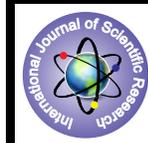


Trademark and the problem of its Infringement in the case of Deceptive Similarity



Law

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ABSTRACT

A trademark not only distinguishes the product of a company or firm from the products of other companies in the given jurisdictional marketplace, but also represents the identity and reputation of the company, and certain impressive qualities of the concerned product or service. Proper and lawful registration of a trademark gives some legitimate and privileged rights to the owner of the registered trademark such as authoritative ownership over the registered trademark; authoritative and exclusive commercial or professional uses of the trademark; security and protection of the trademark and selling of the registered trademark. Trademark infringement violates these rights of the trademark's owner. This paper while highlighting the basic information about trademark and its utility focuses on the problem of trademark infringement in the case of deceptive similarity with citation of some case laws.

Introduction

A trademark, trade mark, or trade-mark is a recognizable sign, design, or expression which identifies products or services of a particular source from those of others, although trademarks used to identify services are usually called service marks.

A Trademark generally refers to a "brand" or "logo".

Trademark registration can also be obtained for a business name, distinctive catch phrases, taglines or captions.

Properly used and promoted, a Trademark may become the most valuable asset of a business. Trademarks such as Coca Cola, HP, Canon, Nike and Adidas serve as an indication of origin of the goods as well as an indication of quality.

It is also essential to obtain trademark registration for the business name/trade name under the Trademarks Act. Registration of a company or business name under the Companies Act does not in itself give protection against others who might commence using identical or similar marks.

Use of TM, SM and * symbols

'TM' stands for Trademark and 'SM' stands for Service mark. The use of TM and SM symbols notifies the public that the company is claiming exclusive ownership of the trademark and can generally be used by one who has filed a trademark application.

The * symbol, can be used only once the trademark is registered and the registration certificate is issued. Also, you may use the registration symbol only in connection with the goods and/or services in respect of which the trademark is registered.

According to sec. 2 (zb) of the Trade Mark Act 1999

"trade mark" 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 shape of goods, their packaging and combination of colours; and--

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose 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; and

(ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so 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, either as proprietor or by way of

permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark;

The most important thing here is, that any trademark must be distinctly different and unique, from the trademarks of other companies, and ought to be capable of being represented graphically. Even the partial similarities, phonetic similarity, or resemblance in appearances between the trademarks of two different people or companies, can give rise to the cases of trademark opposition or trademark infringement litigation. For example --- Encore and Anchor; Ambal and Andal; or Saffola and Savola; etc, as these similarities may create the likelihood of confusion or deception to the customers.

Trademark provides protection to the owner of the mark by ensuring the exclusive rights to use in to identify the goods or services or authorize another to use it in return of payment. It works like a weapon in the hand of registered proprietor or owner of the mark to stop other traders from unlawful use of the mark of the registered owner. Under section 28 of the Act, the registration of a trade mark shall give to the registered proprietor of the trademark, the exclusive right to the use of the mark in relation to the goods in respect of which the mark is registered and to obtain relief in respect of the trademark in the manner provided under the Act.

Why should one register a trademark?

A registered trademark gives the exclusive use of that name, providing its owner the capability:

- * To offer licenses and franchises.
- * To be differentiated from competitors.
- * To be protected from third parties using an equal or similar name, exercising the legal actions that correspond.
- * To protect the Internet domain name.
- * To impede others attempting to register similar trademarks.
- * To create Trademark Value Goodwill, an active intangible for the company.
- * To have priority over third parties wanting to register their trademarks, in countries which do not require registration.

As per section 18 (1) of the Trade mark Act, 1999, any person claiming to be the proprietor of a trademark used or proposed to be used by him may apply in writing in prescribed manner for registration. The application must contain the name of the mark, goods and services, class in which goods and services fall, name and address of the applicant, period of use of the mark.

As per Trademark Act, a mark shall be deemed to be infringed mark if:

1. It is found copy of whole registered mark with a few additions and alterations,

- The infringed mark is used in the course of trade,
- The use of the infringed mark is printed or usual representation of the mark in advertisement. Any oral use of the trademark is not infringement.
- The mark used by the other person so nearly resembles the mark of the registered proprietor as is likely to deceive or cause confusion and in relation to goods in respect of which it is registered.

