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DESCRIPTIVE TRADEMARKS: EASY TO MARKET, TOUGH TO PROTECT



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A 'descriptive trademark' is one that identifies a characteristic, quality, purpose or some other aspect of a product or service. For instance, the words 'apple' for fruits and 'all bran' for cereals would be considered descriptive in nature. As a general rule, such words do not qualify for trademark registration and an objection can be raised by the registrar if he is of the view that the mark applied for registration falls into this category. However, such an objection may be overcome by establishing that the mark has acquired a distinctive character by virtue of its use or that it is a well-known mark.

Descriptive trademarks are often preferred by the marketing teams of companies as they communicate product associations to consumers. Nonetheless, the Indian courts have now made it clear that such marks, even if registered, may be considered invalid. In *Marico Limited v Agro Tech Foods Limited*, it was contended by Marico, owner of the registered marks 'Lo-sorb' and 'Losorb', that Agro Tech's use of the tagline 'with low absorb technology' was tantamount to infringement/passing-off. The goods in this case were identical—edible oil containing an anti-foaming agent by which less oil was consumed while cooking.

The court observed that the registration of the trademarks 'Losorb' and 'Lo-sorb' was *prima facie* invalid as they are only a minor variation of the descriptive expression 'low absorb' and no evidence of distinctiveness existed as the marks were sought to be registered on a 'proposed to be used' basis.

It was also observed that use for just seven years is not enough to grant monopoly over the terms. And since the marks were used along with other trademarks such as 'Sweekar' and 'Saffola', it would be a moot point, to be decided after trial, as to what extent of sales could be attributable to these marks. The court thus held that an action for infringement/passing-off was not applicable and declined to grant an interim injunction.

The Division Bench of the Delhi High Court laid down the following guidelines:

- A trademark that is devoid of distinctive character cannot/ought not to be registered if filed on a 'proposed to be used' basis.
- In order to get protection on account of acquired distinctiveness, a descriptive trademark must establish undisturbed use over a long period of time.
- In an infringement action, the court can look into the validity of a registration for the purpose of passing an interlocutory order once the objection as to invalidity of registration is taken up in the pleading/written statement.
- In an infringement action, the court is entitled to consider the evidence of distinctiveness up to the date of grant of registration for the purpose of

"THE COURTS ARE LEANING AWAY FROM GRANTING PROTECTION TO DESCRIPTIVE MARKS, EVEN IF REGISTERED. THE LEVEL OF PROTECTION AFFORDED TO SUCH MARKS IS LOW AND THE MESSAGE TO THE TRADEMARK OWNERS IS LOUD AND CLEAR THAT IF YOU WISH TO REGISTER DESCRIPTIVE MARKS, DO SO AT YOUR OWN RISK."

passing any interlocutory order, but not evidence showing distinctiveness post registration.

- Even if a mark has obtained finality to its registration, the defendant can take statutory defences such as fair use, use in a descriptive sense, etc. to defeat an infringement action.

The *Marico* case relied heavily on the judgment of the Supreme Court in the *Cadila Healthcare* case. In this case, the court held that the mark 'Sugar Free' with respect to artificial sweeteners was descriptive in nature and would not be afforded protection so that it could restrain others from using the term as part of their descriptive phrases.

In another recent case, the court held that the use of the tagline 'Rehydrates Fluids; Replenishes Vital Salts; Recharges Glucose' along with the mark 'Glucon-D Isotonik' does not infringe Gatorade's registered mark 'Rehydrate Replenish Refuel'.

It is abundantly clear from the above judgments that the courts are leaning away from granting protection to descriptive marks, even if registered. The level of protection afforded to such marks is low and the message to the trademark owners is loud and clear that if you wish to register descriptive marks, do so at your own risk.

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