

Entrepreneurship and IP Strategy
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Lecture 39
Capsule Revision

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Speaker 1: A very warm welcome in the fourth module of week eight of the course, Entrepreneurship and IP Strategy, this is the second Capsule Version. And we are very thankful to you being very active on the discussion forum. We have considered a few questions here for this capsule version.

Speaker 2: Yes, I have a few questions actually. So, first question is this that, I have applied for a good to take trademark application, how to deal with a trademark objection, which is raised under Section 9 (1)(B) of the Trade Marks Act 1999, as the mark consists exclusively of words or indications, which may serve in trade to designate the quality intended purpose or other characteristics of the goods or a service.

Speaker 1: So, you have applied for good to take trademark, that good to take. And here what the thing happened is like, that mark is rejected during the examination under the absolute grounds of the rejection of the or refusal of a registration. Now, here if you see the Section 9 of a trade Mark Act actually, it deals with refusal of a registration. Now, here are the various reasons are there that one of the reason is like, whatever in your case happened, that is one of the reason.

The other reasons for rejection are like, devoid of any distinctive character or not capable of distinguishing the goods or services of one person from the other person in that case also it will be rejected. Then the other reason like it may be kind of a, if it consists exclusively of marks or indications, which have become customary in the current language. So, if that kind of a scenario is there that will be rejected.

Then the other few reasons are like, deceive the public or confusion, if it is causing confusion, then if it comprises of any matter likely to hurt the religious susceptibilities of any class, then yes, in that case also it will be rejected or if it contains a scandalous or obscene matter, yes, at that time also, it will.

So, these are the few examples I have given, in what cases the registration is a kind of a it is refused. Now, I can give you the kind of suggestion that either in such case the, the simple way is like consider another trade name and you for a fresh application or the other kind of option here is like a acquire distinctiveness. And I can give you the example, two examples I can give rather, one example of Aaj Tak and second example I can give you of a Sulekha

Speaker 1: So, these are the two kind of trade, well known kind of a, you know about that trademarks and they have acquired that distinctiveness and through that they have kind of a received like a, that secondary meaning is received to that particular common words and they have established there kind of activity based on that particular trade name. If you could able to do this kind of a activity that if you could able to establish that thing, then probably I will say that this will help you. So, only two ways are there, either go for a new application or second option is kind of a, think of acquired distinctiveness. You can try this thing.

Speaker 2: So, the next question I have it is, how can we recognize potential IPs in our business, especially industrial designs with specific reference to packaging? Can you please give examples of packaging registered as IPs?

Speaker 1: So, something you want to know that about how you can recognize the potential IPs. Now, yes, you are aware about IP audit we have given a little bit idea about IP audit. So, if you see that IP audit is a exercise it can be conducted in the organization. And you can just try to dig out, I will say mining kind of activity or it is kind of digging kind of activity and you can find out

the potential, potential IP which is present in that organization and experts they do that kind of activity very easily.

So, I can mention here that IP audit is like the subject I have done PhD on that. And yes, I can give you the confidence that, definitely this IP auditing is helping you to identifying the that potential IP. Probably you will not able to identify that but the expert will definitely visit and within kind of a, few kind of a, when the complete unit is visited immediately after coming out of that unit he will say that, this, this are kind of a possible trademark this, this things kind of repeated and this thing, this kind of activity is, that happens.

So, that is an expert opinion kind of a thing. And if you see the packaging related examples, yes means in the packaging, you can just see the example of for Heena mahendi the kind of a thing and you can just take that Kajal Heena is a yes, that example is there. And if you see that Kajal Heena that packaging is there, in the IP India site, if you go and you can search you will get so many kind of registrations related to packaging, just type that packaging and you will get that kind of industrial designs which are around that packaging industry.

So, yes IP audit and then the kind of the search through IP India, you do for especially you are talking about a packaging industry. So, I am just saying that for a packaging, you can go and you can get the idea on that, what are the different kind of industrial designs which are protected. And IP audit, definitely it helps, there are 130 plus processes are there. And they check the process and performance of particular activity which is followed in the organization and definitely it helps you. And definitely it helps you to develop a good robust IPMS system along with whatever your question is about potential IP.

Speaker 1: So, IP audit is like a for identification of IP and yes, these are the two examples you have given.

