

The legal framework for trademarking Names, Surname and Personality Traits in India

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Abstract

“Name” and “surnames” have moved ahead of identity to brand names. The Article examines the Trademark protection that is been provided to names, surnames and personality traits in India. The article focuses on common and uncommon surnames. Moving further, the article will explore landmark judgments passed by High Courts and Supreme Court of India. The article tries to settle the rift between public interest and private interest in the light of commercialization of individual identity. The article throws light on Intellectual property protection to the fictional characters as provided by Indian law. Judicial interpretation of intellectual property protection to the generic names, surnames or personality traits on the ground of brand identity, goodwill and consumer recognition has been elaborated in the article.

Keywords

Trademark; Name and surname; Personality rights; IP of fictional characters; doctrine of honest concurrent use

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1. Surname and Personal Name

Name which classifies as a personal data is identity of an individual. Possessing a name is not just limited to humans, but also animals, things, eatables. Everything and everyone have a NAME which reflects as their identity. With reference to name of individual, name is divided in three parts. First name, middle name and last name. There are different types of names. Females have two names in their life time, one is maiden name, that is name Maiden Name (before wedding) and other one is Married name, that is name post their wedding. This has been introduced under the concept of females adopting their husband's name as their last name post marriage. Apart from this, there are screen names, Poetic name and other names by which the artist disguise himself in his art, so that he creates a unique identity.

A surname is individuals last name or family name which the person has inherited from parents and is shared with other community members. It is passed down through generations within a family or community. Personal name is individuals name that is first name. It defined the social, cultural and personal identities. Either Personal Name or surname, they are not just labels but an inseparable part of an individual's identity. Names establish personal identity and reputation. It helps to build strong brand in both personal as well professional space.

Surname and personal names are often named after the business that is established by the founder. It may be with an object to establish a personal connection and build a sense of trust or credibility with the customer base. The usage of personal or surname as brand names helps the customer to connect with the brand and make it memorable. It also honors the founder's legacy. Many times, it is also done to leverage existing reputation of the brand name.

Gucci, an Italian luxury fashion brand is named after its founder Guccio Gucci. Chanel, French fashion house is named after Gabrielle "Coco" Chanel. Suzuki, a Japanese automaker is named after Michio Suzuki. Tata, a multinational company from India is named after its founder Jamsetji Tata. Similarly, Bajaj, named after Bajaj family and Honda was named after its founder Siichiro Honda.

2. Protecting Personal and Surname as Trade mark

Trademark is a form of Intellectual property rights which is used to distinguish the similar goods or services originating from a different undertaking. Section 9(d) of the Trademark and Merchandise Act 1958² stated that personal names and surnames cannot be trademarked, but the new law Trade Marks Act 1999³ omitted this express prohibition. As a result of this, personal names and surnames are trademarked in India.

Section 2(zb) of the Trade Marks Act 1999⁴ defined "trademark" as something that can be represented visually and help to distinguish goods and services from each other. Hence a person can get his name trademarked provided person associates or related themselves to a product or service. In addition to this it has to be distinctive and should have gained "secondary meaning".

Though any name including but not limited to personal name, surname, signature of the person can be registered as trademark, it has to satisfy certain conditions that are laid down:

1. The personal name or surname should have a distinguishing character.

² Act No. 43 Of 1958

³ Act No. 47 Of 1999

⁴ Ibid.

2. If the proposed personal name or surname has a “well recognized” meaning other than surname, then it can be registered without any proof of distinctiveness.
3. The applicant should provide evidence for the use or plans to put the trademark on goods or services.
4. The degree of reputation in the relevant industry and their good will.
5. The numbers of years of its existence either as registered or unregistered trademark.

Taylor Swift is an American Singer and song writer. She has registered her name as trademark for clothing including but not limited to shirts, t-shirts, sweatshirts, jerseys in class 25 (US Class 22 and 39) and claimed prior use since 2000 vide registration no: 3439210⁵ registered on June 03, 2008. She has moved forward and registered, T.S (her initials), The 1989 World Tour (Name of her tour), Fearless 1989 (Album Name), Swifties (Name of fan club), Signatures, Song titles and lyrics which totally constitutes more than fifty-two trademarks⁶.

