

How 'Distinctive' should a trade mark be?

By Adarsh Ramanujan and R. Subhashree

A creative mind may say that a rose called by any other name would smell as sweet and a name has nothing to it. The Trademarks Act, 1999, however, envisages the opposite and our experience with brand names and market shares show that a name has quite a bit to it. It provides for registration of trademarks - a mark capable of being represented graphically and distinguishing the goods and services of one person from those of others. A trade mark may include shape of goods, their packaging and combination of colours. Sections 9 and 11 make it clear that the scheme of things under the Trademarks Act, 1999 is to allow for registration of only those marks that are sufficiently distinctive in nature.

Consider the case of 'Dettol', 'Xerox', 'Dalda' where what was originally the brand or name (trade mark) of the entity has been significantly diluted to now bear reference to the product itself. So much so, that even while buying a product having a different brand name, the image is that of 'dettol' or 'dalda'! These illustrations highlight the manner in which marks originally distinctive in nature, have subsequently become common reference for consumers.

The other side of the coin is where manufacturers try to carve out a unique image or brand value from common or generic words. Let us take the case of *Bhole Baba Milk Food Industries Ltd v. Parul Foods Specialities Pvt. Limited*¹. The Plaintiff and the Defendant sold dairy products under the name of 'Krishna' and 'Parul's Lord Krishna', respectively. The latter, however, reduced the font size of 'Lord' and hence, it was alleged that the defendant's products bore significant resemblance to the Plaintiff's product, 'Krishna'. The Delhi High Court held that registration cannot possibly give an exclusive statutory right to the Plaintiff qua a particular word of common origin. The Court opined that the affinity of Lord

¹ MANU/DE/4050/2011 - Delhi High Court order, dated 17th October 2011, in FAO(OS) 109/2011.

Krishna for butter was widely known and the party could only claim distinctiveness, if at all, in the way the word was written.

Colour or combination of colours can be registered as a trademark². In *Loubotin v. Yves Saint Laurent*, for instance, Loubotin claimed that he had the exclusive right to use red colour soles in shoes and that by trading in shoes having red soles, Yves Saint Laurent had infringed his trademark. Ruling against this, the United States District Court of the Southern District of New York,³ reasoned that granting an injunction to that effect was overly broad and inconsistent with the scheme of trademark registration. The court impliedly noted that providing exclusivity over the colour red may affect competition in the market.

Cadbury (Kraft Foods) was successful in staking its claim against SOCIÉTÉ DES PRODUITS NESTLÉ S.A (Nestle)⁴ to register the colour purple (Pantone 2685C) on the whole of the visible surface of its chocolate bars, eating chocolate and drinking chocolates. The ruling stated that the colour had acquired a distinctive character and people associated the colour with Cadbury chocolates. Evidence, in the form of a public survey, proved that the public associated the colour with Cadbury's products. In the same breadth, however the Court did refuse to extend the same relief to chocolate assortments and chocolate cakes despite the fact that the colour had been in use for these products as well. This was solely due to the fact that evidence did not indicate that the public associate this colour, for these products, with Cadbury.

Another recent and interesting dispute revolves around the numeral '8'. In *Radico Khaitan Ltd v. Carlsberg India Pvt Ltd*,⁵ the rival parties sold mineral water branded as 8 PM and beer marked as Palone 8. Ruling against the Plaintiff in this case, the Delhi High Court opined that a numeral, in itself, cannot be said to have distinctive character and that in any case, the numeral 8 was generally used in the beer industry and other (third party) users had also registered similar trademarks. However, in the interests of the consumers, to avoid confusion it was asked of the defendant to change the manner in which the numeral '8' was

2 Under Section 10(2) read with Section 10(1) of the Trade Marks Act, 1999, unless a trademark is registered with a limitation as to colour, it will be deemed to be registered for all colours.

3 *Christian Louboutin S.A. v. Yves Saint Laurent Am., Inc.*, 778 F. Supp. 2d 445 (S.D.N.Y. 2011)

4 Order dated 20-10-2011 in respect of TRADE MARK APPLICATION No. 2376879 (UK) - <http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o35811.pdf>

5 Delhi High court order dated 16-9-2011 in I.A. No. 8122/2011 in CS(OS) 1216/2011- <http://lobis.nic.in/dhc/MAN/judgement/16-09-2011/MAN16092011IA81222011.pdf>

represented. While it was agreed that the definition under the Trademarks Act was inclusive and protection could be availed for numerals also, it was reasoned that a single numeral is not as distinct as two or more numerals, such as in the case of the '555' mark for agarbathis. Similarly, in *Skol Breweries Limited v. Som Distilleries & Breweries Limited*⁶, the Bombay High Court also held that numerals cannot claim exclusivity.

On the other hand, in the case of *Kamal Trading v. Gillette UK Limited*⁷, where the court was concerned with the usage of identical mark 7 O CLOCK by the defendant. The Court considered that to be a case of a composite mark that was distinctive as a whole and the defendants were restrained from using the mark on their tooth brushes (allied products) as it would confuse the trade in respect of the plaintiff's use of the mark on their shaving creams and razors.

In another recent and interesting decision, which, to a certain extent, may seem to overlap with the concept of a geographical indication, the Calcutta High Court⁸ held that naming a lounge in the hotel as 'Darjeeling lounge' did not amount to "passing off", despite being similar to 'Darjeeling' tea. The Plaintiff, the Tea Board of India, owned the registration for 'Darjeeling' tea. It alleged that the hotel served food and beverages including tea and that this would confuse the public that the tea had the attributes of 'Darjeeling' tea. Effectively, as attempt was made to claim an exclusive right to the use of the word 'Darjeeling'. The Court however ruled that the trade mark (and the geographical indication) protection extended only to goods covered within the scope of the registration. In view of the fact that defendant was in the hospitality industry and not trading particularly in tea as well as the prima facie finding of fact that the Defendant had not held themselves out as authorities who could certify the goods to be 'Darjeeling' tea, the court denied an interim injunction.

Conclusion

Thus, Courts have consistently taken the stand that words that are common or otherwise generic to an industry cannot be normally allowed to be registered *per se*. Registrability may be allowed if the mark in question has a 'plus' factor that can add to the distinctiveness of the

6 MANU/MH/1110/2011

7 1988 PTC 1 (7' O Clock)

8 MANU/WB/0633/2011

mark. There is no exhaustive test to determine the manner in which 'plus' factor would assist in adding distinctiveness and will vary with the facts and circumstances of each case.

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