



PASSING OFF AND INFRINGEMENT OF TRADEMARKS IN INDIA

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ABSTRACT

This paper discusses the principles of passing off and infringement action under the Trademarks Act, 1999. Trademark infringement means that when a person uses another person or company's trademark without the permission of the owner. It is illegal in a way to promote their goods and services and keep the customers in deception. And Passing off means that when a person sells his goods as the goods of another. Then the owner can bring the action against the person. Now there is interesting thing and that is when a trademark is registered, then there is a case of infringement. And when the trademark is not registered then there is a case of passing off. It provides for what acts constitute passing off and infringement of trademarks, what are the remedies available, who can sue and be sued and the defences available in case of trademark violation. The paper also discusses the factors to be considered in case of passing off and infringement action along with different judicial pronouncements given by Indian Courts. Those who have not registered trade mark can also stop the other person to use the identical or similar trade mark by the Doctrine of Passing Off. This doctrine is based on the principle that no one has right to represent one's goods as the goods of other. To get the remedy of passing off the plaintiff has to prove that he is the owner of the mark, and the same has gained reputation and goodwill and misrepresentation has been done by the defendant due to which the plaintiff has suffered huge damages. This article deals with the concept of the passing off, the main elements that constitutes passing off, evolution of law of passing, difference of it with the infringement and the role of judiciary to uphold the concept of passing off. Though the person who has not registered the trade mark get the rights but these rights are very limited. As to prove the passing off one has to show reputation and goodwill attached to passing off as no criteria or definition is provided in any of the statute. So it becomes cumbersome job for the plaintiff to prove the same and even judiciary takes different approach in different case in relation to passing off.

KEYWORDS:-Passing Off, Infringement, Goodwill, Reputation and Misrepresentation.

INTRODUCTION

One purpose of a trademark is to provide protection to customers by ensuring that goods and services they purchase are actually manufactured or provided by the companies associated with the marks. By granting trademark owners the exclusive right to use certain marks to identify their goods and services, trademark law allows a firm to distinguish its products and services from that of other firms. This is a method of branding. The value of a trademark to its owner is dependent on a number of factors, such as the size of the market created for the branded product, as well as the novelty or uniqueness of the mark itself. A trademark in relation to goods conveys to the general public and specifically to the consumers about the origin and quality of those goods, thereby acquiring reputation in the course of business and time. Therefore the concept of a trademark is the foundation of one's business to

distinguish from others. A good trademark is often the best salesman of the goods and is a visual symbol of goodwill and stamp of quality. Every businessman who has spent considerable amount of money making his mark popular will try to secure it from usage by unscrupulous competitors. Protection of trademark is important not only from the business point of view but also for the protection of consumer from fraud and imposition. The Trademark Act of 1999, both in letter and spirit, lays down that, while it encourages fair trade in every way and aims to foster and not to hamper competition, it also provides that no one, especially a trader, is justified in damaging or jeopardizing another's business by fraud, deceit, trickery or unfair methods of any sort. This necessary precludes the trading by one dealer upon the good name and reputation built up by another. The first Trademark legislation was enacted in India in 1940, but before that, protection to trademarks in the



country was governed by the principles of common law based on English cases. The law relating to protection of this form of industrial property is intricate and complex. The reputation of a business symbolized by a mark, under common law, can be protected only by an action for Passing off. Registration of a trademark under the Trade Marks Act of 1999 gives statutory rights and slight infringement of it can invite an action for Infringement. However, even the unregistered trademarks are also protected as the Act itself provides that an action of passing off remedy is available for unregistered trademark.

