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JUDICIAL APPROACH TOWARDS ACQUIRED DISTINCTIVENESS IN INDIA: A COMPARATIVE ANALYSIS WITH RESPECTIVE TO USA AND INDIA

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Abstract:

The concept of distinctiveness refers to the capacity of a trademark to identify and distinguish the goods and services. When it comes to registration, if the goods are inherently distinctive, the process of registration should be as relatively easy as a trademark and should have a distinctive character that sets it apart from the existing goods and services. In the case of generic or descriptive marks, the process of registration becomes difficult unless it is proved that the mark is being distinguished or has a distinctive meaning. This gives rise to the concept of acquired distinctiveness, as these marks should have acquired distinctiveness over time by the usage of such marks extensively and exclusively in the marketplace. In India, Section 9(1) of the Trademark Act deals with absolute grounds for refusal and also covers the aspect of acquired distinctiveness.

To establish the acquired distinctiveness, the mark must be used in the Indian period for a significant period. When we take the case of the US, they follow a use-based application for registration and they have a specific duration for considering the distinctiveness factor, the person who submits the declaration for the usage of the trademark that has been done before the registration will be registered. Further, they have established the guidelines for proving acquired distinctiveness.

In India, it is done through the judiciary which plays a vital role in interpreting the acquired distinctiveness of goods and services. As it mostly depends on the consumer perception and how the mark has been recognized as an indicator of the goods or services the acquired distinctiveness can be claimed. This creates an opportunity to re-visit the judicial interpretation of acquired distinctiveness and the possibility to see the necessity of guidelines to prove acquired distinctiveness.

Keywords: Distinctiveness, Secondary Meaning, registration, likelihood of confusion, well-known mark

Introduction:

Trademarks generally create an identity for the product or services that distinguishes it from other similar providers in the market. Based on this trademark, the consumer associates it with the particular manufacturer as it is easy for them to recognize and relate to it. The main function of the trademark is to differentiate one of the products and services from the other business entity as to say the mark must possess distinctiveness to be distinguished from other products or services. In India, the Trademark Act of 1999 governs the laws about trademarks and their requirements for registration. The requirements of the trademark under the act must be graphically represented, capable of distinguishing itself from other goods and services, it should be used to indicate or establish a connection between the product or service and the person who has the right to use the trademark.¹

The distinctiveness of trademarks is classified into two types, inherent and acquired. The inherent distinctiveness is dependent on how descriptive the marks depend on the products and services to say less the descriptive the more it will be inherent. So, more descriptiveness is considered as less distinctiveness. As every trademark is associated with particular source of goods and services over long-term usage, the mark is strongly associated with those goods or services as registered in the minds of consumers. The concept of acquired distinctiveness starts once the trademark acquires the distinctiveness that is determined based on how descriptive it is and how the mark is being viewed from the customer's perspective, so it would not be deceiving the consumers in the market.²

The trademark is considered to be important as many brands are running various businesses, and most of them find a way to attract consumers. One of the strategies used is marks that are associated with products that are protected under the law so they cannot be claimed by other business entities. As the trademark helps you to protect the business asserts. Further, it helps you to build a reputation in the industry as it helps in showing consumers how credible and trustworthy. This makes it difficult for competitors to imitate and capture the market.³ It does not only protect your mark but also helps in expanding your business as these are a few benefits that can be claimed from registering a trademark. So, following the requirements of the trademark will lead to easy registration of the trademark.

¹ Frequently Asked Questions (FAQs) | Trade Marks | Intellectual Property India, <https://ipindia.gov.in/faq-tm.htm> (last visited Feb 22, 2025).

² Acquired distinctiveness & secondary meaning, <https://www.tramatm.com/trademark-academy/article/acquired-distinctiveness-and-secondary-meaning> (last visited Feb 22, 2025).

³ Paula Celestino, *Council Post: The Importance Of Trademarking Your Business*, Forbes, <https://www.forbes.com/councils/forbesagencycouncil/2023/01/18/the-importance-of-trademarking-your-business/> (last visited Feb 22, 2025).

Concept of Distinctiveness:

Under Trademark law, it is seen that a mark's ability to be differentiated. The ability to differentiate means that the trademark should not have any non-distinctive words or names. It should be different from the products or services that are the subject of the other's trademark. The characteristic of the trademark has to be unique in customers' eyes that can be used for advertising and later developed as a reputable trademark. What makes one product different from another is its distinctiveness which makes these goods and services appear unique because it prevents customers from being deceived in any manner.⁴ A trademark is distinctive where the public at once and unmistakably associates the mark with the source or a manufacturer/owner when used concerning the goods or services. Trademark distinctiveness has been categorized along a spectrum that starts from less to more distinguishable, this system is used to distinguish the products and services as it varies based on types of marks.

