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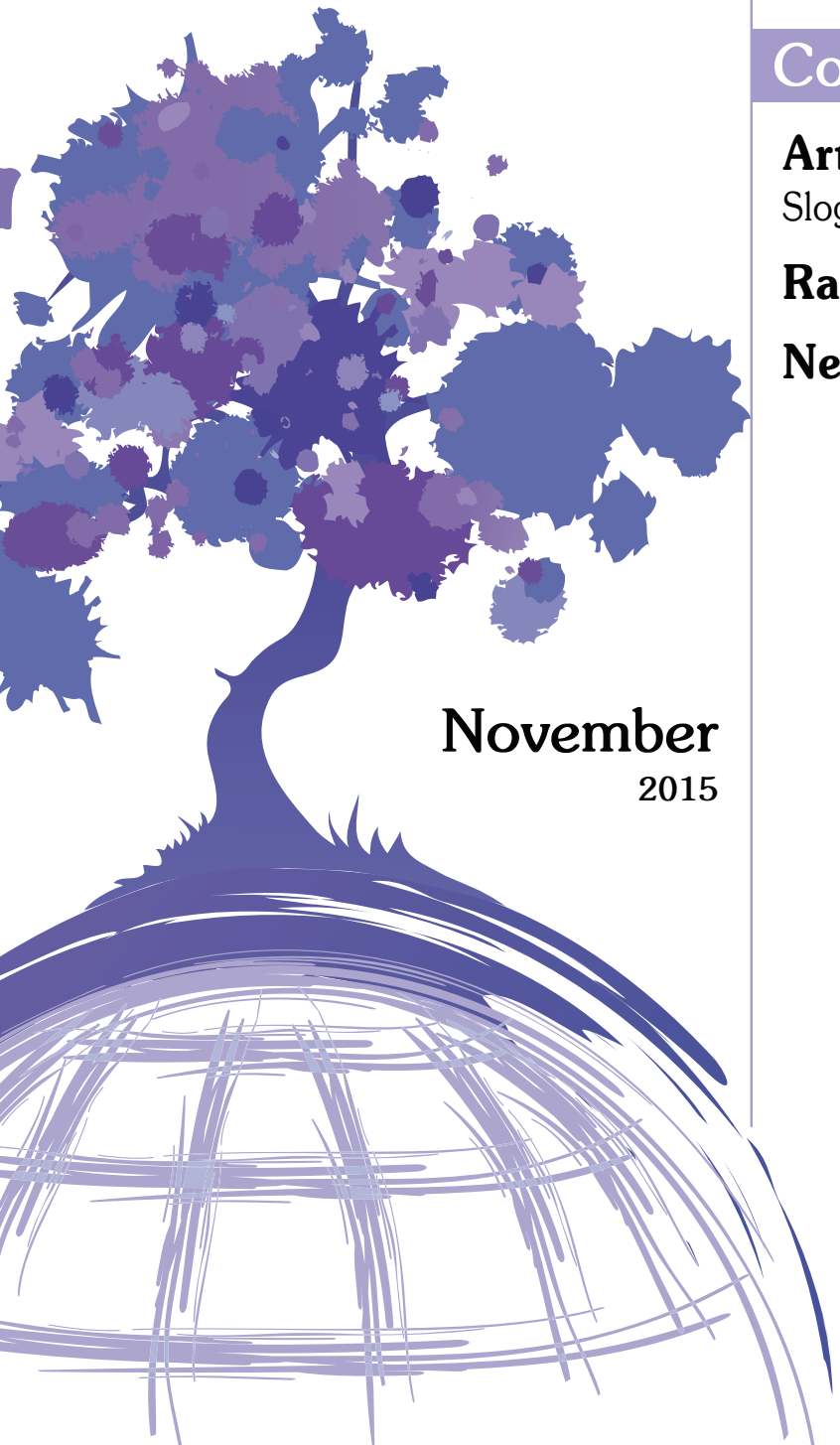

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Article

Slogans - An issue of descriptiveness

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Getting trademark protection for slogans is often accompanied by one particular hurdle of retaining exclusivity, which results from their descriptive nature. A slogan is generally a combination of common words which describes the goods or services, or glorifies the goods and/or services of the company. Due to its descriptive or laudatory nature, it can be difficult for slogan marks to pass the distinctiveness test or act as a source identifier. Therefore, slogans can be refused registration unless they have acquired secondary meaning through use. Due to extensive advertising, particularly through various modes of electronic and social media which spreads the information rapidly and widely, marks can acquire distinctiveness way too quickly. Descriptive marks can acquire secondary meaning in a far shorter time than was previously the case when only conventional media was available to disseminate information about goods and services.

