

INTERNATIONAL JOURNAL FOR LEGAL RESEARCH AND ANALYSIS



Open Access, Refereed Journal Multi Disciplinary
Peer Reviewed

www.ijlra.com

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ISSN

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UNDERSTANDING TRADEMARK INFRINGEMENT – KEY LEGAL ELEMENTS AND CASE STUDIES

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ABSTRACT

A trademark is a unique symbol, word, phrase, logo, design, or a combination of these elements and is inclusive of colours that identifies and differentiates the goods or services of one business from those of others.

Trademarks always play a crucial role in the business world by distinguishing the goods and services of one company from those of others, given that they provide valuable brand recognition and help businesses build customer loyalty. They also serve as indicators of quality and source, allowing consumers to make informed purchasing decisions when it comes to deciding between brands, which encourages competition and innovation.

Trademark infringement occurs when unauthorised use of a trademark or a substantially similar mark takes place, leading to a likelihood of confusion among consumers and members of the trade as to the origin of the goods/services or leading to the dilution of the original mark's distinctiveness.

Action against infringement of trademark has been made a statutory right under the Trade Marks Act. But the action against passing off of trade marks has only been recognized by the Act. The Act merely lays down the procedure to be followed in such an action. The substantive part constituting the principles and the grounds for such an action still form part of the common law, from which it has been adopted.

This paper aims at analyzing the law relating to infringement of trade marks. It aims at bringing out the various forms of infringement, legal provisions, remedies and defences taken along with along with well-settled case-laws.

KEYWORDS: Intellectual Property - Trademarks - Unauthorised Use - Deceptive Similarity

- Infringement.

INTRODUCTION:

"The ideal trademark is one that is pushed to its utmost limits in terms of abstraction and ambiguity yet is still readable. Trademarks are usually metaphors of one kind or another. And are, in a certain sense, thinking made visible." ~ Saul Bass.

This quote signifies the importance of trademark and its use in the field of industry. Trademark being one of the most important form of intellectual property rights and the key component to business promotion and product identity. This trademark is always relied by the people to choose a product and they are one of the key source of attraction and the spring-board for a company to grow and to make itself distinct from other similar goods and services.

In terms of a common man, a trademark is a mark that can be visually displayed and identified as a person's goods and products against those offered by others. Trademark is a form of intellectual property that can include a term, pattern, symbol, or phrase including a colour etc. A certified or patent trademark is a text, symbol or combination that identifies a business or a commodity and distinguishes it from others in the marketplace.

LEGAL FRAMEWORK OF TRADEMARK INFRINGEMENT:

INFRINGEMENT:

Trademark infringement is the unauthorized use of a mark that is identical or confusingly similar to a registered trademark in a way that misleads consumers about the origin of goods or services. This violation occurs when an entity uses a sign, logo, word, or symbol that resembles an established trademark, leading to confusion, deception, or dilution of the brand identity of the rightful owner. This unauthorized use typically involves the sale of goods or services in a manner that misleads consumers into believing there is an association with the trademark owner.¹

Legal Definition of Trademark Infringement:

According to the **Lanham Act (U.S. Trademark Law, 15 U.S.C. § 1114)**: "Any

¹ <https://www.indiafilings.com/learn/trademark-infringement-in-india/#:~:text=Trademark%20infringement%20occurs%20when%20a,services%20offered%20by%20the%20company.>

*person who, without the consent of the registrant, uses in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services is liable for trademark infringement."*²

Similarly, under **Article 16 of the TRIPS Agreement (Trade-Related Aspects of Intellectual Property Rights)**, trademark owners have the exclusive right to prevent unauthorized third-party use that leads to confusion.³

TYPES OF INFRINGEMENT:

DIRECT INFRINGEMENT

The direct trademark infringement in India, under Section 29 of the Trademarks Act, 1999 (India), happens when someone uses an identical or deceptively similar trademark in respect to goods and services which are also same as that covered by a registered trade mark resulting in confusion. For instance, using "Apple" for other electronics would probably violate Apple Inc's copyright.

