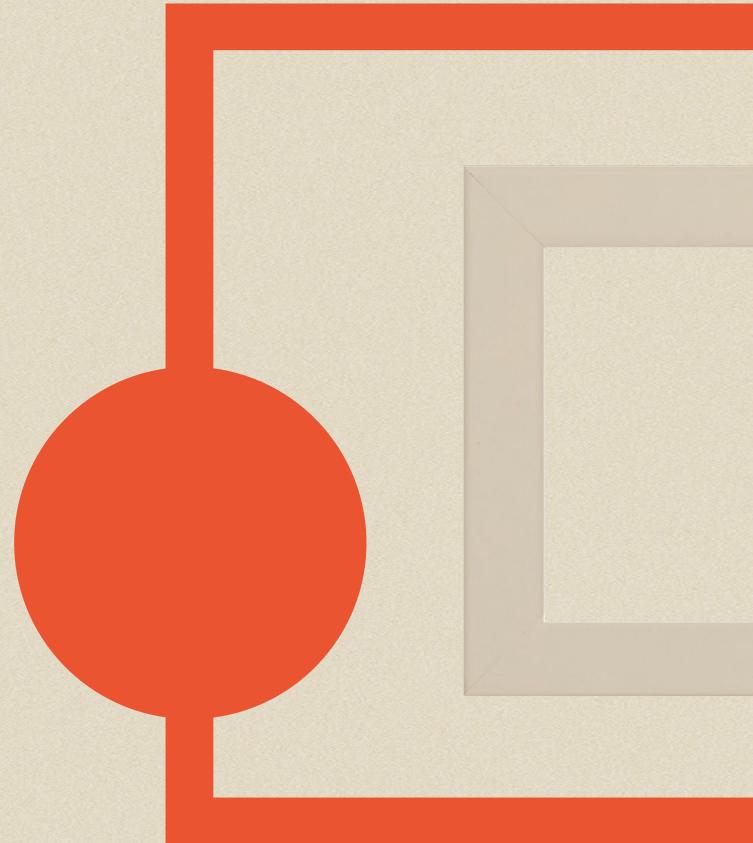


# TRADEMARKS FOR STARTUPS & SMALL BUSINESSES

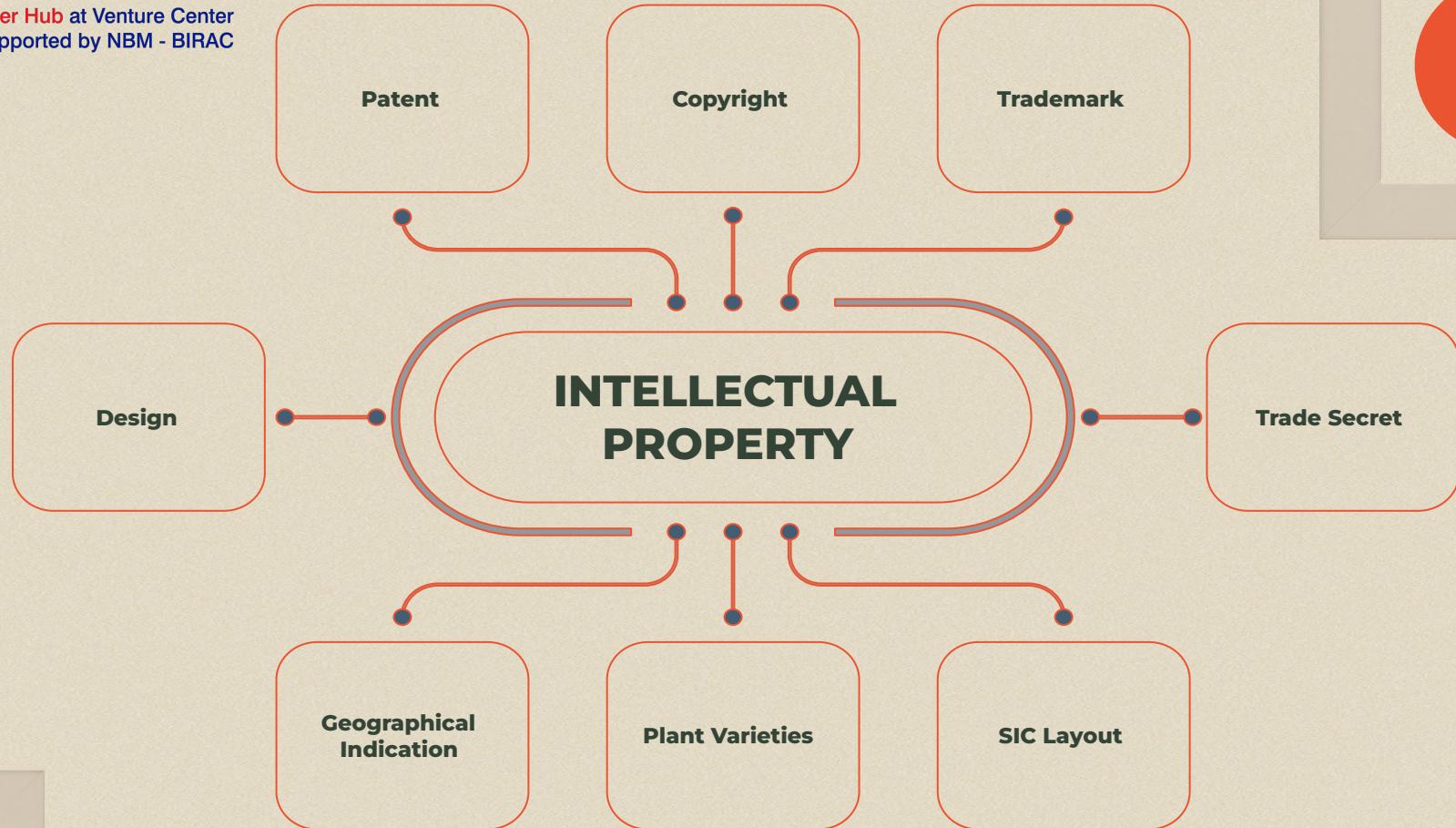
KIRTI DUBEY  
ARCHANA JOSHI



# OUTLINE

- Introduction to Trademarks
- How to get a trademark registered?
- International Trademark & Branding
- Best practices for Trademark Registration
- Case Studies
- Conclusion

# INTRODUCTION TO TRADEMARKS



# TRADEMARK

A trade mark is a visual representation attached to goods for the purpose of indicating their trade origin.

A recognizable & unique symbol, sign, design, word(s), expression or phrase that denotes or represents a product or service.



जिन्दगी के साथ भी  
जिन्दगी के बाद भी

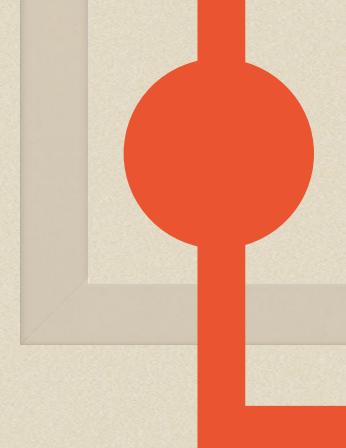
## Definition of 'trademark' according to the Trade Marks Act, 1999

Section 2 (1)(zb) states -

*"trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours;*

# What is the Purpose?

- Create legally enforceable ownership rights for a 'brand'
- Create mechanisms to trade in 'brands' & rights to exploit them commercially



## Importance of Trademark

- Formal property right; can be traded
- Enforceable; Prevent unfair competition; theft
- Clarity on ownership & exploitation rights
- Protects investment and reputation

