

## **Advanced Trademark Law: Insights from EU and India**

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### Overview:

This elective offers an in-depth exploration of advanced trademark law, offering a comparative analysis of key principles between the European Union and India. The course aims to equip students with a strong theoretical foundation, while also focusing on emerging trends in trademark protection. By examining both these jurisdictions, students will gain a nuanced and holistic understanding of the evolving landscape of trademark law, its complexities and jurisprudence.

India's Trade Marks Act, 1999, being heavily influenced by the UK's Trade Marks Act, 1994, provides an ideal framework for comparative study with the EU system. The course will delve into the substantive legal frameworks and judicial decisions governing the complexities surrounding trademarks, while emphasizing the interplay between national laws and global influences.

Course Objective: By the end of the course, students will:

- Compare the core principles and legal frameworks governing trademarks across the European Union and India.
- Critically analyse the protection and enforcement of conventional and non-conventional trademarks & the requirement of 'graphical representation' in relation to the latter.
- Examine key case laws related to absolute and relative grounds of trademark refusal, specifically:
  - Likelihood of Confusion – double identity infringement and deceptive similarity
  - Bad faith and good faith in respect of trademark registration and use
  - Deceptive and Immoral Marks
- Gain an in depth understanding of geographical indications.
- Evaluate key doctrines such as trademark dilution (genericide, blurring, tarnishment) and passing off, with special focus on unfair advantage, trade dress, brand identity and character merchandising.
- Exploring the exceptions to trademark infringement: comparative advertisements and trademark parody.
- Understanding the principle of trademark exhaustion and its implications for global trade.
- Analysing the challenges of trademark infringement in the Digital Age, through keyword advertising.

Books (relevant chapters for each topic will be mentioned in the course manual):

1. Lionel Bently & Brad Sherman, "Intellectual Property Law", (Oxford University Press: Oxford)

OR

2. William Cornish, David Llewelyn and Tanya Aplin, Intellectual Property: Patents, Copyrights, Trademarks & Allied Rights

Academic Articles:

1. WIPO 'Relation of Established Trade Mark Principles to New Types of Marks' (SCT 17/3) Mar. 30, 2007.
2. Gangjee, Dev S. (2010), "Non-Conventional Trade Marks in India", National Law School of India Review, Vol. 22, No. 1, available at: <https://repository.nls.ac.in/nlsir/vol22/iss1/4>
3. Ricketson, Sam (2007), "Trade Mark Liability Issues Arising Out of Internet Advertising", Media & Arts Law Review, University of Melbourne Legal Studies, Vol. 12, No. 1, available at SSRN: <https://ssrn.com/abstract=958858>
4. Schechter, Frank (1927), "The Rational Basis for Trademark Protection", Harvard Law Review, Vol. 40, No. 6, pp. 813-833, available at: [https://www.jstor.org/stable/pdf/1330367.pdf?refreqid=fastly-default%3Ace78c3c40d4899fe1bc840f826f1a40a&ab\\_segments=&origin=&initiator=&acceptTC=1](https://www.jstor.org/stable/pdf/1330367.pdf?refreqid=fastly-default%3Ace78c3c40d4899fe1bc840f826f1a40a&ab_segments=&origin=&initiator=&acceptTC=1)
5. Gangjee, Dev S. (2008), "Polymorphism of Trademark Dilution in India", Transnational Law and Contemporary Problems, Vol.17(3), pp.101-120, available at: [URL](#)
6. Kuan, Siew (1990), "Get-Up Of Goods And The Law Of Passing-Off: A Case On Lemons: Reckitt & Colman Products Ltd. v. Borden Inc. and Others", Malaya Law Review, Vol. 32, No. 2, pp. 333-345 (available on JSTOR)
7. Gangjee, Dev (2008), "(Re)Locating Geographical Indications: A response to Bronwyn Parry", Trade Marks and Brands: An Interdisciplinary Critique, edited by Lionel Bently, Jennifer davis, and Jane c.Ginsburg, Cambridge University Press, pp. 381-397, available at: [https://assets.cambridge.org/97805211/87923/frontmatter/9780521187923\\_frontmatter.pdf](https://assets.cambridge.org/97805211/87923/frontmatter/9780521187923_frontmatter.pdf)
8. Davis, Jennifer (2008), "Between a sign and a brand: mapping the boundaries of a registered trade mark in European Union trade mark law", Trade Marks and Brands: An Interdisciplinary Critique, edited by Lionel Bently, Jennifer davis, and Jane Ginsburg, Cambridge University Press, pp. 65-92, available at: [https://assets.cambridge.org/97805211/87923/frontmatter/9780521187923\\_frontmatter.pdf](https://assets.cambridge.org/97805211/87923/frontmatter/9780521187923_frontmatter.pdf)