Speaker 1: Yes.

Speaker 2: So, now the third question that, take example of a Samsung, when it made a mobile phone with a brand new microphone design, along with its changes in the layout design of interior of a smartphone, which causes handset to be more reliable, then Samsung sold its smartphone, then someone for example, company X bought the smartphone from that Samsung and open it and now X knows how the smart phone layout is and copied the layout and other

interiors of Samsung Mobile phone, then does a Samsung will have anything to prevent company X to copy its interior layout and design.

So, it is like whether there will be a copy or there will be like that someone will copy Samsung's design by taking its phone that way the question is asked by a student actually. This is on the, this is on the forum this question is there.

Speaker 1: So, if you see the, you are like asking a question over protection of this kind of inputs, which are there in the technological inputs or you can say that kind of the, it is like internal kind of a, packaging kind of a thing and a technology which is used internally. So, something like a reverse engineering kind of a thing and whether that is hampering the kind of a, copying kind of a thing or imitation kind of thing is happening or not. So, you are doing this course that is IP protection and IP protection, this kind of system itself is there to avoid such kind of activities.

So, we have a patent for this, we have a semiconductor layout designed for that, although it is not that much kind of used by organizations, but yes, that is one of the Act which is helping in the protection of semiconductor layout design act, the name itself says, that is protecting that particular layout design within that particular unit, whatever it may be, but organizations are using effectively patent for the protection of that particular thing. So, Samsung, which is very aggressive actually, if you see the IP kind of activities of Samsung, that they are like very aggressive and they are very kind of a prone for IP filing.

And yes, they are filing IPs for that particular thing. So, whatever you have mentioned for everything they have like patent, they have protected it with one or the other IP especially here, the design patent will be there and then the, that patent and utility patent, they are in the USA so I have used these words. So, in USA that kind of arrangement will be there, in India, industrial design protection and patent will be there.

And yes, that way they will be completely protected and nobody will copy that particular thing. And therefore, that way imitation is completely, completely avoided and therefore we should thank to IP laws for that actually. So, yes definitely by this way you are taking a caution that nobody will copy the technology So, I guess this is good enough to understand this thing, IP is there to protect you.

Speaker 2: So, imitation is not that easy. So, the next question is like, can you please give some example on patent ticketing through any company or a corporate giant. Yeah, it is related to patent ticketing.

Speaker 1: So, when we are talking about patent kind of a, ticketing kind of a thing or a pattern fencing kind of a thing is there, please remember that if you are talking about patent fencing or a ticketing, it is a good strategy, I will say, it is one of the good strategies which is followed by the organization to protect their core IP and it is surrounded by a many incremental whatever developments are there, all that incremental developments will be protected by other IPs and it is a very common activity.

And when you say, that there is a patent ticketing or a pattern fencing it is a generally a common activity. Every organization do that and actually this terminology, when we are talking about a patent thicketing, it came in the case of a SEM Corporation and a Xerox Corporation. And they said that Xerox constructed a patent thicket to prevent a competition. Now, this is a very common practice, it is a good strategy, there should not be any negative kind of connotation for that I will say.

And definitely, pharma companies, semiconductor companies, biotechnology companies, computer software, they are using this, telecommunication, nano technology, they are using it very effectively. And I can give you the example of a Toyota they have done that thing to protect their hybrid vehicles. And they want that if anybody wants to do that hybrid vehicles, they should take license from Toyota. So, that is very common thing. And I guess there is no issue in that particular thing, it is one of the effective strategy.

Speaker 2: So, patent thicketing is one of the good strategies or the effective strategies. Now, the next question is, I would like to know the process that MSME entrepreneur should undertake to register a brand name on its own manufactured product and the legal strategy to protect it misuse.

Speaker 1: So, something related to MSME and MSME whether I am understanding this question that, that MSME entrepreneur undertake to register that a brand name you are saying and that trademark we will say and like, what is the legal strategy to protect the misuse of that particular trademark.

So, trademark registration simple, as we have seen in week **three**, anybody can go for that trademark registration, once you do that particular thing search, then apply, then examination, then register if there is no objection and all that thing, and then we have seen that particular details actually.

So, that is a normal kind of procedure you have to follow. And if you have done that registration, nobody will use it. So, and if somebody uses that, you have a kind of a, you can go and file a case against that particular thing as it is infringement case you can go into the trademark office, trademark registry I should say and they will take care of that.

