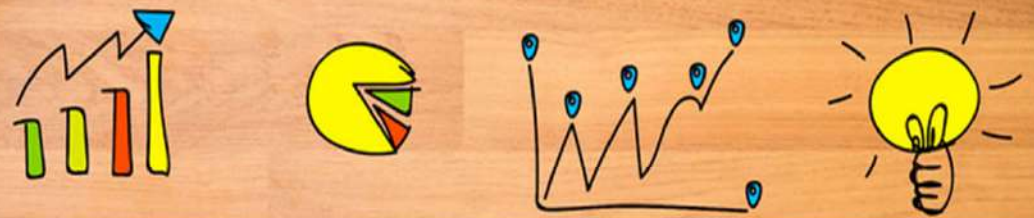




# INTELLECTUAL PROPERTY



PRESENTED BY  
**CA. RISHU GUPTA**  
**CS. NEHA GUPTA (LLB)**

If you don't see a problem with this question,  
you need this class!

**"All I asked was, 'Can I patent  
my copyrighted trademark?!'"**





## WHAT IS INTELLECTUAL PROPERTY RIGHTS ???

- ❑ Intellectual Property - A Product of HUMAN CREATION.
- ❑ Right – The standard of permitted action by Law.
- ❑ Intellectual property rights are *legal rights* governing the use of *creations of human minds*.
- ❑ They usually give the creator an *exclusive right* over the use of his/her creation for a *certain period of time*.
- ❑ It is an **Intangible Asset** which can be sold, gifted, assigned and licensed like any other property.

## *Intellectual Property Right Quotes*

“Representations that *do not* make *sense* are the best Trade Marks” — Kalyan C. Kankanala

If a man is keeping an idea to *himself*, and that idea is taken by stealth or trickery-I say it is stealing. But once a man has *revealed* his idea to others, it is no longer his alone. *It belongs to the world.*” — Linda Sue Park

“To achieve *patent* commercialization *success*, every inventor must think like a *business man*” — Kalyan C. Kankanala

“*Knowledge* is very vital in life`s *transformation* and *transition*”  
— Jaachynma N.E. Agu

# MAJORS LAWS GOVERNING IPR

## PATENTS

Patents Act, 1970  
Patents Rules, 2017  
(Amended).

## COPYRIGHTS

- Copyright Act, 1957  
- Copyright (Amendment)  
Act, 2012  
- Copyright Rules, 2016

## VARIANTS OF INTELLECTUAL PROPERTY RIGHTS

## TRADEMARKS

- Trade and Merchandise  
Mark Act, 1958 Amended as  
Trade Mark Act, 1999  
- Trademark Rules, 2017

## GEOGRAPHICAL INDICATIONS

The Geographical Indications of  
Goods (Registration & Protection)  
Act, 1999

## DESIGNS

Designs Act, 2000 &  
Designs Rules, 2001

## One product – many IP rights

### Trademarks

- NOKIA
- Product “225”
- Start-up tone

### Copyright

- Software
- User manuals
- Ringtones
- Start-up tone
- Images



### Patents and utility models

- Data processing methods
- Operating system
- Operation of user interface

### Designs

- Form of overall phone
- Arrangements and shape of buttons
- Position and shape of screen

### Trade secrets

- Part of technical know-how kept “in-house” and not published

# TRADE MARK

It means a mark capable of being *represented graphically* and which is capable of *distinguishing* the *goods* and *services* of one person from those of *others* and may include shape of goods, their packaging and combination of colors. {u/s 2(zb) of Act}

- It is *anything* which identifies a *brand* to a common *consumer*.

Example →



\* “*Mark*” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof. {u/s 2(m) of Act}

# WHAT CAN BE TRADEMARKED ?????

## WORD

A word mark is a **distinct text** of the name of the company/product name for the purpose of **branding**. Thus it is specifically text based unlike a **logo** that represents a pictorial image.



## NUMBERS

The number must be used as a **brand** for the product/service. For e.g. the number 5 must be used specifically for a line/class of products/services and must be identified by it in order to obtain the TM.



## DEVICE

A **device** is a printed/painted figure/design/character. They do not consist of any letters/words/numerals etc.



## PACKAGING

All the contents featured on top of the packaging, i.e. the **names**, **slogans** etc. can be trademarked. This can stop a competitor from using a deceptively similar packaging for their product.





## PRODUCT

A **product** mark is similar to trademark only, but it is to identify the products or goods instead of services. To safeguard the product category and avoid any duplicity of the same a product mark is registered.

