



Theoretical Underpinnings of IP Laws

Theoretical Underpinnings of Trademark Law: Decisions of the Supreme Court of India

Aqa Raza^{1†} and Ghayur Alam²

¹Jindal Global Law School, O.P. Jindal Global University, Sonapat — 131 001, Haryana, India

²National Law Institute University, Bhopal — 462 044, Madhya Pradesh, India

Received: 31st December 2021; accepted: 3rd June 2022

This Paper identifies and analyses the theoretical underpinnings of trademark law in the light of decisions of the Supreme Court of India (*here in after*, the Court). Outcome of analysis is four-fold. One, only the Utilitarian Theory has been invoked by the Court and that too not explicitly but only by implication to justify trademark law. Two, judicial ratiocination mainly hinges on two grounds that trademark law maximizes happiness by directing unwary customer to the source of goods or services, and minimizes the pain of unwary customer by protecting her from actual or likely deception or confusion as to the source of goods or services. Three, protection of exclusive right of trademark holder in the trademark is merely a means necessary to promote social good in general and interest of unwary customer in particular. Four, judicial invocation of *publici juris* is designed to pre-empt tragedy of commons. At the end, Paper develops an argument that the Court should have applied judicially manageable standards to rigorously scrutinize theoretical underpinnings of trademark law.

Keywords: Utilitarian Theory, *Publici Juris*, The Trade Marks Act, 1999, Theoretical Underpinnings, Supreme Court of India, Ratiocination, Intellectual Property, Common Law, Equity, *Consimili Casu*, Unwary Purchaser, Consumer Welfare, Trademark Monopoly, Trademark Trafficking, Public Policy, Commercial Morality, Trademark Infringement, Passing Off Action

Prince of Denmark in the drama of trademark is ‘unwary customer’. Hence, it may be apposite to provide an insight into the character of Prince of Trademark known variously as ‘*unwary customer*’ or ‘*average man of ordinary intelligence*’. Prince of Trademark being a progeny of ‘*reasonable man*’ is the role model for actual customers. It is trite in common law that ‘*reasonable man*’ – a man without blood and flesh, a mere figment of legal imagination and judicial fiction – is necessary and non-negotiable standard to measure the conduct and behavior of real man. Legal standards are like Polaris and belong to the realm of ‘ought’ in The Laws’ Empire if we may use Dworkin’s well-known phrase. These standards help promote efficient and effective administration of law and justice. Sans legal fiction and legal standards, legal system will be singularly empty of many major premises and it will not be possible to begin legal reasoning and to fashion a legal remedy. Conduct and behavior of real men and women ought to be measured and scrutinized on the touchstone of legal standards to establish abidance or deviance therefrom.

With the recognition of *consimili Casu* by the Statute of Westminster II (1285)¹ and resultant birth of Trespass on Case (or simply ‘Case’) – the most fertile mother of all actions according to F. W. Maitland – gave birth to passing off action, the common law genesis recognizing the legal norm that no one ought to piggyback on the reputation of other’s goods by misrepresentation and causing harm to the other.² Goods acquire reputation after a considerable time only when in the estimation of public goods in question is worthy of reputation. In other words, even the birth of passing off action was to protect the interest of the public from confusion and deception rather than mere protection of reputation of goods.

Birth of registered trademark made it abundantly clear that the protection of trademark is primarily intended to protect the interest of unwary customer from actual or likely confusion or deception irrespective of the fact whether the trademark in question has acquired reputation or not.

In trademark law – for both registered and unregistered trademarks – the fundamental question is whether an unwary customer, not the real customer, is likely to be confused or deceived by two identical

[†]Corresponding author: Email: aqaraza@outlook.com

marks, or substantially similar marks, or identical goods or services having reputation or goodwill, or substantially similar goods or services having reputation or goodwill. The question is not whether an unwary customer or real customer has been confused or has been deceived. It is sufficient that an unwary customer *may be confused* or *may be deceived*. End of trademark law, therefore, is to protect and promote the interest of the customer and consumer. Protection of trademark or goodwill of a trader is merely a means to achieve this legal end. For all theoretical and practical purposes trademark law, therefore, is a species of consumer protection law for every human person is not necessarily a producer or distributor but every human person is definitely a consumer. A law which protects and promotes the interest of everyone is nothing except social welfare law promoting social good which is non-rivalrous in nature.

Story of the theme presented in this Paper began with the publication of ‘*Theoretical Underpinnings of Copyright and Design Laws: Decisions of the Supreme Court of India*’³ (*hereinafter*, the First Paper) in the *Journal of Intellectual Property Rights (JIPR)*. The First Paper, *inter alia*, demonstrated that Indian scholarship on intellectual property (*hereinafter*, IP) including those published in *JIPR*⁴ do not deal with the justification or otherwise of IP in general or any of the types of IP in particular. A sequel to the First Paper ‘*Theoretical Underpinnings of Patent Law: Decisions of the Supreme Court of India*’ was published in *JIPR*.⁵ This is the third paper on the same theme but with a new character ‘Prince of Trademark’.

Decisions of the Supreme Court of India (*hereinafter*, the Court) on IP related matters are very less in comparison to other matters. Amongst the IP matters, maximum number⁶ of decisions is on trademark law. Trademark law, therefore, emerges as the Queen of IP decisions. Decisions under The Trade and Merchandise Act, 1958,⁷ are more than the decisions under The Trade Marks Act, 1999.⁸ In all, there are eighty-six reportable decisions available on trademark law.⁹ Twenty-one decisions are of twentieth century and sixty-five decisions are of twenty-first century.

In this Paper, therefore, an attempt has been to provide an insight into the character of ‘*unwary customer*’ by discovering and evaluating judicial ratiocination of theoretical underpinnings of trademark law in the light of decisions of the Court. It

is hypothesized that the theoretical approach of the Court in this regard is English and seem to be reasonable and sound. The Paper also develops an argument that the Court should have applied judicially manageable standards to rigorously scrutinize theoretical underpinnings of trademark law. For the sake of convenience, the decisions of the Supreme Court relating to theoretical underpinnings of trademark law will be analysed into two parts: twentieth-century decisions; and twenty-first century decisions.

Theoretical Underpinnings of Trademark Law: Twentieth Century Decisions

As noted above, 21 reportable decisions are available from twentieth-century which includes 1 Constitution Bench, 8 Division Bench, and 12 Full Bench. No Single Bench decision is reported. Theoretical underpinning of trademark has been dealt in only 11 decisions – 4 Division Bench and 7 Full Bench.

*National Sewing Thread Co Ltd v James Chadwick*¹⁰ is the first decision of the Supreme Court. Lead opinion was delivered by Justice Mehr Chand Mahajan. While discussing ‘burden of proof’, the Court highlighted the centrality of ‘*an average man of ordinary intelligence*’¹¹ in trademark law discourse echoing utilitarianism that trademark dispute must be approached from the side of the society consisting of men and women of average intelligence rather than from the side of trademark owner or alleged infringer. The Court also declared that the ‘onus of proof’ in an action of passing off shall be on the plaintiff to prove whether there is likelihood of the defendant’s goods being passed-off as the goods of the plaintiff.¹² The Court was emphasizing that the plaintiff who is claiming an exclusive right in a mark must prove that his mark has been infringed by the defendant or the defendant has passed off his goods as that of the plaintiff which is ‘*likely to deceive or cause confusion*’¹³ to the public in general or a person of average intelligence. The element of public clearly echoes utilitarianism. It would have been appropriate, had the Court while discussing burden and onus of proof should have also declared the standard of proof in trademark matters as to whether ‘*preponderance of probabilities*’ is sufficient or the standard should be ‘*clear, cogent and convincing evidence*’.

In *Corn Products Refining Co v Shangrila Food Products Ltd*,¹⁴ the Court emphasized the ‘*point of*

view of a man of average intelligence and of imperfect recollection' to whom overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.¹⁵

In *Amritdhara Pharmacy v Satyadeo Gupta*,¹⁶ the Court observed, 'A trademark is likely to deceive or cause confusion by the resemblance to another...if it is likely to do so in the course of its legitimate use in a market.'¹⁷ 'Deceptive resemblance' was explained in the form of two important questions: '(1) who are the persons whom the resemblance must be likely to deceive or confuse, and (2) what rules of comparison are to be adopted in judging whether such resemblance exists...confusion... is...state of mind of a customer who, on seeing a mark thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection.'¹⁸

In *Kaviraj Pandit Durga Dutt Sharma v Navaratna Pharmaceutical Laboratories*,¹⁹ it was observed that 'The persons who would be deceived are...purchasers of the goods and it is the likelihood of their being deceived that is the subject of consideration. The resemblance may be phonetic, visual or in the basic idea represented by the plaintiff's mark. The purpose of the comparison is for determining whether the essential features of the plaintiff's trademark are to be found in that used by the defendant...It should...be borne in mind that the object of the enquiry in ultimate analysis is whether the mark used by the defendant as a whole is deceptively similar to that of the registered mark of the plaintiff.'²⁰

In *Sumat Prasad Jain v Sheojanam Prasad*,²¹ Court relied on the observation in *re Powell's Trade Mark*²² in which utilitarian functions of trademark were identified as indicator or signal to the purchaser or a possible purchaser: (i) as to the manufacture or quality of the goods,²³ and (ii) his eye of the trade source from which the goods come, or the trade hands through which they pass on their way to the market.²⁴ Trademark is a bright signal to an unwary purchaser as to the manufacture or quality of goods and services. It does not follow from here that trademark guarantees the quality of goods or services rather it only signals the unwary customer as to 'source' of goods and services.