FRAMEWORK FOR TRADEMARKS

Intellectual property can be protected by patents, copyrights and trademarks. Trademark protection doesn't have a constitutional footing, while patents and copyrights do. State law is the origin of trademarks; Federal trademark protection was passed in 1870, but that particular act was ruled unconstitutional. But in terms of history, the Romans, Greeks and others used different markings to indicate who made items such as pottery or bricks. In the middle Ages, trade guilds employed markings to identify who made a particular product. The 1946 Lanham Act is the basis of the modern U.S. trademark system which spelled out the major requirements for registration and maintenance of ownership. The purpose of trademark law is to prevent confusion in the minds of the consuming public as to the source of a particular good and/or service. The owner of a trademark has spent time and resources marketing goods and services identified by the mark. And the purpose of doing that is to have the mark identified with only those goods and services to the exclusion of other goods and services. In monopolistic competition, trademarks or branding can be very useful as a method to help differentiate close but imperfect substitutes. The trademark holder often must work to prevent others from using the trademark and benefiting from prior use of the trademark. Using someone else's trademark without permission, known as infringement, will likely cause confusion in the minds of the consuming public. It is not necessary to prove actual confusion of unique customers in order to prove trademark infringement. Proving likelihood of confusion in the market satisfies the requirement so that similar marks in physical design could constitute cases of infringement (Besen, 1991).

PASSING OFF

Passing off action is based on common law principle. The damages claimed for in an action for passing off is "un-liquidated damages". The action against passing off is based on the principle that "a man may not sell his own goods under the pretence

that they are the goods of another man."¹ Similar view has been held in ICC Development (International) Ltd. vs. Arvee Enterprises² that "the passing off action depends upon the simple principle that nobody has any right to represent his goods as the goods of somebody else". In a passing off action, the priority in adoption and use of trade mark is superior. Passing off is not defined in the Trademark Act, 1999. It is referred to in Section 27 (2), 134 (1)(c) and 135 of the Act. Section 27 (2) states that the rights of action against any person for passing off as the goods of another person or the remedies in respect thereof are unaffected by the provision of the Act. Section 134 (1) (c) refers to jurisdiction of courts to try suits for passing off arising out of the use of any trademark. Section one 135 specifies the remedies available in respect of passing off arising from the use of a trademark. Passing off cases are often cases of "deliberate and intentional misrepresentation, but it is well settled that fraud is not a necessary element of the right of action and the absence of the intention to deceive is not a defence in an action for passing off though proof of fraudulent intention may materially assist a plaintiff in establishing probability of deception."³ The concept of passing off which is a form of tort has undergone changes in the course of time. At first it was restricted to the representation of one's goods as those of another. Later, it was extended to business and services. Subsequently, it was further extended to professions and non-trading activities. Now a days, it is applied to many forms of unfair trading and unfair competition where the activities of one person cause damage or injury to the goodwill associated with the activities of another person or group of persons. The law of passing off applies whenever there is the prospect of confusion between marks and getup or where there is the prospect of confusion of identity through the unauthorised use of similar marks or get-up. It is because the main consideration of passing off is whether deception or confusion is likely to arise, passing off can be used to protect any kind of distinctive name, mark, logo or get-up used to identify a company or business as well as products or services.

ESSENTIALS THAT CONSTITUTE PASSING OFF ACTION

In Reckitt & Colman vs. Borden⁴, their Lordships used the term "classical trinity", for goodwill, misrepresentation and damage, which are the three elements of the tort of passing off.

¹ N. R. Dongre v. Whirlpool Corporation, (1996) 5 SCC 714

² 2003 (26) PTC 245 (Del.)

³ Laxmikant Patel vs. Chetanbhai Shah, 2002 (24) PTC 1 (S.C)

⁴ (1990) RPC 341 (HL)



1. Goodwill:- the Plaintiff has to establish a goodwill or reputation attached to the goods and services which he supplies, in the mind of the purchasing public by association with the identifying get-up under which his particular goods and services are offered to the public as distinctive specifically of his goods or services.

As Lord Macnaghten has stated: "Goodwill is the benefit and advantage of a good name, reputation, and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old established business from the new established business at its first start. The goodwill of a business must emanate from a particular centre or source. However, widely extended or diffused its influence may be, goodwill is nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates."⁵

Goodwill is thus the benefit and advantage of a name and get-up, and it is the attractive force which brings in business. A passing off action is a remedy for the invasion of a right of property in the business or goodwill likely to be injured by any actionable misrepresentation, not in the name or get-up itself. Goodwill need not be established in the mind of every member of the relevant public, but in a significant section of it.⁶ A reputation generated among a very few people will not do. There must be a substantial number of potential customers although not necessarily a majority. The action of passing off lies where there is a real possibility of damage of goodwill to some business or trading activity. Therefore, the plaintiff has to establish a goodwill in his business or his goods or services with which the trade or public will be led to associate the defendant's activities.

