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Deceptive Similarity Of Trademarks

In India

Authored By-F Mohamed Jamirul

Introduction

The term "deceptively similar" means that even if the similarities are not identical or similar, their deceptive nature, which can be perceived either through sound or look, that is visually or phonetically, can lead to the conclusion that the infringer's underlying intention or object is to profit from the prior user's reputation and good will, as the element of confusion involves the customer's state of mind when seeing the mark.¹ Imperfect remembering can lead to such confusion².

Deceptive Similarity Of Trademarks

The question of whether two marks are "deceptively similar" or "similar" or "nearly resembling" or its equivalent arises in connection with trademark registration, i.e., during the process of filing a trademark application, in opposition and rectification proceedings, and in infringement and passing off actions³. The appearance of a trademark is crucial in determining whether or not it has been infringed upon. If you name your company JINX'S (pronounced "jinks"), you'll get in trouble with the well-known band INXS (pronounced "in excess"). Despite the fact that the two names have quite distinct meanings and do not sound comparable when pronounced, they would appear remarkably similar in print and on record covers. INXS is also a unique name, and the brand that owns it is well-known. It's risky to approach odd trademarks that name well-known items or services because "name recognition" of well-known marks is so high that people are likely to confuse comparable marks with the well-known ones. According to section 2(1)(h) of the Act⁴, 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. The language in the definition is identical with what was contained in the repealed 1958 Act, vide section 2(1)(d)⁵. The expression "deceptively similar" or its equivalent is in use in the following provisions of the Act:

- Section 2(1)(i)(v)(b), which defines “false trade description” refers to the expression “identical with or deceptively similar to”.
- Section 11, which contains relative grounds for refusal of a registration, uses the term “identical with or similar to”.
- Section 16(1), which discusses about registration of trademarks as associated trade marks, uses the phrase “is identical with” and “or so nearly resembles it as to be likely to deceive or cause confusion” and Section 16(2) exhibits the phrase “identity or near resemblance of marks”.
- Section 29, which discusses about infringement of trademarks, uses the phrase “identical with or deceptively similar to” and its variant “identity with or similarity to”
- Section 30, which consists of provisions related to limits on the effect of registered trade mark, incorporates the phrase “identical with or nearly resemble”.
- Section 34, which reveals about saving for vested rights, exhibits the expression “identical with or nearly resembling”.
- Section 40, dealing with restriction on assignments, uses the phrase “nearly resembling each other or of identical trademark”.
- Section 47, comprising provision for removal of mark, etc., on grounds of non-use, consolidates the expression “identical or nearly resembling trademark”.
- Section 75, regarding infringement of certification trademarks, incorporates the expression “identical with or deceptively similar”.
- Section 102, dealing with falsifying and falsely applying trademarks, utilizes the expression “deceptively similar mark”.
- Section 134, which speaks about institutions of infringement suits, incorporates the expression “deceptively similar”.

¹ P. Narayanan, *Law of TradeMarks and Passing Off* 312 (Eastern Law House, Kolkata, 6th edn., 2004).

² *Micronix India v. J.R. Kapoor*, (2003) 26 PTC 593 (Del).

³ P. Narayanan, *Intellectual Property Law* 172 (Eastern Law House, Kolkata, 3rd edn., 2009).

⁴ Section 2(1)(h) of The Trade Marks Act, 1999, as available at <https://www.indiacode.nic.in/handle/123456789/1993?locale=en>