In *American Home Products Corporation v Mac Laboratories Private Limited*,²⁵ the Court emphasized

that the object of trademark law is to "prevent trafficking in trademarks" which is a cardinal sin.²⁶ This emphasis is clearly utilitarian. For explanation of the term 'trafficking in trademarks', the Court cited the following observation of House of Lords:²⁷

*'[A]lthough as a matter of ordinary English, trafficking in trademarks might mean the buying and selling of trademarks, it seems obvious that it is to have a more specialized meaning in a trademark context...[T]rafficking in a trademark context conveys the "notion dealing in a trademark primarily as, commodity in its own right and not primarily for the purpose of identifying or promoting merchandise in which the proprietor of the mark is interested".'*²⁸

The Court without any hesitation accepted the meaning given to the expression trafficking in a trade by Lord Justice Dillon and Lord Brightman²⁸ and held that the intention to use a trademark sought to be registered must be, therefore, genuine and real and as pointed out by Justice J Tomlin in *re Ducker's Trade Mark*.²⁹ The Court further held that to enable the proprietor of a trademark who has got it registered on the ground that he intends to use the trademark to avail himself of the fiction created by Section 48 (2), he must have had in mind at the date of his application for registration some person to whom he intends to allow the use of the trademark as a registered user. This would eliminate all chances of trafficking in a trademark. If an applicant for registration did not have at the date of his application for registration a particular registered user in view, he cannot be said to have had a bona fide intention to use the trademark and in such an event he cannot resist an application made under clause (a) of Section 46 (1) of the 1958 Act.³⁰ The Court was emphasizing that if you get a trademark registered, use it for the purpose for which it trademark is registered and do not start trading trademark as such for it will defeat the utilitarian function of trademark.³⁰

In *Wander Ltd v Antox India*,³¹ the Court highlighted the utilitarian function of the trademark law in the following words:

'Passing off is said to be a species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation which another has established for himself in a particular trade or business. The action is

regarded as an action for deceit. The tort of passing off involves a misrepresentation made by the trader to his prospective customers calculated to injure, as a reasonably foreseeable consequence, the business or goodwill of another which actually or probably, “causes damages to the business or good(will)” of the other trader.³² (Emphasis supplied)

In *Gujarat Bottling Co Ltd v Coca Cola*,³³ the Court identified the utilitarian dimension of trademark as follows:

*[I]t is permissible...to permit a person to use his registered trademark. Such licensing of trademark is governed by common law and is permissible provided (i) the licensing does not result in causing confusion or deception among the public; (ii) it does not destroy the distinctiveness of the trademark, that is to say, the trademark, before the public eye, continues to distinguish the goods connected with others; and (iii) a connection in the course of trade consistent with the definition of trademark continues to exist between the goods and the proprietor of the mark.*³⁴

In *Bengal Waterproof Ltd v Bombay Waterproof Manufacturing Co*,³⁵ the Court reiterated that trademark law ‘creates a mechanism to protect public from deception’³⁶ and further held that in case of continuing tort, a fresh period of limitation begins to run at every moment of the time during which the breach or the tort, as the case may be, continues.³⁷

In *Cycle Corporation of India Ltd v T I Raleigh Industries Pvt Ltd*,³⁸ Court reiterated the anti-trafficking function of trademark³⁹ and as to the ‘burden of proof’⁴⁰ on the parties the Court reiterated its earlier position.

In *N R Dongre v Whirlpool Corporation*,⁴¹ Court relied on *Wander Ltd*³² and observed that

*‘We see no reason why a registered owner of a trademark should be allowed to deceive purchasers into the belief that they are getting the goods of another while they would be buying the goods of the former which they never intended to do.*⁴² The Court further observed that *‘Injunction is a “relief in equity” and is based on equitable principles.*⁴³

In all the decisions analyzed above, the focus of the Court was “unwary customer” and “protection of her interest from likelihood of confusion and deception” as to the source of goods and of services. Though none of the decisions involved ‘services’ and were

concerned with trademark associated with ‘goods’ but the logic of these decisions may be safely extended to services as well for trademark law does not discriminate between ‘goods’ and ‘services.’

No opinion as to the theoretical underpinning of trademark law was expressed by the Court in 10 decisions: *Vishnudas Trading v Vazir Sultan Tobacco Ltd, Hyderabad*,⁴⁴ *Registrar of Trade Marks v Ashok Chandra Rakhit Ltd*,⁴⁵ *Dau Dayal v State of Uttar Pradesh*,⁴⁶ *State of Uttar Pradesh v Hafiz Mohammad Ismail Jawed Ali*,⁴⁷ *Hamdard Dawakhana (Wakf), Delhi v Union of India*,⁴⁸ *National Bell Co v Metal Goods Mfg Co (Pvt) Ltd*,⁴⁹ *State of Uttar Pradesh v Ram Nath*,⁵⁰ *Joint Secretary to the Government of India v Food Specialities Ltd*,⁵¹ *Manmohan Garg v Radha Krishna Narayan Das*⁵² and *Whirlpool Corporation v Registrar of Trade Marks, Mumbai*.⁵³

Theoretical Underpinnings of Trademark Law: Twenty-First Century Decisions

In twenty-first century (till 30 December 2021), 65 reportable decisions of the Supreme Court are available on trademark law which include 1 Single Bench, 58 Division Bench and 6 Full Bench. No Constitution Bench decision has been reported. Theoretical underpinning of trademark has been dealt in 20 decisions – 19 Division Bench and 1 Full Bench. The first decision is *Haldiram Bhujawala v Anand Kumar Deepak Kumar*⁵⁴ but it does not deal with theoretical underpinning, and the latest decision is *Commissioner of GST and Central Excise v Citi Bank*⁵⁵ delivered on 9 December 2021.

In *S M Dyechem Ltd v Cadbury (India) Ltd*,⁵⁶ Justice M Jagannadha Rao delivered the unanimous decision of the Court. The Court highlighted the increased tensions in trademark cases as under:

*‘[T]he tension is between protectionism on the one hand and allowing competition on the other. In the late nineteenth century where law was regarded as a science, the legal formalists laid down principles and legal rules, treating trademark as “property”. In the beginning of this century, legal realists laid emphasis on pragmatic considerations of economic policies and “real world results” and the “likelihood of confusion”.*⁵⁷

As to the legal principles applicable to the cases of infringement, the Court held that

‘Under Section 29...a plaintiff...has to prove not only that his trademark is infringed by a person who is not a registered proprietor of the mark or a

registered user thereof but that the said person is using a mark in the course of his trade, which is identical with or deceptively similar to the trademark of the plaintiff, in such manner as to render the use of the mark “likely to be mistaken as the registered trademark”.⁵⁸

Court further cited *Kerly*⁵⁹ on the point of ‘essential features if copied’ and observed that the principle⁶⁰ is not absolute. For devices and composite marks, Court relied on the judgment of Justice Parker in *Pianotist Co’s Application*⁶¹ as quoted in *Halsbury*:⁶²

*‘The marks, names or get-up concerned must always be considered as the whole thing, as the true test is whether the totality of the impression given both orally and visually is such that it is likely to cause mistake, deception or confusion.’*⁶³

Court observed that ‘English Law relating to differences in essential features which principles...are equally applicable in our country’⁶⁴ and laid down three tests: First, is there any special aspect of the common feature which has been copied.⁶⁵ Second, whether the dissimilarity of the part or parts is enough to mark the whole thing dissimilar.⁶⁵ And third, whether when there are common elements one should not pay more regard to the parts which are not common, while at the same time not disregarding the common parts? What is the first impression?⁶⁵ For the meanings of the words “deceive” and “confuse” used in Section 2(1)(d), Court relied on the decision of Lord Denning in *Parker-Knoll v Knoll International*⁶⁶ that:

*‘[W]hen you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.’*⁶⁷

For explaining the difference between infringement and passing off, Court cited⁶⁸ Lord Halsbury’s decision in *Schwepes Ltd v Gibbens*⁶⁹ and also explained buyer’s ignorance and chances of his being

deceived by relying on Lord Justice Romer’s decision in *Payton & Co v Snelling Lampard & Co*:⁷⁰

‘[I]t is a misconception to refer to the confusion that can be created upon an ignorant customer. The kind of customer that the Courts ought to think of...is “the customer who knows” the distinguishing characteristics of the plaintiff’s goods, those characteristics which distinguish his goods from other goods in the market so far as relates to general characteristics. If he does not know that he is not a customer whose views can properly be regarded by the Court.’ In *Schwepes Ltd v Gibbens*,⁷¹ Lord Halsbury said, if a person is so careless that he does not look and does not treat the label fairly but takes the bottle without sufficient consideration and without reading what is written very plainly indeed up the face of the label, you cannot say he is deceived.⁶⁸