In **Deepam Silk International vs. Deepam Silks**,⁷ while granting an order of injunction restraining the defendant from using the plaintiff's trademark, the Karnataka High Court observed that "once the plaintiff has shown that he has been doing business for more than a decade with the trade name and that he has not only applied for registration of a trademark nearly a decade back, but also has spent lakhs of rupees on gaining the reputation by spending towards advertisements in almost all medias available, the loss that would be caused to the plaintiff, if another person like the defendant makes use of the same trade name and sells the same goods, cannot be ascertained in terms of money. It is the reputation of the plaintiff's trade name that will be in jeopardy. If the defendant is to sell inferior goods, it will definitely affect the business of the plaintiff and

⁵ Commissioners of inland Revenue VS. Muller & Co's Margarine Ltd.(1901)A,C.217

⁶ Chocosuisse Union des Fabricants Suisses de Chocolat vs. Cadbury Ltd., (1999) RPC 826

⁷1998 (18) PTC 18 Kar.

will give an impression to the buyers of the goods from the defendant that the goods sold by the trade name are not maintaining their quality. Therefore, there is every likelihood of the plaintiff losing its customers and getting its trade name defamed."

Passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of the business. The law assumes or presumes that if the goodwill of a man's business has been interfered with by the passing off of goods, damage results therefrom. The plaintiff need not wait to show that damage has resulted, he can bring his action as soon as he can prove the passing off; because it is one of the class of cases in which the law presumes that the plaintiff has suffered damage.

2. Misrepresentation: the Plaintiff must demonstrate a misrepresentation by the defendant to the public leading or likely to lead the public to believe that the goods or services offered by him are the goods and services of him.

In its classic form the misrepresentation which gives rise to an action of passing off is an implied representation by the defendant that his goods are the goods of the plaintiff. As Lord Diplock explained in *Advocaat* case⁸ that:

"Where the plaintiff and defendant were not competing traders in the line of business, a false suggestion by the defendant that their business were connected with each other would damage the reputation and thus the goodwill of plaintiff's business." The basis of passing off action being a false representation by the defendant, it must be proved in each case as a fact that the misrepresentation was made. The use by the defendant in connection of the goods, of the mark, name, or get-up in question must represent such goods to be the goods of the plaintiff, or the goods of the plaintiff of a particular class or quality; and the defendant's use of such mark, name or get-up is calculated to deceive.⁹

3. Damage: the plaintiff must demonstrate that he suffered or in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief endangered 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.¹⁰ In a passing off action, damage is presumed even if there is likelihood of deception.

In *ICC Development (International) Ltd. vs. Arvee Enterprises*¹¹ and in *Sakalain Meghajee vs. BM House (India) Ltd.*¹², the Delhi High Court cited

⁸ (1979) AC 731, p. 741-742

⁹ *Spalding vs. Gamage* (1915) 32 RPC 273

¹⁰ *Law of Trademarks and Geographical Indications*, KC Kailasam, Publication: Wadhwa Nagpur; 2nd Edition, 2005, pg. 343

¹¹ 2003 (26) PTC 245 (Del.)

¹²2002 (24)PTC 207 (Del.)



the case of Erven Warnik Besloten Vennootschap & Anr. Vs. Townend & Sons (Hull) Ltd. & Anr.,¹³ wherein the House of Lords identified five characteristics which must be present in order to create a valid cause of action for “passing-off”. The House of Lords held that “passing-off” is:

1. A misrepresentation;
2. Made by a trader in course of business;
3. To prospective customers of his or ultimate consumers of goods or services supplied by him;
4. Which is calculated to injure the business or goodwill of another trader which can reasonably be foreseeable; and
5. Which causes actual damage to a business or goodwill of the trader by whom the action is brought or in a quia time (because he fears or apprehends) action will probably do so.

