



# Jus Corpus Law Journal

Open Access Law Journal – Copyright © 2022 – ISSN 2582-7820  
Editor-in-Chief – Prof. (Dr.) Rhishikesh Dave; Publisher – Ayush Pandey

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## Different Spectrum of Trademark distinctiveness

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Received 28 July 2022; Accepted 27 August 2022; Published 30 August 2022

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*Human beings are naturally predisposed to trusting that which they can recognize, that which they can recall, and that which they can relate with. Businesses run on trust, and visual and auditory cues such as signs, symbols, and jingles are one of the quickest ways to gain brand recognition, and consecutively get more business.*

*For example,*

- 1) *50% of consumers are more inclined to make purchases from a brand whose logo they know.*
- 2) *75% of people brands by their logos.*
- 3) *55% of a first impression is made because of visual cues such as logo or brand colours.*

*As we can see, logos and brand names are extremely useful business assets to build goodwill and brand recognition and like any other business asset, its ownership must be legally protected. Trademarks are the legal mechanism that ensures the sanctity of a business' value generating creative property such as signs, symbols, jingles, mottos, brand names, etc. For recognition, it should be distinctive from that of others. Through this article, we aim to understand the legal framework surrounding trademarks and how trademark law can be distinguished. We also endeavour to critically analyse the distinctiveness of trademarks in various ways we can differentiate that and what are the spectrum of distinctiveness.*

**Keywords:** *distinctive, mark, trademark, distinguish, spectrum*

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## INTRODUCTION

Something which distinguishes you as a provider of goods or services is a trademark. To do that, it must be distinctive. It must be unique in order to do that. Not every brand is made equally. Depending on where your brand falls on the distinctiveness spectrum, certain brands are intrinsically stronger than others. Your trademark will be given greater protection the more unique it is. A brand can often be recognized just by looking at it. Would it take you a long time to identify Nike sneakers or a Starbucks coffee? They are easily recognizable just by looking at them. Alternatively, we can recognize them by their logo, attractive graphics which are eye-catching, or taglines.

## HOW CAN A MARK BE DISTINCTIVE?

What does the term "distinctive mark" mean? A generic term cannot be distinctive, but the word or mark you use must be able to set you apart from other companies that sell the same thing. While some words will be completely indistinguishable, others will stand out greatly. The distinctiveness of a trademark will determine its ability to be protected. Protect the ability of highly distinctive marks is greater than that of less distinctive marks. It's crucial that you determine the mark's position on the spectrum. We refer to the range of distinctiveness on the spectrum of trademarks as weak to strong marks. The word "ORANGE" on an orange would be an illustration of a generic mark. If it were for ice cream, it would be suggestive, and if it were for a car, it would be arbitrary. Being distinctive means having that inherent ability to set your goods and services apart from those of similar providers. As a result, we are unable to record the indications that indicate the goods or services that need to be differentiated. Consider the mark "diet ice cream," for instance. The company sells items like ice cream, cold beverages, shakes, etc. First off, in this mark, the terms "ice cream" and "diet" refer to the product itself and the number of calories it has. As a result, we are unable to register it under trademark legislation.

Parts A and B of the 1958 Act<sup>1</sup> are included in the 1999 Act.<sup>2</sup> The 1999 Act allows us to register trademarks if their existence is unique.<sup>3</sup>

## CASE LAWS OF DISTINCTIVENESS

It was determined in *W.N. Sharpe Ltd. v Solomon Bros Ltd.*<sup>4</sup> that terms like "good," "best," and "superfine" could not be adopted since they could not acquire secondary meaning and could not be registered.<sup>5</sup> According to the court in *Cluett Peabody & Co. Inc. v Arrow Apparels*,<sup>6</sup> the mark must be unique. The buyer must be able to see where the items came from. The products were not distinguished by terms like "Best," "Superior," etc. They couldn't be trademarks since they were simply descriptive.<sup>7</sup> A key idea in the law that governs trademarks and service marks is trademark uniqueness. The issue of whether the trademark "EASY.COM" was descriptive was raised in the *Easynet Group Plc v Easygroup IP Licensing Ltd.* case<sup>8</sup>. It was decided that the best course of action is to consider the mark as a whole and determine if the mark is overall descriptive. During that process, it is acceptable to keep in mind how descriptive each of the mark's individual components is, but ultimately, the whole evaluation is what counts.<sup>9</sup> It was decided that the best course of action is to consider the mark as a whole and determine if the mark is overall descriptive. During that process, it is acceptable to keep in mind how descriptive each of the mark's individual components is, but ultimately, the whole evaluation is what counts. A common descriptive term can acquire a secondary distinctive meaning via use in relation to the products, as demonstrated by a number of decided cases.<sup>10</sup>

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<sup>1</sup> Trade & Merchandise Marks Act 1958