The case of *Abercrombie & Fitch Co. Vs. Hunting World, Inc.*,⁵ is the first case to point out the spectrum of distinctiveness, as from the less to more distinctive aspects, it can be classified as a generic, descriptive, suggestive, arbitrary, and fanciful mark. This is one of the important cases in understanding the concept of distinctiveness. Where in this case plaintiff and respondent are in the business of clothing. When both companies were making clothes for a jungle expedition, the plaintiff initially used the term "Safari" for their goods but it was not registered, by that time the defendant started to use the term Mini Safari for their goods as they also did not register it for trademark. So this case went to court the plaintiff said that the defendant was trying to use the goodwill they gained by using the "Safari", but in the lower court, it was seen that established that the use of the mark wasn't creating any confusion and due to lack of presumption of confusion the liability false on the plaintiff to prove the mark creates confusion to the public which leads to the decision in favor of the defendant. The Supreme Court has overturned the judgment that agreeing to the words is a descriptive term and not a generic term, as the concept of inherent and acquired distinctiveness has derived from this case, as the term "Safari" had acquired distinctiveness at that time with plaintiff and prior use of the mark along with knowledge of consumer that the products are derived from plaintiff.⁶ This distinctiveness plays a major role when generic and descriptive mark comes in for registration. The generic marks refer to the common name that is used for identifying a product

⁴ Himanshi Singh & Sahil Khan, Concept of Distinctiveness: Trade Marks Act, 1999, 4 INDIAN J.L. & LEGAL RSCH. 1 (2022).

⁵ 461 F.2d 1040 (2d Cir. 1972)

⁶ Law Essentials, CONCEPT OF DISTINCTIVENESS UNDER TRADEMARK LAW, <https://lawessential.com/blogs-ip/f/concept-of-distinctiveness-under-trademark-law> (last visited Feb 22 2025).

or service as the word/name that is used regularly in our lives. In this case, descriptive marks generally describe the character, quality, purpose, or feature that is connected to the product/service. These marks do not enjoy the inherent distinctiveness as they are common words/names or they describe the feature. They can gain identification through acquired distinctiveness through recognition from consumers as they associate the original product/service with the business entity. This is applicable in the case of descriptive marks while in the case of generic marks, it is difficult to prove the acquired distinctiveness.⁷ This aspect will impact when the registration of trademarks happens as it will fall under the scrutiny of Sections 9 and 11 of the Trademark Act, 1999. The acquired distinctiveness generally depends on the secondary meaning of a word/name that it acquired through the operation of the business. The secondary meaning is not applicable for all the terms, some words are incapable of acquiring it, we can take the example of terms like good, best, etc. as these terms cannot have secondary meaning.

A word, whether or not having reference to a feature of the goods or services, that has the primary meaning over that word/name different from what it generally refers to, has acquired a secondary meaning and has become registerable. This is the same for descriptive words as they could assume a secondary meaning that has been used for a long time, that has established a reputation in the market.

Understanding Acquired Distinctiveness in India:

Generally generic or descriptive words or names cannot be registered under the trademark unless it has gained goodwill and reputation among consumers in the market by acquiring a secondary meaning to that word or name. As per the Trademark Act of 1999, Sec.9(1)'s exception for registration of a trademark is only when a mark has acquired distinctiveness that results from the usage of the mark.⁸ The criteria for registration of a mark in case of having secondary meaning or acquired distinctiveness is through the extensive and substantial use of that mark for a while as it is equated with a well-known mark.⁹ But from the case of *Ishi Khosla vs Anil Aggarwal*¹⁰, it can be seen if that mark has to gain secondary meaning, existing of the product in the market for several years is not necessary, even the new idea that appeals to the

⁷ The Differences Between Descriptive and Generic Trademarks, Cohn Legal, PLLC (Jan. 5, 2025), <https://www.cohnlg.com/the-differences-between-descriptive-and-generic-trademarks/> (last visited Feb 22, 2025).

⁸ Section 9(1) of Trademark Act, 1999.

⁹ *Trademarks: Distinctiveness Is an Exception of Descriptiveness*, SCC Times (Aug. 24, 2021), <https://www.sconline.com/blog/post/2021/08/24/trademarks/> (last visited Feb 23, 2025).

¹⁰ 2007(34)PTC370(DEL).

public can become an overnight hit.¹¹ So, the criteria for registering a mark that is said to have acquired distinctiveness is through the years of usage and through well-known to the consumer as this would not cause likelihood confusion among other products/services.