In *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd*,⁷² Justice B N Kirpal delivered the unanimous judgment of the Court. Court held that passing off action depends upon the principle that nobody has a right to represent his goods as the goods of some body. In other words, a man is not to sell his goods or services under the pretence that they are those of another person.⁷³ The five tests laid down by Lord Diplock in *ErwenWarnink*⁷⁴ were relied upon by the Court: (i) a misrepresentation; (ii) made by a trader in the course of trade; (iii) to prospective customers of his or ultimate consumers of goods or services supplied by him; (iv) which is calculated to injure the business or goodwill of another trader – a reasonably foreseeable consequence; and (v) which causes actual damage to a business or goodwill of the trader by whom the action is brought or in a *qui timet* action will probably do so.⁷⁵ As to difference in passing off and infringement, Court relied on the decisions in *National Sewing*,⁷⁶ *Corn Products*,⁷⁷ *Amritdhara*,⁷⁸ and Lord Parker’s observations in *Pianotist Co’s Application*.⁷⁹ The position as to burden of proof as decided in *Navaratna Pharmaceutical*⁸⁰ was reiterated by the Court. In the medicinal products, for comparison of two word marks, Court accepted the text as formulated by Lord Parker in *Pianotist Co’s Application*⁸¹ that ‘If, considering all those circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead

to confusion in the goods then you may refuse the registration, or rather you must refuse the registration in that case.’⁸² The true test is whether the totality of the proposed trademark is such that it is “likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trademark”. The Court further cited Lord Johnston who said ‘We are not bound to scan the words as we would in a question of comparatioliterarum. It is not a matter for microscopic inspection, but to be taken from the general and even casual point of view of a customer walking into a shop.’⁸³ (Emphasis supplied)

The Court also cited the principles as formulated by Lord Parker as referred in *S M Dyechem*⁸⁴ and observed that the observation laid down in *S M Dyechem*⁸⁶ appears contrary to the decision of this Court in *Amritdhara*¹⁶ where it was observed that ‘the products will be purchased by both villagers and town folk, literate as well as illiterate and the question has to be approached from the point of view of a man of average intelligence and imperfect recollection.’ A trade may relate to goods largely sold to illiterate or badly educated persons. The purchaser in India cannot be equated with a purchaser of goods in England...[I]n trademark matters, it is necessary to go into the question of comparable strength.’ The Court held the decision on merits in *S M Dyechem* does not lay down correct law.⁸⁵ Referring to leading American decisions: *American Cynamid Corporation v Connaught Laboratories Inc*,⁸⁶ *Blansett Pharmaceuticals Co v Carmick Laboratories Inc*⁸⁷ and *RJ Strassenburgh Co v Kenwood Laboratories, Inc*,⁸⁸ Court emphasized that

*‘The drugs have a marked difference in the compositions with completely different side effects, the test should be applied strictly as the possibility of harm resulting from any kind of confusion by the consumer can have unpleasant if not disastrous results. The courts need to be particularly vigilant where the defendant’s drug, of which passing off is alleged, is meant for curing the same ailment as the plaintiff’s medicine but the compositions are different. The confusion is more likely in such cases and the incorrect intake of medicine may even result in loss of life or other serious health problems.’*⁸⁹

The Court also observed that in view of the varying infrastructure for supervision of physicians and pharmacists of medical profession in our country due

to linguistic, urban, semi-urban and rural divide across the country and with high degree of possibility of even accidental negligence, strict measures to prevent any confusion arising from similarity of marks among medicines are required to be taken.⁹⁰ The Court reiterated the decision in *Syntex Laboratories Inc v Norwich Pharmacal Co*⁹¹ where it was observed that “Stricter standard in order to prevent likelihood of confusion is desirable where involved trademarks are applied to different prescription pharmaceutical products and where confusion result in physical harm to consuming public.”⁹² For application of English principles in India on medicinal products, Court quoted from *McCarthy*⁹³ and answered in negative. Court further held:

*‘[I]n India...purchaser of...goods...who may have absolutely no knowledge of English language or of the language in which the trademark is written and to whom different words with slight difference in spellings may sound phonetically the same. While dealing with cases relating to passing off, one of the important tests which has to be applied in each case is whether the misrepresentation made by the defendant is of such a nature as is likely to cause an ordinary consumer to confuse one product for another due to similarity of marks and other surrounding factors.’*⁹⁴

The Court laid greater emphasis on the adoption of stricter approach and stringent measures in judging the possibility of confusion of one medicinal product for another by the consumer.

*‘While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself...The confusion as to the identity of the product itself could have dire effects on the public health.’*⁹⁵

Lastly, the Court laid down seven principles to be considered in an action for passing off or infringement in deciding the cases relating to deceptive similarity in medicinal products: (1) the nature of the marks – whether the marks are word marks or label marks or composite marks; (2) the degree of resemblance between the marks, phonetically similar and hence similar in idea; (3) the nature of the goods in respect of which they are used as trademarks; (4) the similarity in the nature, character and performance of the goods of the rival

traders; (5) the class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods; (6) the mode of purchasing the goods or placing orders for the goods; and (7) any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.⁹⁶

In *Laxmikant Patel v Chetanbhai Shah*,⁹⁷ Court held that ‘An action for passing-off will...lie wherever the defendant company’s name, or its intended name, is calculated to deceive, and so to divert business from the plaintiff, or to occasion a confusion between the two businesses.’⁹⁸ Court explained the definition of “trademark” under The Trade Marks Act that ‘[T]rademark is very wide and means, inter alia, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others.’⁹⁸ ... ‘The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that he goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise.’⁹⁹ The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury. *Salmond & Heuston in Law of Torts*¹⁰⁰ call this form of injury as “injurious falsehood”.¹⁰¹

In *Milmet of the Industries v Allergan Inc*,¹⁰² Court cited *Dongre*¹⁰³ and *Cadila*¹⁰⁴ and observed as to the factors to be considered in dealing with deceptive similarity in the field of medicines:

‘Courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The Court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the applicant in India and the user by the overseas company. “The Court must ensure that public interest is in no way imperiled” ...[I]f a mark in respect of a drug is associated with the Respondents worldwide it would lead to an

*anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India...Thus the ultimate test should be who is first in the market.*¹⁰⁵

In *Satyam Infoway Ltd v Sifynet Solutions Pvt Ltd*,¹⁰⁶ as to the nature of domain name and trademarks the Court observed as under:

‘[A] domain name may pertain to provision of services within the meaning of Section 2(z). A domain...serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location.’¹⁰⁷ ... ‘[L]arge number of trademarks containing the same name can comfortably coexist because they are associated with different products, belong to business in different jurisdictions etc., the distinctive nature of the domain name providing global exclusivity is much sought after.’¹⁰⁸

Court explained the elements of trademark in passing off as under:

‘[P]assing off...is an action not only to preserve the reputation of the plaintiff but also to safeguard the public.’¹⁰⁹ ... ‘First (element)...defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant’s goods or services are the plaintiff’s...’¹⁰⁹ [S]econd element...is misrepresentation by the defendant to the public...¹¹⁰ In assessing the likelihood of such confusion the courts must allow for the “imperfect recollection of a person of ordinary memory”.¹¹¹ [T]hird element...is loss or the likelihood of it.¹¹² (Emphasis supplied)...It is apparent therefore that “a domain name may have all the characteristics of a trademark and could found an action for passing off”.¹¹² (Emphasis supplied)

Reiterating that the rulings in *Rediff Communication Ltd v Cyberbooth*,¹¹³ *Yahoo Inc v Akash Arora*,¹¹⁴ *Dr Reddy’s Laboratories Ltd v Manu Kosuri*,¹¹⁵ *Tata Sons Ltd v Manu Kosuri*,¹¹⁶ *Acqua Minerals Ltd v Pramod Borse*,¹¹⁷ and *Info Edge (India) Pvt Ltd v Shailesh Gupta*,¹¹⁸ correctly reflect the law,¹¹⁹ the Court explained the distinction between a trademark and a domain name:

‘[D]istinction lies in the manner in which the two operate...[S]ince the internet allows for access

without any geographical limitation, a domain name is potentially accessible irrespective of the geographical location of the consumers...Confusing similarity in domain names may be a ground for complaint and similarity is to be decided on the possibility of deception amongst potential customers. The defenses available to a complaint are also substantially similar...¹²⁰

The Court further observed that 'a passing off action is based on the goodwill that a trader has in his name unlike an action for infringement of a trademark whereas trader's right is based on property in the name as such.'¹²⁰ 'Another facet of passing off is the likelihood of confusion with possible injury to the public and consequential loss to the appellant. The similarity in the name may lead an "unwary user of the internet of average intelligence and imperfect recollection to assume a business connection between the two"...¹²¹ '[A] deceptively similar domain name may not only lead to a confusion of the source but the receipt of unsought for services.'¹²²