## SERVICE

A service mark is used to identify and distinguish the **services** rather than the products provided by any enterprise. The service mark is for the **intangible products**.



## SHAPE

The shape marks can be categorized in **Trade Dress** wherein, other than the logo, label, and other identifiable symbols; a product can also be distinguished based on its packaging.

## PATTERN

The general meaning of pattern is a **repetition of similar design**, so it is a type of trademark wherein the pattern is able to distinguish the product and services of one brand from another.



## COLLECTIVE

As the name suggests these marks are linked with a *group of people* and not one single product or service. These trademarks are primarily owned by an *organization, institutes or any association* that is related to several members.



## CERTIFICATION

The certification mark is created to show the *standard of a company* i.e. it is to show that a trader's *goods or services* are certified as meeting particular standards.

## SOUND

The another form of trademark where the "mark" is of sound graphics that distinguishes the products and services of one from the other. Only those notations of sound that are *graphically represented* can be registered as trademarks.



## COLOUR

The *colour combinations* become the *brand* itself and become known by it for that particular product. The public tends to associate the scheme with the specific product.

# What is Building Trademark?

- In the recent time, Any person, company and Firm can get *Trademark for buildings* in India according to the provisions of **Trademark Act, 1999** and it common phenomenon around the world to securing Trademark for buildings.



- **On May 19, 2017**, **The Indian Hotels Company (IHCL)** created history by securing a Trademark registration for the *exterior design* of the **Taj Mahal Palace Hotel**. It is a iconic landmark of **Mumbai** is the first of its kind in India to get registered trademark.

# *Duration of Intellectual Property Rights*

## TRADEMARK AND GEOGRAPHICAL INDICATIONS

- Valid for 10 years
- Renewable after every 10 years for *indefinitely* period.

## COPYRIGHT

- Valid for 60 years
- In the case original Literary, music and artistic work, 60 years counted from the death of creator. Also, it is granted registration during life time of the creator.

## PATENTS

- Valid for 20 years
- it cannot be **renewed**. Nor **can** one pick up the rights to an expired **patent**. Once a **patent** expires, the invention goes in the public domain.
- Patent can be renewed for maximum of 20 years duration.

## DESIGN

- Valid for 10 years
- Renewable for further period of 5 years.

# Trademarks & Trade Names

**TRADEMARK**

**Vs.**

**TRADENAME/  
DOMANIN  
NAME**

It identifies the  
*goods or services* of  
that company

It identifies a  
*company* or  
a *business*



*Trademark*  
**cromā**



*Trademark Owner*  
Infiniti Retail Limited

## A trademark can be designated by the following symbols:



It is used to indicate that the **TRADEMARK IS APPLIED FOR REGISTRATION** but still not registered and is under process although this mark is used to *promote goods or brand services*.



It is used to represent a **REGISTERED TRADEMARK/ SERVICE MARK** that provides the applicant *complete ownership and legal rights* over the trademark/ service mark.



## What Are Non-Registrable Trademarks?

- # Marks resembling *existing* and *established* trademarks.
- # **Confusing/Deceptive** marks.
- # Unlawful marks/ **prohibited** marks.
- # Scandalous/obscene/**religiously inflammatory** marks.
- # *Laudatory words* that describe the quality of goods (such as best, perfect, super, Royal etc)
- # A list of prohibited trademarks issued by the Trademark Registry can be accessed at <http://ipindiaonline.gov.in/tmrpublicsearch/prohibitedmarks.aspx>



It means a mark which has become so to the *substantial segment* of the public which *uses such goods or receives such services* that the use of such mark in relation to *other goods or services* would be likely to be taken as indicating a connection in the course of trade or rendering of services between *those goods or services* and *a person using the mark in relation to the first mentioned goods or services*.  
{Section 2(zg) read with Rule 124 of the Trademark Rules, 2017}

Example:

**Horlicks**



**Whirlpool**  
CORPORATION

A list of Trade Marks which have been recognized as *Well Known Trade marks* in India by the Indian Intellectual Property Office can be accessed at <http://ipindiaonline.gov.in/tmrpublicsearch/wellknownmarks.aspx>



# ADVANTAGES OF TRADEMARK

*“prior applicant to Trademark registry,  
is the owner in most of the cases”*



- It gives **exclusive rights** to the Owner.
- It indicates the **source or origin** of goods or services.
- It **assures consumers** of the quality of goods associated with the mark.
- It creates **business goodwill** and **brand awareness**.
- It **advertises** the product as well as **distinguishes** it from other products.
- It creates an **intangible assets** which is advantageous to the organization.