In case of registration, if the mark falls under scrutiny of Sec.9's as the mark being non-distinctive, the duty bounds on the applicant to prove that the mark has acquired distinctiveness. Some elements are used to prove the acquired distinctiveness under Indian law, one is the duration of use of the mark by showing significant usage over time and in the process of identifying goods/services. Further, effort to promote your product to the public through advertising. By providing data regarding the reputation and demonstrating that consumers have accepted the mark, establishing the mark's link with consumers is vital to prove that the mark is associated with that particular business.¹² The registration for the mark that has acquired distinctiveness is similar to how you register a trademark under the Trademark Act and Trademark Rules since for acquired distinctiveness there are no established guidelines on how to determine and the manual gives us the idea of how to produce the evidence of use, through an affidavit before registrar must be given except if registrar accepts oral evidence in addition of affidavit. The registry has given a way to assess the distinctive character of the mark based on the evidence that is provided the factors like "market share held by the mark, geographically wide-spread, how long-standing use of the mark, the amounts invested in promoting the mark, the relevance of the class as it identifies the origin of goods/services and statement for the Chambers of Commerce and Industry or from other trade associations or professionals."¹³

Understanding Acquired Distinctiveness in the US:

Sec.2(f) of the Trademark Act, of 1946 paved the way for registering descriptive terms that had acquired distinctiveness through prolonged use and public recognition. The Act says that the mark used should be "Substantially exclusively and continuously" for 5 years as it's considered to possess acquired distinctiveness, for proving with evidence varies based on the degree of descriptiveness, where the mark can achieve the distinctiveness through distinctiveness quickly through intensive advertising. The mere descriptive marks are excluded from the register from the act unless it is shown to acquired distinctiveness under Sec.2(f). The Lanham Act maintains

¹¹ Trademark Law in India Types of Trademarks, Registration and Acquired Distinctiveness, Singhania & Partners, <https://singhania.in/blog/trademark-law-in-india-types-of-trademarks-registration-procedure-and-acquired-distinctiveness-of-generic-words> (last visited Feb 23, 2025).

¹² Acquiring Distinctiveness in Trademarks, Markshield (Oct. 6, 2024), <https://markshield.in/acquired-distinctiveness/> (last visited Feb 23, 2025).

¹³ Acquired distinctiveness, Manual of Trade Marks.

the fact that generic marks cannot be protected as trademarks as once a valid trademark enters into the public domain, that mark can be subjected to cancellation.¹⁴

In the US to prevent refusal of registration, the applicant needs to show distinctiveness, and in case of having the descriptive component mark, a disclaimer shall be used in case of claiming exclusive rights over that descriptive term, which can be turned into a strategic advantage like stopping the third party from using it.¹⁵ The assessment for the duration of the mark plays a significant role here in proving the acquired distinctiveness, as if a mark is used for some years or decades, it can be claimed based on continuous and exclusive use of the mark. In general, it needs to fulfill the 5 years before being brought under the examination process as per 2(f). If it is not registered initially, it can be placed under the Supplemental Register as it offers limited benefits and also prevents third parties from registering similar marks.

It is seen that if an applicant has already registered previously with the same mark but that covers different classes it is seen there is the possibility that a claim of acquired distinctiveness is easy even if the mark is not yet being used for the new goods or services, as to support this claim, the applicant must demonstrate, first is the acquired distinctiveness for the previously register mark, secondly the relationship between the new and previously registered goods and services along with the strong likelihood that the mark's trademark function will extend to the new products or services when they enter into business.¹⁶

In the case of determining whether the proposed mark has acquired distinctiveness, the USPTO evaluates based on factors like length and exclusivity of its use in the US. The cost and extent of advertising, efforts that are associated with the mark with a specific purpose like media coverage or consumer studies, as not all factors need to be needed but it seems that longer and more extensive use increases the likelihood of distinctiveness. It is seen that a minimum of 5 years with strong sales is required even though it is a short period, with significant marketing efforts it is seen as sufficient but it must not be less than 2 years of use from the date of application as it is considered to be insufficient. USPTO will assess if it is continuously in use, and if there is any break, it checks whether the reputation of the mark is diminished, if sales are strong the prior distinctiveness is retained. The classification is considered to be important

¹⁴ Morris Turek, *What Is Acquired Distinctiveness for Purposes of Trademark Registration?*, US Trademark Attorney Morris Turek, <https://yourtrademarkattorney.com/acquired-distinctiveness-trademark/> (last visited Mar 2, 2025).