In *Dhariwal Industries Ltd v MSS Food Products*,¹²³ Court observed that '[T]he fact that neither party has a registered trademark as on the date of the suit cannot stand in the way of entertaining the claim of the plaintiff and granting the plaintiff an injunction in case the plaintiff is in a position to show prima facie that it was the prior user of its mark, that it had a prima facie case and that the balance of convenience was in favour of the grant of an interim injunction...Section 39...unregistered trademark may be assigned or transmitted with or without goodwill of the business concerned.'¹²⁴ ...'[P]rima facie establishment of prior user goes a long way in enabling the plaintiff to claim an injunction in a passing off action.'¹²⁵

In *Dhodha House v S K Maingi*,¹²⁶ Court explained when a cause of action arises in case of trademark infringement and observed that 'A cause of action will arise only when a registered trademark is used and not when an application is filed for registration of the trademark.'¹²⁷

In *Ramdev Food Products Pvt Ltd v Arvindbhai Rambhai Patel*,¹²⁸ Justice S B Sinha who penned down the unanimous judgment of the Court, traced the history of trademark from the ancient times – Harappan Civilization.¹²⁹ The Court quoted from *Christopher Morcom*¹³⁰ that 'The concept of distinguishing goods or services of the proprietor

from those of others was to be found in the requirements for a mark to be registrable.'¹³¹ Court further referred to its earlier decisions in *Gujarat Bottling*¹³² and *Laxmikant*¹³³ observed that 'A trademark is the property of the manufacturer. The purpose of a trademark is to establish a connection between the goods and the source thereof which would suggest the quality of goods. If the trademark is registered, indisputably the user thereof by a person who is not otherwise authorized to do so would constitute infringement...It is...well settled that a person cannot use a mark which would be deceptively similar to that of the registered trademark. "Registration of trademarks is envisaged to remove any confusion in the minds of the consumers." If, thus, goods are sold which are produced from two sources, the same may lead to confusion in the mind of the consumers. In a given situation, it may also amount to fraud on the public.'¹³⁴

As to the different functions of trademark, Court cited *Sumat Prasad Jain*,¹³⁵ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,¹³⁶ *Baker Hughes Limited v Hiroo Khushalani*¹³⁷ and *Milmet Oftho Industries*¹³⁸ and observed that 'Traditionally, a trademark has always been considered a vital and inseparable part of the goodwill of the business. In fact, the sale of a trademark without the sale of the goodwill to the same buyer is considered null and void.'¹³⁹ (Emphasis supplied)...'Even under the common law, licence has to be interpreted to subsume the law and prevent the mischief which is deceptive having regard to the fact that trafficking in trademark is not permitted.'¹⁴⁰ Court further observed that the 'non-obstante nature of a provision although may be of wide amplitude, the interpretative process thereof must be kept confined to the legislative policy'¹⁴¹ and laid down the test that '[T]est would be...deceptively similar test...'¹⁴²

Explaining the doctrine of passing off, Court observed that it is a '[C]ommon law remedy whereby a person is prevented from trying to wrongfully utilize the reputation and goodwill of another by trying to deceive the public through 'passing off' his goods.'¹⁴² Quoting *Kerly*, Court noted the three elements of passing off: First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up'.¹⁴² Second, he must demonstrate a misrepresentation by the defendant to the public leading or likely to lead the

public to belief that the goods or services offered by him are the goods or services of the plaintiff.¹⁴³ Third, he must demonstrate that he suffers or, in a quick time action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or service is the same as the source of those offered by the plaintiff.¹⁴⁴ 'The test...is as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.'¹⁴⁵

The Court further stated that '*After all, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Homes.*'¹⁴⁶ Referring to *Navaratna Pharmaceutical*,¹⁴⁷ *Power Control Appliances v Sumeet Machines Pvt Ltd*¹⁴⁸ and judgment of Justice Lahoti in *Midas Hygiene Industries (Pvt) Ltd v Sudhir Bhatia*,¹⁴⁹ Court observed that: '*[I]n an infringement of trademark, delay by itself cannot be a ground for refusing to issue injunction...normally an injunction must follow...*'¹⁵⁰

In *Gomzi Active v Reebok India Co*,¹⁵¹ Court reiterating to its decisions in *S M Dyechem*¹⁵² and *Navaratna Pharmaceutical*,¹⁵³ and referred to *Halsbury's Laws* and *Kerly* as to the maintainability of a passing off and infringement suit.¹⁵⁴

In *Heinz Italia v Dabur India Ltd*,¹⁵⁵ Court referring to *Corn Products*¹⁴ and *Cadila*⁷² observed that '*[P]rinciple of phonetic "similarity" cannot be ignored and the test is as to whether a particular mark has obtained acceptability in the market so as to confuse a buyer as to the nature of product he was purchasing.*'¹⁵⁶

In *Meghraj Biscuits Industries Ltd v Commissioner of Central Excise, UP*,¹⁵⁷ to one of the questions of law that whether the grant of registration certificate under The Trade Marks Act will automatically provide benefit of exemption to the SSI Unit, the Court referred the judgment of the *Pahwa Chemicals Pvt Ltd v Commissioner of Central Excise, Delhi*¹⁵⁸ and observed as under:

*'[T]he object of the exemption Notification was neither to protect the owners of the trademark nor the consumers from being misled. These are considerations which are relevant in disputes arising out of infringement/passing off actions under the Trade Marks Act...object of the Notification is to grant benefits only to those industries which otherwise do not have the advantage of a brand name.'*¹⁵⁹*[A]bandonment*

of the trademark has to be proved by the appellants.'¹⁶⁰

The Court observed as to the nature of the Trade Marks Act that 'The Trade Marks Act, 1999 has been enacted...to provide for...better protection of trademarks and "for prevention of the use of fraudulent marks".'¹⁶¹ '[I]t is clear that the effect of making the registration certificate applicable from retrospective date is "based on the principle of deemed equivalence to public user of such mark". This deeming fiction cannot be extended to the Excise Law. It is confined to the provisions of the Trade Marks Act.'¹⁶² Court also quoted the decision of Bombay High Court in *Consolidated Foods Corporation v Brandon and Co Pvt Ltd*¹⁶³ as to the Court of Equity, Court of Chancery in relation to trademarks.¹⁶⁴

'[T]he Courts of Equity in England granted relief in cases of infringement of trademarks on the basis of infringement of the right of property in the trademark. There was no other basis...All that was necessary for the plaintiff to prove was that he had used that mark in respect of his particular type of goods. That was enough in the eyes of the Courts of Equity to entitle him to a relief by way of an injunction in case of an infringement of his mark by some other trader....[T]he statute which came to be enacted in England in 1875 and the subsequent statutes did nothing more than to embody the rights in relation to trademarks which were already laid down by the Courts of Equity. As a matter of fact, the statute enabled a person to have registered a mark not only which he had been using but also a mark which he proposed to use. The latter type of mark would evidently refer to a distinctive mark, a mark which does not directly describe the nature or quality of the goods to which it is attached. In cases of such marks, whereas the Courts of Equity did require some slight user before the proprietor thereof could institute an action for infringement thereof, the statute enabled the registration of such mark without any user at all, because such mark being distinctive per se it was not necessary for the person applying for its registration to show that mark had acquired a reputation in the market, so that it could be associated only with his goods and of nobody else. Even so far as this country is concerned, the Trade Marks Act of 1940 does not seem to have made any change in the legal rights

*of the owner of a trademark as established by the Courts of Chancery in England.*¹⁶⁵

Court cited the observation of Justice Chagla in *re Century Spinning and Manufacturing Co Ltd.*¹⁶⁶

*'[I]t is clear that even prior to the passing of this Act (The Trade Marks Act of 1940) the owner of a trademark could maintain an action for the infringement of a trademark and that action could only be maintained on the assumption that he was the owner of the trademark and he had a proprietary right in the trademark...'*¹⁶⁷

Court further held that '[T]rademark...property for the purpose of Section 54 of the Specific Relief Act, 1963¹⁶⁸ as any other kind of property'¹⁶⁹ and observed as to the common law right in trademark that 'Trade Marks Act provides a procedure whereby by registering his trademark the owner gets certain facilities in the mode of proving his title...under Section 23...registration is to be prima facie evidence of the validity of the trademark.'¹⁶⁹ 'Registration under the statute does not confer any new right to the mark claimed or any greater right than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout the State and it established the record of facts affecting the right to the mark...The trademark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected. Priority in adoption and use of a trademark is superior to priority in registration.'¹⁷⁰

Court held that by applying the principle of deemed equivalence if the SSI unit wrongly affixes a trademark of another person, be it registered or not, or if it uses the trademark of an ineligible person then such default would not be eliminated by the principle of deemed equivalence embodied in Section 28 of the Trade Marks Act as that "principle is based on a deeming fiction" which fiction is confined only to the provisions of The Trade Marks Act.¹⁷¹

