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Deceptive Similarity In Trademark Law

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I. Abstract

Every individual on this planet has various rights over their property, be it immovable or movable. Similarly, there are some legal protections given to intellectual property like inventions, logos, symbols, designs, etc., and offenders who violate the owner's rights by copying them face consequences. In this paper, we covered the infringement of the rights of the owner of a trademark, one of the intellectual properties. Sometimes, the defendant does not exactly copy the work of the owner but creates a similar product that resembles the former or the original product, which means deceptive similarity. In this paper, we discussed the meaning of deceptive similarity, how we can test for trademark infringement, and some judicial interpretations.

II. Introduction

Individuals are granted rights over their creative works, or intellectual property rights (IPR). Typically, they grant the inventor a time-limited, exclusive right to utilize his or her idea. There are five types of IPR: copyright, patent, trademark, geographical indication, and industrial design.

Any word, phrase, symbol, design, or combination of these that distinguishes your products or services can be considered a trademark. Customers observe a company's trademarks to identify their organization in the marketplace. We frequently refer to both trademarks and service marks

collectively as "trademarks." A "service mark" is used for services; a trademark is used for commodities.

A trademark has various advantages, including indicating the origin of your products or services, protecting your brand legally, and preventing fraud and counterfeiting.

A. Origin And Evolution of Trademark

In India, there was no statute legislation governing trademarks prior to 1940, which is how India's trademark law came to be. When the common law theories of passing off and equity were applied to safeguard trademarks. Due to the absence of any specific legislation addressing the subtleties of trademark infringement and passing off, the **Trademark Act of 1940**¹³²⁸ was created for the first time in India, providing a mandate for the registration and statutory protection of trademarks in that country. The statutory provisions of the Trademark Law substantially followed English precedent and legislation.

After trade and commerce expanded, the Legislature realized the need for strong proprietary laws and repealed the earlier statute. In order to replace and supplant the Trademarks Act, 1940, the **Trade & Merchandise Marks Act, 1958**¹³²⁹, and the **Trade & Merchandise Marks Rules, 1959**, were created. The 1958 Act and Rules 1959 were developed in order to strengthen trademark protection. The Sea Customs Act, the Criminal Procedure Code, and other legislation such as the Indian Penal Code had trademark-related provisions that were later combined under this law.

¹³²⁸ The Trade Mark Act, No. V of 1940. Available at: <https://iprlawindia.org/wp-content/uploads/2021/04/1940.pdf>

¹³²⁹ The Trade and Merchandise Marks Act, No. 43, Act of Parliament, 1958 (India). Available at: <https://wbconsumers.gov.in/writereaddata/ACT%20&%20RULES/Relevant%20Act%20&%20Rules/The%20Trade%20And%20Merchandise%20Mark%20Act.pdf>

To meet the Trade-Related Aspects of Intellectual Property Rights (TRIPS) requirements and take into consideration the rising globalization of both trade and technology, the **Trademark Act, 1999**¹³³⁰, and Trademark Rules were developed and entered into force on September 15, 2003. The Trademark Act of 1999, among other things, intends to allow the registration of collective and service trademarks, to strengthen the protection of well-known marks, and to establish the Intellectual Property Appellate Board (IPAB) to expedite the resolution of appeals and petitions for rectification.

The Trademark Act of 1999 was subsequently amended by the Trade Marks (Amendment) Act of 2010. **The Trademark (Amendment) Act, 2010**¹³³¹, was amended by the addition of Chapter VI, Special Provisions Relating to Protection of Trademarks Through International Registration under the Madrid Protocol. As a result, both national and international trademark registrations fall under the purview of the Indian Trademark Law.

B. What Does Deceptive Similarity Mean?

In accordance with the Trademark Act of 2009, a mark must be distinctive and not deceptively similar toward other trademarks; however, no criteria for evaluating deceptive similarities are given. Deceptively similar marks can be defined as the marks which are identical enough for the consumer to mistakenly believe they are associated to a well-known or registered brand.

Section 11(1) of the Trademark Act, 1999¹³³² states that, *"a trademark cannot be registered if it is deceptively similar, or identical, with the existing trademark and goods and services, that is likely to create confusion in the mind of the public at large"*

A registered trade mark is violated under Section 29(2)¹³³³ of the Trade Marks Act, 1999 by a person who is not the registered owner or a person using the mark in accordance with a permit, uses in the course of business a mark that, due to its identification with the registered trade mark and the likeness of the goods or services covered by such a registered trade mark, is likely to cause confusion among the consumers or to have a link with the registered trade mark.

