

JUDICIAL STANCE ON TRADEMARK PROTECTION FOR ACRONYMS & ABBREVIATIONS IN INDIA

POOJA*

ABSTRACT

In today's world, people refer to products with acronyms/abbreviations rather than the full form, as it remains in the minds of people strongly. However, the law does not provide for the automatic registration of acronym of a registered trademark. It is considered autonomous to the registered trademark. It is critical to examine the deceptive similarity in the marks by a change in one letter. If there are two acronyms with different full forms, can they be allowed to be used it concurrently as they convey different meaning? These are some of the questions that need to be answered by the court before determining the case of the acronym. However, the judicial stance taken in the issue of acronyms is different in each case. The nuances of the judicial stand on protecting acronyms and the current dispute of the acronym KSRTC between the state of Kerala and Karnataka is also examined in this paper.

Keywords: *Acronyms, abbreviations, trademark, deceptive, KSRTC.*

* LLM in Intellectual Property Law, Christ (Deemed) University, Bengaluru, [Email:gurupooja1999@gmail.com](mailto:gurupooja1999@gmail.com).

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Introduction

A person registering a trademark under the Indian Trademarks Act, 1999 have exclusive right over the same. In order to gain exclusive rights over the acronym/abbreviation of such a word, the person should file another application separately for such an acronym. The word/phrase protected by the proprietor is protected as it is. The proprietor willing to gain protection for an acronym of such a word/phrase has to go through the same process of registering any other mark. This shows that there is a bar in the automatic registration of acronyms/abbreviations of registered marks. The acronym independently should satisfy the conditions of Section 9 and Section 11 of the Act. The acronym should be devoid of distinctiveness and it should not be deceptive/identically similar to any other mark.

Most consumers refer to products or services by their acronym, it is because the acronym of a word/phrase retains in the memory of a person for a long time than its full form. Therefore, the main function of a trademark is the origin function which is enhanced by the registration of acronyms.¹ The deceptively/identical acronyms may cause confusion to the public. For example, KFC, BMW, and BCCI are some of the popular acronyms, of which many people will not be aware of the full-form. Only a few people who are interested in the subject matter of the acronym will be aware of its full form. The target audience interested in sports, particularly cricket, will know the full form of BCCI is the Board of Control for Cricket in India. If any mark deceptively similar to BCCI comes into the market, then it causes confusion to the target audience.

The basic conditions for trademark registration are that it should be capable of graphical representation, inherently distinctiveness, or should acquire distinctiveness through use. In addition to that, it is very important that the acronym should not be generic or descriptive. Acronyms are capable of graphical representation, so the first condition is satisfied. However, the nature of the acronym whether descriptive or distinctive can be decided only on a case-by-case

¹ Lisa P. Lukose, Consumer Protection vis a vis Trademark Law, 1 IJCLP 89 (2013).

basis. The Indian judiciary has treated the cases of acronyms differently in each case. The contentions of the parties and observations of the court in each case have to be keenly examined to have a conclusion in the judicial stance on trademark protection of acronyms/abbreviations.

Statutory Protection Given to Acronyms

Under the Trademark Act, of 1999, section 2(1)(m) is about the definition of a mark. In which the mark is said to include "letters". In addition to that, the definition of a name under Section 2(o) of the Act, includes the abbreviation of a name. This shows that the Trademark Act, 1999 includes provisions for letters as well as the abbreviation of names. In the Trademark Rules, 2017, Form TM-A provides for the procedure to register the trademark, in which the category of the word mark is given, which is inclusive of one or more letters. This shows that the letters can be applied for the registration of the trademark. It can be a single letter or two or more letters.

Moreover, in the trademark manual, the concept of distinctiveness under section 9 is discussed, which provides that even a single letter or more letters can attain distinctiveness. Also, it throws light on the tendency of using the abbreviation of names in the course of trade. These abbreviations are open to objections as similar to any other mark is also provided in the manual. Similarly, in international agreements, the aspect of trademark protection of acronyms or letters is provided. For example, in the TRIPS agreement, Article 15 talks about the protectable subject matter, which includes the category of letters.² Therefore, it is evident that the statutory provisions are in support of trademark protection assigned to acronyms. Even though in many places, the term "acronym/abbreviation" is not explicitly mentioned. They give protection to the category of one letter or more than a single letter. However, even though there are statutory protections given to them, there are many issues that arise in invoking statutory rights. This can be seen in a plethora of cases, some of the important cases are highlighted in this article.