¹⁵ Acquired Distinctiveness and Secondary Meaning, Cohn Legal, PLLC (Jan. 5, 2025), <https://www.cohnlg.com/acquired-distinctiveness-and-secondary-meaning/> (last visited Mar 2, 2025).

¹⁶ Trademark Q&A: How does USPTO evaluate “acquired distinctiveness”?, <https://www.tramatm.com/trademark-questions-and-answers/specifics-of-us-trademarks/how-does-uspto-evaluate-acquired-distinctiveness> (last visited Mar 2, 2025).

as it should be aligned with specific goods and services even if it does not match the WIPO classification. The evaluation of distinctiveness is seen in various aspects such as the cost and nature of the goods whether they are specialized or common, the market size, and the market share that helps in determining the turnover gained under the mark represents a substantial portion of the relevant market, advertising expenditures and continuous use of mark are considered for assessing the mark.¹⁷

In case of examination, the authority sees that if the proposed mark causes any confusion with the registered mark, if so then they will refuse registration and will give 6 months to rebut the refusal. If any previous application is pending that could hinder the process, the applicant is notified as the process will be suspended until the prior application is either registered or abandoned. Mostly the application will need the website address, as most of the applicants will omit it as third parties will access the site as they use their content, but in case of using the mark as a source identifier should be included as that supports the claim of acquired distinctiveness.

Assessing acquired distinctiveness preemptively at filing, particularly for strongly descriptive or bordering on distinctive marks, is a tactical strategy to overcome likely refusals since it dissuades authority from refusing the mark as generic or that doesn't acquire secondary meaning. Pending prior registration of the same or a similar trademark can be considered by the authority as evidence of acquired distinctiveness for a pending mark. Additional evidence can be required, however, if the mark is highly descriptive or potentially misleading regarding the goods or services. Prior registrations are considered *prima facie* evidence of acquired distinctiveness only when the claimed part of the registered trademark has not been disclaimed. The applicant should demonstrate that the mark has acquired distinction for it to be registrable in case the USPTO holds that the mark is not inherently distinctive. The absence of inherent distinctiveness of the mark is practically admitted if the applicant alleges acquired distinctiveness but does not allege inherent distinctiveness. However, registration in the Supplemental Register does not suggest recognition of a lack of acquired distinctiveness.¹⁸ An applicant would first need to submit evidence of continuous and exclusive use for at least five years to support a claim of acquired distinctiveness. Second, prior registration of the same mark or a substantial portion thereof. Lastly, other relevant evidence. Whether a mark has acquired distinctiveness is a question of fact. But if an applicant submits evidence of substantially

¹⁷ Supra Note 14.

¹⁸ Jeffrey Turben, *What the 2(f)?: Demonstrating Acquired Distinctiveness*, Alt Legal (2020), <https://www.altlegal.com/blog/what-the-2f-demonstrating-acquired-distinctiveness/> (last visited Mar 2, 2025).

exclusive and continuous use of the mark in commerce for five years or more from the date of the claim of distinctiveness, this can be prima facie evidence that the mark has acquired distinctiveness.¹⁹

It is seen that a five-year term of use may be satisfied within the application period and is not necessarily connected to the date of filing. Considering that the descriptive part of the mark has been in use for considerably longer than five years, but the whole applied-for mark has only been used for a lesser period, the applicant might be required to emphasize the long-standing, continuous, and exclusive use of the descriptive aspects. This focus can assist in establishing acquired distinctiveness, even if the applicant is unable to establish such use of the entire mark. If the PTO grants a Sec. 2(f) claim based on a declaration of exclusive and continuous use for five or more years alone, the resulting registration on the authority is accorded a legal presumption of validity. This presumption extends to the validity of the claim of acquired distinctiveness, i.e., the mark is presumed to have acquired distinctiveness unless it is shown otherwise.²⁰

It seen that authorities are generally will not give a specific opinion about the amount or type of evidence needed to establish acquired distinctiveness but will sometimes offer advice on a reasonable course of action. They frequently will state if they consider a mark highly descriptive or possibly generic and if they think a five-year use declaration would be enough. Where the mark has been held highly descriptive, stronger evidence than that of the five-year declaration is necessary for sustaining the acquired distinctiveness claim as this can be seen in the case of Yamaha International Corporation, the court has said that the quality of evidence necessary to establish acquired distinctiveness within five years is determined by the descriptive character of the trademark. A very descriptive trademark necessitates a higher amount of evidence to prove secondary meaning since continuous use alone might not be enough to show that consumers identify the mark with a particular source.

