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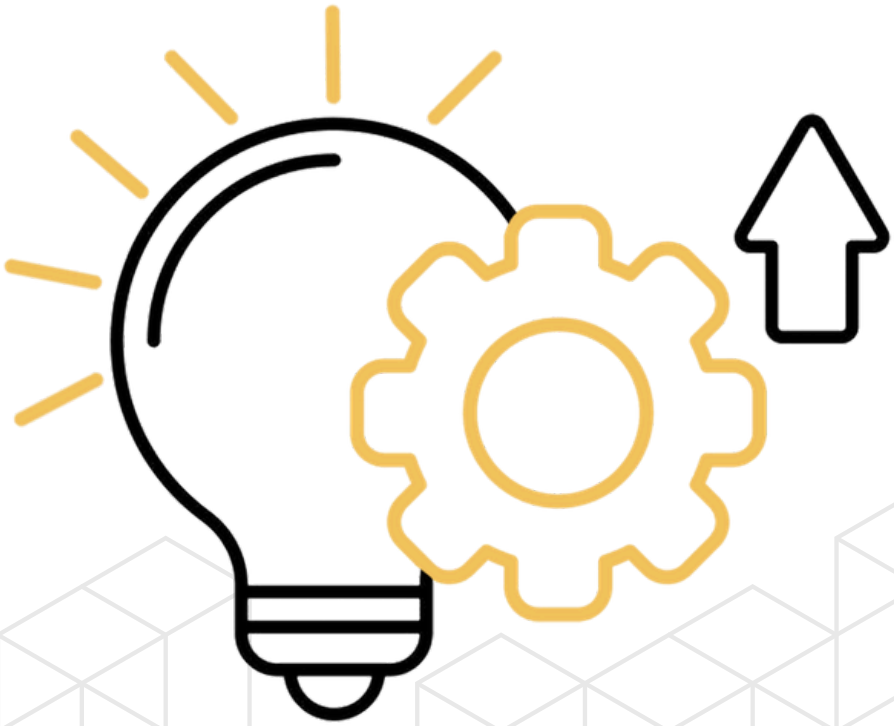


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BUILDING AND SUBSTANTIATING TRADEMARK GOODWILL AND SECONDARY MEANING IN THE DIGITAL AGE.

- Khushboo Tomar Mangal

Brands can emerge as reputable entities with the advent of today's digital marketplace, with business names trending across social media, and thus finding themselves with large follower numbers and robust sales, in a very short time frame. However, the fact of being popular does not automatically create enforceable legal rights to use and enforce the use of a trademark. The most significant factor will be the existence of goodwill associated with that trademark; and in many cases, whether there has been sufficient evidence to demonstrate that any particular trademark has developed a secondary meaning.

Goodwill with respect to a trademark represents the reputation and commercial value ascribed to a trademark through usage over time; therefore, it embodies the trust and recognition that consumers attach to a trademark for continuous use based on the consistency of a product/service's quality, customer experience, and association. Consumers looking at well-established trademarks like Apple do not just see a name -- they see the brand as having direct relation to its source, standard and reputation. Therefore, there is a foundation of goodwill associated with the mark. Goodwill is not created solely by registering a trademark; it is based upon the continued usage and marketing of the trademark, including consistent branding, customer satisfaction, and continuous promotional efforts. Goodwill is also the basis for providing protection to a trademark in any passing off action or enforcement action relating to trademark usage.

When a mark is either descriptive or not inherently distinctive it may have a secondary meaning. A descriptive term will not constitute a trademark unless it starts to become associated with a particular business as opposed to just the product category as a whole. This association of consumer perception is referred to as secondary meaning. An example of this occurred in the case of Booking.com where the issue was whether the term "Booking" in conjunction with ".com" could act as a source identifier which is distinct. The issue was whether consumers saw "Booking" as identifying a specific entity or if the term simply was a description of what was being produced. Secondary meaning only exists when such a change in perception occurs.

Creating and developing strong trademarks goodwill requires consistency. Trademark needs to be used in the same way on your website, across all social media platforms, packaging, advertising and all forms of communication. Frequently changing a company's logo or style/branding presentation can reduce the trademark's overall distinctiveness or legal ability. It is equally important that adequate documentation is kept providing necessary support. Proof of advertising expenditures, digital advertising campaigns, influencer sponsorships, or promotions can demonstrate that the business took steps to

create brand awareness. Testimonials, newspaper articles, awards, and online reviews can also provide additional support for the claim of goodwill. Digital analytics such as an increase in followers, engagement, geographic spread of followers and repeat customers can also help further support the evidence of developing distinctiveness.