Legal Implications: Direct trademark infringement in India is where a person applies the trademark to his goods or services which is similar to the registered trademark without prior permission. Legal remedies include orders to restrain such activities, award of damages for any losses and orders for the disposal of the infringing products. These measures safeguard the rights of the owner of the trademark, guard the buying public from being misled and ensure that all commercial brands used are authentic.

INDIRECT INFRINGEMENT

Section 29(5) of the Trademarks Act, 1999 (India) states indirect trademark infringement in India, it happens when someone facilitates another person to use a trademark identical with or deceptively similar to the registered trademark knowing and having reason to believe that such facilitative act would constitute infringement. For instance, providing Packaging Materials with a Counterfeit Mark.

² [https://www.law.cornell.edu/definitions/uscode.php?width=840&height=800&iframe=true&def_id=15-USC-1068185591856914034&term_occur=999&term_src=#:~:text=\(1\)%20Any%20person%20who%20shall,such%20use%20is%20likely%20to](https://www.law.cornell.edu/definitions/uscode.php?width=840&height=800&iframe=true&def_id=15-USC-1068185591856914034&term_occur=999&term_src=#:~:text=(1)%20Any%20person%20who%20shall,such%20use%20is%20likely%20to)

³ https://www.jpo.go.jp/e/news/kokusai/developing/training/textbook/document/index/TRIPs_Agreement.pdf

Legal Implications: Indirect trademark infringement in India is for parties who promote others to infringe the trade mark, for instance suppliers or distributors. Legal consequences include the stopping of specific activities that help to facilitate the infringement, orders to prohibit continued involvement in infringement. The parties may be punished and ordered to stop offering to the market products that contain the patented invention.

TRADEMARK INFRINGEMENT UNDER TRADEMARKS ACT, 1999:

Section 29 of the **Trade Marks Act, 1999** provides a detailed legal framework for trademark infringement in India. This section outlines **what constitutes infringement, the different scenarios of infringement, and the consequences of such infringement.**

Section 29(1): Basic Definition of Infringement

A **registered trademark** is said to be infringed **if a person, without permission**, uses a mark that is **identical or deceptively similar** to the registered trademark **in the course of trade** and in a way that may cause **confusion or deception among the public.**

Key Elements of Infringement:

- **Use of an identical or similar mark**
- **Without authorization** from the trademark owner
- **In the course of trade or business**
- **Confuses or deceives consumers** about the source of goods/services.

• **Section 29(2): Infringement Due to Similarity & Confusion**

A **trademark is infringed** if a person uses a mark **identical or deceptively similar** to a registered trademark in such a manner that:

- (a) **It causes confusion among consumers; OR**
- (b) **It creates an association** with the registered trademark.

This applies when the infringing mark is used for:

- (i) **The same goods or services;**
- (ii) **Similar goods or services**, where there is a risk of confusion;
- (iii) **Dissimilar goods or services**, but the registered mark is well-known.

Example:

A company sells soft drinks under the brand “**Coca-Cola**”. If another company starts selling “**Koka-Kola**”, it may lead to confusion and is likely to be considered infringement.

- **Section 29(3) & (4): Infringement of Well-Known Trademarks**

Even if the infringing mark is used for **different** goods or services, it is considered infringement **if the registered trademark is well-known** and the use of the infringing mark:

- **Takes unfair advantage** of the well-known trademark’s reputation; or
- **Is detrimental to the distinctive character** or reputation of the registered trademark.

Example:

If someone starts using the brand “**Nike**” for selling cars, it will still be considered infringement because Nike is a **well-known trademark**, and such use might harm its reputation.⁴

- **Section 29(5): Use of Trademark in Business Name (Company Name Infringement)**

A **registered trademark is infringed** if a person uses it as part of their **company name, trading name, or business name** without authorization.

