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Demystifying the concept of Deceptive Similarity under Trade Mark Law

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ABSTRACT

The term Trade Mark can be attributed as a mark that differentiates the goods and services of one person from that of others. A trademark can be held to be deceptively similar to another mark if it creates any kind of confusion in the mind of consumers of the goods and services. The act does not lay down the parameters that are to be taken into consideration while determining the question of deceptive similarity. The present article analyses the concept of deceptive similarity, through various decisions of the courts. The factors which are to be taken into consideration, while determining the question of deceptive similarity are identified.

The first legislation in India on Trade Marks was the Trade Marks Act, of 1940. Later, after the independence, the Act was repealed by The Trade and Merchandise Act, of 1958. With the advent of globalisation, Intellectual Property attained immense value and recognition which led to the need for a uniform standard for protecting trademarks and also the need for a coherent procedure for the enforcement of the trademark globally, which ultimately set the way for the TRIPS agreement. The TRIPS agreement resulted in the repeal of the 1958 legislation and the enactment of the 1999 Trade Marks Act.

According to Article 16 (1) of the TRIPS agreement, every holder of a registered trademark will be having the exclusive right to prohibit and exclude all third parties from using the mark or similar or identical signs which are likely to create confusion, by usage on the identical or similar goods and services, unless in cases wherein consent of the proprietor has been obtained. Art 16(1) also enshrines that, where the goods are identical and marks are both identical to that of the registered proprietor, the chances of confusion are maximum.

The concept of deceptive similarity as defined in the Act of 1940 and 1958 is the same and it contained the requirements as laid down by the TRIPS agreement later. Hence the 1999 Act, also follows the same definition.

As per 2(1)(d) of the 1958 Act "deceptively similar":-- "A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to

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deceive or cause confusion”.

As per S.2 (1)(h) of the 1999 Act, A mark shall be considered to be deceptively similar to the other mark if it resembles the other mark., which may cause some confusion or may deceive the public. The expression “deceptively similar” or an identical term can be seen in the given sections of the 1999 Act:²

The definition of “ False Trade Description” as provided under Section 2(1)(i)(v)(b) of the act denotes “identical with or deceptively similar to”.

The Relative grounds for refusing registration of trade mark as provided under S.11 of the Act, uses the expression “identical with or similar to”. It also uses the words “identity” with or “similarity to”.

Section 16 (1), which deals with the registration of a Trademark as an associated mark uses the term “is identical with” “or so nearly resembles it as to be likely to deceive or cause confusion” and Section 16 (2) uses the expression “identity or near resemblance of marks”.

Deceptive Similarity Jurisprudence under Indian Judiciary evolved over the years through various judgments. Traditionally the Judiciary followed a narrow interpretation of the concept. More importance was given to the visual or phonetic similarity of two marks in deciding the question of deceptive similarity, even while holding the marks to be also conceptually similar.

The seven factors to be taken into consideration, while determining the question of deceptive similarity are³:

- A. The Type of Marks i.e of the mark is a label mark, word mark or a combination of both the marks i.e composite marks,
- B. Whether there is a phonetical resemblance between the marks, which in turn gives the same idea.
- C. The type or class of goods for which marks are used.
- D. Whether there is any kind of similarity in the character, nature or performance of the goods with that of the competitors.
- E. The class of customers who are likely to purchase the goods and whether the customers are likely to take care while purchasing the goods.
- F. The platform through which they are purchasing the goods.

² Dr.S.Venkateswaran, Venkateswaran on Trade Marks and Passing Off, Lexis Nexis Butterworths Wadhwa, Nagpur, 5th Edn 2010 P.p 418 -419

³ Biopharma and Air v. Sanjay Medical Store and Ors, 1997 PTC(17) 355

G. Any other surrounding circumstances, which in turn depends on the case to case.

In **F. Hoffman La Roche & Co. Ltd vs Geoffrey Manners & Co. Pvt. Ltd**⁴ while deciding that DROPOVIT and PROTOVIT are not deceptively similar, held that, while determining whether a mark is deceptively similar to the other mark, the intention to deceive or cause confusion is not the only criteria to determine deceptive similarity. It is also very important to look into the mark from the point of view of consumers.

The aural and ocular similarities of a mark constitute a very important factor, in determining whether a mark is deceptive or delusive.⁵

The Hon'ble Calcutta High Court in **Prem Nath Mayer vs Registrar Of Trade Marks And Anr**⁶, held that while deciding the question of deceptive similarity, it should be always kept in mind that the consumer, need not be always a literate person. Depending on the products or goods, the consumers also may change. Where the goods involved were Chaff-Cutter, the court decided that, even though the words are phonetically not similar, there are chances for confusion for an ordinary man of average intelligence.