Deceptive similarity

According to sec. (h) of the 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 deceive or cause confusion;

A mark shall not be registered as a trademark if it is of such nature as to deceive the public or cause confusion. It can be seen that 'similarity and identical nature of the trademark' and 'likelihood of deception and confusion' are the grounds for refusal to register them either as an absolute ground or a relative ground for refusal of registration, depending on the facts and circumstances of each case.

Factors to be considered:

The question of similarity between two trademarks or the likelihood of deception or confusion from their use cannot be decided in vacuum, but it should be determined in the background of surrounding circumstances. The under mentioned factors should be considered for determination of deceptive similarity.

- The nature of the marks i.e. whether they are invented words, words having descriptive significance, non-descriptive words, geographical names, surnames, letter, numerals or devices.
- The degree of resemblance between the two marks-phonetic, visual as well as similarity in idea or expression.
- The nature of the goods/services in respect of which they are used or likely to be used as trademarks.
- The similarity in nature, character and purpose of the goods/services of the rival traders
- The class of purchasers who are likely to buy the goods bearing the marks, their level of education and intelligence, and the degree of care they are likely to exercise in purchasing the goods.
- The mode of purchase of goods or of placing orders for the goods, and
- Any other surrounding circumstances

The aforementioned factors are quite relevant for deciding deceptive similarity. Evidence of actual deception is not necessary, although weight will be given to instances of actual deception or confusion. When the goods are different, evidence of confusion may be essential.

In Delhi Lakme Ltd vs. Subhash Trading 1996 PTC (16)567. Plaintiff was selling cosmetic products under the registered Trade Mark "Lakme". Defendant was using the Trade Mark "Like-Me" for the same class of products. It was held that there was striking resemblance between the two words. The two words are also phonetically similar. There is every possibility of deception and confusion being caused in the mind of the prospective buyer of the plaintiff's products. Injunction was made permanent.

In another case the party in the trade mark registry made an application for registration of trade mark "FIXACOL". The opponents were registered proprietors of trade mark 'FEVICAL' who pleaded rejection of the application on the grounds of deceptive similarity and confusion. The application was refused registration on the above grounds (PTC 1995, 105).

In Castrol Limited and others vs. Subhash Kapoor and others ,2002(24)PTC 654(Del.)

The High court of Delhi has held that trademark "INDOL" adopted by defendants has deceptive similarities in look and sound to the trademark "INDROL" with similar colour combination, get up and by out is bound to create confusion amongst unwary customers and it has decreed to protect the right of plaintiff

In M/S Mahashian Di Hatti Ltd. Vs. MR. Raj Niwas, Proprietor of MHS Masalay, judgment pronounced by Delhi HC in 2011 -

The plaintiff company engaged in the business of manufacturing and selling spices and condiments, which are being sold under its registered logo (comprising "MDH" within three hexagon device on red colour background) and is registered since 31st May 1991 and the plaintiff company uses its logo throughout in India and also claims for throughout the world. The plaintiff company has tremendous goodwill and reputation not only in India but worldwide in respect of the goods sold under its registered trademark. The defendant has been using the logo "MHS" within hexagon device with red colour background on the carton is alleged to be similar to those being used by the plaintiff company. The plaintiff company has accordingly sought an injunction restraining the defendant from using the infringing logo "MHS" or any other trademark identical with the or deceptively similar to plaintiff's registered trademark "MDH" logo. The plaintiff was also awarded punitive damages amounting to Rs. 1 Lakh against the defendant.

Conclusion

Trade mark registration under the Act only has effect in India. To obtain trade mark rights and protection in other countries it is necessary to use and/or register the trade mark in those countries. Trade mark protection is territorial in nature. A separate registration will have to be made in each of the countries where protection is desired. For extending one's businesses to international horizons, proper registrations of the concerned trademarks under one or more international trademark treaties are pre-requisite. Today, for protecting the due rights of the owners of trademarks in international arenas, there are four most significant and influential international trademark conventions or treaties in the entire world. To enable the trademark's owner to reap the benefits of his registered trademark, laws should be executed strictly and apart from this awareness on the part of trademark's owner and end users is much of importance so that they can take necessary action against the infringers.

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