Example:

If someone registers a company called “**Rolex Watches Pvt. Ltd.**” without permission from **Rolex**, it will be an infringement.⁵

- **Section 29(6): Definition of "Use" in Trademark Infringement**

The Act clarifies that a trademark is considered to be “used” in the following cases:

- (a) It appears on goods, packaging, labels, or advertisements.
- (b) It is displayed in business transactions.
- (c) It is used in **advertising or promotions** in a manner that misleads the public.

Example:

If someone advertises “Adibas Shoes” (similar to Adidas) in newspapers or on a website, it will be infringement under this section.

⁴ <https://ijlmh.com/wp-content/uploads/Consumer-Perception-Protection-of-Well-Known-Trademarks.pdf>

⁵ <https://iiprd.wordpress.com/tag/rolex-sa-v-alex-jewellery-pvt-ltd-ors/>

- **Section 29(7) & (8): Infringement by Advertising:**

A **registered trademark is infringed** if someone uses it in advertising in a way that:

- (a) **Takes unfair advantage** of the registered mark;
- (b) **Harms the reputation** of the trademark;
- (c) **Misleads the public** about the product's origin.

Example:

A company falsely advertises "**Our shirts are better than Raymond's premium collection**", using **Raymond's logo** in the advertisement. This could be considered **infringement due to misleading advertising**.⁶

- **Section 29(9): Infringement of Phonetically or Visually Similar Marks:**

Trademark infringement occurs **even if the infringing mark is not visually similar** but sounds similar when spoken.⁷

Example:

If a brand starts selling products under "**KwikStar**", similar to "**QuickStar**", it can still be considered infringement due to phonetic similarity.

- **Section 29(10): Use of Trademark Outside India:**

Even if an infringing mark is **not used in India**, but the goods/services bearing the mark are **imported into India**, it will still be considered **infringement**.

Example:

A foreign company manufacturing **fake "Apple" iPhones** and importing them to India would be infringing Apple's trademark under this section.⁸

⁶ https://consumeraffairs.nic.in/sites/default/files/file-uploads/misleading-advertisements/misleading_advertiesment_and_consumer%20%281%29_0.pdf

⁷ <https://www.mondaq.com/india/trademark/1582544/sound-advice-navigating-phonetic-similarity-in-indian-trademark>

law#:~:text=In%20India%2C%20phonetic%20similarity%20is,as%20by%20their%20visual%20representat ion.

⁸ <https://www.sonisvision.in/blogs/global-trade-and-the-trademark-infringement-dilemma-navigating-the-risks>

- **ESSENTIAL LEGAL ELEMENTS OF TRADEMARK INFRINGEMENT:**

OWNERSHIP OF A VALID TRADEMARK:

The first and foremost requirement is that the **plaintiff must own a valid trademark**, either through **registration under the Trade Marks Act, 1999**, or under **common law rights** by virtue of prolonged and extensive use.

Case Law: Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.⁹

- The Supreme Court of India recognized that **domain names** can also be trademarks if they **acquire distinctiveness** and act as source identifiers.
- The plaintiff, **Satyam Infoway**, owned the registered trademark "**Sify**", which was being used by the defendant. The court ruled in favor of Satyam Infoway.

Case Law: N.R. Dongre v. Whirlpool Corporation¹⁰

The Delhi High Court held that even a **foreign trademark** not registered in India can be protected under the **doctrine of transborder reputation**.

- The court ruled in favor of **Whirlpool Corporation**, preventing the defendant from using the "Whirlpool" mark in India.
- **Unauthorized Use of the Trademark:**

For an infringement claim to succeed, the defendant must have **used the plaintiff's registered trademark (or a deceptively similar mark) without permission**.

Case Law: Raymond Ltd. v. Raymond Pharmaceuticals Pvt. Ltd. (2010)¹¹

- The Bombay High Court restrained **Raymond Pharmaceuticals** from using "Raymond" in the pharmaceutical sector, even though **Raymond Ltd.** was primarily a textile brand.
- The court ruled that the use of the name could create **consumer confusion**.
- **Likelihood of Confusion:**

The **most critical test** in determining infringement is whether the defendant's use of the mark is **likely to cause confusion** among consumers regarding the source, affiliation, or sponsorship

⁹ (2004) 6 SCC 145

¹⁰ 1996 PTC (16) 583 (SC)

¹¹ 2010 (44) PTC 25 (Bom).

of the goods/services.

