

# THE CONCEPT OF DECEPTIVE SIMILARITY: LAW & PUBLIC POLICY

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## INTRODUCTION

A trademark<sup>1</sup> refers to the visual symbol in the form of word, a device, or a label which is applied to the articles of commerce with the sole motive to indicate to the consumers that the goods<sup>2</sup> are those manufactured by a particular person and can be very well distinguished from the goods which are manufactured or produced by others.<sup>3</sup> It applies to the services<sup>4</sup> also which are made available to the consumers. Thus, in order to qualify for protection, it is very much

essential that a trademark must be distinctive in nature and should not intend to create any kind of confusion as to the origin of goods or services. In *Colgate Palmolive Company v. Anchor Health and Beauty Care Pvt.*,<sup>5</sup> it was held that “the difference in the style of the appearance of words on the container or packing which identifies its manufacturers by way of style, colour combination or textures or graphics is certainly significant or relevant for determining the overall imitation of the container but when a product is having distinctive colour combination, style, shape, and texture has been on the market for decades as in this case it is in the market since many years it leads to ineluctable inference of having acquired secondary meaning on account of its reputation and goodwill earned at huge cost.”

### Essential Functions of Trademark

There are varieties of functions performed by a trademark and statutory functions of trademark are different from the role which is actually played by the trademark.

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<sup>1</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 2(1)(zb): “*trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, their packaging and combination of colours.*”

<sup>2</sup> *Id.* §. 2(1)(j): “*goods means anything which is the subject of trade or manufacture*”.

<sup>3</sup> P. NARAYANAN, LAW OF TRADEMARKS AND PASSING OFF 1 (6<sup>th</sup> ed., Eastern Law House 2004).

<sup>4</sup> *supra note 1*, § 2(1)(z): “*Service means service of any description which is made available to potential users and includes the provision of services in connection with business of any industrial or commercial matters such as banking, communication, education, financing, insurance, chit funds, real estate, transport, storage, material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction, repair, conveying of news or information and advertising.*”

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<sup>5</sup> 2003 (27) PTC 478 Del.

The first and foremost function of the trademark is the indication of goods or services to which it is applied and this can be very well understood from the definition of Trademark under the Act.<sup>6</sup> In *The International Association of Lions Club v. The Association of Lions India*,<sup>7</sup> it was observed that “it was irrelevant whether or not the public was aware of the plaintiff’s identity as the manufacturer or supplier of the goods in question, as long as they were identified with a particular source.”

Trademarks are the means of achieving product differentiation and the term ‘product differentiation refers to the image of a product which a buyer has in his mind with respect to a particular product which is entrenched in a particular manner or style.’<sup>8</sup> Thus, a trademark is a source of product differentiation which reduces the search cost and enables the

consumer to categorise and classify goods or services according to their characteristics.

Trademark is a source of advertisement because it functions as an indicator. In *N.R. Dongre v. Whirlpool Corporation*,<sup>9</sup> it was held that advertisement of a trademark without existence of goods in the market is also to be considered as use of the trademark. It is not necessary however that the association of the plaintiff’s marks with his goods should be known all over the country or to every person in the area where it is known best. The knowledge and awareness of the trademark in respect of goods is not limited to the population of a country wherein the goods are made available but the same knowledge also reaches in the other countries where the goods may or may not have reached. When a product is launched, people in the other countries get acquainted with it through advertisements by means of newspapers, magazines, television, cinemas etc. irrespective of the fact whether such product is made available in that country or not. This transfer and dissemination of information have been made possible only through the development of communication systems.<sup>10</sup>

Thus, identification of a given source through a particularly successful and advertised trademark

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<sup>6</sup> *Brahmos Aerospace Pvt. Ltd. v. Fiat Jee Limited*, decided on 24 Feb. 2014, it was held that ‘Brahmos’ is a well-known trademark and it was concluded that in order to understand the arguments of the parties, one has to read the definition of the “mark” and the “trademark” under §§ 2(1)(m) and 2(1)(zb) of the Trade Marks Act, 1999 together. In § 2(1)(m), the meaning of the “mark” includes the name and word and/or any combination thereof. Similarly, as per § 2(1)(zb), the “trademark” means, if the same is used in relation to goods or services for the purposes of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; *See also*, *Bloomberg Finance v. Prafull Saklecha*, 2013 (56) PTC 243 (Del) and *Rolex Sa v. Alex Jewellery Pvt Ltd.*, (2009) 41 PTC 284 (Del).

<sup>7</sup> 2006 (33) PTC 79 Bom.

<sup>8</sup> *Functions of Trademarks in India* (Jan. 26, 2017, 10:20 PM), <http://www.solubilis.in/blog/functions-of-trademark-india/>.

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<sup>9</sup> 1996 SCR (5) SUPP 369; *See also*, *Faulder & Co. Ltd. v. O & G. Rushton*, (1903) 20 RPC 477).

<sup>10</sup> VIKAS VASHISHTH, *LAW AND PRACTICE OF INTELLECTUAL PROPERTY IN INDIA* 67 (2<sup>nd</sup> ed., Bharat Law House 2002).

creates a substantial market power.<sup>11</sup> However, there may be comparative advertising by which producers in the same market may specify the differences or similarities between their and their competitors' products which may or may not be true.<sup>12</sup> But it has been made permissible to inform consumers and to enable them to make a wise decision. They have a right to make an informed decision which is not possible without advertisement. They have a right to know about the merits and demerits of a product.

Trademark can be described as a source of consumer welfare. Modern trademark highly favors consumer interest. There has to be a balance between the interest of trademark proprietor and consumer welfare. In *M/S. Hindustan Pencils Pvt. Ltd. v. M/S. India Stationery Products*,<sup>13</sup> it was observed that the distinguishing mark is solely for the benefit of the consumer and it is a representation by the owner to the consumer informing him that the

goods bearing a particular trademark have been manufactured or marketed by the owner of the mark.

Trademark guarantees continuance in the flow of quality. Trademarks are the “quality symbols” which molds the order of priority a consumer can have with regard to the purchasing things or availing of services. These marks are considered as the output of one's intellect which he uses in producing the goods and applies to the trade in question. Hence, such form of intellectual property needs protection in order to ensure that quality goods and service are maintained for the welfare of the society. If the product is of standard quality the consumer will influence others to purchase and thereby demand of a product increases.<sup>14</sup> Neither Paris Convention for the protection of industrial property 1883 nor the TRIPS Agreement, 1994 or the Trademark Law Treaty, 1994 refers to this aspect.<sup>15</sup>

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<sup>11</sup>Supra note 8.

<sup>12</sup> Jonas Häckner and Astri Muren, *Trademark Protection and Product Differentiation*, 4 STOCKHOLM UNI. (2005).

<sup>13</sup> AIR 1990 Del 19; See also, *M/S. South India Beverages Pvt. v. General Mills Marketing Inc.*, FAO(OS) No. 389/2014, decided on 13 Oct. 2014, a paramount factor influencing a consumer's choice of brand is his memory of previous exposures of the brand. Distinctive brand names and packaging are highly conducive to mental associations and serve as pathways to facilitate a much more accurate recall by a consumer. It enables finer retrieval of the experience. Studies reveal that extrinsic brand cues might actually enhance the memorability of prior experiences with specific brands, thereby facilitating accurate quality discrimination and improving consumer welfare.

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<sup>14</sup> Raja Selvam, *Quality Control in Trademark - The Indian Perspective*, (Jan. 26, 2017, 12:30 PM),

<http://www.selvamandselvam.in/blog/quality-control-in-trademark-the-indian-perspective/>; See also, *Hyundai Corporation v. Rajmal Ganna*, 2007 (35) PTC 652 Del, the plaintiff's mark HONDA has acquired a global goodwill and reputation. Its reputation is for quality products. The name of HONDA is associated with the plaintiff's especially in the field of automobiles and power equipments on account of their superior quality and high standard.

<sup>15</sup> There are other laws to deal with quality matters like Consumer Protection Act, 1986 and the Drugs and Cosmetics Act, 1940. These laws ensure that sub-standard quality goods and services are not sold to the consumers and provide necessary remedies.

Trademark is a source of protecting the consumers from deception or confusion. The likelihood of confusion between similar marks increases with increase in passage of time and sequential consumption of the products.<sup>16</sup> In *Bloomberg Finance Lp v. Prafull Saklecha*,<sup>17</sup> the Plaintiff opposed the advertised trademark applications of the Defendants for registration of Bloomberg. It was held that the defendants have, by adopting Bloomberg as part of their corporate name, deceived the public into thinking that the services and products offered by the Defendants are that of the Plaintiff or have originated from or are associated with the Plaintiff and that the adoption of the impugned mark by the Defendants is likely to create confusion in the minds of the public that the Defendants are associated with the Plaintiff.