Even in India, many of the celebrities have registered trademark of their names and surnames. SRK’s World, SRK’s World, www.srksworld.com and SRKWORLD is registered under class 16 that is Paper and paper articles, printed matter and other related items⁷. Further the name Shah Rukh Khan has been registered under class 35, 36,41 and 42. Ajay Devgan, a famous Indian Actor has trademarked his signature under class 41⁸. Sanjeev Kappor, a famous cook has trademarked Sanjeev Kapoor’s signature cook book, Sanjeev Kapoor Logo, Sanjeev

⁵ United States Patent and Trademark Office, Trademark Status and Document Retrieval for Application No. 77141381, https://tsdr.uspto.gov/#caseNumber=77141381&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch (last visited Jan. 4, 2025).

⁶ United States Patent and Trademark Office, Trademark Electronic Search System (TESS) Search Results, <https://tmsearch.uspto.gov/search/search-results> (last visited Jan. 4, 2025).

⁷ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434942474, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434942474&st=Wordmark> (last visited Jan. 4, 2025).

⁸ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434942923, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434942923&st=Wordmark> (last visited Jan. 4, 2025).

Kapoor Academy under class 41⁹. Alia Bhatt, a famous Indian Actress has registered her name and signature under Class 35¹⁰.

In Shivaji Rao Gaikwad v. Varsha Productions¹¹, Plaintiff filled present case against the defendant for using his name in the film titled 'Main Hoon Rajinikanth'. Plaintiff stated that he is well known as Rajanikanth and movie titled in his name would infringe his personality rights. The court held that though the movie is not the biopic of the plaintiff but plaintiff could be easily identified with the title of the movie. The court ordered defendants restraining from using the title "Main Hoon Rajanikath". Eventually, the film was renamed as "Main Hoon Part Time Killer".

In Jaleel Associates v. Hotel Sagar Association¹², the Kerala High Court protected the plaintiff's mark "Hotel Sagar" because of prior use. Though the surname is very simple without any significance, it can be registered on the basis of proof of distinctiveness.

In Mahindra and Mahindra Paper Mill v. Mahindra and Mahindra Ltd¹³, the infringement of trade mark "Mahindra" was brought before the court. The Honorable Supreme Court of India restrained the appellants from using the trade mark "Mahindra" and held that the respondents (Mahindra and Mahindra Ltd) have been using the surname Mahindra for more than fifty years hence it could cause a reasonable belief in the mind of general public that the appellants are associated with the respondents.

⁹ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434945898, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434945898&st=Wordmark> (last visited Jan. 4, 2025).

¹⁰ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434946451, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434946451&st=Wordmark> (last visited Jan. 4, 2025).

¹¹ 2015 (62) PTC 351 (Madras)

¹² Jaleel Associates vs Hotel Sagar 2005 (1) KLT 757 Decided on 3.12.2004

¹³ Appeal (civil) 7805 of 2001

Hon'ble Delhi High Court in *Prathiba M Singh v. Singh and Associates*¹⁴ discussed on trademark "Singh and Associates". The court opined that tagline with the name of the founder that is "Founder Manoj K Singh" to remove any scope for the confusion caused because of the title. Such distinction would help their Indian and foreign clients to identity them.

Similarly, in *Manju Monga v. Manju Mittal*¹⁵, Plaintiff claimed "Manju" and "Cookery classes" are integral part of the trademark and carries goodwill. Hence defendants use of "Manju Mittals cookery classes" amount to infringement of trademark. The court stated that in order to achieve balance the defendant can use "Manju Mittal Cookery House" or "Manju Mittal Training center" along with her photographs and mainly defendant will use her name and surname as a single word that is "MANJUMITTAL".

In *Honda Motors Co Ltd v. Charanjit Singh and Ors*¹⁶, Delhi High Court stated that the trade mark "Honda" is derived from the name of the founder of the said company and has distinctiveness and good will acquired. Therefore, the court opined that the consumers can believe that Honda relates to the Plaintiff.

