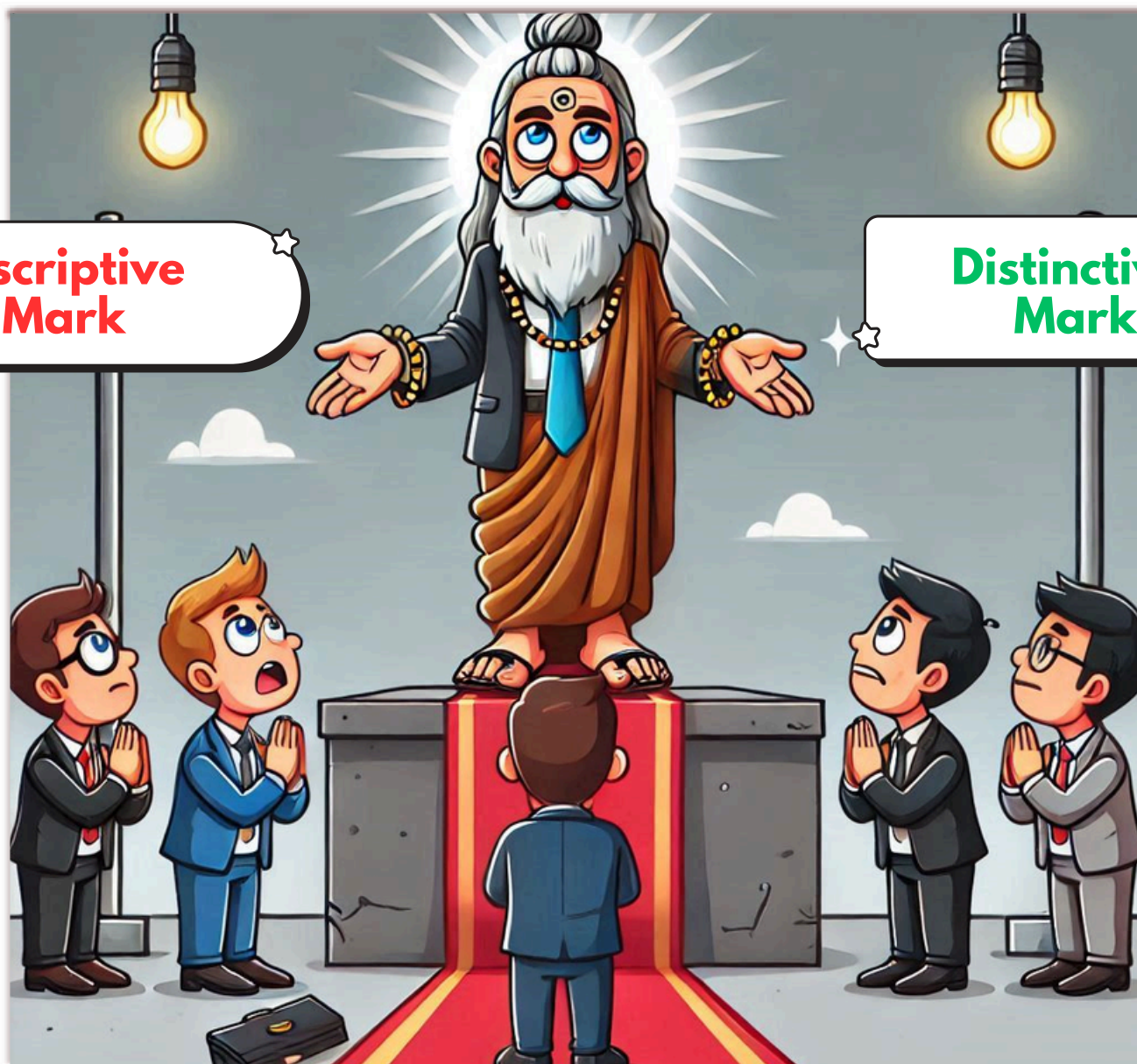


Wednesday Wisdom 04-12-2024

**Descriptive
Mark**

**Distinctive
Mark**



**ARE YOU A BRAND GURU?
YOU MUST KNOW THIS BEFORE
YOU CREATE A BRAND**



Brand Gurus, you spend hours and hours on creative thinking but if that effort is proved worthless due to lack of knowledge on difference between distinctive and descriptive mark, imagine how will you feel [1]?

