
ACQUIRED DISTINCTIVENESS AS CRITERIA FOR TRADEMARK PROTECTION

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Introduction

Trademarks are essential commercial identity tools that allow consumers to identify the source of goods and services in the market. Although distinctive marks *per se*, i.e. fanciful or arbitrary words, have instant protection, descriptive or indistinctive marks can only be registered if they have gained distinctiveness by use. Also referred to in common law as secondary meaning, this doctrine secures the marks that have, through usage over time, become closely identified with one trader and which deserve legal protection.

In India, the doctrine is enshrined in ‘Section 9(1) of the Trade Marks Act, 1999’, which prohibits registration of descriptive or generic marks unless they have “acquired a distinctive character.” The doctrine has numerous challenges. In contrast to the US or EU, where formal tests and survey proof are regularly employed¹, “Indian courts and the Trade Marks Registry” have not taken uniform standards of evidence on board. Applicants may be called upon to produce voluminous records of sales, advertising spend, and invoices, but such information is not necessarily confirmation of consumer association. Furthermore, globalization and e-commerce have added new dimensions, including trans-border reputation and online consumer recognition, that further complicate the evidentiary process.

This paper discusses acquired distinctiveness as a theory and as a practice. It discusses statutory law, reviews judicial interpretation in India and overseas, and outlines modern issues. Finally, it contends that the Indian regime needs more apparent evidentiary standards and international best practice harmonization in order to ensure that brand protection is weighed against the maintenance of public domain and fair competition.

¹ *Windsurfing Chiemsee Produktions v Boots* (1999) ETMR 585 (ECJ).

Research Question

1. What are the legal framework governing acquired distinctiveness in India, and how does it compare with international regimes such as US and EU Trademark Directives?
2. What evidentiary requirements are currently applied by Indian Courts and the Trade Mark Registry in proving acquired distinctiveness?
3. What risk arise from granting protection to descriptive or common terms under the doctrine?

Research Objective

1. To examine the statutory foundation of acquired distinctiveness under the Trademark Mark Act, 1999
2. To conduct a comparative study if Indian standards with those of the USEU and UK.
3. To evaluate the challenges and risk associated with the doctrine, including monopolization of descriptive words and evidentiary burdens.

Research Methodology

The study on “Acquired Distinctiveness as Criteria for Trademark Protection” adopts a qualitative doctrinal research methodology. Supplemented by a comparative approach, to analyse the concept, legal framework, and judicial interpretation of acquired distinctiveness in trademark law.

It involves an in-depth examination of statutory provisions, case law, and legal literature. The study aims to understand how acquired distinctiveness functions as a criterion for trademark protection and how courts interpret and apply this principle in practice. The research is analytical and exploratory, focusing on understanding the theoretical foundations, statutory provisions, and practical application of acquired distinctiveness in trademark registration. It also seeks to identify challenges faced by businesses in proving acquired distinctiveness before the registry and the courts.

The research intends to provide a comprehensive understanding of acquired distinctiveness as a criterion for trademark protection in India, highlighting its practical implications, judicial approach, and challenges faced by brand owners in establishing distinctiveness.

Understanding Trademark

A trademark is a name, term, or symbol that differentiates a company's products from those of other companies. Selling products or providing services becomes simpler with a trademark, as identifying a product with trademarks is assured and less challenging.

“A trademark isn't always a brand, but a brand is always a trademark”. At times, trademarks and brands are mixed up. A brand may be a symbol or logo, whereas a trademark serves as a unique sign or identifier in a business entity, encompassing broader implications than brands. Individuals are more influenced by the distinctive trademarks that signify the quality of the item. A trademark might also be a logo, image mark, or catchphrase.

‘A trademark is a property right, and the law protects that right’. Trademark law aims to align the interests of businesses and consumers. It primarily functions to prevent the consumer market from descending into monopoly. It additionally states that any company not entitled to a specific customer because of the trademark used by the rightful owner. It creates a vibrant market and prevents it from falling into the hands of deceptive companies. It prevents businesses from relying on the market foundation created by other entities by deceitfully using their trademarks and logos in their products.

Origin of Trademark Law in India

The origin of trademark law in India began under British rule. To regulate trade protection business goodwill, the ‘Trademark Act, 1940’ was enacted, model on the English law.

