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NAME AS A TRADEMARK: COMPARATIVE ANALYSIS BETWEEN INDIA, USA, AND UK

Within the ever-changing realm of intellectual property law, the application of personal names as trademarks represents a noteworthy aspect of non-traditional trademarks, engendering substantial discourse and legal examination in numerous jurisdictions. It is worth mentioning that registration and protection of personal names as trademarks are regulated by distinct legal systems in countries including the United Kingdom, India, and the United States. In light of this context, the TRIPSⁱ Agreement functions as a paradigmatic legal instrument that directs the strategies of these countries, acknowledging the importance of trademarks as components of a wider array of intellectual property rights. This article undertakes a comparative analysis to examine the manner in which these nations maneuver through the complexities associated with the utilization of personal names as trademarks. It does so by utilizing TRIPS as a governing principle to shape the legal environments of these countries.

India Perspectiveⁱⁱ:

The journey of using surnames as trademarks in India has seen significant evolution, particularly with the enactment of the “Trademark and Merchandise Act, 1958”. Initially, the registration of surnames as trademarks faced refusal under section 9(1)(d)ⁱⁱⁱ. However, the landscape has transformed with the introduction of new legislation, leaving room for interpretation due to the absence of explicit provisions regarding the use of surnames or personal names as trademarks.

Under the current legal framework i.e. “The Trade Marks Act, 1999”, the definition of “mark” under section 2(1)(m)^{iv} of the Act “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.” The Act neither explicitly includes nor excludes surnames and personal

names, but rather mentions "name," implying the possibility of such registrations. Despite the challenges in protecting surnames as trademarks, many well-known brands in India effectively utilize surnames, such as Tata, Bajaj, and Mahindra and Mahindra, which have achieved "well-known" trademark status.

Legal precedents in India, such as the **Mahindra and Mahindra Paper Mills v. Mahendra and Mahendra Ltd**^v case, highlight the importance of acquiring distinctiveness and secondary meaning through continuous use when protecting surnames as trademarks.

Therefore it is required that in order to name get registered as trademark it should be distinctive and have acquired secondary meaning.

USA Perspective^{vi}:

In the United States, the legal landscape surrounding the use of personal names as trademarks is multifaceted. While there is no absolute right to use one's own name as a trademark, certain circumstances allow for its use under U.S. trademark law. However, a mark that is "primarily merely a surname" cannot be protected without proof of acquired distinctiveness. 15 U.S.C. § 1127^{vii} explains about the different kinds of marks.

Generally, five factors will be considered to determine if acquired distinctiveness must be shown:

Whether the surname is rare;

Whether the term is the surname of anyone connected with the applicant;

Whether the term has any recognized meaning other than as a surname;

Whether it has the "look and feel" of a surname; and

Whether the stylization of lettering is distinctive enough to create a separate commercial impression.

The U.S. trademark law emphasizes the inherent distinctiveness of personal names, especially when used in combination with first names or initials. Legal cases like *In re P.J. Fitzpatrick, Inc.*^{viii} demonstrate how the addition of initials can alter the commercial impression of a surname, thus affecting its trademark status.

UK Perspective^{ix}:

In the United Kingdom, the registration of personal names as trademarks is generally permitted, except for the names of members of the Royal Family. The UK Intellectual Property Office (UKIPO) allows trademark applications that include first names, surnames, or both, provided that written consent is obtained from the individual concerned for famous individuals. As per Section 1 of the Trade Marks Act, 1994, “A trademark may, in particular, consist of words (including personal names), designs, letters, numerals, colors, sounds or the shape of goods or their packaging.”

- Legal considerations in the UK, as demonstrated in cases like **Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd^x**, underscore the importance of honesty and integrity in using personal names in trade. The UK Trade Marks Act 1994, section 11(2)(a)^{xi}, allows individuals to use their own name in trade without infringing on a registered trademark, providing a defense against claims of infringement.