# TRADEMARK CLASSIFICATION

## GOODS AND SERVICES

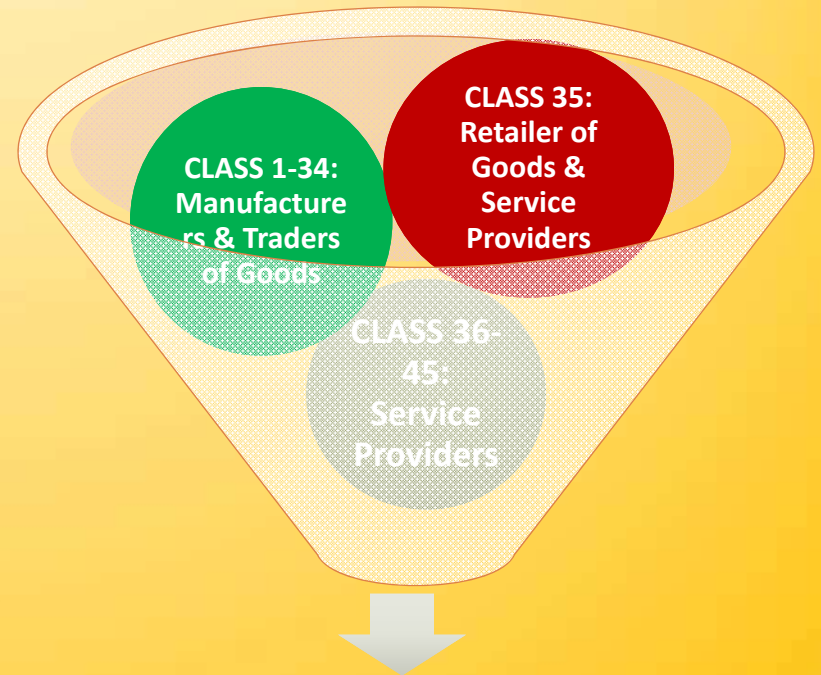


⚡ **Before** filing a trademark application, it is necessary to **identify** the classes in which you wish to *seek protection* for your trademark.

⚡ An application should be made in the **relevant classes** of current goods/services as well as in classes where there is **intent to use**.

⚡ The primary objective is to **group together similar** nature of goods and services.

A brief of the International Classification of goods and services (Nice Classification) adopted in India.



All goods and services are divided into **45** classes

# Priority in adoption prevails over priority in registration

- ⌘ Although **registration of trademark** is prima facie an evidence of **validity of a trademark**, yet the registration cannot upstage a **prior consistent user** of trademark.
- ⌘ Registration of a trademark is not a **pre-requisite** in order to sustain a **civil or criminal** action against violation of trademarks in India.
- ⌘ In India, a **civil action** for **infringement** of trademark (in case of **registered** trademark) and **passing off** (in case of **unregistered** trademark) can be initiated.

## The primary and exclusive Trademark rights

### Are obtained –

By Usage  
(a)



By Registration  
(b)