Case Law: Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd. (2001)¹²

- The **Supreme Court of India** ruled that even **minor phonetic similarities** in medicine trademarks (e.g., "**Falcitab**" vs. "**Falcigo**") could lead to **confusion** and negatively impact public health.
- The court adopted a **strict approach for pharmaceutical trademarks**, recognizing the high risk of confusion.

- **Commercial Use in Trade**

Trademark infringement requires that the unauthorized use of the mark occurs in a **commercial setting** (i.e., trade or business operations).

Case Law: Yahoo! Inc. v. Akash Arora & Anr.¹³

- The **Delhi High Court** restrained **Akash Arora** from using the domain name "**Yahoo India**", as it created a **false commercial impression** that it was affiliated with Yahoo! Inc.
- **Harm to the Trademark Owner (Dilution & Brand Damage)**

Even if there is **no direct confusion**, infringement can occur if the defendant's use of the trademark **dilutes the brand's distinctiveness** or **tarnishes its reputation**.

Case Law: ITC Ltd. v. Philip Morris Products¹⁴ (2010)

- ITC sued **Philip Morris** over the **Marlboro "Don't Be a Maybe" campaign**, arguing that it harmed **Gold Flake's** brand by implying that smokers of other brands were indecisive.
- The court ruled in favor of ITC, recognizing **brand dilution**

- **DEFENCES AGAINST TRADEMARK INFRINGEMENT:**

1. **Honest Concurrent Use (Section 12 of the Trade Marks Act, 1999)**

If two parties **independently and honestly** use identical or similar trademarks for the same goods or services **without intent to deceive**, the court may allow concurrent use.

¹² (2001) 5 SCC 73.

¹³ 1999 II AD (Delhi) 229

¹⁴ 2010 (42) PTC 572 (Del)

2. **Prior Use (Section 34 of the Trade Marks Act, 1999)**

If a party has been **using the mark before the plaintiff's registration**, they may claim a defense under **prior use rights**.

3. **Fair Use (Descriptive Use) (Section 30(2)(a) of the Trade Marks Act, 1999)**

If a trademark is used **in good faith to describe characteristics of goods/services** rather than as a brand, it may qualify as **fair use**.

4. **Parody and Satire (Free Speech Defense)**

A trademark may be used in **parody, criticism, or satire** if it **does not create confusion** or harm the brand's reputation.

5. **Non-Use of the Trademark by the Plaintiff (Lack of Bonafide Use)**

If a registered trademark owner **does not actively use** the mark for **five consecutive years**, the defendant can argue that the mark **should be removed from the register** under **Section 47 of the Trade Marks Act, 1999**.

6. **Lack of Consumer Confusion**

A defendant can argue that their mark is **sufficiently different** from the plaintiff's mark and does not cause **consumer confusion**.

7. **Doctrine of Acquiescence (Plaintiff's Delay in Filing a Lawsuit)**

If the trademark owner **knowingly allows the defendant to use the mark for a long time without objecting**, the defendant can claim that the owner has **acquiesced** to the use.

8. **Use in Accordance with Honest Practices (Section 30 of the Trade Marks Act, 1999)**

If a defendant uses a mark **fairly and honestly**, without intent to deceive, it may not constitute infringement.

9. **Public Interest (Generic and Common Terms)**

Some words become **generic** over time, and no single party can **monopolize them**.