Between identical markings and misleadingly similar marks, there is a fine line. Identical marks are those that are "exactly the same/similar," whereas deceptive similar marks are those that are "almost exactly the same/similar," such as the logo, word, or letter of the mark, which may lead consumers to believe that the second product is the original product.

Deceptive resemblance has always been viewed as a basis for a trademark infringement or passing-off lawsuit. Deceptively similar marks are taken into consideration as a reason for objection under Indian trademark regulations while the Trademark Registry is registering the mark.

1. Test of infringement

¹³³⁰ The Trade Mark Act, No. 47, Act of Parliament, 1999(India). Available at: https://legislative.gov.in/sites/default/files/A1999-47_0.pdf

¹³³¹ The Trade Marks (Amendment), No. 40, Act of Parliament, 2010 (India). Available at: https://ipindia.gov.in/writereaddata/Portal/IPOAct/1_46_1_tmr-amendment-act-2010.pdf

¹³³² The Trade Mark Act, Section 11(1), No. 47, Act of Parliament, 1999(India). Available at <https://indiankanoon.org/doc/696256/>

¹³³³The Trade Mark Act, Section 29(2), No. 47, Act of Parliament, 1999(India). Available at: [https://indiankanoon.org/doc/773798/#:~:text=\(c\)%20its%20identity%20with%20the,with%20the%20registered%20trade%20mark.](https://indiankanoon.org/doc/773798/#:~:text=(c)%20its%20identity%20with%20the,with%20the%20registered%20trade%20mark.)

When two marks are used, the plaintiff must prove that the mark used by the defendant is so similar to the plaintiff's registered trade mark that it is likely to create confusion with regard to the goods for which it is registered. This is true even when the two marks are not identical. The plaintiff would bear the burden. Of course, the buyers of the items are the ones who would be duped, and the possibility of this happening is what needs to be taken into account. The comparison is being done to see if the defendant is using the key components of the plaintiff's trademark. The key question is whether the defendant's entire use of the mark is confusingly similar to the plaintiff's registered mark.¹³³⁴

The infringement test is the same as in a passing-off action when the infringing trade mark is similar to but not identical to the complaining trade mark in the register.¹³³⁵

Customers of ordinary intelligence and imperfect recollection are likely to be puzzled by an action for infringement or passing off if certain criteria are met, which is the crucial test. The plaintiff must show that the defendant's goods, as marked, caused consumers to mistake them for the plaintiff's items, in addition to the resemblance in the trade names.¹³³⁶

C. Judicial Interpretations

The Supreme Court of India has established various criteria for determining trademark misleading resemblance. However, it varies

depending on the specifics of each case. Here are a few examples of recent legal rulings on deceptive similarity:

1. ***Bigtree Entertainment v Brain Seed Sportainment***¹³³⁷:

The Delhi High Court declined to grant the plaintiffs, the owners of the website bookmyshow.com, a temporary restraining order prohibiting the defendant from using the domain name bookmysports.com. The plaintiffs' request for an interim injunction was denied because they were unable to show that the prefix "BOOKMY" had acquired distinctiveness or a secondary meaning, according to the court's ruling that the prefix "BOOKMY" of the plaintiff's trademark BOOKMYSHOW was descriptive and not arbitrary.

2. ***SM Dyechem Ltd. V. Cadbury (India) Ltd.***¹³³⁸:

Under the trademark "PIKNIK," the plaintiff in this case started a chip and wafer company. Later on, the defendant opened a chocolate shop called "PICNIC." A lawsuit for trademark violation was then brought. The trademarks' differences in look and wording led the court to find that they did not meet the criteria for misleading similarity.

3. ***M/S Allied Blenders and Distillers Pvt. Ltd. V. Govind Yadav & Anr.***

In this case, the plaintiff asserted that the defendant's trademark "Fauji," which stands for "Officer's Choice," is deceptively similar to her own. As "Fauji" is a Hindi translation of a military commander, the claim was made

¹³³⁴ Durga Dutt Sharma v. Navaratna Pharmaceuticals Laboratories AIR 1965 SC 980

¹³³⁵ Rustom and Hornby Ltd. v. Zamindara AIR 1970 SC 1649

¹³³⁶ Rajkamal Metal Industries v. Mahadev Steel Products (2001) PTC 510 (Del)

¹³³⁷ CS(COMM) 327/2016

¹³³⁸ AIR 2000 SC 2114

based on conceptual similarity in the development of the trademarks. Additionally, both sides are involved in the alcoholic beverage industry. The packaging for both bottles is also comparable. The court in this case ruled that there is no deceptive similarity between the trademarks "Officer's Choice" and "Fauji," and so dismissed the trademark infringement lawsuit, despite the fact that trade dress is an important factor in evaluating cases of trademark infringement.