*Dr. Redddy's Laboratories Ltd. V. Reddy Pharmaceuticals Limited*¹⁷, it was stated by the Delhi High Court though plaintiff was not registered trademark protection cannot be rejected merely on the ground that Reddy is a common surname and cannot be monopolized. The Court opined that the defendant by using the trademark Reddy in their pharmaceutical preparations is neither concurrent not honest user. There appears a malafide intention to mislead the customers. Hence the trademark protection was granted.

¹⁴ CS(OS) No.1173/2012, I.A. No.7776/2012 (u/S 149 [CPC](#)), I.A. No.12189/2012 (u/O 8 R-10 [CPC](#)), I.A. No.14017/2012 (of defendant u/O 7 R-11 [CPC](#)), I.A. No.14518/2012 (of the defendant u/O 8 R-1 [CPC](#)), I.A. No.9079/2013 (of defendant for filing additional documents), I.A. No.7775/2012 (of plaintiff for exemption) & I.A. No.14519/2012 (of defendant for exemption)

¹⁵ I.A. No.5379/2011 in CS (OS) No.820/2011

¹⁶ **101(2002)DLT359, 2003(26)PTC1(DEL)**

¹⁷ *Dr. Reddy'S Laboratories Ltd. vs Reddy Pharmaceuticals Limited* PTC 435 Delhi High Court Decided on 26.082004

3. Doctrine of Honest Concurrent use

Section 35 of the Trade Marks Act 1999¹⁸, states that bona fide use refers to the honest use of his own name by person without any objective to extract the good will accumulated by another person. The main intention of the clause is to protect the legitimate interest of the person using his own name without infringing the rights of trademark holder.

In Precious Jewels and Varun Gems¹⁹ case, both parties are family members and were using surname “RAKYAN”. Though the shop was adjacent to each other they were permitted by court to use surname as per Section 35 of the Trade Marks Act 1999²⁰. The parties were doing business in their own names and hence there was prima facie case in favor of plaintiff.

In Goenka Institute of education and research v. Anjanai Kumar Goenka and another²¹, the trademark “Goenka” was discussed. The Delhi High Court applied Doctrine of Honest Concurrent use stated that the defendant can continue using Goenka but however they were directed to insert their trust name in brackets below the school’s name to remove any kind of confusion.

In Kores (India) Ltd v. M/s Khoday Eshwarsa and Son²² the Bombay High Court laid down five factors for assessing if a trademark is used to honestly:

1. The nature and trademark’s use with reference to duration, area and volume of trade of goods and services.
2. The degree of similarity of the resemblance of marks to identify potential public inconvenience.
3. The honesty of the concurrent use of both parties.
4. Actual evidence of similarity or confusion in marks

¹⁸ Act No. 47 Of 1999

¹⁹ Precious Jewels & Anr vs Varun Gems Civil Appeal 7191 of 2014 Supreme Court of India Decided on 4.08.2014

²⁰ Ibid.

²¹ Goenka Institute Of Education & Research vs Anjani Kumar Goenka FAO (OS) No. 118/2009 Decided on 29.05.2009

²² 1985(1)BOMCR423

5. Note on relative inconvenience that could be caused.

In *Bata India Limited vs Pyare Lal & Co., Meerut City And Ors*²³, the defendant advertised “Batafoam” which is promoting products like mattress and cushions. Hence plaintiff contented that this infringed their trademark and tricked customers to buy the product. They further contented that the name Bata will pass off their products and damage their good will. The court highlighted the origin of word “Bata”. It is the surname of Thomas Bata, a native Czechoslovakian who started business of shoes and rubber products in India. It was held that in the perspective of common man and Batafoam and Bata are similar both visually and phonetically. This would deceive the customer. Henceforth injunction was granted against the use of name by the respondent as it creates confusion among general public.

4. Personality Rights

Personality rights refer to the protection of individuals name, image, voice, likeness and other related aspects. This protects their identity from being unauthorized commercial usage. This ensures that individuals have adequate protection of their Right to Privacy and Right to Publicity.