• **REMEDIES AGAINST INFRINGEMENT OF TRADEMARK:**

Remedies serve as a proof for violation of the registered as well as the unregistered trademarks. In India the legal provision that regulate remedies for infringement of trademarks is governed by the provisos of Trademarks Act, 1999. SECTION-29 and SECTION-30 of the Trade mark Act, 1999.¹⁵

¹⁵ <https://www.mondaq.com/india/trademark/1529084/trademark-infringement-in-india-its-mean%C4%B1ng-types-and-remed%C4%B1es>

- **Civil Remedies:** According to the Trade Marks Act, 1999 there are some civil reliefs to be provided to the person whose trademark has been utilized. They are;

1. **Injunction:**

An injunction is defined as restraining one person from performing certain activity or action through the course of law, and regarding the trademark infringement, it imposes limited an individual from using the trademark in a prohibited manner. Through such a stay whether within a temporary or a permanent nature, the court affords protection to the person who holds the trademark.

2. **Damages:**

Compensation is provided with a view to restore the loss that the owner of the trademark incurred due to trademark infringement. The fiscal value of financial loss or brand damage is regained under this remedy. The total of the damages would be recognized by the court when evaluating the actual and probable loss of the owner because of the infringement.

3. **Custody of infringing materials:**

Such remedy means that the Court of Law can compel the violator to display all the kinds of products or goods in relation to the brand name. In such circumstances, the Court may compel the authorities not to release the associated materials account, and destroy all such products. Where the trademark relates towards services, i.e., where a Service Mark has been infringed, the direction might be given to stop the rendering of services immediately by the infringer.

- **Criminal Remedies:**

The Trade Marks Act, 1999 also enumerates few provisions that may be considered as criminal remedy for the infringement of the trademark as follows:

Section 103 of the Act lays down the criminal remedy for the infringement of the trademark of any person or business which provides for a maximum of 6 months imprisonment extendible up to a period of 3 years for violating the rights in trademarks.

Section 104 of the Act also outlines measures that require to be provided as a measure against an infringement. The section provides for a penalty of fifty thousand rupees which may be increased up to an extent of two lakhs of any person if he is found to be violating the trademark

rights.

Also, the punishment of trademark infringement is also stated in SECTION 105 of the same act.

- **Administrative remedies:**

Civil remedy, criminal remedy, and the administrative remedy are the remedies available for the infringement of the trademark.

In relation to a mark which is identical with the original mark or deceptively similar thereto and which is capable of being defended under section-9[1] or 11 pf the Trade Mark Act, 1999. If such a situation comes, then investigations are conducted based on the examiner of trademark registration. A trademark opposition is always filed by a third party; thus, they will oppose the existing trademark in the trademark journals having the completion of the registration process.

Another form of conducting administrative remedy is through endorsement of the trademark offending which is already registered. This in a way eliminates confusion of trademarks.

Since the remedy is administrative the process is performed by monitoring the trade activity of goods embodying an infringed trademark. Consequently, this essay finds that hesitation is averted by restrictions on import as well as export of those goods which bear a trademark that is fraudulent in nature. These three methods of implementing administrative remedy are useful in most cases when preventing trademark imitation.¹⁶

- **WELL SETTLED DECIDED CASE-LAWS:**

CADILA HEALTHCARE LTD. V. CADILA PHARMACEUTICALS LTD. (2001)¹⁷

Facts:

- **Cadila Healthcare Ltd.** (Plaintiff) and **Cadila Pharmaceuticals Ltd.** (Defendant) were **separate companies** that originated from the **same family business**.
- The Plaintiff marketed a **malaria drug under the name "Falcitab"**, while the Defendant launched a **competing malaria drug under the name "Falcigo."**

¹⁶ <https://www.mondaq.com/india/trademark/1529084/trademark-infringement-in-india-its-mean%C4%B1ng-types-and-remed%C4%B1es>

¹⁷ (2001) 5 SCC 73

Plaintiff's Arguments:

1. The names "Falcitab" and "Falcigo" were **phonetically similar**, likely to confuse consumers.
2. Malaria medication is a **life-saving drug**, and **even minor confusion** could endanger lives.
3. Medical practitioners and chemists may **mistakenly prescribe or dispense the wrong drug**.

