

# BRANDING AND TRADEMARK

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WHAT IS THE CONNECTION BETWEEN A  
BRANDING AND IP LAW?

**BRANDING AND TRADEMARKS ARE KEY TO  
SUCCESS IN BUSINESS AND IN THE GLOBAL  
MARKET?**

# WHAT IS A BRANDING?

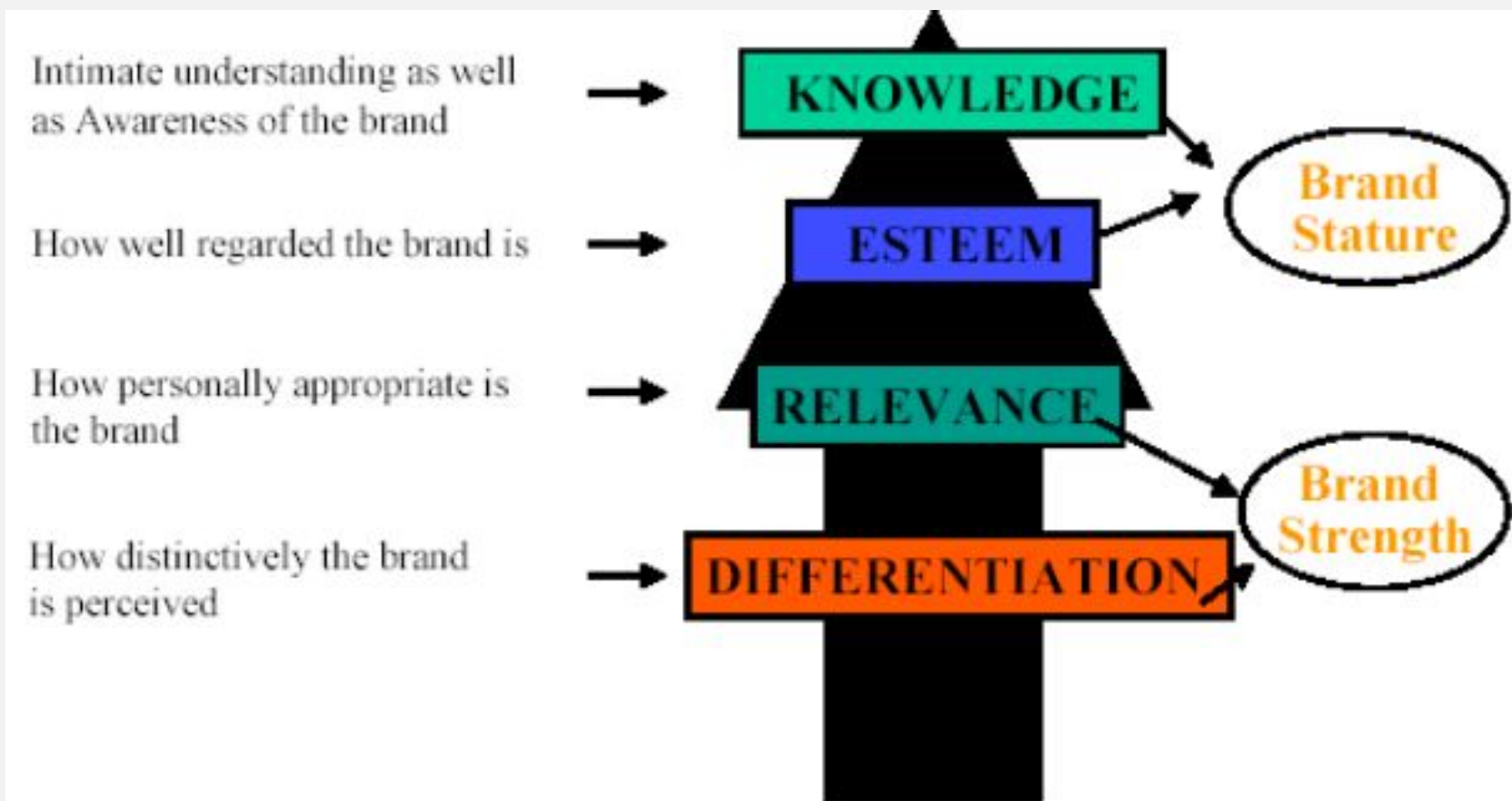
- Branding -- is the process by which the name or the identity of a company, an enterprise, an organization (etc.) is communicated.
- Branding allows a company to differentiate its products and services from the competition by creating a bond with its customers. It aims to take a position in the marketplace and create customer loyalty.
- It is the way by which companies launch and sell goods & services, communicating the essence of new products and lines, highlighting why it is great and better than all competing products.
- It reflects in general a prestigious (aesthetic) image in order to attract more consumers.