Trademark is a source of protecting the investment and trade or business of the manufacturer. The owner of the trademark

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<sup>16</sup> *Sentini Bio Products Pvt. Ltd. v. M/S. Allied Blender & Distillers*, FAO (OS) 368/2014 decided on 6 July, 2015; *See also*, *Corn Products v. Shangrila Foods*, AIR 1960 SC 142, the Supreme Court held that 'Gluovita' was likely to cause confusion with the mark 'Gluovita' as both conveyed the same idea of glucose and life giving properties of vitamins.

<sup>17</sup> 2013 (56) PTC 243 (Del); *See also*, *Apple Computer Inc. v. Apple Leasing & Industries*, 1992 (1) Arb. LR 93, it was held that it was not necessary to insist that a particular plaintiff must carry on business in a jurisdiction before improper use of its name or mark can be restrained by the court. The main consideration was "the likelihood of confusion and consequential injury to the plaintiff and the need to protect the public from deception. Where such confusion is prima facie shown to exist, protection should be given by courts to the name or mark".

should be able to protect his investment which he must have spent in the form of time and money in presenting a service or product to the consumer. Thus, he should prevent others from using the trademark which is determined by the strength, or goodwill, of the association between the trademark and its source, and it is the consumer who determines this value.<sup>18</sup> Trademarks can sometimes be socially harmful. Landes and Posner claim that marks should be protected when they are socially beneficial and not when they are deleterious.<sup>19</sup>

#### MEANING AND SCOPE OF DECEPTIVE SIMILARITY

When a person gets his trademark registered, he acquires valuable rights to the use of the trademark in connection with the goods in respect of which it is registered. And, in the event of any invasion of his rights by any other person using a mark which is identical or deceptively similar to his trademark, he could protect his mark by an action for infringement and obtain an injunction.<sup>20</sup> Thus, the basis for

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<sup>18</sup> *Trademark Legal Basis* (Jan. 27, 2017, 12:45 PM), <http://www.trademark.iastate.edu/basics>.

<sup>19</sup> William Fisher, *Theories of Intellectual property*, 3-4.

<sup>20</sup> *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, AIR 1965 SC 980; *See also*, *American Home Products v. Mac Laboratories*, AIR 1986 SC 137; *National Bell Co. v. Metal Goods Mfg. Co.*, AIR 1971 SC 898; *M/s Avis International Ltd. v. M/s Avi Footwear Industries and another*, AIR 1991 Delhi 22 and *Ruston and Hornby Ltd. v. Zamindara Engineering Co.*, AIR 1970 SC 1649.

protecting the trademark is that no mark shall be registered which is likely to deceive the public or which creates confusion in the minds of the public in regard to the 'origin' or source of goods or services.

The expression 'deceptive similarity' as enshrined under § 2(1)(h) of the Trademarks Act, 1999 says that the similarity or resemblance must be such as it would be likely to deceive or cause confusion.<sup>21</sup> In order to come to a conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They are not required to be placed side by side to determine whether there are any differences in their design.<sup>22</sup> The test of comparison of the marks side by side is not a sound one<sup>23</sup> because the question is not whether

a person, while seeing both the marks side by side is confused or not but whether the person who sees proposed trademark in the absence of other trademark is liable to be deceived for what he has general recollection.<sup>24</sup> Deception can arise with regard to the deception as to the goods, deception as to the trade origin, deception as to the trade connection.<sup>25</sup>

### Misrepresentation

Under the trademark, misrepresentation<sup>26</sup> occurs where the defendant says or does something which indicates either expressly or impliedly that the defendant's goods or services derive from the claimant,

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(1890) 15 AC 252, deception is not proved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, nor orders are not placed, or are often not placed, under such conditions; *Firm Koonerji Becharilal v. Firm Adam Hazi Pirmohomed Esabh*, AIR 1944 Sind 21.

<sup>24</sup> *Damodara Pai v. Manilal*, (1972) Ker LJ 19.

<sup>25</sup> *Anamika Bhandari, Trademark: Infringement and Passing Off* 1(1) RSLR 133.

<sup>26</sup> *Anheuser Busch v. Budejovicky Budvar*, (1984) F.S.R. 413, it was held that the use of the same name by the defendants, however honest and however much used elsewhere, constitutes a misrepresentation if it leads people to believe that their goods are the goods of the plaintiffs; *See also*, *M/S Castrol Limited v. Mr. Thakur Dassochani*, AIR 2000 Delhi 60, use of word 'CASTROL' by the defendants amounted to infringement. It was held that the misrepresentation is calculated to cause damage and injury both to the plaintiffs' business and to their reputation and goodwill and the consumer and general public; and the defendants have attempted to make a deliberate misrepresentation to the purchasing public otherwise it cannot be a matter of coincidence. It is a systematic attempt by the defendants to derive unfair advantage and cause misrepresentation. The misrepresentation is bound to cause confusion and deception in the minds of the purchasing public.

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<sup>21</sup> *A.V. Rajadurai Nadar v. P. Ayya Nadar*, AIR 1977 Mad 237, any conclusion reasonable and proper can be arrived at by a meticulous examination of each detail and then making a comparison. At the same time, what readily strikes the eye must also be conclusive. But, when one looks at it, especially from the standpoint of a person who is most likely to use a particular brand of matches, if it appears that the difference is prominent and it cannot lead to any similarity or a deceptive similarity or confusion, then there could be no objection to the two different trademarks.

<sup>22</sup> *Man Mohan Sharma v. Manjit Singh*, FAO No.4739 of 2016(O&M); *See also*, *Parle Products (P) Ltd. v. J.P. and Co.*, AIR 1972 SC 1359; *Lily ICOS LLC v. Maiden Pharmaceuticals Lim*, 2009 (39) PTC 666; *Kirorimal Kashiram Marketing & Agencies Private Limtied v. Shree Sita Chawal Udyog Mill Tolly Vill.*, 2010(44) PTC 293 (Delhi) and *DB Ruston and Hornby Ltd. v. Zamindara Engineering Co.*, AIR 1970 SC 1649.

<sup>23</sup> *The Singer Manufacturing Co. v. The Registrar Of Trade Marks*, AIR 1965 Cal 417; *See also*, *Eno v. Dunn*,

which is actually not. The action has become vast to include representations relating to the good or services and representations which suggest that there is a link between the claimant and the defendant.<sup>27</sup>

The defendant's state of mind is not essential because the guiding factor is to determine the consequences of defendant's actions and their effect on the public.<sup>28</sup> A fraudulent or deceptive copying of the trademark owned by another person amounts to a false misrepresentation to the public which is required to be protected against such misrepresentation.<sup>29</sup> The courts have been very flexible in deciding whether the defendant has made the requisite misrepresentation. The misrepresentation can arise through the use of words or actions. The most common form of misrepresentation is through the use of words<sup>30</sup> which can be either oral or written. In some cases, misrepresentation can be there in the

action of a defendant when defendant produces goods to look like claimant's or when it gives rise to the misrepresentation in relation to the registration of names registered on the internet.<sup>31</sup>

Misrepresentation can be as to the source,<sup>32</sup> quality,<sup>33</sup> and control or responsibility on the goods or services. The courts have recognised that misrepresentation may occur when the conduct of defendant gives rise to the fact that the defendant has control or responsibility on the goods or services. However, the mere fact that a defendant suggests that they are connected to the claimant will not necessarily amount to passing off because the connection will be relevant only if defendant's misrepresentation suggests that claimant has some type of responsibility or control over the goods or services.<sup>34</sup> It is passing-off to represent the claimant's goods of a particular type or quality as those of another or

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<sup>27</sup> LIONEL BENTLY & BRAD SHERMAN, *INTELLECTUAL PROPERTY LAW 692* (Oxford University Press 2003).

<sup>28</sup> *Id.* at 693.

<sup>29</sup> *Pfizer Products Inc. v. Vijay Shah*, decided on 29 Nov., 2010; *See also*, *M/S East African (India) v. M/S S.R. Biotech*, decided on 16 July, 2012, to Succeed in a passing off action plaintiff needs to establish that the defendant is making a misrepresentation to the public. The court is also to see the likelihood of confusion in the minds of the public being caused that the goods offered by the defendant are the goods of the plaintiff.