# Is An Indian Trademark Valid Abroad?



*No, Indian Trademark is not valid abroad.*

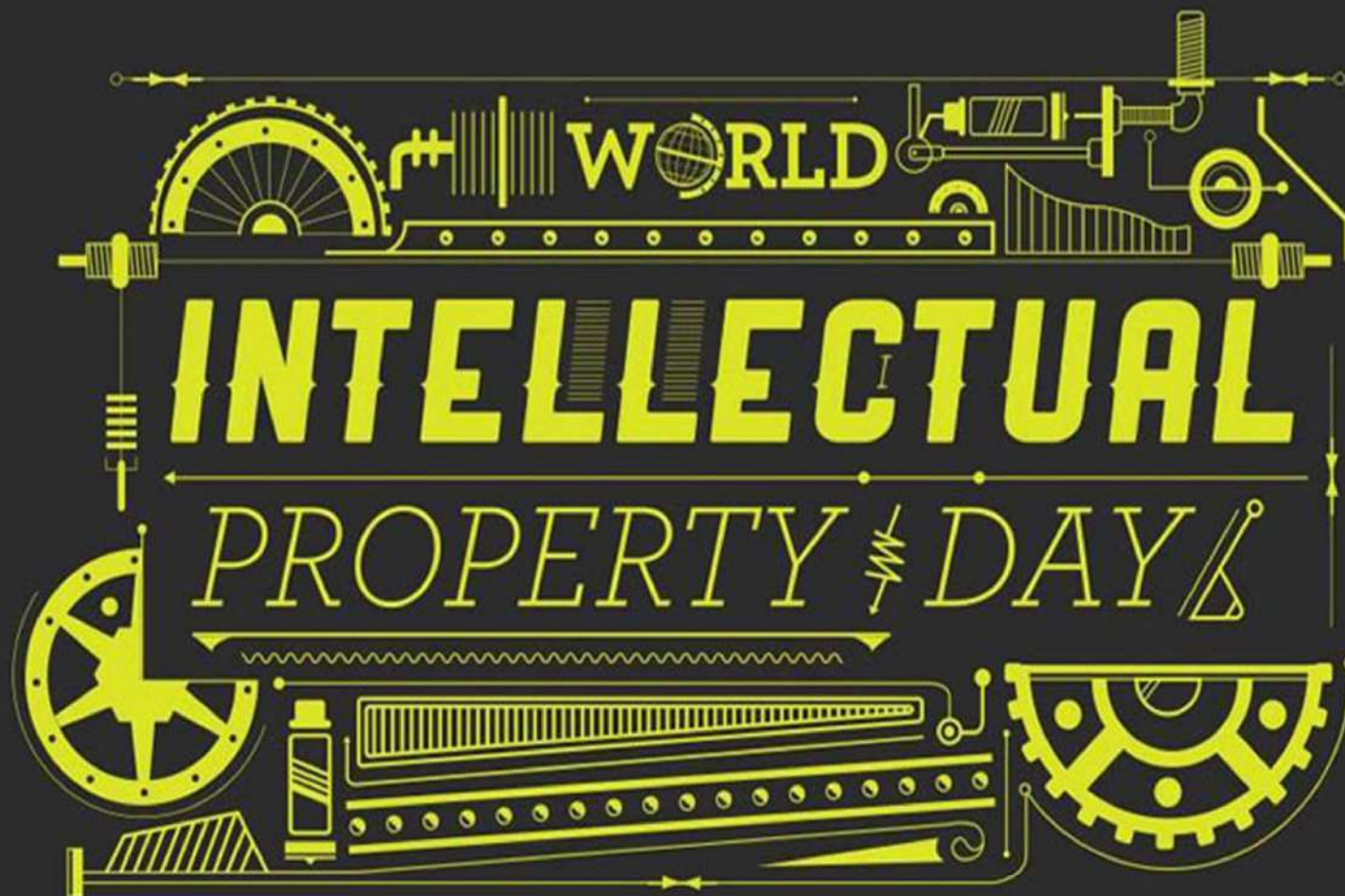
Certain countries, however, do recognize a **Indian registration** as a **basis for registering** the mark in those countries.

Keep in mind that the **Internet** is changing international trademark boundaries. By adding your trademarks, you are being **proactive** in minimizing the **potential cost** of international litigation.

# Does Registration Cover Other Countries?

- ❖ A INDIAN trade mark registration *only covers INDIA*. It does not, therefore, afford protection in any of other country,
- ❖ *Separate application* must be filed in each of these countries if registered protection is required.
- ❖ Applications for registration in *foreign countries* can be based on a INDIAN trade mark application.
- ❖ Convention priority may be claimed, if foreign applications are filed within *six months* after filing of the INDIAN application.

The duration of trademark registration is 10 years from the date of application which can later be renewed for a further period of 10 years. The application for renewal can be made prior to the date on which renewal falls due.



**WORLD INTELLECTUAL  
PROPERTY ORGANIZATION**

**26 APRIL**

# WORLD INTELLECTUAL PROPERTY ORGANISATION

WIPO is the *global forum* for *intellectual property* services, policy, information and cooperation. WIPO is a self-funding agency of the *United Nations*, with *191 member* states.

WIPO's mission is to lead the *development* of a balanced and effective *international intellectual property (IP) system* that enables *innovation* and *creativity* for the benefit of all. WIPO's mandate, governing bodies and procedures are set out in the *WIPO Convention*, which established WIPO in *1967*.

WIPO's Headquarters is situated in Geneva, *Switzerland*.

WIPO has currently *191 Members* states out of Total *195 Countries* in the *world*.

**WIPO's *Non-members*** are the states of Kosovo, Federated States of Micronesia, Nauru, Palau, Solomon Islands, South Sudan, and the states with limited recognition. Palestine has observer status.