Issues Involved in Protecting Acronyms

The issues faced by the proprietor are either the acronym was not eligible for registration or any other deceptively similar mark came into existence in the market which may cause confusion to

² Dev Gangjee, Quibbling Siblings: Conflicts between Trademarks and Geographical Indications, 82 CHI.-KENT L. REV. 1253 (2007).

the public in relation to the mark of the proprietor. Firstly, the mark gets rejected for protection if it is not devoid of distinctive under Section 9 of the Act which provides the absolute grounds for the rejection of a trademark. The distinctiveness can be acquired inherently or through use it can attain secondary meaning, that is acquired distinctiveness. The Spectrum of distinctiveness established in the popular, safari case³, is important to be examined at this point. The spectrum moves from a higher degree of protection to a lower degree of protection. The fanciful marks stand in the stronger rank for protection; however, the generic or descriptive words are in the weaker rank for protection. Now the question arises whether the acronyms of a generic term or descriptive terms can be protected. Even though the word/phrase is descriptive, it can get protection if the acronym/abbreviation of such word/phrase has attained distinctiveness.

The term “cutting room appliances”⁴ was considered to be a descriptive term, its acronym "C.R.A." was held not to be distinctive and was not eligible for trademark protection. However, in another instance, the acronym of continuous vision⁵ being "CV" was considered to be distinctive even though the full form is descriptive and generic in nature. The distinction that can be drawn from both instances is that the C.R.A. was held not to be distinctive as the consumers refer to the product as CRA and it was generic in the market. However, the CV used for the multi-focal lens was not used commonly in the market. Therefore, it did not have a generic element, even though continuous vision is generic in the market. The determination of significance given by the public with regard to the acronym is vital.⁶ If the acronym is used as a synonym for the product, then it is generic, however, the CV was not synonymously used for the multi-focal lens, and therefore it is held to be distinctive. Each case can be decided based on its facts and circumstances and a general rule cannot be laid down in this regard.

The next major issue faced by the proprietor is when there is any other mark existing in the market that is identical/deceptively similar to the registered mark. Even a change in one letter of the acronym is considered to be deceptively similar if it causes a likelihood of confusion under Section 11 of the Act and the relative grounds for rejection of trademark applies in such cases. The courts grant an injunction if they found two acronyms are deceptively similar. Sometimes the claimant

³ *Abercrombie v. Hunting world*, 537 F.2d 4 (2d Cir. 1976).

⁴ *Breth v. Cutting Room Appliances Corp.*, 57 U.S.P.Q. (BNA) 46, 4 (Com'r Pat. & Trademarks Jan. 1, 1943).

⁵ *Modem Optics, Inc. v. Univis Lens Co.*, 234 F.2d 504 (C.C.P.A. 1956).

⁶ *Mary LaFrance, Initial Impressions: Trademark Protection for Abbreviations of Generic or Descriptive Terms*, 45 AKRON L. REV. 201 (2012).

faces difficulty in proving the deception that is caused. The claimant should have established a well-known status of his mark among the public and should also prove the change in one letter of the acronym may also cause confusion that may harm his reputation and goodwill.

In addition to this, if two users are present for the same acronym then the first user in the market or the prior user of the mark in the market gets protection in trademark law as per section 34 of the Act. The prior has the vested rights over the mark, so he has the right to prevent others from using it subsequent to him. Another question that is dealt with in this paper is what happens when there are users in the market for the same acronym and both have attained secondary meaning through use. Can the prior use be applied in such cases or the honest and concurrent use of the mark be provided to them? This is substantiated by the contemporary issue of the KSRTC mark. The mark that both the state of Kerala and Karnataka uses for a long time. Even though the state of Kerala was the first user of an acronym in the market, people have attributed secondary meanings to the mark of both states. In such cases, will the public interest prevail over the stipulations of trademark law? Many people argue that honest and concurrent use should be given to both states. In the next following parts, we would be discussing each of these issues in detail.