<sup>30</sup> *SK Sachdev v. Shri Educare Limited*, 2008 SCC OnLine Del 799; the defendants were restrained from using the words 'SHRI RAM' and from using the mark SHRI RAM GLOBAL SCHOOL and the domain name www.shreeram.in. They were held guilty of misrepresentation.

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<sup>31</sup> *Supra note 27* at 694.

<sup>32</sup> *M/S. Sancheti Appliances Pvt. v. M/S. D.K. Electricals*, decided on 9 Feb. 2011; *See also* *Reckitt and Colman Products Ltd. v. Borden Inc and others*, [1990] 1 All ER 873, In order to bring an action for passing off, one of the elements is to prove that that he suffers or is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of his (the defendant's) goods or services is the same as the source of those offered by the plaintiff.

<sup>33</sup> *M/S. Castrol Limited v. M/S. Ramesh Rajput*, decided on 5 Aug. 2011, Defendant's malafidely adopted plaintiff's trademark to pass of their inferior quality goods as that of plaintiffs genuine goods and to make illegal profit out of it. Injunction was granted.

<sup>34</sup> *Supra note 27* at 699.

to represent sub-standard or second-hand goods as new. It is also passing-off to misuse claimant's goods to sell others, for example by refilling claimant's containers.<sup>35</sup>

### **Whether misrepresentation is Deceptive or not: Comparison as a whole**

In order to ascertain whether the misrepresentation is deceptive or not, the marks should be looked at as a whole.<sup>36</sup> Thus, it has to be borne in mind that the objective is to make ultimate analysis whether the mark used by the defendant as a whole is deceptively similar to the registered mark of the plaintiff.<sup>37</sup>

While examining the question of misrepresentation or deception, a comparison has to be made between the two trademarks as a whole.<sup>38</sup> The Anti-Dissection Rule compare composites as whole conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison.<sup>39</sup> The

marks must be compared as a whole. It is not right to say that because the difference in the portion of a word is there of the corresponding portion, there is no sufficient similarity to cause confusion. The true test is whether the totality of proposed trademark is likely to cause confusion or not.<sup>40</sup>

### **Tests to determine whether the two marks are deceptively similar or not**

As far as the similarity is concerned what is required is "a mere resemblance" or close similarity and not the close resemblance.<sup>41</sup> The 'ordinary observer' test is applied to determine if two works are substantially similar. The Court will look to the response of an 'average lay observer' to ascertain whether a copyright holder's original expression is identifiable in the allegedly infringing work.<sup>42</sup> The factors creating confusion depends upon the nature of mark itself, the class of customers, trade channel, the list is not exhaustive because

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"PANTOBLOC" or any other mark which is identical or deceptively similar to the plaintiff's registered trade mark "PANTODAC".

<sup>40</sup> F. Hoffman – La Roche and Co. Ltd. v. Geoffrey Manners and Co. (Pvt.) Ltd, AIR 1970 SC 2062.

<sup>41</sup> B.L. WADEHRA, LAW RELATING TO INTELLECTUAL PROPERTY 167 (4<sup>th</sup> ed., Universal Law Publishing Co. 2007).

<sup>42</sup>M/S. South India Beverages Pvt. v. General Mills Marketing Inc, FAO(OS) No. 389/2014, decided on 13 Oct. 2014; *See also*, Peter Pan Fabrics Inc. v. Martin Weiner Corp., 274 F.2d 487 (2nd Cir. 1960); Since it is employed to determine qualitative and quantitative similarity in visual copyright work, the said test can also be usefully applied in the domain of trademark law as well.

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<sup>35</sup>CHRISTOPHER WADLOW, THE LAW OF PASSING OFF: UNFAIR COMPETITION BY MISREPRESENTATION 285 (3<sup>rd</sup> ed., Sweet & Maxwell 2004).

<sup>36</sup> *Supra note 3* at 361.

<sup>37</sup> Cadbury India Limited v. Neeraj Food Products, 142 (2007) DLT 724; Kaviraj Pandit Durga Dutt Sharma v. Navratna Pharmaceutical Laboratories, [1965] 1 SCR 737; Ruston & Hornbi Limited v. Zamindara Engineering Co., AIR 1970 SC 1649.

<sup>38</sup> Pepsico, Inc v. Psi Ganesh Marketing, CS(OS) 157/2013, decided on 19 May, 2014.

<sup>39</sup> Cadila Healthcare Ltd. v. Aureate Healthcare Pvt. Ltd., CS (OS) No.123 of 2011, decided on 30 July 2012; the defendant was restrained from using the trade mark

there are several other factors required to be taken into conclusion to determine whether there is a likelihood of confusion or deception by the use of a mark.<sup>43</sup>

Whether a mark used by proprietor deceives the public or not depends upon the variety of factors and no concrete answer can be there to determine whether the impugned mark creates confusion as to the source or origin of goods. It depends on the facts and circumstances of each case. In some cases, courts have given regard to the common elements<sup>44</sup> present between the two marks while sometimes courts consider the uncommon elements. Trademarks may be considered as deceptive if they misled the public as to the quality of goods to which they attach. According to ECJ<sup>45</sup> the standard necessary for deception is that there is 'the existence of actual deceit is a sufficiently serious risk that the consumer will be deceived.'<sup>46</sup>

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<sup>43</sup> Sony Kabushiki Kaisha v. Shameao Markar, AIR 1985 Bom 327.

<sup>44</sup> Macleods Pharmaceuticals v. Intas Pharmaceuticals Ltd., decided on 29 May, 2013; F. Hoffmann-La Roche & Co. Ltd v. Geoffrey Manners, 1970 AIR 2062, 1970 SCR (2) 213; Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical, 1965 AIR 980, 1965 SCR (1) 737; Corn Products Refining Co. v. Shangrila Food Products, AIR 1960 SC 142.

<sup>45</sup> Consorzio per la Tutela del Formaggio Gorgonzola v. Käserei Champignon Hofmeister GmbH & Co. KG and Eduard Bracharz GmbH, C-87/97, [1999] ECR I-1301.

<sup>46</sup> TANYA APLIN & JENNIFER DAVIS, INTELLECTUAL PROPERTY LAW: TEXT, CASES AND MATERIALS 267 (1<sup>st</sup> ed., Oxford University Press 2009).

For determining deceptive similarity there is a requirement to examine 'whether the essential features of the plaintiff's trade mark are to be found in that used by the defendant'.<sup>47</sup> There is no hard and fast rule to laid down a universal test to determine the similarity between two marks. When the class of buyers is quite educated and rich the test to be applied is different from the one where the product would be purchased by villagers, illiterate and poor. The test to be applied in a country like India may be different from the test in England, United States of America or Australia.<sup>48</sup>

The correct method of resolving the issue is to independently study the design, bearing in mind the registered trademark and to ascertain whether the design would create an impression in the mind of an ordinary citizen that he was buying an article bearing the registered trademark.<sup>49</sup> Apart from the structural, visual and phonetic similarity or dissimilarity, the question has to be considered

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<sup>47</sup> United Biotech Pvt. Ltd. v. Orchid Chemicals, decided on 4 July, 2011, 'FORZID' was held deceptively Similar to 'ORZID'; *See also*, Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical, 1965 AIR 980.

<sup>48</sup> M/S Mohan Meakin Limited v. A.B. Sugars Limited, CS(OS) 2335/2010, decided on 10 Oct. 2013; Khoday Distilleries Limited (Now known as Khoday India Limited) v. The Scotch Whisky Association, (2008) 10 SCC 723; *See also*, Carew Phipson Limited v. Deejay Distilleries Pvt. Limited, AIR 1994 Bom 231, wherein interim injunction was refused on the ground that customers buying the alcoholic beverages subject matter in that case would normally be educated and discerning.

<sup>49</sup> *Supra note* 10 at 164.



from the point of view of a man of average intelligence and imperfect recollection. Secondly, it is to be considered as a whole and thirdly it is the question of his impression.<sup>50</sup>

Whether the two marks are structurally and phonetically similar and would cause deception in the mind of the consumer is relevant.<sup>51</sup> There are different tests<sup>52</sup> evolved by the courts from time to time, such as ‘test of an ordinary memory of ordinary purchaser’,<sup>53</sup> test of essential features of the mark/label was

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<sup>50</sup> Bdh Industries Ltd. v. Croydon Chemical Works Pvt. Ltd., 2002 (4) BomCR 5; National Sewing Thread Co. Ltd v. James Chadwick, 1953 AIR 357; Ciba Ltd. v. M. Ramalingam & S. Subramaniam, AIR 1958 Bom 56; Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142; F. Hoffmann La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd., 1970 AIR 2062; Astra - IDI Ltd., v. TTK Pharma Ltd., AIR 1992 Bom 35; Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., decided on 26 March 2001.

