

ESSENTIALS OF TRADEMARKS AND UNFAIR COMPETITION (2002) By Dana Shilling, John Wiley & Sons, Inc., New York, Pp. 1-274, Price: Rs. 2114, ISBN-13: 978-0471-20941-6.

Trademark is considered as one of the main assets of any association or business house as the reputation and achievement of such organization gigantically depends upon the right use of its trademark. Similarly, trademark is also regarded as a remarkable concept under Intellectual Property Laws due to its tremendous development and usage in the commercial sector. Trademarks are easily identifiable designs, words, or combinations through which a unique brand, product, or service can be recognized. They are attributes of intellectual innovations that recognize brands and items from others in their market.¹ However, with the widespread enhancement of reputation, comes the risk of unfair competition. Unfair competition is a term that incorporates a few distinctive deceptive strategic policies that are intended to puzzle customers with respect to the source of a product or damage the reputation or goodwill of other companies and lead to infringement of the trademark.

Dana Shilling's "*Essentials of Trademarks and Unfair Competition*" published by John Wiley & Sons, Inc., New York is an in-depth venture in the sphere of trademark and provide the reader with a strategic formula such as methods of conducting "Preliminary", "Screening" and "Knockout" searches; tips regarding "Weak Marks", "Expedited Handling" for registering their marks. The approach adopted by Dana in this book is analogous to real-world examples, illustrations and case studies rather than adhering to set theoretical facts and information. This captivating compilation enhances our understanding of protection available to Trademark Law and delivers a stage wise technique for registration of trademark. As the author uncovers the sphere of trademark and a spectrum of other related topics she asserts that "the concepts of brand and trademark are closely related, although the brand is a more modern and trademark a more traditional idea and even though they are somewhat similar they are far away from being identical."² Discarding the view that brand and trademark are identical, she alleges that "although both of them involve product image and goodwill, the concept of trademark focuses

¹ Friedmann, Danny, "The Uniqueness of the Trademark, A Critical Analysis of the Specificity and Territoriality Principles" 38 *European Intellectual Property Review* 678-686 (2016).

² Dana Shilling, *Essentials of Trademark and Unfair Competition* 2 (Wiley & Sons, Inc., New York, 2002).

on the same source of the goods whereas owing to mergers and product divestitures, a brand may be owned by several companies and thus the brand does not provide proof of source.”³

In Chapter I of the book titled, “*Trademark Basics Overview*” by incorporating a sequence of illustrations, tips and techniques the author throws light on the basics of trademark law and trademarks, to begin with. Dana through this book attempts to bring invigorating practicality to the discussion of what trademark law is by exploring the need for protection and identification of trademarks. Apart from providing an overview of the trademark basics, she attempts to impart a detailed understanding of the scope of the State and the Federal trademark laws. She throws light upon the vivid conditions prevailing for registration to cancellation of trademark under the modern State Trademark Bill and Federal Trademark Laws separately and distinctly. With real-world references and demonstration, she draws the focus of the readers on the subject of trademarks and their use in commerce.

Chapter II of the book titled, “*Trademark Types*” commences with a review of fundamentals and the dialogue is dedicated to the types of trademarks and handling of trademark disputes including an unambiguous discussion on the threats to trademarks which subsequently leads to the evolution of other related issues in trademark law. With the foundation well established, it then discloses a huge and mounting group of issues for instance the challenging association between trademarks and the Internet, including but not limited to when Trademarks are utilized as URLs and even when a cyber-squatter can be penalized for exploitation of domain name registration. The vital concepts such as keywords, metatags, linking and framing are discussed in a very lucid way in order to appraise the readers regarding domain name disputes and ISP liability through illustrations and classic case studies.

However, in this chapter, it seems that the author has emphasized more upon the Domain Name and Cyberspace issues pertaining to trademarks but failed to justify the title as the discussion over types of trademarks is limited. The chapter introduces the concept of Non-Traditional Trademark but failed to discuss the challenges pertaining to registrability and graphical representation of such marks. Distinctive categorization of Non-Traditional Trademark could have provided a stronger validation to the title suggested by the author.

³ *Ibid.*

Through a simplistic approach, in Chapter III titled, “*Establishing, Registering, and Defending a Trademark*” Dana elucidates how to conduct a trademark search (“Preliminary”, “Screening”, “Knockout”) in order to verify whether the desired trademark is available, and process to further register a trademark. Further, she has also suggested the readers subscribe to Electronic Search Services such as “DIALOG, LEXIS or WESTLAW” and frequently check “Trademark Periodicals” for getting updated information on any developments of Trademark law.⁴ The transparency and arrangement throughout the third chapter show the readers exactly what is involved in registering a trademark. The author goes over the benefits of Federal registration and how to apply for trademark registration yourself by establishing the essential elements required for trademark application under the Lanham Act (15 U.S. Code Section 1051)⁵. The author also suggests for a unique strategy of conducting a search on “Weak Marks” whereby the applicants can check trademark oppositions and cancellation actions involving similar marks.