In *K Narayanan v S Murali*,¹⁷² Court observed that '[T]here is no right in the person to assert that the mark has been infringed and that a proposed registration which may, or may not be granted will not confer a cause of action to the plaintiff, whether the application for registration is filed by the plaintiff, or the defendant.'¹⁷³ ...'[M]ere filing of...application cannot be regarded as a cause of action...since filing

*of an application for registration...does not indicate any deception on the part of the respondent to injure business or goodwill of the appellants.*¹⁷³

In *Kabushiki Kaisha Toshiba v TOSIBA Appliances Co.*,¹⁷⁴ the judgment on behalf of the Court was delivered by Justice S B Sinha. As to the theoretical underpinnings the Court observed as under:

*'The intention to use a trademark sought to be registered must be genuine and real. When a trademark is registered, it confers a valuable right. It seeks to prevent trafficking in trademarks. It seeks to distinguish the goods made by one person from those made by another. The person, therefore, who does not have any bonafide intention to use the trademark, is not expected to get his product registered so as to prevent any other person from using the same. In that way trafficking in trademark is sought to be restricted.'*¹⁷⁵

In *Thukral Mechanical Works v P M Diesels Pvt Ltd.*,¹⁷⁶ Court observed that there cannot be any doubt or dispute that the registration of a trademark confers a very valuable right. The person in whose name the trademark has been registered may take action against any person for passing off the goods as that of the registered owner. It confers an exclusive right of use of the trademark in relation to the goods in which the trademark is registered. The same is an assignable right in terms of Section 36 of the Act, whereas an unregistered trademark is not.¹⁷⁷ [T]rafficking in trademark is to be discouraged. A registered proprietor of a trademark should not be permitted to circumvent the law of user of the trademark for a long time by assigning the same from time to time. But then such a case has to be made out. Allegation of trafficking is a serious one. It must be proved in presence of the person against whom such allegations are made.¹⁷⁷ Court further observed that 'It must not...be forgotten that Section 46(1)(b) provides for a special remedy. As a person obtains a right on and from the date of registration and/or renewal thereof, he can ordinarily be deprived of his right unless it is shown that the assignment thereof by his holder was not a bona fide one or had been made by way of camouflage...[T]he mistake of the predecessor should not be visited with non-use of the present registered owner.'¹⁷⁷ As to the expiry of right in a registered trademark, the Court observed:

'The right of a registered trademark is not lost automatically...does not provide for a 'sun set'

law...The principle of purchaser of a property has a duty to make enquiries, therefore, cannot apply in a case of this nature. So long as the right to assign a registered trademark remains valid, once the same is validly assigned, the assignee derives the same right as that of the assignor in terms of the statute. A title to a trademark derived on assignment as provided for under the Act cannot be equated with a defective title acquired in any other property as admittedly on the date of assignment, the right of the registered trademark was not extinguished.¹⁷⁸ ... 'An assigner can transfer only such right which he possesses.'¹⁷⁹

In *T V Venugopal v Ushodaya Enterprises Ltd*,¹⁸⁰ quoting *McCarthy*¹⁸¹ the Court observed that in order to obtain some form of relief on a passing off claim, the user of a generic term must prove some false or confusing usage by the newcomer above and beyond mere use of generic name.¹⁸² The utilitarian justification of trademark law is evident from the observation that law is consistent that "no one can be permitted to encroach upon the reputation and goodwill of other parties".¹⁸³

In *Neon Laboratories Ltd v Medical Technologies Ltd*,¹⁸⁴ Court explained the exclusivity in the pharmaceutical industry as under:

*'[T]o claim exclusivity of user, the trademark should normally partake of a new creation, or if an existing word, it should not bear descriptive characteristics so far as the product is concerned, nor should it be of an extolment or laudation...[W]e must accept the reality that in the pharmaceutical industry it is commonplace that trademarks reproduce and resonate the constituent composition. While this aspect and feature may be a good ground for declining registration of the trademark, it may nevertheless remain a favorable determinant in a passing off action.'*¹⁸⁵

The Court further observed that *'[A]s world shrinks almost to global village, the relevance of the transnational nature of a trademark will progressively diminish into insignificance...the attainment of valuable goodwill will have ever increasing importance.'*¹⁸⁶

In *S Syed Mohideen v P Sulochana Bai*,¹⁸⁷ Court explained the trinity and the principle of the law of passing off in the light of utilitarian justification:

'Traditionally, passing off in common law is considered to be a right for protection of goodwill

*in the business against misrepresentation caused in the course of trade and for prevention of resultant damage on account of the said misrepresentation. The three ingredients of passing off are goodwill, misrepresentation and damage. These ingredients are considered to be classical trinity under the law of passing off as per...Lord Oliver...in...Reckitt & Colman Products Ltd v Borden Inc.*¹⁸⁸ ...*[P]assing off action is essentially an action in deceit where the common law rule is that no person is entitled to carry on his or her business on pretext that the said business is of that of another.*¹⁸⁹ ...*'[I]t is...recognized principle in common law jurisdiction that passing off right is broader remedy than...infringement. This is due to the reason that the passing off doctrine operates on the general principle that no person is entitled to represent his or her business as business of other person.'*¹⁹⁰*'It is also well settled principle of law in the field of the trademarks that the registration merely recognizes the rights which are already pre-existing in common law and does not create any rights.'*¹⁹¹

In *Toyota Jidosha Kabushiki Kaisha v Prius Auto Industries Ltd*,¹⁹² referring to its earlier decisions in *S Syed Mohideen*,¹⁸⁷ *Reckitt & Colman Ltd*,¹⁹³ *Dongre*⁴¹ and *Milmet*,¹⁰² the Court observed that "To give effect to the territoriality principle, the courts must necessarily have to determine if there has been a spillover of the reputation and goodwill of the mark used by the claimant who has brought the passing off action."¹⁹⁴ The Court further observed that "commercial and business morality" which is the foundation of the law of passing off should not be allowed to be defeated by imposing such a requirement. In such a situation, likelihood of confusion would be a surer and better test of proving an action of passing off by the Defendants...In the last resort it is 'preponderance of probabilities'.¹⁹⁵

In *Nandhini Deluxe v Karnataka Cooperative Milk Producers Federation Ltd*,¹⁹⁶ the Court applied the test as laid down in *National Sewing*¹¹ and observed that the visual appearance of the two marks is different and they even relate to different products.¹⁹⁷ Referring to its decision in *Vishnudas Trading*⁴⁴ Court observed that *'[P]rinciple of law while interpreting the provisions of Trade and Merchandise Act, 1958'*¹⁹⁸ *is equally applicable as it is unaffected by the Trade Marks Act inasmuch as the main object underlying the...[P]rinciple is that the proprietor of a trademark cannot enjoy monopoly over the entire class of goods*

and, particularly, when he is not using the said trademark in respect of certain goods falling under the same class.¹⁹⁹

In *Wockhardt Ltd v Torrent Pharmaceuticals Ltd*,²⁰⁰ Court highlighted the nature of passing off that '[P]assing off is, in essence, an action based on deceit, fraud is not a necessary element of a right of action, and that the defendant's state of mind is wholly irrelevant to the existence of a cause of action for passing off, if otherwise the defendant has imitated or adopted the plaintiff's mark.'²⁰¹

The Court did not express any opinion as to the theoretical underpinnings of trademark law in 45 decisions.²⁰²

The Court in twenty-first century decisions has explicitly used the expression 'services' in its decisions to highlight the focus of trademark law and it seems that the Court has applied the same theoretical justification as seen in the twentieth-century decisions.

Conclusion

The analysis of eighty-six decisions of the Supreme Court on trademark law from the twentieth and twenty-first century clearly reveals that the theoretical underpinnings of trademark law is Utilitarian. Trademarks are not protected merely because someone through his efforts or labour creates a new, fancy, or beautiful trademark; rather the *raison d'être* is protection of interest of unwary purchaser to identify the source of goods or services without being misled by confusion or deception. The "two ends" of trademark law as recognized by the Supreme Court may be summarized as: (i) "protection of unwary customer", i.e., person of average intelligence and imperfect recollection, from deception or/and confusion as to source of origin of goods or services; and (ii) "protection of the right of the trademark owner". In other words, it can be said that the primary justification of the trademark law is only a means of achieving the primary purpose of trademark law. The Utilitarian justification of trademark justifies the monopoly in the form of trademark and this monopoly is not only tolerated but is also encouraged for it maximizes the happiness of the unwary customer and minimizes his pains.

In its decisions, the Supreme Court has stressed that trademark law is a law relating to welfare of the consumers. While deploying the Utilitarian approach in the cases relating to trademark and domain names in relation to trademark, the approach of the Court

seems to be uniform. The Court extended its reasoning to provide the same protection to the domain names through the remedy of passing off in order to protect the unwary customers from deception.¹²⁰ Approach of the Supreme Court in invoking Utilitarianism and *publici juris*³ in the trademark decisions seem to be reasonable and sound. But when the Court was engaged in utilitarian discourse, it was expected that the Court should have applied manageable judicial standards to rigorously scrutinize the theoretical underpinnings of trademark law from all possible angles. It was also expected that the Court should have referred to the name of Utilitarian framework and the names of their proponents. Notable thing in the decisions of the Supreme Court is that in none of the decisions the constitutional validity of The Trade Marks Act was challenged. In the decisions dealing with the theoretical underpinning of trademark law, the Court was unanimous and no dissenting or concurring opinion was delivered in any decision.