Defendant's Arguments:

1. The word "**Falci**" was derived from *Falciparum malaria* (a severe form of malaria).
2. Since "Falci" was a **generic prefix**, no single party could claim exclusive rights over it.
3. The product packaging and manufacturer names were **distinct**, so confusion was unlikely.

Issues:

1. Can **phonetic similarity** between two drug names create confusion among consumers?
2. Should **public safety risks** be a factor in trademark infringement cases involving pharmaceutical products?

Holding:

The **Supreme Court of India** ruled in favor of **Cadila Healthcare Ltd.**

It held that:

1. **Likelihood of confusion is more critical in pharmaceutical trademarks** than in general consumer goods.
2. The **degree of caution exercised by consumers** differs:
 - **Ordinary consumers** are more likely to be confused.
 - **Even medical professionals & chemists can misread prescriptions.**
3. **Public interest takes precedence over commercial considerations.**
4. The court laid down the "**Test for Deceptive Similarity**":
 - **Visual, phonetic, and structural similarity** must be assessed.
 - **Consumer perception matters more than side-by-side comparison.**

Impact:

- Strengthened **trademark protection for pharmaceutical products.**
- **Even small variations in drug names can constitute infringement.**

ITC LTD. V. BRITANNIA INDUSTRIES LTD. (2016)¹⁸**Facts:**

- **ITC Ltd.** launched "**Sunfeast Farmlite Digestive-All Good**" biscuits in **2016**.
- ITC's packaging had a **yellow & blue color scheme** with a distinctive layout.
- **Britannia Industries** later introduced "**Nutri Choice Digestive**" biscuits with a **very similar packaging style**.

Plaintiff's Arguments:

1. Britannia's packaging **closely resembled ITC's trade dress**, causing confusion.
2. Consumers might **mistakenly purchase Britannia's product** believing it was associated with ITC.
3. **Trade dress** (color, shape, layout) is as **important as the brand name**.

Defendant's Arguments:

1. The yellow & blue color scheme was **common in digestive biscuits**.
2. There were **differences in logos and brand names**, so consumers wouldn't be misled.

Issues:

1. Does **trade dress similarity** amount to **trademark infringement**?
2. Can a **color combination & packaging design** be **protected under trademark law**?

Holding:

The **Delhi High Court** ruled in favor of **ITC Ltd.**

Key findings:

1. **Trade dress is an essential part of a brand's identity.**
2. **Visual resemblance alone** can cause **consumer confusion**, even if brand names are different.

¹⁸ 2016 SCC Online Del 5100

3. **Britannia's packaging was too similar**, creating an unfair advantage.
4. Britannia was **restrained from using the contested packaging**.

Impact:

- Strengthened **protection for trade dress** in India.
- Established that **color & packaging are equally important as brand names**.

YAHOO INC. V. AKASH ARORA (1999)¹⁹**Facts:**

- **Yahoo Inc.** owned the well-known internet brand "**Yahoo!**".
- The Defendant, **Akash Arora**, registered the domain "**Yahoo India**" and offered similar services.
- Yahoo Inc. filed a lawsuit, claiming **cybersquatting & trademark infringement**.

Plaintiff's Arguments:

1. "Yahoo" was a **well-known global trademark**.
2. The domain "Yahoo India" was **misleading** and could cause confusion.
3. The Defendant was **trying to benefit from Yahoo's goodwill**.

Defendant's Arguments:

1. The word "**Yahoo**" was **generic** and couldn't be monopolized.
2. Their website had a disclaimer stating **no affiliation with Yahoo Inc**

Issues:

1. Does **using a similar domain name** amount to **trademark infringement**?
2. Are disclaimers sufficient to prevent consumer confusion?

Holding:

- The **Delhi High Court** ruled in favor of **Yahoo Inc.**
- **Key findings:**
 1. **Domain names are protected trademarks.**
 2. **Even small variations** (e.g., adding "India") can mislead users.

