

The power of a **Trademark**. It's not just a name – it's identity, reputation, and trust.

UNDERSTANDING THE BASICS OF TRADEMARKS & Why it is important to implement Watch Services

TRADEMARK

DESIGN
LAW
REGISTERED
LEGAL
BRAND
NAME
EXPERT
BUSINESS
EXCLUSIVE
TRADE
MARK
CORPORATE
IDENTIFY
THE
BUSINESS
RECOGNIZABLE
CLASS
COMMERCIAL
MARKETING
COMPANIES
ATTORNEY
CONSUMERS
REGISTER
CORPORATE
RIGHTS
UNIQUE
VALUE
RECOGNIZABLE
TRADEMARK



What is a Trademark?

A trademark serves as a **source identifier**, capable of distinguishing the goods or services of one business from those of another.



A

Word Mark

A distinct word or phrase, such as "AMUL".



Device/Logo Mark

A unique symbol or design, like the iconic Apple logo.



Slogan Mark

A memorable phrase that captures a brand's essence, e.g., "Because You're Worth It".



Other Marks

Includes shape, sound, colour, and combination marks.

❖ Each trademark must be unique & distinctive – descriptive/ generic marks are not permitted.

Basics of Trademark Law

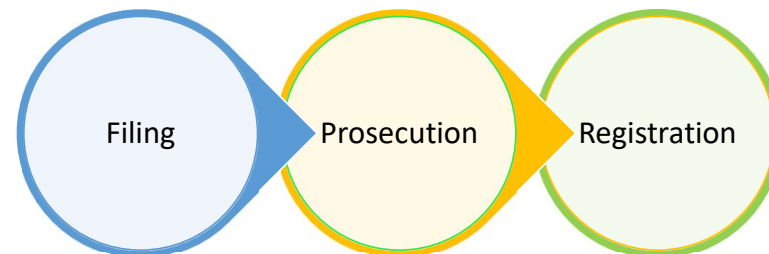
- Trademarks are territorial in nature
- Prior user
- NICE classification [Classes 1 to 45]
- Registration – exclusive right to use the trademark
- Violation of the rights – Infringement/ Passing-off actions, Damages, Criminal complaint with respect to counterfeits

Trademark Classes: 1 to 45

- **Classes 1–34:** For Goods (e.g., Class 3: Cosmetics, Class 9: Electronics, Class 11: Lighting).
- **Classes 35–45:** For Services (e.g., Class 35: Advertising, Class 41: Education, Class 45: Legal Services).

Multiclass Applications – Class 99

Class 99, enables the filing of a single application across multiple classes. This simplifies the process, though each class must still undergo individual scrutiny for potential similarities or conflicts.



Trademark Objections

Trademark applications can face refusal on two primary legal grounds: absolute and relative. These sections ensure that only truly distinctive and non-conflicting marks are registered, preventing consumer confusion and protecting existing rights holders.

Section 9: Absolute Grounds for Refusal

Applies when a mark lacks inherent distinctiveness, meaning it cannot function as a trademark. This includes marks that are:

- Descriptive of the goods/services (e.g., "PURE WATER" for bottled water).
- Generic or customary terms in trade practices.
- Deceptive, scandalous, or unlawful.
- Incapable of distinguishing goods/services.

✓ **Generic terms** = Common names of the goods or services themselves.

✗ Cannot be registered **under any circumstance**, even with long use.

⚠ **Descriptive terms** = Describe **features, qualities, or characteristics** of the product.

Can be registered **only if** they acquire distinctiveness.

Section 11: Relative Grounds for Refusal

Concerns the likelihood of confusion with earlier registered trademarks. Refusal occurs if:

- The mark is identical or similar to an existing mark.
- Goods/services are identical or similar, causing confusion (e.g., "NIKKE" for sportswear vs. "NIKE").
- The earlier mark has a reputation, and the new mark would exploit or harm it.

Why Watch Services?