The International statutory **Basic fee** for Registration of Intellectual Properties **internationally** according to **WIPO agreement and protocol** is -

WIPO's BASIC STATUTORY FEE STRUCTURE	SWISS FRANS
Where no reproduction of the mark is in color	CHF 653.00
Where any reproduction of the mark is in color	CHF 903.00

WIPO's TOTAL STATUTORY FEE STRUCTURE (191 MEMBER STATES)	SWISS FRANS
Where no reproduction of the mark is in color	CHF 23,349.00
Where any reproduction of the mark is in color	CHF 23,599.00

**Note** : One CHF = INR 68.69 approx (Value Date = 19.03.2019)



<b>WIPO's TOTAL STATUTORY FEE STRUCTURE (PER MEMBER STATES)</b>	<b>SWISS FRANS</b>
United States of America	CHF 388.00
Australia	CHF 263.00
Switzerland	CHF 450.00
China	CHF 249.00
Germany	CHF 100.00
European Union	CHF 897.00
United Kingdom	CHF 227.00
Egypt	CHF 100.00

# GLIMPSE OF DIPP

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Office of the Controller General of Patents, Designs & Trade Marks  
Department of Industrial Policy & Promotion,  
Ministry of Commerce & Industry,  
Government of India



Patents ▾

Designs ▾

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- > Comprehensive E-Filing
- > Public Search
- > Dynamic Utilities

E-Gateways



- > Journals
- > Annual Reports
- > Vacancy Announcement

Publication



- > Acts & Rules
- > Manuals / Guidelines
- > Controller's Decision [↗](#)

Resources



- > Copyright Office
- > SICLDR
- > Patent Information System

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# TRADEMARK SEARCH



Government of India  
Ministry of Commerce & Industry  
Department of Industrial Policy & Promotion  
Controller General of Patents Design & Trade Marks  

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Public Search of Trade Marks



[Class Details](#) | [Well Known Marks](#) | [Prohibited Marks](#) | [Vienna Code Classification](#) | [International Non-Proprietary Names\(INN\)](#) | [Help](#)

Search Type :

Key Word	Value	
Wordmark	<input type="text" value="Start With"/> <input type="text"/>	
Class	<input type="text"/>	<i>*Enter one class at a time</i>
Goods Description	<input type="text"/>	<i>*Will be available soon</i>

Search

Best View in Resolution of 1024x768 or later. Enable Javascript for Better Performance.

# Trademark Jurisdictions



**Controller General of Patents,  
Designs & Trade Marks**

Office of the Registrar of Trade Marks

Trademarks



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## Locations and Jurisdiction

Home > Trade Marks > About Us > Locations and Jurisdiction

### Territorial Jurisdictions of TMR Offices

- > **MUMBAI** : The State of Maharashtra, Madhya Pradesh, Chhattisgarh and Goa
- > **AHMEDABAD** : The State of Gujarat and Rajasthan and Union Territories of Daman, Diu, Dadra and Nagar Haveli.
- > **KOLKATA** : The State of Arunachal Pradesh, Assam, Bihar, Orissa, West Bengal, Manipur, Mizoram, Meghalaya, Sikkim, Tripura, Jharkhand and Union Territories of Nagaland, Andaman & Nikobar Islands.
- > **NEW DELHI** : The state of Jammu & Kashmir, Punjab, Haryana, Uttar Pradesh, Himachal Pradesh, Uttarakhand, Delhi and Union Territories of Chandigarh
- > **CHENNAI** : The state of Andhra Pradesh, Telangana, Kerala, Tamilnadu, Karnataka and Union Territories of Pondicherry and Lakshadweep Island

#### About Us

Workflow Chart

Quality Policy of Office

Introduction about Trade  
Marks Registry

Administrative Steps Involved

Locations and Jurisdiction

# Copyright Office Website



## Copyright Office

[Home](#) | [Copyright Societies](#) | [Organisational Structure](#) | [IPR Chair](#) | [Contact Us](#) | [Notice](#) | [E-Register](#) | [New Applications](#) | [Hearing Orders](#)



### Online Services

- ▶ e-Filing of Application
- ▶ Status of the Application
- ▶ Received Application
- ▶ Work Awaited Application
- ▶ Application for Hearing
- ▶ Details of Processing Fee
- ▶ Check List
- ▶ Workflow
- ▶ FAQ