References

- 1 (1285) 13 Edw. 1.
- 2 Chaytor A H and Whittaker W J (eds), Maitland F W, *The Forms of Actions at Common Law* (Cambridge University Press, Cambridge), 1936. (Book was first published with *Equity* in 1909).
- 3 Raza A, Theoretical Underpinnings of Copyright and Design Laws: Decisions of the Supreme Court of India, *Journal of Intellectual Property Rights*, 26(4) (2021) 220–234.
- 4 Online repository of the *Journal of Intellectual Property Rights (JIPR)*, <http://nopr.niscair.res.in/handle/123456789/45> (accessed on 14 December 2021). A review of papers published in *JIPR* from Volume 1(1) [January 1996] to Volume 26(4) [July 2021] reveals that no paper focusing on the theoretical underpinnings of trademark law has been published.
- 5 Raza A, Theoretical Underpinnings of Patent Law: Decisions of the Supreme Court of India, *Journal of Intellectual Property Rights*, 27(4) (2022) 285–289.
- 6 As on 30 December 2021, Supreme Court has delivered 86 decisions on the trademark law out of which only 31 decisions invoke the theoretical underpinning. 14 decisions are on The Copyright Act, 1957 (Act 14 of 1957) of which 6 deals with the theoretical underpinnings; 12 decisions are on The Patents Act, 1970 (Act 39 of 1970) of which only 2 decisions invoke the theoretical underpinning; and 2 decisions are on The Designs Act, 2000 (Act 16 of 2000) of which only 1 decision deals with the theoretical underpinnings. There is no direct decision of the Supreme Court on the remaining 3 IP statutes, namely: The Geographical Indications of Goods (Registration and Protection) Act, 1999 (Act 48 of 1999); The Protection of Plant Varieties and Farmers' Rights Act, 2001 (Act 53 of 2001); and The Semiconductor Integrated Circuits Layout-Design Act, 2000 (Act 37 of 2000).
- 7 Act 43 of 1958.

- 8 Act 47 of 1999.
- 9 The decisions on trademark law have been taken from the *Judgment Information System of the Supreme Court* (JUDIS), <https://main.sci.gov.in/judgments> (accessed 30 December 2021). For the purposes of citations: Supreme Court Reports (SCR), TruePrint copies from Supreme Court Cases (SCC), SCC OnLine, Patent and Trade Marks Cases (PTC), Supreme Court Almanac (SCALE) and All India Reporter (AIR) have been referred and relied upon.
- 10 [1953] 4 SCR 1028, Full Bench decision.
- 11 [1953] 4 SCR 1028, 1046–1047.
- 12 [1953] 4 SCR 1028, 1048.
- 13 [1953] 4 SCR 1028, 1047.
- 14 [1960] 1 SCR 968. Full Bench decision. Justice A K Sarkar delivered the judgment.
- 15 [1960] 1 SCR 968, 979.
- 16 [1963] 2 SCR 484. Full Bench. Justice S K Das delivered the judgment.
- 17 [1963] 2 SCR 484, 493.
- 18 [1963] 2 SCR 484, 494.
- 19 [1965] 1 SCR 737. Full Bench decision. Justice N RajagopalaAyyangar delivered the judgment.
- 20 [1965] 1 SCR 737, 755–756.
- 21 (1973) 1 SCC 56. Full Bench decision. Justice J M Shelat delivered the judgment.
- 22 (1893) 10 R. P. C. 200.
- 23 (1973) 1 SCC 56, 59.
- 24 (1973) 1 SCC 56, 59.
- 25 (1986) 1 SCC 465. Division Bench decision. Justice D P Madan delivered the judgment.
- 26 (1986) 1 SCC 465, 493.
- 27 (1984) 1 All ER 426, 433.
- 28 (1986) 1 SCC 465, 494.
- 29 (1928) Ch L 405, 409.
- 30 (1986) 1 SCC 465, 510.
- 31 1990 Supp. SCC 727. Full Bench decision. Court was unanimous.
- 32 1990 Supp. SCC 727, 734.
- 33 (1995) 5 SCC 545. Division Bench decision. Justice S C Agarwal delivered the judgment.
- 34 (1995) 5 SCC 545, 557. Court quoted from Narayanan P, *Law of Trade Marks and Passing Off* (4th edn, Eastern Law House, Kolkata), 2016, p. 335.
- 35 [1996] Supp. 8 SCR 695. Division Bench decision. Justice S B Majumdar delivered the judgment.
- 36 [1996] Supp. 8 SCR 695, 708.
- 37 [1996] Supp. 8 SCR 695, 708–709.
- 38 [1996] Supp. 2 SCR 820. Full Bench decision. Justice Ramaswamy delivered the judgment of the Court.
- 39 [1996] Supp. 2 SCR 820, 831.
- 40 [1996] Supp. 2 SCR 820, 832.
- 41 [1996] Supp. 5 SCR 369. Division Bench decision. Justice J S Verma delivered the judgment.
- 42 [1996] Supp. 5 SCR 369, 381.
- 43 [1996] Supp. 5 SCR 369, 386.
- 44 [1996] Supp. 3 SCR 329. Division Bench decision. Justice G N Ray delivered the judgment.
- 45 [1955] 2 SCR 252. Full bench decision. Justice Sudhi Ranjan Das penned down the judgment.
- 46 AIR 1959 SC 433. Full Bench decision. Justice T L VenkataramaAiyar penned down the judgment.
- 47 [1960] 2 SCR 911. Full Bench decision. Justice K N Wanchoo penned down the judgment.
- 48 [1965] 2 SCR 192. Constitution Bench. Chief Justice P B Gajendragadkar (as then he was) delivered the judgment.
- 49 [1971] 1 SCR 70. Division Bench decision. Justice J M Shelat delivered the judgment.
- 50 [1972] 2 SCR 572. Division Bench decision. Justice P Jagmohan Reddy delivered the judgment.
- 51 [1985] Supp. 3 SCR 165. Full bench decision. Justice R S Pathak delivered the judgment.
- 52 [1998] 1 SCR 1027. Full Bench decision. The Court was unanimous.
- 53 [1998] Supp. 2 SCR 359. Division Bench decision. Justice S Saghir Ahmad delivered the judgment.
- 54 [2000] 1 SCR 1247. Division Bench. Justice M Jagannadha Rao delivered the unanimous judgment.
- 55 2021 SCC OnLine SC 1212. Division Bench decision. Justice K M Joseph delivered the judgment of the Court.
- 56 [2000] Supp. 1 SCR 86. Division Bench decision.
- 57 [2000] Supp. 1 SCR 86, 98.
- 58 [2000] Supp. 1 SCR 86, 108.
- 59 Kerly D M, *Law of Trade Marks and Trade Names* (11th edn, Sweet and Maxwell, London), 1983, Para 14.21.
- 60 ‘The identification of an essential feature depends partly on the courts’ own judgment and partly on the burden of the evidence that is placed before it. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the sound of words forming part or the whole of the mark.’ [2000] Supp. 1 SCR 86, 108–109.
- 61 (1906) 23 RPC 774.
- 62 Halsbury’s *Law of England*, Volume 38 (3rd edn, LexisNexis Butterworths, United Kingdom), 1964, Para 987.
- 63 [2000] Supp. 1 SCR 86, 111.
- 64 [2000] Supp. 1 SCR 86, 112–113.
- 65 [2000] Supp. 1 SCR 86, 114.
- 66 (1962) RPC 265 (HL).
- 67 [2000] Supp. 1 SCR 86, 116.
- 68 [2000] Supp. 1 SCR 86, 117. Court cited *Navaratna Pharmaceutical Laboratories Ltd* [1965] 1 SCR 737; *Ruston & Hornsby Ltd v The Zamindara Engineering Co* AIR 1970 SC 1649 and *Wander Ltd v Antox India* 1990 Supp. SCC 727.
- 69 (1905) 22 RPC 601(HL).
- 70 (1900) 17 RPC 48.
- 71 *Schwepes Ltd v Gibbens* (1905) 22 RPC 601(HL).
- 72 [2001] 2 SCR 743. Full Bench decision.
- 73 [2001] 2 SCR 743, 749.
- 74 *ErwenWarnink BV v J Townend & Sons* 1979(2) AER 927.
- 75 [2001] 2 SCR 743, 749.
- 76 [1953] 4 SCR 1028, 1046–1047. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 750.
- 77 [1960] 1 SCR 968, 978. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 751.
- 78 [1963] 2 SCR 484, 493. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 752.