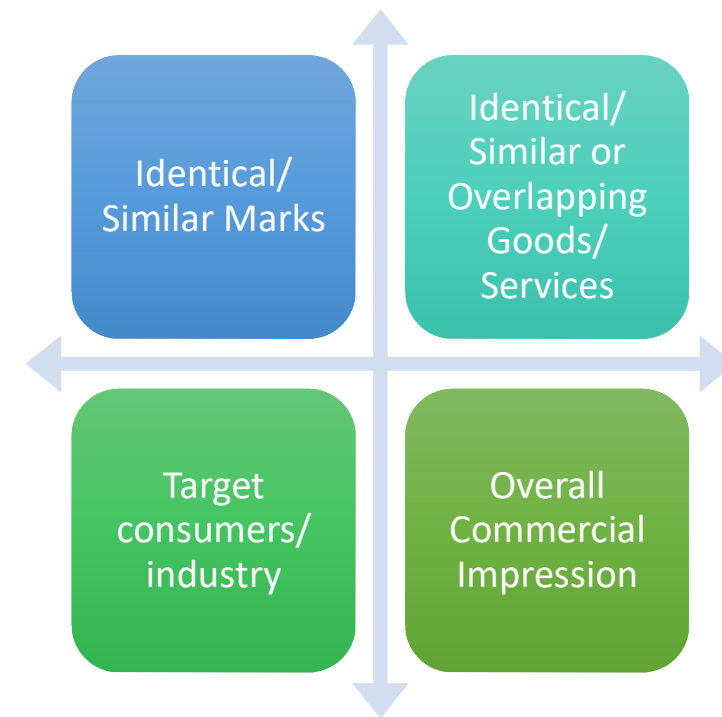
Continuous surveillance of new filings, domain names, and online usage for confusingly similar marks is required in order to mitigate the following business risks:

- ❑ Lost opposition window
- ❑ Dilution/ erosion of brand equity
- ❑ Impact on business
- ❑ Higher litigation costs later

In today's hyper-competitive, global marketplace, a robust trademark watch service is no longer a nice-to-have - it's a necessity. By proactively monitoring for potential infringement and taking swift action to enforce their rights, brand owners are maintaining the integrity of their brand and value of their trademark assets.

Benefits:

- ✓ Timely Actions
- ✓ Maintain brand identity & consumer trust
- ✓ Prevention of Counterfeits & Brand dilution
- ✓ Strong IP Portfolio



Identifying Similar Marks

A trademark can be considered deceptively similar to another when there exists a likelihood that it could confuse or mislead consumers about the nature, source or affiliation of the goods or services it represents. Assessing trademark similarity goes beyond surface-level comparison, requiring a deep dive into how marks are perceived by the public.



Visual Similarity

Marks with similar stylisation, font, or overall appearance, e.g., "K&U" vs. "K&V" in identical cursive.



Phonetic Similarity

Marks that sound alike when spoken aloud, regardless of spelling, e.g., "Kwality" vs. "Quality".



Aural Similarity

Marks that sound alike when spoken, regardless of spelling, e.g., "ALFA" vs. "ALPHA".



Conceptual Similarity

Marks that convey the same or similar idea or meaning, e.g., "SunCare" vs. "SolarCare".

While trademark similarity is typically assessed within the same class of goods or services, in the case of well-known marks, cross-class similarity is also taken into account to prevent dilution and protect brand reputation.

Eg. **Daimler Benz Aktiegessellschaft v. Hybo Hindustan (AIR 1994 Delhi 239)** – BENZ used for undergarments not permitted, even though entirely different goods.

Examples of Deceptively Similar Trademarks:



LikeMe → Lakme

Nuke → Nike

Nataraj → Nataraj

Pepsi Plus → Pepsi

Saffola FITTIFY Gourmet → Saffola FITTIFY

NUTRI ACTIVE → NUTRI CHOICE

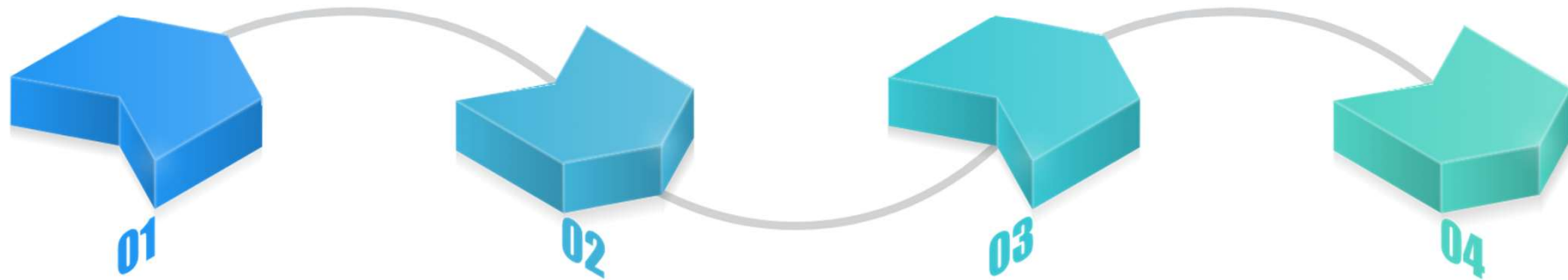
HM Megabrands → H&M

VOGUE → VISIONVOGUE

Subject Mark	Proposed Impugned Mark
	



Our Approach:



Understanding Client's Brand Portfolio

- A brand dictionary is created: variants, phonetics, stylization
- Monitoring of core & allied classes
- Understanding nature of threats: bad-faith filings, cybersquatting
- Awareness of client's sensitivity thresholds & reporting needs