In *Laxmikant V. Patel vs. Chetanbhai Shah*,¹⁴ the Hon’ble Supreme Court held the three elements of passing-off action are:-

- a. Reputation of the goods;
- b. Possibility of deception.

CHARACTERISTICS OF PASSING OFF ACTION

Following characteristics can be attributed to passing off action:-

a. Proof of fraudulent intent not necessary: it is not essential that the plaintiff must establish fraud on the part of the defendant in a passing off action. While granting injunction against the defendants using the trademark “Horlioks”, the Delhi High Court held that “the use of the offending mark by the defendants to imitate the plaintiff’s trademark appears to be flagrant and blatant attempt on the part of the defendants to imitate the plaintiff’s trademark with a view to deceive the unwary purchasers and exploit and encash on their goodwill in order to pass off their goods as that of the plaintiff’s. the law does not permit anyone to carry on his business in such a way as would persuade the customers in believing that the goods belonging to someone else are his or are associated therewith. Where there is possibility of confusion in business, an injunction would be granted even though the defendant adopted the name innocently.”¹⁵

b. Passing off not limited to goods: Passing off properly so called is not confined to the case of sale of goods. Passing off also restrains a defendant from trading under a particular name though the defendant trader is not selling the goods.¹⁶ Thus, when a name has become identified, by adoption and

user with a particular trade or manufacture or business, the person who so used or adopted it can obtain the aid of the Court to restrain the use of it by others in such a way as to lead customers or the public to think that the trader business of the person sousing is his trade or business.

c. Evidence of false representation, but not deception necessary: false representation made by the defendant, whether expressly or otherwise, must be proved as a matter of fact in each case. Absence of actual deception is not determinative. The ultimate question of whether the deception is likely to cause confusion remains a question of fact for the courts to decide in the light of available evidence.

d. Plaintiff and defendant need not be in the same field: in passing off action, it is immaterial whether the plaintiff and the defendant trade in the same field or trade in different products. Remedies in the form injunction was granted in favour of the plaintiff on the basis of an action of passing off even though the plaintiff and defendant were trading in altogether different products.¹⁷

e. Prior user to be established: for inherently distinctive marks, ownership is governed by the priority of use of such marks. The first user in the sale of goods is owner and senior user. In order to succeed, the plaintiff have to establish user of the mark prior in time than the impugned user by the respondents.

ISSUE IN A PASSING OFF ACTION

The issue in a passing off action may be stated as follows: “would the users of the defendants, either the actual user or the proposed user conceded for the purposes of the action, be likely to lead persons, either members of trade or of the public, to suppose that the defendant’s goods so sold were the product of the plaintiff’s, or that the business concerned in its production was the plaintiff’s or was associated with the plaintiff’s business.”¹⁸

Factors to be considered in case of an action for passing off:-

The Hon’ble Supreme Court in *Cadila Health Care Ltd. Vs. Cadila Pharmaceuticals Ltd.*,¹⁹ held that the following factors to be considered in case of an action for passing off action of an unregistered trademark for deciding the question of deceptive similarity:-

1. The nature of the marks, i.e, whether the marks are word marks or label marks or composite marks, i.e, both words or label works.
2. The degree of resemblance between the marks, phonetically similar and hence similar in idea.

¹³ 1979AC 731

¹⁴ 2002(24) PTC 1 (sc)

¹⁵ *Horlicks Ltd. Vs. Bimal Khamrai*, (2003) 26 PTC 241 (Del.)

¹⁶ *6 Sales Affiliates lts. Vs. Le Jean Ltd.*, (1947) 64 RPC 103

¹⁷ *Honda Motors Co. Ltd. Vs. Charanjit Singh*, 2003 (26) PTC 1

¹⁸ *Showerings vs. Bulmer*, (1965) RPC 307

¹⁹ AIR 2001 SC 1952



3. The nature of goods in respect of which they are used as trademarks.
4. The similarity in nature, character and performance of goods of the rival traders.
5. The class of purchasers who are likely to buy the goods bearing the marks 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.
7. Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.”

