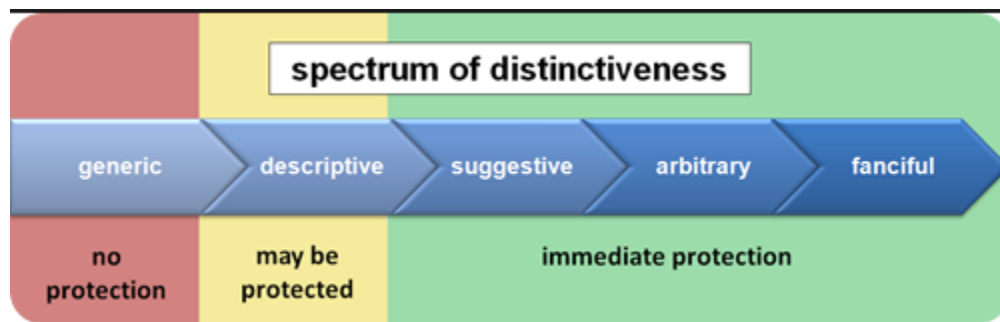


How strong is your Brand?

Distinctiveness of a mark vis-à-vis the goods/services is the foremost criteria for seeking registration as this requisition forms an absolute refusal ground under Indian law. The principle or measure of distinctiveness works on the very fundamental function of a trademark - to identify goods/services of one undertaking and distinguish them from those of another.

Distinctiveness decides registrability of a mark, which can be taken as a spectrum or range with "generic" and "descriptive" marks with no or weak distinctive character at one end, "fanciful/coined/inherently distinctive" marks with strong distinctive character at the other end and "suggestive" and "arbitrary" marks lying between these two points as shown below:



This is popularly known as "spectrum of distinctiveness" in the US or the "Abercrombie classification" or "Abercrombie factors". In Indian context one could add coined or invented instead of fanciful.

What makes a mark distinctive

In India, 'distinctiveness' has been provided for under the provisions of section 9 (1) (a) of the Trademarks Act, 1999 which states that trademarks shall not be registered which are devoid of distinctive character, that is to say, not capable of distinguishing goods or services of one person from those of another.

'Devoid of distinctive character' is better explained in TREAT case (1996) RPC 28 by Mr Justice Jacob:

What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other mark) which cannot do the job of distinguishing without first educating the public that it is a trade mark?



A colour or very simple geometrical shapes, such as a circle, could be an example which is simply too insignificant to constitute or be taken to be a trade mark.



Another example could be two/three letter or numeral mark. Now, whether such a letter or numeral mark could be registered prima facie will depend upon whether the average consumer would expect goods/services under the sign to originate from a single undertaking. If the sign does not possess the character necessary to perform this essential function of a trade mark it is “devoid of any distinctive character.”

A mark – “UIS” was only allowed registration for hand tools and instruments on evidence of two years user. (United Iron v Registrar AIR 1967 Punj 64)

Although trademarks consisting of letters or numerals are considered prima facie non distinctive, however, with regard to textile marks it has been the practice of the Registry to treat such marks as prima facie distinctive except to the extent they are prohibited from registration under the relevant rules. Also, two/three letter marks which can be clearly pronounced as words could be considered prima facie capable of distinguishing e.g. HE, OX etc.

Coined/Invented marks:

Is there a category of trademarks which could be considered to be distinctive without much regard to products/services?

The answer is yes, the first category of marks on the spectrum i.e. coined or fanciful or invented terms. Coined or invented words are preferred for registration as they are considered distinctive ab initio. The protection afforded to such marks has been superior throughout the world.



In one of the landmark judgments, if a word was invented, it could be registered per se (Eastman Photographic Materials v. The Comptroller General (1898) 15 RPC 476)).

Further coined/invented marks could be coined in various ways. They could be a combination of applicant's name and trading style with adding/subtracting letters to make it a pronounceable word, or a descriptive word with a suitable prefix or suffix.

In Hoffman La Roche v Geoffrey Manners AIR 1970 SC 2062, it was observed *that it is true that the word "DROPOVIT" is coined out of words commonly used by and known to ordinary persons knowing English. But the resulting combination produces, a new word, a newly coined word which does not remind an ordinary person knowing English of the original words out of which it is coined unless he is so told or unless at least he devotes some thought to it. It follows that the word "DROPOVIT" being an invented word was entitled to be registered as a trade mark and is not liable to be removed from the Register on which it already exists.*

Thus, invented words meet the criteria of distinctiveness and thus not hit by any grounds of refusal laid out in section 9 of the Trademarks Act.

Arbitrary marks:

Another category of marks is arbitrary marks. Such marks bear no reference to the goods or services or their character or quality. These are generally dictionary words but meaningless in the context in which they are used. For example, Apple for computers, Diesel for a bookstore etc



In Playboy Enterprises, Inc. v. Bharat Malik and Anr. 2001(21) PTC 328 (Del) it was held that there is not a scintilla of doubt that the defendants have adopted the word "PLAY" with sole object to exploit and trade on its

goodwill and widespread reputation. There is no credible explanation as to why the word "PLAY" was chosen. The trademark PLAYBOY falls in the category of arbitrary marks and thus its close imitation or deceptive similarity by using any part of the word either as prefix or suffix is likely to create confusion in the minds of the customers as to its source.

It was further observed that 'arbitrary' marks have no connection to the nature or type of the goods.

Thus, arbitrary marks would be considered to be a strong choice of marks.