# SUCCESSFUL BRANDING

- **DEVELOPING A BRAND IS PART OF A STRATEGIC BUSINESS PLAN**
- Target what customers care about: Articulate precise values and qualities that are relevant and of direct interest
- Emphasize features that are both important to consumers and quite differentiated from competitors
- Sell the brand outside (but also think about motivating your partners & your employees in the development of your brand).
- Keep the brand flexible, create multiple variations and names for your products, imagine in advance a rich collection of packaging

# HOW BRANDS ARE BUILT



# INTRODUCTION TO IP LAW

**Intellectual property (IP)** refers to creations of the mind, such as inventions; literary and artistic works; designs; and symbols, names and images used in commerce.





Scotch Whisky is registered as a Geographical Indication (GI) in many markets around the world, including the UK and EU.

The brand name and logo is trademarked.



The precise components of a blend are usually a closely guarded secret protected by 'trade secret'.

Distinctive packaging and design can be trade marked under trade dress protection.

# TRADEMARKS

A Trademark is any sign or any combination of signs used to distinguish the goods and/or services offered by one undertaking from those offered by another.



(WORD)



(NAME)



(SURNAME)



SLOGAN



DEVICE



NUMBER



(SYMBOL)



(SIGNATURE)



(LETTER)



SHAPE



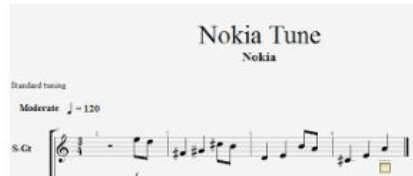
SINGLE COLOR



COMBINATION OF COLORS



SOUND



PACKAGING



COLLECTIVE MARK



CERTIFICATION MARK



RMG&Co.  
LAW GROUP

## ORIGIN AND DEVELOPMENT OF TM

- During the British regime in India, the big merchants and businessmen who had established their mark in the market in respect of certain goods under the particular brand name, style or design felt they should continue to be sold or traded under the same brand name, style or design and no other person shall be allowed to adopt that brand name, style or design.
- The Government earlier enacted the **Indian Trademark Act 1940**, then **Indian Trade & Merchandise Marks Act, 1958** and finally it was replaced by **Indian Trademark Act, 1999**.

# ORIGIN AND DEVELOPMENT OF TM

- **The Trade Marks Bill, 1999** was introduced in the Lok Sabha which was then passed by them and eventually passed by even the Rajya Sabha.
- The Bill received the assent of the President on 30.12.1999 and became an Act.
- **OVERVIEW OF TM ACT 1999**
  - 13 chapters with 159 sections.
  - Provides the procedure of registration of trademark.
  - Provides remedies for infringement of trademark.
  - Consists of Appellate board, its powers and functions.

