

MANUPATRA INTELLECTUAL PROPERTY REPORTS

- For inventing business methods no incentive is required because better business methods are necessary ingredients of the art of doing business and further the need for making more money is inexorable. Page [Yahoo Inc v. The Assistant Controller of Patents and Designs, Chennai and rediff.com India Limited] 0001
- To constitute an infringement, a person need not adopt and use the whole of the mark of the Plaintiff and it is sufficient if the mark used or proposed to be used by him is identical with or deceptively similar to the mark of the Plaintiff. [L'Oreal v. Dushyant Shah] 0045
- When a party is using prior user as a shield in an action for infringement, it is necessary to prove that they have been continuously using the trade mark in respect of the goods manufactured or marketed by them. [M/s. Nakoda Dairy (P) Ltd. v. M/s. Kewal Chand Vinod Kumar] SNC3
- Merely hosting a category of copyrightable content, such as music videos, with the general knowledge that one's services could be used to share infringing material, was insufficient to meet the actual knowledge requirement under § 512(c)(1)(A)(i). [UMG Recordings Inc. MGB NA LLC LLC MBG UK v. Shelter Capital Partners LLC LP LLC] C-1
- Amazon, Google, Facebook threaten to flash black screens in protest to government censorship D-3
- Copyright Society Challenges Govt. Circular in Bombay High Court E-2
- First amongst Equals: Review of the Historical Perspectives of the Trade Mark Legislation and Registration [An article by Saravanan A, Filma V, Edited by Dr. Sudhir Ravindran] F-11

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First amongst Equals: Review of the Historical Perspectives of the Trade Mark Legislation and Registration

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Intellectual Property Rights help people to assert ownership on their creativity and innovations in various fields. There are many kinds of IPR and one of the most vibrant amongst them is trade mark. It is the oldest form of IP and is used to indicate the source of the products and services. The origin of trade marks can be traced back to the times when commence of goods began. This article discusses about the history of trade mark legislations and identifies the first registered trade marks.

Introduction

A trade mark was the first way a tradesman identified his goods and services.¹ The history of trade marks traces back to ancient times and it is difficult to fix the exact date when the first trade marks appeared. Trade marks commonly referred to as "identifying marks" have been recognised in some form or the other since times immemorial. Greeks, Romans, Egyptians and the Chinese used these markings to identify the maker of a product so that a buyer would know the workmanship of the goods or services that he or she was

buying.² They were one of the foremost forms of Intellectual Property protection and have undergone steady evolution.

Evolution of Trade Mark

A trade mark is a word, phrase, slogan, design or symbol that is used to identify merchandise and is used to distinguish merchandise from competing products. The history of trade mark originates in ancient times, Neolithic man marked cave walls to show that he owned the cave. These marks are the predecessor to today's trade marks.³ In 5000 B.C., people were producing pottery with indication of the name of the ruling Chinese

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1 "Patents, Copyrights, and Trademarks – A Look Back" by Rachel Ralston, Craig Fellenstein, Jaclyn Vassallo, available at <http://www.informit.com/articles/article.aspx?p=366896> last visited on 8th December, 2011

2 Ibid

3 Ibid

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emperor, name of the manufacturer and place of making.⁴

A Hellenistic author, a Greek Egyptian Horapollon, wrote his book "Hieroglyphica" probably in the 5th century AD, which was published in the 15th century. Horapollon considered hieroglyphs not as elements of Egyptian language, but as ideograms conveying certain notions. Some of the hieroglyphs from Horapollon's book, for example Phoenix bird, became a commonplace in emblematic science.⁵

Symbolising and emblematising were extremely popular in medieval Europe. In the 15th century, the military outfit was very bombastic and rich in emblematical elements like innumerable mottos, abundantly decorated hats, jackets, armours and horse harness.⁶

King Edward I of England enacted the law, which prohibited jewellers to sell their gold and silver ware without previous stamping at the Goldsmith's Hall (assay office in London), when they officially started marking gold and silver in 1300 in England. Those, who tried to counterfeit the hallmarks were sentenced to death.⁷

