



BOOK REVIEWS

LAW OF TRADEMARKS IN INDIA WITH INTRODUCTION TO INTELLECTUAL PROPERTY (2006). By Ahwani Kr. Bansal. Cliptrade, 13 Hakikat Nagar, The Mall, Delhi- 110009. Pp lxxi + 1307. Price Rs. 1120/-.

TRADEMARK IS an identifying symbol. A trademark or a trade name is an important source of product differentiation that individualises the goods and gives the goods a distinct personality of its own. A good brand name carries its own image and goodwill and consumers often attach certain qualities to the product. Trademarks are essence of competition. They promote competition in the market and assure the product quality. They make possible a choice between competing items by enabling the purchaser to distinguish between the goods. To protect trademark is to protect the consumers from deceit and confusion and it fosters fair competition.

The book under review¹ is a new edition of the *Law of Trademarks in India*, the first edition of which was published in 2001. Since the first edition, several new interpretations have been given to various trademark related concepts and a plethora of new judicial pronouncements have also been given by the courts. Hence, the author has attempted in the present volume an extensive revision of case laws as well as the new concepts.

To introduce a species a small description of the genus is essential. Thus, before introducing the trademark, the author elaborately defines and explains intellectual property (IP) and its various branches. The book opens with a general essay on intellectual property. This chapter, *inter alia*, deals with the nature of IPR rights, its benefits, acquisition and exploitation of IPRs. The description on 'India's comparative advantage in different types of IPRs'² brings into light our strength and weakness in the contemporary IPR driven market economy. The author captures in this chapter the relative importance of trademarks and other constituents of IPRs.³ The introductory chapter also conceptualises TRIPS⁴ centred definition of intellectual property. The chapter is structured and presented in such a way to afford a sufficient

1. Ashwani Kr. Bansal, *Law of Trademarks in India with Introduction to Intellectual Property* (2006).

2. *Id.* at 21.

3. *Id.* at 24.

4. Trade Related Aspects of Intellectual Property Rights.



perspective to any reader, which may include a non-legal or non-IPR person, regarding the basic notions and rationale of IPRs and how the system works in the present competitive market economy.

After having created a strong foundation of intellectual property for the readers, the author unfolds to them the fundamental and legal concepts of trademarks. Primarily the concept of trademark is a business concept. Hence an attempt is made to understand the business concepts in the beginning and then the legal concept of trademark is explained with the help of relevant statutory provisions and judicial pronouncements. A successful brand is the most important source of market power. The entire market approach is linked with trademarks/famous brands. Consumers look at the brand than the product. And so the author approaches the subject from various perspectives: trademark as a tool of marketing; trademark as a link between consumer and seller; trademark as a catalyst for economic growth; trademark as a constitutional right etc. This approach is undoubtedly highly beneficial to appreciate the function of trademark in the global competitive market. A brief distinction between various kinds of trademarks, *viz*, certification mark, collective mark, textile mark, well-known trademarks, service marks, etc. are also given. The author critically analyses the definition of trademark and highlights the changes brought about by the 1999 amendments in the definition and substantive requirements for registration. The book also differentiates between various terminologies such as trade name, property marks and brand names etc., which are generally mistakenly used as synonyms.

When dealing with the subject of trademark authors usually concentrate on legal principles and issues alone. But the book under review presents a comprehensive coverage on the economic functions of trademark as well. The author also analyses how trademark can be best used as a source of revenue for the government. The topics such as rights of proprietor of trademark, authorities under the Act and their jurisdiction etc. with relevant rules are exclusively dealt with.

Trademark law, whether statutory or common law is based broadly on three principles, *viz*, distinctiveness, deceptive similarity of marks and similarity of goods. A proper understanding of these principles is indispensable to appreciate the law of trademark. These concepts are explained and interpreted by analysing a series of case laws and by critically examining the statute. One can find in this book a rare exposition of the principle of absolute and relative grounds of refusal of trademarks. There exists a wrong notion that trademark law is evolved to protect the interests of traders/manufacturers of goods alone. Obviously the interest of traders and producers of goods/services are protected by trademark laws. However, more importance is attached to the interests of the public to assure them unchanged quality and to give



them satisfactory assurance. Consumer has an inherent right to be protected from deception and confusion whether there is any direct financial injury or not. The use of trademark is to protect the consumers from deception and confusion as to the origin of goods/services and its quality. By emphasising the consumer protection function of the trademark, the author illustrates how the courts are interpreting and enforcing trademark concepts for the protection of consumers' interests.

