

Dictionary Word with Acquired Distinctiveness – Registerable as a TM

A trademark may be a word, sign, and symbol or even graphic that is applied to a company, goods or services to distinguish them from those of the competitors. For example a brand, product, company name, or logo. This enables consumers to identify, purchase and enjoy products and services based on their specific characteristics and quality, as promised by the said trademark/owner.

A trademark can be composed of logos, images, words, short phrases, colours or even a compound of all of these. The most commonly used are words and pictures however, other distinguishable marks may also be used if they are capable of graphical representation. For instance Louis Vuitton, the famous luxury brand has obtained a trademark for its check pattern which is known as the Damier Pattern, the infamous confectionery brand Cadbury has the colour purple trademarked for its chocolates even though trademark for a single colour is very hard to obtain. And Coca-Cola has a trademark for its bottle's design. Some more examples of trademarks are DETTOL, ROLEX, NESTLE, SUN PHARMA, THEOBROMA, MONT BLANC etc.

ACQUIRED DISTINCTIVENESS

Every trademark identifies the goods sold under them as emanating from a particular source. With passage of time it gets strengthened and a particular trademark gets registered or mentally associated in the minds of the consumers as distinctive of the product and its source. Some trademarks are distinct from their inception due to their inherent characters and they are given legal protection immediately upon use as a trademark while certain marks gain protection due to a secondary meaning they acquire over time. Thus there is a correlation between 'strength' and 'secondary meaning' of a trademark. A non-inherently distinctive mark must have that quantum of strength or secondary meaning to qualify as trademark¹.

If we consider the case of DETTOL or DALDA, they were originally brand names but they have diluted to now bear reference to the product itself to such an extent that even if we buy the same product under another brand name, the image that comes to our mind is that of Dettol and Dalda only. This is acquired distinctiveness.

Basically, this implies that some words, although primarily distinctive of character and quality of goods or services, may lose their descriptive meaning and acquire distinctiveness by reason of use. Mark that is not innately distinctive, but by the virtue of extensive and significant use of the mark over a period of time, persuades the consumers to relate the mark with a product or services, then Mark is said to have 'acquired distinctiveness' or 'secondary meaning'.

The Trademark Act of 1999 indirectly deals with 'acquired distinctiveness' or 'secondary meaning' under proviso of section 9 (1) and section 32. The registration of descriptive trademarks is prohibited under Section 9(1)(b) of the Act. However Proviso to Section 9(1) provides that a trade mark shall not be

¹ <http://www.mondaq.com/india/x/39320/Trademark/Distinctiveness+through+Secondary+Meaning>

refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark².

Further Section 32 also provides that "where a trade mark is registered in breach of sub-section (1) of section 9, it shall not be declared invalid if, as result of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration acquired a distinctive character in relation to the goods or services for which it is registered.

The Act is very silent on the factors which are to be considered while assessing if the 'mark has `acquired distinctiveness' or 'acquired secondary meaning' unlike US and other nations which have settled principles to deal with these aspects of law. In India, the Court and IPAB have been playing a vital role in laying down principles to establish if the mark has acquired distinctiveness or not.

Mere use of a mark doesn't mean it's rendered distinctive, increased use does not do so either. The use and increased use should be in a distinctive sense to be of any material. It is permissible and necessary to determine the meaning and significance a sign holds on a given date³. The usage in question is not limited to the consumers or end users of the products but it is also extended to the others concerned in the trade such as the manufacturers, wholesalers and retailers.

In Godfrey Philips India Ltd v Ginnar Foods and Beverages Ltd⁴, it was held that a descriptive trademark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source.

The acquisition of distinctiveness is a laborious and time consuming process. Even so no time has been stringently fixed for a trademark to become distinctive unlike in the British Act of 1919 which states that 2 years bonafide use was considered enough. There can be cases where for sundry reasons a trademark becomes distinctive in a really short time or another case where a trademark never acquires distinctiveness. Hence it is not possible to rule out any hard and fast rule regarding the time period required to acquire distinctiveness.

In Ishi Khosla v Anil Aggarwal⁵ it was held that to acquire secondary meaning, it is not necessary that product has to be in the market for a number of years, if a new idea is fascinating and appeals to the public, it may become a hit overnight.

In Easynet Group Plc v Easygroup IP Licensing Ltd, the question was whether the trade mark `EASY.COM' was descriptive. It was held that the proper approach is to look at the mark as a whole and to see if the mark as a whole is descriptive. In the course of that exercise, it is permissible to

² [The Trademarks Act, 1999](#)

³ [Bach and Bach Flower Remedies Trademarks, \[2000\] RPC 513](#)

⁴ [2005 \(30\) PTC \(SC\) 1](#)

⁵ [2007 \(34\) ptc 370 \(del\)](#)

consider the descriptive nature of the separate elements of the mark but ultimately it is the overall assessment that matters.

Although via several decided cases, it has been shown that a common descriptive word can acquire a secondary distinctive meaning by use in relation to the goods. However it can be extremely difficult to establish that such word has become distinctive in fact and has acquired a secondary meaning different from its natural meaning. The difficulty becomes even greater when the mark is not only descriptive but also contains the name of the product such as Diabolo for a top or shredded wheat etc. This difficulty may sometime be overcome if the alleged trademark is in fact a description of goods but the public identifies it as a fancy word and not a descriptive word.

The onus is on the applicant to show that the word which is primarily descriptive of quality of goods has become descriptive. The onus must be discharged by the applicant in respect of every article to which the trademark is applied and not just for one of the many products to which the mark is applied. When the case is on the border line, the registrar will usually refuse to grant the registration, however, he will not try to discover reasons for refusing the registration. However, the trader should get a fair opportunity for establishing his right to the statutory protection.

In determining whether a mark has acquired a distinctive character because of long and continuous use, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular source. In assessing the distinctive character of a mark in respect of which registration has been applied, the following should be taken into account:

- The market share held by the mark.
- How intensive, geographically, widespread and long, standing use of the mark has been.
- The amount invested by the undertaking in promoting the market.
- The proportion of the relevant class of persons who identify the goods to be coming from a particular undertaking
- Statements from various trade and commerce associations.

If on these factors, the competent authority finds that a significant number of people identify the goods as originating from a particular source because of the trademark; it must hold that the requirement for registering the mark laid down has been satisfied.