

Law Relating to Trademarks

Part-3



Absolute Grounds for Refusal of Registration

Section 9(1) of the Act containing provisions relating to absolute grounds for refusal for registration prohibit the registration of those trademarks

(a) Lack of Distinctive Character

which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person;

(b) Descriptive Marks

which consist exclusively of marks 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;

(c) Customary 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: Provided 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 mark.

However, a trademark shall not be refused registration, if the mark has in fact acquired a distinctive character as a result of use or is a well-known trade mark before the date of application. In short, **a trade mark which has been demonstrated to be distinctive in the market place shall be regarded as distinctive in law as well and be registerable.**

Additional Grounds for Refusal

According to Section 9(2) the following trademark shall not be registered:

1. Deceptive or Confusing

If the trademark tends to deceive the public or cause any confusion;

2. Religious Sentiments

In any instance if the trademark hurts any religious sentiment of any demographic section of Indian citizens;

3. Scandalous Matter

It comprises or contains scandalous or obscene matter;

4. Prohibited Use

Its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.

Shape of Goods - Section 9(3)

Section 9(3) prohibits registration of a mark, if it consists exclusively of shape

of goods which result from the nature of the goods themselves or which is necessary to obtain a technical result or which gives substantial value to the goods.

- It is, however, explained that the nature of goods or services in relation to which the Trade Mark is used or proposed to be used shall not be a ground for refusal of registration.



Case Study: Himalaya Drug Company vs. S.B.L. Ltd.

2013(53)PTC 1 (Del.)(DB)

Background

In the case of Himalaya Drug Company vs. S.B.L. Ltd. 2013 (53) PTC 1 (Del.) (DB): the Appellant had filed a suit against the Respondent for infringement of trade mark "Liv.52" by use of the trade mark "Liv-T".

The lower court dismissed the suit of the Appellants holding that the mark 'LIV' is publici juris and there is no similarity between the two trademarks. 'Liv' will be considered as the generic on account of the fact that it is used in respect of medicine used for treatment of ailment of 'Liver' and non-distinctive part of the mark and it is to be ignored even if the two rival marks are to be taken as a whole.

The Defendant could not prove by way of its evidence that the word 'LIV' is generic. The Plaintiff on the other hand proved the distinctiveness of its mark by way of its evidence by providing the orders where the mark 'LIV.52' has been granted protection. The court also noted that consumer asked for Plaintiff's product as Liv.52 thus 'LIV' was the essential and prominent feature of the mark 'LIV.52' and restrained the Defendant from using the mark 'LIV-T' and the Court allowed the Defendant to amend its mark accordingly to a mark which will not be similar to the mark of the Plaintiff.

High Court Decision

The Plaintiffs filed an appeal before the High Court of Delhi, whereby the High Court reversed the finding of the lower court and upheld the principles of Trade Mark law of comparison and infringement. The court held that **the onus of proving that the term 'LIV' has become generic lied heavily on the Defendant,** more so in the light of the fact that the Trade Mark of the Plaintiff had voluminous sales, was being used since the year 1955 and was registered since the year 1957 and as seven years had expired from the date of the registration, the Registration of the trade mark the trade mark was taken to be valid as per Section 32 of the erstwhile Trade Marks Act, 1958.

Case Study: Amritpal Singh vs. Lal Babu Priyadarshi

2005 (30) PTC 94, Intellectual Property Appellate Board (IPAB)

In the case of Amritpal Singh vs. Lal Babu Priyadarshi , 2005 (30) PTC 94, Intellectual Property Appellate Board (IPAB) the word RAMAYAN was refused registration on the grounds that:

1

First Ground

Firstly, it was not capable of distinguishing the goods of the applicant

2

Second Ground

Secondly, that it was likely to hurt religious sentiments of a class of society.

Further, Intellectual Property Appellate Board referred the case Registrar of Trade Marks v. Ashok Chandra Rakhit Ltd., AIR 1955 SC 555 where in the Hon'ble Supreme Court in his order inter alia observed: "(4) It appears that subsequently the Registrar found that the word "Shree" was used by Hindus as an auspicious symbol and placed even on letter heads and that consequently it was not adapted to distinguish within the meaning of the Act.

In course of time, therefore, a practice became established in the Registry whereby the word "Shree" was either refused registration as a trade mark or a disclaimer was enforced if it were made a part of a trade mark. So inflexible had been this practice that barring this particular trade mark No. 3815 there was no other trade mark containing the word "Shree" which had been registered without a disclaimer of the word "Shree".

Naturally this circumstance was bound to be regarded as an invidious discrimination and, indeed, pointed reference is said to have been made to it and it was suggested that the Registry should deal impartially and uniformly with all applications in matters relating to practice."



Limitation as to Colour

Section 10 provides that a trade mark may be limited wholly or in part to any combination of colours and any such limitation shall be taken into consideration by the Registrar or the High Court, as the case may be, having to decide on the distinctive character of the trade mark.

- ❑ **So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.**

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