

Legal Issues in ‘Corporate-Commercial IP [Business and Regulatory]’

Issue: Does Proof of Conceptual Similarity of Marks by Itself form a Sufficient Ground for Infringement?

Introduction

- ❖ **Likelihood of confusion** is a key indicator of trademark infringement, established by the identity or “**deceptive**” similarity of the rival marks.
- ❖ Deceptive similarity of trademarks is judged on the basis of their visual, phonetic, structural and **conceptual similarity**. Often, more than one of these tests apply to a given case in hand.
- ❖ While determining visual, phonetic and structural similarity is quite straightforward, and objective tests can be implied to ascertain the same, however, conceptual similarity is a slightly more subjective test.
- ❖ Conceptual similarity aspect focuses on semantic content of a trademark such as the meaning of marks. Accordingly, the test becomes slightly more subjective as it depends upon what a consumer will understand from the trademark.
- ❖ For instance: The marks “BAGGAGE” and “LUGGAGE” may be considered similar, as they are synonyms. Another example is “PINK LADY” and “LADY IN ROSE” – these while not synonymous, are lexically related and therefore could be similar.

Relevant Legal Provisions

❖ **Section 2(h), Trade Marks Act, 1999 –**

“deceptively similar — A mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion” [Emphasis supplied]

❖ **Section 11(1), Trade Marks Act, 1999 –**

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*“Relative grounds for refusal of registration.—(1) Save as provided in section 12, a trade mark shall not be registered if, because of— ...(b) **its similarity to an earlier trade mark** and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.” [Emphasis supplied]*

Relevant Legal Provisions (Contd.)

❖ Section 29, Trade Marks Act, 1999 –

“Infringement of a registered trade mark - (1) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

*(2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of— ...**(b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark...is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.**” [Emphasis supplied]*

Examples of Conceptual Similarity: Relevant Judicial Decisions

- ❖ *Corn Products Refining Co. v. Shangrila Food Products Ltd.* [AIR 1960 SC 142]
- **Conflicting marks:** GLUVITA v. GLUCOVITA in respect of biscuits.
- **Held:** “...the idea of the two marks is the same. The marks convey the ideas of glucose and life giving properties of vitamins. The Aquamatic case (*Harry Reynolds v. Laffeaty's Ld.*) [1958 R.P.C. 387], is a recent case where the test of the commonness of the idea between two marks was applied in deciding the question of similarity between them. Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonable likely to cause a confusion between them.” [Emphasis supplied]

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Examples of Conceptual Similarity: Relevant Judicial Decisions (Contd.)

- ❖ *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt.* [221 (2015) DLT 359]
- **Conflicting marks** : OFFICER'S CHOICE v. COLLECTOR'S CHOICE in respect of whiskeys



- **Held:** “...it prima-facie emerges clear that COLLECTOR and OFFICER, may be considered hyponyms of the hypernym 'persons holding office' or the word COLLECTOR may be considered a hyponym of the word OFFICER or both COLLECTOR and OFFICER may be synonymous to each other : 'persons holding office'. What needs to be ascertained, thus, whether these two words exist in hyponymy or synonymy with each other in the same context, such that the same idea is conveyed by the marks 'Officer's Choice' and 'Collectors' Choice', causing the likelihood of confusion or deception in the minds of a consumer of average intelligence and imperfect collection.” [Emphasis supplied]

Examples of Conceptual Similarity: Relevant Judicial Decisions (Contd.)

- ❖ *Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt.* [221 (2015) DLT 359] [Contd.]
 - **Held:** “... the word 'Collector' is a hyponym of the word 'Officer' and both are synonyms of the phrase/idea 'Person holding an office of authority'. Hence, the two words are similar... Turning to the question whether the two words are deceptively similar... we need to explore how related ideas are stored and retrieved by the human mind... when a consumer has to make a decision regarding a purchase, and is confronted with the product of the appellant with the mark 'Collector's Choice', the word 'Collector' shall bring to his mind the cue 'Person holding an office of authority' which is related to the word 'Officer' since both trademarks in the present case are used in the same context for whisky...”
 - “Since the marks 'Officer's Choice' and 'Collector's Choice' are prima-facie deceptively similar as they convey the same meaning, the impact of different trade dress is highly unlikely to rule out consumer confusion between the two products in this case, especially since consumers expect manufacturers of alcoholic beverages to churn out variants.” [Emphasis supplied]

Examples of Conceptual Similarity: Relevant Judicial Decisions (Contd.)