# Why file for a Trademark?

Legal Protection

Preventive Measures

Pursuing Infringers

Licensing

Use of Notices

Monetary Benefits



# Different types of Trademarks

# Types of Trademarks



**ARBITRARY/FANCIFUL**

For example - DOVE



**SUGGESTIVE**

For example - EVEREADY



**COINED/INVENTED**

For example - KODAK



**DESCRIPTIVE**

For example - BEST BUY



**GENERIC**

For example - BAND-AID

# Kinds of Trademarks



## WORD MARK

For example - DISNEY



## THREE-DIMENSIONAL

For example - TOBLERONE



## COLOUR

For example - CADBURY



## DEVICE MARK

For example - ADIDAS



## SOUND MARK

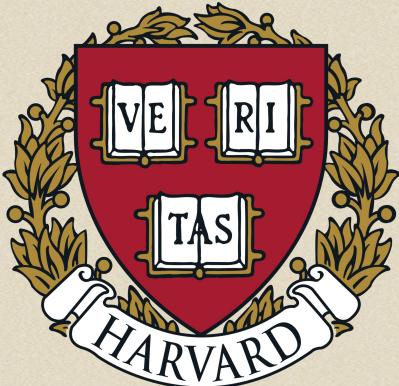
For example - NETFLIX



# Other Trademarks

Certification Mark	Collective Marks	Series Marks
<p>Trademarks used by entities for certifying the characteristics of the goods or services as being of a certain kind or quality. These marks are used by independent organizations only. For e.g. Indian Standards Institution.</p> 	<p>Trademarks which distinguishes (from others) the goods or services of members of an association which owns the trademark. They apply the same to have set standards for their service. For e.g. Institute of Chartered Accountants.</p> 	<p>Trademarks which are similar yet different only in minor, non-distinctive characters &amp; are registered by an owner to include multiple versions of a mark in similar goods/services. For e.g. Lay's.</p> 

# WELL-KNOWN MARKS



Google



BAJAJ



FedEx®

SUBWAY®



Bisleri®



# CLASSIFICATION OF GOODS/SERVICES

# Classification

## (Goods - 1 to 34 & Services - 35 to 45)

- Different services & products are divided into classes for the purpose of trademark. Each class consists products/services of a particular nature.
- Class Search: <https://euipo.europa.eu/ec2/search/find>
- NICE Classification for Goods/Services -  
<https://drive.google.com/file/d/1TGJnBjD4D9FGAF1xxi0ljqroAe3PmIDrZ/view?usp=sharing>

# Selection of Classes

## Jio

9 - Computer, Software,  
Electronics  
35 - Business services & consulting  
38 - Telecommunications  
42 - Technology & Software  
services



## Flipkart

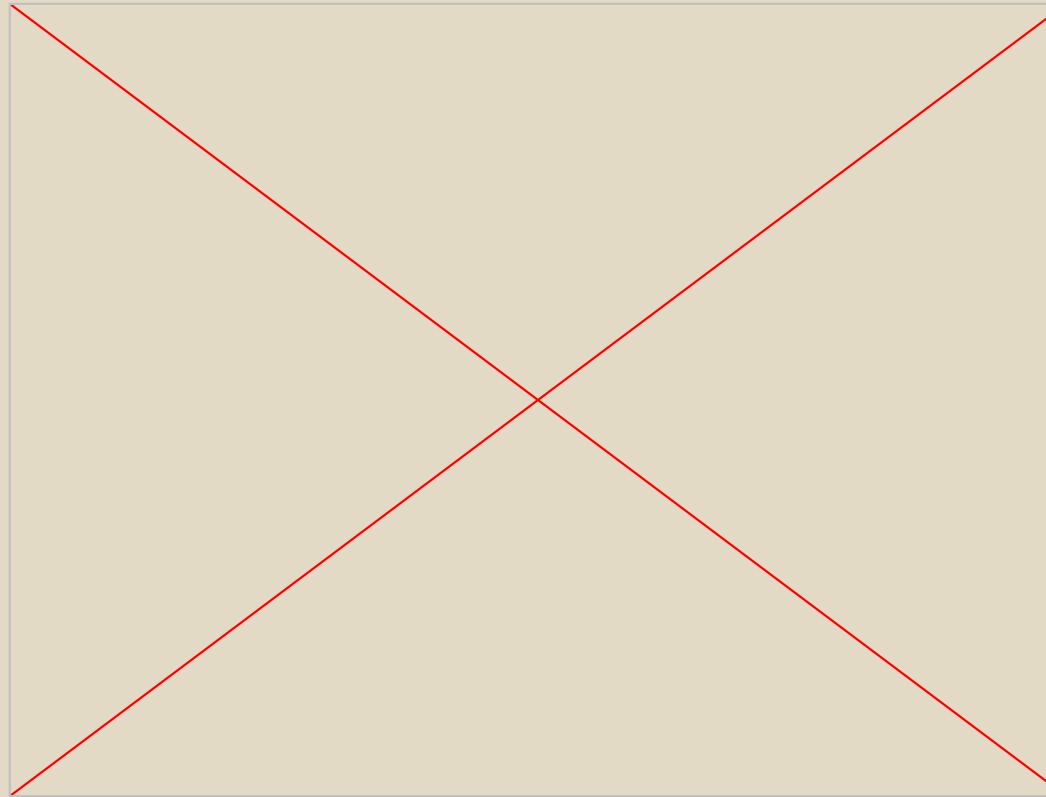
9 - Computer, Software,  
Electronics  
16 - Paper, books & Stationery  
35 - Business services & consulting  
38 - Telecommunications  
41 - Education, Entertainment &  
Training  
42 - Technology & Software  
services