# WELL-KNOWN TRADEMARKS



# CLASSIFICATION OF TRADEMARKS

**Trademark  
Classes in India**

 CLASS 1 Chemical Products	 CLASS 10 Medical Devices & Apparatus	<b>CLASS 19</b> Building & Construction Material (Non Metallic)	 CLASS 28 Toys, Games & Sports Goods	 CLASS 37 Construction & Building Repair Services	
 CLASS 2 Paints, Varnishes, Lacquers	 CLASS 11 Lighting, Heating, Cooking Water Supply Apparatus		 CLASS 20 Furniture, Mirrors & Frames etc	 CLASS 29 Meats & Processed Food(s)	 CLASS 38 Telecommunication Services
 CLASS 3 Cosmetics, Cleaning & Laundry Products	 CLASS 12 Vehicles (Automobile)		 CLASS 21 Houseware & Glassware	 CLASS 30 Staple Foods (Flour, Cereals etc)	 CLASS 39 Transportation & Storage Services
 CLASS 4 Industrial Oils, Greases & Lubricants	 CLASS 13 Firearms, Explosives & Ammunition		 CLASS 22 Ropes, Fibre, Stuffing Material	 CLASS 31 Agri & Horticulture Products, Live Animals	 CLASS 40 Treatment of Material(s) Services
 CLASS 5 Pharmaceutical Products & Veterinary	 CLASS 14 Precious - Metals & Stones, Jewellery		 CLASS 23 Yarns and Threads (Textile use)	 CLASS 32 Beer, Mineral Water & Non Alcoholic Drinks	 CLASS 41 Education & Entertainment Services
 CLASS 6 Common Metals & Alloys	 CLASS 15 Musical Instruments		 CLASS 24 Textiles, Textile Goods & Fabrics	 CLASS 33 Alcoholic Beverages (except Beer)	 CLASS 42 Scientific, Technological and Computer Services
 CLASS 7 Machines & Machine Tools	 CLASS 16 Stationery & Paper Goods		 CLASS 25 Clothing & Footwear	 CLASS 34 Tobacco Products	 CLASS 43 Food & Restaurant Services
 CLASS 8 Hand - Tools & Implements	 CLASS 17 Rubber & Extruded Plastic Products		 CLASS 27 Carpets, Floor Coverings & Wall Hangings (Non Textile)	 CLASS 35 Advertising & Business Services	 CLASS 44 Medical, Cosmetic & Veterinary Services
 CLASS 9 Scientific & Engineering Devices (Apparatus)	 CLASS 18 Leather & Leather Goods			 CLASS 36 Insurance, Financial & Real Estate Services	 CLASS 45 Legal & Security Services

# WHAT CAN AND CANNOT BE TRADEMARKED

## CAN

- Distinctive ( ALAG )
- No Deceptive Similarity
- Same description and similarity of goods
- Prior use

## CANNOT

- Proper names or likenesses without consent from the person
- Generic terms, phrases, or the like
- Government symbols or insignia
- Vulgar or disparaging words or phrases
- The likeness of a U.S. President, former or current
- Immoral, deceptive, or scandalous words or symbols
- Sounds or short motifs. These are covered by Copyright instead.



# WHAT TO AVOID WHEN SELECTING A TRADEMARK.

- **Generic terms: CHAIR to sell chairs**
- **Descriptive terms: SWEET to sell chocolates**
- **Deceptive terms: “ORWOOLA” or “Pure wool” for 100% synthetic material**
- **Marks and terms contrary to public order/morality**
- **Do not use flags, armorial bearings, official hallmarks, emblems without a legal authorization**

# PRACTICAL ASPECTS OF TRADEMARK

- Create or buy a trademark (after searching worldwide to find out that there are no similar registered ones **-avoid claims-** refusals or oppositions)
- Protect your trademark through your national or regional office and then extend it to the world (WIPO Madrid & Protocol System)
- Use and maintain your trademark(s) (**paying fees, following notification of refusals, extending territory**)
- Enforce your trademark(s), innovate (**develop new products**)

# TRADEMARK PROCEDURE IN INDIA

- Search
- Filing application
- Examination of Trademark
- Response to examination report
- Hearing
- Acceptance/Advertise before acceptance
- Publication for 4 months
- Oppositions
- Registration
- Renewal within 10 year from the date of filing

# VALUE OF FAMOUS TRADEMARKS

- Global Brand Scoreboard
  - 1. Coca-cola      67.53\$ billion
  - 2. Microsoft.    59.95\$ billion
  - 3. IBM            53.37\$ billion
  - 4. Intel            35.58\$ billion
- ( and increasing )

# ADVANTAGES AND BENEFITS



Legal Protection.



Tradable Asset



Licensing and Assignment

# BRAND | SUB-BRAND



Apple WATCH   Apple News   Apple One  
Apple tv+   Apple Music   Apple News



FedEx Express   FedEx Ground   FedEx Custom Critical  
FedEx Office   FedEx Freight   FedEx Trade Networks



prime   amazon.com   aws  
kindle   prime video   WHOLE FOODS



GE Security

GE Marine

GE Aviation

GE Healthcare

GE Lighting

GE Energy

GE Capital

## TRADE DRESS

**Trade dress** is the characteristics of the visual appearance of a product or its packaging (or even the design of a building) that signify the source of the product to consumers.