<sup>51</sup> United Biotech Pvt. Ltd. v. Orchid Chemicals & Pharmaceuticals Ltd., 2012 (50) PTC 433 (Del.) (DB).

<sup>52</sup> Anglo-Dutch Paint, Colour and Vanish Works Pvt. Ltd. v. India Trading House, AIR 1977 Delhi 4, the tests laid down for comparing the two marks are: (i) The question whether the two marks are so similar as likely to cause confusion or deceive is one of first impression. It is for the Court to decide this question. (ii) The question has to be approached by applying the doctrine of fading memory i.e. From the point of view of a man of average intelligence having imperfect recollection. (iii) Whether the overall visual and phonetic similarity of the two marks is likely to deceive such a man or cause confusion that he may make mistake the goods of the defendant for those of the plaintiff. (iv) The other questions which arise are: (i) who are the persons who are likely to be deceived and (ii) what rules of comparison are to be adopted in judging whether such resemblance exists; Corn Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142.

<sup>53</sup> *Supra note* 10 at 164.

applied,<sup>54</sup> test of the environment in which the trademark is used.<sup>55</sup>

### **Intention to deceive is not necessary: The guiding principle**

One of the guiding factors to determine whether the mark in question deceives or creates confusion does not depend upon the intention to deceive. It is immaterial whether the intention of the person to deceive the general public is present or not. Thus, an intention to deceive need not be proved.<sup>56</sup> In *Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd.*,<sup>57</sup> it was held that the plaintiff was not required to establish fraudulent intention on the part of the defendant and it was not necessary as such. Also, once the reputation has been established, plaintiffs need not prove fraudulent intention or misrepresentation on the part of defendants.<sup>58</sup>

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<sup>54</sup> Pepsico, Inc. v. Pure Water Beverages, 2011 (47) PTC 147 (Del.); Mumtaz Ahmad & Etc. v. Pakeeza Chemicals, AIR 2003 All 114, in order to come to the conclusion whether one mark is deceptively similar to another the broad and essential features of the two are to be considered.

<sup>55</sup> M/S Mohan Meakin Limited v. A.B. Sugars Limited, CS(OS) 2335/2010 decided on 10 Oct. 2013, the defendants were restrained to use ‘TOLD MOM’ mark and it was held to be deceptively similar to ‘OLD MONK’.

<sup>56</sup> P.L. Anwar Basha v. M. Natrajan, AIR 1980 Mad 56, defendants were restrained from using ‘Meen Mark Beedi’ because the overall similarity between the labels of plaintiff and defendant was there.

<sup>57</sup> AIR 1996 Bom 149.

<sup>58</sup> *Kirloskar Proprietary Ltd. v. Kirloskar Dimensions Pvt. Ltd.*, AIR 1997 Kant 1.

**Persons to be considered: The Factors which decide whom the mark must be calculated to deceive**

The relevant person is the average consumer who is “reasonably well informed and reasonably observant and circumspect”<sup>59</sup> although such a person will rarely have the opportunity to make a direct comparison but has to rely on the ‘imperfect picture of them that he has kept in his mind’.<sup>60</sup> The persons to be considered in estimating the resemblance between the marks is all those who are likely to become purchasers of the goods.<sup>61</sup> The average consumer can be the adult public at large.<sup>62</sup>

The general principle on the standard of care to be expected is that it must not be assumed that a careful examination of the mark will be made,<sup>63</sup> It is hard to say that unusually stupid people may be deceived.<sup>64</sup> If the goods are expensive, the consumers are generally the educated persons.<sup>65</sup> If the goods are cheap, the consumers are likely to be the illiterate

persons.<sup>66</sup> The attentiveness of consumers is taken into account which depends upon various considerations.<sup>67</sup>

**Types of similarity: The three factors**

The main factors to be considered are as follows:

- i. *The visual similarity of the marks:* It will include length of the respective marks, use of prefixes, suffixes, common syllables, and shared elements of shape.<sup>68</sup>
- ii. *The aural similarity of the marks:* It turns on similarity when the marks are pronounced. It depends upon the length of the marks, the number of syllables and the pronunciation of the marks.<sup>69</sup>

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<sup>66</sup> *Devi Pesticides Private Ltd. Rep. v. Shiv Agro Chemicals Industries*, (2006) 2 MLJ 834, defendants were restrained from using SUPER BOOM or any other mark deceptively similar to plaintiffs registered trademark BOOM PLUS and BLOOM FLOWER-n and it was held that the products were pesticides, fertilizers and other agents the channel of marking is also the same and the needy consumers are illiterate agriculturists who would not be able to distinguish between the marks BOOM PLUS, BOOM FLOWER-n and SUPER BOOM one would always believe that the same would originate from the same source.

<sup>67</sup> NICHOLAS CADDICK QC & BEN LONGSTAFF, *A USER’S GUIDE TO TRADEMARKS AND PASSING OFF* 77 (3<sup>rd</sup> ed., Bloomsbury Professional Ltd. 2012).

<sup>68</sup> *Id.* at 69; *Cadila v. Biochem*, decided on 23 May 2012, defendants were restrained from using the word "ATTOR" which was deceptively, confusingly, phonetically and visually similar to the plaintiff's trademark "ATORVA"; *See also*, *Pidlite Industries Pvt. Ltd. v. Mitters Corporation*, AIR 1989 Del 157, FEVICOL and TREVICOL were held to be visually similar and identical marks.

<sup>69</sup> *Id.* at 70; *See also*, *Indchem Health Specialities v. Naxpar Labs Pvt. Ltd.*, 2002 (2) MhLj 513, the words

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<sup>59</sup> C-210/96 *Gut Springenheide and Tusky*, [1998] ECR I-4657.

<sup>60</sup> *Lloyd Schuhfabrik v. Meyer*, [1999] FSR 627.

<sup>61</sup> ‘G.E.’ [1973] RPC 297 at 321-322 HL.

<sup>62</sup> *Whyte and MacKay Ltd. v. Origin Wine UK Ltd*, [2015] EWHC 1271 (Ch.) (06 May 2015).

<sup>63</sup> *Id.* at 591 *Wotherspoon v. Currie*, (1871-72) LR 5 HL 508 at 519.

<sup>64</sup> *Ibid.*, *Payton v. Titus Ward*, (1900) 17 RPC 58 at 67.

<sup>65</sup> KERLEY’S LAW OF TRADEMARKS & TRADE NAMES 591 (14<sup>th</sup> ed., 2007, Sweet & Maxwell); *HFC v. Midland* [2000] FSR 176 at 184.

Phonetic and visual similarity means the reference to the ear as well as eye.<sup>70</sup> Examples of Phonetic Similarity are WIPRO and EPRO, GLUVITA and GLUCOVITA, LAKME and LIKEME. Example of Visual Similarity is the kingfisher bird of McDowell of a mark bearing two Kingfishers.<sup>71</sup>

iii. *The conceptual similarity of the marks:*

Certain marks may not look or sound alike but may be similar in concept. The relevant point is to see the overall message of the mark.<sup>72</sup>

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"Cheri" and "Cherish" they are structurally and visually similar as well as aurally similar and easily give rise to deception and confusion, AEVIS was held to be phonetically similar to the registered mark AVI's and thus, injunction was granted; *See also*, Bengal Immunity Co. Ltd. v. Denves Chemical Mfg. Co., AIR 1959 Cal 636 the court held that there is a great resemblance of sound between the words 'ANTIPHLOGISTINE' and 'B.I. PHOLGISTON'; SBL Ltd. v. Himalaya Drugs Co., AIR 1998 Del 126, it was held that the abbreviation 'LIV' is made out of Liver, which is an organ of human body. Nobody can claim an exclusive right to the use of Liv as a constituent of trademark. Thus, no phonetic similarity between Liv. 52 and Liv.-T; Camlin Pvt. Ltd. v. National Pencil Industries, AIR 1988 Del 393, there is no similarity or resemblance between the two marks 'CAMLIN FLORA' and 'TIGER FLORE'; Aravind Laboratories v. V.A. Samy Chemical Works, AIR 1987 Mad 265, 'EYETEX' and 'EYEVIX' are two phonetically similar marks; Bombay Oil Industries Pvt. Ltd. v. Ballarpur Industries Ltd., AIR 1989 Del 77, there is a marked degree of phonetic similarity between 'SHAPOLA' and 'SAFFOLA'; Grandlay Electricals v. Vidya Batra, 1998 PTC 646, trademark HENKY was held to be phonetically and deceptively similar to GRANDLAY.

