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## Detailed Analysis Refusal under 9<sup>th</sup> Provision of Trademark Act

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**ABSTRACT:** Since trademark is what makes customers recognize and relate some products to a specific trust and quality, it is very important for manufacturing firms to protect their trademark in order to distinguish their own goods and services from others. A proposal for registration of a trademark is, more frequently than not, often met with rejection or opposition on various grounds. This paper has briefly addressed in this article the failure to file on the relative grounds protected by section 11 of the Trademarks Act.

**KEYWORDS:** Intellectual Property, IPR, Registration, Trademark.

### I. INTRODUCTION

The Trademark Act provides that if there is a possibility of misunderstanding among the public on the basis that a trademark is equal or equivalent to any prior trademark, no such trademark shall be registered. Consequently, where a later trade mark is connected to the public by an earlier trade mark, it is possible that such a resemblance between the marks is more than adequate to cause misunderstanding, thus putting it into the reach of section 11 (1). Furthermore, there is no reason to prove uncertainty because the goods and services are equal and not merely related, because this is because the resemblance between the later and earlier trademarks where the goods and services are similar or identical is due to the similarities between the goods and services.

The general structure and phonetic resemblance of the words as a whole is more likely to be considered by an average citizen and correlated with the essence of the medicine previously bought by him. Therefore, the "true test" is whether the proposed trademark, in this situation, is likely to create uncertainty in the minds of those who are currently acquainted with the prevailing trademark or not, when viewed in full.

The structural factor, i.e., must be taken into account as well as the phonetic similarity.

It should also take into account the meaning and ideas expressed by the words. It is possible that the words that express the same meaning or concepts create misunderstanding

It should be noted here that Section 11(2) of the Trademarks Act must not be registered in the following cases:

1. Where a trademark is equivalent or comparable to an earlier trademark.
2. Where any goods or services identified with the mark to be registered are not identical to the goods or services for which the mark is registered in the name of another proprietor, i.e. older than that of the corresponding mark. It means 'a mark which has become so for a significant segment of the public who uses or receives certain goods or services that the use of such a mark in relation to other goods or services is likely to be treated as suggesting, in the course of trade or rendering of services, a connection between such goods or services and a person who uses the mark in relation to the goods or services referred to first or since 1960, an applicant has been using the term CARREFOUR for his worldwide supermarket sector.

The proprietor filed a passing-off complaint against the respondents for the use of the furniture name 'Carrefour' from July 2000. In the present case, in respect of the furniture, the trademark was not registered in India for the benefit of the

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claimant. It was, however, registered with respect to furniture in other countries and registered in India with regard to other products. Consequently, a significant segment of the public recognised and connected the goods of the applicants with the trade name 'CARREFOUR' and, in the course of trade, was likely to create a connection between the products of the respondents and that of the applicant. The court then concluded that "CARREFOUR" is a well-known trademark.

In a rather significant case, in *Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Union*, the Hon'ble Indian Supreme Court released a verdict on a controversy that has been going on for eternity. Through a dishonest finding of similarities in the documents, the Supreme Court finds that there is only a solitary way to save the objection of the respondent against the co-existence of the two registrations. In the Court's opinion, the respondent must show that its own registration comes within the scope of the expanded rights provided by Section 11(2) of the Trade Marks Act to well-known trademarks. Indeed, Section 11(10)(i) of the Act explicitly provides imprimatur for the defense of well-known marks in opposition proceedings such as this one. Excluding the Supreme Court, this clause persists.[1]

## II. DISCUSSION

The utter reasons for denial of registration was laid out in section 9 of the Trade Marks Act, 1999. The utter reasons for failure to register a trademark have to do with public policy. The statutory object of this section is to safeguard the rightful interest of merchants as well as of the public who are real and genuine customers of different trade marks in the form of signs, labels, trademarks, words, etc. obtained by them in relation to their goods/services.

Where the mark consists exclusively of the shape of the goods arising from the existence of the goods themselves; where the mark consists exclusively of the shape of the goods required for the technological outcome to be obtained;

However, as a result of its use, a trademark has gained a 'distinctive character' or is a 'well-known trademark' and no registration of the trademark is denied prior to the date of application for registration. The distinctive character that enables one to differentiate one person's products/services from others can be innate or acquired. It is also necessary to take into account the intrinsic characteristics of the trademark, so that the goods/services can be differentiated from each other.[2]

The problem concerned in *Hindustan Development Corp. v Deputy Registrar of Trade Marks*<sup>3</sup> based on the term "Rasoi" and whether or not it should be registered as a trademark for hydrogenated groundnut oil. It was held that the grammatical meaning of a symbol did not apply to the nature of the goods, but that it had to be viewed from the general public's point of view. For the general population, then, the term "rasoi" means cooking. The use of hydrogenated groundnut oil is for cooking purposes, which in turn forms a part of its character. The term "rasoi" then explicitly refers to the "character" of products.