Trademark



Trade dress

PLAINTIFFS' PRODUCTS	DEFENDANTS' IMPUGNED PRODUCTS
<p data-bbox="901 329 1065 365">MONACO</p>  The image shows a yellow and red package of Monaco biscuits. The word "MONACO" is written in large, bold, black letters across the center. There are several round biscuits visible on the packaging.	<p data-bbox="1498 329 1615 365">CrackO</p>  The image shows a yellow and red package of CrackO biscuits. The word "CrackO" is written in a stylized font. There are several round biscuits visible on the packaging.
<p data-bbox="876 618 1090 654">HIDE &amp; SEEK</p>  The image shows a purple and white package of Hide & Seek biscuits. The words "HIDE & SEEK" are written in a stylized font. There are several rectangular biscuits visible on the packaging.	<p data-bbox="1454 618 1658 654">PEEK-A-BOO</p>  The image shows a purple and white package of Peek-A-Boo biscuits. The words "PEEK-A-BOO" are written in a stylized font. There are several rectangular biscuits visible on the packaging.
<p data-bbox="886 906 1080 942">KRACKJACK</p>  The image shows a brown and white package of Krack Jack biscuits. The words "Krack Jack" are written in a stylized font. There are several square biscuits visible on the packaging.	<p data-bbox="1429 906 1684 942">KRACKER KING</p>  The image shows a brown and white package of Kracker King biscuits. The words "KRACKER KING" are written in a stylized font. There are several square biscuits visible on the packaging.



Pidilite Industries Limited trade dress



Poma-Ex Products trade dress



## USING A TM ON THE INTERNET

- Use of TM on internet may raise controversial legal problems
- Conflict between trademarks and domain names(internet addresses) - cyber squatting
- WIPO procedure for domain name dispute (<http://arbiter.wipo.int.domains>)

## POPULAR CASES OF TRADEMARK

- XEROX TRADEMARK CASE

If you photocopy something, do you 'Xerox' it?

The word 'Xerox' became that generic that Xerox fell into the EU trademark dispute. A brand mark that **becomes generic** loses **trademark** protection, brand value, and profit. Although, Xerox played smart and still has its trademark protection.



## TRADEMARK AS A TRADABLE ASSET

South Korea's Lotte Confectionery **acquired** Ahmedabad-headquartered ice cream maker **Havmor** Ice Cream Ltd (HIL) for Rs 1,020 crore in an all-stock deal.



YOU CAN GET A WORDMARK AND LOGOMARK  
BOTH TO PROTECT YOUR BRAND.

RMG&Co.

LAW GROUP





**HONDA**

## OTHER TRADEMARK CASES



A case example of an application that is free-riding on a well-known trademark: Invalidation (the left one)

**KUMA**  **VS.** **PUMA** 



A case example of an application that is free-riding on a well-known trademark in other countries: Invalidation (the left one)

**DoggiS** **VS.** **DoggiS**



A case example of an application that is free-riding on a well-known trademark: Invalidation (the right one)

**ROLEX** **VS.** **POLEX**



A case example in which an agent filed an application to register a trademark of its client: Invalidation (the left one)

 **VS.** 



A case example of an application that is free-riding on a well-known trademark: Opposition decision upheld (lack of intention to use) (the left one)

**IWATCH** **VS.** **SWATCH**



Nasty Nestlé

# COPYRIGHT

Copyright is concerned with protecting the work of the human intellect. The domain of copyright is the protection of literary and artistic works. These include writings, music, and works of the fine arts, such as paintings and sculptures, and technology-based works such as computer programs and electronic databases.



## WHAT CAN BE COPYRIGHTED ?

- literary works such as novels, poems, plays, reference works, newspaper articles;
- computer programs, databases;
- films, musical compositions, and choreography;
- artistic works such as paintings, drawings, photographs, and sculpture;
- architecture; and.
- advertisements, maps, and technical drawings.