4. *Satyam Infoway Ltd V. Sifynet Solutions Pvt. Ltd*¹³³⁹

In this case, the Supreme Court of India looked at a trademark and intellectual property issue that had not been studied before. When it comes to trademarks used by online media, the court serves as precedent. It was said that since everyone who uses the internet may access domain names, these marks are crucial. The use of such marks fraudulently would not only mislead consumers and users, but also cause uncertainty over unexpected service invoices. The domain name in this instance was deemed by the judiciary to be recognised as a valid trademark. It further acknowledges that using such marks fraudulently without the creator's consent would be considered violation under the Trade Marks Act of 1999.

5. *Parle Products (P) Ltd. V. JP & Co. Mysore*¹³⁴⁰

One of the most significant examples of deceptive similarity is this one. In this decision, the Supreme Court stated that in order to determine whether two marks are similar, the marks' primary

characteristics must be taken into account. The court ruled that overall similarity must be taken into account in order to avoid misleading clients or the wider public. The markings in this instance are identical in every way, including colour, size, colour scheme, and mark design, which might lead to confusion. The court determined that the mark in this case was deceptively similar because, if the customer or general public had not seen the slight distinctions, they may have mistaken it for either mark. The court ruled that depending on the features, each case would need to be examined and interpreted independently.

6. *Yahoo! Inc. v. Akash Arora & Anr.*¹³⁴¹

In this case, a single judge of the Delhi High Court upheld Yahoo! Inc.'s request for an injunction against the defendants who were intending to use the domain name "yahooindia.com" for online services. Yahoo! Inc., the owner of the "Yahoo!" trademark and the web address "yahoo.com," claimed that by using the confusingly identical domain name "yahooindia.com," the defendants had exactly replicated the format, contents, style, colour scheme, and source code of the plaintiff's previously developed Regional Section on India at the plaintiff's website. The plaintiff had been utilising country-specific domains following "yahoo," such as "yahoo.ca" for Canada. Consequently, "yahooindia.com" may be thought of as another website in the "yahoo" series.¹³⁴²

¹³³⁹ AIR 2004 SC 3540

¹³⁴⁰ 1972 AIR 1359, 1972 SCR (3) 289

¹³⁴¹ 1999 IAD Delhi 229, 78 (1999) DLT 285

¹³⁴² Chakraborty, R. (2009) *Growth of Intellectual Property Law and Trademarks*, SSRN. Available at: https://papers.ssrn.com/sol3/papers.cfm?abstract_id=1335874 (Accessed: January 21, 2023).

7. ***Rediff Communication Ltd. v. Cyberbooth and Anr.***¹³⁴³

The owner of the well-known site and domain name "rediff.com," the plaintiff in this case, applied for an injunction against the defendant, the registrant of the domain name "radiff.com," on the grounds that the latter was deceptively similar to theirs. In order to pass off their business services as those of the plaintiffs, the plaintiff claimed that the defendants intentionally adopted the phrase "radiff" as part of their trading style. The petitioner further argued that this was done on purpose by Cybertooth in order to deceive the public into thinking that Cybertooth is affiliated with the Rediffusion group and thereby unjustly profit from the plaintiff's good name.

III. **Conclusion**

The most significant aspect of the Act is Deceptive Similarity as a basis for rejection of trademark registration, coupled with other supplemental requirements covered by Deceptive Similarity. Evidence of an aim to demonstrate deceptive similarity is immaterial, as was previously stated.

It is sufficient to show that the infringing mark is identical to or confusingly similar to the registered mark in order to prove trademark infringement; no more evidence is needed. It is not sufficient to show that the markings are identical or confusingly similar in a passing-off case. The usage of the mark should be likely to mislead or confound. Furthermore, in a passing-off action, it is necessary to demonstrate that the defendant's use of the trademark is likely to harm or damage the plaintiff's goodwill, whereas in a lawsuit for trademark infringement, there is no requirement that the

defendant's use of the mark harm the plaintiff in any way.

This leads to the conclusion that a proprietor cannot utilise another proprietor's trademark, nor can he alter or use a mark that originated from someone else with a solid reputation and goodwill if doing so might lead to misunderstanding or deceit among consumers.

¹³⁴³ 1999 (4) BomCR 278