Comparative Analysis:

Across all three jurisdictions, certain common themes emerge in the approach to using personal names as trademarks. The concept of acquired distinctiveness plays a crucial role, requiring proof of secondary meaning in cases where a name is primarily a surname. Additionally, the use of personal names must be genuine and not misleading, with legal safeguards in place to prevent unfair advantage or confusion among consumers.

In terms of registration requirements, while the UK and India generally permit the registration of personal names as trademarks, the USA adopts a more stringent approach, emphasizing the need for acquired distinctiveness. Furthermore, the UK stands out for its requirement of obtaining consent from famous individuals for trademark applications using their names.

Conclusion:

Ultimately, the comparison of utilizing personal names as trademarks in India, the USA, and the UK highlights the varied legal environments and strategies employed by each nation. Although there are commonalities in acknowledging the significance of acquired distinctiveness and secondary meaning, variations in registration criteria and judicial precedents influence the precise implementation of trademark law. The basic objective remains constant: to guarantee fair competition, safeguard consumer interests, and maintain the integrity of intellectual property rights, despite any differences. Understanding the legal framework of each jurisdiction is crucial for firms and individuals dealing with trademark registration and enforcement. Stakeholders can protect their brands and identities in the global marketplace by utilizing legal concepts and precedents, which can encourage innovation and stimulate economic progress.

- ⁱCenter for Policy Analysis on Trade and Health, "Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), <http://www.cptech.org/ip/texts/trips/15.html>, (accessed Feb. 27, 2024).
- ⁱⁱ Zoya Nafis, "What's in a Name? Registration of Surnames as Trademark" (2015), <https://www.mondaq.com/india/trademark/410700/whats-in-a-name-registration-of-surnames-as-trademark> (last visited February 27, 2024).
- ⁱⁱⁱIndianKanoon,[https://indiankanoon.org/doc/344332/#:~:text=\(1\)A%20trade%20mark%20shall,applicant%20f or%20registration%20or%20some](https://indiankanoon.org/doc/344332/#:~:text=(1)A%20trade%20mark%20shall,applicant%20f or%20registration%20or%20some) (last visited Feb. 27, 2024).
- ^{iv} IndianKanoon, <https://indiankanoon.org/doc/493060/> (last visited Feb. 27, 2024).
- ^v Umang Raj, "Mahendra And Mahendra Paper Mills vs Mahindra And Mahindra Ltd.", <https://www.legalservicesindia.com/article/1668/Mahendra-And-Mahendra-Paper-Mills-vs-Mahindra-And-Mahindra-Ltd.html> (last visited February 27, 2024).
- ^{vi}Igor Demcak, "Can You Use a Personal Name as a Trademark?", <https://www.tramatm.com/blog/category/legal/can-you-use-personal-name-as-a-trademark> (last visited February 27, 2024).
- ^{vii} "15 U.S. Code § 1127,<https://www.law.cornell.edu/uscode/text/15/1127/>, (last visited February 27, 2024).
- ^{viii} re P.J. Fitzpatrick, Inc., 95 U.S.P.Q.2d 1412 (TTAB 2010), <https://www.ny-trademark-lawyer.com/can-you-use-your-name-as-a-trademark.html> (last visited February 27, 2024).
- ^{ix}Karolina Fryzlewicz "Registering Personal Names as Trade Marks: Steps to Consider Before Naming a Fashion Brand After Yourself," <https://www.mewburn.com/news-insights/registering-personal-names-as-trade-marks-steps-to-consider-before-naming-a-fashion-brand-after-yourself#:~:text=Can> (last visited February 27, 2024).
- ^x Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd, [2010] EWCA Civ 110 (Court of Appeal 24 February 2010), [https://uk.practicallaw.thomsonreuters.com/D-0118451?transitionType=Default&contextData=\(sc.Default\)&firstPage=true](https://uk.practicallaw.thomsonreuters.com/D-0118451?transitionType=Default&contextData=(sc.Default)&firstPage=true) (last visited February 27, 2024).
- ^{xi} Trade Marks Act § 11, Pub. L. No. 26, 1994, <https://www.legislation.gov.uk/ukpga/1994/26/section/11> (last visited February 27, 2024).