## DESIGNS ACT, 2000

- The **primary objective** of the **Design Act** is to protect the **designs**.
- The **Design Act** Of 2000 is an **Act** to consolidate and amend the **law** relating to the protection of **designs**. Its **main objective** is to protect new or original **designs** from getting copied which causes loss to the proprietor.
- Salient Features:
  - 1) The work must be capable of selling and made separately.
  - 2) It must be original and new to the market.
  - 3) It should be purely distinguishable from other **designs**.
  - 4) It must not relate to obscenity or any material which is inappropriate.

## MAIN PROVISIONS OF THE ACT

- 1) The 'Controller General of Patents, Designs and Trade Marks' appointed shall be the controller for Industrial design.
- 2) Registration Formality
- 3) Prohibition of Registration
- 4) Certification
- 5) Expiration & Renewal
- 6) Public Inspection
- 7) Petition for the cancellation
- 8) Benefits of Registration
- 9) Refused applications
- 10) Infringement

# INDUSTRIAL DESIGNS THAT CANNOT BE REGISTERED

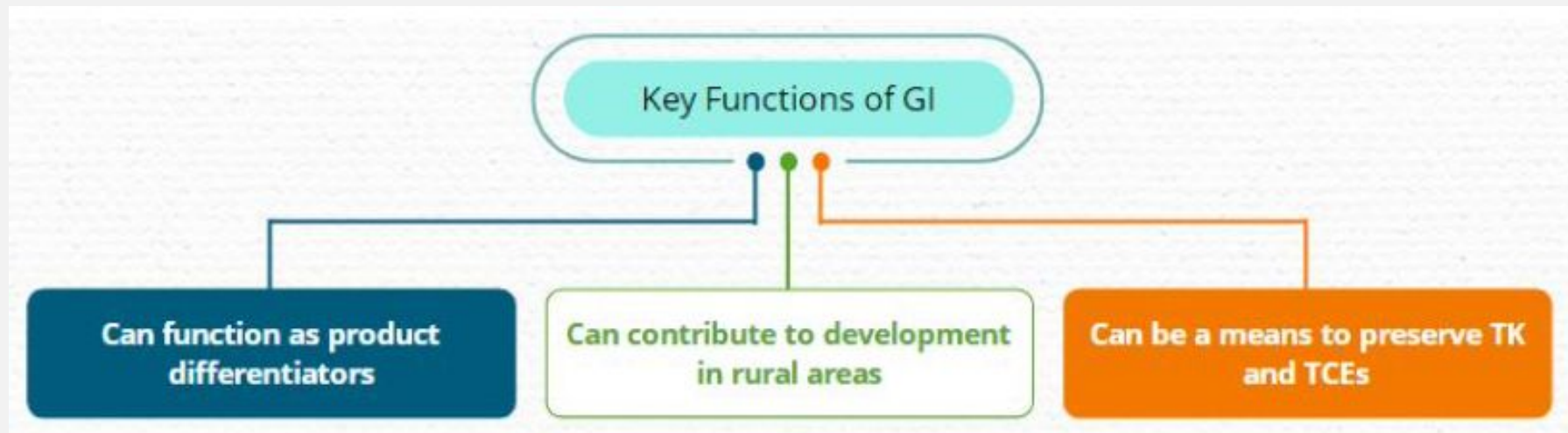
- Opposing to public moral values
- Any process of construction
- Not distinguishable from previously registered designs
- Includes Trademark
- Books, jackets, calendars, certifications, forms and other documents, dressmaking patterns, greeting cards, leaflets, maps and plan cards, postcards, stamps, medals.
- Flags, Emblems or Signs of any country
- Integrated circuits