In addition, even though the term "rasoi" did not explicitly impute the character or consistency of the nice, the word must be "distinctive" in order for it to be registered. Such distinctiveness must mean that the goods on which the label is used are the goods of the proprietor and that they are capable of discriminating between the goods of the proprietor and those of others. In addition, it should not be registered even though the word "rasoi" is unique since it is a generic word, and no one should use such words exclusively and deprive anyone of using the traditional words in a language that is publicly owned. The term "rasoi" could therefore not be reported in the instant case because it lacked distinctive characteristics associated with the appl.[3]

The term "Janta" used for electric torches was similarly tried for registration in *Geep Flashlight Industries v Registrar of Trade Marks*. The registrar declined to file on the basis that it was neither distinctive nor capable of discriminating between the applicant's goods and those of others. The term "Janta" is a generic word which is symbolic of the fact that the items are not pricey and therefore refers to the nature or character of the goods for the common man. The Supreme Court ruled in *J R Kapoor v Micronix India*<sup>5</sup> that the term 'micro' used for the manufacture of electronic products was indicative of microtechnology and, thus, no one should say that it was used exclusively.[4]

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In order to benefit from being a well-known trademark, the Court notes that the respondent must at least show that it had gained a distinction in the four years (1985 to 1989) that it was the only such trademark in Classes 29 and 30. The Court finds that there is no documented proof to show that this was so and authorizes the co-existence of the registrations on that basis. On the basis of these facts, three conjunctive conditions need to be met:

- (a) that, for products or services which are not equivalent to those of the respondent, the appellant shall apply to file an equal or similar trademark;
- (b) the use of the Appellant must be such that it takes undue advantage of, or is harmful to the registration of the Respondent; and
- (c) The trademark of the respondent must be a well-known trademark in India. This, in essence, may be translated in two ways: "non-like" goods or services which refer to goods or services of another class or may refer to goods or services of the same class, but other than the goods or services stated by the claimant.

To refer to the present case, this must mean the latter. The Court continues to test the case of the respondent in Section 11(2), although it fails to affirm whether the above view is preferred. Indeed, its sole point in this regard is that Section 11 'prohibits the registration of a [mark] in respect of related products or other goods, but does not refer to the provisions of this Section. Secondly, the Court finds that it is unconvinced that the trademark of the appellant was used in order to take undue advantage of the trademark of the respondent. Since the three sections of Section 11(2) are conjunctive, it is important to provide a positive finding here in order to avoid the registration of the Appellant. No such result is returned. This should have the effect of ending the enquiry under Section 11(2).

Instead, the Court goes back and questions why, between 1985 and 1989, the Respondent has displayed distinctive character. This is, of course, entirely pointless because the argument of the respondent on the "unfair benefit" plank has already collapsed. The Court may be working on that issue because the provision of 'unfair advantage' is not specifically delineated from the well-known requirement of a trade mark in Section 11(2) itself.

Overcoming Objection under Absolute Grounds for Refusal:

In order to explain the symbol, the claimant would have used it as a way of distinguishing the commercial origin of the goods;

The consequence of this usage is that, over the course of trade, the relevant public(or a large proportion thereof has come to rely on the label as a way of distinguishing the commercial origin of the goods;

Where a trade mark is just one of the numbers used by an undertaking to define the trade origin of the products, the Trademark Officer must be assured that, by itself, the trade mark applied for has fostered a concrete belief in the people concerned that the goods carrying the trade mark come from, or are regulated by, a single undertaking.

### III. CONCLUSION

Even though it is somehow important to proceed with challenging the well-known character of the Respondent's trademark, it is categorically beyond the reach of the misleading resemblance investigation ostensibly at issue here. Moreover, much more technically, two largely unobjectionable lower forum rulings before this Court should definitely not have been defended within the contemplation of a previous consumer respondent. From the aforementioned discussion, it can be inferred that the registration of a trademark mainly involves the 'distinctive nature' of a trademark, and that it is primarily the 'distinctive character' of a trademark used by the goods/services to be protected. It is through this distinguishing character of a trade mark that it is possible to recognise and differentiate the goods/services of an individual from those of others. In comparison, the norm required for the registration of trademarks is not very stringent.

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Therefore, as the reputation, identity and goodwill synonymous with the goods/services co-extensively with the trademark itself, a trademark is of considerable significance and importance.

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