DEFENCES TO A PASSING OFF ACTION

In a suit for passing off, apart from denying the plaintiff's allegations generally, the defendant may be able to plead the following in defence in his case:-

1. The defendant may prove that the plaintiff's business is either fraudulent or forbidden by law. If any particular business could be shown to be a fraudulent business or one forbidden by law or one which the public policy of law was to prevent, then in those cases the proprietor cannot claim protection of the court.²⁰ For example, if a trader who sells through street markets counterfeit versions of sound recordings and DVD's bearing a famous trademark might not be allowed to rely on his sales to maintain a passing off action against another counterfeiter who has come into the market after him.²¹
2. A false representation contained in the mark itself did furnish a defence at law and at equity. Where a trademark is used exclusively in connection with a trade which was itself fraudulent, the fraud in the trade which was itself carried on by the trademark is a defence.²²
3. The mark complained of is not distinctive of the plaintiff's business and there is no likelihood of passing off by reason of defendant's use of the mark.
4. The plaintiff is guilty of acquiescence, laches, etc. or the defendant has prior used the mark.
5. The defendant's mark represent his own name which he has the right to use. "A man is entitled to carry on his business in his own name so long as he does not do anything more than that to cause confusion

with the business of another, and so long he does it honestly”.²³

6. The field of activities of the parties are completely different.²⁴
7. The defendant claims right of concurrent use of his mark of his mark. Honest and concurrent user of a trademark when established will constitute a defence.²⁵
8. The defendant's use of the mark is the bona fide description of the character or quality of goods or services. However, the defence of the name being 'surname' or 'personal name', though available to individuals, is not applicable to a corporate body.²⁶
9. Innocent misrepresentation by the defendant also constitutes a valid defence against passing off action. Under Section 135 (3)²⁷, where the defendant satisfies the court that he was unaware of the existence and nature of plaintiff's trademark, and that when he became aware he ceased to use the trademark complained of, the Court shall not grant relief by way of damages or an accounts of profit.
10. The defendant is using the Plaintiff's mark by way of a license. Under Section 12 an honest concurrent user would be protected. Under Section 30 (2)(c)(i), a defence is always open that the proprietor of a registered trademark has expressly or impliedly consented to the use of the said trademark by the defendant. This defence, if laid, would need a trial.²⁸
11. The defendant may successfully plead and establish that the alleged misrepresentation was made by his employee outside the scope of his authority and contrary to express instructions.²⁹
12. Lastly, the defendant may plead that the plaintiff has abandoned his mark and that the defendant has either already moved for rectification of register for removal of mark or proposed to do so. Where a mark is abandoned, it may become common to trade.³⁰ When abandoned, the mark may be

²⁰ Newman vs. Pinto, (1887) 4 RPC 508, p.519

²¹ Leather cloth Co. Ltd. Vs. American Leather Cloth Co. Ltd., (1865) 11 ER 1435 (HL)

²² Newton Chambers & Co. Ltd. Vs. Neptune Waterproof Paper Co. Ltd, (1935) 52 RPC 399; p.406

²³ Rodgers vs. Rodgers, (1924) 41 RPC 277

²⁴ Dunlop vs. Dunlop, (1889) 16 RPC 12

²⁵ Manoj Plastics vs. Bholu Plastic, (1983) PTC 368

²⁶ Kirloskar Disedal Recon Ltd. Vs. Kirloskar Proprietors Ltd, AIR 1996 Bom. 149

²⁷ Trademarks Act, 1999

²⁸ QRG Enterprises vs. Surendra Electricals, 2005 (30) PTC 471 (Del.)