Distinctiveness of acronyms

As we have already seen that in the spectrum of distinctiveness, descriptive words are attributed to weaker protection. However, the acronyms can get secondary meaning through usage and get protection under acquired distinctiveness. Mostly, in India, the acronyms of descriptive words are not given protection under trademark law. In the case of *Bharat Biotech International Ltd v. Optival Health Solutions Pvt. Ltd.*,⁷ the acronym in dispute was "TCV" which is substantiated as Typhoid Conjugate Vaccine. The plaintiff had registered for both the "TCV" and "TYBAR-TCV" marks, he had established that his mark is a well-known trademark as per 2(1)(zg) of the Act. The defendant contended that the mark "TCV" is generic in nature and is very common in the medical community. The mark of the defendant was ZYVAC-TCV, so he submitted that removing the generic term from his mark leaves only "ZYVAC" and "TYBAR", which shows no similarity, therefore no infringement. The court observed that the TCV was descriptive and generic in nature. The registration for such a mark was held to be invalid and the exclusion of TCV results in prefix

⁷ *Bharat Biotech International Ltd. v. Optival Health Solutions Pvt. Ltd.*, (2020) 269 DLT 296.

only, which is different in both marks, therefore it was held to be no infringement. The ratio of this case proves that if the acronym is used commonly in the market and describes the product which helps the consumers to connect the acronym directly to the product is descriptive in nature and is not liable to be protected under trademark law.

On the other hand, if the acronym is a newly coined word and is distinctive in the market, then it can get trademark protection. The mark "Liv" for liver was considered to be distinctive.⁸ It was observed that the plaintiff has coined this word and it is not a commonly used word in the market. The division bench of the high court reversed the single bench order and held that the word "Liv" is not in *publici juris*. Such a word is not used in common parlance and is not constrained to the public right. The court was against the anti-dissection rule in this case. It was observed that the two marks laid down for comparison should be seen as a whole, and they should be dissected and compared. The overall similarity test was upheld in this case for checking the deceptive similarity in two marks. The doctrine of essential feature states that when the dominant feature of the mark belonging to the proprietor is copied by any other person, then it is considered an infringement. The consumers may refer to the product in the market with such an essential feature, therefore two products in the market cannot have the same essential feature in order to prevent the likelihood of causing confusion.

The distinctiveness through secondary meaning can be attained by using the mark for a long time. The unregistered trademark can also get protection by using the mark for a long time. The proprietor should prove that his mark has become well-known by providing the sales and turnover in the court. In the popular acronym case of VIT university⁹, the court observed that the long and uninterrupted use of the acronym "VIT" has attained secondary meaning. Illegal appropriation by using such marks is always prevented to protect the reputed mark from damages. Similarly, in L & T case¹⁰, the court observed that dissimilarity in products given by the parties cannot be an excuse for using the same acronym. Also, the mark of Larsen and Turbo is a well-reputed mark that cannot be infringed for the such non-material difference in product or class of goods. The mark "LNT" was held to be phonetically similar to the mark "L&T". It should be noted that to

⁸ Himalaya Drug Company v. S.B.L. Limited, (2012) 194 DLT 536 (DB).

⁹ VIT University v. Bagaria Education Trust, (2016) 67 PTC 120.

¹⁰ Larsen and Toubro Ltd. v. Lachmi Narain Trades, (2015) 64 PTC 386.

deceive someone is different from causing confusion. The element of intentionally lying is present in deceiving, therefore such actions can never be permitted for trivial contentions of the infringer.