To decide on deceptive similarity, it is important to consider the broad and essential features of both marks. It is not ideal to see the differences in the design or mark by keeping both marks side by side. To determine the question of deceptive similarity, it is enough if the impugned mark bears such an overall similarity to the registered trademark as would lead a customer, who usually⁷ knows the registered mark to accept the impugned mark, if offered.

In **K. R. Chinna Krishna Chettiar vs Sri Ambal & Co., Madras & Anr**⁸, the Supreme Court of India, held that there is no ocular resemblance between the two marks, Ambal and Andal. The court further held that visual comparison is not the only test to determine deceptive similarity. The resemblance between the two marks must be considered for the ear as well as the eye. There is close propinquity between the sounds "Ambal" and "Andal" and hence decided that the two marks are deceptively similar.

In the case of **Coca-Cola Co. of Canada v. Pepsi Cola Co. of Canada Ltd**⁹, it was found that cola was in common use in Canada for naming beverages. The distinguishing feature of the mark Coca-Cola was coca and not cola. For the same reason, the distinguishing feature of the

⁴ 1970 AIR 2062

⁵ Encore Electronics Ltd. v. Anchor Electronics & Electricals Pvt. Ltd.

⁶ AIR 1972 Cal 261

⁷ Parle Products (P) Ltd v. J. P. & Co. Mysore, 1972 AIR 1359

⁸ 1970 AIR 146

⁹ [1940] SCR 17

mark Pepsi Cola was Pepsi and not cola. It was not likely that anyone would confuse the word Pepsi with coca.

In *ITC Ltd. v. Britannia Industries Ltd*¹⁰ wherein it was observed that the goods involved are eatables like biscuits, chocolates etc packaging of the goods plays a key role. The colour and the colour scheme of the packet, determine the initial choice of the customer and help them in identifying the particular brand of a proprietor.

The recent decision of the Delhi High Court involving two marks, one being Cadbury's very famous "Jems" mark and the other being the "James Bond" mark of the defendants, considered the following factors while granting a permanent injunction against the defendants from using the trade mark "JAMES" and "JAMES BOND"¹¹:

Firstly what kind of products or goods are in question, here the goods involved were chocolates.

Secondly, the consumers who generally consume the products, where the majority of customers were found to be children, that too both urban and rural populations.

Thirdly where the particular products are sold, here it was identified that the products were sold not only in big retail stores but also in roadside shacks, paan shops, patri vendors, kirana stores and stalls outside schools, etc.

After analysing these factors, the court observed that the colour combination, get up and layout of a good plays a very important aspect, for the consumers and in the instant case, taking into consideration, the target group for the goods, that is children, the likelihood of confusion is even higher.

In *M/S Allied Blenders and Distillers Pvt. Ltd. v. Govind Yadav & Anr*,¹² the Hon'ble Delhi High Court while dealing with the notion of conceptual similarity, held that the plaintiff's mark "Officer's Choice" and the defendant's mark "Fauji" are not deceptively similar. The court dismissed the contention of the plaintiff that the defendant's mark "Fauji" will create a big confusion among the consumers and held that the words are not only phonetically different but conceptually also confers two different meanings.

In Lavroma case,¹³ the case where Lord Johnston observed that the comparison of marks is not a matter for microscopic inspection but is to be taken from the general and even casual point of view of a customer walking into a shop

¹⁰ 2016 SCC OnLine Del 5004

¹¹ Mondelez India Foods Pvt. Ltd. v. Neeraj Food Products, 2022 SCC OnLine Del 2199,

¹²2019 SCC OnLine Del 6834

¹³ Tokalon Ltd. v. Davidson & Co, 32 RPC at 133 at 136

In *The Gillette Company v. Tigaksha Metalics Private Limited*,¹⁴ the Delhi court while deciding that the Defendant's mark is deceptively similar to that of the plaintiff's mark, held that the words "Sword" and "Talwar", deliver the same meaning.

In *Shree Nath Heritage Liquor Pvt. Ltd and Ors. v. Allied Blender & Distillers Pvt Ltd*¹⁵ Delhi High Court held that the marks "Officer's Special" and "Collector's Choice" are deceptively similar.

The imperfect recollection of the name by the customers was taken into consideration while holding that the marks "Lakshmandhara" and "Amritdhara" are deceptively similar. Furthermore, the court also opines that in cases of medicinal products, additional protection has to be given.¹⁶

The Apex Court, in *Cadila Healthcare Ltd. v. Cadila Pharmaceuticals*¹⁷, while holding that the marks "Falcitab" and "Falcigo" are deceptively similar, observed that in the Indian market, a large majority of consumers are illiterate and don't know the English language and these people are to be considered while deciding the question of deceptive similarity of products, especially in case of medicinal products.

