

Trade Marks Ordinance, 2001 on Distinctiveness

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Distinctiveness in trademarks provides that any sign or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. These may include, in particular, personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs. Andrew Inglis, Olswang defines the distinctiveness in these words,

“...Distinctiveness in relation to trade marks refers to the capacity of the mark to distinguish the goods or services of its proprietor from the goods and services of others. The more distinctive a mark, the more likely it will be that broad rights attach to it...”

Capable of distinguishing The capacity to distinguish goods or services is fundamental to the concept of a trade mark. Invented words and devices are generally capable of performing that function but there are some that are not either because they are devoid of distinctive character, they consist of signs or indications that designate the kind, quality, quantity, intended purpose and so on of the goods or services concerned or because they have become customary in the current language or bona fide and established practices of the trade. However, even some of those marks of that kind can in time acquire distinctiveness through sales and advertising. The level of distinctiveness required for a distinguishing guise is higher than for an ordinary mark, therefore, there are fewer of them.

Acquiring distinctiveness To acquire distinctiveness in trademark, the applicant's trademarks must not be devoid of any distinctive as mentioned in clause (b) of subsection (1) of section 14 of Trade Marks Ordinance, 2001 is related with absolute grounds for refusal of registration, “...trade marks which are devoid of any distinctive character;...” Trade Marks which are devoid of any Distinctive Character in *British Sugar Plc v James Robertson's and Sons Ltd* Jacob J suggested that a trade mark that is devoid of any distinctive character is the sort which cannot do the job of distinguishing without first educating the public that it is a trade mark. In this context, the Court of First Instance

observed in *Baby-Dry*¹, that the distinctive character of a sign must be assessed in relation to the goods or services in respect of which registration is claimed. The subsection 1 of section 15 of trademark Ordinance 2001 has laid down considerations for any tribunal to decide on distinctive character of trademarks, “... A trade mark may be limited wholly or in part to one or more specified colours, and any such limitation shall be taken into consideration by any tribunal having to decide on the distinctive character of the trade mark...” The section 17 of Trade Mark Ordinance, 2001 provides that a trademark is a detrimental to the distinctive character shall not be registered. The Section 84(2) reading with section 2 of THIRD SCHEDULE of trade Mark Ordinance 2001 deals with use of a domain name shall be taken as source identifier if it is used on Internet to distinguish goods or services of one undertaking from the other provided that use of a domain name as a mere distinctive reference. A mark, which is inherently not distinctive Exception to clause (b), (c) or (d) of Section 14 of trademarks Ordinance 2001

“... provided that a trade mark shall not be refused registration by virtue of clause (b), (c) or (d) if, before the date of application for registration, it has, in fact, acquired a distinctive character as a result of the use made of it or is a well known trade mark...”

The Inherent distinctiveness of all the trademarks resulted in part from its statutory right. A mark not distinctive (e.g. descriptive) may acquire distinctiveness through use.

The distinctiveness of Trade Marks as a series The clause (c) of subsection 3 of section 20 of trade Mark Ordinance, 2001 other matter of a non-distinctive character added as part of trade mark series, if any, shall not affect the identity and distinctiveness of the trade marks, provided non-distinctive character which does not substantially affect the identity of the trade mark.

The affect of lose of distinctiveness The subsection 2 of section 73 of trade Mark Ordinance, 2001 for the purposes of the registration of a Trade Mark may be revoked, if use of a trade mark shall include use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.

A new interpretation of the distinctiveness of a Trade Mark Many national authorities that symbol comprising two non-distinctive words were non-distinctive and ineligible for registration. The *BABY-DRY 1* judgment seemed to change this interpretation.

It was the view that an assessment of distinctiveness must consider whether the word combination in question is understood in ordinary-language use as a normal way to refer to the goods in question or represents their essential characteristics in common parlance.

Conclusion A trade mark shall not be registered unless it contains or consists of at distinctiveness, the name of a company, individual, or firm, represented in a special or particular manner; one or more invented distinctive words; one or more words having no direct reference to the distinct character or quality of the goods, and not being according to its ordinary signification, a geographical name or surname or the name of a sect, caste or tribe in Pakistan; any other distinctive mark, provided that a name, signature, or any word, other than such as fall within the descriptions in the

above clauses, shall not be registered except upon evidence of its distinctiveness. The writer is an advocate of High Court and practicing immigration and corporate laws in Pakistan since September 2001. Author can be contacted by Adil Law Company (Advocates and Immigration lawyers) Office No.3 2nd Flr Hafeez Chambers 85 The Mall Rd Lahore Pakistan Telephone: +9242-6306195 +9242- 6360108 Fax: + 9242 6360108 Cell: +92300 4254910 E-mail: adil.waseem@lawyer.com