

“All You Need to Know about Single Letter Trademark”

Sarthak Potdar
Symbol Law Firm

Intellectual Property is one of the most essential elements of the modern business. Intellectual property includes copyright, trademark, design, geographical indication, patent, industrial design, integrated circuit, which is a valuable asset of any company. It tries to create healthy competition; the manufacturer and traders can develop their products more effectively, without any theft of goodwill and Intellectual Property.

Trade mark is a part and parcel of Intellectual Property Right. The Trade Marks Act, 1999 under **Section 2 (zb)** defines “trade mark” as a mark capable of being represented graphically and it is capable of differentiating the goods or services of one person from another and on the basis of goods, their packaging and combination, use of colours.¹

The definition of ‘mark’ under **Section 2(m)** of the act states that which enumerates a mark to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination, use of colours or any combination.² In short, a trademark is a symbol which is capable of distinguishing between goods or services of one another.

There has been a major evolution of trademark, Major of the Indian Laws originated from English Laws which were substantially in force while formulating Laws prior to Indian Independence. Subsequently, requests were made to the Bombay Government introducing a Bill in the Bombay Legislative Council on the lines of the English Act. There was a need for a law exclusively for addressing trademark practice and procedure and to govern infringement of trade mark in India, which eventually led into the Trademark Act, 1940. The Trademark Act, 1940 reflected the provisions under the UK Trademark Act, 1938. The Trademark Act, 1958 is in accordance with the provisions associated with trademarks in the Indian Penal Code, Criminal Procedure Code and Sea Customs. The Trademark Act, 1958 was thereafter repealed by the Trademark Act, 1999 which governs trademark law in India.

Trademark provides protection to the owner of the mark by giving him exclusive rights to use in order to identify the goods or services or authorize another in return of payment. It works like a weapon in the hand of the owner of the trademark. Owner of the mark can stop other traders from unlawful use of their mark. Under **Section 28**, the registration of a trade mark shall give to the registered proprietor to whom the trademark belongs, the exclusive right of the mark lies with the owner in terms of the goods and services and to obtain relief in respect of the trademark under the Act. The proprietor of a trade mark has a right to file a suit for infringement of his right.

¹ Section 2(zb), Trade Marks Act, 1999.

² Section 2(zb), Trade Marks Act, 1999.

Trademark can be said to be a weapon of law, which protects your firm's Intellectual Property.

The basic question which arises is – Whether you can own a letter, which in a way is right, but in a way, is very wrong. The question is, even if you get a letter to be your registered trademark when there's 19,000 other ones. How is someone going to differentiate yourself in the marketplace from all the other one and even if you can get it as a registered trademark, what value does it have.

Two essential ingredients for Trademark registration

Section 18 (1) of the Trade mark Act, 1999, states that any person claiming to be the proprietor of a trademark used or proposed to be used by him may apply in writing in prescribed manner from registration. The application must include the name of the mark, the information about goods and services, the class in which goods and services fall, name and address of the applicant, period of use of the mark all these things needs to be specified.³

- **Represented graphically**– ‘Graphical representation’ has been defined under **Section 2(1) (k)** as representation of a trademark for goods or services represented or capable of being represented in paper form and include representation in digitized form. This essential is a must for qualification as a valid trademark merely implies that the mark should be capable of being put on the register in a physical form.⁴
- **Distinguishing Good and Services**- The definition of “trade mark” under **Section 2(1)(zb)** of the Act states that a mark “which is capable of distinguishing the goods or services of one person from those of others or one another”.. That a trademark must be distinctive and not be devoid of a distinctive character or letter.

Infringement is a breach as well as violation of another's right. The Trademark Act states that, Registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered. Infringement of trademark means use of such a mark by a person other than the registered proprietor which nearly resembles the mark of the registered proprietor as is likely to cause confusion and in relation to goods in respect of which it is registered.

TRADEMARK – LETTERS AND NUMBERS

In **section 2(1)(m)** of the Trade Marks Act, the definition of the expression “mark” includes inter alia “letter” and “numeral”. The definition of “trade mark” means “a mark capable of distinction” The law therefore recognizes a trade mark may be constituted by a letter and numbers but there are exceptions to it.⁵

³ Section 18 (1), Trade Marks Act, 1999.

⁴ Section 2(1)(k), Trade Marks Act, 1999.

⁵ Section 2(1)(m), Trade Marks Act, 1999.