- ❖ *Make My Trip (India) Private Limited v. Make My Travel (India) Private Limited* [2019 (80) PTC 491 (Del)]
- **Conflicting marks:** MakeMyTrip v. MakeMyTravel in respect of travel booking services.
- **Held:** “...The phenomenon is also described by some as 'Word Association' meaning "stimulation of an associative pattern by a word" or "the connection and production of other words in response to a given word done spontaneously... words are not stored in our mental lexicon as single items, but forming clusters with related concepts... In the present case also, while the first two words of the marks MakeMyTrip and MakeMyTravel are identical, the last words, TRIP and TRAVEL are similar and convey the same idea. Similarly, the Defendant’s tag line DREAMS UNLIMITED is deceptively similar to the Plaintiff’s taglines HOTELS UNLIMITED and MEMORIES UNLIMITED. While the second word in the tag lines is identical, the first words DREAMS, MEMORIES and HOTELS, when considered in the context of travel and holiday related services, may be used in the same context or idea. “[Emphasis supplied]”
- “... In view of the law laid down by the Supreme Court in the foregoing judgments and having regard to the facts of the case, there cannot be any doubt that the Plaintiff has a strong prima facie case and the balance of convenience also lies in its favour. In case the Defendant is permitted to continue to use infringing marks, grave and serious prejudice is likely to be caused to the Plaintiff.” [Emphasis supplied]

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Examples of Conceptual Similarity: Relevant Judicial Decisions (Contd.)

❖ *Gillette Company v. Tigaksha Metalics Private Limited* [251 (2018) DLT 530]

• **Conflicting marks:**



• **Held:** The court held the marks to be similar despite presence of the words WILKINSON and ZORRIK in the labels and stated that the term “TALVAR” is conceptually similar to “SWORD” in as much as it is the Hindi translation of the word. Court relied on the decision in Allied Blenders to state that if the marks convey the same meaning “...*the impact of the differences in trade dress was unlikely to rule out consumer confusion between the two products...*” [Emphasis supplied]

Examples of Conceptual Similarity: Relevant Judicial Decisions (Contd.)

- ❖ *Hamdard National Foundation (India) v. Sadar Laboratories Pvt. Ltd.* [CS (COMM) 551/2020, Delhi High Court, January 6, 2022]
- **Conflicting marks:** ROOF AFZA v. DIL AFZA in respect of non-alcoholic beverages
- **Held:** “...there is no identical mark that has been used. The similarity is sought on the ground that 'Dil' and 'Rooh' entail deep emotions and that the word 'Afza' is common to both. As has been repeatedly held by the courts, the standard to be adopted while determining confusion arising in the mind is of a consumer of imperfect memory or recollection and of ordinary sensibilities. It would be taking an extreme position, even if the consumers were connoisseurs, to believe that the use of the word 'Rooh' and 'Dil' would cause confusion because they connote deep emotion...we are concerned with the common consumer, to whom, in ordinary use of the words, 'Dil' and 'Rooh' do not denote the same thing. There cannot be a confusion being created on account of the meaning of the two words. This plea raised on behalf of the plaintiffs deserves rejection and is rejected.” [Emphasis supplied]

Conclusion

- ❖ Conceptual similarity is an important prong in proving deceptive similarity. It has been accepted by the courts to be the sole ground for infringement, despite differences in visual and phonetic similarities. [*Allied Blender's Case*]
- ❖ However, it is also important to note that none of these cases progressed only on the grounds of conceptual similarity of the marks, except the *Rooh Afza* case. In every case, conceptual similarity was argued along side other aspects.
- ❖ The *Rooh Afza* judgment is therefore an exception because it was based purely on the similarity of the meaning of the marks Rooh (spirit/soul) and Dil (heart) (which the court did agree had a similar connotation). Had the tests of “hyponyms” been applied in this case, the conclusion could be different. The words Rooh and Dil can be said to be connected in so far as both are homonymous to “human emotions/feelings”.
- ❖ It would be interesting to see the court’s final holding in this case and whether they go back to the *Allied Blender's Case* to decide differently.

THANK YOU!

Questions?

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