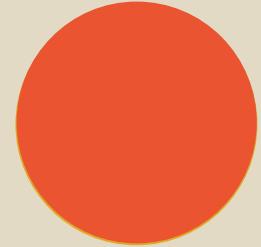
# TRADEMARK AVAILABILITY SEARCH

# Trademark Availability Search

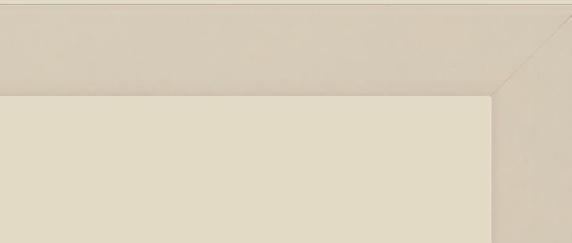
- Global Brand Database: <https://branddb.wipo.int/en/advancedsearch>
- Indian Trademark Search Website:  
<https://tmrsearch.ipindia.gov.in/tmrpublicsearch/frmmain.aspx>
- eSearch plus (European IP Search Database): <https://euipo.europa.eu/eSearch/>



# IP India Public Search Website

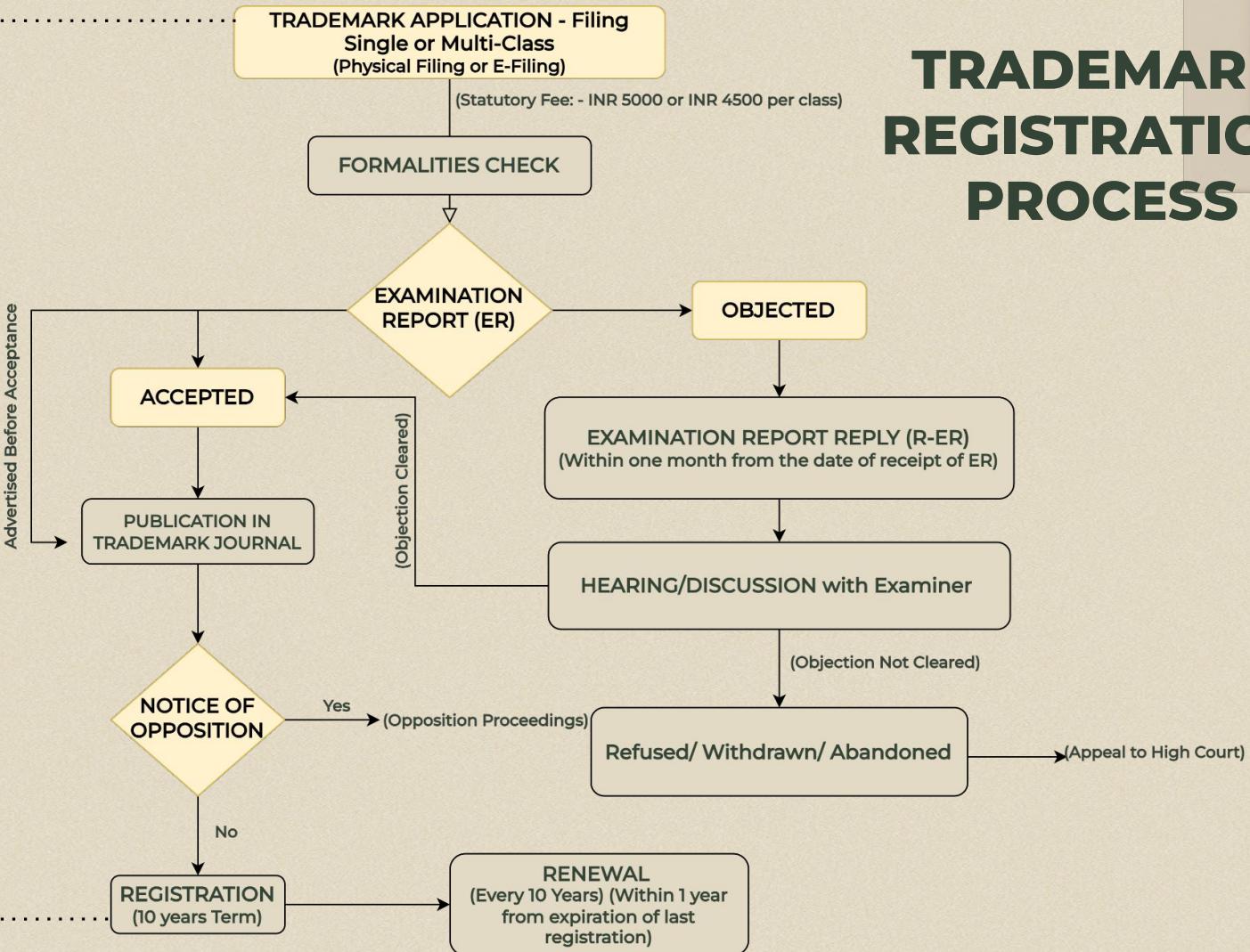


# HOW TO GET A TRADEMARK REGISTERED?



# TRADEMARK REGISTRATION PROCESS

Approximate 12-14 months from filing of Application



# GROUNDS OF REFUSAL

# Absolute Grounds of Refusal

- Non-distinctive or devoid of any distinctive character (e.g. Mithaiwala, Electrix)
- Exclusively indicates some characteristic (e.g. Good Tea)
- Customary to the language
- Causes deceive or confusion (e.g. Nike & Nuke)
- Hurts religious susceptibilities (e.g. Ganesh Beedi)
- Contains scandalous or obscene matter (e.g. Myntra Logo)
- Prohibited under Emblems and Names Act, 1950
- Shape of good results from nature of goods
- Shape necessary for technical result or gives substantial value

# Relative Grounds of Refusal

- Deceptively similar to the third party mark
- Similar to Well-known mark
- Identical to the third party mark
- Identical to Well-known mark
- Identical or similar marks in similar class of goods/services
- Identical or similar marks in different class of goods/services
- Any similarity within marks which results or suggests public confusion
- Any law which prohibits from mark registration
- Prohibition by virtue of Copyright Law
- Prohibition due to Law of passing off



# REGISTRATION CERTIFICATE

# Use of ™ & ® Notices

# Symbols to use on Marks

TM	®
Source identifier for goods/services	Registered trademark for goods/services
Used for unregistered trademarks & service marks	Used for registered trademarks only
Renders common law trademark rights	Renders ownership rights within Trademark Laws

- Use on Top-Right Corner



- Not to be used on Legal Forms or Affidavits
- Only use where using or protected legally