Attempts have been made from time to time by persons to expand the boundaries of the definition of trademark. Shape trademarks, sound trademarks and smell trademarks are recent development in the trademark jurisprudence and one can hardly find any literature on these topics. However, the author has exhaustively and comprehensively described these novel concepts with illustrative cases and examples. Though principle of exhaustion is an old principle, hardly any book on intellectual property explains the principle in a reader friendly tone. The author has devoted one entire chapter to depict exhaustion right doctrine in the domestic and international market. The merits and demerits of exhaustion, the concept of parallel importing and grey goods are discussed elaborately with case laws.

A trademark can be renewed for any number of times and to keep a trademark alive it must be in constant use. Licensing of trademark helps the proprietor to use his mark in various countries of registration. Licensing, assignment and transmission of trademark are crucial issues which involve many legal questions. The author has very carefully and beautifully narrated the entire legal issues surrounding the transfer of trademark rights.

A student of trademark law may always confuse between the right under concurrent registration and vested rights. No books so far have differentiated the difference between the two. The author has devoted one chapter in explaining and differentiating the right under concurrent registration under section 12 and vested rights under section 34.

Trademark law is not only a branch of intellectual property laws but also an important branch of commercial law. It is about commercial symbols and the significance and power that they represent in the market. The law of trademark thus aims to prevent unfair competition. Trademark infringement is violation of standards of commercial morality. Trademark infringement is a type of unfair competition. The Indian Act does not have exhaustive provisions on infringement and passing off. Hence it was for the judiciary to interpret and evolve tests to determine infringement/ passing off tests on similarity and dissimilarity principles etc. Through a series of case law the judiciary has interpreted and formulated basic principles to determine trademark violation. The author has in a systematic way arranged all the case law that either determined or expanded the concept of infringement/passing off. One must



appreciate the author's analytical skills in critically examining the development of legal principles on infringement and passing off.

Another feature of the work that makes it a distinct one is the selection of related topics surrounding the trademark regime. For example, one chapter exclusively deals with protection of trademark by copyright law. Another chapter deals with foreign trademarks in India. Another chapter focuses on protection of trademark as domain names. Such trademark related topics usually find no place in general trademark literature. But the book under review attempts to bring fundamental trademark principles as well as trademark related IPR issues in a single volume. It enables a reader to have a comparative study of trademark principles in relation to other forms of IPRs.

With the advent of e-commerce, market entities use trademark as domain name to mark their existence in the cyberspace. Trademarks have become vital aspects of trading on the Internet. It gives rise to trademark infringement issues in the cyberspace. The new chapter on domain name discusses both national and international jurisprudential issues relating to domain names by examining case laws and legal policies.

Intellectual property laws are operated internationally and the transboundary operation is based on international agreements. To understand the international protection and transboundary operation of trademark one must know how trademarks are being protected in the international markets. It calls for a careful analysis of various international treaties to which India is a signatory. The last part of this work hence presents the international legal regime on trademark, including the relevant provisions under Paris Convention, TRIPs Agreement and Madrid Agreement. This will help to test the conformity/compliance of Indian Act with that of the international laws.

Although the new Act⁵ differs from the UK Acts of 1938 and 1994 in certain important aspects, the basic principles relating to the trademark law are the same in both countries. The principles enunciated in the decisions of the English courts are, therefore, frequently quoted with approval by high courts as well as apex court in India for interpreting various provisions in the Indian Act. In the absence of any Indian precedents, English precedents are held in high repute and high persuasive value is attached to them. This justifies the reference in the book to English precedents. Unlike other books on trademark, which heavily relies on English precedents and sometimes on English cases alone, the book is primarily based on Indian judicial decisions and hardly any Indian case is missed out from the author's scrutiny.

5. The Indian Trademarks Act, 1999



In this second edition of the book, the author has meticulously revised all the chapters contained in the first edition. Since the law of trademarks has continued to develop in response to the new demand of the business realities the author has substantially re-written the coverage of several key topics. In the new edition, the number of chapters have increased from 24 to 32 and 350 new pages have been added as new matters have been blended into previous material.

New chapters on shape trademark, foreign trademarks, application of passing off principles in medicinal sector, trademark in advertising, domain name protection, disparagement of trademark, and distinctiveness of trademark have been suitably incorporated in the book.

The meticulously revised edition covering statutory, judicial and market changes with its bulk appendix covering national as well as international trademark laws and rules makes the work a thoroughly updated one in every sense. Unquestionably, it will positively contribute to the legal literature available on the subject and it will certainly prove to be useful to members of society including bar, bench, academia and students.

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