In *Amitabh Bachchan v. Rajat Nigam and Ors*²⁴, the Delhi High Court passed the first John Doe order for personality rights. Amitabh Bachchan's image and voice were protected from unauthorized commercial use. This was done in the light of fake Kaun Banega Crorepati game show which was done with an intent of causing financial scam.

In *Anil Kapoor v, Simply Life India and Ors*²⁵, the petitioner Mr. Anil Kumar, Indian actor sought protection of his personalities, publicity rights associated with him including but not limited to his name, voice, photograph, likeness, body language, signature. He contended that the word “Jhakaas” was made popular by him by unique dialogue delivery and body language. Hence it is a part of his personality. The respondent has been using the word “Jhakaas” along

²³ AIR1985ALL242, AIR 1985 ALLAHABAD 242, (1985) 2 CURCC 29

²⁴ CS(COMM) 819/2022

²⁵ CS(COMM) 652/2023 and I.A. 18237/2023-18243/2023

with his photographs on their merchandise. An injunction had been granted and respondents were restrained from utilizing plaintiffs' personality rights.

In *Tata Sons Limited vs Mr. Manu Kishori & Ors*²⁶, the plaintiff sued for trademark infringement by the Mr. Manu Kosuri, Managing Director of defendant No.2 Ramadasoft. The respondents are involved in registering domain names and registered "jrdtata.com, ratantatata.com, tatahoneywell.com and others. The plaintiff stated that the trademark and names TATA is a registered trademark since 1917 and is well known household name. The court stated that this amounts to trademark infringement and the Honorable court orders the respondent to transfer the ownership of domain names to the complainant as the respondents does not have any lawful rights or demonstrated legitimate interest over the domain names and used them in the bad faith.

Akshay Kumar Bhatia, a Bollywood actor has trademarked word Khiladi under class 13²⁷ and class 41²⁸. Sachin Tendulkar, an athlete has registered Sachin's (label), Sachin Tendulkar, Sach by Sachin Tendulkar under class 28²⁹ and class 29³⁰.

²⁶ 2001IIIAD(DELHI)545, 90(2001) DLT659, 2001(58) DRJ306, 2001(2) RAJ311

²⁷ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434966369, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434966369&st=Wordmark> (last visited Jan. 4, 2025).

²⁸ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434967045, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434967045&st=Wordmark> (last visited Jan. 4, 2025).

²⁹ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434970010, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434970010&st=Wordmark> (last visited Jan. 4, 2025).

³⁰ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434968792, <https://tmsrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434968792&st=Wordmark> (last visited Jan. 4, 2025).

Interestingly, Usain St. Leo Bolt, a famous athlete has trademarked his signature pose under class 18, 25 and 28³¹ in India. Jumpman logo of Nike that is photo Micheal Jordan is used to promote the Air Jordan brand of sneakers and sportswear has been applied to be trademarked in India by Nike Innovate C.V. under Class 9³², 18³³, 28³⁴, 41³⁵, 35³⁶.

5. Trade mark of deceased individual

Section 14 of the Trade Marks Act 1999³⁷, deals with registration of trademark which showcases connection or reassemble to any person, if alive should he should provide consent and if deceased within twenty years prior to the date of application, then the legal representative of the deceased person should provide consent in writing. The Registrar has authority to refuse such applications on the found of non-submission of the written consent.

³¹ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434971096, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434971096&st=Wordmark> (last visited Jan. 4, 2025).

³² Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434992807, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434992807&st=Wordmark> (last visited Jan. 4, 2025).

³³ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434993123, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434993123&st=Wordmark> (last visited Jan. 4, 2025).

³⁴ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434992464, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434992464&st=Wordmark> (last visited Jan. 4, 2025).

³⁵ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434990418, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434990418&st=Wordmark> (last visited Jan. 4, 2025).

³⁶ Controller General of Patents, Designs, and Trade Marks (India), Trademark Public Search for Application No. 434991884, <https://tmrsearch.ipindia.gov.in/tmrpublicsearch/tmsearch.aspx?tn=434991884&st=Wordmark> (last visited Jan. 4, 2025).

