



Intellectual Property Attorneys

# TRADEMARKS

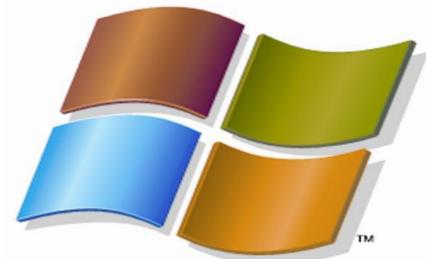
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# Trademarks

- Distinctive mark, symbols, signs or logos that help consumer to distinguish between competing goods or services. Should not be descriptive of the goods or services.
- A trade name is the name of an enterprise which individualizes the enterprise in consumer's mind.
- In fact, linked in consumer's mind to quality expectation.



# Deciding on trademark/ logos

## Things to consider when deciding on brand name/ trademark /logos -

- Trademark acts as **unique source identifier**; associates the product with the company in the minds of the customer
- Consider mark that aligns with the business and legal requirement
- **Protectability and Enforcement** of your trademark – **Distinctive marks**; the mark should be capable of being registered and enforced
- **Avoid descriptive and deceptive marks**
- Generate Investment and brand value

# Strong trademark - why is it important

## Trademark strength and why is it important?

The nature of a mark, particularly its relative strength or weakness, will have a direct bearing on its performance in the market and on its scope of legal protection. A “**strong**” mark is a mark that is **highly distinctive**, thus immediately identifying the owner as the source of the covered products or services. When a mark is **scarcely distinctive**, then the mark is considered “**weak**.” In general, the stronger a mark is, the easier it is for the mark to be eligible for registration and to obtain protection from unauthorized use and registration by others.

Source - <https://www.inta.org/fact-sheets/trademark-strength/>

# Hierarchy of trademarks

- Fanciful or Coined marks –



- Arbitrary marks –



- Suggestive marks -



# Hierarchy of trademarks

- Descriptive marks



- Descriptive marks which have acquired distinctiveness or acquired secondary meaning -



# Hierarchy of trademarks

- Generic marks –



- Marks which died a generic death



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**CELLOPHANE**

**ESCALATOR**

# Importance of Search & correct identification of goods / services



Government of India  
 Ministry of Commerce & Industry  
 Department of Industrial Policy & Promotion  
 Controller General of Patents Design & Trade Marks  
 Public Search of Trade Marks



[Class Details](#) | [Well Known Marks](#) | [Prohibited Marks](#) | [Vienna Code Classification](#) | [International Non-Proprietary Name\(INN\)](#) | [Help](#) |

## COMPUTER GENERATED TM-SEARCH REPORT

Search Criteria : Wordmark	Search String : rapid	Class : 42	Search Date : 12-May-2020
APPL NO	CLASS	CONFLICTING MARK	JOURNAL No

3690282	42	RAPID	1900	SONATA SOFTWARE LIMITED	#1/4, APS Trust Building, NR Colony, Bull Temple Road, Bangalore-560019, Karnataka, India	Registered
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APPLICATION DATE : 29/11/2017