<sup>70</sup> R.K. NAGARAJAN, INTELLECTUAL PROPERTY LAW 415 (3<sup>rd</sup> ed., Allahabad Law Agency 2007); *See also*, M/s Avis International Ltd. v. M/s Avi Footwear Industries and another, AIR 1991 Delhi 22.

<sup>71</sup> G.S. Srividhya, *Overview of Trademarks Law*, NALSAR 3.

<sup>72</sup> *Supra note 71* at 70; *See also*, Aktiebolaget Volvo v. Hari Satya Lubricants, decided on 3 Nov., 2016,

### **The role of evidence: Actual deception need not be proved**

Evidence of facts and circumstances which are relevant to decide the question of similarity of marks are always admissible, however, the question whether one mark nearly resembles another as is likely to deceive or cause confusion is question of fact is purely a question for the tribunal to decide.<sup>73</sup> A judge is entitled to make a decision based on his own experience even in the absence of evidence.<sup>74</sup> Evidence of actual deception is not necessary, although weight will be given to instances of actual deception or confusion.<sup>75</sup>

### **Deceptive Similarity in case of Pharmaceuticals**

Every medicinal preparation has an active ingredient that produces a therapeutic effect. This active ingredient has a chemical name and a generic name. The chemical name is difficult to pronounce and it describes the molecular structure. For this purpose, the drug is known by the generic name in scientific community. It has the usefulness in scientific

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Injunction was granted on the ground of adoption of the mark VALVO by the defendants which was visually, phonetically, structurally and conceptually similar to the plaintiffs' trademark VOLVO.

<sup>73</sup> P. NARAYANAN, INTELLECTUAL PROPERTY LAW 182 (3<sup>rd</sup> ed., Eastern Law House 2013).

<sup>74</sup> *Supra note 65* at 604; Spalding v. Gamage and Neutrogena, (1915) 32 R.P.C. 273.

<sup>75</sup> *Supra note 73* at 183.

and medical research, education and medical journals. This non-proprietary name is very important to the doctors, pharmacist and other health care providers. This non-proprietary name is in public domain and is not protected by exclusive right. The medicinal preparation containing the drug has a brand name which is chosen by the entity marketing the medicine. The brand name is the trademark of a medicine and is a proprietary over which the trademark owner has the exclusive right to use.<sup>76</sup>

There is no provision in the Trademarks Act, 1999 in respect of drugs or medicines. The Government of India under § 23(1) of the Act has mentioned that no trademark shall be registered in respect of certain single ingredient drugs. When an application for the registration of trademarks for pharmaceuticals and medical preparations covering the listed drugs, the Registrar requires the applicant to file an affidavit to the effect that the trademark applied for is not used or proposed to be used in respect of any listed drugs.<sup>77</sup> Medicinal and pharmaceutical preparations are considered to be the goods of the same description and it is well established practice of Trade Marks Registry.<sup>78</sup> Veterinary preparations are prima

facie held to be of the same description as medicinal preparations for human use.<sup>79</sup>

An unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. He would not split the name into its component parts and consider the etymological meaning thereof.<sup>80</sup>

In *Cadila Healthcare Limited v. Cadila Pharmaceuticals Limited*,<sup>81</sup> it was observed that,

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<sup>79</sup> *Id.* at 246.

<sup>80</sup> *Amritdhara Pharmacy v. Satyadeo Gupta*, 1963 AIR 449, the registration of trade name 'LAKSHMANDHARA' in respect of medicine which was in use since 1923 was not allowed because the appellants were having registered trade mark 'AMRITDHARA' in respect of similar medicinal preparation which was in use since 1903 because the former was a deceptively similar to their mark, thereby resulting in confusion among the public; *See also*, *Wockhardt Limited v. Patiala Medical Agencies*, 2003 (26) PTC 425 (IPAB), the trademark PALGON BOLUS with similar cartons and packs was held deceptively similar to ANALGON which was registered trademark for medicinal, pharmaceutical and veterinary preparations as it was sufficient to deceive.

<sup>81</sup> Decided on 26 Mar. 2001; *See also*, *Merck KgaA v. Abhinav and Ashok Trading*, decided on 27 March 2014, CARBOPHAR was held to be deceptively similar to CARBOPHAGE; *Ranbaxy Laboratories Limited v. V. Anand Prasad*, 2004 (28) PTC 438 IPAB, OSTWIN was held to be deceptively similar to FORTWIN, the later was in use since 1975, both the medicines being for the treatment of bones as they had the common suffix 'WIN'; *Simatul Chemical Industries (P) Limited v. Cibatul Limited*, 19 GLR 315, deception between two trade marks is not only concerned with the concerned two parties but is concerned with the consumers and the interest of the

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<sup>76</sup> Zakir Thomas, *Legal Issues in Branding Medicinal Products*, 13 JIPR 523 (2008).

<sup>77</sup> *supra* note 3 at 241.

<sup>78</sup> *Id.* at 245.

“Drugs are poisons, not sweets. Confusion between medicinal products may, therefore, be life threatening, not merely inconvenient. Noting the frailty of human nature and the pressures placed by society on doctors, there should be as many clear indicators as possible to distinguish two medicinal products from each other. It is not uncommon that in hospitals, drugs can be requested verbally and/or under critical/pressure situations. Many patients may be elderly, infirm or illiterate. They may not be in a position to differentiate between the medicine prescribed and bought which is ultimately handed over to them.”

### **DECEPTIVE SIMILARITY: AN ABSOLUTE GROUND FOR REFUSAL OF REGISTRATION**

The legislative context of defining the scope of Deceptive Similarity as a ground for the refusal of trademark can be seen from the enacted provisions which enhances the scope of the concept and determines the features which tends to deceive or confuse the public. The said provisions are enshrined in the Trademarks Act, 1999 under §§ 9 and 11. § 9 deals with the

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general public will also have to be seen; *Vividharg Investment Pvt. Ltd. v. Glenmark Pharmaceuticals Ltd.*, 2003 (27) PTC 52, RIDUCLER was held deceptively similar to RELCER amounting to the dishonest adoption and use; *Apple Laboratories Ltd. v. Boots Company Plc*, 2004 (29) PTC 265 (IPAB), registration of BRUFORTE was not allowed being deceptively similar to BRUFEN.

absolute grounds for the refusal of a trademark while § 11 provides the relative grounds for the refusal. The difference between the two is that the former deals with the refusal when the inherent qualities of already registered trademark are in question while in the latter, the protection of an earlier trademark when it conflicts with the rights of third parties is dealt with.<sup>82</sup> Absolute grounds are meant to protect the interest of the public while relative grounds are meant to protect the interest of proprietors of already registered trademark. Trademark plays a dual role i.e., the identification of source and protection against confusion for the benefit of consumers. The operations of the new mark may overlap with the operations of an earlier registered trademark, which makes it liable to be rejected for registration purpose.<sup>83</sup> A mark shall not be registered as a Trademark if it is of such nature as to deceive the public or cause confusion.<sup>84</sup> In *Tata chemicals Ltd. v. Deputy Registrar*,<sup>85</sup> the registration of TATA for

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<sup>82</sup> *Absolute and relative grounds for refusal to register a trade mark*, (Feb. 03, 2017, 1:00 PM) <https://www.lexisnexis.com/uk/lexispsl/ipandit/document/393990/55YX-NS41-F18F-K0P6-00000-00/Absolute-and-relative-grounds-for-refusal-to-register-a-trade-mark>.

<sup>83</sup> ASHWANI KUMAR BANSAL, *LAW OF TRADEMARKS IN INDIA* 167 (2<sup>nd</sup> ed., 2009, Commercial Law Publishers).

<sup>84</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 9.

<sup>85</sup> 2003 (27) PTC 422 Del, “the adoption of a trade mark in the first instance are of considerable importance when one comes to consider whether the use of that mark is or has not been a common user. If the user in its inception was tainting it would be difficult in most cases to purify it subsequently”; *See also*, *Usha Rani v. Registrar Of Trade*

pressure cookers was declined as there was a likelihood of deception because TATA was a household name all over India.