In case of *In re Van Valkenburgh*, the court held that the duration of use carries persuasive weight in determining distinctiveness used the Sec. 2(f) five years of substantially exclusive and continuous use of a mark as a trademark serves as *prima facie* evidence of acquired distinctiveness. This means that such use creates a presumption that the mark has developed secondary meaning, making it eligible for registration.²¹

¹⁹ In Re Loew's Theatres, Inc, 769 F.2d 764 (Fed. Cir. 1985), Justia Law (2025), <https://law.justia.com/cases/federal/appellate-courts/F2/769/764/197064/> (last visited Mar 2, 2025).

²⁰ Ibid.

²¹ In re Van Valkenburgh, Lexology (2011), <https://www.lexology.com/library/detail.aspx?g=78122422-2caf-438d-8f26-1e040ee72d29> (last visited Mar 3, 2025).

Judicial Analysis in India:

In India, the judiciary has considered based on the evidence granting registration of the descriptive trademark that has acquired distinctiveness. However, the standards that are set by them are different as most of them depend on the circumstance. One of the important cases when it comes to acquired distinctiveness is *Cadila Healthcare Ltd. v Gujarat Cooperative Milk Marketing*.²² The main issue that revolves around this case is the use of the term “Sugar-Free” by Cadila Healthcare has acquired distinctiveness as the public associates it with their products, as the defendant uses the same mark for the frozen dessert packaging. The plaintiff here states that the trademark has been long used. Extensive marketing has been done concerning sugar substitutes and other products, as consumers associate it with their products. Still, the defendant contested that the term is in a descriptive sense. It indicates the characteristic of their frozen dessert since it describes the absence of sugar and not being considered a trademark. Since, at that point, the mark had not been registered, it went through passing off action and here the plaintiff has shown statistics of television and print media along with highlighting the substantial sales revenue to prove they have exclusively and distinctively associated with their products. Another contention brought by the plaintiff is that the font size in its packaging as it resembles that it is part of the defendant’s trademark will cause likelihood confusion. This case highlights the use of the descriptive expression as a trademark does not give the user the right to prevent others from using that expression to describe the characteristic of their product.²³

In the case of *Marico Limited vs Agro Tech Foods Limited*²⁴ It was discussed the usage of the mark “LOW ABSORB” was and the defendant used it as “WITH LOW ABSORB TECHNOLOGY”. This case has interpreted the term distinctiveness even though they are not defined under the act. It is seen from the judgment of how the term distinctiveness has been interpreted and further here it is seen as an important element of proof since there is no proof for the usage of the trademark as the actual user, only for the proposed to be used basis rather than the actual user of the mark.

In the case of *Bhole Baba Milk Food Industries Ltd. vs. Parul Food Specialities Pvt. Ltd.*²⁵ As the plaintiff claimed that “KRISHNA” has acquired a secondary meaning to the specific ghee product to prevent the defendant from using the mark, so court checks whether they have

²² 2008(36)PTC168(DEL).

²³ Secondary Meaning and Acquired Distinctiveness, Law Firm in Ahmedabad (Feb. 20, 2023), <https://amlegals.com/secondary-meaning-and-acquired-distinctiveness/> (last visited Feb 24, 2025).

²⁴ 2010 SCC OnLine Del 3806.

²⁵ 2011 SCC OnLine Del 4422.

sufficient distinctiveness to prevent from using the mark that has the term “KRISHNA”. The plaintiff has acquired the secondary meaning by providing sales figures as they argue it is “infrangible proprietary interest”, but the defendant claims that the term is considered to be a common word as it is connected to the Hindu god with association to dairy products, so the exclusivity cannot be claimed. The judge considered various factors like multiple users in similar business, being god’s name, and also scrutinized the sales figure as rejecting it stating it must be considered relative to consumer bases, as in this vast country, even substantial sale is not indicated widespread consumer association. Further, it was observed that registration for the label mark with design not for the word, so considering these factors, the usage of the mark is not a statutory right. So, this case established that the use of generic terms will not be enough even if we submit the sale report to prove acquired distinctiveness as it increased the level of registrability of the trademark. In the case of *Advance Magazine Publishers, Inc. and Anr vs. M/s. Just Lifestyle Pvt. Ltd.*²⁶ This case deals with how the mark “VOGUE” has acquired distinctiveness as how uniquely they have associated with the mark. The case was filed for infringement under Sec 29(4) of the Trademark Act, 1999. The court emphasized that only if they have acquired secondary meaning as it is associated in the minds of consumers. Further, in this case, they have referred to the test used in *British Sugar Plc.* the case for considering aspects of extensive use and promotion of marks as this includes advertising, sales figures, and their presence in the market. The court's decision in this case that acquired distinctiveness of “IN VOGUE” is considered irrelevant as they failed to the reputation of the magazine by taking into consideration logo design and context, also we can consider the fact that they have been in dissimilar goods/services. In the case of *Aegon Life Insurance Company Ltd. vs. Aviva Life Insurance Company India Ltd.*²⁷, this case concerns the mark “iTerm” with the defendant's mark’s “i-Term”, as this case took acquired distinctiveness as one of the major issues to check, the plaintiff argued that “iTerm” is a coined or invented words and not descriptive so in its should be inherently distinctive and it is to be protected. In this case, the plaintiff used the Google Trends report to support their claim as before 2009 there was no search of this term, brought to prove that the term is not a common word as it is associated with the brand. The court took the view that whether the term “iTerm” is shown to consumers, they associate it with the plaintiff. Further, the mere use of the term for a long time is not considered to be primary as the court needs evidence beyond that to determine, as the court also finds that “iTerm” is somewhat descriptive. So, the burden of proof is high on the plaintiff's side in this