In *Sun Pharmaceutical Industries Ltd. and Anr. v. Kinetic Life science*¹⁸, the Hon'ble court while deciding that the plaintiff's registered mark "ISITE" when compared with the defendant impugned mark "EYESITE" creates an impression that both marks are visually similar and phonetically identical. In this case the Hon'ble Delhi High Court laid down the following parameters, which are to be considered while deciding questions of similarity:

- i. competing marks have to be seen as a whole;
- ii. marks are not to be kept side by side for comparison and are not to be dissected or compared syllable by syllable;
- iii. if the marks are visually and/or phonetically identical or similar, confusion/deception is likely to occur; and
- iv. public interest supports a lesser degree of proof showing confusing similarity in the case of trademarks in respect of medicinal and pharmaceutical products,

¹⁴ (2018) 251 DLT 530

¹⁵ (2015) 221 DLT 35

¹⁶ Amritdhara Pharmacy vs Satyadeo Gupta, 1963 AIR 449

¹⁷ 2001 (2) PTC 541 SC

¹⁸ CS(COMM) 241/2021

The court while deriving at the conclusion, stated that even though the prefix of the plaintiff and defendants marks “I” and “EYE” respectively are different, the issue of phonetic similarity and overall similarity of the marks can not be ignored. The court also took into consideration the fact that the products are similar.

In **SM Dyechem LTD. v. Cadbury (India) Ltd**¹⁹, the plaintiff filed a case against the defendant for trade mark infringement on the ground that the defendant’s “PIKNIK” mark, for chips and wafers is deceptively similar to the defendant's “PIKNIK” mark, which was used for chocolates. The Hon’ble court held that where the brands are different in composition and visibility, no question of deceptive similarity arises.

In **M/s. Hitachi Ltd. v. Ajay Kr. Agarwal and Ors**,²⁰ the hon’ble court applied the test of the point of view of the common man with an imperfect memory and observed that though both marks ‘Hitachi’ and ‘Hitaishare are in two different languages and are visually dissimilar, there is a strong phonetic similarity between the marks as both the terms are pronounced similarly and hence it will create confusion to the common customers.

In **Times Internet Ltd vs Jonathan S. And Another**²¹ the court while holding that the defendant’s domain name www.myindiatimes.com is deceptively similar to M/S Bennet Coleman & Co Ltd’s www.indiatimes.com, opined that on` account of long use, reputation, goodwill and marketing, the mere mentioning of the term “indiatimes”, will directly denote the products and services offered by the plaintiff. The court further opined that the mark “Indiatimes” is not a word which can be found in the dictionary and the same has been coined and developed by the plaintiff, resulting in eligibility for the highest level of protection. Thus the mark “Indiatimes” cannot be used by anyone else.

The Apex court while deciding the infringement action filed by Mahindra and Mahindra, observed that “Mahindra has acquired distinctiveness and secondary meaning in trade and that if any proprietor uses similar marks for their business, a likelihood of confusion may arise as consumers may presume that there is some kind of relationship with the original plaintiffs.”²²

In an infringement claim, it is a settled law that the Court is required to compare the two competing marks, i.e. registered mark of the Plaintiff and the allegedly infringing mark used by the Defendant, in the course of trade. Where the said two marks are identical, no further questions arises as straightaway the fact of infringement is made out . However, when the two

¹⁹ 2001 AIR SCW 1411

²⁰1995 (2) Arb. LR 348,

²¹ 2012 (51) PTC 195 (Del)

²² Mahendra And Mahendra Paper Mills vs Mahindra And Mahindra Ltd 2001 Supp(5) SCR 225

marks are not identical, plaintiff would have to establish that the impugned mark so closely resembles or is deceptively similar that it is likely to deceive or cause confusion about the goods in respect of which the mark is registered. The resemblance may be phonetic, visual or in the basic idea of the plaintiff's mark.

Trade marks play a very important role in creating goodwill and reputation for the various providers of goods and services. Taking into consideration its importance in creating brand value and also in generating profit, there are high chances of trademark infringement, where certain proprietors may try to take a free ride at the cost of the reputation created by others. An analysis of the above decisions of various courts, suggests that there is no hard and fast rule to determine the case of deceptive similarity. The honourable courts have opined, through various decisions, the different parameters which can be taken into consideration while determining the question of infringement of trade mark. The various factors which have to be taken into consideration while deciding on deceptive similarity were identified. It is observed that the judiciary has not only considered visual resemblances as criteria for deciding the question of deception, but in certain cases, where there lacks visual similarity, but phonetic similarity or identity, the court has decided that there is a strong case of deception. Another factor which the judiciary takes into consideration is the class of consumers and the medium of purchase. Furthermore, depending on the goods or services which is the subject matter of the trade mark, the level of protection also changes. For medicinal products, a higher level of protection is granted.