<sup>2</sup> Trade Marks Act 1999

<sup>3</sup> *Ibid*

<sup>4</sup> *W N Sharpe Ltd v Solomon Bros Ltd* (1915) RPC 15

<sup>5</sup> *Ibid*

<sup>6</sup> *Cluett Peabody & Co Inc v Arrow Apparels* 1998 (18) PTC 156 (Bom)

<sup>7</sup> *Ibid*

<sup>8</sup> *Easynet Group Plc v Easygroup IP Licensing Ltd* 2006] EWHC 1872 (Pat)

<sup>9</sup> *Ibid*

<sup>10</sup> Sana Singh, 'India: Trademark Law In India - Types Of Trademarks, Registration Procedure And Acquired Distinctiveness Of Generic Words' (*Mondaq*, 28 September 2021)

<<https://www.mondaq.com/india/trademark/1115666/trademark-law-in-india-types-of-trademarks-registration-procedure-and-acquired-distinctiveness-of-generic-words>> accessed 25 July 2022

However,<sup>11</sup> it may be quite challenging to prove that a term has actually become unique and has developed a secondary meaning separate from its original meaning. When the mark includes the product name in addition to being descriptive, such as Diabolo for a top or shredded wheat, the challenge is exacerbated. If the purported trademark is actually a product description, but the general public perceives it as a fancy term rather than a descriptive phrase, then this challenge could occasionally be overcome.

## **SPECTRUM OF DISTINCTIVENESS**

Trademark distinctiveness is classified on a scale from lower to greater in terms of uniqueness. They follow the system of hierarchy. It should be able to differentiate between the products or services provided by one individual and those provided by another.

### **Generic Trademark**

This is the brand's weakest form. Most of the time, it isn't even a brand. It's merely a general name that everyone uses to refer to a specific item or service that they provide. Generic brands are not allowed to be trademarked since, if you were to be granted a monopoly over them, no one else would be able to market variations of the same goods or services because they would have to stop referring to them as such. You cannot trademark the word "diamonds" if you are selling diamonds, for instance. If you sell ice cream, you cannot trademark the word "ice cream" and so on. Some brands, when they start, are regular brands and then become generic through use. They experienced genericide because they are a part of our everyday vocabulary and were previously distinctive brands for the creative things they provided. For instance, the word "escalator" was a trademark of the Otis Elevator Corporation until it became a generic term as a result of its own success. Similar circumstances apply to Xerox, Dalda, and the App Store, where what was formerly a brand name has been changed to relate to the actual product.

Generic trademarks cannot be registered under the Trademark Act of 1999's Section 9(1)(b).<sup>12</sup> Section 32 of the Act does, however, make an exception, stating that "Where a trade mark is

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<sup>11</sup> *Ibid*

<sup>12</sup> Trade Marks Act 1999, s 9(1)(b)

registered in breach of sub-section (1) of section 9<sup>13</sup>, it shall not be declared invalid if, as a result of the use which has been made of it, it has after registration and before the 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."<sup>14</sup>

In order to register a generic trademark,<sup>15</sup> the owner must satisfy the examiner that the mark in issue has acquired secondary importance or novelty<sup>16</sup> and needs to be protected under Section 32 of the Act<sup>17</sup>. One product category could permit generic language while another would not. For instance, the name "Apple" refers to fruits in general, not smartphones. *Mr. A.D. Padmasingh Isaac and M/s Aachi Masala Foods (P) Ltd v Aachi Cargo Channels Private Limited*<sup>18</sup> was a case that the petitioner filed against the respondent for using the word "Aachi" in violation of the petitioner's trademark. As "Aachi," which in Tamil means "grandmother," is of broad usage and cannot be monopolized by Aachi Masala Food alone," the Madras High Court rejected the complaint. The owner has been successful in securing trademark protection for a composite generic mark that combines a generic word with additional words.<sup>19</sup> However, the owners' attempts to assert exclusivity with respect to generic expressions in their composite marks have usually failed. Due to the fact that it would provide one company with an unfair competitive advantage over all others, granting one company exclusive rights to use a common term in their trademark would also be against the natural justice principle.<sup>20</sup>

### **Descriptive Mark**

The common name for the item or service is no longer used in descriptive marks, which elevates them beyond generic ones. However, they utilize terms that have no purpose other than to precisely define the quality or attribute of their item or service. For instance, you cannot

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<sup>13</sup> Trade Marks Act 1999, s 9(1)

<sup>14</sup> Trade Marks Act 1999, s 32

<sup>15</sup> Sana Singh (n 10)

<sup>16</sup> *Ibid*

<sup>17</sup> Trade Marks Act 1999, s 32

<sup>18</sup> *Mr. A D Padmasingh Isaac v Aachi Cargo Channels Pvt Ltd* AIR 2014 Mad 2