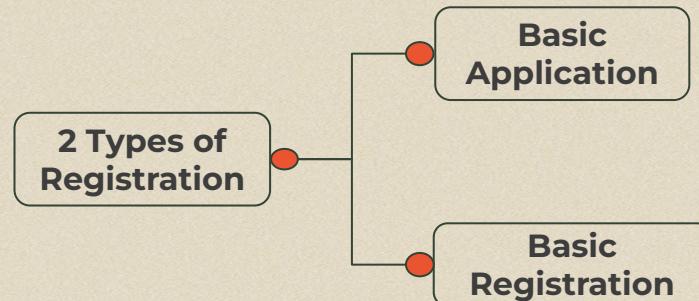


# INTERNATIONAL TRADEMARK & BRANDING

# One Stop Solution to Global Branding

## Via Madrid Protocol

- Governed by Madrid Agreement & Madrid Protocol (administered by International Bureau at World Intellectual Property Organization)
- One Application; One Currency; One Language - enables protection of marks within multiple territories with options to extend geographically
- Number of states who are contracting party to Madrid Agreement in effect: 130\*



\* According to [https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid\\_marks.pdf](https://www.wipo.int/export/sites/www/treaties/en/docs/pdf/madrid_marks.pdf) (Status on August 1, 2023)

# GOOD & BAD TRADEMARK



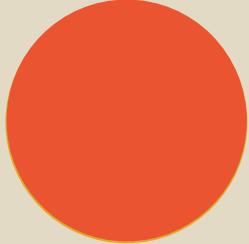
# GOOD TRADEMARK



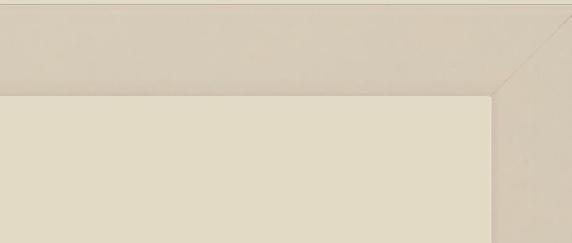
# BAD TRADEMARK



The multinational company working in fields of industry, healthcare and worker safety was incorporated as Minnesota Mining & Manufacturing company and later on adopted the logo of 3M.



# **BEST PRACTICES FOR TRADEMARK REGISTRATION**



# Best Practices for Trademark Registration



## SEARCH

Strong, Comprehensive & Thorough



## DEFINE

Clarity of goods/services; class



## CREATE

A Good (Distinctive) Mark



## USE

Mark usage with plenty evidences



## PROSECUTE

Application; Responses & Waiting Period



## MAINTAIN

Monitor & Enforce your rights; Timely Renewal

# TRADEMARK DILUTION, GENERICIDE & INFRINGEMENT

# Trademark Dilution & Genericide



## Dilution: STARBUCKS

Dilution of a mark by unsatisfactory use in a class of similar-looking products



## Genericide: XEROX

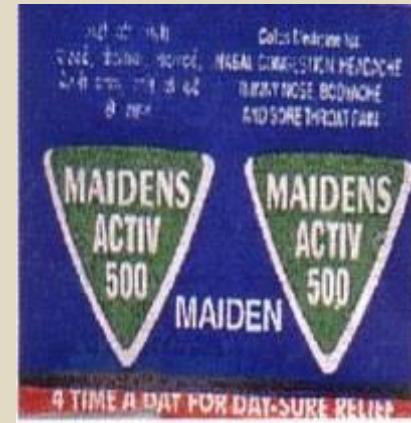
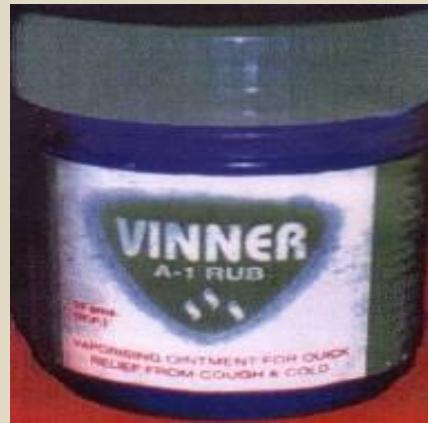
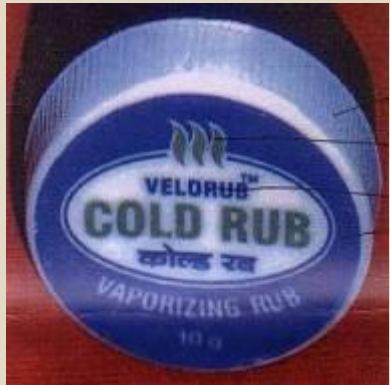
An overtly famous trademark taking a place as a common word in the slang