### Act, Rules & Notifications

- ▶ Copyright, Act 1957
- ▶ Copyright Rules 2013
- ▶ Notifications
- ▶ Toolkit

- ▶ Who's Who
- ▶ Right To Information Act
- ▶ News & Events
- ▶ Announcements

### Introduction

The Copyright Act, 1957 came into effect from January 1958. This Act has been amended six times till date since then, i.e., in 1983, 1984, 1991, 1994, 1999 and 2012. The Copyright (Amendment) Act, 2012 is the most substantial. The main reasons for amendments to the Copyright Act, 1957 include to bring the Act in conformity with WCT and WPPT; to protect the Music and Film Industry and address its concerns; to address the concerns of the physically disabled and to protect the interests of the author of any work; incidental changes; to remove operational facilities; and enforcement of rights. Some of the important amendments to the Copyright Act in 2012 are extension of copyright protection in the digital environment such as penalties for circumvention of technological protection measures and rights management information, and liability of internet service provider and introduction of statutory licences for cover versions and broadcasting organizations; ensuring right to receive royalties for authors, and music composers, exclusive economic and moral rights to performers, equal membership rights in copyright societies for authors and other right owners and exception of copyrights for physically disabled to access any works.

[More]

### Copyright Office

Section 9 of the Copyright Act requires for establishment of an office to be called the Copyright Office for the purpose of the Act. The Copyright Office is to be under the immediate control of a Registrar of Copyrights to be appointed by the Central Government, who would act under the superintendence and directions of the Central Government. The Copyright Office is currently located at the following address:

Boudhik Sampada Bhawan,  
Plot No. 32, Sector 14, Dwarka,  
New Delhi-110075  
Telephone No.: 011-25301202

[More]

▶ [05-03-2018: PUBLIC NOTICE REGARDING STATUTORY INTERIM LICENSE U/S 31D \(1\) OF THE](#)

### Downloads

- ▶ Forms
- ▶ Documents
- ▶ Archives

### Useful Links

- Department of Industrial Policy & Promotion
- World Intellectual Property Organization
- Intellectual Property India
- IPAB

# THE TRADEMARKS ACT, 1999 & THE TRADEMARKS RULES, 2017 (BRIEF SUMMARY)

☐ Total Number of *Sections = 159*

☐ Total Number of *Rules = 158*

☐ Total Number of *Forms = Eight Forms*

a) Form TM-A

b) Form TM-M

c) Form TM-R

d) Form TM-C

e) Form TM-O

f) Form TM-P

g) Form TM-U

h) Form TM-G



# Forms & Fee Structure

Forms	Purpose (E-Filing)	Statutory Fee Structure
Form TM-A	Application For Registration.	Rs. 4,500.00 / Rs. 9,000.00 **
Form TM-M	Application For the Amendments in Application.	Rs. 900.00
Form TM-R	Application For Renewal of Trademark.	Rs. 9,000.00
Form TM-C	Request for Search and Issue of Certificate.	Rs. 9,000.00
Form TM-O	Application for Oppositions and Counter Statements.	Rs. 2,700.00
Form TM-P	Application for Registration Subsequent Proprietor in case of Assignment.	Rs. 9,000.00
Form TM-U	Application for Registered User of a Registered Trademark in respect of goods or services.	Rs. 4,500.00
Form TM-G	Application for Registration of a person as a Trademark Agent under rule 147 & 149.	Rs. 4,500.00

**Note: In case of Physical filing fee is 10% More than E-Filing Fees.**

**\*\* Note :** INR 4,500.00 in case of Individual, Start-ups and MSME applicants *per class per* Trademark application. INR 9,000.00 in case of any other applicant *per class per* Trademark application.

# Copyright Statutory Fee

Works	Purpose	For Non-Commercial Use	For Commercial Use
Literary Work	Application for Registration	INR 500.00	<b>INR 2,000.00</b>
Dramatic Work	Application for Registration	INR 500.00	INR 500.00
Musical Work	Application for Registration	INR 500.00	INR 500.00
Artistic Work	Application for Registration	INR 500.00	<b>INR 2,000.00</b>
Cinematography Work	Application for Registration	INR 5,000.00	INR 5,000.00
Sound Recording Work	Application for Registration	INR 2,000.00	INR 2,000.00
Literary or Artistic Work	Application for change in particulars of Copyright	INR 200.00	<b>INR 1,000.00</b>
Dramatic or Musical Work	Application for change in particulars of Copyright	INR 200.00	INR 200.00
Cinematograph Film Work	Application for change in particulars of Copyright	INR 2,000.00	INR 2,000.00
Sound Recording Work	Application for change in particulars of Copyright	INR 1,000.00	INR 1,000.00
Extract or Certified copy from Indexes or Register of Copyright	Written request for taking extracts or copies from Indexes or Register of Copyright	INR 500.00	INR 500.00



# ® TRADEMARK INFRINGEMENT

- ✚ *Infringement* refers to violation of a law or right.
- ✚ Infringement of trademark {u/s 29 of the Trademarks Act, 1999} means **violation** of the **exclusive rights** granted to the **registered proprietor** of the trademark to use the same.