It appears that there is no major variation in the meaning of these terms based on the context in which they are employed in the Act. As defined by the notion of "deceptive resemblance," these expressions in various parts transmit and connote the same meaning and effect⁶. The rules established by courts in deciding whether two trademarks are deceptively similar would be equally applicable to determining whether two marks are similar or nearly resemble each other. PayPal v. Paytm is one of the current disputes. On November 18, 2016, PayPal Inc. filed an objection with the Indian Trademark Office accusing Paytm, an Indian mobile wallet company, of trademark infringement. Paytm had been gradually becoming a household name in middle-class India for six years – until November 8, 2016, when Indian Prime Minister Narendra Modi announced the demonetization of Rs. 500 and Rs. 1000 currency notes, thus nullifying 80 percent of the country's cash in circulation. This drastic measure was used to combat massive sums of unaccounted "black" money in the Indian economy, which was being utilized for bribery, corruption, tax evasion, and other illegal activities. The demonetization has resulted in an out-of-the-ordinary growth in electronic transactions, with Paytm being at the forefront. In the first 14 days after demonetization, Paytm's daily transactions increased tenfold, and the amount of money added to Paytm accounts increased tenfold. Paytm's rapid growth in such a short time garnered it not only enormous revenues and valuation, but also the interest of global competitors like as PayPal. PayPal accused Paytm of using the two-tone blue color combination of PayPal's own logo throughout, particularly where "the first word in each mark is in a dark blue color and the second syllable in a light blue color," according to the lawsuit. Furthermore, PayPal pointed out that both marks begin with the term 'PAY,' which customers remember more than the second syllable, despite the marks being of similar length. According to the Indian trademark law, an applicant must publicize and advertise their logo for a period of four months so that third parties might file objections. Paytm filed for a trademark on July 18, 2016, which implies the four-month window for filing a trademark expired on November 18, 2016. PayPal's complaint on the final day has prompted a lot of questions about why a company like PayPal, which has plenty of legal resources, would wait until the very last minute to file a complaint. Needless to say, the expansion of Paytm in a market that had previously been overlooked, underserved, and/or underperforming by PayPal only became a danger after demonetization.

⁵ S. 2(1)(d), Trade and Merchandise Marks Act, 1958: 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.

Nature Of Resemblance

A mark is deceptively similar to another mark if it resembles it so closely that it is likely to deceive or cause confusion, according to Section 2(1)(h) of the Trademark Act, 1999⁷. This suggests that there are varying degrees of likeness. It is not enough to have some form of likeness for misleading similarity; the resemblance must be such that it is likely to confuse or cause misunderstanding. This definition is broad and does not limit the type of similarity that should be investigated. As a result, the court may take into account both the visual and phonetic likeness. It's also crucial to have similar thoughts represented by the marks. Similarity in the net impression generated in the mind, or similarity in the phrases or legends explaining the gadgets, for example, may be taken into account in the case of devices. However, the degree of similarity that is required is a matter that cannot be defined a priori due to the nature of things⁸. Each case must be decided based on its particular set of circumstances. As a result, decided instances are of limited use in determining the question of misleading similarity in a specific case. They are only valuable in the sense that they establish general principles.

Likelihood Of Deception Or Confusion

The aspect of propensity to deceive or confuse in order to hold a trademark deceptively similar to another mark is the focus of the definition of "deceptively similar." Any mark that is so similar to another mark that it may cause confusion in the mind of a common consumer is to be viewed as deceptively similar to the other mark that is either already registered, exists in the market, or for which a prior application was filed⁹. A likelihood of confusion or deception exists when customers are likely to confuse the new name with the older and established trademark due to similarities between them. It's also worth noting the term "likely." It indicates that the only thing that needs to be established is the possibility of confusion. As a result, it is not required to demonstrate that there are no conditions that could cause confusion.¹⁰

⁶ V. Kailasam, *Law of TradeMarks and Geographical Indications* 35 (Wadhwa, Nagpur, 1st edn., 2003).

⁷ Section 2(1)(h) of the Trademark Act, 1999 as available @ https://www.indiacode.nic.in/show-data?actid=AC_CEN_11_60_00004_199947_1517807323972§ionId=16787§ionno=2&orderno=2

⁸ *Amritdhara v. Satya Deo*, AIR 1963 SC 449; Also see *Seixo v. Provezende*, (1866) LR 1 Ch 192.