- 79 (1906) 23 RPC 774. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 752.
- 80 [1965] 1 SCR 737, 755–56. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 756.
- 81 (1906) 23 RPC 774, 777.
- 82 [2001] 2 SCR 743, 756–757.
- 83 [2001] 2 SCR 743, 758.
- 84 [2000] Supp. 1 SCR 86, 117. Referred in *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 760–761.
- 85 [2001] 2 SCR 743, 761.
- 86 231 USPQ 128 (2nd Cir. 1986).
- 87 25 USPQ 2nd, 1473 (TTAB 1993).
- 88 106 USPQ 379.
- 89 [2001] 2 SCR 743, 762–763.
- 90 [2001] 2 SCR 743, 763.
- 91 169 USPQ 1 (2nd Cr. 1971).
- 92 [2001] 2 SCR 743, 765.
- 93 McCarthy J T, *McCarthy on Trade Marks and Unfair Competition* (3rd edn, Clark Boardman Callaghan, New York), Para 23.12.
- 94 [2001] 2 SCR 743, 766–767.
- 95 [2001] 2 SCR 743, 767.
- 96 [2001] 2 SCR 743, 767–768.
- 97 (2002) 3 SCC 65. Division Bench decision. Justice R C Lahoti delivered the judgment of the Court.
- 98 (2002) 3 SCC 65, 71.
- 99 (2002) 3 SCC 65, 72.
- 100 Buckley R A, *Salmond and Heuston on the Law of Torts* (20th edn, Sweet & Maxwell, London), 1992, 395.
- 101 (2002) 3 SCC 65, 72.
- 102 2004 (28) PTC 585 (SC). Division Bench decision. Justice S N Variava delivered the judgment of the Court.
- 103 [1996] Supp. 5 SCR 369, 386. Cited in 2004 (28) PTC 585 (SC), 587.
- 104 *Cadila Health Care Ltd v Cadila Pharmaceuticals Ltd* [2001] 2 SCR 743, 768.
- 105 2004 (28) PTC 585 (SC), 588.
- 106 2004 (28) PTC 566 (SC). Division Bench decision. Justice Ruma Pal delivered the judgment of the Court.
- 107 2004 (28) PTC 566 (SC), 569–570.
- 108 2004 (28) PTC 566 (SC), 570. Court cited Rowland D and Macdonald E, *Information Technology Law* (2nd edn, Cavendish Publishing, London), 2000, p. 251.
- 109 2004 (28) PTC 566 (SC), 570.
- 110 The Court considered the case of *Cadbury Scahweppes v Pub Squash* 1981 RPS 429 and *Erven Warnink v Townend* 1980 RPC 31.
- 111 2004 (28) PTC 566 (SC), 570–571. Court cited *Aristoc v Rysta* 1945 AC 68.
- 112 2004 (28) PTC 566 (SC), 571.
- 113 AIR 2000 Bombay 27.
- 114 (1999) PTC 19 201.
- 115 (2001) PTC 859 (Del.).
- 116 (2001) PTC 432 (Del.).
- 117 (2001) PTC 619 (Del.).
- 118 (2002) 24 PTC 355 (Del.).
- 119 2004 (28) PTC 566 (SC), 571.
- 120 2004 (28) PTC 566 (SC), 574.
- 121 2004 (28) PTC 566 (SC), 576–577. Court referred to the Collins English Dictionary (Collins, United Kingdom).
- 122 2004 (28) PTC 566 (SC), 577.
- 123 2005 (30) PTC 233 (SC). Division Bench decision. Justice P K Balasubramanyan delivered the judgment.
- 124 2005 (30) PTC 233 (SC), 237.
- 125 2005 (30) PTC 233 (SC), 239.
- 126 2006 (32) PTC 1 (SC). Division Bench decision. Justice S B Sinha delivered the judgment of the Court.
- 127 2006 (32) PTC 1 (SC), 9.
- 128 AIR 2006 SC 3304. Division Bench decision.
- 129 AIR 2006 SC 3304, 3314.
- 130 Morcom C, Roughton A and Graham J, *The Modern Law of Trade Marks and Service Marks* (Butterworths Law, England), 1999.
- 131 AIR 2006 SC 3304, 3314.
- 132 [1995] Supp. 2 SCR 514. Cited in AIR 2006 SC 3304, 3314.
- 133 (2002) 3 SCC 65. Cited in AIR 2006 SC 3304, 3314–3315.
- 134 AIR 2006 SC 3304, 3315.
- 135 [1973] 1 SCR 1050. Cited in AIR 2006 SC 3304, 3315.
- 136 (1999) RPC 117. Cited in AIR 2006 SC 3304, 3315.
- 137 1998 PTC (18) 580. Cited in AIR 2006 SC 3304, 3315–3316.
- 138 2004 (28) PTC 585 (SC). Cited in AIR 2006 SC 3304, 3316.
- 139 AIR 2006 SC 3304, 3317. *Dhariwal Industries Ltd v M S S Food Products* 2005 (30) PTC 233 (SC), 237.
- 140 AIR 2006 SC 3304, 3317–3318.
- 141 AIR 2006 SC 3304, 3318. Court cited *ICICI Bank Ltd v Sidco Leathers Ltd* 2006 (5) SCALE 27.
- 142 AIR 2006 SC 3304, 3318.
- 143 AIR 2006 SC 3304, 3321–3322.
- 144 AIR 2006 SC 3304, 3322.
- 145 AIR 2006 SC 3304, 3322. *Ruston & Hornsby Ltd v Zamindara Engineering Co* (1969) 2 SCC 727.
- 146 AIR 2006 SC 3304, 3322.
- 147 [1965] 1 SCR 737, 754–55. Cited in AIR 2006 SC 3304, 3322.
- 148 (1994) 2 SCC 448. Cited in AIR 2006 SC 3304, 3324.
- 149 (2004) 3 SCC 90
- 150 AIR 2006 SC 3304, 3324.
- 151 2007 (34) PTC 161 (SC). Division Bench decision. Dr Arijit Pasayat delivered the judgment of the Court.
- 152 *S M Dyechem Ltd v Cadbury (India) Ltd* [2000] Supp. 1 SCR 86. Cited in 2007 (34) PTC 161 (SC), 162.
- 153 [1965] 1 SCR 737.
- 154 2007 (34) PTC 161 (SC), 163.
- 155 (2007) 6 SCC 1. Division Bench decision. Justice Harjit Singh Bedi delivered the judgment of the Court.
- 156 (2007) 6 SCC 1, 8.
- 157 (2007) 3 SCC 780. Division Bench decision. Justice S H Kapadia delivered the judgment of the Court.
- 158 2005 (189) ELT 257 (SC)
- 159 (2007) 3 SCC 780, 786.
- 160 (2007) 3 SCC 780, 787.
- 161 (2007) 3 SCC 780, 787–788.
- 162 (2007) 3 SCC 780, 789.
- 163 AIR 1965 Bom 35.
- 164 AIR 1965 Bom 35. Para 27 and 30.
- 165 (2007) 3 SCC 780, 790.
- 166 AIR 1947 Bom 454.