¹⁹ 78 (1999) DLT 285

3. A **disclaimer does not excuse infringement**, as users may not always notice it.
4. The Defendant was **barred from using "Yahoo India"**.

Impact:

- **Strengthened trademark protection for domain names.**
- **Prevented cybersquatting in India.**

AMRITDHARA PHARMACY V. SATYA DEO GUPTA (1963)²⁰**Facts:**

- **Amritdhara Pharmacy** was the **registered trademark owner** of the medicinal product "**Amritdhara**", used for indigestion and stomach disorders.
- **Satya Deo Gupta** applied to register "**Lakshmandhara**" for a similar medicinal product.
- Amritdhara Pharmacy opposed the application, arguing that "**Amritdhara**" and "**Lakshmandhara**" were **deceptively similar**.

Plaintiff's Arguments:

1. Both names had the common suffix "**Dhara**", leading to **phonetic similarity**.
2. Consumers with imperfect recollection would **confuse** the two products.

Defendant's Arguments:

1. The **prefixes were different** ("Amrit" vs. "Lakshman"), making them **distinguishable**.
2. The words had **distinct meanings**, and consumers could differentiate.

Issues:

1. Whether **phonetic similarity** is enough to cause consumer confusion.
2. Whether **different prefixes (Amrit vs. Lakshman)** prevent infringement.

Holding:

- The **Supreme Court of India** ruled in favor of **Amritdhara Pharmacy**.
- **Key findings:**
 1. **Phonetic similarity is a strong basis for trademark confusion.**

²⁰ AIR 1963 SC 449

2. The common suffix "**Dhara**" made the words sound alike.
3. Consumers often have an **imperfect recollection** of brand names.
4. **Deceptive similarity exists even if the prefixes are different.**

Impact:

- Established the "**phonetic similarity**" principle in trademark law.
- Confirmed that **partial similarity** can still cause consumer confusion.

STARBUCKS CORPORATION V. SARDARBUKSH COFFEE & CO. (2018)²¹

Background

- **Starbucks Corporation** is one of the most **recognized global coffee brands**, with a strong presence in India through a joint venture with Tata (Tata Starbucks).
- Starbucks is known for its **green circular logo with a mermaid (siren) at the center**, which is widely associated with its premium coffee products.
- The company holds **trademark registrations in multiple countries, including India**, protecting its **brand name, logo, and trade dress**.

2. Emergence of Sardarbuksh Coffee & Co.

- **Sardarbuksh Coffee & Co.**, a Delhi-based coffee chain, started operations in **2015** and expanded rapidly.
- The brand used a **green circular logo featuring a Sikh turbaned figure, similar in shape, color, and design** to Starbucks' famous **green mermaid logo**.
- The name "Sardarbuksh" was also **phonetically similar** to "Starbucks," creating confusion among consumers.
- Sardarbuksh started as a **small coffee cart business** but later expanded into **multiple locations** in Delhi.

3. Starbucks' Objection & Legal Action

- Starbucks filed a **trademark infringement lawsuit** against Sardarbuksh in the **Delhi High Court in 2018**, alleging that:
 1. **The name "Sardarbuksh" was deceptively similar to "Starbucks," creating confusion.**

²¹ 2018 SCC Online Del 10528

2. **The circular green logo with a central figure was an imitation** of Starbucks' branding.
 3. The similarity was **deliberate and aimed at exploiting Starbucks' goodwill**.
 4. Even though "Sardarbuksh" had a **Sikh cultural reference**, it still **violated trademark law** as it caused confusion.
- Starbucks sought an **injunction** to stop Sardarbuksh from using the **name and logo** and demanded **rebranding**.

Issues Before the Court

1. Whether "Sardarbuksh" is phonetically and visually similar to "Starbucks."
2. Whether Sardarbuksh's logo closely resembles Starbucks' logo, leading to confusion.
3. Whether the use of a Sikh figure instead of a mermaid makes the logo distinct.
4. Whether Sardarbuksh's use of the name and logo constituted trademark infringement and passing off.