Search Tools & Methodology

- TMView, Markify, WIPO Global Brand Database, Indian Trademarks Registry and other TM Tools, etc.
- Search strategies – identical/ phonetic/ aural/ conceptual

Detecting Deceptive Similarity

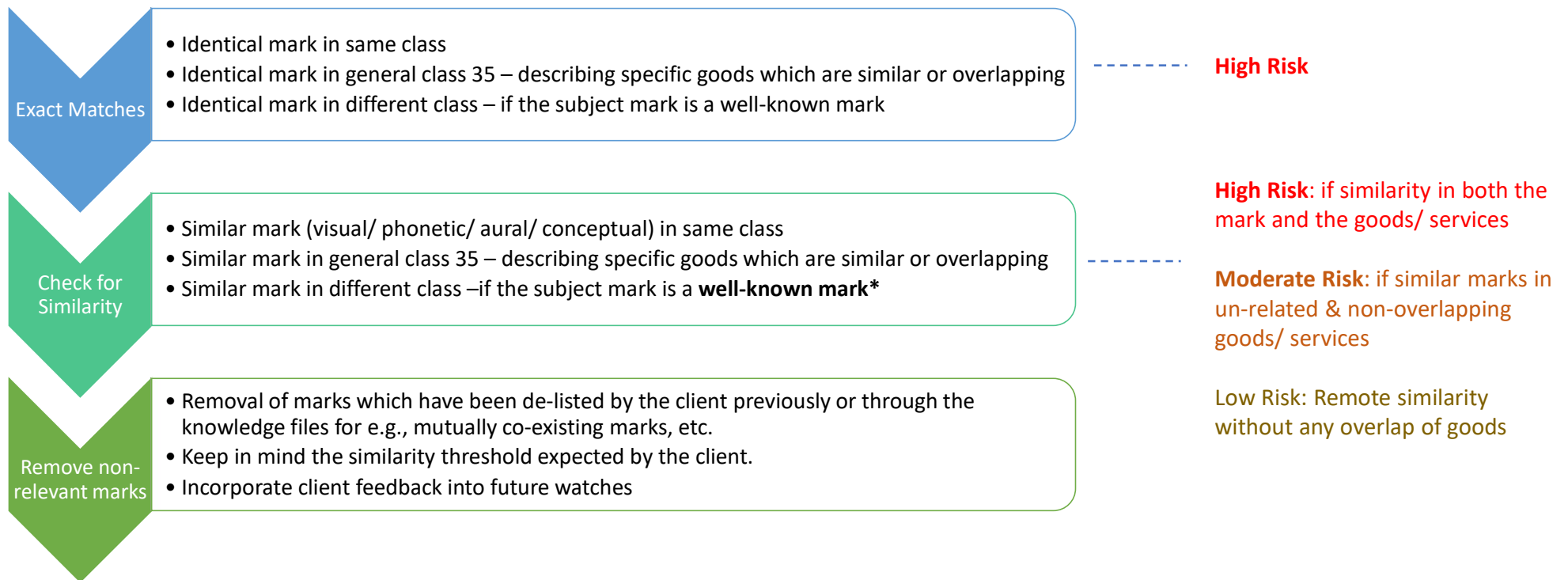
- Assess visual, phonetic, structural, conceptual similarity
- Test of imperfect recollection
- Other considerations for well-known marks

Risk Assessment & Reporting

- Risk tagging: High / Medium / Low
- Any other client-specific requirements

Step-by-Step Process to Assess Trademark Similarity

We employ a meticulous, multi-stage process to identify potential trademark infringements, ensuring comprehensive protection for the clients. This involves a hierarchical search, beginning with exact matches and progressively moving to phonetic, aural, and conceptual similarities across relevant classes.



(*Well-known marks enjoy greater protection – across all classes)

Non-Verbal Infringement: Trade Dress & Label Trademarks

Trademark protection extends beyond words and logos to the overall visual presentation of a product, known as trade dress. This crucial area of law prevents competitors from mimicking a product's distinctive appearance, which could confuse consumers and dilute brand equity.

What is Trade Dress?

Trade dress encompasses the overall visual appearance and packaging that signifies a product's source. This can include: Colour combinations and graphic layouts; Unique bottle shapes or product configurations; Distinctive font usage and label designs.

Label Designs

These are generally packaging-style marks. In such cases, assess whether the overall layout, color scheme, or visual presentation bears any resemblance to the client's trade dress. Even if the names differ, a similar look and feel can still amount to deceptive similarity.

Examples:

Pidilite Industries Limited Vs Poma-Ex Products (Bombay High Court 2017 (72) PTC 1)





Thank
you

Watch services are the brand's early warning system. It is often the first step in winning.

Stay Ahead with AILegal Insights

Contact us for strategic guidance on patents, trademarks, and IP compliance.

 services@ailegalconsultants.com