There were also personal marks that existed since the beginning of 13th century till the end of 16th century and were widely used by traders and merchants throughout Europe. These merchant's marks can be considered as predecessors of modern trade marks because they bore names of traders and served as a guaranty that the sold goods were of expected quality. In the 15th century, there appeared printer's marks, which were put on books to identify printer, for instance German printer Johannes Gutenberg used the mark representing a double shield, which first appeared in books published in 1462. In the 16th century, emblems decorated not only palaces and castles of noblemen, but also on inns and taverns and were widely used in trade.⁸

The British Parliament adopted the first legislative act concerning trade marks in 1266 under the reign of Henry III, and according to that act, every baker (for example) had to put his or her mark on the breads that were produced.⁹

Nowadays, it is up to a seller to use or not use a mark. Modern marks are not aimed only at identifying ownership as was the case with the proprietary marks of the middle ages. Modern marks are an asset for the producer whereas in earlier times the trade marks were a liability.¹⁰

Definition of Trade Mark

Trade marks are word, phrase, symbol or design, or a combination of words, phrases, symbols or designs that are

4 <http://www.tmprotect.idknet.com/eng/history.html> last visited on 8th December, 2011

5 Ibid

6 Ibid

7 Ibid

8 Ibid

9 "Patents, Copyrights, and Trade marks - A Look Back" by Rachel Ralston, Craig Fellenstein, Jaclyn Vassallo, available at <http://www.informit.com/articles/article.aspx?p=366896> last visited on 8th December, 2011

10 <http://www.nls.ac.in/resources/ded/resources/IPR/IPRFeb11KA.pdf> last visited on 7th December, 2011

capable of distinguishing the goods and/or services produced or provided by one enterprise from those of others and help to establish an identity in the market place. Trade marks have come to represent not only actual goods and services, but also the reputation of the business. It is a marketing tool used by manufacturing and service providers as a means of helping consumers and traders in identifying them.

Need For Registration

Trade mark registration is one of the strongest ways to protect one's trade mark. Registration makes it a lot easier to protect the trade mark against would-be infringers and could end up saving a lot of time and money, in proving that, one is the legitimate owner of the trade mark. Registering and maintaining registration of the trade marks grants many advantages like - protection against infringement of trade mark, exclusive use of the mark, licence or sell and the right to prevent others from using, applying the said trade mark without proper authority.

History of Trade Mark Legislations

The history of trade mark law begins when enactments were made in the 19th century in Europe and the United States of America. However, this is not the first Trade mark-like situations that have emerged in History. Throughout history, going back thousands of years, there have been marks, symbols, or graphics that have been associated with specific individuals or organisations. They have been used in advertisements, seals of approval, etc.¹¹

United Kingdom

The first legislation on trade marks can be traced to England where the Bakers Marking Law, 1266 was enacted, which governed the use of stamps or pinpricks on loaves of bread. The law on registration of trade marks was later enacted on 13th August, 1875 in Great Britain. This granted to a trade mark holder a monopolistic right for his or her mark and also the right to sue those who infringe upon it.¹²

There were Acts in 1883, 1905 and 1919 but the key Act, foreshadowing the current regime was the 1938 Trade Marks Act. Several amending acts were subsequently passed in the UK but these only added to the difficulties in the interpretation of the 1938 Act.¹³ The Trade Marks (Amendment) Act, 1984 introduced the registration of service marks in respect of services such as laundries and banking. The Patents, Designs and Trade Marks Act, 1986 and the Copyright, Designs and Patents Act, 1988 made further amendments, which made the forgery of a trade mark a criminal offence.¹⁴

External pressures overtook the 1938 Act and its amendments and soon the case for a regime more in line with European countries was irresistible. Indeed, the EC directive on the harmonisation of trade mark law has been hailed as the single largest driving force behind the 1994 Act.¹⁵ Now the modern regime is enshrined in the 1994 Trade Mark Act in UK.