²⁶ 2016 SCC OnLine Bom 8417.

²⁷ (2019) 80 PTC 1.

case.

But if we view from the case of *Living Media India Ltd vs. Jitender V. Jain And Anr*²⁸ the court had observed that the mark was descriptive and when they were read individually through the dictionary meaning but the words were put together as composite form as it was claimed to be coined by the plaintiff. The term here “AAJ TAK” had acquired distinctiveness to certain leave with the public and gained secondary meaning by prior and extensive use of the mark. So, the plaintiff is considered to be the only user of the combined term. Also, in this case we can view how the aspect of secondary meaning or acquired distinctiveness has a reverse impact on descriptive trademarks, so Sec.9 of the Trademark Act, 1999 can be invoked here.²⁹

Another important case we can consider is the case of *Nandhini*, where it happened for trademark registration if the mark is for two different services or businesses, even if they fall under the same class. In this case, the Supreme Court considered that as they held that they are not deceptively similar as even though they are phonetically similar they are two different trademarks when we compare them with logos. Further, it did not cause any confusion among the general public. As previous judgments discussed, the term is the goddess’s name as it is not invented by either party. Lastly, it is seen that no person can claim exclusive rights by trying to monopolize the entire class of goods.³⁰ In the case of *Peps Industries Private Ltd. vs. Kurlon Ltd.*³¹, The court had refused to grant the plaintiff’s injunctive relief as the mark is descriptive and the owner of the mark cannot show how it had acquired the distinctiveness as it results from the extensive use of the trademark.³²

In the case of *Capital Food Private Limited, vs Radiant Indus Chem Pvt. Ltd*³³, In this case, the court has granted ad interim injunction against the defendant from manufacturing, selling, or dealing with the products marks “SCHEZWAN CHUTNEY” and “SZECHUAN CHUTNEY”, here the plaintiff had argued that it has the trademark for “SCHEZWAN CHUTNEY” that had acquired distinctiveness, for which the plaintiff placed their arguments that mark is coined and the combination is two terms is unique and arbitrary, thus making it inherently distinctive. Further, it is registered and has had extensive use since 2012, along with which the plaintiff

²⁸ 98(2002)DLT430.

²⁹ “Aaj Tak” Trademark Infringement By Rogue Websites, (Feb. 23, 2022), <https://ipbulletin.in/aaj-tak-trademark-infringement/> (last visited Feb 24, 2025).

³⁰ Pratyush Kalro, *Nandini v Nandhini: A Case Analysis*, Lets Get Legal (2022), <https://letsgetlegal.in/nandini-v-nandhini-a-case-analysis/> (last visited Feb 24, 2025).

³¹ FAO(OS) (COMM) 94/2020.

³² Descriptive Marks: Test Of Acquired Distinctiveness And The Prior Use Defence, <https://www.mondaq.com/india/trademark/945640/descriptive-marks-test-of-acquired-distinctiveness-and-the-prior-use-defence> (last visited Feb 25, 2025).

³³ 2023/DHC/000224

has shown records of revenue growth. Further, the court has considered the plaintiff's contention and its presence in the market which led to the grant of an injunction. In the case of *Girnar Food & Beverages Private Ltd. vs. Tni Plastics*³⁴, this case is filed to restrain the defendant from using the mark "GIRNAR" which the plaintiff also sought to decree to mark as the well-known mark. The plaintiff argued that the trademark has acquired a wide reputation and goodwill along with the nature of the business conducted in India to give an idea of the geographical extent the plaintiff's products are known to the consumers. Further, it was pointed out that now the mark does not denote to particular class rather it is associated with the plaintiff in all classes as it had acquired secondary meaning as it is used beyond the scope of goods/services that were handled by the plaintiff. So, from the material produced it was held that the mark is inherently distinguishable and has an immense reputation, which led to the conclusion that it's a well-known trademark.