# TRADEMARK INFRINGEMENT



**VICKS (2007 - Present)**

# Counterfeit Products



# CASE STUDIES

# Case Study: Mom & Me → babyoye

- Insufficient availability search led to adoption of a confusingly similar mark inviting dispute
- Abandoned the mark for dispute resolution
- Acquired a budding brand for a new face
- Incurred loss of 100+ Cr. & criticism for failed litigations





**Me N Moms (Since 1994)**



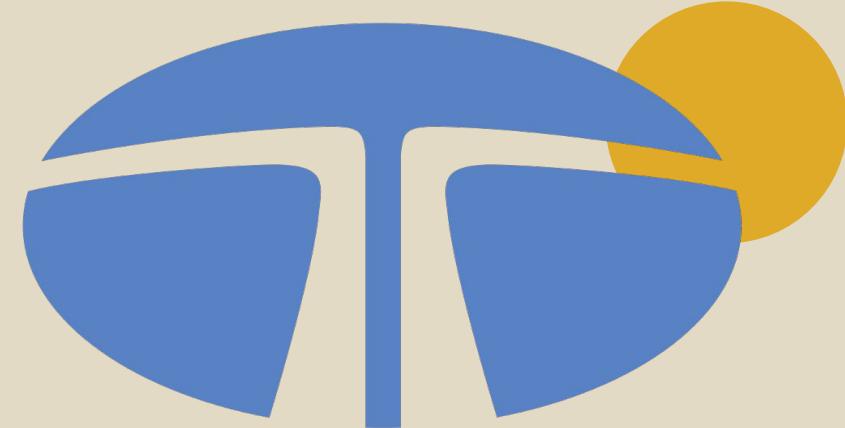
**Mom & Me (2008-2015)**

## Case Study: TATA

~ A well-sustained and reputed brand of all time

Takeaways -

- Quick approach and creating opportunity in disaster
- A strong list of brands built on even stronger values
- Independent set of businesses with creative and philanthropic viewpoint

The word 'TATA' in a bold, blue, sans-serif font, with each letter having a slight upward curve at the top.

# CONCLUSIONS

1

## PROTECT YOUR IP

Any kind of Intellectual property is worth protecting in business.

Making good use of your IP can generate wealth and respect for businesses effectively.

2

## TRACK YOUR IP

Tracking and being aware of IP potential in every arena is extremely important for startups to preside in the industry and not be open to harmful transactions.

# **TechEx.in Facilitation Services for Trademarks**

- Advise on procedure, costs & timeline
- Advise on strategy and availability search
- Preparation of documents required for registration
- Facilitation of physical filing at respective Indian Trademark Office
- Assistance in filing response to Examination Report
- Assistance in preparation for hearing before the Trademark Registry

# Trademark Filings by TechEx.in



firstcry



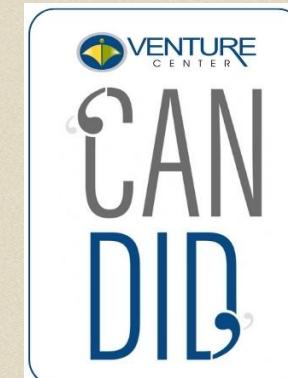
Nethram



BLACKFROG  
TECHNOLOGIES PVT. LTD.



Indsecure



AKB Cols  
sciences

lifta

HySAAA

Sa\*mit

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# THANKS

Does anyone have any questions?



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