


Intellectual Property
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Lecture - 19
What can be protected?

What may be protected?

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Subject Matter

- It should conform to the definition of trade mark under the Act
- Particularly, prove 3 conditions
 - A sign/mark
 - Capable of being represented graphically
 - Capacity to distinguish

The subject matter of trademarks can fall into what has been already provided under the trademarks act. First, it should conform to the definition of trade mark under the act and it should satisfy the 3 conditions provided in the definition. One, it should pertain to a sign or a mark; 2, it should be capable of being represented graphically, as we had already mentioned the mark should be capable of being shown on, paper the it has to be 2 dimensional. 3, it should have the capacity to distinguish goods and services.

So, the fact that it should pertain to a sign or a mark, it should be represented graphically and it should be able to distinguish the products and services from that of a competitor.

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A Sign or Mark

- Concept of sign is broad, but not without limits
- *“Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof*

The concept of a sign is too broad, but it is not without limits. The act defines a mark as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. So, mark has a quite a wide definition under the act.

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A Sign or Mark

- Limits on registration of shapes
 - Shape results from nature of goods themselves
 - Shape necessary to obtain technical result
 - Shape gives substantial value to goods


The limits on registration of shapes are also mentioned in the act. For instance, you cannot have a mark which is a shape that results from the nature of goods themselves. For instance, it will be hard for somebody to sell mango juice in a package with is which

looks like a, which shaped like a mango. There was a case involving a lemon juice which was sold in a packaging that look like a lemon. This case was in the United Kingdom the Jeff lemon case.

So, you cannot have property rights on shapes; where the shape signifies the shape of the nature of the goods themselves. So, you cannot sell mango juice in a mango shaped container. 2, you cannot have registration of shapes that are necessary to obtain technical result. Sport shoes are shaped aerodynamically so that they can cut the drag coefficient. And it is necessary for shoes to be shaped in a way in which they can cut the drag.

So, you cannot have a registration of a shape as a mark which is essentially to which is common for footwear. 3, shape gives substantial value to the goods. When a shape gives a substantial value to the good, then that shape cannot be a subject matter of a mark. For instance, all bottles are shaped in a way to contain fluids and which have a narrow opening so that the flow of the liquid is controlled while pouring. So, this shape which is common to all bottles cannot be the subject matter of a mark. So, these are limits to the registration of shapes.

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Graphical Representation

- The mark should be capable of being graphically represented
 - Representation of sign
 - Words marks are written, figurative marks by pictures
 - Representation of unconventional marks can be problematic

The mark should be capable of being graphically represented, and by graphical representation we refer to the representation of this of a sign. Word marks are represented in writing; figurative marks are shown by pictures.

Representation of unconventional marks can be problematic. We had seen in the case of sound marks, and in the case of taste marks and smell marks, because of the nature in which they are perceived, it becomes hard to graphically represent these marks. Unconventional marks like sound mark, smell marks and taste marks cannot be registered under the Indian trademarks act.

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Distinctive Character

- Capable of distinguishing the goods and services of one undertaking from the goods and services of other
- Distinctiveness Hierarchy
 - Arbitrary/Fanciful/suggestive
 - Google/Apple/SugarFree


Trademarks need to be distinctive, they should be capable of distinguishing the goods and services of one undertaking from the goods and services of another.

The distinctiveness can be of different types. The distinctiveness can be arbitrary; for instance, Google is an arbitrary word, it is a word which does not have any meaning. So, the distinctiveness of the word Google came by repeated usage over a period of time. The distinctiveness can also be fanciful, enterprise may choose a trade mark of a word which is entirely unconnected with its business; for instance, the company Apple Inc chose Apple as its trade mark for selling software and hardware products relating to computers.

So, that is a fanciful term which has acquired distinctness over a period of time. Distinctiveness can also be suggestive; for instance, the trade mark Sugar Free and there was a case in India pertaining to this mark means the product is free of sugar. But this trade mark is used for sweetness, and sweetness like sucralose, aspartame and stevia are

all sold by this company which markets itself as sugar free. So, sugar free is a suggestive mark, but it has attained distinctiveness by usage for a long period of time.