From these case laws, we can infer that the standards mostly they see are the duration of usage of the mark, we can see from the case of *Britannia vs ITC*, which involves the violation of packing of the biscuits as they are deceptively and caused likelihood confusion. High Court considered this matter as the large sale of ITC, but it did not give exclusivity for the color combination as that had been used for the short term.³⁵ While considering the geographical factor, taking into consideration the case of *T.V. Venugopal* case, even though the mark was descriptive, the mark had acquired distinctiveness and has established has secondary meaning among consumers of that state. Then considering the aspect of the consumer, the mark being used and published which gains its goodwill and reputation, for which the court has adopted various ways to find sales reports, advertisements, etc. These criteria become less relevant as most of the judgments vary on a case-to-case basis. As on general notion, the court takes a few factors like the extensive usage of a mark, whether that mark confuses the consumer, and on what class these goods fall as if they have the same descriptive mark.

For better understanding, this paper incorporates the tables on what factors these courts relies most to assess the acquired distinctiveness:

Factors	Supreme Court	Delhi High Court	Bombay High Court
Duration of Use	Through Whirlpool, 1996 case, The Court noted	The case of <i>VRS Food Ltd. Vs Prem Chand</i> ,	<i>Pidilite Indus. Ltd. v. Jain</i> , 2015 the court held

³⁴ 2024 SCC OnLine Bom 3429.

³⁵ Cherian Chacko Manayath & Deepa Padmar, Quantifying Consumer Perception to Identify Acquired Distinctiveness of Trademarks: The Case for a Survey-Based Approach, 5 J. INTELL. PROT. STUD. 1 (July 2021).

	<i>extensive prior use</i> of “WHIRLPOOL” in India and related goodwill through long-term use and advertising	2018, it is identified that plaintiff had used the mark since 1987, and eventually the mark held well known.	that mere “long standing, continuous use” by itself is insufficient to establish distinctiveness
Sales Figure	The Supreme Court has indicated that mere volume of sales, even if extensive, does not by itself confer distinctiveness. In practice, the HC and SC treat sales data as supplementary i.e., useful to show use of the mark, but not dispositive.	<i>Premier SPG v. FA Premier League</i> , 2024 the Court found that mere invoices and financial figures of sales do <i>not</i> prove distinctiveness on their own.	Referring the above-mentioned judgement, The Court explained that invoices/ financial figures of sales <i>may</i> show use or growth, but it is necessary that something more is to show the mark has become distinctive.
Advertisement or promotion	The Whirlpool, 1996 even though not directly connected with acquired distinctiveness, the court upheld that Whirlpool’s extensive advertising (even abroad) built a trans-border reputation; noting publications of Whirlpool’s ads as evidence of goodwill	There are judgments that support advertisement and promotions but no specific judgement as treated as part of overall evidence of use.	The Court had stressed the need for “ <i>wide publicity</i> .” It held that a plaintiff must show extensive advertising/publicity along with use for a descriptive mark to acquire secondary meaning.
Market surveys/Public or Consumer perception	The Supreme Court recognizes that the ultimate test of secondary meaning is the reaction of consumers. In <i>Godfrey Philips v. Girnar</i> , 2005,	From the case of <i>Stokely Van Camp, Inc. v. Heinz India</i> 2010, the Court rejected distinctiveness as <i>no consumer survey</i> evidence was shown. It	From the case of <i>Aegon Life Ins. Co. v. Aviva Life Ins. Co.</i> 2019, the Court had ruled that high sales/expenses alone can’t substitute for

	the Court quoted McCarthy: “Secondary meaning for a descriptive term is a matter of fact, to be determined from relevant evidence <i>probative of probable customer reaction</i> ”.	held mere use alone didn’t prove secondary meaning	survey proof. The plaintiff must show market trends or consumer survey data demonstrating how <i>the public perceives</i> the mark.
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Further the next tables identify what are the evidence that courts take primarily and what are all considered to be secondary to assess this evidence.