### **‘Deceptive similarity’ or ‘Confusing Similarity’?**

To deceive means deceiving a person by telling him a lie or making a false representation and making him believe that a particular thing is true which in fact is false. To confuse means to cause confusion without telling lie or making false representation to a person.<sup>86</sup> Even though the expression deceptive similarity is common with the Indian Judiciary, advocates and in books but with the other concepts such as dilution, tarnishment and disparagement it is expected that any emphasis on deceitful action

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Marks, 2004 (29) PTC 647 IPAB, application for the registration of the trade mark 'USHA' in respect of switch gears, electric switch, electric main switch, metal clad switch fuse was refused as it was opposed by the respondents having their registered trademark 'USHA' for sewing machines, electrical fans, regulators and parts thereof which has got wide reputation and good will in India as well as abroad; *Sunder Parmanand Lalwani v. Caltex Ltd.*, AIR 1969 Bom 24, the Bombay High Court held that the name 'Caltex' cannot be permitted to be registered in connection with the applicant's watches on the ground that a large number of persons if they saw or heard about the mark 'Caltex' in connection with the applicant's watches, would be left to think that watches were in some way connected with the opponents who were dealing in petrol and various oil products with the mark 'Caltex'; *Bata India Limited v. Pyare Lal & Co.*, 2004 (29) PTC 647 IPAB, Meerut City the Allahabad High Court held that as the trade mark 'Bata' was used extensively with respect to footwear, the use of the mark 'Batafoam' with respect to mattresses would amount to passing off.

<sup>86</sup> V.K. AHUJA, LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS (2<sup>nd</sup> ed., Lexis Nexis 2013).

shall be left far behind in the times to come. The phrase ‘confusingly similar’ is used in the U.S. law to depict the concurrent use of conflicting marks due to which there is likelihood of confusion which leads to infringement.<sup>87</sup>

No provision under the Act mentions about the reasonable understanding or an intelligent or educated person. What is important is the impact on an average kind of a person which includes illiterate and marginally literate persons in the context of India. Such persons have imperfect recollection and they are not applying their full caution while buying. In other words, it can be said that a mark is considered to be ‘deceptively similar’ if it is so similar to the protected mark that a substantial number of average consumers are likely to be confused or misled about the source of the goods which are sold under the second mark and they may also believe that such products originate from the same owns who owns the protected mark.<sup>88</sup>

### **Purpose of § 9(2)(a): Protection of Public Interest**

Only a likelihood of confusion was required to be proved under Trademarks Act, 1958 and in 1999 Act, it is a requirement to prove that the nature of mark is such that it may

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<sup>87</sup> *Supra* note 83 at 177.

<sup>88</sup> *Ibid.*

lead to actual deception or confusion.<sup>89</sup> The absolute grounds are meant to secure public interest and thus, a trade mark shall be refused registration when there is a proof that the mark, due to its nature shall cause confusion or deception, on the ground of public policy.<sup>90</sup> “Rolls Royce” and the “Nike” swoosh were not famous when first introduced, but become famous over time. A famous mark is one that already has been tested by time, so that seeing or hearing it now evokes thoughts of a singular source in the minds of a large proportion of the relevant public.<sup>91</sup>

#### **Confusion when Goods or Services are Same, Similar or Different**

§ 9(2)(a) does not specify the determination of confusing similarity with respect to the similarity or dissimilarity of goods or services. Generally, when the goods or services are same or similar, the likelihood of confusion is more. Thus, it can be inferred that the applicability of § 9(2) will be there against the intended trade mark registrations by the prior users of similar mark irrespective of the

fact whether the goods or services involved are same, similar or different.<sup>92</sup>

In *Pioneer Bakeries (P) Ltd. v. Kraft Jacobs Suchard Ltd.*,<sup>93</sup> while rejecting opposition it was held that registration of trademark shall not be refused when there is no likelihood of confusion. The mark “MILKA” was sought to be registered for bread while the same mark was already registered for chocolates. In case the goods are different still the registrar is mandated to refuse registration if there is a likelihood of confusion.<sup>94</sup> The trademark TOSIBA was found to be deceptively similar to the registered famous trademark “TOSHIBA” but the question was relating to the similarity or difference of goods in two applications. The mark was not allowed registration even though the applicant amended the application by dropping the goods in which TOSHIBA had interest.<sup>95</sup> The registration of

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<sup>92</sup> *Supra* note 83 at 171.

<sup>93</sup> 1998 PTC (18) 502.

<sup>94</sup> *Supra* note 83 at 180.

<sup>95</sup> *Toshiba Appliances v. Kabushiki Kaisha Toshiba*, 2002 (24) PTC 654; *See also*, *Kalyanpuri Flour Mills Pvt. Ltd. v. Jagmohan Kumar*, 2004 (29) PTC 314 (IPAB), *APPU BRAND* for flour and dalls was refused for registration because *HATHI CHAAP* for the same goods existed and *ELEPHANT BRAND* could be substituted for *HATHI CHAAP* in Hindi. It was held that there will be confusion in the minds of public because the class of purchasers were rustic and uneducated maid servants or servants with every possibility of mis-identification of goods; *Chamanlal & Sons v. Bharat Industries*, 2004 PTC (28) 676 (IPAB), the registration of mark *SUN BRAND RICE* was refused because *SURAJ* existed for the same goods. *SSUN* in English is equivalent to *SURAJ* in Hindi. Thus, the registration was refused.

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<sup>89</sup> *supra* note 83 at 169.

<sup>90</sup> *Id.* at 171.

<sup>91</sup> Jacob Jacoby, *Experimental Design and the Selection of Controls in Trademark and Deceptive Advertising Surveys*, 92 TMR 947 (2002).

trademark BANZO was allowed for diesel engines, electrical motors, centrifugal pumps and parts which was opposed by the owners of trademark BENZ, MERCEDES BENZ because BANZO was in use since 1988 and was not deceptively similar to opponent's mark. Similarly, DU PONT was allowed for whiskey even though it was similar to that of DU PONT because the opponents failed to establish trans-border reputation for the evidence to show the use of mark.<sup>96</sup>

### **DECEPTIVE SIMILARITY: A RELATIVE GROUND FOR REFUSAL OF REGISTRATION**

A trademark shall not be registered if there exists a likelihood of confusion on the part of the public because of its identity is linked to the earlier trademark and goods or services covered by the trademark are similar. Also, when a trademark is similar to an earlier trademark and the identity or similarity of goods or services is covered by the trademark, there is a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark.<sup>97</sup>

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<sup>96</sup> E.I. Du Pont De Nemours & Co. of USA v. Gemini Distilleries Ltd., 2004 PTC (28) 663 (IPAB).

<sup>97</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 11(1).

A trademark shall not be registered if the earlier trademark is well-known trademark in India and the mark which is sought to be registered is identical or similar to an earlier trademark and is to be registered which are not similar to the goods or services for which the earlier trademark is registered in the name of a different proprietor. The use of the later mark, in such case would take unfair advantage of the distinctive character or reputation of the earlier trademark or is detrimental to that.<sup>98</sup>

The prior trademarks are vested with the exclusive right and they enjoy legal protection for the same, the later marks which are similar to those of the earlier trademarks<sup>99</sup> can be restrained by the courts under passing off action and cannot be registered in the name of different proprietors. The parameters of this prohibition of registration of similar later marks to earlier trademarks is known as Relative grounds.<sup>100</sup> Under § 11(1) the Registrar has to *suo moto*

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<sup>98</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 11(2).

<sup>99</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, § 11(4) Explanation: For the purposes of this section, earlier trade mark means- (a) a registered trade mark or an application under § 18 bearing an earlier date of filing or an international registration referred to in § 36E or convention application referred to in § 154 which has a date of application earlier than that of the trade mark in question, taking account, where appropriate, of the priorities claimed in respect of the trade marks; (b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.

<sup>100</sup> *Supra note* 83 at 201.



refuse registration while under § 11(2), the proprietors of earlier trademarks have to oppose registration of new marks.<sup>101</sup> Likelihood of confusion under this section includes likelihood of association with the mark.

### **Scope of § 11(1): Similarity of Goods or Services**

According to this section, a trademark, which because of its identity or similarity with an earlier trademark and the similarity of goods or services or identity or similarity of goods or services, respectively, there is a likelihood of confusion on the part of the public, shall not be registered. In order to attract this provision, it is important that the trademark in question must be identical or similar to an earlier registered trademark and the goods or services must be similar which are covered by earlier trademark.

### **Use of Identical mark for Same or Similar Goods**

The law of trade marks take care of the identity of the goods with the proprietors of the trade mark and as per the law there can be only one proprietor in respect of a mark pertaining to the same goods or description of same goods.<sup>102</sup>

<sup>101</sup> *Id.* at 202.