USER DATE : 01/08/2015

GOODS/SERVICES : PLATFORM AS A SERVICE [PaaS]; PLATFORM AS A SERVICE (PaaS) FEATURING COMPUTER SOFTWARE PLATFORMS FOR AUTOMATED PIPELINE MANAGEMENT FOR BUILD, TEST AND DEPLOYMENT MANAGEMENT, PROJECT SETUP AND MANAGEMENT, TEMPLATE DRIVEN AUTOMATED INFRASTRUCTURE PROVISIONING AND ENVIRONMENT CREATION, INTEGRATED ENVIRONMENT AND NETWORK MONITORING, INTEGRATED CODE QUALITY ANALYSIS, TEST AUTOMATION AND MANAGEMENT, INTEGRATED DASHBOARD REPORTING AND ANALYTICS, STANDARD BUILT-IN PIPELINES TEMPLATES AND INFRASTRUCTURE TEMPLATES, REUSABLE TEMPLATES, TEST ASSETS AND SCRIPTS; SOFTWARE AS A SERVICE [SaaS] FOR IMPROVING THE EFFICIENCY AND ACCURACY OF BUSINESS OPERATION; SOFTWARE AS A SERVICE FOR MANAGEMENT, ANALYSIS, MONITORING AND CONTROLLING THE TESTING ACTIVITIES OF SOFTWARE FOR BUSINESS OPERATION; SOFTWARE AS A SERVICE PROVIDING AUTOMATED PIPELINE MANAGEMENT FOR BUILD, TEST AND DEPLOYMENT MANAGEMENT, PROJECT SETUP AND MANAGEMENT, TEMPLATE DRIVEN AUTOMATED INFRASTRUCTURE PROVISIONING AND ENVIRONMENT CREATION, INTEGRATED ENVIRONMENT AND NETWORK MONITORING, INTEGRATED CODE QUALITY ANALYSIS, TEST AUTOMATION AND MANAGEMENT, INTEGRATED DASHBOARD REPORTING AND ANALYTICS, STANDARD BUILT-IN PIPELINES TEMPLATES AND INFRASTRUCTURE TEMPLATES, REUSABLE TEMPLATES, TEST ASSETS AND SCRIPTS; COMPUTER SOFTWARE DEVELOPMENT; COMPUTER SOFTWARE DEVELOPMENT SERVICES FOR OTHERS; CUSTOMIZING COMPUTER SOFTWARE; CONSULTING SERVICES IN THE FIELDS OF INFORMATION TECHNOLOGY AND COMPUTER SOFTWARE INTEGRATION; HOSTING OF PLATFORMS ON THE INTERNET; MONITORING OF NETWORK SYSTEMS; PROGRAMMING OF SOFTWARE FOR INTERNET PLATFORMS; TESTING OF COMPUTER SOFTWARE; CONSULTING SERVICES IN THE FIELD OF CLOUD COMPUTING; CONSULTATION SERVICES FOR THE DEVELOPMENT OF CLOUD BASED SOLUTIONS; CLOUD COMPUTING SERVICES; CONSULTATION IN THE FIELD OF CLOUD COMPUTING NETWORKS AND APPLICATIONS; CONSULTING SERVICES FOR OTHERS IN THE FIELD OF DESIGN, PLANNING, AND IMPLEMENTATION PROJECT MANAGEMENT OF COMPUTER SOFTWARE TESTING; SCIENTIFIC AND TECHNOLOGICAL SERVICES, NAMELY, AUTOMATED PIPELINE MANAGEMENT FOR BUILD, TEST AND DEPLOYMENT MANAGEMENT, PROJECT SETUP AND MANAGEMENT, TEMPLATE DRIVEN AUTOMATED INFRASTRUCTURE PROVISIONING AND ENVIRONMENT CREATION, INTEGRATED ENVIRONMENT AND NETWORK MONITORING, INTEGRATED CODE QUALITY ANALYSIS, TEST AUTOMATION AND MANAGEMENT, INTEGRATED DASHBOARD REPORTING AND ANALYTICS, STANDARD BUILT-IN PIPELINES TEMPLATES AND INFRASTRUCTURE TEMPLATES, REUSABLE TEMPLATES, TEST ASSETS AND SCRIPTS IN THE FIELD OF RETAIL, CPG, TRAVEL, MANUFACTURING AND FINANCIAL SERVICES; PROVIDING TEMPORARY USE OF ONLINE NON-DOWNLOADABLE OPERATING SOFTWARE FOR ACCESSING AND USING A CLOUD COMPUTING NETWORK.

4066464	42	RAPID RIDE	1914	AMNEX INFOTECHNOLOGIES PVT. LTD.	B-1301 Mondeal Heights, Sarkhej - Gandhinagar Highway, Ahmedabad 380054	Opposed
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APPLICATION DATE : 24/01/2019

USER DATE :

GOODS/SERVICES : Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software.

Vienna Code(s) : 261325, 180107, 270501, 290112

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# Importance of Search & correct identification of goods/ services



Government of India  
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## COMPUTER GENERATED TM-SEARCH REPORT

Search Criteria : Wordmark	Search String : grid	Class : 9	Search Date : 12-May-2020
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APPL NO	CLASS	CONFLICTING MARK	JOURNAL No	PROPRIETOR NAME	PROPRIETOR ADDRESS	STATUS	Image
1998011	9	GRID IOS	1725	M/S. CISCO TECHNOLOGY, INC.	170 WEST TASMAN DRIVE SAN JOSE CALIFORNIA 95134, U.S.A.	Registered	

APPLICATION DATE : 23/07/2010

GOODS/SERVICES : COMPUTER OPERATING SOFTWARE; ROUTER, SWITCH, HUB AND SERVER OPERATING SOFTWARE; SOFTWARE FOR ENERGY MANAGEMENT; SOFTWARE FOR POWER GRID DATA COMMUNICATION NETWORKS; NETWORK MANAGEMENT AND SECURITY SOFTWARE, NAMELY, SOFTWARE FOR TRAFFIC PRIORITIZATION, SECURITY, INTRUSION PREVENTION, VIRTUAL PRIVATE NETWORKS, FIREWALLS, AND IDENTITY AND ACCESS CONTROL.