³⁷ ACT NO. 47 OF 1999

As per Section 04 of Emblems and Names Prevention of Improper Use Act, 1950³⁸, prohibits registration of trademark in the name or emblem as notified by central government. The protection has been granted to National Flag, St. John's Ambulance Association, St. John's Ambulance Brigade (India), Mahatma Gandhi, Shrimati Indira Gandhi, Chatrapati Shivaji Maharaj, Gandhi, Nehru, Shri Lal Bahadur Shastri and others.

6. Trade Mark protection of the fictional characters

In Neela Film Productions Private Limited v. Taarakmehtakaooltachashmah.com and others³⁹ Delhi High Court issued John Doe or Ashok Kumar Orders for the protection of the Intellectual property rights. This show has been running from July 28th 2008 successfully and hence it is easy to attract the traffic for commercial opportunities. The show makers have trademarked the show characters such as "Gokuldhaam", "Jeethalal" etc.

Hence it can be noted that the trademark protection has been extended even to the fictional characters in the digital era.

7. Conclusion and Recommendations

In the increasingly competitive world, established a personal branding is crucial and has immense value. Trademarking names, surnames, fictional characters, voices, signature, signature poses and other traits which relates to the identity of the individual is a commercial strategy as it is associated with brand value. This does not only protect exclusive rights but also protects the uniqueness of the individual. It also protects the personality rights including the likeness or resemblance.

When an individual gets his name or surname trademarked that means that have protection against usage of that name with regard to goods and services for the class that is selected. It

³⁸ ACT NO. 12 OF 1950

³⁹ CS(COMM) 690/2024, I.A. 36509/2024, I.A. 36510/2024, I.A. 36511/2024, I.A. 36512/2024, I.A. 36513/2024 & I.A. 36514/2024

doesn't provide a universal or general protection against all goods and services. Henceforth celebrities have to apply for protection across the globe and classes as per applicable laws.

As the scope of personality rights expands and defining personal branding is constantly expanding it is important for the law makers to elevate law so that it goes hand in hand with the competitive market place. This will help the individual to protect their identity, monetize it and more importantly protection from the misuse of the same. This trademark protection shall ensure that the legacy of the individual is protected for the upcoming generations.

It is to be noted that misrepresentation and misleading marketing techniques have evidenced a setback owing to the extension of protection of trademark. However, the question that arises here is it is practically impossible to have a unique name and/or parents check the trademark status before naming their child. Surnames are applicable to every individual belonging to that particular community. In such cases, if trademark protection against a generic or most common name is granted then it will be troublesome for the other person with the same name.

The country as of now witnessing a mushroom growth in the digital scams, personality infringement and other misrepresentation cases. The legislature should frame laws to address the personality rights and reduce the burden from the shoulders of the Judiciary.

In the above context the following recommendations are suggested:

7.1. Amendment to Trade Marks Act 1999

Current Act, does not explicitly state about the recognition to names and surnames. "Name" and "Surname" should be defined. The statutory protection will be given only to the individuals who were able to commercialize and gain reputation with that identity. Rules should be framed to identify the same.

7.2. Separate framework for personality rights

With the growing digital media scams and artificial intelligence, it has become very important to protect exploitation of individuals image, likeness and other personal identifiers.

7.3. Consumer protection and awareness

Disclaimers and/or disclosures should be provided during the use of well-know name or name similar to well-known brand. This upholds the public interest.

7.4. Framing of model guidelines

There are no guidelines for clicking pictures or videos at public places. This is eventually leading to capturing and exploitation of personality rights of individuals without their consent and knowledge. Educational institutions are using the pictures details of the top-ranking and students who got placed along with disclosing their workplace as well as compensation. These are some of the grey areas which needs to be regulated.

As stated, “Names”, “Surnames” and “Personality Traits” are not just a personal identity but is a commercial valuable asset it has to be protect. As the current laws and regulations only provide fragmented and unorganized protection, a harmonized policy is need of the hour. This will not only enhance the intellectual property laws of the country but also uphold the Constitutional values and rights of the citizens in the fast-growing world.