Arguments by Starbucks (Plaintiff):

1. **Phonetic Similarity:** The words "**Sardarbuksh**" and "**Starbucks**" sound alike, leading to a high likelihood of **consumer confusion**.
2. **Visual Similarity in Logo:**
 - Both logos used a **green circular background with a white central figure**.
 - The **Sikh man in Sardarbuksh's logo** resembled the positioning of **Starbucks' mermaid**, maintaining an overall **identical brand aesthetic**.
3. **Intended Imitation:** The defendants **intentionally adopted** a name and logo close to **Starbucks** to mislead consumers and benefit from Starbucks' reputation.
4. **Trademark Dilution:** Even though Starbucks and Sardarbuksh catered to different market segments, allowing Sardarbuksh to continue using the name would **dilute Starbucks' strong global brand identity**.

Arguments by Sardarbuksh (Defendant):

1. **Cultural Relevance:** The name "**Sardarbuksh**" was derived from "**Sardar**" (a common title for Sikh men) and had **no connection to Starbucks**.
2. **No Exact Logo Copying:**
 - Unlike Starbucks' mermaid, Sardarbuksh's logo featured a **Sikh figure wearing a turban**.

- The **text style and fonts were different.**
- 3. **No Monopoly Over Green Circular Logos:** Starbucks **cannot claim exclusivity over all green circular logos** in the coffee industry.
- 4. **Different Target Consumers:** Sardarbuksh was **an Indian brand targeting local consumers**, while Starbucks focused on **premium customers.**

The **Delhi High Court ruled in favor of Starbucks**, granting **partial relief**: **Key Findings:**

1. **Phonetic Similarity:**

- The words "Sardarbuksh" and "Starbucks" **were similar in sound**, and consumers could confuse them.
- The defendant had **altered its name from "Sardarbuksh" to "Sardarji-Bakhsh"** during the case, **which still retained similarity to "Starbucks."**

2. **Visual Confusion in Logo:**

- The court found **strong visual resemblance** between the **green circular logos**, despite differences in the central figures (mermaid vs. Sikh man).
- **Common consumers may not notice subtle distinctions**, leading to **brand confusion.**

3. **Intentional Imitation:**

- The Court noted that Sardarbuksh's branding **clearly tried to capitalize on Starbucks' goodwill.**
- Such unfair advantage amounted to **passing off and trademark dilution.**

4. **Mandatory Rebranding:**

- The **Defendant was ordered to change its name** and logo across **all outlets** to prevent further confusion.
- Sardarbuksh rebranded itself as **"Sardarji-Bakhsh Coffee & Co."** **Final**

Ruling:

- The **Court issued an injunction, prohibiting the use of "Sardarbuksh" and its logo.**
- However, the **rebranded name "Sardarji-Bakhsh" was allowed** since it had sufficient differentiation.

CONCLUSION:

Trademark infringement is a serious violation that **not only affects businesses but also misleads consumers.** Indian courts have consistently upheld **strong protections for**

trademark owners while balancing the principles of fair competition.

From landmark cases like **Amritdhara Pharmacy v. Satya Deo Gupta (1963)** and **Cadila Healthcare v. Cadila Pharmaceuticals (2001)**, Indian courts have established that **deceptive similarity**—whether phonetic, visual, or conceptual—plays a key role in determining infringement. **Starbucks v. Sardarbuksh (2018)** further reinforced that **globally renowned brands deserve stronger protection**, even against unrelated goods, to prevent dilution.

Overall, Indian trademark law, governed by the **Trade Marks Act, 1999**, aims to **prevent consumer confusion, protect brand identity, and promote fair trade practices**. Courts consider factors like **visual & phonetic similarity, reputation, intent of the infringer, and likelihood of confusion** when deciding cases.

As businesses expand globally, **brand protection is more crucial than ever**. Companies must **register their trademarks, actively monitor infringement, and enforce their rights** to safeguard their brand identity in India's competitive market.

