

Legal Issues in ‘Corporate-Commercial IP (Regulatory & Litigation)’

Issue: “Whether exclusive rights can be claimed in common element shared across multiple marks of a proprietor?”

Relevant Legal Provisions

❖ *Section 17 of the Trade Marks Act, 1999*

Effect of registration of parts of a mark. –

(1) When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.

(2) Notwithstanding anything contained in sub-section (1), when a trade mark--

(a) contains any part--

(i) which is not the subject of a separate application by the proprietor for registration as a trade mark; or

(ii) which is not separately registered by the proprietor as a trade mark; or

(b) contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered.

❖ *Section 28 of the Trade Marks Act, 1999*

Rights conferred by registration.—

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

Relevant Legal Provisions

❖ *Section 29 of the Trade Marks Act, 1999*

Infringement of registered trade marks.

(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--

- (a) its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or*
- (b) its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or*
- (c) its identity with the registered trade mark and the identity 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.*

(3) In any case falling under clause (c) of sub-section (2), the court shall presume that it is likely to cause confusion on the part of the public.

Relevant Judicial Decisions

❖ ***McDonald's Corporation and Ors. Vs. Sterling's Mac Fast Food [2008(37)PTC 247(Karn)]; Karnataka High Court; Single Judge Bench***

“8. ...From a plain reading of the above provision of the Act, it is clear that the trade mark used must be identical or deceptively similar to the registered trade mark of others. Even according to the plaintiffs, their registered trade marks are BIG MAC, McDonald's & Corporate logo M. The defendant's trade mark is STERLING'S MAC FAST FOOD or MAC FAST FOOD. Except the word MAC is common in both, the other words are altogether different. Therefore, it cannot be said that defendant has infringed the registered trademark of plaintiffs by using the same in its business.”

“14. ... Therefore the plaintiffs cannot claim exclusive right to trade with their trade mark 'Mac'.”

4

“15. It is also pertinent to note that the admitted position is, plaintiffs grievance is only against using the word MAC by the defendant... This being the admitted facts, plaintiffs cannot claim exclusive right on the defendants trade mark. Since defendant has been using its trade mark since 1983, plaintiffs cannot have any grievance against it. The suit filed by the plaintiffs is imaginary and vexatious. The trial Court is justified in dismissing the suit with costs.” (emphasis supplied)

Relevant Judicial Decisions

❖ ***Neon Laboratories Ltd. Vs. Themis Medicare Ltd. [2014(60)PTC 621(Bom)]; Bombay High Court; Single Judge Bench***

"11. Since the Plaintiff has adopted a series of marks with LOX, it follows that consumers of the Plaintiff's products would be acquainted with the mark. Consequently, when confronted with the XYLOX Family marks, these consumers would naturally assume them to be part of the Plaintiff's series of marks. What has been copied, Dr.Tulzapurkar says, is LOX, the prominent feature of the Plaintiff's series of marks. If there be a series of marks registered to a single proprietor, a new mark with a feature prominent in that series leads to a perfectly natural assumption by a consumer that the new mark, too, emanates from the same proprietor. It is only where the marks in a series, whether registered or not, and which have a common feature are owned not by a single entity but by several that a defendant's application for a new mark with that common feature acquires any legitimacy..."

5

"26. There is no doubt in my mind that the Defendants' XYLOX family of marks are confusingly and deceptively similar to the Plaintiff's LOX family of marks." (emphasis supplied)

Relevant Judicial Decisions

❖ ***Modi-Mundipharma Pvt. Limited Vs. Speciality Meditech Pvt. Ltd. and Ors. [2025:DHC :5039-DB]; Delhi High Court; Division Bench***

*“25.11.9. It is a fact that the Trade Marks Act does not expressly recognise the concept of a family of marks. However, the concept, though judicially created and developed, is merely a manifestation of the principles contained in the Trade Marks Act. **When an entity is the proprietor of a number of registered trademarks containing a common prefix or suffix, or a common first or second word, any other mark by a third party which would contain the same first or second word, if used for similar goods or service, could result in likelihood of confusion within the meaning of Section 29(2) of the Trade Marks Act.** It is this concept which is elliptically described as the "family of marks" concept. Thus, the concept of a family of marks is not alien to the Trade Marks Act, but merely a recognition of the principles that underlie the statute.*

6

25.11.10. As already noted, the "family of marks" concept when applied to the present case, clearly indicates that the appellant is the registered proprietor of a family of marks of which CONTIN is a common suffix. The use of any other mark by a third party, with the same suffix, for pharmaceutical preparation, could, therefore, lead to confusion or a presumption of association within the meaning of Section 29(2) of the Trade Marks Act. As the registered proprietor of the CONTIN family of marks, the appellant would be entitled to injunct any such mark from being used.” (emphasis supplied)