So, you need not to worry about it, it is a completely the kind of an infringement case. And then there is affiliate board in Madras and that also will help you in this particular this. So, there will not be a misuse kind of a thing, if it is a registered kind of a trademark. So, you need not to worry about that thing. So, I guess register, and then be safe I will say in that way. There will not be misuse.

Speaker 2: So, MSME, as MSME kind of proprietor he can do this or take this caution. The next question is, how can I know if my idea has been patented or not in India, kindly suggest.

Speaker 1: Patent if you are talking about a patent, we have to just remember that it is, you cannot kind of a limit to India, only in FTO case yes, you can just limit your search to the India, if you are entering into the commercial mode and all that thing. But otherwise I will say, that if you are thinking of a filing of a patent, that is a application of a patent, application filling, if you are in that stage and if at that stage you are just thinking of India, it is like you are going on the wrong direction.

You have to think of a novelty item, world means, whether it is first time in the world that you have to check when you are thinking in that. I am not knowing exactly in which stage you are, if you are a patent filing you have to do the worldwide stage, worldwide search. And if you are in a FTO kind of a, commercialization stage then yes, FTO a very limited search limited to India you have to do, that kind of activity you can do.

Now, how you are going to do that thing, you know that a pattern searching in RFPC we have a, one of the kind of a module dedicated on that, how you can, and we have given you the patent databases also and by using that patent databases, you can do the kind of a search and you will

get the idea whether it is really patented in India or anywhere in the world whatever your context is accordingly you can do the, that search and you can see the search report.

So, that way you will get the idea whether it is really novel or not. And then you have to take a further decision based on that particular thing. Paid and public databases are there, Espacenet that I will say the, that is a very good database you can use it for the searching and that way you can get. And if for India specifically you have to do, you have to go on IP India site and there you have to do the public search, specific to the patent whether it is published or granted you have to choose that particular thing and you will get a data that whether it is patented in India or not.

If you are very specific to the India, IP India is a website there you can do the search and if worldwide you want to do, I will suggest go for Espacenet and that will give, that will help you to get the novelty kind of a status worldwide. So, I guess depending on the context, you can go and do the search on these two websites. I guess.

Speaker 2: So, these are the ways by which anyone can just find out that whether it is patented in India or anywhere. So, the last, last question that, here if it is something related to in this internship, that the candidate want to know about the internship that will be offered at IIT Kharagpur. Because in the, the toppers in NPTEL examination, they get the opportunity to do the internship. So, the question probably that regarding it is, that details about internship they want to know.

Speaker 1: So, internship, yes, if you are like a, if you are, you topper yes, in the NPTEL examination, you get the chance to do the internship here in IIT, Kharagpur. And you are getting a scholarship also for that particular thing and yes, we are like a ready kind of, what we can say we are going to offer internship for this course, those who will do the like, who will be the top yes, we are like offering internship to those candidates.

Speaker 2: There is one, one more question actually, that is related to FTO if you could answer it in a briefly, yes, that will be helpful, that what is FTO, what is FTO?

Speaker 1: So, FTO, Freedom To Operate search like a, when we are talking about a commercialization of a product before entering into the market, it is a mandatory to do FTO.

Mandatory in the sense, it is a good for you that to check that if there is like a, if there is any kind of a IP related to that particular technology owned by someone else.

Because we know that there is a kind of a 18 months timeline of a publication, we are pretty well aware about that. And therefore, whenever attorney is giving you the search report, he is saying that 99 percent my search is kind of I am giving you the kind of a 99 percent that disclaimer, disclaimer he gives.

Why this disclaimer is there, that he will not give you the 100 percent guarantee, he will give you that 99 percent because that 18 months patents are there and eventually, they will published, and that will be that information will be available. So, FTO is mandatory before going into the market, prior art searches mandatory before you go into the patent filing that application, prior art search is kind of a you have to do it.

So, that, there will be 100 means, you can say that 99 percent chance is there for the grant of patent. And FTO, there should not be any infringement, so FTO should be done before entering into the commercialization. So, considering the paucity of time we have to stop here, we try to answer the questions. If you have more questions, you can just keep it in the live session and we can. Thank you.

Speaker 2: Thank you.