11 <http://www.tabberone.com/Trademarks/TrademarkLaw/History/History.shtml> last visited on 7th December, 2011

12 Ibid

13 <http://writepass.co.uk/journal/2011/10/free-law-essay-uk-trademark-law-and-fashion-brands/> last visited on 9th December, 2011

14 <http://www.ipo.gov.uk/types/tm/t-about/t-what-is/t-history.htm> last visited on 8th December, 2011

15 Ibid

United States of America

American trade mark law was initially influenced strongly by English trade mark law. In the U.S., various avenues are available for seeking a remedy. The state courts will adjudicate based on state registration or common law right; the federal courts will adjudicate based on federal registration.¹⁶

Federal Trade Mark Act was enacted as the first U.S. federal law to protect trade marks

On 8th July, 1870, the Federal Trade Mark Act was enacted as the first U.S. federal law to protect trade marks. In 1879, however, the U.S. Supreme Court held the law was unconstitutional due to a conflict with the provision on patents in the U.S. Constitution. It was therefore abolished. In its place, a trade mark law was enacted on 3rd March, 1881 that targeted trade marks used in interstate commerce based on the interstate commerce clause in the U.S. Constitution (Article 1, Section 8, Clause 3). This law, however, was unable to accommodate the development of the American economy and underwent a major Amendment in 1905. It underwent further partial revisions occasionally during subsequent years.¹⁷

Upon the enactment of the Lanham Act on 5th July, 1946, American trade mark law came to rank equally with English or German trade mark laws. The Lanham

Act is similar to English trade mark law because it adopted use-based principles as its foundation. Further, it was the first United States trade mark law which approved the registration of service marks.¹⁸

Australia

Prior to their federation, four of the states in Australia had set up trade mark registers - South Australia in 1863, Queensland in 1864, New South Wales in 1865, and Victoria in 1876. In each of those states, local statutes contained provisions for punishing the fraudulent use of trade marks and provided for a register of trade marks.¹⁹

In 1905, a Federal Trade marks Act was introduced to cover all of Australia. Prior registrations in the separate states remained in force but were not renewable. The 1905 Act was based largely on contemporary trade mark legislation in the United Kingdom.²⁰ The next trade mark registration was the Trade Marks Act, 1955 which also largely mirrored then United Kingdom legislation of 1938. Since then, Australia has passed two more Trade Mark Acts although only one of them came into effect.²¹ The present legislation is the Trade Marks Act, 1995 which came into effect on 1st January, 1996.

India

While some form of proprietary protection for marks in India dates back several millennia, India's statutory Trade marks Law dates back to 1860. The definition of trade marks was provided in the Indian Penal Code and was later adopted in Indian Merchandise Marks Act, 1889.²² Prior to 1940 there was no

16 <http://www.iip.or.jp/translation/ono/ch2.pdf> last visited on 8th December, 2011

17 Ibid

18 Ibid

19 <http://www.inta.org/INTABulletin/Pages/EarlyTrademarkLegislationAroundtheWorldPartI.aspx> Last visited on 12th December, 2011

20 Ibid

21 Mark J. Davison, Ann Louise Monotti, Leanne Wiseman, Australian Intellectual Property Law Pg. 64

22 Paul Goldstein, Intellectual Property in Asia: Law, Economics, History and Politics Pg. 73

official trade mark Law in India. Numerous problems arouse on infringement, law of passing off etc and these were solved by application of Section 54 of the Specific Relief Act, 1877 and the registration was obviously adjudicated by obtaining a declaration as to the ownership of a trade mark under Indian Registration Act 1908.