Single letters, Although the distinctive character of single letter marks should, like other types of marks, be taken into consideration by reference to the goods or services applied for and the perception of them by the public, the relevant public's perception of these marks may not be the same as other marks of the other words, and it may prove more difficult to establish distinction for marks consisting of a single letter than other word marks. **Each case should be individually examined on their specific facts. Proper care should be taken to avoid registering for the single letter marks that are descriptive**, such as the letter "S" for clothing which indicates small. Particular and due care is required where the goods are technical items such as motors, machines and laptops, where certain letters may have a descriptive meaning and it has become customary in the language/code language or in the honest and established practices of the trade. If, upon examination of the descriptiveness, a single letter mark is found to be descriptive, customary in the trade and/or devoid of any distinctive character in respect of the goods concerned, registration would be refused until and unless there is evidence of distinctive character having been acquired as a result of the use made of the said mark.

Two or more letters are registrable with ease, unless the letters designate a characteristic of the goods or services of the application (for example "XYZ" for guide books or directories, or "XL" for clothes which specifies Extra Large) or are devoid of any distinctive character or letter. Descriptive abbreviations Marks which are merely abbreviations for specific goods or services are considered to be devoid of any distinctive character. *For example, in relation to software, "SDK" is short for "software development kit", SDK is package that allows a programmer to develop applications for a particularly specific platform and is devoid of distinctive character. However, in such cases, "CVSP" on its own for software is registrable because it is not a known abbreviation, even though it is believed to be "computer virus scanning programme".* Descriptive words when they are paired with appropriate abbreviations/ acronyms where a word/mark consists of the juxtaposition of a descriptive word combination and a non-descriptive letter sequence, if the public perceives the letter sequence as an abbreviation of the word combination by reason of the fact that each letter in the sequence reproduces the first letter of each word of that combination, the mark in question, when considered as a whole, would be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character. Objections under section 11(1)(b) and (c) would be raised against an application for registration of such mark. In simple words, **the mere fact to bring a letter sequence as abbreviation, which is not descriptive and is considered to have distinctive character, and a combination of descriptive word altogether, without introducing any unusual variation, would be liable to result in a verbal expression consisting exclusively of signs/indications which may serve, in trade, to prompt out the characteristics of the goods or services concerned and is also devoid of distinctive character. Factors and questions such as how the goods or services applied for is likely to be abbreviated in trade or business, or that the initial letters may spell out another word combination or have other meanings, will not have any relevance to the assessment and determination of prima facie distinctiveness.**

Objections under section 11(1)(b) and (c) would be raised against an application for registration of such mark.

Trademarks are not supposed to be considered just on the basis of what they look like, but what the businesses they are registered into. If either one of them is similar, and it's likely to cause confusion to a general consumer or less attentive consumer about which business they are into, thus the trademark is denied. However, if the businesses are different enough, it doesn't really matter if their trademark is the substantially same.

TRADEMARK BATTLE

In the Trademark battle between WalletHub and Major League Baseball, The league claimed his mark is similar as compared to the one's used by WalterHub. As both the parties to the suit used the letter W's as their logo: one on a flag the Chicago Cubs fly when they win a game, and the other one was logo of WalletHub.

When WallerHub decided to file for trademark and patent of their logo, MLB challenged it on the grounds that it was too similar to their logo and filed a case against WalletHub.

WalletHub's view on Single letter trademark:

Single letters are the most popular trademarks. Each letter of the alphabet has atleast hundreds of trademarks. There are, for example, over 2,000 trademarks of the letter w, making it the most popular. According to WalletHub, their logo was different from the one used by MLB due to colour differentiation and the fact that the consumers weren't confusing the two said logo's.

The question is, even if you get a letter to be your registered trademark when there's 19,000 other ones. How is someone going to differentiate yourself in the marketplace from all the other one and Even if you can get it as a registered trademark, what value does it have.

There are 10,000 registered trademarks of the letter 'W' yet each and every one is differentiated from one another. Here, the question which came forward was that whether the two 'W' created any confusion in the minds of the consumer and whether the logos were similar enough to prove theft of intellectual property.

The case ended in out of the court settlement wherein WalletHub agreed to a settlement offer that would have forbidden WalletHub from using any form of a single letter 'W' in any future trademark application

RECOGNIZED RIGHT IN LETTER TRADEMARKS

Letters are the most essential feature of trademarks. There may be cases where trademark is comprised of a single letter. A single letter trademark which is descriptive to trade, are considered as poor trade mark on the face of the law and strong evidence of user shall be required to establish the trade mark right in the eyes of the authorities. When the mark

comprises of more than one letter and not descriptive in nature to goods and trade are considered to be relatively stronger trademarks.