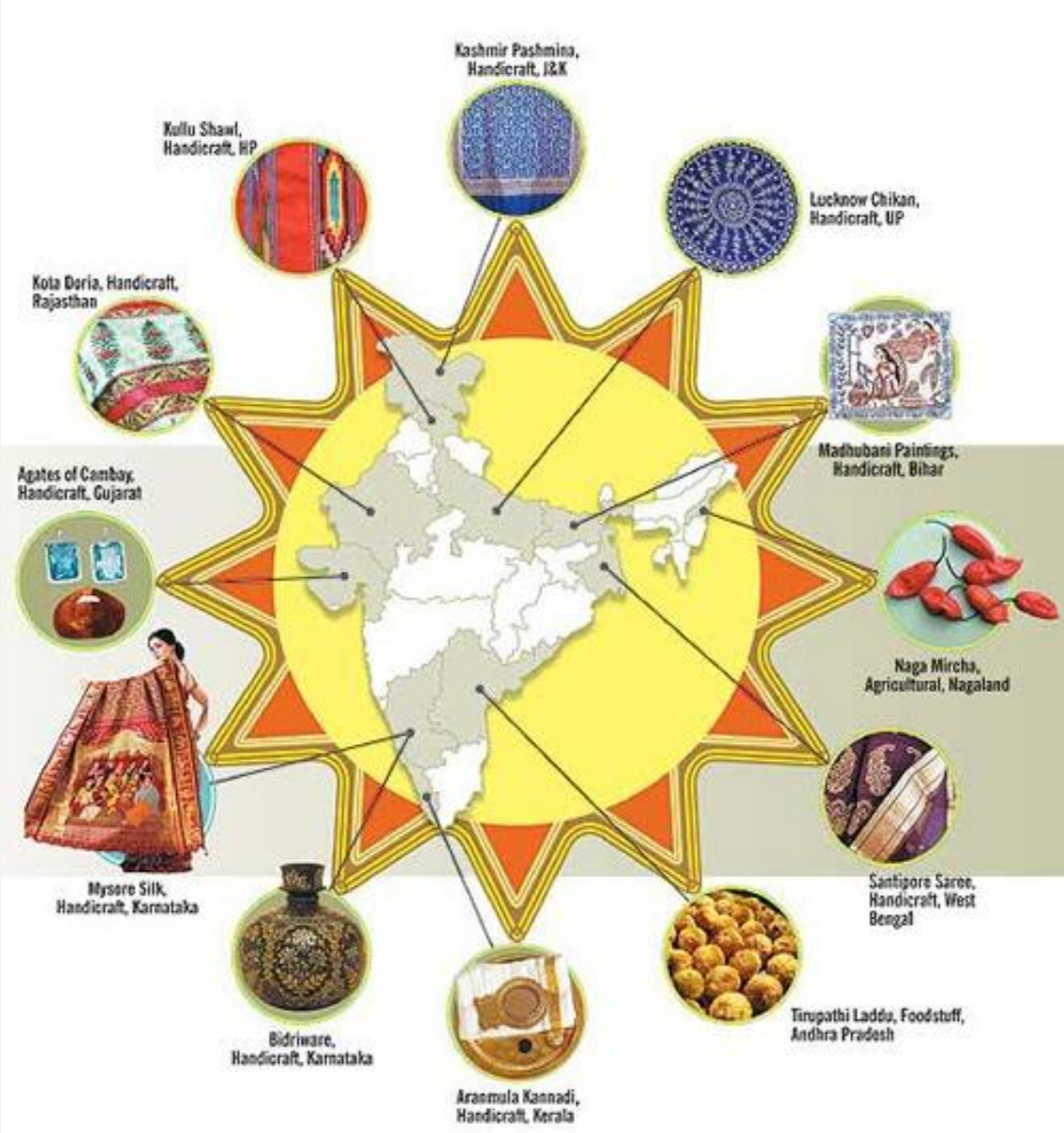
# Examples of Designs



# GEOGRAPHICAL INDICATIONS

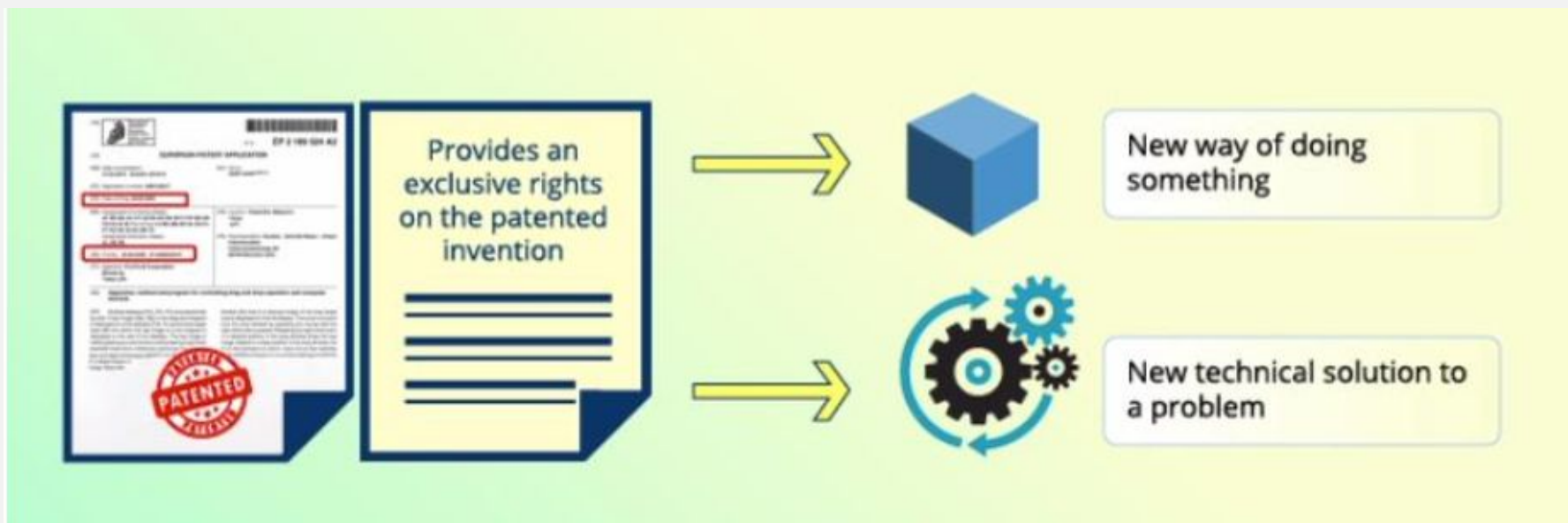
Geographical indications or GIs are signs identifying goods that have a specific geographical origin and possess a given quality, reputation or other characteristic that is essentially attributable to that origin. They can be used for both agricultural and industrial products.