²⁹ Boston Marine Patents Company Ltd. Vs. Wheeler & Thomson, (1954) 71 RPC 432

³⁰ National starch Manufacturing co. Vs Munn's Patent Maizena and starch co. (1894)11



appropriated by another person. The onus is on the defendant to prove abandonment.³¹

NEW FACET OF PASSING-OFF ACTION

The present Trademarks Act, 1999 which provides protection of trademark in its diverse forms, cases of trade dress does not strictly fall within the statutory definition of “trademark” under Section 2 (1)(zb), because the business or product that enjoys goodwill independent of the brand value enjoyed by the trademark cannot always be included within the protective sweep of the Trademarks Act. This is because of two reasons, firstly, trade dress law is less explicitly set forth in statute law in India. Secondly, the trade dress protection is broader than trademark protection. One of them being that the breadth of trade dress protection is generally perceived to be broader than the conventional protection afforded to trademarks and business name. The reason for this is that packaging and product design cannot be registered for trademark protection, and also the trade dress infringement claim requires the Court to focus on the plaintiff’s entire selling image, rather than the narrower single facet of trademark alone. These elements encompass the manufacturer’s total selling image, unlike trademarks that merely identify and distinguish the manufacturers from the competitors. However, in *Colgate Palmolive & Co. vs. Anchor Health and Beauty Care Pvt. Ltd.*³², the Delhi High Court raised the bar of trademark protection available to trade dress of goods and held that similarity of trade dress was an attribute of passing off, and was actionable per se.

INFRINGEMENT OF A TRADE MARK

Section 27(1) of the Trademarks Act, 1999 provides that a person shall be entitled to initiate legal proceeding to prevent or recover damages for the infringement of a registered trademark. Infringement occurs when someone else uses a trademark that is same as or deceptively similar to registered trademark for the identical or similar goods or services as to cause confusion in the mind of the public. This right of bringing an infringement action against the defendant has been conferred by Section 28 of the Trademarks Act, 1999. Section 28 of the Act provides that the registration of a trademark gives to the proprietor of a registered trademark an exclusive right to use the trademark in relation to the goods and services in respect of which the trademark is registered and to obtain relief in respect of infringement of the trademark. Trademark infringement claims generally involve the issues of likelihood of confusion, deceptive marks, identical marks and dilution of marks. Likelihood of confusion

occurs in situations where consumers are likely to be confused or misled about marks being used by two parties. The plaintiff must show that because of the similar marks, many consumers are likely to be confused or misled about the source of the products that bear these marks. Dilution is a trade mark law concept forbidding the use of a famous trade mark in a way that would lessen its uniqueness. In most cases, trade mark dilution involves an unauthorized use of another’s trade mark on products that do not compete with, and have little connection with, those of the trade mark owner. For example, a famous trade mark used by one company to refer to hair care products, might be diluted if another company began using a similar mark to refer to breakfast cereals or spark plugs.

What constitutes Infringement?

Section 29 of the Trademarks Act, 1999 deals with infringement. In this context, the ingredients of Section 29 (1) are as follows:-

1. The plaintiff’s mark is registered.
2. The defendant’s mark is identical with, or deceptively similar to plaintiff’s registered mark;
3. The defendant has taken any essential feature of the mark or has taken the whole of the mark and then made a few additions and alterations.
4. The defendant’s use of the mark is in course of the trade in respect of goods/services covered by the registered trademark.
5. The use of the infringing mark must be printed or usual representation of the marking advertisements, invoices or bills. Any oral use of the trademark is not infringement.
6. The use by the defendant is in such manner as to render the use of the mark likely to be taken as being used as a trademark.
7. The defendant’s use of the mark is not by way of permitted user and accordingly unauthorised infringing use. While the above is the general proposition of law as per Section 29 (1), the various circumstances in which the trademark is infringed are enumerated in sub-sections 29(2) to (9) of Section 29.

INFRINGEMENT- VARIOUS FACTORS

In *Wockhardt Ltd. Vs. Aristo Pharmaceuticals Ltd.*³², Madras High Court, after holding the defendant’s mark “SPASMO-FLEXON” deceptively and phonetically similar to “SPASMO-PROXYVON”, summarised the law as follows:

1. The registered proprietor of a trademark has exclusive right to the use of the trademark in relation to the goods and services in respect of

³¹ Noor Illahi Maqbul Illahi vs. R.J Wood & Co., (1928) Lah. 487; AIR 1928 Lah. 924