Suggestive marks:

If the reference to the character or quality is only indirect or suggestive, the mark may be considered as possessing sufficient degree of inherent capacity to distinguish. Such marks are categorised as "suggestive"



It was observed in ITC Limited Vs. Nestle India Limited MIPR 2015 (2) 40 that the word or mark "MAGIC MASALA" (Masala means Spices) cannot be considered as descriptive word, and as stated in the McCarthy on Trademarks and Unfair Competition (III Edition), imagination is required on the customers part to get some direct description of the product from the term, and it is only suggestive and it cannot be descriptive. The descriptive term directly and clearly conveys information about the ingredients, qualities, or characteristics of the product or service, the "suggestive" term only indirectly suggests these things.

Thus, a trademark may allude to the nature or function of the goods or services for which registration is sought, since allusion is suggestive rather than a descriptive attribute so long as the monopolization of the allusion does not exclude other traders from being able to use the images or words which are part of their ordinary stock in trade.

Descriptive marks:

A mark which has a direct reference to the character or quality of the goods/service is considered as inherently not capable of distinguishing. Such marks are considered to be "descriptive" ones.



In *Online India Capital Co. Pvt. Ltd and Anr. v. Dimension Corporate* (2000) V AD (Del) 860, the plaintiff company was running the website “www.mutualfundsindia.com” while the defendant had created a similar website “www.mutualfundindia.com”. It was held that the expression “mutual funds” forming part of the plaintiff’s domain name is the *description* of the services being offered by the plaintiff. The material placed on record failed to show that the said expression had acquired a secondary meaning which is a precondition for grant of protection to a *descriptive name*. It was thus held that no prima facie case was made out for the grant of interim injunction prayed for by the plaintiff.

This has been precisely stated in Section 9 (1) (b) which states that a trademark registration shall be refused if it consists *exclusively* of words or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

The objective is that “traders should not obtain any monopoly in the use of words as trademarks to the detriment of the members of the public, who, in the future and in connection with their goods might desire to use them”.

Generic marks:

The last category of marks on the spectrum is generic marks. Generic marks are alternatively defined under Section 9 (1) (c) which states that marks which consist *exclusively* of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade shall not be registered.

Thus, signs and indications that are common to trade or customary in current language or in the established practice of trade are prohibited from registration.



In *Himalaya Drug Co. Vs. SBL Limited* 2010 (43) PTC739 (Del) it was observed that "LIV' is really an abbreviation of Liver, which is a generic name of an organ. It is, in any event, understood as such. There appear to be a number of drugs in the market using the prefix 'LIV' for their names. Notwithstanding the survey report, the evidence of the witnesses in the present case bears this out." Eventually, it was held that 'LIV' is publici juris and, therefore, when the two marks Liv.52 and LIV-T are compared, 'LIV' will be considered as generic.

When looked at closely, Section 9 (1) (c) further supplements to what has been stated in Section 9 (1) (b). The only difference is that the former covers the marks which are actually believed to be in use in trade whilst the latter covers the marks which may be used in trade in the future as well.

Acquired distinctiveness:

Finally, a trademark which is primarily non distinctive when interpreted in light of Section 9 (1) (a) (b) (c) could still be registered if it can be shown that on the date of application the mark has in fact acquired a distinctive character as a result of the use made of it (proviso to section 9) Thus, if a mark is associated in the minds of public with the goods/services of a particular trader, then it could not be legitimately used by others as a trademark. The onus is on the applicant to show that by reason of use, the mark has lost its descriptive meaning and has acquired a secondary distinctive meaning. Furthermore, the distinctiveness objection can be overcome by presenting appreciable evidence of use both in and outside India by way of affidavit in order to demonstrate that the mark has acquired distinctiveness. Generally three years of use prior to the date of filing of the application supported by evidence by way of affidavit with documents such as invoices of sale, promotion material is sufficient to claim acquired distinctiveness.

In *T.V. Venugopal Vs. Ushodaya Enterprises Ltd., and another* (2011) 4 S.C.C. 65, the Hon'ble Supreme Court, that whether the trade mark, trade name or mark, are descriptive or generic word and by referring to various judgments, held as follows:- "Para No. 73. In Halsbury's Laws of England, Volume 48 Fourth edition at page 190, it is stated that it is possible for a word or phrase, which is wholly descriptive of the goods or services concerned, to become so associated with the goods or services of a particular trader that its use by another trader is capable of amounting to a representation that his goods or services are those of the first trader and that although the primary meaning of the words is descriptive, they have acquired a secondary meaning as indicating the products of a particular trader."



Conclusion:

- Coined/Invented/Fanciful words are the strongest marks. Being unknown, the infringers of these marks are hard pressed to provide any plausible reason for their adoption or use.
- Arbitrary marks, again, are a strong choice of marks as they are words already existing in popular vocabulary, but have no logical relation to the goods/services in connection with which they are used.
- Suggestive marks require imagination, thought and perception to determine the nature of goods or services in question and are registrable without proof of secondary meaning. Such marks could be differentiated from the descriptive marks due to their incongruous nature. However, such marks could face troubles that they may be considered suggestive by some and descriptive by others.
- Descriptive marks are considered to be weak as they describe an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services. Such marks are not considered to be a strong choice of marks reason being such marks should be kept free for use for all traders/public. However, such marks are registrable upon evidence of acquired distinctiveness. Even if they qualify for trademark protection, descriptive marks are the weakest marks, and do not receive as broad legal protection as coined/arbitrary/suggestive marks.
- Generic marks are terms that the relevant purchasing public understands primarily as the common name for the goods or services in question. These terms are not registrable as trademarks except upon evidence of acquired distinctiveness.

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