On to the rest of the procedure, which Dana goes over in detail, including what is needed for registration, how to produce the necessary paperwork (including preparation of drawings), how to determine the appropriate classes of goods, and what occurs when the trademark is registered. The sign must be graphically depicted in order to be the subject of a successful registration application, as required by section 2(1)(zb) of the Indian Trademark Act, 1999 as well as EU Directive 2015/2436.⁶ With the prompt progression of technology and increased competition, enterprises and businesses in this era rely heavily on the consumer's multiple senses, such as smell, taste, and sound, to promote their products. It is important to note that, despite their widespread use on the worldwide industry, these non-traditional trademarks do not have exclusive protection due to the mandate of graphical representation. In this book, while discussing strategies of “Preparing the drawing” for registration, Dana failed to explore the position of graphical representation for non-conventional trademarks entirely.

⁴ *Supra* note 2 at 123.

⁵ The Lanham (Trademark) Act (Public Law 79–489, 60 Stat. 427) (Act of 1946).

⁶ Arka Majumdar, Subhojit Sadhu, *et. al.* “The requirement of graphical representability for Non-Conventional trademark” 11 *Journal of Intellectual Property Rights* 313 (2006), available at: [http://nopr.niscair.res.in/bitstream/123456789/3588/1/JIPR%2011\(5\)%20313-317.pdf#:~:text=For%20instance%2C%20clear%20and%20unambiguous%20representation%20of%20a,of%20the%20sign%20it%20purports%20to%20represent%2C%20unmistakably.7](http://nopr.niscair.res.in/bitstream/123456789/3588/1/JIPR%2011(5)%20313-317.pdf#:~:text=For%20instance%2C%20clear%20and%20unambiguous%20representation%20of%20a,of%20the%20sign%20it%20purports%20to%20represent%2C%20unmistakably.7) (last visited on April 19, 2022).

The author explores different, inter-related conceptions of trademark through material examples in Chapter IV titled, “*Handling Trademark Disputes*” and deliberates what to do in case of an allegation of trademark infringement or if the trademark proprietor believes that the trademark has been infringed. Through a thorough discussion, the fourth chapter of the book enlightens readers about the opposition procedure and cancellation proceedings before the Trademark Trial and Appeal Board (TTAB), the system of bringing infringement suits, or defending against charges of infringement, how to structure ads and other communication to protect, not weaken, the trademark, to acquire remedies against counterfeits and under the Uniform Deceptive Trade Practices Act (UDTPA)⁷. The incorporation and impact of the Uniform Deceptive Trade Practices Act (UDTPA) upon Lanham Act⁸ have also been explained in depth. Along with the defenses and remedies available for infringement of Trademark, the author also gave an exhaustive idea with regard to the role and process of UDRP (Uniform Domain Name Dispute Resolution Policy) and the efforts of ICANN (the Internet Corporation for Assigned Names and Numbers) to resolve domain name disputes in an efficient and uniform manner.⁹

In Chapter V, titled “*Trade Dress*”, Dana advances that “usually when the subject matter of trademarks comes up, what is being discussed is the conventional trademark- a word or combination of letters, perhaps written in a distinctive typeface or combined with a logo or other design elements.”¹⁰ Consequent to such assertion, she addresses the topic of trade dress (including product design and packaging) as other kinds of trademarks that can be registered. The whole subject of trade dress overlaps with trademarks as protection for this important form of marketing has gained greater recognition in the courts. She, therefore, acknowledges trade dress as used in marketing to convey the total image of a product.¹¹

With a detailed description of The Wal-Mart Case¹² in 2000, Dana underlined that the case divided trade dress into two categories: product design (the appearance of the product itself) and packaging design (the box, bag, wrappers and so on). The conclusion drawn from the case was that product designs are never inherently distinctive. So, unless the product design had been

⁷ Public law 104-153- Anticounterfeiting Consumer Protection Act (Act of 1996).

⁸ The Lanham (Trademark) Act, (Act of 1946), s. 34 (d)(1)(A).

⁹ *Supra* note 2 at 110-112.

¹⁰ *Supra* note 2 at 123.

¹¹ Trademark Manual of Examining Procedure, s.1202.03 (Ornamentation, since Lanham Act does not directly discuss about Trade dress).

¹² *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.* (99-150) 529 U.S. 205 (2000)165 F.3d 120.

registered as trademark the plaintiff has to prove that the product design has acquired secondary meaning in order to win a case for trade dress infringement. Through insightful tips and techniques spread throughout the book, the author suggests some protective tactics for trade dress and what makes trade dress distinctive. Finally concluding on the subject matter of trade dress, Dana states the scope of trade dress in State law as well as outside the United States. Towards the end of this chapter, the author further asserts the relation between Trade dress with that of Functionality Doctrine and concludes with the understanding that if product packaging/appearance is functional in nature it cannot serve as a trademark or trade dress.¹³ It is the core of the functionality doctrine to avoid a monopoly of an entity over a fundamental element of the product, which might play a critical part in the product lines of competing entities. CHANEL is considered to be one of the world-famous and recognized fragrance brands in the fashion industry for decades, which is an excellent illustration of this difficulty. Due to the application of the functionality doctrine, the application filed by CHANEL was rejected on the basis that the fragrance is in itself the element of the product, making all beauty and personal care items such as cologne and perfume now ineligible for trademark registration.¹⁴

