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ISO 9001:2008 & ISO 27001:2013 Certified

The case of identical trademarks

BACKGROUND

A world renowned design studio having its headquarters in New York, United States of America and a small partnership based startup running an online information portal and city guide were using an identical Trademark. This startup had to respond to the lawyer's legal notice instructing the startup to stop using the conflicting Trademark.

CHALLENGES

- The major concern was that the opposite party was a well-established company and claimed the mark as a well-known Trademark which is strictly identified with them for diverse scope of businesses including the hospitality and retail sectors developed in collaboration with the government of USA.
- The client being a new business neither had similar goodwill in the market, nor the financial backup to fight the case out in court of law in different Jurisdictions.

STRATEGY

- The first step was to ensure that the client was in no way interested in competing with the conglomerate in any field. This ensured that both the parties were willing to come to the negotiating table.
- Advantage was taken of the fact that the client's mark was not registered in the same class as that of the conglomerate. Even though a well-known mark cannot be registered in any class whatsoever, the lawyers of the conglomerate were coerced to understand that the client had been running their honest business long enough to be identified in related trade circles.

IMPACT

- The strategy of shifting the focus away from the conflict of interest worked in favour of the client.
- The solution was that both the parties agreed to co-exist in a scenario where they do not conflict with each other's area of business.