Courts who evaluate for secondary meanings focus on things like how long and continuously the brand has been used, advertising, sales volume, how much attention the company has received in media, consumer awareness, intentional copying of the company's brand by competitors, etc. but when used digitally, courts would look at things like website screenshots, archived website pages, analytic reports, and large amounts of sales or purchases generated in the marketplace; companies must view and compile all this evidence (or material) as an organized "brand evidence file." Unfortunately, there are a number of businesses (either large or small) who spend enormous amounts of money marketing their products but do not have organized records to support their branded product's growth and visibility in their market. If a company does not have documented proof of their brand's existence, even if they have created a very successful brand, they may find it exceedingly difficult to prove they have any legal rights to that brand.

When dealing with descriptive trademarks, consumer surveys may be particularly helpful. In all cases, a properly conducted survey will ask consumers which name they associate with the appropriate type of business; if a majority of respondents provided a direct answer identifying one company, the evidence of secondary meaning may be more easily substantiated. Although conducting a survey may be expensive, it can hold a great deal of weight in the results of litigation involving high-value brands.

Businesses today make many mistakes that undermine their brand's strength. Examples may include believing that having many social media followers proves they have goodwill; using marks descriptively rather than as brand identifiers; not acting against infringers; failing to protect their domain names; allowing third parties to misuse their marks without challenging those actions; and failing to enforce their trademarks through a true sense of exclusivity. Enforcement, therefore, is not simply reactive; it creates and maintains exclusivity and gives trademark owners a stronger legal position.

In essence, goodwill reflects the reputation that consumers have for a particular product or service, and it is also an indication of a company's value based on the confidence level that consumers have in their purchasing decisions. The pace at which brands grow today creates an increased responsibility on the part of companies to document their brand's efforts using digital evidence (i.e., social media) and other means; therefore, those companies that successfully implement strategic planning and establish a chain-of-evidence system will have a greater likelihood of establishing their trademark rights in a dispute.

In the current business environment, a trademark represents much more than just a name or logo, it identifies the business with the customer. When asserting rights

associated with a trademark or trade name, the business must demonstrate that a distinctive connection exists in the mind of the customer between the product or service and the trademark or trade name when claiming that the trademark or trade name has been infringed upon or that the trademark or trade name has been used in a way that violates the owner's exclusive rights. This requires presenting credible and well-documented evidence to the courts in order to establish that an identity exists in law. Popularity on the Internet is not a reliable source for proving that an identity exists.

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EXAMINATION TRENDS AND PROSECUTION PROCEDURES.

- Suchi Rai

In India, a patent application is examined only after the filing of a Request for Examination (RFE) or a request for expedited examination. For applications filed on or after 15 March 2024, the RFE must be filed within 31 months from the earliest priority date, whereas applications filed prior to this date are subject to a 48-month deadline which is under the previous regime.

Upon examination, the Indian Patent Office (IPO) issues a First Examination Report (FER) outlining any objections or deficiencies as per the prevailing rules. The applicant must respond within six months from the FER issuance date, with a possible extension of up to three additional months upon filing the prescribed request before expiry of the permissible period. If the Controller is satisfied with the response and no further objections remain, the application proceeds to grant.

Where objections remain outstanding or fresh issues arise from the applicant's response, the Controller may issue a hearing notice, providing at least 10 days' advance notice. During the hearing, the applicant or its authorized representative has an opportunity to address the objections before the Controller. Written submissions must then be filed within 15 days from the hearing date. Following consideration of the submissions, the Controller may either allow the application to proceed to grant or refuse the application if the objections are found not to have been adequately addressed.

As per the prevailing practice at the IPO, following the hearing and submission of written hearing submissions, the Controller generally proceeds to issue a final decision and dispose of the application. Accordingly, if the Controller is satisfied with the Applicant's submissions, the application may proceed to grant. If the Controller is not satisfied, the Controller may issue a reasoned order refusing the application.

In the event the application is refused, the Applicant may challenge the Controller's decision by filing an appeal before the jurisdictional High Court within three months from the date of the order.

