

STRATEGIES TO AVOID TRADEMARK OBJECTIONS

Trademark objections are common but can be avoided by keeping in mind the following:

- 1. Trademark search:** Before applying for a trademark, the appellant or the applicant's attorney must conduct a **thorough trademark search** to ensure that there are no marks that are identical or similar to the mark for which the registration is sought.
- 2. Fanciful/Arbitrary names:** To avoid a trademark objection, **avoid using common names** for the trademark. **An arbitrary name has no meaning.** For example, the fashion brand **“Uniqlo”** is a new word that was coined by the proprietor (Tadashi Yanai, a Japanese billionaire businessman, the founder and president of Fast Retailing, the parent company of Uniqlo) for his course of business.
- 3. Non-descriptive names:** One should always **avoid using descriptive names** for their trade of business. A word that **describes the nature of the goods or services** is called a **descriptive word.** For example, using the name **“XYZ apparels”** for a clothing brand is descriptive and hence, **would attract section 9 objection** from the Trade Marks Act, 1999.
- 4. Combination of well-known marks:** One should **avoid using words that are in a combination of well-known marks** such as **“Nestlé clothing”** or **“Apple footwear”** as **“Nestlé”** and **“Apple”** are famous and well-known marks. Using such **famous marks/names** **would attract trademark objection** as well as opposition that may cause the removal of the trademark in future.
- 5. Clerical errors:** Lastly, while applying, one **must check the application for any clerical errors.** One must ensure that **all the information provided in the application is true and correct** regarding relevant class in which the goods and services fall for which registration is sought.

Source: Intellectual Property Rights: Contemporary Issues by Dr. Neelam Seam and Dr. Minaxi Tomar