USER DATE :

2177535	9	GridION	1742	OXFORD NANOPORE TECHNOLOGIES LTD	EDMUND CARTWRIGHT HOUSE, 4 ROBERT ROBINSON, SCIENCE PARK OXFORD OX 4 4GA, UK	Registered	
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APPLICATION DATE : 19/07/2011

GOODS/SERVICES : SCIENTIFIC, NAUTICAL, SURVEYING, PHOTOGRAPHIC, CINEMATOGRAPHIC, OPTICAL, WEIGHING, MEASURING, SIGNALLING, SUPERVISION, LIFE-SAVING AND TEACHING APPARATUS AND INSTRUMENTS; APPARATUS AND INSTRUMENTS FOR BIOLOGICAL, CHEMICAL, BIOCHEMICAL, DNA, RNA, PROTEIN, POLYNUCLEIC ACID AND MOLECULAR ANALYSIS; APPARATUS AND INSTRUMENTS FOR USE IN DNA, RNA, PROTEIN AND POLYNUCLEIC ACID SEQUENCING; APPARATUS FOR THE ANALYSIS OF POLYNUCLEIC ACID SEQUENCES; APPARATUS AND INSTRUMENTS FOR THE ANALYSIS OF NUCLEIC AND POLYNUCLEIC ACIDS; APPARATUS AND INSTRUMENTS FOR THE ANALYSIS OF PROTEINS; APPARATUS AND INSTRUMENTS FOR ANALYSIS OF GENETIC INFORMATION, GENOMIC INFORMATION AND PROTEOMIC INFORMATION; APPARATUS AND INSTRUMENTS FOR USE IN LABORATORY ANALYSIS; DIAGNOSTIC AND TESTING APPARATUS, NOT FOR MEDICAL PURPOSES; MONITORING APPARATUS AND INSTRUMENTS; COMPUTER PROGRAMS, COMPUTER HARDWARE AND DATA PROCESSING APPARATUS, ALL OF THE ANALYSIS AND RECORDAL OF SCIENTIFIC DATA; INSTRUMENTS AND APPARATUS FOR THE DISPLAY OF INFORMATION OBTAINED FROM SCIENTIFIC EQUIPMENT; SILICON CHIPS; DNA CHIPS; MICROARRAY CHIPS; ANALYTE DETECTOR CHIPS; BIOSENSOR CHIPS; PARTS AND FITTINGS FOR ALL THE AFORESAID GOODS

USER DATE :

Best View In Resolution of 1024x768 or later. Enable Javascript for Better Performance.

# Trademark registrability

- Grounds of Objection in most jurisdictions (India, USA, EU, China,)
  - **Absolute Grounds and Relative grounds**
  - **Under Absolute Grounds –**
    - Non-distinctiveness
    - Mark is merely descriptive
    - Geographical names/ Geographically descriptive
    - Primarily merely a surname
    - Discriminatory against any nationality, flag, emblem of a country, foreign nations
    - Contains Scandalous or immoral matters

# Some examples for marks refused under absolute grounds

- Non-distinctive/ merely descriptive marks which describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services
  - **CREAMY** for yogurts,
  - **WORLD'S BEST BURGERS** for burgers,



# Some examples – China

- Where the mark include the name of the state, which is prohibited under the law.



- If the name of the state is used in the trademark of a Chinese applicant but it is mutually independent from other distinguishable features and the name of the state only indicates the country of the applicant, it can be allowed



# Some examples – China

- Marks with the name of a nation which defames or belittles such nation, such trademark shall be determined as with the nature of national discrimination.



Designated Goods: Flush Toilets

- Marks only having direct representation of the function or use of designated goods

***SAFETY***

Designated Goods: Leakage  
Protector

# EUIPO Registrability

- There is examination only on absolute grounds of refusal which includes amongst others –
  - Non-distinctiveness
  - Descriptive trademarks
  - Customary signs or indications
  - Contrary to public policy
  - Conflict with GI, traditional terms of wines
- If an objection is raised it is difficult to overcome such objection in the EU.

# Some examples in the EU for marks NOT accepted

- Words like **ECO** denoting Ecological, **GREEN** denoting Environmentally friendly, **PRO** for goods for professionals or supporting something are NOT accepted
- Single letters like **C** for juices as it is taken to refer to **Vitamin C** and NOT accepted
- Slogans like **SAVE OUR EARTH NOW** for Classes 3, 17, 18, 20, 22, 24, 25 and 28 NOT accepted
- Customary signs like  which was applied for goods in class 25
- are NOT accepted

# Some examples for Accepted marks

- Accepted Slogans –
- LOVE TO LOUNGE in class 25
- Shapes unrelated to the goods themselves are accepted like registered in class 16 and 21.



# Trademark registrability

- **Relative Grounds of refusal / Conflict objection**
  - Should not be identical to an earlier mark, well-known trademark
  - Should not cause Likelihood of Confusion
- Likelihood of confusion can be caused by –
  - Sound of the conflicting mark
  - Appearance of the conflicting mark
  - Meaning
  - Commercial impression
  - Goods / services
- The likelihood of confusion test is very high in the USA.
- In China substantive examination will include examination on likelihood of confusion .