After Independence it was replaced by the ‘Trade and Merchandise Mark Act, 1958’, which widen protection and recognized and unregistered marks. With globalisation and India joining the WTO it became necessary to align with the ‘TRIPS Agreement (1995)’. This led to the Trade Mark Act, 1999, which continues to govern trademark today. The 1999 Act modernising the law by including service marks, shapes, packaging and even colours, bringing Indian trademark law closer to international standards.

Objective of Trade Mark Act, 1999

The ‘Preamble of the Act’ outlines the objective of trademark law in India. It states that “the legislation intent to consolidate the law relating to the registration and use of trademarks in the market. It further seeks to protect trademark owners and the damages they suffer from fraudulent usage of trademarks”².

‘In the landmark case of “*Laxmikant V Patel v. Chetanbhat Shah & Anr*,”³ the Hon’ble Supreme Court opined that the objective of the Trademark Act, id two-fold:

- To ensure honest and fair play in the market.
- To protect the owner of a trademark from any legal and financial injury that may cause by fraudulent and unauthorised use’.

Trademark Distinctiveness

The idea of trademark uniqueness may seem simple, but it actually includes a sophisticated understanding of how people view marks in connection to the products or services they represent. Since trademark categories group marks according to their innate capacity to differentiate one entity's goods from another, they are essential to this perception. Brand recognition is greatly influenced by these categories, which range from descriptive and general to arbitrary and fantastical. To be protected, a trademark needs to be recognizable and distinguishable. These products or services must be set apart from those of rivals. According to the basic criterion of distinctiveness, a distinguishing mark is both distinctive and protectable if it either:

- Inherently distinctive, or
- Has acquired distinctiveness through secondary meaning.

Inherent Distinctiveness

Inherent Distinctiveness is a building block in the trademark system that plays an important

² Trade Marks Act 1999, Preamble.

³ (2002) 3 SCC 65.

role in the legal protection and market power of a mark. Marks having inherent uniqueness are usually given greater legal rights because they have the characteristics that make them distinctive in a busy market. Inherent worth not only increases brand identity but also makes it easy to establish trademark rights. As opposed to marks that need heavy use in order to acquire acquired distinctiveness, inherently distinctive marks can be registered for protection, and brand owners receive the benefits promptly. This is critical in competitive markets where consumer perception is everything. Also, inherent distinctiveness strength may deter potential infringers because stronger marks are less likely to be confused with other marks. Therefore, recognizing the significance of inherent uniqueness is essential for firms looking to establish and sustain a strong brand presence in their respective markets.

In trademark law, inherently distinctive marks have certain properties that differentiate them from more common or descriptive names. Such marks tend to be fanciful, arbitrary, or suggestive, each possessing a strong identity. They create an aura of distinctiveness and allow for consumer recognition, thus becoming stronger in the market.

Acquired Distinctiveness

Acquired distinctiveness is a key concept in trademark law, as it permits marks that are not inherently distinctive to be given legal protection by virtue of use in commerce⁴. Several considerations, including duration and quality of use, consumer recognition, and advertising support, bear heavily on the creation of acquired distinctiveness. Analysis of salient examples can shed light on the real-world application of such principles and the strategic value of building consumer identification with specific marks.

“Acquired distinctiveness”, alternatively known as “secondary meaning,” may arise if an unregistered trademark gains distinctiveness. In particular, a descriptive term as a trademark can gain meaning over time through the manner in which the owner utilizes it. This can cause consumers to identify the mark with a particular source, maker, or producer.

Comparison between Inherent and Acquired Distinctiveness

A mark is said to be inherently distinctive when, by its very nature, it is capable of identifying the source of goods or services without needing prior use or consumer recognition. For

⁴ Trade Marks Act 1999, s 9(1).

example, invented words like ‘*Kodak*’ or arbitrary uses such as ‘*Apple*’ for computers are considered inherently distinctive because they immediately stand apart and signal a unique origin. Such marks are readily entitled to trademark protection as they do not require additional evidence of consumer association.

On the other hand, acquired distinctiveness refers to situations where a mark that was originally descriptive or non-distinctive gains the ability to distinguish goods or services through long and continuous use. Over time, consistent advertising, consumer exposure, and market presence may cause the public to associate that mark exclusively with a particular source. For instance, the word *Windows* in relation to Microsoft’s operating system or *Whirlpool* for washing machines, though descriptive in ordinary language, have acquired distinctiveness because consumers now immediately link them to a specific brand.

