parte order to inspect the defendant's premise without notice, where there is possibility of the defendant destroying or disposing of the damaging material. Such an order is for inspection of the premises of the defendant.

Mareva injunction, mareva injunction is to protect the interest of the plaintiff. In a suit by plaintiff against defendant court granted order to restrain the defendant from disposing of their

assets within the jurisdiction until the trial ends or court give judgment in an action for infringement of TM is passed.

Interlocutory injunction or temporary injunction means prohibition an action by party to a law suit until the disposal of suit.

Temporery injunction is not granted by the court in the case if plaintiff have bear irreparable loss. As regards the temporery injunctions, the procedure is well covered under code of civil procedure, 1908 and also the specific relief Act, 1963.

Permanent or perpetual injunction is a final order of a court that a person or entity abstain or withhold from certain Activities permanently.

2. Damages on account of profits or Damages.

Amount of damages is granted by the court after considering that what the actual loss of owner of TM was arises due to infringement of TM. Any profit is earned by the infringer by the TM of another registered owner, all the profit or certain amount of monetarily compensation is provided to the owner of TM.

The damages in TM as a relief plays a very important role and the main Aim of damages is monetary compensation to the owner of TM whose rights is infringed by another person that is infringer.

In the case of Microsoft corporation v. Mr. Kiran and Anr, the court in this case observed that the legal position in India related to granting damages in cases of infringement of copyright and TM is initially growing or progressive. The court in the cases of infringement of copyright & TM play a very effective role and now started granting the relief of damages with the view that defendant cannot escape as a consequence of its disappearing from legal proceedings. The claimant has a right to damages if defendant infringed the right of claimant or cause of action is infringement of a registered TM or passing off.¹⁹

3. Custody of materials infringed;

This remedy states that an order for delivery-up of infringing labels and marks for destruct or wipe out or erasure, this sentence means that the court may ask or give order to the infringer to deliver all the goods which are labeled with the brand name that is well known trade mark or registered trade mark or court may direct the authorities to destruct all the goods in which TM is used by the infringer.

¹⁹ Manupatra Intellectual property Reports, February 2014.

And where the TM is related to services means when the service mark is infringed the order is given by the court to stop the services instantly by the infringer.

CASE LAWS:

In the case²⁰ the Delhi High Court found that the defendant was using the Trade mark “like-me” which was similar to “lakme”, the registered trade mark of plaintiffs. Both the Trade marks were apart from dealing with the same range of cosmetic products. The court held that there was every possibility of deception and confusion being caused in the minds of prospective buyers of the plaintiffs products, therefore it confirmed the injunction against the defendant.

In the case²¹ the High Court dealt with the infringement of Trade Mark “DIPLOMAT” related to whiskey, by using a similar Trade Mark viz “COX DIPLOMAT PREMIUM WHISKEY” by the defendant. The court found that there was deceptive similarity between the label used by the plaintiff as his trade mark and the one introduced by the Defendant & that is amount to infringement of the plaintiff’s trade mark within the meaning of section 29(1) of the trade mark Act, 1999.

ARE CIVIL REMEDIES ARE EFFECTIVE IN TRADE MARK INFRINGEMENT?

Are civil remedies are really effective? By the effectiveness of civil remedies, it means that in the infringement of TM, are civil remedies are successfully implemented, achieved all the object properly and fruitfully which is given in the Act, and the problems which are arise due to infringement of TM are solved successfully or properly or fruitfulness which protect the rights and interest of the original owner of TM which is violated by infringer.

The purpose and aim of civil remedies is to restore or repair or refurbished the party injured (Viz. plaintiff) to that same position where in before the wrong occurred. Damages and injunction are the main civil remedies in a matter of the infringement of TM.

With the reading many of the case laws deals with TM infringement, and the provisions which is given in the TM Act, 1999 related to the infringement of TM and their remedies which are available in the violation of the rights of the original owner of TM. The question before us Are civil remedies are effective? With such reading the cases laws and the provision of the Act²² I came to the point and throw the light in this matter that, civil remedies have effective strength (civil remedies are effective in nature) as well as effective weakness (civil remedies are not fully effective in nature).

²⁰Lakme Ltd v. Subhas Trading & others, 1996 PTC(16) , Delhi, 567.

²¹Cox Distillery and another v. Mc dowell & co. ltd, 1999 PTC (19) 507 (M.P).

²² The Trade Mark Act, 1999.

If we talk about the damages remedy it has an effective strength as well as effective weakness. Damages means, it is a type of civil remedy, it is the most important remedy which plaintiff can avail after TM is infringed. It is type of civil remedy include an amount of money being paid to the plaintiff by the defendant to generally compensate them for injury or damage suffered or impairment.

Damages effective strength :- in civil remedies, damages are very effective remedy when the loss suffered by an original owner of TM was an economic loss or loss to goodwill or reputation etc.

Damages effective weakness:- after the TM is infringed by the infringer or violates the rights of the original owner of TM. Damages is an effective remedy but damages cannot restore the plaintiff's to their original position likely before the infringement of TM is occurred or if the plaintiff had suffered loss or injuries other than pure economic loss.