³² (1999) PTC 540



- which the trademark is registered and to obtain relief in respect of infringement of the trademark in manner provided by the Act.
- Whether it is deceptively or has become publici juris is a question of fact to be established.
 - When a number of marks, all have a common element, may it be prefix, suffix or root, i.e. essential part or the core of the mark, they come to be associated in the public mind as an indication of the same source, which misleads or causes deception or confusion.
 - It is the common element that has to be identified in an impugned mark and the registered trademark and if such common element is highly distinctive and is not just a description or a commonly used word, the likelihood of deception or confusion would be very much there, despite the fact that it might differ in similarity in certain letters.
 - The nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration.
 - Marks must be looked at from the first impression of a person of average intelligence and imperfect recollection.
 - Marks must be compared as a whole, microscopic examination being impermissible.
 - The broad and salient feature must be considered, for which the marks must not be placed side by side to find out the differences in design.
 - Overall similarity is the touchstone.
 - It is not the colour of the container or the difference of the product, but it is the statutory right to the word that has to weigh.
 - The plaintiff need not in general show prima facie case that is required to be shown must be something more than a case that will avoid the action being struck out as frivolous or vexatious and even if the chance of success at the trial are only twenty percent, the statutory protection is absolutely necessary by way of an injunction in order to prevent confusion or deception arising from similarity of marks.

Following are the instances where the acts constituted infringement of trademark:-

a. Taking substantial feature of the mark:- a mark is infringed by another trader, if, even using the whole of it upon or in connection with his goods, he uses one or more of the essential features.

b. Additions:- addition of extraneous matter, inconspicuous additions is infringement. If a person incorporates whole or part of a registered Trademark of another, the addition of other matter would not save him from the charge of infringement.

c. When a mark is copied:- if the defendant absolutely copied the mark and made a facsimile representation of it, no further evidence is required.

When the similarities are so close as to make it impossible to suppose that such marks were devised independently of each other, in absence of evidence of common origin, the conclusion that one party copied the mark of another.

d. Marks likely to cause confusion: Likelihood of confusion occurs in situations where consumers are likely to be confused or misled about marks being used by two parties. The plaintiff must show that because of the similar marks, many consumers are likely to be confused or misled about the source of the products that bear these marks. Where the visual, aural and conceptual similarities is caused by the defendant's trademark which causes confusion in the minds of the public as to its origin, then the mark is held to be an infringing mark. Furthermore, if the association between the marks causes the public to wrongly believe that the respective goods comes from the same or economically linked undertakings, there is a likelihood of confusion.³³

e. Use of reconditioned or second articles:- the use of plaintiff's mark on reconditioned goods may constitute infringement even if it is clarified that goods are not original but reconditioned.³⁴

f. Printing of labels:- unauthorised printing of labels of the plaintiff will constitute infringement. Moreover, if a copyright subsists in labels, it will constitute infringement of copyright as well.

g. Goods manufactured by third party would constitute infringement:- when the owner of a mark gets the goods manufactured by a third party under a contract, solely for the mark, sale of the goods bearing the mark by such a manufacturer to other person would constitute infringement.

h. Marks used along with other's mark:- use of the plaintiff's mark along with the defendant's name even if prominently displayed constitutes infringement.³⁵

i. Similar marks in medicinal products: when the goods or products involved are medicinal products, confusion of sources or drugs or medicinal preparation caused by similar marks of the defendant would constitute infringement, although similarity in the marks would have been very less.

j. Marks with international reputation used unauthorisedly: in case of marks which have acquired international reputation, an action for its protection against un-authorised use will lie even if the owner of the trademark does not have any business activity in India.³⁶

³³ Compass Publishing BV vs. Compass Logistics Ltd., (2004) RPC 41

³⁴ Rolls-Royce vs. Dodd, 1981 FSR 517

³⁵ Levi vs. Shah (1985) RPC 371

³⁶ Torrent Pharmaceuticals Ltd. Vs. Wellcome Foundation Ltd. (Guj. H.C) 2001 (2) CTMR 158



Who can sue for infringement?