✚ Use of Registered Trademark or a mark identical, or deceptively similar to it is said to be **infringed** when it is used by a person who is neither the **registered proprietor** nor the **license holder** of the said trademark in relation to the **goods or services** for which the said trademark is **registered** and such use could lead to confusion between the **original trademark** and a **mark that is used later**.



In order for the use of a mark to be counted as *Trademark Infringement*, a few things must be true:

- The mark must be *valid* and eligible for *legal protection*.
- The person who claims that infringement has happened must *own* the mark.
- The unauthorized use of the mark must be connected with the *sale or advertising of services or goods* i.e. it must be used in *commerce*.

## PUMA OUTSTRIPPED LINGBAO in a Trademark Infringement Case

→ Macau's Court of Final Appeal has ruled in favor of German sportswear and shoe manufacturer **PUMA** in a case of trademark infringement.

→ Its decision ends a *five-year* tussle between Puma and Chinese shoe manufacturer LINGBAO, which was using a **brand logo** that Puma claimed was *too similar*

❑ PUMA logo: a leopard jumping to the left.

❑ LINGBAO'S logo also features a leopard, leaping to the right.

→ According to the verdict, although both logos constituted what the law designates as “**mixed logos**” (combining an **image** with a **name**), the name in the LINGBAO logo is *not big enough* to clearly be different.

→ Accordingly, the court ruled there is a risk customers will be **confused** when facing a choice of the two **similar brands** on *similar goods*.



# Remedies Against Infringement



## CIVIL REMEDIES

### INJUNCTION

- Perpetual
- Temporary

### Damages or Account of Profits

- It can be together with or without an **order for delivery**, or **destruction** or **erasure** of the **infringing** products

## **SCOPE FOR PROFESSIONALS**

~ The protection of intellectual property has become so important that companies today carry out **intellectual property audits** to identify their **intellectual wealth** and form **special departments** to manage them.

~ The legal professional who specializes with matters related to intellectual properties are the **Intellectual Property Attorneys** and they can be anyone from a lawyer to professionals such as Chartered Accountants, Company Secretaries, Management, Science and Commerce students.

~ An intellectual property Attorney can specialize in any or all of the fields associated with the Intellectual Property Rights. In addition, one can also work in the field of **industrial design**, layout design of integrated circuit, **geographical indication**, trade secrets and **protection of plant varieties**, information and communication technology law (cyber laws).

## *Rule 144 of the Trademark Rules, 2017*

**Qualifications for registration of Trademark Agents — Subject to the provisions of **Rule 145**, a person shall be qualified to be registered as a trademarks agent if he —**

*(i) is a citizen of India;*

*(ii) is not less than **21 years** of age;*

*(iii)(a) is a **graduate of any university** in India or possesses an equivalent qualification and has passed the **examination** prescribed in rule 148 or*

*(iii)(b) is **an Advocate** within the meaning of the Advocates Act, 1961 (25 of 1961) or*

*(iii)(c) is **a member of the Institute of Company Secretaries of India;***

*(iv) is considered by the Registrar as a fit and proper person to be registered as a trademark agent.*

## ***RULE 145 OF THE TRADEMARK RULE (2017)***

**A person shall not be eligible for registration as a Trademark Agent if he-**

- Has been ***adjudged*** by a ***Competent Court*** to be of ***unsound mind***.
- Is an ***un-discharged insolvent***.
- Being a ***discharged insolvent*** has ***not obtained*** from ***the court or the appropriate forum as the case may***, a certificate to the effect that ***his insolvency was caused by misfortune without any misconduct on his part***.
- Has been ***Convicted*** by ***a competent court or the appropriate forum*** as the case may, ***whether within or outside India of an offence punishable with transportation or imprisonment***, ***unless*** the offence of which he has been convicted has been ***pardoned*** or unless on an application made by him, the Central Government by order in this behalf, has ***removed the disability***;
- ***Being a legal practitioner***, has been held guilty of professional misconduct by any High Court in India;
- ***Being a chartered accountant***, has been held guilty of negligence or misconduct by a High Court; or
- ***Being a registered trademarks agent***, has been held guilty of professional misconduct by the Registrar.