The key difference lies in proof. Inherent distinctiveness does not require evidence—it is presumed by law due to the uniqueness of the mark. Acquired distinctiveness, however, must be demonstrated through concrete evidence such as sales figures, advertising expenses, consumer surveys, and the duration of use. While inherently distinctive marks enjoy immediate protection, descriptive marks can only be protected once they have established secondary meaning in the marketplace. Together, these two forms of distinctiveness reflect the balance trademark law seeks to maintain between rewarding brand identity and keeping common language free for public use.

Theoretical Basis of Acquired Distinctiveness

The idea of acquired distinctiveness is based on the principle that even if a mark is not inherently unique at the time it is created, the law can still protect it once it becomes strongly associated with a particular business in the minds of consumers. The theoretical foundation lies in primarily function of a trademark, to identify the source of goods or services and to prevent confusion in the market place.

In practice, many businesses begin with descriptive or simple terms, by themselves, may not qualify for trademark protection. Over time, however, consistent use, widespread advertising, and consumer recognition can transform such terms into powerful brand identifiers⁵. Once a descriptive mark acquired this “Secondary Meaning”, the law steps in to protect it,

⁵ Trade Marks Act 1999, s 9(1).

acknowledging both the effort of the business on building goodwill and the reliance of consumers on that association.

In “*T.V. Venugopal v. Ushodaya Enterprises Ltd*”⁶., the supreme court held that the term “Eenadu” originally meaning “Today” in Telugu, had acquired distinctiveness through long use and was strongly associated with a particular newspaper.

Similarly, in “*Qualitex Co. v. Jacobson Production Co.*”⁷, recognized that even a colour, though not inherently distinctive, could acquire distinctiveness of consumers comes to associate it with a particular brand. These cases highlight the theoretical basis that, trademark law protects not the word or symbol in the abstract, but its ability to signify origin and prevent consumer deception.

At the same time, the requirement of strong evidentiary proof ensures that protection is not misused. This balance allows the doctrine to reward genuine brand-building while safeguarding fair competition by preventing business from monopolising ordinary language without proof of consumer association.

Statutory Provisions and Evidentiary Requirement to Prove Acquired Distinctiveness

To prove that a mark has acquired distinctiveness, trademark law requires strong evidence showing that the public associates the mark with a single source rather than seeing it as a descriptive or generic term.

The evidentiary requirement varies across jurisdiction but shares common elements.

1. In the ‘United States, the U.S Patent and Trademark Office (USPTO)’, allows applicants to rely on three main forms of evidence,
 - Prior registration: if a trademark owner already has an existing registration on the principal register for the same or similar mark in relation to closely connected goods or services, this can be used as proof of acquired

⁶ *T.V. Venugopal v Ushodaya Enterprises Ltd* (2011) 4 SCC 85.

⁷ *Qualitex Co v Jacobson Products Co* 514 US 159 (1995).

distinctiveness⁸.

The logic here is that if the ‘USPTO’ has already recognized the distinctiveness of a mark for related products, it is reasonable to extend the recognition to the new application.

- Substantially exclusive and continuous use in commerce: If a trademark owner can show that their mark has been in consistent and almost exclusive use for at least five years in connection with the goods or services listed in application, the USPTO will generally accept this as sufficient proof of acquired distinctiveness⁹. This period of sustained use helps demonstrate that consumers have come to associate the mark with a single source.
 - Actual evidence of Acquired distinctiveness: Even if the mark has not been in use for five years. This is often the most demanding route, as it requires strong and convincing evidence that the mark has developed secondary meaning in the minds of consumers. Such evidence may include extensive sales figures, advertising expenditures, length and manner of use, market share data, and consumer surveys showing that the public associates the mark with a specific source.
2. In ‘European Union, Article 7(3) of the EU Trademark Regulation’ required proof that a descriptive mark has acquired distinctiveness “Through Use” before it can be registered. Courts in the EU and UK rely heavily on surveys and market evidence to determine whether consumers identify the mark with a particular trade.
 3. In India, ‘Section 9 of Trade Mark Act, 1999’, absolute grounds for refusal of registration.

In “Reddaway & co ltd. v. Banham & co”¹⁰. the plaintiff manufactured and marketed camel hair belting. The defendant began marketing belting of camel's hair under the label Camel Hiar Belting. The trader demanded a claim to the term "CAMEL HAIR".

⁸ US Trademark Manual of Examining Procedure (TMEP) §1212.04; see also *In re Dial-A-Mattress Operating Corp* 240 F3d 1341 (Fed Cir 2001).