Hence, we want to bust a common misconception among the public and businesses that a trademark should be descriptive, directly highlighting the nature, purpose, or characteristics of a product or service. While this belief may seem logical, it contradicts the purpose of the Trade Marks Act, 1999 (“Act”). A trademark’s primary purpose is to serve as a unique identifier, distinguishing owner’s goods or services from those of competitors. Descriptive trademarks, however, often fail to meet this condition and are frequently ineligible for registration.

Section 9(1)(b) of the Act specifically prohibits the registration of trademarks that describe the kind, quality, quantity, intended purpose, value, geographical origin, the time of production or other characteristics of the goods or services. This provision ensures that common descriptive terms remain freely available for all businesses to use, thereby maintaining fair competition in the marketplace.

This article addresses the myth of descriptive trademarks and associated challenges.

1. What are the legal implications of using a descriptive mark in branding?

- **Difficult in granting protection:** Many businesses believe that a descriptive trademark is advantageous because it directly informs consumers about the product or service. However, this approach often backfires, as descriptive marks fail to meet the legal requirements for trademark protection. The Act prioritizes creativity, uniqueness, and distinctiveness. Granting exclusive rights to descriptive terms would unfairly restrict competitors from using common words necessary to describe their offerings.

[1]The article reflects the general work of the author on the date of publication and the views expressed are personal. No reader should act on any statement contained herein without seeking detailed professional advice.



- **Lack of Distinctiveness:** A trademark acts as a source identifier, linking a product or service to its origin. Descriptive marks directly describe the goods or services without creating a unique brand identity. For example, “Original juice” for a juice brand lacks distinctiveness because it directly describes the product, suggesting that the juice is genuine or natural and fails to differentiate one juice brand from another.
- **Limits on Future Expansion:** A descriptive mark may confine a brand to specific categories, restricting it from expanding into new product lines. For example, a trademark like “Refresh Coffee” might create difficulties if the brand later wants to diversify into tea or snacks under the same brand name.
- **Legal Challenges:** Descriptive marks are prone to opposition and cancellation proceedings. Even if a descriptive mark manages to secure registration (perhaps by acquiring distinctiveness through long-term use), competitors or third parties can challenge its validity. They may argue that the term is too generic or necessary for fair use within the industry. This issue can lead to costly legal disputes and brand instability.

In an interesting example, before the Delhi Court, last year, the registrant owner of the mark IOD- Institute of Directors sued for injunction against Director’s Institute [CS (COMM) 611/2023, I.A. 16738/2023 & I.A. 16739/2023]. However, the Defendant reproduced an affidavit submitted by IOD before the trademark registry, wherein they themselves had accepted that proprietorship over common English words cannot be claimed.

“We humbly submit that the mark IOD INSTITUTE OF DIRECTORS BUILDING TOMORROW’S BOARDS (DEVICE) of the Applicant is in the form of a device. It is pertinent to note that the words used in the mark are common English language words and are descriptive in nature and cannot belong to any one Proprietor. The Applied mark should be seen as a whole. It does not have direct reference to the characteristics like kind, quality, quantity or other characteristics of services. Moreover, the mark possesses all the necessary pre-requisites laid down by the law to be termed as a mark as defined in section 2(1)(m) of the Trade Marks Act, 1999.”

The Court emphasized that, it is well settled that words of ordinary English usage cannot be monopolised. Else, the entire English language would be appropriated by a few, which can obviously not be permitted. No monopoly can be claimed by the registrant of such a mark. The Court refused to grant the injunction.

- **Consumer Confusion:** Descriptive marks are often too similar to one another, which can create confusion for consumers. For example, if several businesses use descriptive names such as “Healthy Bites” for healthy food or snacks businesses, it becomes challenging for customers to distinguish one brand from another. This similarity can lead to misunderstandings, where consumers may not know which specific brand they are interacting with.