Relevant Judicial Decisions

- ❖ *Modi-Mundipharma Pvt. Limited Vs. Speciality Meditech Pvt. Ltd. and Ors. [2025:DHC :5039-DB]; Delhi High Court; Division Bench*

*“25.11.11. That said, however, the principle of a "family of marks" cannot extend to grant of an injunction, in favour of the appellant and against all third parties, from using any mark of which CONTIN is a part, for pharmaceutical preparations or otherwise. **Though the principle of a family of marks is well recognised, the Court cannot, without actual facts before it, presume that every mark of which CONTIN is a part, and which may deal with pharmaceutical preparations, is necessarily infringing in nature. One may, for example, hypothetically, envisage the use of a mark with the word "CONTINUOUS" or "CONTINGENT" which, hypothetically, may not be infringing even if it is used for pharmaceutical preparations, and contains "CONTIN"...**”*

7

“25.12. We, therefore, uphold the decision of the learned Single Judge insofar as it refuses to grant injunction to the appellant, as sought, against any third party using CONTIN as a prefix or as a suffix of any mark under which pharmaceutical preparations are manufactured or cleared.” (emphasis supplied)

Relevant Judicial Decisions

❖ ***Mankind Pharma Ltd. Vs. Ram Kumar M/S Dr. Kumars Pharmaceuticals [2025 DHC 7142]; Delhi High Court; Single Judge Bench***

“21. The Petitioner has several Trade Mark registrations granted in its favour that use the word ‘KIND’ as a suffix. Hence, the Petitioner has developed a Family of Marks with the word ‘KIND’ as an essential part of the Petitioner’s Trade Marks. In Mankind Pharma Ltd. v. Cadila Pharmaceuticals Ltd. 2015 SCC OnLine Del 6914 , a Coordinate Bench of this Court has observed that the word ‘KIND’ has no relation to sale of the Pharmaceutical products and the Petitioner having established its first user of the word ‘KIND’ in the pharmaceutical market is entitled to a higher protection for the word ‘KIND’.”

“22. Although the word ‘KIND’ is not related to the pharmaceutical products being sold by the Petitioner, but due to its continuous and extensive usage, the said mark has come to be exclusively associated with the Petitioner, and this would entitle the Petitioner to a higher protection for the KIND Family of Marks. Merely changing the first part of the Impugned Trade Mark and using the distinguishing family name or characteristic is likely to cause confusion in the market.” (emphasis supplied)

Relevant Judicial Decisions

❖ *Wow Momo Foods Private Limited Vs. Wow Burger & Anr [2025:DHC :9320-DB]; Delhi High Court; Division Bench*

"49. Where, therefore, an entity has a family of registered marks in all of which the dominant feature is common, it is entitled to protection against use of the same dominant feature by another person in another mark. This is because the use of the common dominant feature in the family of the marks results in that dominant feature conveying an impression, to the consumer of average intelligence and imperfect recollection, that the products come from the same stable. The aspect of likelihood of confusion is, thereby, exacerbated.

50. In the present case, the appellant has a family of marks of which WOW is the common initial prefix. The prefix WOW has, therefore, acquired distinctiveness in view of the existing family of marks. The use of any mark, by a third person, by combining the prefix WOW with the name of a food item, would clearly result in confusion and conveying an impression to the average consumer, that the mark is yet another in the family of the marks belonging to the appellant. This is yet another reason why the respondent cannot be permitted to use the mark WOW BURGER." (emphasis supplied)

Conclusion

❖ Sections 17, 28 and 29 of the Trade Marks Act, 1999 confer exclusive rights in a registered trade mark and provide remedies against infringement, while Section 17 clarifies that such rights attach to the mark as registered and do not separately extend to its individual parts. The Act does not expressly address whether a common element appearing across multiple marks of a proprietor can itself form the basis of an infringement claim.

❖ In *McDonald's Corporation*, the Court declined to recognize exclusivity in the common element “MAC”, holding that rights could not be asserted in the shared element alone. In contrast, in *Neon Laboratories*, *Mankind Pharma*, and *Wow Momo Foods*, the courts recognized that a common element used consistently across a series of marks may acquire distinctiveness, and its use by another may give rise to likelihood of confusion. The Division Bench in *Modi-Mundipharma* clarified that the family of marks concept is rooted in the statutory test of likelihood of confusion, but does not confer an absolute right to restrain every use of the common element.

❖ These decisions indicate that the ability to restrain use of a common element does not arise merely from its presence in multiple registered marks, but depends on whether such element has, through use, come to indicate a single trade source within the meaning of the infringement provisions.

THANK YOU!
Questions?

Adyanshi Kashyap
Associate

11

© ALG India Law Offices LLP, 2026.

Disclaimer: Views, opinions, and interpretations are solely those of the presenters, not of the firm (ALG India Law Offices LLP) nor reflective thereof.

This presentation hosted at: https://www.algindia.com/wp-content/uploads/2026/03/LIS_Adyanshi-Kashyap_March-2-1.pdf