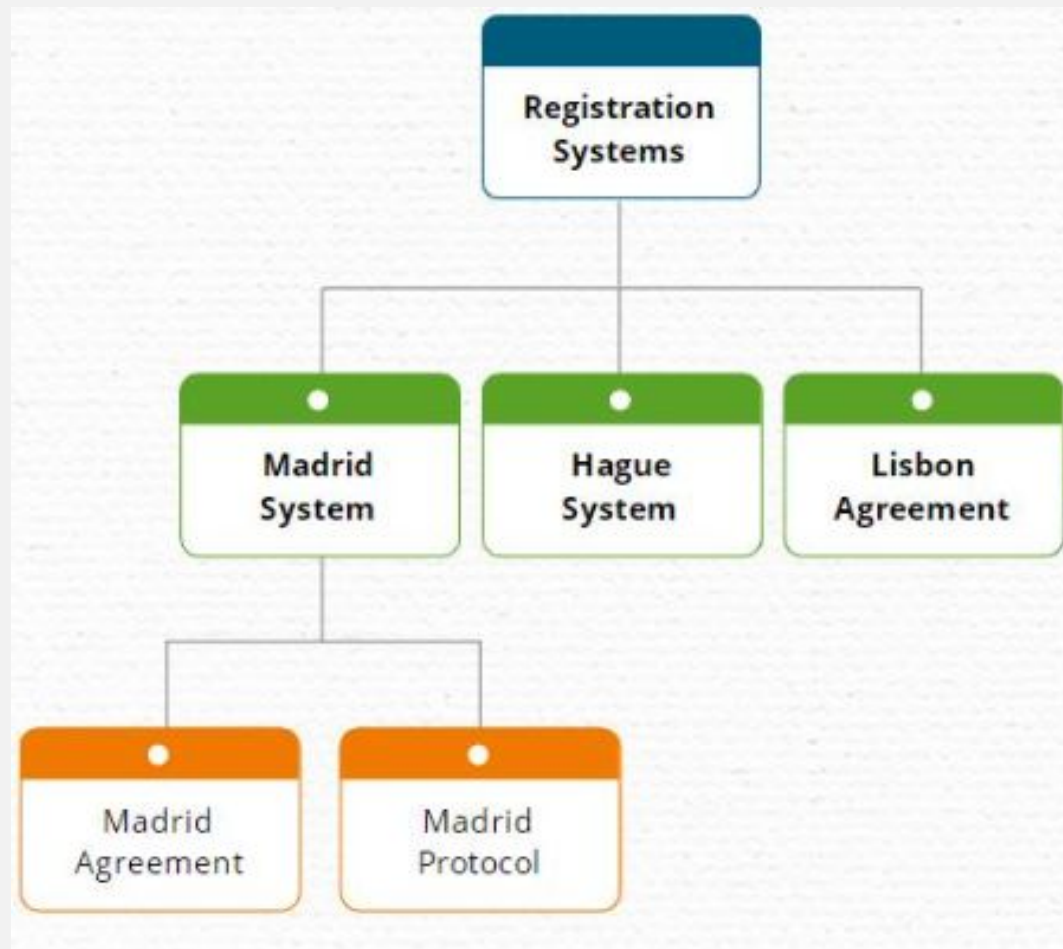
# PATENTS

A Patent is a legal document that grants an exclusive right on the patented invention, which is a product or a process that provides, in general, a new way of doing something, or offers a new technical solution to a problem.





# INTERNATIONAL REGISTRATION



## MADRID SYSTEM FOR THE INTERNATIONAL REGISTRATION OF MARKS

The Madrid system for the international registration of marks (the Madrid system), that was established in 1891, functions under the Madrid Agreement and the Madrid Protocol (adopted in 1989) are administered by the International Bureau of WIPO located in Geneva headquarters in Switzerland.

This system for an international protection of Trademarks and Brands is adopted by more than 70 member states of WIPO, which are members of the

**« MADRID UNION »**

**The Madrid and the Protocol system offers the possibility  
to record a trademark in more than 70 countries at once**

# PROTECTING A TM THROUGH REGISTRATION

- The most widely used classification system (Nice has 34 classes for goods and 11 for services - a total of 45 classes of goods and services).
- Some TM offices such as in US and Canada require the proof that the TM is used.
- A substantive examination may be required to avoid conflict with an existing and similar Mark, previously registered.
- Some countries publish the TM in a journal allowing 3rd parties to make an opposition (during a certain period of time).
- Once it is decided that there are no grounds for refusal, a certificate is issued with a validity of 10 years.
- Registration can be renewed indefinitely but may be cancelled if TM is not actively used for a certain period stated in the TM law.

## CASE LAWS

### 1) Yahoo!, Inc. v. Akash Arora & Anr

- Held: A domain name serves the same function as trademark and is entitled to equal protection. The defendant had a domain name 'Yahoo India!' which was identical and phonetically similar to the plaintiff's trademark 'Yahoo!'. The court held that internet users would be confused and deceived into believing that both the domain names have the same source.



# CASE LAWS

## 2) Amul Wins Trade Mark Case in Gujarat High Court

The Gujarat High Court in a landmark judgement has ruled that a registered trade mark user has the right to restrict others using their trade mark for different class or goods. It has ruled that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with or similar to the registered trade mark and is used in relation to goods or services which are not similar to those for which the trade mark is registered. It further ruled that the contention of using a trade mark for a long time, without valid permission, is not acceptable, as passing off is a recurring wrong and therefore can be prevented at any stage and at any time.

This significant judgement will come as a great relief to leading organisations whose trade marks are regularly being infringed by unprincipled elements. The problem of trade mark infringements has assumed alarming proportions all over the country. The Kaira District Co-operative Milk Producers' Union Ltd. and GCMMF had filed trade mark infringement cases against two local shop owners – Amul Chasmaghar and its partners and Amul Cut Piece Stores in the District Court, Anand. The District Court, Anand passed an order dated 25-4-07, ruling that it was a clear case of infringement and restrained the two from using Amul trade mark. Amul Chasmaghar had challenged this interim injunction in the Gujarat High Court.



**THANK YOU.**

**REGARDS,**

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