In the matter of a well-known platform, the Delhi High Court[2] refused to grant an interim injunction sought by Bigtree Entertainment, owner of the trademark “BOOKMYSHOW”, against the use of the prefix “BOOKMY” by the website “BOOKMYSPOORT”. Bigtree claimed that “BOOKMYSPOORT” was deceptively similar to its trademark, alleging the prefix “BOOKMY” was distinctively associated with its brand. However, the Court noted that the prefix “BOOKMY” appeared descriptive rather than distinctive, and exclusivity cannot be claimed over descriptive terms widely used in an industry. The Hon’ble Court observed that the plaintiff failed to show that “BOOKMY” was exclusively associated with its business or had acquired secondary meaning. Accordingly, the injunction was denied.



[2] Bigtree Entertainment Pvt Ltd Vs Brain Seed Sportainment Pvt Ltd & Anr. CS(COMM) 327/2016

2. What are the key factors that determine whether a trademark is distinctive and non-descriptive?

For a trademark to stand out and function effectively as a brand identifier and acquire exclusive protection under the Act, it must possess distinctiveness. This means it should differentiate the product or service from others in the market. Key factors include:

- **Originality:** A strong trademark often uses inventive or coined words that have no inherent meaning or direct connection to the product or services. For example, "Xerox" is a coined term with no direct meaning, making it highly distinctive.
- **Acquired Distinctiveness:** Over time, even descriptive marks may achieve distinctiveness through extensive use and consumer association with a specific brand, which is referred to as "secondary meaning". To prove secondary meaning, the owner must demonstrate that consumers now recognize the descriptive mark as representing their specific products or services, not just as a general description of the product's features. Evidence could include sales data, advertising material, consumer surveys, invoices and social media post.
- **Not Confusing with Existing Marks:** Trademark must not be similar to any existing, well-known mark, as it could cause consumer confusion. Even if a trademark is distinctive in its own, if it closely resembles another registered trademark, it may be rejected on the grounds of likely confusion.
- **Market Uniqueness:** The trademark must stand out in its specific market sector. For example, a word that may be common in one industry can be distinctive in another. "Apple" is distinctive in electronics but will not be as unique for a business of selling fruits.

3. What are the categories of Distinctive Marks?

There are three categories of distinctive marks:

- **Fanciful Marks:** These marks are coined or invented words that have no meaning before they are used as a trademark. They are entirely new and created specifically to represent a brand, making them inherently distinctive. Fanciful marks are often the strongest form of trademark protection due to their uniqueness and originality, with no pre-existing associations in the marketplace. Examples of fanciful marks include Kodak (for photography) and Pepsi (for cold drinks).



- **Suggestive Marks:** Suggestive marks provide a hint or suggestion about the product or service but require the consumer's imagination to make a connection. These marks do not directly describe the product but imply its nature or characteristics. Examples of suggestive marks include Netflix (suggesting movies and streaming services) and Jaguar (suggesting speed and luxury for high performance car).
- **Arbitrary Marks:** These are words that are commonly used in the language but have no direct or inherent connection to the product or service they represent. These marks use familiar words in completely unrelated contexts, making them highly distinctive and capable of strong trademark protection. Examples of arbitrary marks include Amazon (for e-commerce, unrelated to river).

4. Can a Descriptive Trademark ever be registered? If so, under what conditions?

Yes, a descriptive trademark can be registered under certain conditions, though it is generally more challenging to do so. There are exceptions to Section 9(1)(b) of the Act:

- **Prove Secondary Meaning:** A descriptive mark can be registered if it has acquired a secondary meaning, where consumers identify the mark with a specific brand rather than the general product or service. This requires evidence of substantial market use and consumer recognition. The Delhi High Court observed that even if the words "AAJ TAK" are descriptive in nature and even if they have a dictionary meaning, together it is still coined word of the plaintiff and has acquired a secondary meaning by virtue of prior, continuous and extensive use and therefore the combination of the two words "AAJ TAK" cannot be used by any other user.
- **Distinctiveness in Context:** A descriptive mark may also be registered if it is distinctive in a particular market or sector. If the mark has become distinctive within a particular geographic area or sector, it could be considered non-descriptive for that market. However, this is a more niche condition and will need to be assessed on a case-by-case basis.

Conclusion:

So, Brand gurus must know that while the belief that trademarks should be descriptive is a common public misconception, such marks often fail to meet the legal and market requirements for distinctiveness. For sustained success, businesses should focus on creating unique, coined, and legally strong trademarks that ensure strong brand protection and recognition in today's competitive market.

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