

WHY SURNAME TRADEMARKS ARE CONSIDERED TO BE WEAK?

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We live along with a population of more than 1 billion belonging to different regions following different religions and customs. our incredible India is home to all the different individuals. Many of us share the same name as follower of similar traditions and practice. Carrying out business or other profession in our name has been in trend since ages as identity to whom the work belongs to. Getting one name as a trademark and as a unique identity on the other hand is contradiction to its protection of rights because we may share our name with many others.

When we talk about Success in the business world, we know that it particularly depends on the message you convey and the image you project in front of the world. **A trademark distinguishes a good from other competitors and helps to establish the identity in the market place.**

Starting of a business in India or in any other country, we see that most of the people keep their surnames or personal names as their company's name. it's not a new concept which we are talking about here, ample number of people use their surnames with their businesses to connect their identity with it and to promote their businesses by their own names. While using a surname we should be aware of its rareness and its secondary meaning of it, because there are a lot of similar surnames which may cause confusion for the public e.g. Singh and Singh, Singh and Singh associates, Khurana and Khurana etc. these surnames are common and are quite easy to create confusion for the public. A person who has a rare or uncommon surname, may get it registered and use it as trademark.

But the main concern here, is the protection and registration of such surnames, a person can register it but he cannot claim exclusive right over the mark i.e. surname and cannot even stop any other person from using it.

If we talk about it in legal terms, the trademarks act, 1958 under clause (d) of section 9 specifically refuses the registration of surname as trademark but however the new act i.e. the trademarks act, 1999 also has no provision to allow or disallow the use of the surnames or personal names. Under the act the definition of the word “mark” also doesn’t absolutely include or exclude any surname and personal names, so it is thus assumed that the registration of surnames and personal names are allowed but generally, it is stated that you cannot claim a monopoly over something which is common to many others.

The question here arises is if you get your surname registered and you cannot even stop anybody else from using it then what is the point of it?

The answer to this is, that if your mark has obtained distinctiveness over a period of time but before the date of application and it can also be shown by the way of any documentary proof, then the registry might grant your mark registration.

Position of surname trademarks in India: -

1. If a surname has no secondary significance i.e. which has no other meaning to it, then it will not be registered unless a proof of distinctiveness is provided because there can no differentiation in the same surname kept by any other person being a common surname.
2. If a surname has other meaning adjoined to it ex. Ms. Rachael greens then it may get registered without any proof of distinctiveness.

We are surrounded by plenty of surnames which have been registered like, Tata, Honda, Suzuki, Bajaj, Sony etc. These are some well-known marks which exists across the globe.

In a case at Delhi High Court it was contended by the petitioner, “The word AGGARWAL cannot be registered as a trademark unless distinctiveness is established on the part of the applicant. The provisions of Section 9 of the Trade and Merchandise Marks Act, 1958

(hereinafter referred to as “the 1958 Act”) were referred to by the petitioner to indicate that without distinctiveness, the word AGGARWAL, because it was both a surname and the name of a sect or caste, could not be registered.

We can understand it in detail while referring to some cases decided by the hon’ble courts of India.

1. Pratibha Singh v. Singh and associates: -

The plaintiff asserted that she coined the name “Singh and Singh” in the year 1997 when she started independent practice of providing legal services and has been continuously using the said mark since then and the said mark has acquired a secondary meaning in reference to the plaintiff, especially in the field of Intellectual Property law. The mark was registered in the year 2005. The plaintiff came to know about another law firm named "Singh and Associates" practising in IPR laws only. The plaintiff learnt that the Advocates working in the name and style of the defendant were making unsolicited approaches to the foreign associates and clients of the plaintiff in an obvious effort to confuse the plaintiff's clients and divert work to the defendant.

The court observed and stated that the defendant, during the pendency of this suit, shall use the logo, of which registration has been obtained, strictly as per the registration certificate, particularly as to the font, size etc. and shall use no other name / logo similar or deceptively similar to the plaintiff's registered mark. However, in order to ensure that none is led into believing even for a moment that —Singh & Singh|| and —Singh & Associates|| are one and the same and the possibility whereof the defendant also admits though pleads that the plaintiff was believed to be connected with the defendant, I direct the defendant to, while so using its logo, add the words —Founder Manoj K. Singh|| immediately thereunder. The defendant, if desires, to add any other words / inscription, shall have liberty to apply to the Court.

2. Mahindra and Mahindra v Mahindra and Mahindra

An infringement suit was filed by Mahindra and Mahindra (plaintiff) against Mahindra and Mahindra Seeds Pvt Ltd (defendant) for using a deceptively similar mark. The Court decided the matter in favour of the plaintiff and observed that though the word "Mahindra" is a common surname in India, the plaintiff had acquired distinctiveness and secondary meaning of the word "Mahindra" with its continuous use and if used by the defendant even in regard to different field of activity, it would surely result in creating confusion in the public mind that it belongs to the plaintiff.

In our incredible India which is known to world as unity in diversity, people add surname to show their background where they belong to, like region or district, hence getting trademark for the same may prove to be a weak trademark as every individual having similar background will share the similar surname. We are actually surrounded by ample number of common surnames which are being used as trademarks in many people's businesses. If we talk about the key to protect such surnames, it's just the distinctiveness of surnames, but still after the distinctiveness it cannot guarantee exclusive rights over such trademark. So, a surname which is being used by a person as a company's name should be rare and unique with a proof of distinctiveness only then, it can be registered otherwise there is no such law which states that a surname can be registered it's just the assumption we make and claim for.