⁹ Lanham Act, 15 USC §1052(f); *In re La. Fish Fry Prods., Ltd* 797 F3d 1332 (Fed Cir 2015).

¹⁰ *Reddaway & Co Ltd v Banham & Co* [1896] AC 199 (HL).

The name “CAMEL HAIR” was considered to be descriptive but had attained secondary meaning in the commerce trade and had been identified with the plaintiff's business and hence it was subject to protection.

In “ITC v. Nestle India Ltd”¹¹. the conflict developed because of the factor of monopoly, since plaintiff argues that the defendant's use of the misleading similar words.

Both the term “Magic” and its variant “Magical” are commonly employed in the industry. Therefore, the plaintiff and the defendant cannot have monopoly over the term “Magic” or “Masala” as both are commonly used in Indian cooking as well as the food industry.

Court went on to expound that plaintiff hasn't used the word Magic as the description of the flavour since there is no flavour known as Magic. Plaintiff has gone ahead and given the flavoured in the sachet the name Magic. Meanwhile, plaintiff has used the term "Magic Masala" to market the Masala in the sachet in an appreciative manner. In most instances, the courts have ruled that a meritorious term cannot be given a monopoly or protection.

While these evidentiary requirements provide a structured way to establish secondary meaning, questions remain about their adequacy. On one hand, they prevent casual or opportunistic claims by requiring proof of consumer recognition through sustained use or concrete evidence. On the other, there is concern that the standards are sometimes applied too leniently, especially with the five-year rule in the U.S. or when Indian courts accept long use without robust consumer surveys. This can lead to the monopolization of descriptive words or common phrases, which undermines market competition and restricts other traders from using language essential to their trade.

Judicial Interpretation

- In the “*Living Media India Ltd. v. Jitender V. Jain and Anr*”¹² case, the court had to determine whether the name and style of “AJJ TAK”, along with its logo, are generic terms that are not exclusive to any one individual, whether or not they relate to the news

¹¹ *ITC Ltd v Nestle India Ltd* 2013 (53) PTC 327 (Mad).

¹² *Living Media India Ltd v Jitender V Jain and Anr* 2002 SCC OnLine Del 378

program. As per the court's ruling, the combination of the two words "AJJ TAK" cannot be used by any other user, even though they are descriptive in nature and have a dictionary meaning when used together. This is because the plaintiff coined the term, which has gained a secondary meaning through extensive, continuous, and previous use.

Both the words "AJJ" and "TAK" are individually descriptive that cannot be monopolized by any single user. However, by virtue of past, continuous and extensive usage, the combination of words has achieved distinctiveness and is thus protected.

- In "*J.L. Mehta v. Registrar of Trademarks*"¹³, the question was whether "SULEKHA" a word that, according to the dictionary, translates as "a person with good handwriting" could be held as a valid trademark. Since it is a descriptive word, it was a valid trademark held by the court as being in relation with the fountain pen, nibs, and other goods of similar use. Words that are common to a language or descriptive words can be trademarked when used as regards to another class of goods.
- In the case of "*Metropolitan Trading Company v. Shri Mohanlal Agarwal*"¹⁴, it was determined that the trademark had gained uniqueness due to its lengthy history of use, while the other trademark, also known as "ZODIAC," was ineligible for registration due to its little history of use. In this instance, the IPAB determined that the appellant's trademark "ZODIAC" was eligible for registration since it had become unique after over thirty years of usage. The court's interpretation of the time frame for "Acquiring Distinctiveness" is demonstrated by this case.
- In "*Ishi Khosal v. Anil Aggarwal*"¹⁵, the Delhi High Court ruled that "a product does not need to be on the market for a number of years in order to acquire secondary meaning." A new concept could become popular overnight if it is interesting and engaging to consumers. This example clarifies the idea of "acquired distinctiveness." It is not required that the products associated with a trademark have been on the market for a specific number of years in order for the trademark to have distinguished itself. Because a trademark can become unique very quickly even overnight it varies from one

¹³ *JL Mehta v Registrar of Trade Marks* AIR 1977 Cal 19.

¹⁴ *Metropolitan Trading Co v Shri Mohanlal Agarwal* 2004 (29) PTC 139 (IPAB).

¹⁵ *Ishi Khosla v Anil Aggarwal* 2007 (34) PTC 370 (Del).

situation to another. The amount of time that a trademark must have gained distinctiveness is not fixed.