The first trade mark law in India was passed in the year 1940 and was known as the Trade Marks Act, 1940 and this corresponded with English Trade marks Act. This law was subsequently replaced by the Trade and Merchandise Act, 1958. Thereafter the Government of India amended this Act in order to bring the Indian trade mark law in compliance with its TRIPS obligations. The new Act that was passed was the Trade Marks Act, 1999. This Act came into force in the year 2003. The Trade Marks Act, 1999

and the Trade Marks Rules, 2002, presently govern the trade mark law in India. The object of the 1999 Act is to confer the protection to the user of the trade mark on his goods and prescribe conditions on acquisition, and legal remedies for enforcement of trade mark rights.

History of Trade Mark Registrations

United Kingdom


Registration of trade marks in the United Kingdom was first provided for by the 1875 Trade Marks Act. Protection was, and still is, afforded after first use of the mark. The first trade mark to be registered under the 1875 Trade Marks Act was the famous Bass "red triangle" design, which is still registered for "beer."²³ It is considered as the oldest registered Trade mark in the world. It remains conceptually unchanged since the last 135 years. It is valid up to 1st January, 2022.²⁴

Applicant's name	Trade mark	Trade mark No.	Date of mark No.	Class Grant	Validity
Bass and Company		1	1 st January, 1876	32	Till 1 st Jan, 2022

United States of America

The Federal Trade Mark Act of 1870 began to register the trade marks five years earlier to England. The first trade mark to be federally registered in 1870 was a design mark for liquid paints, primarily composed of linseed oil and zinc oxide that was produced by Averill

Paints Company of Newburgh, Ohio. The mark consisted of an eagle holding in its beak a pot of paint and a pennant with a slogan shown against an industrial background. However, the Law of 1870 was later repealed as contradicting to the Constitution and the first registration was annulled.²⁵

Applicant's name	Trade mark	Trade mark No.	Date of Grant	Class	Validity
Averill Chemical Paint Company		1	25 th October, 1870		Annulled

23 www.inta.org/INTABulletin/Pages/EarlyTrademarkLegislationAroundtheWorldPartI.aspx
Last visited on 12th December, 2011

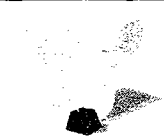
24 www.ipo.gov.uk/tm/t-find/t-find-number?detailsrequested=C&trademark=1 Last visited on 14th December, 2011

25 <http://www.tmprotect.idknet.com/eng/history.html> last visited on 14th December, 2011

Australia

Australia respected rights acquired by use rather than by being the "first to file." The first trade mark registered under the 1905 Act was for the image of a pine tree;


that registration is now owned by Fisons Plc, which uses the mark on chemical substances prepared for use in medicine and pharmacy.²⁶

Applicant's name	Trade mark	Trade mark No.	Date of Grant	Class	Validity
Collison and Company		1	2 nd July 1906		

India

The first registered trade mark in India is not traceable. However, the earliest trade mark traceable is trade mark No. 10 granted by Kolkata Trade mark Office on 1st June, 1942 for the mark BLACK AND

WHITE (Device) to James Buchanan & Company Ltd. It is a British company involving in the manufacture of Whisky. This mark has been renewed and is valid up to 1st July, 2016.²⁷

Applicant's name	Trade mark	Trade mark No.	Date of Grant	Class	Validity
James Buchanan & co. Ltd		10	1 st June, 1942	33	Till 1 st June, 2016

Conclusion

It is evident that, Trade mark is not a new form of IP and there have been marks, symbols, or graphics that have been associated with specific individuals or organisations throughout history. They have been used in advertisements, seals of approval, etc. The marks have been adopted and used by manufacturer or merchant in order to designate his or her goods or services. The qualitative and quantitative standardisation of products

led to the use of distinguishing signs to assist consumers in choosing their products. Throughout the history of trade mark law, the law has worked to protect the manufacturers from infringers and consumers from inferior counterfeits or substitutes. The trade mark consequently acquired its present financial, social and commercial importance with the development of mass production, distribution and consumption.

²⁶ Ibid

²⁷ <http://124.124.193.235/eregister/eregister.aspx> last visited on 14th December, 2011