

Trademark Law in India – Types of Trademarks, Registration Procedure and Acquired Distinctiveness of Generic Words

I. TRADEMARKS

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.

Trademarks are valuable business assets and even though it is not mandatory under law, it is advisable to have the mark registered as unregistered trademarks only receive limited protection. Post registration, in case another business tries to employ the same or a similar mark, there will be a proper legal recourse to stop it. A trademarked name marks all of the products and services as the proprietor's and no one else's and also prevents loss of reputation due to counterfeit products. A Trademark is valid for 10 years and it can be renewed indefinitely on payment of additional fees. Trademark rights are private rights and protection is enforced through court orders.¹

In India, the Trade Marks Act, 1999 deals with several aspects of trademarks like registration, protection, provisions of relief in case of infringement etc. India is a signatory of the Paris convention and the TRIPS agreement and hence the Act is compliant with the principles thereof.

II. **TYPES OF TRADEMARKS**

A trademark may be divided into the following categories:

- 1. Word marks:** They may be words, letters or numerals. Eg: COCO CHANEL and APPLE
- 2. Device marks:** These marks consist of exclusive representation of a word, letter or numerical. Eg: The way in which AMAZON is written or EBAY is written.
- 3. Figurative marks / logos:** They consist of a figure or a logo. Eg: The YELLOW M of Mc Donlads or the SWOOSH sign of Nike.

¹ <https://www.wipo.int/trademarks/en/>

4. **Service Marks:** A service mark basically differentiates the services (and not goods) of one person from that of another. Eg: The name UNITED AIRLINES, the FLY THE FRIENDLY SKIES tagline, and the logo of a world map are service marks. This is because United provides a service: airline flights around the world.²
5. **Collective Marks:** Marks being used by a group of companies. The owner of such marks may be an association or public institution or cooperative. Eg: CA used by the Institute of Chartered Accountants and the mark CPA, to indicate members of the Society of Certified Public Accountants.
6. **Certification Marks:** Certification marks are used to define standards. They assure the consumers that the product meets certain prescribed standards. Eg: ISI mark and FSSAI mark.
7. **Well-known marks:** When a mark is easily recognised among a large percentage of the population it achieves the status of a well-known mark. Example: ROLEX, CARTIER, FERRARI.
8. **Unconventional Trademarks:** Unconventional trademarks are those trademarks which get recognition for their inherently distinctive feature:
 - **Colour Trademark:** Purple colour trademark of Cadbury Chocolates
 - **Sound Marks:** A well-known sound trademark is the Hemglass ice cream van jingle.
 - **Shape Marks (3D marks):** The coca cola bottle.
 - **Smell Marks:** Brazilian footwear company Grendene successfully trademarked their line of bubble gum-scented jelly sandals in June, 2015

III. REGISTRATION OF TRADEMARKS

On filing a Trademark application, the registry issues an official receipt that has the filing date and application number. Then the Indian Trademarks Office examines the application, as to ensure it can be registered under the Trademarks Act and if any objection to registration is raised, registry issues an examination report to the applicant. The applicant is then required to file a written response or is required to give evidence of acquired distinctiveness and thereafter a hearing with the examiner is posted.

If post examination and hearing, the registrar is of the view that the trademark can be allowed, Letter of Acceptance is issued to the applicant after which the trademark is published in the Trademark Journal. Post publication, it is open for opposition for 4 months from date of publication. If no objection is raised in these 4 months, certificate is issued and in case of objection, both parties are given opportunities to be heard.

² <https://www.upcounsel.com/senrice-mark-example>

Trademark Registration is a tedious process and it usually takes around 18-24 months to acquire registration in cases with no objections or oppositions.

Once the trademark is registered, it is valid for a period of 10 years from the date of application. The registration can then be renewed indefinitely as long as the renewal fees are paid every 10 years.

IV. DESCRIPTIVE MARKS

A descriptive trademark is a word that identifies the characteristics of the product or service to which the mark pertains. It is similar to an adjective. An example would be DEEP BOWL. If that's the mark you used to describe a spoon with a deep bowl for scooping, it is what's known as a descriptive trademark. Other examples of descriptive marks are KOLD AND KREAMY for ice cream, CHOCO TREAT in respect of chocolates and chocolate based confectionery and AERO GEAR for sky diving suits, tools and equipment.

A mark is descriptive if in its common use it is reasonably indicative of the thing it's intended to be used for. In order to be descriptive, it is sufficient if information is afforded so as to the general nature and character of the product covered and it's not necessary that the words shall comprise of a clear, complete and accurate description.³ The meaning which should be given to such a mark is the one that is most likely to be conveyed to the public.

To consider if a mark has direct reference to the character and quality of the goods, the word is not to be viewed in its strict grammatical sense but as how it will be conceived by the public at large which is targeted.⁴

To prove that a word is descriptive, it has to be shown descriptive as a whole, it cannot be split into fragments to make it objectionable on account of being descriptive.