Factors	Type of Evidence	Supreme Court	Delhi HC	Bombay HC
Consumer Surveys	Primary	Survey data directly gauges public perception of the mark’s source. Courts view statistically valid consumer surveys as strong proof of acquired distinctiveness.	Empirical surveys are highly probative. In <i>Stokely Van Camp v. Heinz India</i> , the Court noted that without survey evidence, there was no prima facie showing that the mark had acquired secondary meaning. In practice, a well-designed survey is treated as primary evidence of consumer association.	No specific cases presented but the court likewise values direct evidence of consumer recognition. A credible market survey or witness evidence of public association is needed to upgrade a descriptive term to a trademark.
Duration of Use	Primary	Long and widespread use can build goodwill, but duration alone is not conclusive. The SC has stressed that even prolonged use must	As longstanding user of a descriptive term must show the term has lost its original meaning and now points uniquely to	The Court explicitly held “use is not equal to distinctiveness,” even for descriptive marks. Extensive

		result in a change of meaning to the public.	their goods. Mere continuous use is not enough without evidence of new association with public.	prior use helps, but it must have actually displaced the generic meaning. In practice, the court demands proof that long use has made the mark a recognized as origin of the product.
Sales Figure	Secondary	Mere sales volume or revenue does not itself prove a mark's distinctiveness. Courts look for consumer association, not just large turnover.	The turnover alone isn't enough to prove secondary meaning. The Court requires additional proof like consumer recognition beyond raw sales.	The court held that invoices or sales data alone cannot show that a descriptive mark has become distinctive. Sales figures only show use, not exclusive source-identification.
Advertisement or promotion	Secondary	Advertising outlays indicate effort but do not by themselves create distinctiveness unless consumers associate the mark with one source.	The Court noted that as noted ads can actually show descriptiveness if the mark is used generically. Like the prominent use of a term in ads to describe the product instead of highlighting a brand undermined	Bombay HC requires <i>extensive</i> and <i>wide</i> publicity to build secondary meaning. Mere advertising spend without evidence of consumer recognition is not decisive. Wide public awareness

			distinctiveness.	must be shown beyond the ad budget.
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From this we can see that the Delhi High Court has consistently varied in its assessment of the evidence required to show acquired distinctiveness. As previously mentioned, *Capital Foods Pvt. Ltd .vs. Radiant Indus Chem Pvt. Ltd.*, a single judge accepted large volumes of sales and a massive amount of publicity expenditures but ruling that the publicity and sales weren't sufficient to show that the term “Schezwan Chutney” had acquired secondary meaning. In taking this position, he stressed that the appellant would have to show that the term lost its descriptive nature and became inherently linked to the Appellant. The said ruling was later quasi-overturned on the basis of the same sales and publicity expenditures being accepted as evidence of secondary significance by course of a Division Bench. The Court confirmed that in order to satisfy the test for acquired distinctiveness, advertising would be required for determining acquired distinctiveness.

The Bombay High Court has kept a tough standard on acquired distinctiveness, especially for generic or descriptive terms. One of the examples we can take is *People Interactive (India) Pvt. Ltd. v. Vivek Pahwa*, the Court found that “shaadi”, as a generic term, could not acquire distinctiveness even through extensive use or fame, even though it is common in the public domain. This finding demonstrates the Court’s reluctance to afford trademark protection to descriptive or generic terms no matter how much use or fame is established, in effect creating a high standard of evidence for establishing secondary meaning.

It is seen that these courts have taken divergent approaches, while the SC have given limited guidance for the evidentiary requirement, the Delhi HC in its inconsistent ruling create uncertainty and Bombay HC standard make it challenge for protecting descriptive and generic trademarks.

Conclusion and Suggestion:

In India, the scope of acquired distinctiveness is brought under Sec.9(1) of the Trademark Act, 1999, through the extensive and long usage of marks. From the analysis of the precedents and recent ruling, the determination of secondary meaning is done on a case-to-case basis as they don’t have standard terms that confine the criteria to access the acquired distinctiveness. But with these terms, determining the acquired distinctiveness is still in the hands of the judiciary.

So, they need to revisit the guidelines that have been given for examination purposes under the Trademark Manual for accessing the mark as it is vague and unclear.

There is a need to specify the period through which the mark has to be used to prove acquired distinctiveness, as from these cases, the duration is inconsistent. Whereas a trademark should be used for five years or more before one applies for registration to act as prima facie proof of acquired distinctiveness, the five-year period is merely a presumption.

The examination guidelines must make it clear that five years is not required as of right but is only a loose standard. Trademark owners are nonetheless able to prove acquired distinctiveness through substantial evidence even if the mark has not been used for five years. Further to list out what can be brought or used as evidence for proving the mark has acquired distinctiveness. These are some changes that can be brought to make it clear on what basis the mark is considered to have acquired distinctiveness and it can be registered as a trademark.