Deception Or Confusion's Nature

The term "deceptively similar" is defined in such a way that it is not limited to any one sort of deceit or confusion. The following scenarios can lead to deception or confusion:

- Deception or confusion about items: A person may purchase goods after seeing one mark and believing it to be the brand, which is not the case. This is the most typical sort of misunderstanding or deception.
- Deception or ambiguity about trade origin: A person looking at a mark may believe that the items are from the same source as other things carrying a comparable mark that he is familiar with. This is deception or confusion about the source of the trade.
- Deception or confusion about the trade connection: A person looking at the mark may not think it's the same as one with a different brand in mind, but the likeness may lead him to believe the two are connected in some manner. The use of the mark may arouse in the purchaser a suspicion of a connection between the goods and the owner of the registered trademark.

Factors To Take Into Account

It is only proper to evaluate the objective consideration as well as the prior marks' degree of distinctiveness, including their public reputation, when considering deceptive similarity of trademarks. In order to determine whether the marks are deceptively similar, the following aspects must be considered:¹¹

- a) The uses of the commodities or services in question;
- b) The users of the goods or services in question;
- c) The physical characteristics of the items or services;
- d) The channels of distribution via which products or services reach the market;

⁹ V.A. Mohta, *Trade Marks, Passing Off and Franchising* 50 (AIR Pvt. Ltd., Nagpur, 1st edn., 2004).

¹⁰ *Coca-Cola Co. v. Pepsi-Cola Co.* (1942) 59 RPC 127.

¹¹ David Kitchen, David Llewelyn, *et. al.* (eds.), *Kerly's Law of Trade Marks and Trade Names* 241 (Sweet & Maxwell, London, 14th edn., 2005).

e) In the case of self-serve consumer items, where they are found or likely to be found in supermarkets in practise, and in particular where they are found or likely to be found on the same or separate shelves;

f) The amount to which the respective commodities and services compete with one another; this inquiry may take into account how individuals in the trade classify items, for example, whether market research agencies, who, of course, act for industry, group the goods or services into similar sectors.

The question of trademark similarity or the probability of deception or confusion emerging from their use should never be assessed in isolation, but rather in the context of the surrounding circumstances. The following aspects must be taken into account¹²:

- The nature of the marks, such as whether they are words, whether coined or descriptive or non-descriptive, surnames or geographic names, devices, letters or numerals, or a combination of two or more of the above;
- The degree of similarity between the markings and fundamental qualities, such as phonetic, visual, and conceptual similarities²³;
- The type of items for which they are being used or are expected to be used as trademarks;
- The nature, character, and purpose of the rival traders' goods are identical;
- The class of purchasers who are most likely to acquire items bearing the marks, their level of education and intellect, and the degree of caution with which they are likely to buy the goods;
- The manner in which items are purchased or orders are placed;
- Any other circumstances that may exist.

These elements should not be considered separately. The weight that should be given to one component is frequently determined by the relative importance of the other factors.

¹² *Essco v. Mascot*, AIR 1982 Del 308.

¹³ *Durga Dutt Sharma v. N.P. Laboratories*, AIR 1965 SC 930.

Conclusion

The Supreme Court held in *K. R. Chinna Krishna Chettiar v. Sri Ambal & Co.*¹⁴ That ocular comparison is not necessarily the deciding factor. The ear, as well as the sight, must be considered while evaluating the similarity between the two markings. It is not essential that the trade mark be intended to deceive or cause confusion in order to determine if it is deceptively similar to another. It is necessary to examine the potential impact on the average customer. It is vital to use both visual and phonetic testing for this aim. It's also crucial to compare the grades in their entirety. It is not correct to state that just because a portion of a word differs from the comparable portion of the term in the other case, there is no sufficient similarity to induce misunderstanding. The true test is whether the trademark as a whole is likely to produce deceit, misunderstanding, or error in the minds of those who are familiar with the existing mark¹⁵.

¹⁴ AIR 1970 SC 146.

¹⁵ *F. Hoffmann-La Roche & Co. Ltd. v. Geoffrey Manners & Co. Pvt. Ltd.* AIR 1970 SC 206