- 167 (2007) 3 SCC 780, 791.
- 168 Act 47 of 1963.
- 169 (2007) 3 SCC 780, 791.
- 170 (2007) 3 SCC 780, 791–792.
- 171 (2007) 3 SCC 780, 793.
- 172 2008 (11) SCALE 175. Division Bench decision. Justice S B Sinha delivered the judgment of the Court.
- 173 2008 (11) SCALE 175, 179.
- 174 AIR 2009 SC 892. Division Bench decision. Justice S B Sinha delivered the judgment of the Court.
- 175 AIR 2009 SC 892, 900–901.
- 176 2009 (1) SCALE 497. Division Bench decision. Justice S B Sinha delivered the judgment of the Court.
- 177 2009 (1) SCALE 497, 506.
- 178 2009 (1) SCALE 497, 509.
- 179 2009 (1) SCALE 497, 510.
- 180 (2011) 4 SCC 85. Division Bench decision. Justice Dalveer Bhandari delivered the judgment of the Court.
- 181 McCarthy J T, *McCarthy on Trade Marks and Unfair Competition*, Volume 2 (3rd edn, Clark Boardman Callaghan, New York), para 12.5.
- 182 (2011) 4 SCC 85, 110.
- 183 (2011) 4 SCC 85, 120.
- 184 2015 (10) SCALE 505. Division Bench decision. Justice Vikramajit Sen delivered the judgment.
- 185 2015 (10) SCALE 505, 508–509.
- 186 2015 (10) SCALE 505, 512.
- 187 (2016) 2 SCC 683. Division Bench decision. Justice A K Sikri delivered the judgment of the Court.
- 188 (1990) 1 All E.R. 873; also known as ‘*Jif Lemon case*’.
- 189 (2016) 2 SCC 683, 699–700.
- 190 (2016) 2 SCC 683, 700.
- 191 (2016) 2 SCC 683, 701.
- 192 (2018) 2 SCC 1. Division Bench decision. Justice Ranjan Gogoi delivered the judgment of the Court.
- 193 *Reckitt & Colman Products Ltd v Borden Inc* (1990) 1 All E.R. 873.
- 194 (2018) 2 SCC 1, 17–18.
- 195 (2018) 2 SCC 1, 19.
- 196 (2018) 9 SCC 183. Division Bench decision. Dr A K Sikri delivered the judgment of the Court.
- 197 (2018) 9 SCC 183, 211.
- 198 Act 43 of 1958.
- 199 (2018) 9 SCC 183, 213–214.
- 200 (2018) 18 SCC 346. Division Bench decision. Justice Rohinton F Nariman delivered the judgment of the Court.
- 201 (2018) 18 SCC 346, 351.
- 202 *Haldiram Bhujawala v Anand Kumar Deepak Kumar* [2000] 1 SCR 1247 (Division Bench decision. Justice M Jagannadha Rao delivered the unanimous judgment); *Colgate Palmolive (India) Ltd v MRTP Commission* 2002 (8) SCALE 507 [Division Bench decision. Justice S B Sinha delivered the judgment of the Court]; *Hardie Trading Ltd v Addisons Paint and Chemicals Ltd* [2003] Supp. 3 SCR 686 [Division Bench decision. Justice Ruma Pal delivered the judgment of the Court]; *Commissioner of Central Excise, Calcutta v Emkay Investments (Pvt) Ltd* (2005) 1 SCC 526 [Full Bench decision. Justice Dr A R Lakshmann delivered the judgment]; *Bhavanesh Mohanlal Amin v Nirma Chemicals Works* 2005 (31) PTC 497 (SC) [Division Bench decision. Justice Arijit Pasayat delivered the judgment]; *Commissioner of Central Excise, Trichy v Grasim Industries Ltd* [2005] 3 SCR 466 [Full Bench decision. Justice S N Variava delivered the judgment of the Court]; *ICICI Bank Ltd v Municipal Corporation of Greater Bombay* [2005] Supp. (2) SCR 62 [Division Bench decision. P P Naolekar delivered the judgment of the Court]; *Commissioner of Central Excise, Raipur v Hira Cement* [2006] 1 SCR 1077 [Division Bench decision. Justice S B Sinha delivered the judgment of the Court]; *Commissioner of Central Excise, Chandigarh v Khanna Industries* [2006] Supp. (9) SCR 725 [Division Bench decision. Justice Arijit Pasayat delivered the judgment of the Court]; *Reiz Electrocontrols (P) Ltd v Commissioner of Central Excise, Delhi-I* (2006) 6 SCC 213 [Division Bench decision. Dr Arijit Pasayat delivered the judgment of the Court]; *Whirlpool of India Ltd, Bangalore v Deputy Commissioner of Commercial Taxes, Bangalore* [2006] Supp. 10 SCR 305 [Division Bench decision. Justice Markandey Katju delivered the judgment]; *Commissioner of Central Excise, Bangalore v Brindavan Beverages (Pvt) Ltd* [2007] 7 SCR 1033 [Division Bench decision. Dr Arijit Pasayat delivered the judgment of the Court]; *Commissioner of Central Excise, Jaipur v Sri Ganganagar Bottling Co* [2007] 9 SCR 669 [Division Bench decision. Dr Arijit Pasayat delivered the judgment of the Court]; *Commissioner of Customs v Ferodo India Pvt Ltd* 2008 (3) SCALE 153 [Division Bench decision. Justice S H Kapadia delivered the judgment of the Court]; *Dabur India Ltd v KR Industries* 2008 (37) PTC 332 (SC) [Division Bench decision. Justice S B Sinha delivered the judgment of the Court]; *PD Lakhani v State of Punjab* 2008 (6) SCALE 236 [Division Bench decision. Justice S B Sinha delivered the judgment on behalf of the Court]; *Unison Electronics Pvt Ltd v Commissioner, Central Excise, Noida* [2009] 3 SCR 607 [Division Bench decision. Justice Dr Arijit Pasayat delivered the judgment of the Court]; *Commissioner Central Excise, Delhi v Ace Auto Comp Ltd* 2010 (13) SCALE 387 [Division Bench decision. Justice D K Jain delivered the judgment of the Court]; *DAV Boys Sr Sec School v DAV College Managing Committee* [2010] 8 SCR 952 [Division Bench decision. Justice P Sathasivam delivered the judgment of the Court]; *Infosys Technologies Ltd v Jupiter Infosys Ltd* 2010 (44) PTC 625 (SC) [Division Bench decision. Justice R M Lodha delivered the judgment of the Court]; *Jeffrey J Diermeier v State of West Bengal* 2010 (5) SCALE 695 [Division Bench decision. Justice D K Jain delivered the judgment of the Court]; *Shalimar Chemical Works Ltd v Surendra Oil & Dal Mills (Refineries)* [2010] 10 SCR 703 [Division Bench decision. Justice Aftab Alam delivered the judgment of the Court]; *Purshottam Vishandas Raheja v Shrichand Vishandas Raheja* 2011 (5) SCALE 391 [Division Bench decision. Justice Gokhale delivered the judgment of the Court]; *Commissioner of Central Excise, Mumbai v Kalvert Foods India Pvt Ltd* [2011] 9 SCR 902 [Division Bench decision. Justice Mukundakam Sharma delivered the judgment]; *Commissioner, Central Excise, Bangalore v Meyer Health Care Pvt Ltd* [2011] 4 SCR 794 [Division Bench decision. Dr Mukundakam Sharma delivered the judgment of the court]; *Rasiklal Manickchand Dhariwal v M S S Food Products* 2011 (13) SCALE 183 [Division

Bench decision. Justice R M Lodha delivered the judgment of the Court]; *Skyline Education Institute (India) Private Ltd v S L Vaswani* 2010 (42) PTC 217 (SC) [Division Bench decision. Justice G S Singhvi delivered the judgment of the Court]; *Suresh Dhanuka v Sunita Mohapatra* 2012 (49) PTC 417 (SC) [Full Bench decision. Justice Altamas Kabir delivered the judgment of the Court]; *Commissioner of Central Excise, Chennai III Commissionerate, Chennai v Australian Foods India (Pvt) Ltd, Chennai* [2013] 1 SCR 932 [Division Bench decision. Justice D K Jain delivered the judgment of the Court]; *Young Achievers v IMS Learning Resources Pvt Ltd* (2013) 10 SCC 535 [Division Bench decision. Justice K S Radhakrishnan delivered the judgment of the Court]; *Lakha Ram Sharma v Balar Marketing Private Limited* 2014 (57) PTC 225 (SC) [Division Bench decision. Justice A K Sikri delivered the judgment of the Court]; *Satnam Overseas v Sant Ram & Co* 2014 (57) PTC 220 (SC) [Division Bench decision. Justice K S Radhakrishnan delivered the judgment]; *Precious Jewels v Varun Gems* 2014(60) PTC 465 (SC) [Division Bench decision. Justice Anil R Dave delivered the judgment of the Court]; *Commissioner of Central Excise, Chennai v Nebulae Health Care Ltd* 2015 (12) SCALE 94 [Division Bench decision. Justice A K Sikri delivered the judgment of the Court]; *Indian Performing Rights Society Ltd v Sanjay Dalia* 2015 (63) PTC 1 (SC) [Division Bench decision. Justice Arun Mishra delivered the judgment of the Court]; *Kali Aerated Water Works,*

Salem v Commissioner of Central Excise, Madurai 2015 (7) SCALE 44 [Division Bench decision. Justice A K Sikri delivered the judgment on behalf of the Court]; *Vir Rubber Products Pvt Ltd v Commissioner of Central Excise, Mumbai III* 2015 (5) SCALE 206 [Division Bench decision. Justice A K Sikri delivered the judgment on behalf of the Court]; *Royal Orchid Hotels Ltd v Kamath Hotels (India) Ltd* (2018) 1 SCC 728 [Division Bench decision. Justice Ranjan Gogoi delivered the judgment]; *Patel Field Marshal Agencies v P M Diesels Ltd* (2018) 2 SCC 112 [Division Bench decision. Justice Ranjan Gogoi delivered the judgment]; *Parakh Vanijya Pvt Ltd v Baroma Agro Product* (2018) 16 SCC 632 [Division Bench decision. Justice R Banumathi delivered the judgment]; *U C Surendranath v Mambally's Bakery* (2019) 20 SCC 666 [Division Bench decision. Justice R Banumathi delivered the judgment]; *International Association for Protection of Intellectual Property (India Group) v Union of India* (2021) 4 SCC 519 [Division Bench decision. Justice S Ravindra Bhat delivered the judgment of the Court]; *Rajkumar Sabu v Sabu Trade Pvt Ltd* 2021 SCC OnLine SC 378 [Justice Aniruddha Bose delivered the judgment on behalf of the Court]; *Sudhir Kumar v Vinay Kumar* 2021 SCC OnLine SC 734 [Division Bench decision. Justice M R Shah delivered the judgment of the Court]; and *Commissioner of GST and Central Excise v Citi Bank* 2021 SCC OnLine SC 1212 [Division Bench decision. Justice K M Joseph delivered the judgment of the Court].