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## The scope of intellectual property protection

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### Abstract

In modern times, a trademark can represent more than just the source of goods and services or quality, but also an idealized brand image that buyers want to have. Business owners have begun to invest in building a positive reputation for their brand through various forms of advertising. The original scope of trademark protection under Article 5 (1) (a) of the Trade Mark Directive (TMD) was limited to the origin and quality guarantee functions under the essential function theory. However, subsequent rulings by the Court of Justice of the European Union (CJEU) have broadened this scope to include communication, investment, and advertising functions, also known as "modern" functions, to protect trademark owners' investments. This enlargement has sparked ongoing discussions in European trademark law. The free movement of goods principle and the exercise of exclusive rights linked with trademarks have long been at odds with each other. The CJEU settled this dispute by establishing the concept of European exhaustion, which the TMD subsequently put into practice in Article 7 (1). However, this broad rule is not absolute, as a trademark owner with strong cause to oppose the continued marketing of products will not be exhausted. This thesis examines the effects of the TMD's enhancement of trademark protection under Article 5 (1) (a) on trademark owners' rights to resist wider marketing of their branded items in the context of parallel importation.

**Keywords:** Intellectual property, copyright, patents, trademarks

### Introduction

Real costs are incurred by customers due to the competitive benefits linked to exclusive possession of especially potent phrases. It will be more difficult for rivals to attract customers if Persimmon can restrict the terms they may use. This may indicate that customers are being led to buy Persimmon goods when they would have preferred another brand, or it might simply indicate that other brands are finding it more difficult to establish a foothold in the market. Consequently, Persimmon will have more money to spend. Importantly, such benefits do not materialize due to the superiority of Persimmon's product. They build up because Persimmon may legally restrict how other fitness trackers use the term "active" in comparison to its own. Trademark law ought to be sensitive to these concerns about competition. Indeed, trademark law ought to be attentive to these primary issues. The purpose of trademark legislation is to encourage level playing fields, which is good for consumers in the long run. Trademarks should be screened

out by law if they have a tendency to limit competition, which would be bad for consumers.

True, certain terms may be more crucial to a company's success than others, but trademark law seems to see this as a significant matter. To achieve this goal, it mandates that "descriptive" phrases must have acquired secondary meaning before they may be protected as trademarks, which makes it more difficult to obtain trademark rights in these terms. In other words, descriptive phrases cannot be trademarked unless they have two meanings: first, to describe the kind of product it is; and second, to identify the manufacturer of that item. Additionally, trademark law aims to expand the scope of descriptive words' non-trademark applications by identifying certain uses as descriptive fair uses. Unfortunately, these tenets aren't enough.

In today's interconnected world, trademarks are essential tools for safeguarding customer confidence in brands and ensuring their continued success. They help customers make educated purchases by providing a distinct indication of the

product's origin and quality. Trademark laws lay forth the rules for who may legally own a trademark and how to get others to stop copying their work. It may be a challenging environment for brand owners that operate in several markets due to the fact that trademark protection and enforcement methods might differ greatly between countries. In this study, we will compare and contrast the trademark systems of three different countries: India, Europe, and the US. This study's objective is to compare and contrast the trademark systems in different jurisdictions by looking at their respective legislative frameworks, registration procedures, enforcement methods, and pertinent cases. Additionally, it seeks to investigate possible areas of reform and harmonization across various countries, as well as the difficulties encountered by brand owners in an ever more digital and linked world.

### **Traditional Trademark Law**

Trademark law as it has traditionally been practiced primarily addresses three areas: first, the process of registering and administering trademarks (including rules, processes, fees, and the length of time that trademarks are valid), second, the scope, limitations, and exceptions of trademark rights, as well as remedies and procedures for trademark infringement, and third, the international aspects of trademarks (including the various treaties, conventions, and agreements that help trademarks be recognized and protected across different regions and countries).

The fundamental elements of classic trademark law have also remained constant over the years. The first is rooted in the idea of territoriality, which states that regions and countries assign and enforce trademark rights in accordance with their respective legal systems. Second, it relies on the idea of uniqueness, which states that trademarks should be able to tell one business's products and services apart from another's. Furthermore, it is founded on the idea of usage, which states that trademarks may only be acquired and kept valid and enforceable via use in commerce.

**Trademark registration process:** To register a trademark in the US, one must go through the thorough examination procedure run by the USPTO. In order to apply for a trademark, one must provide details about the mark, how it is classified, and proof that it is used for business or commercial purposes. The uniqueness of the mark, any possible incompatibilities with other marks, and conformity with applicable laws are among factors that are considered during the inspection process. Trademark owners have exclusive rights and protection once their trademarks are registered.