<sup>102</sup> *Pee Cee Soap & Chemicals Limited v. Registrar Of Trade Marks*, 2005 (30) PTC 310 IPAB, the registration of DOCTOR for cosmetics and toilet preparations was

The provisions of the U.K. Trademarks Act, 1994 are useful to Indian Judiciary in this regard.<sup>103</sup> In *Societe Des Produits v. V.M. Confectionery Limited*,<sup>104</sup> the registration of mark ZERO was refused because a registered trademark AERO in respect of cocoa, chocolates, confectionery and chocolate biscuits already existed.

### **Dilution or Association of later Mark with earlier Mark**

Trademark dilution usually occurs either by way of blurring or tarnishing. In case of

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already in use by the opponent in respect of soap, detergent, toilet preparations, cosmetics.; *See also*, *Charak Pharmaceuticals v. Deepharma Limited*, AIR 1999 Delhi 15, the registration of trademark ULCERAX which was opposed by the proprietor of trademark ALSAREX used on medicines for same diseases. It was held that all medicines whether they may be allopathic, ayurvedic or homeopathic are goods of the same description under the Act. Thus, the defendant by using the trade mark ULCEREX has prima facie infringed the plaintiff's registered trade mark ALSAREX; *Smt. Raj Wadhwa, Proprietress v. Glaxo India Limited And Heinz*, 2005 (31) PTC 201 IPAB, the registration of GOLDCON-D for infant foods was refused because it was similar in sound to that of GLUCON-D which is very famous and reputed trade mark in respect of glucose, flour biscuits; *Bhagwant Lal Chaman Lal v. Shulton Inc.*, 2005 (30) PTC 88 IPAB, the registration of OLDSPICE in respect of safety razors was refused as OLD SPICE for after shave already existed which has acquired worldwide reputation.; *The British India Corpn. Ltd. v. Kharaiti Ram*, AIR 2000 Delhi 289, DWM-DHARIWAL was opposed by the petitioners because they were well established manufacturers of shawls, blankets and they had been selling their goods from 1920 under the trade name DHARIWAL. Registration was refused.

<sup>103</sup> *Supra note* 83 at 213.

<sup>104</sup> 2004 (29) PTC 508 IPAB, The illiterate class of people may not be able to make that much of subtle distinction and select the goods. Hence, definitely there will be a confusion and deception in the minds of the consumer as well as traders. Definitely the impugned trade mark of the respondent attracts § 11(a) as well as 12(1) of the Act.

blurring there is an erosion or watering down of the “distinctiveness”, “uniqueness”, “effectiveness” and “prestigious connotations” of the trademark is apprehended. Tarnishment happens when a third party uses the mark to besmirch or debase the mark holder.<sup>105</sup> The supporters of Dilution theory believe that a person who has used his intellectual, physical or financial powers to create a commercial product should be afforded judicial relief from a competitor who seeks to “reap where he has not sown”.<sup>106</sup>

In *Caterpillar Inc. v. Mehtab Ahmed*,<sup>107</sup> the Court not only found that there was dilution in respect of identical goods, but also that such dilution was bound to confuse potential consumers. It was observed that, “Since the goods are identical it has immense affect of

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<sup>105</sup> T.G. Agitha, *Trademark Dilution: Indian Approach*, 50 (3) JILI 342 (2008).

<sup>106</sup> *Id.* at 345.

<sup>107</sup> [2002] (25) PTC 438 (Del.), CATERPILLAR, the famous trademark of Caterpillar Inc., USA was adopted by a local proprietor as CAT in Delhi for footwear; *See also*, Jolen Inc. v. Doctor & Company, 98 (2002) DLT 76, Mere advertisement in other countries is sufficient if the trademark has established its reputation and goodwill in the country of its origin and countries where it is registered; N.R. Dongre v. Whirlpool Corporation, 1996 PTC (16); I.K. Sons v. Prakash Brassware Industries, 2004 (29) PTC 493 (IPAB), the registration of PARKO for identical electrical goods was refused; Habitat UK Limited (Formerly) v. Habitat India Pvt. Ltd., 2003 (27) PTC 11 (Bom), registration of HABITAT was refused for similar goods; Green Valley Biscuits Pvt. Ltd. v. Hasmukhrai & Co., 2005 (31) PTC 521 (Reg.), the registration of word SOCIETY with the words FOURACES was rejected the trademark SOCIETY already existed in respect of cognate allied goods.

diluting the identification value of plaintiff's mark. Such dilution supplements the confusion as to source, affiliation or connection. Unauthorised use of the mark on the goods in question which are competing goods itself results in dilution. Potential purchasers are bound to be confused as to source, sponsorship, connection or license.”

In *ITC Limited v. Philip Morris Products Sa*,<sup>108</sup> while refusing the registration for the Philips Co., it was held that ITC's major contention had been the similarity between the W-Namaste mark of the Welcomgroup and the “M” on the Marlboro pack which was alleged to appear deceptively like a “W”. The court observed that a “global” look, rather than a focus only on the common elements of the mark, is to be taken, while considering if the impugned or junior mark infringes, by dilution, an existing registered mark.

When there is dilution by way of impairing the distinctive quality of trademark

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<sup>108</sup> 2010 (42) PTC 572 (Del.); *See also*, Sumathi Chandrasekharan, *ITC loses TM dilution case against Philip Morris*, (Feb. 5, 2017, 2:00 PM), <https://spicyip.com/2010/01/itc-loses-tm-dilution-case-against.html>; Taw Manufacturing Coy. Ltd. v. Notek Engineering Co. Ltd., 68 RPC 271, the plaintiff has to establish is not actual infringement but the likelihood of confusion based on the substantial similarity or identity of the marks; P.C. Mallappa v. Mcdonalds Corporation, 1999 PTC 9; Daimler Benz Aktiegesellschaft v. Hybo Hindustan, 1994 PTC 287; Aktiebolaget Volvo v. A.K. Bhuvu, 2006 (32) PTC 682; William Grant & Sons Limited v. McDowell & Co. Ltd., 55(1994) DLT 80.

which is registered earlier, it is known as dilution by tarnishment.<sup>109</sup> In *Tata Sons Limited v. Gina Kilindo*,<sup>110</sup> the applicants were restrained from engaging in any act whatsoever that will result in the dilution and tarnishment of the well-known trademark TATA and the "T within a circle" device mark of the plaintiff.

### Unfair Advantage

It contemplates the benefit accruing to the applicant through the use of mark which he has applied for. When public is confused into thinking that there is a commercial connection between the suppliers of goods or services supplied under the earlier trademark and the mark which is subject of the application, then there is an anticipation of prohibition.<sup>111</sup> The stronger is the character and distinctive reputation of earlier mark it would be easy to

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<sup>109</sup> *Supra note* 83 at 210.

<sup>110</sup> CS(OS) No.46 of 2014, decided on 6 Jan. 2014; *Mother Dairy Fruit & Vegetable v. S.K. Raheem*, decided on 24 Dec 2016, the use of mark "VINAY MILK" and label/logo and packaging/trade dress which bears a striking similarity to the trade mark/logo and trade dress/packaging of the plaintiff's products amounted to tarnishment and dilution of the reputation and goodwill of registered mark MOTHER DAIRY which was adopted in 1974; *Yahoo! Inc v. Sanjay Patel*, decided on 1 Sep. 2016, the plaintiff claimed protection from infringement of its trademark YAHOO by defendant's YAHOO MASALA CHAKRA and YAHOO TOMATO TANGY. It was held that the continuous infringement by the Defendants 1 and 2 of the Plaintiff's well known trademark has the potential of diluting the trademark Yahoo and tarnishing the reputation attached to the said trademark. It is bound to cause confusion amongst the public, causing them to believe that AFPL is associated with the Plaintiff, which is not.

<sup>111</sup> *Supra note* 65 at 264.

accept the unfair advantage that has been taken or detriment has been caused.<sup>112</sup>

### Scope of § 11(2): Similarity with earlier mark and Registration for Dissimilar goods and services

A trade mark which is identical with or similar to an earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.<sup>113</sup>

Well known trademarks enjoy rights not in relation to same or similar goods or services for which it is registered but it should not have been used by any other person on goods or services different from such goods or services. § 11(2) enables refusal of registration of a later trade mark which is sought to be registered for

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<sup>112</sup> *Id.* at 265.