The Trade Marks Registry in the Draft Trade Marks Manual, 2009 had given guidelines accompanied by several illustrations in order to explain what kind of slogans may be allowed to be registered.

Factors which are considered by the Registry while mulling over the question of descriptiveness are as follows:

- *Ambiguity:* Where there are two or more possible meanings fora sentence/ phrase and one of them is descriptive, the registry will generally not allow registration of such trademarks (slogan) e.g. we set hire standards (for car rental service) is likely to be refused.
- *Value/Inspirational/Motivational Statements:* Slogans which express values in general (not dependent on class or type of goods/service) or slogans which are motivational and/or inspiration with reference to the good and services being offered under it, are not capable of being registered, for e.g. 'we care for the planet' is not likely to be registered on account of expressing values, 'it's never too late' for distance educational services would be motivational and therefore not registrable.
- *Customer service statements:* Slogans which are aimed at customer service, customer's experience are too broad and applicable to most classes and shall therefore cause confusion and are not registrable.
- *Purely promotional statements:* Slogans whose function is purely promotional such as, "celebrate this Diwali with diamonds."

However, it is worth noting that the abovementioned guidelines are missing from the new draft Manual of Trade Marks, 2015.

Even in the absence of said guidelines, one may rely on judicial pronouncements where it has been noted that if a slogan has acquired secondary character, then it may be allowed to proceed for registration. In *Reebok India Company* v. *Gomzi Active*[1] the Karnataka High Court held that a person claiming the benefit of distinctive usage must establish that its slogan has developed secondary meaning and goodwill. The court considered whether the slogan "I am what I am" had acquired distinctive character as a result of Gomzi's use. It accepted Reebok's contention that, as the slogan was a generic phrase, it had not acquired distinctive character in relation to Gomzi's goods. In setting aside the temporary injunction issued by the trial court, the High Court observed that there was no evidence to infer a likelihood of confusion among consumers, as the registered trademarks of the two parties were totally different and mere use of the common words 'I am what I am' would not mislead consumers.

In *Stokely Van Camp Inc* v. *Heinz India Pvt Ltd*[2] the division bench of the High Court of Delhi considered the issue of use of slogan in relation to energy drinks. The plaintiff was using its registered slogan "Rehydrate Replenish Refuel" in conjunction with the trademark GATORADE. The defendant was using the expression "Rehydrates fluids; replenishes vital salts; recharges glucose" in relation to an energy drink launched in the year 2010 called Glucon D Isotonik. The Court held that in the sports and energy drink market, words or expressions which are akin to the plaintiff's slogan mark are not only common, but perhaps necessary in order to describe the characteristics or attributes of such products. Therefore, notwithstanding the fact that a party has obtained registration, if a registered slogan mark or similar expression is used to describe the characteristics of a product within the meaning of Section 30(2)(a) of the Trademarks Act, the user is not guilty of infringement.

It is clear from foregoing discussion that in order for a slogan to be protected as a registered trademark and enforced, it ought to be non descriptive and in case it is descriptive, it ought to have acquired distinctiveness and should not consist of word and/or phrases common to the trade.

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[1] 2007 (34) PTC 164 (Karnataka)
[2] 2012(52)PTC540(Del)

Ratio Decidendi

Copyright registration is not conclusive proof of authorship

Bombay High Court has rejected the argument that copyright registration is a conclusive proof of authorship. The Court in this regard noted that Section 48 of the Copyright Act says that the Register of Copyrights is *prima facie* evidence of the particulars entered in it, meaning thereby that there is only a presumption, *albeit* a strong one, nonetheless rebuttable about the correctness of the entries. It was held that Section 48 is not an acknowledgement of actual authorship being proved, but only of copyright having been applied for and granted.