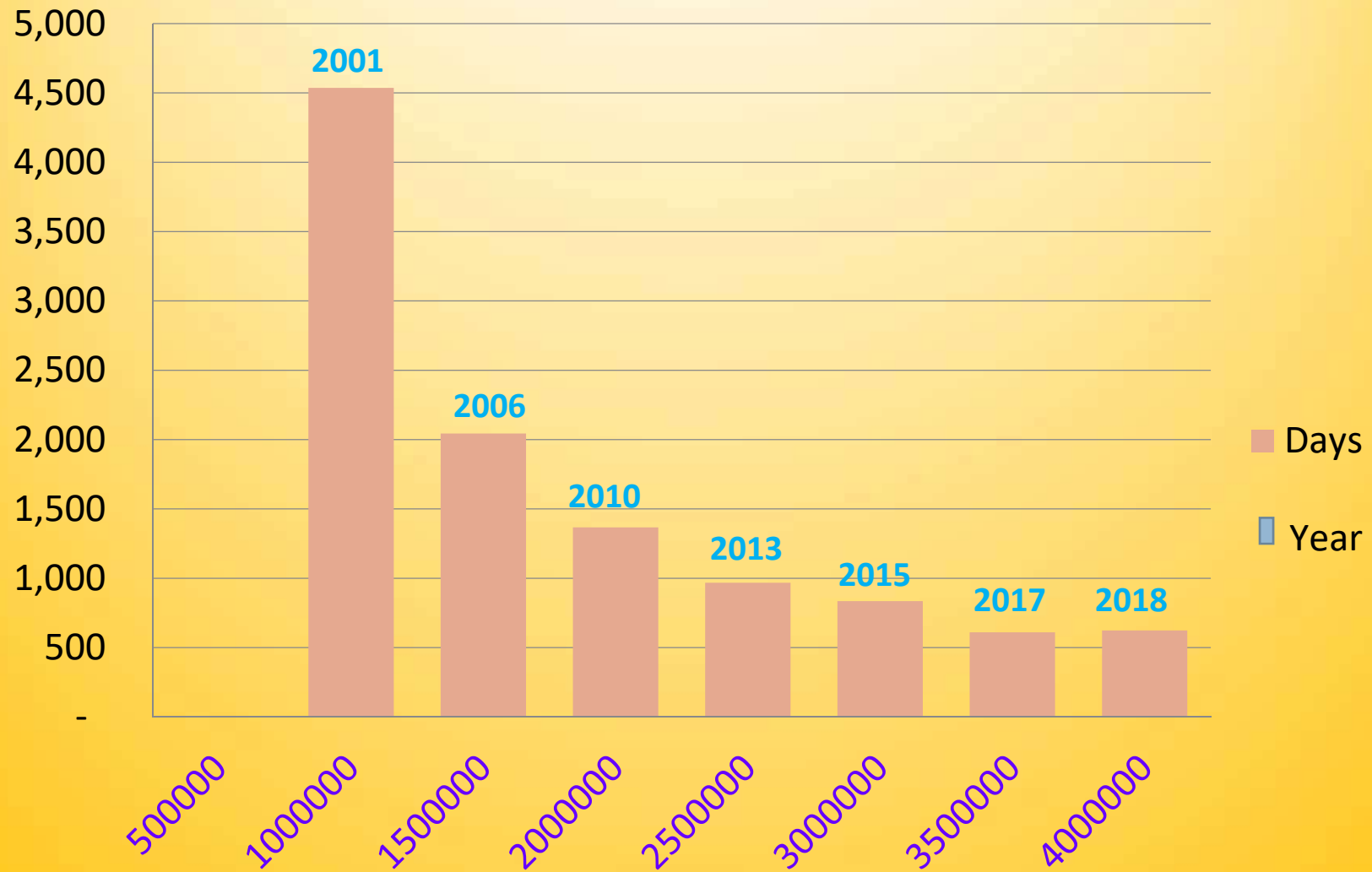
# **PRECAUTIONARY MOVES**

1. **TRADEMARK WATCH**
2. **INTERNET SEARCH**
3. **CONSULT YOUR TRADEMARK COUNSEL**



# Trademark Application Filing Data Analysis

## Application Number



Date Range : 27.10.1988 – 16.11.2018

Have Any

Questions

???

Please Ask

Us

EVERY  
ENDING  
IS  
REALLY JUST A  
NEW BEGINNING

thank  
YOU

~ Presented By

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