Critical Analysis

The concept of acquired distinctiveness, plays a crucial role in determining whether otherwise non-distinctive marks, such as descriptive terms

1. Adequacy of Indian Legal Standards

Under the 'Trade Mark Act, 1999, section 9(1)' bars registration of marks devoid of distinctives character or descriptive in nature, unless the mark has acquired distinctiveness through use¹⁶. Courts in India, such as in "*ITC Ltd. v. Britannia Industries Ltd*"¹⁷. and have recognized that consistent and extensive use, consumer recognition, and market surveys can establish secondary meaning. However, the Indian framework lacks clear evidentiary guidelines on how much use or recognition is sufficient, making outcomes uncertain and inconsistent.

2. Evidentiary Challenges:

Proving acquired distinctiveness is highly fact-intensive. Business must rely on sales data, advertising expenditures, consumers survey or prior use. However, court often treat consumer survey with scepticism, questioning their methodology and representativeness¹⁸. This creates legal unpredictability, as the threshold of proof varies between jurisdictions and cases.

3. Balancing goodwill protection and public Interest

The key Challenges is balancing between protecting actual goodwill and leaving descriptive words open to the public. Indian courts are aware of this but do not have definite standards. While investments by companies in brand building are taken into account, courts are also cautious against excessive protection. For India, the application of systematic guidelines through surveys, market research, and empirical findings

¹⁶ Trade Marks Act 1999, s 9(1) (India).

¹⁷ *ITC Ltd v Britannia Industries Ltd* 2016 SCC OnLine Del 5007.

¹⁸ *Tata Sons Ltd v Manoj Dodia* 2011 SCC OnLine Del 3134 (noting judicial scepticism regarding survey evidence).

would protect only when there is actual distinctiveness, without constraining fair competition

Suggestions:

In order for the doctrine of acquired distinctiveness to be effective in India, it is essential that judicial procedures and legislative measures change to reflect modern business realities. Because of the current lack of consistency in the evidentiary framework under the “Trade Marks Act of 1999”, applicants and adjudicators are left without clarity.

First, the Trademark Registry and the court should adopt standardized criteria for evaluation proof of acquired distinctiveness. Evidence should not be confined to sale, turnover, invoices or advertising expenditures. Instead, weight must be given to consumers survey, digital engagement metric, and empirical market research, factors that directly reflects the public associates a mark with a particular source. Reliance on mere duration of use, while relevant, should no longer be treated as conclusive, what truly matters is consumer perception and identification.

Second, reliance on mere duration of use should be discouraged; instead, the focus should remain on whether consumers associate the mark with a single commercial source.

Third, guidance should be provided on the treatment of online reputation. As e-commerce and digital marketing dominate consumer perception, online evidence such as searches rankings, social media presence, and consumer reviews should be explicitly recognized in the law.

At the same time, India must ensure that its approach is consistent with international standards under TRIPS while safeguarding domestic competition. This experience of the EU and US offers valuable guidance. The European Union Intellectual Property Office (EUIPO) requires concrete proof such as market shares, consumer survey, and geographic reach, while the USPTO recognize a five-year continuous use presumption but still subject it to scrutiny.

If India were to adopt similarly structured evidentiary test, it would enhance predictability, reduce arbitrariness in decision-making, and improve the credibility of Indian trademarks in cross-border disputes.

Conclusion

The doctrine of “Acquired Distinctiveness” is indispensable for ensuring that trademarks fulfil their primary function, to act as indicators of origin and protect consumers from confusion. At the same time, its application must be carefully calibrated to avoid granting unjust monopolies over descriptive expression that belong to the public domain.

In India, while aligned with TRIPS¹⁹ obligations, still lack predictable and transparent evidentiary framework with international standards while ensuring that domestic enterprises are not unfairly disadvantaged. By doing so, the Indian regime can evolve into a system that both protect genuine brand-building efforts and safeguards competition.

The Acquired Distinctiveness must be applied as a balanced doctrine, one that reward businesses for cultivating goodwill but prevent overreach that could harm the public interest²⁰. The future of this doctrine in India will depend on its ability to adapt to digital realities, recognize trans-border reputation responsibility, and develop evidentiary clarity that ensure fairness for all stakeholders in the marketplace.

¹⁹ Agreement on Trade-Related Aspects of Intellectual Property Rights (adopted 15 April 1994, entered into force 1 January 1995) 1869 UNTS 299 (TRIPS), art 15(1).

²⁰ *ITC Ltd v Nestle India Ltd* 2013 (53) PTC 327 (Mad).

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