If there is the presence of malicious intent on the part of the infringer, then the damages have to be paid for such actions. If the mala-fide adoption of the acronym of the plaintiff can cause a huge irreparable loss to him, a permanent injunction is usually granted by the court. The mark "UFO" has gained popularity in the Indian market.¹¹ The defendant contended that the mark UFO used by the plaintiff is an arbitrary mark, however, the defendant used it as an abbreviation of "Under fourteen only". The court did not accept this contention and held that the use of mark UFO was a mala-fide adoption. The arbitrary arrangement of letters forms an acronym or abbreviation, such arrangement makes them distinctive. However, the acronym with mere initials of names without distinctiveness will be considered ordinary English alphabets and no protection will be given to such marks.¹² The letter "P.P." was considered a mere arrangement of letters from the initials of their names and there is no distinctiveness.¹³

Change of one letter of the acronym

Two marks are considered identical or deceptively similar by comparing the marks in question. If the common layman is confused by the appearance of marks, then it is considered to be deceptively similar. The use of such marks by two users is not allowed in the trademark law. Even if there is a change in one letter in the acronym, if it is liable to cause confusion to the public, then it is prevented from using. In Ram Krishnan v. ILM Consulting Pvt. Ltd. case¹⁴, the mark "IILM" and "ILM" was held to be deceptively similar. Both marks were used in the field of educational and recruitment services. The defendant has just added one more letter to the mark, which does not make it different from the plaintiff's well-known mark. The court restrained the defendants from using both the mark as well as the domain which were deceptively similar. If a mark has gained a trans-border reputation, then they are considered to have a commercial presence in India as well.

¹¹ Ufo Contemporary, Inc. v. Creative Kids Wear, CS (COMM) 375/2020.

¹² Russ Jacobs, The Impact of Nameness, Race, Orthography, and Population on Trademark Registration of Surnames, 22 J. GENDER RACE & Just. 185 (2019).

¹³ P.P. Jewellers Pvt. Ltd. v. P.P. Buildwell Pvt. Ltd., ILR (2010) II Delhi 165.

¹⁴ Ram Krishan & Sons Charitable Trust v. ILM Consulting Pvt. Ltd., 2017 SCC OnLine Del 8371.

If the marks are used by one party as a label mark and the other party as a word mark, then they should be examined differently.¹⁵

Two claimants for one acronym

If two people claim for one acronym, then the prior user of the mark is given preference over the subsequent users. The first user in the market principle is followed. To prove prior use, the person should either show he was using the mark before the other party, or he has registered the mark before the other party. Either one of them should be proven in order to gain protection over the mark. In Mahindra and Mahindra's case¹⁶, the defendant was not able to prove either of these conditions. The plaintiff made a strong prima case as they were prior users in the market and have gained a well-known status in the market. The mark of Mahindra company "M&M" has attained secondary significance in the market. Such types of cases are easily disposed of as the plaintiff has well-reputation in the Indian market and the consumers provide them with secondary significance.¹⁷

In the GlaxoSmithKline case¹⁸, the court observed that the likelihood of confusion in the industry of pharmaceuticals should be closely examined as it can cause tremendous effects if wrong products are given to the public. Judicial scrutiny is usually high in such cases. Therefore, the mark "GSK" used by the defendant was prevented as the mark was already existing in the market which belonged to the plaintiff. The problem arises when two claimants using the same mark have gained significant secondary meaning in the market. It would be difficult for the courts to decide in support of either of the mark. This is could be seen with the case study of the mark "KSRTC".

Case study: The battle over the mark "KSRTC"

The Kerala State Transport System started using the abbreviation KSRTC before the state of Karnataka. The prior use/first user in the market vest in the state of Kerala. They started services in 1965, on the other hand, Karnataka started using it in 1974. Both transport systems have been using the same parking lot, booking counters, and management for many years. Moreover, Kerala

¹⁵ International Student Identity Card Association v. Abhishek Tiwari, (2017) 71 PTC 554.

¹⁶ Mahindra & Mahindra Limited v. MNM Marketing Pvt. Ltd., (2014) 60 PTC 227.

¹⁷ Science Olympiad Foundation v. Shivalik Olympiad Foundation, (2015) 64 PTC 564.