**Enforcement Mechanisms:** The United States has strong enforcement measures in place to safeguard the rights of trademark owners. Federal courts provide them with the option to sue infringers for damages, attorney costs, injunctions, and other remedies. There is a strong incentive not to use trademarks without permission because of the statutory damages that are available and because of the possibility of triple damages in situations of deliberate infringement. United States Patent and Trademark Office's Trademark Trial and Appeal Board/TTAB also deals with administrative processes pertaining to trademark matters.

### **Brand Law**

#### **Definition**

The primary goals of brand law are to safeguard the development and production of brands (i.e., the innovative features, designs, functions, or aesthetics of goods or services that attract and retain customers), as well as to prevent and combat counterfeiting and piracy (i.e., the illegal or substandard copying or replication can harm both consumers' and brand owners' rights and interests. The brand law's defining features, nevertheless, are both global and local:

The idea behind it is worldwide recognition and protection of trademark rights, which applies everywhere in the world notwithstanding regional and national variations in legislation. The foundational premise is originality, which states that trademarks may only be protected if they are unique, different, and creative. The idea behind it is collaboration, which implies that different parties with a stake in avoiding or fighting infringement must work together to safeguard brands. On a more local level, some brands may cater to certain goods, services, or cultures in a certain area. For instance, the Champagne area of France is the only authorized producer of the sparkling wine Champagne. Establishing regional agreements or organisations may help safeguard these trademarks by guaranteeing the goods' quality, authenticity, and reputation. One system that prevents the abuse or replication of regional goods is the one in place within the European Union known as geographical indicators.

#### **Literature Review**

Christopher Buccafusco *et al.* (2022) <sup>[5]</sup> Competition is encouraged by trademark law. Customers will have an easier time locating the items they want to buy if they are aware of which firms produce them. The idea that a trademark is associated with a certain manufacturer, known as "source significance," has long been considered essential and sufficient in trademark law to establish a brand's validity. In other words, according to conventional wisdom, a trademark may only be considered pro-competitive if its source is significant. In this article, we contend that this correlation between source importance and pro-competitive Ness is incorrect. A monopoly on certain terms used in trademarks may provide one company a significant competitive advantage, a kind of artificial advantage bestowed by the state, since such phrases are so intrinsic to the branded product. The more companies that make and sell the same product, the more severe this situation grows. Xingpeng Cheng *et al.* (2024) <sup>[4]</sup> Modern businesses have the daunting task of protecting their brands, which are powerful intangible assets that generate and maintain a competitive edge. But there isn't a one, all-encompassing legal category that can handle the many facets of trademark protection. The main focus of traditional trademark law is the registration and protection of distinctive marks that signify the source and quality of goods and services, this article seeks to investigate how a law built to safeguard brands may vary.

Thio (2024) <sup>[3]</sup> Protecting trademarks in the digital sphere presents new obstacles for trademark law. With an eye towards the problems and potential solutions associated with protecting brands in the digital realm, this essay takes a look

at how trademark law has changed in the modern day. The study investigates how Online marketplaces, social media, digital technology, and a literature review with library research affect trademark infringement and counterfeiting. The article examines the statutes and case laws that govern trademark protection in digital spaces, delving into topics including keyword advertising, domain name conflicts, and the peddling of fake products on online markets.

Feng, Yiteng. (2024) <sup>[2]</sup>. There are clear benefits to registering a trademark as opposed to depending just on unfair competition or trademark infringement to protect a business. It ensures that trademark owners' rights are protected by law by providing statutory protection. In addition to securing the mark's exclusive use, registration prevents anyone else from using confusingly identical marks. The onus of evidence now rests on the challenger, thanks to the presumption of legality in court, which is one of its most significant advantages. A trademark's registration grants it protection on a national level, independent of the first trademark use. It is possible to get more damages in the case of trademark infringement with a registered trademark, which might discourage unlawful usage.

Adam, Richard. (2023) <sup>[1]</sup>. The purpose of this study is to illuminate trademark law. registration as a means to curb instances of unfair competition in the business sector and hold perpetrators of mark infringement to account. Method: One definition of research is "the systematic application of research methodologies to the analysis and data collection processes with the express purpose of achieving predetermined objectives." The analytical descriptive approach was used to bring this study to fruition. The goal of this approach is to provide a comprehensive view, evaluate strong legal standards, and delve further into legal realities. This study also makes use of normative juridical research methods. The outcomes are: People have a hard time deciding what to buy since there are so many different brands available. When people shop on a tight budget, it may lead to the proliferation of knockoff goods that look and feel just like the real thing but cost much less.