Damages cannot restore the plaintiff to their original position, this point resulted that damages that is part of civil remedies is not fruitfully effective. And another effective weakness was that damages also do not compensate for the time, inconvenience caused, or stress caused by the plaintiff whose right is violated due to infringement & cost of having to take a matter to a court. This point also resultant, that civil remedies are not effective in nature. It is an effective or less effective both. We cannot say that civil remedies are fully ineffective. In many of the cases I discussed below this paper we cannot say that civil remedies are fully ineffective it is effective as well.

Second important part of civil remedy is injunction, an injunction is an order of the court directing the doing of some Act or restraining the commission or continuance of some Act. The court has discretion to grant or refuse this remedy and when remedy by way of damages is a sufficient relief, injunction will not granted.²³

Effective strength:- Various kinds of injunction like Mandatory injunction & prohibitory injunction in certain circumstances can effectively prevent the future damages to the plaintiff's reputation.

Effective weakness in injunction:- the remedy of injunction will not compensate the plaintiff for any loss suffered.

Apart from these most of the challenges are faced by the court which is being hurdles to the effectiveness of civil remedies. If these challenges are solved then we will say that civil remedies are effective.

Challenges faced by the court and their solutions.

²³ DR.R.K.BANGIA, LAW OF TORTS, 427 (23rd ed., 2013).

1. In the provision of the Act²⁴ there is an absence or non-appearance of any “cost of Damage” which has led to lesser restraints over the infringers. The solution of this challenge came through by the judgment of Delhi High court in case of **Hero Honda Motors Ltd v. shree Assuramji scooters**. in this case Delhi High court made a differentiation between punitive damage and compensatory damages. The court in its Judgment classified damages into three heads: - compensatory damages, punitive damages and damages due to loss in goodwill and reputation. Thereafter this precedent all the courts in nation have learned the art of awarding damages of these three natures in need for in any case.²⁵
2. The remedy for passing off stand to be a next challenge in trade mark legislation. Due to British history of the nation the common law principle was adopted. Constructing the principles guidelines for determining passing-off and preventing copying of well known TM ha become a major challenge. This is specially a problem in fast moving consumable goods sector.²⁶

As India is a large country & world’s second largest market in terms of population, copying well known TM is a very big occurrence here. The decided case by the Delhi HC is a preceding of awarding damages as an effective remedy to this problem but not sufficient. Certain other measures need to be taken by the registry offices, regular check on TM register for similar mark.

Infringement matter should not be taken as leniently even though the infringer of TM has established a long use of the TM. Ex. If well known TM has copied by a person and the copied mark used in any part of India for four years, it should not be given any leeway or liberty.

The another challenge in a matter of passing off that there is an absence of any forceful or positive definition of ‘goodwill’ and ‘reputation’ in TM legislation. While action of passing off is based on ‘reputation’.
3. The newest challenge in the modern era where there is a lot of usage of internet, e-commercial sites etc. challenge faced by TM authorities is the internet issues. Internet issues in India deal with the misuse of TM as domain names. Along with this issue sale of fake, copy goods of well known brand by online marketing or e-commercial shopping sites had created dual problems in this field of TM infringement. The existing legislation (TM Act,1999) seems to be inadequate for solving such problems. Many of the markets in all over India selling a fake products of well-known TM in the name of 1st copy or 2nd copy.

²⁴ The Trade Mark Act, 1999.

²⁵ Manupatra intellectual property reports (MIPR), February 2014.

²⁶ Manupatra intellectual property reports (MIPR), February 2014.

The court have come across such cases many time, mainly the courts in metropolitan cities, the court faces two issues:

- In the issue of misuse of TM as a domain name, the defendant(domain name infringer) provided fake addresses and thereafter when court sent a notice, he never turns up.
- In this circumstances the website operation can be stopped, but no punitive Action (to inflict a penalty or punish) can be taken against the infringer, as he won't respond to the notice of court.

If these challenges are solved than we say that in a matter of Infringement of TM, civil remedies are effective and as I discussed below in this paper, court play a very important role & make possible efforts to provide civil remedies effectively.

CONCLUSION

In the above research I want to conclude that civil remedies are effective as well ineffective, it has effective strength as well as effective weakness. Civil remedies are ineffective because merely in the legislation there is absence of any forceful or positive definition like goodwill, reputation etc. There is no such classification of damages or in the matter of passing off cases it is difficult to prove passing off as actual deception is to be proved instead of mere possibility of TM in infringement, and many reasons of ineffectiveness I had discussed below in this paper which state that civil remedies are not effective. And in many of the cases civil remedies are very effective in nature but we can't say it is fully effective because of some challenges and hurdles I discussed below.

If some challenges are solved effectively and efficiently there is possibility of effectiveness of civil remedies.

In my opinion all the TM should be registered there are some benefits of such registration of TM are:-

- As I discussed the procedure of registration of TM, during the registration of TM when the application is made by person or proprietor, the purpose of the advertisement is to give opportunity to all the interested person to oppose the registration of trade mark if their trade or other interest are likely to suffer because of the registration of trade mark.
- Secondly, by the registration of TM an injured party initiate criminal Action by registration certificate and it makes easy for the police.
- Registration of TM gives the TM owner a jurisdictional option to sue in the city in which he carries his business irrespective of the fact where the infringers place of business.
- Infringement action is more stronger than passing off Action.