# Some examples – India, USA

- Likelihood of confusion based on **sound** of the conflicting mark i.e. phonetically similar although the spellings are different



**T. MARKEY**



**TEE MARQEE**

- **Appearance** of the conflicting marks, change in font or style will not differentiate the marks



**T. MARKEY**



**T. Markey**

# Some examples

- **Meaning** - where the meaning of the marks are the same in different languages (Italian and English)

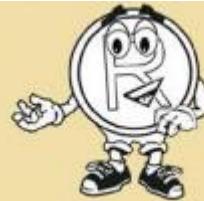


LUPO



WOLF

- **Overall commercial impression** of the marks are the same



# Some examples

- Likelihood of confusion on the basis of **Goods and services**

**T-shirts  
and  
pants**

**Hats**

**Banking  
services**

**Mortgage  
lending  
services**

**T-shirts  
and  
pants**

**Online retail  
store services  
featuring clothing**

# Some examples in EU -

- In the EU an application is not examined on Relative grounds for Refusal, but an Opposition is filed on Relative Grounds for Refusal
  -
- Examples – **MASSA** vs. 
- Messi won the case. The Court held that the possible reputation of the person who is applying for his name to be registered as a trade mark is one of the relevant factors for the purposes of assessing the likelihood of confusion. The General Court did not therefore err in considering that Messi's reputation constituted a relevant factor for the purposes of establishing a conceptual difference between the terms 'messi' and 'massi'.

# Some examples in China -

- Some examples of Similar marks –



# Advertisement, Promotion Marketing

- Use on website, products, services
- Advertise and promote as registered
- Mark registered and mark used should not be different
- In some jurisdictions continued use is required to be shown
- In case there has been different variations of the mark, such variations should be protected through statutory protection
- Should indicate ® markings for registered marks

# Examples

- **Labels and tags for the goods** - A label or tag that is not shown physically attached to the goods may be accepted if it clearly shows the mark in actual use in commerce that includes informational matter that appears on a label in use in commerce such as net weight, volume, UPC bar codes, lists of contents or ingredients, or other information that is not part of the mark but provides information about the goods.



# Examples

- Sales display where goods are sold
- Webpages selling the goods
- Online advertising or printed matter showing a direct link association between your trademark and the services



# WELL-KNOWN TRADEMARKS

117 marks recognized so far as well-known marks in India by the Trade Marks Registry

## The Benefit of Recognition:

- Protection in all classes

# Building on the Brand -

- Make accurate inventory of all trademarks
  - Accurate ownership information
  - Status of each application
  - Status of each registration
  - Renewal in force
  - Common Law Protection –
    - track date of first use along with all supporting documents like invoices, promotional materials, third party publication
    - maintain accurate records

# Building on the brand

- Word mark and Stylized mark protection e.g.



- Stylized marks should be registered to ensure the maximum protection
- Review goods and services for registered marks
  - In case registered mark does not cover new businesses such goods / services need to be protected by filing fresh applications
  - Similarly, if goods /services under registered mark are not used by the business such goods/services be deleted to prevent cancellation of registered marks
  - Less expensive than infringement actions

# Building on the brand

- Correct use of the Trademark and Registered Mark symbol
  - correct use - DELL® MOUSE
  - Incorrect use – HP MOUSE®



# Building on the brand

- USE of trademark
  - Goodwill and reputation; helps in enforcement;
- Correct recordation of change in ownership
  - Change in ownership to be recorded in relevant IP offices
  - Auditing licensing and royalty agreements to ensure that the rights have been correctly maintained and the revenues received
  - Prioritizing IP rights and markets based on branding /R&D strategy and future plans

# Building on the brand – checks in place

- Foreign registrations – TM territorial in nature
- Consider countries where brand owners may have manufacturing, selling, exporting, importing, distributing, licensing activities
- In many jurisdictions applications can be filed on proposed to be used basis
- Prevents fraudulent registrations

# Building on the brand – checks in place

- Enforce rights against unauthorized use – legal notices; cautionary notices; litigations
- Regular monitoring
- Cost savings

# IP Protection Tips & Strategy

## Preserve evidence of use of the mark in India and internationally

- record of successful actions taken
- record of past original advertisements of the mark
- original brochures relating to the product under the mark
- invoices properly identifying the mark
- letters of commendation, awards won, negatives of photographs
- certified legal proceedings extracts of the mark
- annual reports
- record of unsolicited media publicity
- sales and advertising figures relating to the product under the mark

## Constant vigil

- keep a watch in the marketplace
- conduct market surveys on regular intervals
- avail trademark watch service agency services
- file oppositions
- Sending cease and desist notices

## Periodic cautionary notices in leading newspapers

## Register domain names with corresponding trademarks



Intellectual Property Attorneys

# Q & A

# Thank You