¹⁸ GlaxoSmithKline Pharmaceuticals Ltd v. Sarath Kumar Reddy, (2017) 69 PTC 160.

has filed a rectification against Karnataka. The war has been going on for a long time. The press stamen released by Kerala is factually incorrect as there is no order of registry conferring the exclusive right of the acronym "KSRTC" to Kerala.¹⁹ The reply statement was also made by Karnataka about the same. They submit that there is no such notification from the registry restricting the use of the KSRTC mark.²⁰ The trademark search report also proves that there is no such order, as the report shows that both marks are allowed to be used now by both states. The current status of the trademark proves that concurrent use has been going on by both states. The rectification filed by Kerala is still pending in Madras High Court. However, no explicit bar has been imposed in either of the states from using the mark "KSRTC".

Pursuant to this, the question arises can the honest and concurrent mark be given to these states and allow them to use the mark without any restrictions? The questions that have to be answered before providing honest and concurrent use are:²¹

- a) Whether there is honesty in the use of the mark?
- b) What is the quantum of use of the such mark?
- c) What is the degree of resemblance between the marks?
- d) Are there any cases that prove the confusion caused due to the concurrent use of the mark?
- e) Whether any inconvenience will result due to that concurrent use?

Both states have used the mark honestly. In many of the states' transport systems, the use of "SRTC" is common. With that acronym, they add the first letter of the name of the state. For several decades, honest use has been continued. The trademark search report shows that the word mark is registered in combination with the logo of the transport system. So, the state can use the acronym only with the registered logo. This condition helps in reducing confusion among the public. The bus colour, logo, word, and number plate all indicate to which transport system it belongs. These aspects show that the likelihood of confusion is suppressed by the transport systems.

¹⁹ Yashvardhan Rana, "K" SRTCs Trade Mark Row: Paving the Right Path, (2021) SCC OnLine Blog OpEd 135.

²⁰ Nikhil Purohit, *Kerala and Karnataka Tussle Over the 'KSRTC' Mark: Registrability, Concurrent Use, and Infringement*, spicyIP, <https://spicyip.com/2021/06/kerala-and-karnataka-tussle-over-the-ksrtc-mark-registrability-concurrent-use-and-infringement.html>.

²¹ Kores (India) Limited v. Khoday Eshwarsa, 1985 (1) BomCR 423.

The inconvenience will be caused to the public if any of the transport systems is restricted from using the acronym. Both the states have attained secondary meaning through use and the public got used to such usage. Any changes brought in the mark of any of the states will lead to damage to the public interest even though it's against the rule of prior use under the trademark law. There have been no cases of confusion reported till now. This shows that both marks can exist in the market without any inconvenience. In addition to that, section 12 of the Trademark Act also vests the discretionary power of the registrar by including the term "other special circumstance" for permitting more than one person as the owner of a mark. However, such power can be used only in special circumstances²² and the KSTRC issue has the full potential to fall under this special category. The mandate of section 12 also ensures that the public is given notice about the concurrent use of marks in order to avoid confusion among the public. This provision allows rival traders to sue the same mark as both of them had acquired distinctive through their trade.²³ Therefore, both states can be allowed to use the mark KSRTC at the same time and end their battle over intellectual property right.

Conclusion

The Trademark law has treated acronyms/ abbreviations autonomously to their full form of it. The proprietors face many hurdles in gaining the protection of acronyms. Even though the word/phrase is distinctive, that does not make the acronym inherently distinctive. It has to attain distinctiveness through use by gaining secondary meaning. Most of the courts examine the marks based on the spectrum of distinctiveness to decide whether protection can be given. Judicial scrutiny should be high in cases of acronyms, as a change in one letter also may cause confusion in the minds of the people. The infringers should not be allowed to free-ride on the goodwill and reputation of the rightful owner of the mark. The various cases seen in this article show that the judicial stance is very promising in protecting the acronyms under trademark law. Even though the war over the mark KSRTC is unsolved, if the states are given honest and concurrent use then it will uphold the public interest to a larger extent.

²² London Rubber Co. Ltd. v. Durex Products, AIR 1963 SC 1882.

²³ Goenka Institute of Education v. Anjani Kumar Goenka, ILR (2009) VI Delhi 415.