### **Expanding the scope of intellectual property protection**

Brand protection legislation may vary from standard trademark law in many respects, one of which being the breadth of intellectual property it seeks to safeguard. Signs that differentiate the products or services of one supplier from another are primarily covered under trademark law. Nevertheless, there are other aspects of a product or service—its look, style, functionality, or innovation—that contribute to the brand's value and attraction to customers. Brand owners may be granted rights to patents, copyrights, industrial design rights, or trade dress rights as a result of a legislation that is intended to protect brands. To protect the form and look of its iPhone and iPad products, for example, Apple has obtained many design patents. Also, its retail locations are protected by trade dress rights, which ensure that they will always have their own distinct appearance. The legal concept of brand protection is practical and practical because it acknowledges and values trademarks as intangible assets that generate and maintain commercial advantage. A brand is more than just a logo; it's an intricate and ever-changing representation of the product or service's invention, design, functionality, look, reputation, image,

emotion, positioning, promise, and experience, as well as its source and quality. The protection of brands requires a more comprehensive strategy that goes beyond trademarks to include other patents, copyrights, industrial design rights, and trade dress rights are all examples of intellectual property.

### **Emphasizing the reputation, image, and emotion associated with a brand**

A brand protection legislation may also vary from standard trademark law in that it would place more weight on the reputation, image, and emotion linked to a brand than on the mere identity and origin goods and services. One of the main objectives of trademark law is to safeguard customers' interests by preventing marketplace confusion and deceit. But brands may also evoke specific memories and emotions in the minds of buyers. "Just Do It" is a Nike tagline, and it's meant to inspire individuals to go for their aspirations. Thus, a brand protection legislation might also prevent unlicensed or subpar uses of a trademark from harming its goodwill and image. An example of this would be the lawsuit that Louis Vuitton filed against a dog toy manufacturer because the manufacturer had sold chew toys that were too similar to the designer's renowned handbags.

### **Offering remedies**

In contrast to conventional trademark law, a brand protection statute may provide additional legal protections to owners of infringing trademarks, including injunctions, criminal penalties, and monetary damages. Injunctions (requests to cease using the infringing mark), damages (compensation for losses), and account of profits (renouncing the profits gained from using the infringing mark) are the primary legal remedies provided by trademark law in cases concerns infringing upon trademarks. Conversely, if the copyright infringements are multinational or operate in many countries, these remedies could not deter or stop them. Hence, a legislation meant to safeguard trademarks might potentially include criminal penalties for instances of piracy or counterfeiting, such fines, jail time, or the confiscation and disposal of items that infringe. As an example, trademark counterfeiting carries a maximum penalty of seven years in jail and penalties under China's own criminal legislation.

### **Cooperation and coordination**

Customs, government agencies, law enforcement, business partners, internet platforms, and merchants are just a few of the many groups that will need to work together more closely to implement a trademark protection legislation. Asserting a claim for trademark infringement exactly where it should be shoulders of the brand owners. But for brand owners, keeping tabs on the market and launching legal actions may be a time-consuming and costly ordeal. Consequently, additional parties with a stake in avoiding or combatting infringement may need to be more involved and provide more resources for a trademark protection legislation to be effective. Some examples include border customs inspections and seizures of suspected counterfeit goods, criminal cases of counterfeiting or piracy investigated and prosecuted by law enforcement, government legislation and policymaking supporting brand

protection, information and resource sharing among industry partners to address shared threats, and online platforms and retailers taking steps to ensure the authenticity of the goods they offer or host.

### Conclusion

It is fascinating to see how the concept of "Principle of Territoriality" evolved into "protecting foreign mark without its actual presence in particular region." The voyage reveals the highs and lows of the judiciary's attitude to trademark protection. Evidence from the past suggests that territoriality was a factor in mark protection in the past. But, because of technological progress, information is freely available, communication is cheaper and quicker, and the movement of visitors across borders has risen. A new group of squatters has formed, taking advantage of this territoriality concept to register a well-known trademark in the area before the overseas owner does, leaving the owner exposed. The idea to safeguard famous trademarks under 6bis of the Paris Convention arose in response to similar concerns.

In an effort to comprehend the worldwide issues and challenges in protecting a company's trademark—an essential marketing tool and of the many kinds of intellectual property—a large number of esteemed writers, jurists, and research fellows have sought to debate and analyse the doctrine of transborder reputation.

In this study, we looked at a variety of carriers of goodwill and reputation and saw how useful they are in creating a legally protected claim to intellectual property.

This study examined the "Transborder reputation" idea from an Indian point of view. In order to understand the tendency of the Indian court in safeguarding foreign marks, this study provides an in-depth review of instances handled by them. Furthermore, the researcher looked at the use of the notion of transborder reputation in key IP leading nations to comprehend the problem, including Japan, China, the United States, the United Kingdom, and Germany concerns and obstacles of defending respected marks in India. Below is a synopsis of the research for each step of the study.

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