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Secondary Meaning

- Acquired Secondary meaning
 - Consumers recognize mark as a source of indicator
 - Primary significance of the term in the minds of the consuming public is not the product but the producer

Marks over a period of time also get secondary meaning. Secondary meaning is acquired when the customers recognize a mark as a source of indicator. Primary significance of the term in the minds of the consuming public is not the product, but the producer. For instance, there has been cases where it has been argued that the word metro which is a short form for metropolis or metropolitan has been used in various distinct industries. Like metro has been used for hotels, metro has been used for hospitals, metro has been used for selling footwear. So, when an existing marks is used, the use the people who use the mark, the owners of the mark would argue that the mark has acquired a secondary meaning over a period of time.

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Distinctive Character

- Distinctiveness Hierarchy
 - Suggestive
 - Suggest the quality of a good or service, eg. Citibank
 - Descriptive
 - Describes characteristics of product, eg. Coca-Cola
 - Generic
 - Common term used, eg. Xerox

The distinctive character can come from different means. The distinctive character can come from a suggestion what we call it can be suggestive. It can suggest the quality of a good or a service; for instance, Citibank it suggests that it is city based it is based in a city and it does the function of a bank. But together Citibank is a unique word which gives distinct which has distinctiveness.

The distinctiveness can also come out of a description, what we call descriptive; for instance, Coca Cola describes the product, the product being cola. So, the descriptive character of the product can be a part of the name provided it has a distinctive character. The distinctiveness can also become generic over a period of time.

For instance, Xerox though it is a trade mark is commonly used to understand photocopies. Thermos though it is a trade mark is commonly used to understand flasks.

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What Can't be a Trade Mark?

- Functionality
 - Marks cannot be protected if functional
- Disparaging
 - Detrimental to mark's distinctive character and against reputation of the TM
- Immoral or scandalous

What cannot be trade mark? Something which is which did denotes a function or which covers a functionality cannot be the subject matter of a trade mark. Marks cannot be protected if they are functional. A footwear has to be shaped like the human foot you cannot have the shape of a footwear as a trade mark, because it is function is tied to it is use.

Marks that are disparaging cannot qualify as a trade mark. Disparaging marks will not be granted protection. Marks that are detrimental to the distinctive character of an existing mark and against the repetition of a trade mark will not be granted protection. It cannot be a subject matter of a trade mark. Marks that are immoral and scandalous will not be offered protection under the trade mark law.

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What Can't be a Trade Mark?

- Deceptive similarity
 - Marks misdescribes the goods attached to it
- Conflicts with existing Marks
 - Cause confusion with existing marks
 - Cause dilution of existing known marks
- Fraud
 - Knowingly makes false representation

Marks that lead to deceptive similarity, marks which misdescribes the goods attached to it will not be granted trade mark. Marks which conflict with existing marks which is which can cause confusion with existing marks or cause dilution of existing known marks will not be granted protection. And marks that make a fraudulent representation or a false representation will not be granted trade mark.

For instance, somebody comes up with a medicine and calls it cancer cure and wants to get a mark for the word cancer cure. That will not be granted a protection as it amounts to false representation.

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Well-Known Marks



- *“..means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.”*

The act also introduces the concept of well-known marks; a well-known mark means a mark which has become so to the substantial segment of the public; which uses such goods or receive such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade. Or rendering of services between those goods or services, and a person using the mark in relation to the first mention goods or services.

We have seen that some conglomerates like, TATA are regarded as well-known marks. So, regardless of which feel they are, a user may get an impression that this company TATA has now entered a segment or a course of business which they would relate to coming from the house of TATAs. So, the test here is that it should be known to the substantial segment of the public which uses the goods or services. That such services would likely be taken as indicating a connection in the course of trade.