The plaintiff in an infringement suit may be either:

1. The proprietor of the registered trademark or his legal successor.
2. A registered user of a trademark subject to a prior notice to the registered proprietor and consequent failure of the registered proprietor to take any action against the infringer.
3. An applicant for registration of a trademark. He can file an infringement suit to protect his right to continue with the suit which will sustain only if his trademark is registered before hearing the suit.
4. Legal heirs of the deceased proprietor of a trademark.
5. Any one of the joint proprietors of a trademark.
6. A foreign proprietor of a trademark registered in India when Infringement occurs in India.

Who can be sued?

1. The infringer who directly by his action causes infringement or who uses or contemplates or threatens to use a trademark infringing plaintiff's right.
2. The master responsible for his servant's act of infringement. For example, a worker who is engaged in the business of making false labels is a servant of the master who orders the making of such labels. It is the master in such a case who is to be sued.
3. The agents of an infringer.
4. Directors and promoters of a limited company cannot be joined as co-defendants unless they have personally committed or directed infringing acts.

Jurisdiction:

Suit for infringement or for passing off is to be filed in the court not inferior to a District Court having jurisdiction to try the suit.³⁷ District Court having jurisdiction includes a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceedings, the person instituting the suit or other proceedings, or where there are more than one person, any of them who:-

- a. Actually and voluntarily resides;
 - b. or b. Carries on business; or
 - c. works for gain;
- can bring in an action against the defendant.

Period of Limitation:

Under the Limitation Act, 1963, the period of limitation for filing a suit for infringement of a trademark is three years from the date of infringement. Where the infringement is a continuing one, a new course of action arises every time an infringement occurs. For example, a continued sale of infringing article would give rise to a fresh cause of action.

Issues in Infringement suits:

The issues that arise in an infringement action are the following:-

- a. Whether the plaintiff is entitled to file a suit; i.e. whether he is proprietor of a registered trademark or a registered.
- b. Whether the use or proposed use of the mark by the defendant is an infringement of the registered trademark.
- c. Whether the defendant has succeeded in establishing one or more of the defences set up by him.
- d. If the plaintiff's succeeds in the suit, what reliefs he is entitled to?
- e. Whether the plaintiff is entitled to any interlocutory relief?
- f. Whether there has been actual instances of deception and confusion amongst the public?

Evidence in Infringement Actions:

The fact of registration of the plaintiff's mark is to be proved by production of a copy of the entry on the register certified by Registrar and sealed with the Trademark Registry.³⁸ The certified copy will contain all the entries in the register relating to the mark including the conditions, if any, subject to which a mark is registered. In all legal proceedings relating to a registered trademark, the original registration of a trademark and all subsequent assignments and transmissions will be prima facie evidence of the validity. The plaintiff must establish that the use of the mark complained of comes within the scope of definition of infringement. Where the defendant has absolutely copied the mark and made a facsimile representation of it, no further evidence is required. Where the mark used by the defendant is not identical with the registered trademark, the court has to determine the two marks are deceptively similar. Opinion evidence is not admissible, but statement of witnesses to the effect that they themselves would be deceived are admissible. Evidence as what constitutes the essential feature of the mark is admissible.³⁹

CONCLUSION

Thus, from the above discussion it can be said that protection of trademark is important not only from the business point of view but also for the protection of consumer from fraud and imposition. However, it is beneficial if combined action for infringement and passing off is brought in one suit as incorporating a plea of infringement, if the mark gets registered can always amend the plaint. But in an action for infringement alone the plaintiff may not be allowed to include a fresh cause of passing off in order to save the action. Since the scope of passing off action is wider than an infringement action, if an action fails, there is a chance of other succeeding. As

³⁷ Section 134 of the Trademarks Act, 1999

³⁸ Section 137 of the Trademarks Act, 1999

³⁹ Prem Nath vs. Registrar, AIR 1972 Cal 261



stated in the preamble of the Trademarks Act, 1999, the law provides for a better protection of trademarks, the fact that the trademark law provides protection to trademarks has come out to be a reality. The present Act expressly recognises the common law remedy and thus saves both the registered and unregistered trademarks from being misused.

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