Trademarks aren't supposed to be considered just on the basis of what they look like visually, but another important aspect which is to be considered is what business they are being registered into. If either is substantially similar and does create confusion in the mind of a consumer about which business is which, the trademark might be denied by the authorities. However, if the two trademarks in a battle are substantially different, and it doesn't matter if the trademarks are the same. For instance, A career placement service, an insurance auditor, and a business selling new, used, and refurbished airplane engines can all have trademarks on a very similar stylized "A." No one looking for refurbished airplane engines, the thinking goes, would mistakenly contact an insurance auditor.

The burden is on the petitioner to show that there is confusion which has been generated in the minds of the consumer. If the party bringing a suit against you, can prove that there has been theft of Intellectual property and confusion has been created. If they can't prove that, you would win the case.

- **Chemetron Corporation Vs. Morris Coupling & Clamp Co. 203 U.S.P.Q. 537:-**

In this case the court observed that there was a similarity in the mark, it is letter "TT" in which there was slight similarity between both the marks. The court observed that TT must take into consideration that you cannot always compare marks on side-by-side basis and thus the test that must be applied is determining the amount of confusion generated, It is not whether the marks are distinguishable when compared to side-by-side but rather whether they have a resemblance between the two parties must not cause a confusion and this necessary requires us to consider the general memory of the average purchaser who normally retains only a general impression of a trademark over a period of time.⁶

- **P.P. Jewellers Pvt Ltd. vs P.P. Buildwell Pvt Ltd:-**

PP jewellers filed a suit for infringement of trademark against PP buildwell regarding the use of the mark "PP". PP Jewellers had claimed to acquire the trademark by the way of continuous use of the mark. It was claimed by the prosecution that they had built a reputation and goodwill in the said mark and thus PP Buildwell must be held guilty of passing off.⁷

PP Jewellers alleged that PP Buildwell have used the letter mark 'PP' and used the service that being offered by the PP Jewellers under their mark and goodwill. The Court opined that the simple fact that PP Buildwell using letters 'PP' meant that they had no mala fide intention to defraud or confuse consumers. The added material in the form of 'Buildwell' were sufficient to distinguish the PP Buildwell Pvt Ltd marks from that of the PP Jewellers Ltd. They also stated that they had entered the construction business and as such the chances of a customer mistaking one company for the other was real possibility.

⁶ Chemetron Corporation Vs. Morris Coupling & clamp Co., 203 U.S.P.Q. 537

⁷ PP Jewellers Vs. PP Buildwell, IA No. 132 of 2005 CS (OS)

The Court relied upon this fact to hold that the term 'PP' *per se* would not constitute an 'essential feature' of the mark and as such merely the use of the term, 'PP' by 'PP Buildwell' would not institute an infringement.

CONCLUSION

In order to evaluate trademark consisting of letter, it is necessary to understand on one hand the letter is used as an instrument of language and used in communication, and on the other hand, the letter used for distinguishing between products and services. In case of weak trademarks, infringement is not excluded by minor change which does not affect the core of the mark.

The question which is yet to be answered is – Can you own a letter. There are 20,000 registered trademarks of the letter 's' yet each and every one is differentiated from one another. If there is a confusion created by similar single digit letter, should the court entertain such cases. The court isn't that clear on this matter as every case has to be decided on its merits and facts. There cannot be certain rule mending the laws.

The essence of a trade mark depends in its capacity to differentiate a product from another. The owner must act on this issue to avoid an infringement suit. The qualitative differences between the products, as well as the differences between the relevant prices, are not sufficient to exclude the risk of confusion between the products; comparatively less attentive consumers could even be induced to believe that the same entity sells at different prices since products have different quality levels.

We must take into consideration that you cannot always compare marks on side-by-side basis and thus the test that must be applied is determining the amount of confusion generated, It is not whether the marks are distinguishable when compared to side-by-side but rather whether they have a resemblance between the two parties must not cause a confusion and this necessary requires us to consider the general memory of the average purchaser who normally retains only a general impression of a trademark over a period of time.

The court in a number of cases have observed that in a trademark battle, the basic outline on which trademark suits shall be decided is that whether there has been a legitimate confusion in the minds of a layman. Whether there is a confusion caused or not is a question of impression and only the court would be the judge of it. While considering the logic between the two competing letter trademarks the Hon'ble High Court has observed in a number of cases, that It is not right to take a portion of the word (ML) and say that because a portion of the word differs from the corresponding portion of the word in the other case (MLI), there is no sufficient similarity to cause confusion.⁸

⁸ S. Mehal Singh v. M/s. M.L. Gupta & Anr, AIR 1998 Del 64