On the validity of a suit filed by the plaintiff, the court was of the view that since the copyright was further assigned to another entity, it did not vest in the plaintiff and hence the suit was not maintainable. It was noted that the copyright was neither re-assigned back nor the contract for assignment was formally terminated. The plaintiff's contention that there was a reversion of the copyright assignment, when the entity to which the same was assigned dropped the project after learning about the same project of the defendant, was also rejected by the Court in this regard. [*Inception Media LLP* v. *Star India Pvt. Ltd.* - Notice of Motion (L) no. 2375/2015 in Suit (L) no. 886/2015, decided on 8-10-2015]

Registration under Press Act is no defence to infringement action under Trademarks Act

Bombay High Court has rejected the contention of the defendant that he is entitled to use and exploit his Press Act registration and that this does not constitute an infringing use of the plaintiffs' mark ('Indian Express' in this case). The defendant had contended that the use of words "Indian Express" written in *Devnagari* only as a title of publication and not in any other way is legitimate and permissible under the provisions of the Press Act, more so as the title registration to "Indian Express" in *Devnagari* under the Press Act was long before the plaintiffs obtained trade mark registration in *Devnagari*. The Court however observed that the trademark registration, though granted later, was granted from a period even prior to the registration under Press Act.

An earlier decision of the Karnataka High Court in the case of *Times Publishing House Ltd.* v. *The Financial Times Ltd.* was distinguished by the Court as it held that the Trademarks Act was also a special Act just like the Press Act. It noted that the Trade Marks Act, 1999 is wider than the 1958 Act, as it grants express protection to well-known marks that have a domestic reputation (in India), even where those marks relate to goods and services that differ from those of the infringer. Relying on Supreme Court Ruling in the case of *Cadila Health Care Ltd.* v. *Cadila Pharmaceuticals Ltd.*, the court was of the view that given the longevity of the plaintiffs' mark, its widespread use, daily production in very many centres across India, multiple editions, online presence, and large circulation the conclusion of being a well-known mark must necessarily follow. Restraining the defendant permanently, from

using the words, the Court observed that the plaintiff was entitled to protection not only under Section 29(4) of the Trademarks Act, but also under the Press Act inasmuch as nobody can lay claim to title registration of the contested words in any script under the latter Act.

It also noted that there is no law that reputation and goodwill in a trade mark are geographically constrained to the place of their registration or, in the case of a newspaper, to the place where it is printed. [*Indian Express Ltd.* v. *Chandra Prakash Shivhare* - Suit No. 2854/2010, decided on 23-10-2015]

Trademark registration of word 'Ramayan' not permissible

Upholding the decision rendered by the Intellectual Property Appellate Board (IPAB), the Supreme Court has held that names of holy or religious books cannot be claimed as trademark for goods or services. Ruling out the registration of the trademark, the Bench noted that though in the photographs, after adding 'OM's' to the word 'Ramayan', at the top and the sentence, 'Three Top Class Aromatic Fragrance', was also written, in between 'OM's and RAMAYAN', the appellant had not sought the registration of the word 'OM's RAMAYAN' as a trademark. Photographs of Lord Rama, Sita and Lakshman were also shown in the label, which the Court took as an indication that the appellant was taking advantage of the Gods and Goddesses which is otherwise not permitted. It was also held that the word has become public *juris* and common to the trade.

The Court was of the view that using exclusive name of the book 'Ramayan', for getting it registered as a trade mark for any commodity would not be permissible under the Act inasmuch as the word represents the title of a book written by Maharishi Valmiki and is considered to be a religious book of the Hindus. It was however noted that if any other word is added as suffix or prefix to the word 'Ramayan' and the alphabets or design or length of the words are same as of the word 'Ramayan' then the word 'Ramayan' may lose its significance as a religious book and it may be considered for registration as a trade mark. [*Lal Babu Priyadarshi* v. *Amritpal Singh* - Civil Appeal No. 2138/2006, dated 27-10-2015, Supreme Court]

News Nuggets

Indian patent office publishes draft Patent (Amendment) Rules

The Indian Patent Office published the draft Patent (Amendment) Rules 2015 on October 29. The draft Rules propose a number of changes to expedite the patent prosecution process in India. The time for putting an application in condition for grant following the issue of the First Examination Report (FER) has been reduced from twelve months to four months. A two month extension of time will be available upon

payment of a fee. The Controller has to dispose the application within six months of receiving a reply or the expiration of six months from the last date of putting the application in condition for grant. Another significant change proposed by the draft Rules is the introduction of expedited examination upon payment of fees of approximately USD 4000 for regular entities under specified circumstances. Any false representation made in order to expedite examination may cause revocation of the grant. Other proposed changes include changes to the content and format requirements for the abstract and the specification. Also, there is no discretion to grant extension in time for filing the Declaration of Inventorship, a request for expedited examination, payment of renewal fee, filing an application for review of an order of the Controller, or for setting aside an ex parte order passed by the Controller.

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