The mark in question should be related to the goods it covers and then it should be seen what the mark would connote to the average purchaser of the particular goods and what his mental reaction to the mark will be.⁵

Direct Reference

It is implied that a word which has only an indirect reference to the character and quality of goods doesn't classify as descriptive words. What is objectionable to the eligibility of a word being registered as trademark is its direct reference to the character and quality of goods. A word that is merely suggestive in reference to the goods, it does not make it inappropriate as a trademark. In order to analyse if a word has direct reference to or is merely suggestive of the character and quality of the goods, not the strict grammatical sense but the public's perception of it is taken into consideration.

³ [Bharat Enterprises India v C Lall Gopi Industrial Enterprise AIR 1999 P&H 231](#)

⁴ [Gramophone Company Ltd v Itonia Gramophone Ltd \(1931\)48 RPC 309](#)

⁵ [Wadhwa Kapil. 2010, Venkateshwaran on Trademarks and Passing Off, Lexis Nexis, Pg 198](#)

Example: The term SPEEDMASTER in respect of ordinary time pieces and watches has no direct reference to the character and quality of the goods, i.e., time pieces as their ordinary feature is to measure and indicate time. There is no mention of time in the term SpeedMaster and hence it cannot be said that it has direct reference to the goods and hence it can be registered.

Example: The term LUXECLOTHING for a luxury brand has direct reference to the goods that will sell under this name and there are numerous Luxury Brands already existing in the market, hence the term LuxeClothing will not be allowed.

Words which have no direct reference and do not convey any meaning in respect of goods considered are best to be registered as trademarks. For instance: QUAKER for oats, SUNLIGHT for Soap, COBRA for shoe-polish and WHITE HORSE for an alcoholic beverage

No Monopoly in descriptive words

Apart from the act, it has always been held that a word which consists of the name or description of the goods cannot be a trademark and cannot be granted monopoly. Even if at a specific time, the applicant is the only producer of the goods, he cannot be granted monopoly for a word that aptly describes the goods.

Lord Herschell's Committee (UK) said "*Words of description are the property of all mankind and it would not be right for any individual to monopolise them and exclude others from their use.*"⁶

Registration under Section 9(1)

As per the law, registration of descriptive marks is not permissible. Descriptive marks should not be granted registration under section 9(1) of the Trademarks Act in normal circumstances.

However, courts have interpreted that descriptive marks can be afforded registration only in exceptional circumstances. If a mark is descriptive per se but owing to its prolonged use in the trade it has lost its primary descriptive meaning and has become distinctive in relation to the goods it deals with, it can be registered. Therefore, marks, such as INTERNATIONAL BUSINESS MACHINE (IBM) for computers, SHARP for television, and GLUCON-D for revitalizing beverage, among others, are or may be registered under these exceptional circumstances.

In a recent decision of the Division Bench of Delhi HC in Marico's case⁷, the honorable Delhi HC has held that: "*when the descriptive trademark is used only by one person undisturbed for a very long period of time, without anyone else attempting to use the trademark during this long period time, a case can be established of a descriptive word having achieved distinctiveness and a secondary meaning.*" This strengthens the aforementioned proposition that descriptive trademarks are not allowed registration until there is a strong case of distinctiveness as a result of prolonged use.

⁶ [Lord Herschell's Committee Report, Para 26, p. xi](#)

⁷ [Marico Limited V. Agro Tech Foods Limited, Delhi Hc, \(Os\) No. 352/2010](#)

V. **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 trademark⁸.

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 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 mark⁹.

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

⁸ <http://www.mondaq.com/india/x/39320/Trademark/Distinctiveness+through+Secondary+Meaning>

⁹ [The Trademarks Act, 1999](#)

determine the meaning and significance a sign holds on a given date¹⁰. 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 Girnar Foods and Beverages Ltd*¹¹, 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 Aggarwal*¹² 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 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.

¹⁰ [Bach and Bach Flower Remedies Trademarks, \[2000\] RPC 513](#)

¹¹ [2005 \(30\) PTC \(SC\) 1](#)

¹² [2007 \(34\) ptc 370 \(del\)](#)

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.

VI. CONCLUSION

It is a well-recognized standard of law that a trader or an entrepreneur can get exclusive rights to use a particular word having descriptive nature as a trademark if it satisfies that it has acquired a secondary meaning or a distinctive character with constant user for a substantial period of time. The use of the word must be to such a degree that, it has lost its primary meaning and has acquired a distinctive character. The moment the same is used it must remind the consumer of the goods of the proprietor.

From the above, it can be concluded that, there is no absolute rule that mark which is devoid of distinctiveness cannot be registered as a trademark. Also, the Act is silent on what are the prerequisites to determine if the mark has Acquired Distinctiveness by way of its usage or any other factors and over the year's judiciary has played an active role to determine the same.