India has witnessed a substantial improvement in patent prosecution timelines over recent years. Owing to increased recruitment within the IPO and several procedural reforms, the average pendency period has reduced. While patent applications previously required approximately seven to eight years to reach final disposal, applications are now typically concluded within two to three years.

Divisional Applications:

Indian patent law does not recognize continuation applications. Consequently, divisional applications cannot be used merely as a mechanism to extend prosecution timelines. A divisional application must relate to a distinct invention disclosed in the original application and should not give rise to double

patenting concerns with the parent application.

Where the Patent Office raises a double patenting objection, the burden of demonstrating patentable distinction rests with the applicant. Applicants should also be mindful that Indian practice does not provide advance notice of grant. As patents may be granted without prior warning, the opportunity to file a divisional application may be lost once a patent is granted.

Accordingly, any intended divisional application should ideally be filed at the earliest stage of prosecution, preferably before submission of the first substantive response.

The Patent (Amendment) Rules, 2024 have significantly clarified the law relating to divisional applications. The amendments expressly permit applicants to voluntarily file one or more divisional applications under Section 16 based on inventions disclosed in either a provisional specification, a complete specification, or even a previously filed divisional application. This clarification confirms the permissibility of multiple divisional filings within the same patent family and aligns with the Delhi High Court's decision in *Syngenta v. Controller of Patents,* which overturned the narrower interpretation previously adopted in *Boehringer v. Controller of Patents.*

Amendments to Patent Claims:

Indian patent law permits amendments to claims provided such amendments remain within the scope of the claims originally filed and are fully supported by the specification. As a general principle, amendments that introduce new subject matter or expand the original scope of protection are not allowable.

Judicial precedent has, however, adopted a relatively liberal approach to pre-grant amendments. In *Nippon v. Controller of Patents* (2022), the Delhi High Court held that amendments made prior to grant should be construed liberally, provided they do not introduce new matter and are supported by disclosures already present in the specification.

This position was reaffirmed in *Allergan v. Controller of Patents* (2023), where the Court emphasized that claims must be interpreted in conjunction with the complete specification and that both should be read as an integrated whole. Subsequently, in *OpenTV v. Controller of Patents* (2023), the Court clarified that amendments restricting or narrowing claim scope are permissible, whereas amendments that broaden, widen, or expand the scope of protection are not.

The scope of permissible post-grant amendments is governed by Section 59 of the Patents Act. In general, an amendment shall:

- be by way of *disclaimer, correction or explanation;*
- be fully supported by the specification as originally filed;
- not introduce a new matter; and
- fall wholly within the scope of a claim of the specification before the amendment.

Amendments relying upon features disclosed in the specification are generally allowed by Controllers provided that:

- each such feature is clearly and unambiguously disclosed in the specification as originally filed, maybe in the form of working examples;
- the amendment does not introduce any new technical matter in the claims; and
- the amendment further limits the scope of the granted claim, making it more definitive.

The allowable examples of proposed amendments may include:

- deletion of claim/s;
- merging features of original claims which shall in no manner or interpretation broaden the scope of protection under original claim/s; and
- introduction of limiting features (preferably verbatim from the specification) that further restrict the scope and in no manner broaden the scope of the original claim/s.

Accordingly, applicants may refine, limit, or narrow claims during prosecution, provided that the amended claims remain supported by the original disclosure and do not extend beyond the scope of the claims as originally filed.

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DEEMED ABANDONMENT AND COMMUNICATION OF FER: KEY TAKEAWAYS FROM A DELHI HIGH COURT RULING.

- Aayush Sharma

A recent decision of the Delhi High Court sheds light on an issue that many patent applicants and practitioners may not think about until it becomes a problem: what happens when an important communication from the Patent Office is allegedly never received?

While the case arose from its own unique facts, it offers useful guidance on how courts may approach disputes involving communication of examination reports and the consequences that can follow when an applicant is unable to respond within the prescribed timeline.

The case involved a patent application that had entered the Indian national phase through the PCT route. The applicant had completed the required filing formalities and had requested examination of the application.

As part of the examination process, the Indian Patent Office issued a First Examination Report (FER), setting out objections that needed to be addressed before the application could proceed further.

The Patent Office subsequently treated the application as abandoned on the basis that no response to the FER had been received within the prescribed period.