Stressing upon the need for protection of any intellectual property including trademarks, in Chapter VI, titled “*Threats to the Trademark*”, the author gives a comprehensive and exhaustive list of dangers to that trademark. Throwing light on “confusingly similar” the book enlists the factors that courts consider while deciding whether a later trademark is “confusingly similar” to an earlier one.¹⁵ In an attempt to connect the theories to the real world, the book enlists a comparative chart of similar trademarks to attain a more practical approach.¹⁶ Apart from addressing the traditional infringement ways, Dana also reflects on the contemporary technique of trademark infringement such as dilution. Speaking of dilution laws under the Federal Act and the Model State Trademark Bill, Dana highlights the factors considered to determine whether a given mark is distinctive and famous.¹⁷ As infringement automatically follows remedies, the

¹³ *Supra* note 2 at 131.

¹⁴ Franco Galbo, “Making Sense of the Nonsensical: A look at Scent Trademarks and their Complexities”, *available at*: <https://www.ipwatchdog.com/2017/12/21/scent-trademarks-complexities/id=91071/> (last visited on April 19, 2022).

¹⁵ *Supra* note 2 at 138

¹⁶ *Supra* note 2 at 141.

¹⁷ *Supra* note 2 at 145.

book provides a range of special remedies that are available when a “famous” trademark becomes less valuable or distinct on account of the dilution of the same.

The Chapter VII of this book, titled “*Other Issues in Trademark Law*” provides the readers with the insightful information regarding what property is suitable for licensing, issues needed to be included in the licensing agreement; controlling the quality of licensing merchandise and protecting know-how and trade secrets, the book focuses on other issues in trademark law as well. The commercial world is trying to utilize and exploit its intellectual assets to the fullest and often it is found that these forms of intellectual property can be complex and overlapping. The author also discusses about the “Gray Market Goods” or “parallel imports” and simultaneously discusses Copyright infringement done by “Grey Marketers.”¹⁸ This chapter touches all these uprising issues in an accessible style through various legislations and case studies.

Additionally, in the last chapter *i.e.*, Chapter VIII of this book, titled “*Unfair Competition*” apart from trademarks and its related subjects, the author also covers the law of unfair competition in business as other forms of deceptive business practice can overlap with trademark infringement.¹⁹ Understanding the concepts of unfair competition educates the readers about what businesses can and cannot say about each other, how to utilize State laws to battle unfair and deceptive trade practices, to know how the rights of privacy and publicity work together, elements involved in a case of interference with contractual relations and the necessity to use covenants not to compete to make sure that ex-employees do not harm one’s business.²⁰ There are various appendices and legal paperwork at the conclusion of the book. When combined with the knowledge in this work, the final substance should provide readers with the fundamental concepts needed to manage trademark challenges.

This book comprises valuable tips, illustrative real-world examples, and exhibits that allow the readers to identify the developments and strategies concerning trademark registration such as “Preliminary”, “Screening”, and “Knockout” searches; tips regarding “Weak Marks”, “Expedited Handling”.²¹ Non-conventional trademarks cover a wide range of trademarks that do not fall within the traditional definition of a trademark, such as those based on shapes, colours, symbols,

¹⁸ *Supra* note 2 at 161.

¹⁹ R. Reaves Elledge Jr., “Trade Name Infringement as Unfair Competition”, 40 *California Law Review* 571 (1953).

²⁰ Graeme Dinwoodie (ed.), *Trademark and Unfair Competition Law* (Edward Elgar Publishing Ltd, 2014).

²¹ *Supra* note 2 at 51.

logos, letters, phrases, or images, and any combination of these components. With the increase of competition in the market, we have often found commercial entities heavily relying on the consumer's multiple senses, such as smell, taste, and sound, to promote their products, making the protection of Non-Traditional Trademarks equally significant. But this book does not speak in much detail about any strategy for registering these Non-Conventional Marks; hence in our opinion, detailed incorporation of this segment in this book could have been more valuable and enthralling for the readers.

However, it is a well-conceived, authoritative and clear presentation of trademark-related concepts, which is beneficial for both business executives and practitioners in this field. The lucid language used in this book makes it understandable to students for their reference. The book not only covers the litigation perspective of trademarks but through its illustrations, it has very well elaborated upon the economic interest associated with trademarks. The profundity and extensiveness of the authors' knowledge are evident in every chapter. The moderately short deliberations arranged by abundant captions and sub-heads in every chapter and complemented by numerous illustrations and real-world examples accompanied by tips and techniques help to keep the reader's attention throughout. "*Essentials of Trademarks and Unfair Competition*" is a practical and extensive guide to this area of the law. This book will keep readers informed and speedy on the logic, methodologies, innovations, and breakthroughs in trademark law and unfair competition. It is crammed with good suggestions, systems, illustrated genuine examples, exhibits, and best practices.

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