<sup>113</sup> The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999 (India), § 11(2).

different goods or services, if later mark is identical or similar to earlier trademark.<sup>114</sup>

§ 11(2) came in effect on 15 September 2003 and has emerged out of the international practice of protecting the well-known marks and gives effect to article 16.3 of TRIPS which came into effect for developing countries from January 2000. This provision is in line with the WTO-TRIPS Agreement.<sup>115</sup>

The provision under § 11(2) brings a notable change in the statute law, as it brings into light the general trend of judicial decisions in India in the matter of protection of well-known trademarks used for dissimilar goods.<sup>116</sup> The test provided under this section is different from confusion as under this section it is required to show that the use of latter mark is without due cause and it would take unfair advantage or would be detrimental to the distinctive character or reputation of earlier trademark.<sup>117</sup>

### **Unfair Competition**

When a person uses another person's well known trademark, he tries to take advantage of the goodwill that well known trademark enjoys and such an act constitutes an

unfair competition.<sup>118</sup> Since traditional trademark law is designed to protect trademarks for the purpose of preventing confusion, many countries provide for protection of well-known trademarks under the doctrine of dilution in unfair competition prevention law. This is because that where a person uses another person's well-known trademark or trademark similar thereto for the purpose of diluting the trademark, such use does not cause confusion among consumers but takes advantage of the goodwill of the well-known trademark, it constitutes an act of unfair competition.<sup>119</sup>

### **CONCLUSION**

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<sup>118</sup> *Tata Sons Ltd. v. Manoj Dodia*, decided on 28 Mar. 2011, a registered trade mark is also infringed by any advertising of that trade mark if such advertising takes unfair advantage of and is contrary to honest practices in industrial or commercial matters. Also if it is detrimental to the distinctive character of the registered trade mark. Also if it against the reputation of the registered trade mark.

<sup>119</sup> *Tata Sons Ltd. v. A.K. Chaudhary*, decided on 6 Apr. 2009; *See also, M/S Sohan Lal Nem Chand Jain v. Triden Group*, decided on 3 Oct. 2011, a registered trade mark is infringed by any advertising of that trade mark if such advertising takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or is detrimental to its distinctive character; or is against the reputation of the trade mark; *Sun Pharmaceutical Industries v. Anglo French Drugs & Industries*, decided on 12 Sep. 2014, in a passing-off action, the plaintiff's right is: "against the conduct of the defendant which leads to or is intended or calculated to lead to deception. Passing-off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or business. The action is regarded as an action for deceit."

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<sup>114</sup> *Supra note* 83 at 217.

<sup>115</sup> *Id.* at 219.

<sup>116</sup> K.C. KAILASAM, *LAW OF TRADE MARKS* 237 (3<sup>rd</sup> ed., Lexis Nexis 2013).

<sup>117</sup> *Id.* at 238.

It is clear that the primary function of the trademark is to indicate the source or origin of goods or services. But this function is guided by two principles. Firstly, the mark should meet all the necessary conditions as laid down under the Trademarks Act, 1999 i.e., it should be distinctive. Secondly, it should not be of such nature as to deceive or confuse the public regarding the source or origin of goods or services. These two conditions must be fulfilled before deciding whether a mark fulfils the criteria of granting protection or not.

Deceptive Similarity as a ground for refusal of trademark registration is the most important feature of the Act, along with other supplementary provisions covered under the purview of Deceptive Similarity. As already discussed, proof of intention to show Deceptive Similarity is irrelevant. What amounts to Deceptive Similarity is a question of fact and depends upon facts and circumstances of each case. Indian Judiciary as played a very important role in determining whether a particular mark will deceive the public or not. In this paper, the Judicial Endeavour (India as well Foreign) has been discussed very thoroughly to determine the features of Deceptive Similarity and the relevant criteria to determine what amounts to Deceptive Similarity in a particular case.

In order to establish infringement with regard to a registered trademark, it is necessary to establish that the infringing mark is identical or deceptively similar to the registered mark and no further proof is required. In the case of a passing off action, proving that the marks are identical or deceptively similar alone is not sufficient. The use of the mark should be likely to deceive or cause confusion. Further, in a passing off action it is necessary to prove that the use of the trademark by the defendant is likely to cause injury or damage to the plaintiff's goodwill, whereas, in an infringement suit, the use of the mark by the defendant need not cause any injury to the plaintiff.<sup>120</sup>

Thus, it can be concluded that a proprietor cannot use the trademark which is of another proprietor, he cannot adopt/use a mark which causes or is likely to cause confusion or deception in the minds of public, he cannot use a trademark of a Company which is a well-known trademark, and also, he cannot through the use of mark indicate that particular goods originated from him which is actually originating from another person having well-established reputation and goodwill.

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<sup>120</sup>Binita Shahi, *Trademark Protection in India*, LEGAL SERVICES INDIA, (Feb. 10, 2017, 2:00 PM), <http://www.legalserviceindia.com/article/l65-Trademark-Protection-in-India.html>.

# A CONCEPTUAL AND LEGAL ANALYSIS ON HOW FILM CENSORSHIP HAMPERS THE FREEDOM OF ARTISTIC EXPRESSION

*Chandana Arval\**

## **FREEDOM OF ARTISTIC EXPRESSION**

Freedom of artistic expression is the principle that an artist should be unrestrained by law or convention in the making of his or her art. All persons enjoy the right to freedom of artistic expression and creativity, which includes the right to freely experience and contribute to artistic expressions and creations, through individual or joint practice, to have access to and enjoy the arts, and to disseminate their expressions and creations.

Artistic freedom is vital to both the cultural and political health of our society. It is essential in a democracy that values and protects the rights of the individual to espouse his or her beliefs, which is why many international human rights instruments recognize and seek to protect the right to artistic freedom of expression, for instance, artistic expression and creativity, are protected under articles 15 of the International Covenant on Economic, Social and Cultural

Rights (ICESCR) and 19 of the International Covenant on Civil and Political Rights (ICCPR).

## **THE CONUNDRUM CALLED 'CENSORSHIP'**

Censorship, is the anti-thesis to the freedom of speech, expression and information<sup>1</sup>. It is in fact the suppression of speech or any information that may be considered harmful, objectionable, sensitive, politically incorrect or inconvenient as determined by governments, media outlets or other figures of authority in a state. That said, it is extremely difficult to attribute one definition to censorship. The qualities of censorship are not reducible to a

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<sup>1</sup> Sarkar S, *Right to Free Speech in a Censored Democracy*, (2009) 7 UNIVERSITY OF DENVER SPORTS AND ENTERTAINMENT LAW JOURNAL 62, (April 28, 2016), <http://www.law.du.edu/documents/sports-and-entertainment-law-journal/issues/07/right.pdf>.

circumscribed and predefined set of institutions and institutional activities, but is produced within an array of constantly shifting discourses, practices and apparatuses. It cannot, therefore, be regarded as either fixed or monolithic. It is a continuous process. This makes it difficult to have a rigid definition for censorship. Many writers argue that censorship cannot be looked at from a single lens and hence needs to have an inclusive definition that responds to the diverse experiences of censorship, and which reflects the socio-historical specificity of instances of control, conditioning or silencing.<sup>2</sup>

Primarily (but not necessarily) censorship may either be legal or extra legal. Legal censorship is imposed through means strictly authorized by law. It comprises both pre-censorship (pre-dissemination restraints) and subsequent censorship (post-dissemination sanctions), while extra-legal censorship refers to the suppression of information through means not strictly authorized by law<sup>3</sup>.

Some of the driving rationales behind the concept of censorship around the world are the interests of national security, religious peace

keeping, to control obscenity and hate speech. National security, obscenity and hate speech are definitional grey areas, as they are extremely all-encompassing and hence ambiguous, which makes it problematic to comprehend these terms in the context of censorship because, anything and everything that is even mildly offensive or threatening can and has been subject to censorship which makes it essential to address the concept of censorship in the context of freedom of speech and expression in order to see if it is possible to determine the limits of censorship.

## FILM CENSORSHIP- THE INDIAN PERSPECTIVE

The constitution of India, by virtue of Article 19 guarantees its citizens the fundamental right to freedom of speech and expression, such freedom however is not unrestricted and comes with reasonable restrictions. Freedom of speech and expression is the concept of being able to express oneself freely whether through words of mouth, literature, art, or any other medium of communication. It is often regarded as an integral concept in modern liberal democracies. Despite the fact that the Constitution of India does not expressly mention motion pictures as a medium of speech and expression they have been so accepted through the decision of the

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<sup>2</sup> Freshwater H, *Towards a Redefinition of Censorship*, in Müller Beate (ed), *Censorship & Cultural Regulation in the Modern Age* (Rodopi 2004).

<sup>3</sup> Banerjee A, *Political Censorship and Indian Cinematographic Laws: A Functionalist Liberal Analysis*, (2010) 2 DREXEL LAW REVIEW 557, (April 26, 2016), <http://ssrn.com/abstract=1672409>.