The applicant, however, took the position that neither it nor its patent agent had actually received the FER. According to the applicant, it became aware of the issue only after reviewing the status of the application on the Patent Office records. Thereafter, attempts were made to obtain a copy of the examination report and secure an opportunity to respond.

When the matter remained unresolved, the dispute eventually reached the Delhi High Court.

For many patent practitioners, the facts of this case will sound familiar. Patent prosecution today is largely driven by electronic communications, and most applicants assume that once a document has been emailed by the Patent Office, the communication process is complete.

However, prosecution realities are not always that straightforward. Email delivery issues, changes in agent details, corporate spam filters, internal forwarding failures, and other technical issues can occasionally result in important communications being overlooked or not received at all. When the missed communication happens to be an FER, the consequences can be significant.

What makes this decision noteworthy is that the Court did not confine itself to examining whether the Patent Office had dispatched an email. Instead, it examined the broader factual context, including the applicant's conduct and subsequent efforts to pursue the application.

From a practitioner's perspective, one of the most important aspects of the ruling is the Court's willingness to look beyond procedural records and examine the surrounding circumstances.

The Court appears to have been influenced not only by the dispute regarding receipt of the FER, but also by the overall conduct of the applicant. The applicant had entered the national phase, requested examination, maintained the application, and took active steps once the issue came to light.

This is an important takeaway because, in many prosecution disputes, the applicant's conduct often becomes as important as the disputed communication itself. Where an applicant can demonstrate a consistent intention to pursue patent protection, courts may be more inclined to carefully scrutinise whether procedural lapses genuinely justify the loss of substantive rights.

In contrast, prolonged inactivity or a lack of follow-up may make it more difficult for an applicant to obtain similar relief.

The examination process is built around communication between the Patent Office and the applicant. The FER serves as the starting point for that dialogue. It informs the applicant of the examiner's objections and provides an opportunity to submit arguments, explanations, evidence, and, where necessary, claim amendments.

If there is a genuine dispute regarding whether that communication was ever received, the issue becomes more than a mere technicality. It raises a practical question: was the applicant given a meaningful opportunity to participate in the examination process?

The Court appears to have considered this aspect carefully while evaluating the facts before it.

Importantly, the decision should not be interpreted as meaning that every allegation of non-receipt will automatically succeed. Nor does it suggest that proof of dispatch is always insufficient. The outcome was ultimately linked to the specific evidence and factual circumstances presented in this particular matter.

After considering the materials placed before it, the Court set aside the decision treating the application as abandoned and allowed the prosecution process to resume.

The applicant was given an opportunity to receive the FER and respond to the objections raised therein. The Court did not comment on whether the invention itself was patentable. Instead, the focus remained on whether the applicant should be given an opportunity to participate in the examination process.

Although the decision turns on its own facts, it offers several practical lessons for applicants and patent professionals.

First, applicants should not rely exclusively on email communications from the Patent Office. Regular monitoring of application status on the IPO website remains an essential part of portfolio management. In practice, many applicants discover issues through status checks rather than through formal communications.

Second, patent agents should ensure that email addresses, docketing systems, and communication protocols are reviewed

periodically. Even minor administrative issues can sometimes lead to significant prosecution complications.

Third, where a communication issue is suspected, prompt action is critical. The applicant in this case did not remain passive after discovering the abandonment status. Instead, efforts were made to obtain the FER and resolve the issue. Such conduct often strengthens an applicant's position when seeking discretionary relief.

Finally, applicants should bear in mind that restoration of prosecution in such circumstances is not automatic. Courts will generally evaluate the facts of each case, the available evidence, the conduct of the parties, and the overall equities before deciding whether intervention is warranted.

Conclusion

Rather than creating a new legal principle, the Delhi High Court's decision serves as a practical reminder that patent prosecution is ultimately intended to be a substantive examination process rather than a procedural trap.

The judgment demonstrates that where a genuine dispute exists regarding communication of an FER, courts may be willing to examine the surrounding facts carefully before allowing valuable patent rights to be lost. At the same time, the decision should not be viewed as a blanket safeguard against abandonment. The outcome was closely tied to the particular facts, evidence, and conduct of the parties before the Court.

For patent applicants and practitioners, the message is clear: robust docketing practices, regular monitoring of patent records, and prompt action when issues arise remain the best safeguards against prosecution risks. Such measures are far more reliable than having to seek judicial intervention after an application has already been treated as abandoned.

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