<sup>19</sup> *Ibid*

<sup>20</sup> Sana Singh (n 10)

trademark the terms "sunblock" if you sell sunscreen, or "breezy" if you sell air conditioners. Monopoly over descriptive trademarks is prohibited since no one else could offer items and services with the same features or characteristics if they didn't cease using the common names for those qualities and characteristics. In accordance with section 9(1)(b) of the Trade Marks Act,<sup>21</sup> 1999, descriptive marks cannot be registered.<sup>22</sup>

According to Section 32 of the Act,<sup>23</sup> there is an exemption to this "absolute restriction" for descriptive marks that, through use, have acquired distinctiveness, a secondary meaning, or are well-known marks prior to the date of application for registration. A number of well-known companies have also been successful in acquiring uniqueness with their Identifiers.<sup>24</sup> For instance, Coca-Cola, which contains ingredients derived from coca leaves, Kentucky Fried Chicken (KFC). According to the Supreme Court's ruling in *Godfrey Philips India Limited v Girnar Food & Beverages (P) Ltd.*<sup>25</sup> (2005)6, a descriptive trademark may qualify for protection if it has acquired a secondary meaning and is connected to a particular product or source.<sup>26</sup>

### **Suggestive Mark**

This kind of mark does not entirely describe the item or service it stands for, but it does imply certain qualities. It asks customers to use their imagination to recognize the good or service the brand is being used for.<sup>27</sup> These marks, including Airbus, the iPhone, and redBus, are considered to be registerable, although they are not as strong as fanciful or arbitrary marks owing to the chance that they may not be sufficiently unique.

### **Arbitrary Marks**

These are dictionary terms that are used to identify goods and services that are unrelated to the authors' works. The name "Apple" as in the computer, phone, and software company is the most

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<sup>21</sup> Trade Marks Act 1999, s 9(1)(b)

<sup>22</sup> *Ibid*

<sup>23</sup> Trade Marks Act 1999, s 32

<sup>24</sup> *Ibid*

<sup>25</sup> *Godfrey Phillips India Ltd v Girnar Food & Beverages Pvt Ltd SLP (C) No 21531 of 1997*

<sup>26</sup> *Ibid*

<sup>27</sup> *Ibid*

well-known example. The name "apple" refers to a fleshy, often spherical, red, yellow, or green edible pome fruit that is part of the rose family. However, Apple is not in the business of selling apples as its goods and services. Apple is a random brand. Dove, a brand of personal care products, for instance, has nothing to do with birds and in the dictionary means a white or grey bird, which is frequently used as a symbol of peace. Each of these terms has a distinct meaning that isn't related to their trademarks. Nothing inherently identifies, even hints, quality, or other features of the offered goods or services. To be registered as an arbitrary trademark, this is required.

### **Fanciful Marks**

These trademarks are generated terms or invented marks that serve only to designate particular goods or services. Outside of being a firm that creates and produces shoes, apparel, and accessories, Adidas implies nothing. Kodak is only known as a brand associated with photography. Because of their uniqueness, fanciful markings are considered to be one of the strongest types of trademarks, if not the strongest. They only discuss the products or services that they are applied to.<sup>28</sup> Using a fanciful trademark gives you the best chance of winning a trademark infringement action or effectively settling a cybersquatting problem.<sup>29</sup> The disadvantage of a fanciful mark is that it could take some time for customers to identify it with the kind of items and/or services you are trying to offer.

### **ANALYSIS**

The competent authority must evaluate all of the evidence that the mark has evolved to identify the goods in question as coming from a certain source when deciding whether a mark has developed a unique character as a result of long-term, consistent usage.<sup>30</sup> The following should be considered when determining a mark's unique character for which registration has indeed been requested.<sup>31</sup> The market share that the brand commands how extensively, regionally,

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<sup>28</sup> DRM, 'Trademarks: The Spectrum of Distinctiveness' (*DRM*, 18 April 2016) <<https://www.drm.com/articles/trademarks-the-spectrum-of-distinctiveness/>> accessed 25 July 2022

<sup>29</sup> *Ibid*

<sup>30</sup> Sana Singh (n 10)

<sup>31</sup> *Ibid*

widely, and for how long the mark has been used, the sum spent by the venture to promote the market, the percentage of the relevant class of people who say the items came from a certain enterprise, as well as statements from other trade and commerce organizations.

## CONCLUSION

The majority of marks fall somewhere between suggestive, random, and fantastical. They might not be entirely random or fanciful. The spectrum of uniqueness is a great tool to have when coming up with names for your company or trademarks for your product brands. Fanciful, arbitrary, and suggestive marks—also referred to as "inherently distinctive" marks—are frequently registrable on Principal Register even in the absence of proof of secondary importance. The closer you are to a unique or coined mark, the higher your rights are and the more probable it is that your trademark will be registered. The weaker your rights are and the more challenges you'll have in registering your mark, the closer you are to the generic side.