

# All Things IP



Submitted by

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### **Difference between a Trademark and Service mark- (TM) vs. (SM):**

Service marks are referred to as that genus of marks falling within the specie of Trademarks within the family of Intellectual Property Rights (“IP”). Simply put Service Marks are a category of specific forms of trademarks used in relation to branding of service names of a business house. Another way to put it is that all Service Marks are Trademarks but on the contrary all Trademarks are not Service Marks. This note attempts to explain and bring out the basic differences between Trademarks (TM) and Services Marks (SM). The bottom line is that a trademark represents a product produced/manufactured or developed by a business while a service mark represents a service offered by the business.

The symbol TM may be used with an unregistered trademark, while the symbol SM may be used with an unregistered service mark. For goods trademark, a trademark is considered to be used in commerce when it is placed on the goods themselves or their containers; or the displays associated with the goods; or on the tags or labels affixed to the goods; and the goods are sold or transported in commerce. For services related trademarks, a service mark will be considered to be used in commerce when it is used or displayed in the sale or advertising of the services and the services are rendered in commerce.

The difference between TM and SM primarily arises from an international system of classification of goods and services commonly known as the NICE system of International Classification of goods and services (NICE Classification), which India has statutorily adopted in relation to its trademark protection regime in the country. The NICE Classification adopts a system of classification where the goods and services offerings are classified in to 45 classes, wherein Classes 1-34 pertain to goods trademarks and Classes 35-45 pertain to service trademarks or service marks.

To clarify further, where a mark is used, applied for registration and is further registered in relation to any category of services falling within the Classes 35-45 then such trademarks are known as Service Marks. It is sometimes however also possible that a business house may be rendering services under a particular brand, which brand it also uses in relation to goods offerings in which case the difference between a TM and SM is diluted conceptually to that extent and such distinction is only significant from a theoretical perspective of the relevant class under which the trademark has been registered or sought to be registered. For instance, Hewlett-Packard as a business house sells computer hardware products such as printers and laptops under its brand “HP” or “Hewlett-Packard” and it also renders Information Consultancy Services under its brand “HP” or “Hewlett-Packard”. Thus, in this case the difference between a TM and SM vis-à-vis the “HP” or “Hewlett-Packard” is diluted to a great extent and is only relevant from a legal and theoretical perspective.

Further, in the context of brands used by information technology for its software offerings can typically qualify for protection both as goods trademark under Class 9 for Computer Software and also for Software or Platform as a Service (SAAS or PAAS) in relation to hosted services under Class 42. This branding advise and strategy can further become tricky when such software offerings have a utility in the telecommunication space, in which case then in addition to Class 9 and Class 42 businesses may also have to consider protection under Class 38 as a SM.





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The line between a trademark and a service mark is often so thin that many companies simply end up having both. Ultimately, the primary concern for all businesses should be whether a trademark has been applied for registration or has been registered in all the relevant classes of goods or services that protects the brand equity associated with its product and service offerings. That's the best way to ensure that others don't infringe on your trademarks. Working with an experienced attorney will increase your chances of success in your trademark/service mark registration process.

We at Eshwars, have a rich experience of advising, strategizing and protection of various trademarks for our clients in multiple jurisdictions across the globe including India. For more information on our IP Services please write back to us at [saisunder@eshwars.com](mailto:saisunder@eshwars.com)





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