Visual and Phonetic Similarity of Trademarks: Study Of Judicial Trends in India

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***Abstract*—In the modern global marketplace, trademarks play a pivotal role in establishing a brand's identity, protecting consumer trust, and ensuring fair competition. However, the increasing commercial value of trademarks has led to frequent cases of misuse and infringement, particularly through the creation of deceptively similar marks. This study critically examines the judicial interpretation of visual and phonetic similarity in trademark disputes under Indian law, with comparative insights from U.S. jurisprudence. It traces the historical evolution of trademark protection in India, analyses the legal framework under the Trade Marks Act, 1999, and explores the concept of deceptive similarity as defined under Section 2(1)(h). Through a detailed study of landmark judgments—Amritdhara Pharmacy v. Satya Deo Gupta, Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd., Mahindra & Mahindra Ltd. v. Mahendra & Mahendra Paper Mills Ltd., and others—the research identifies the judicial principles used to determine similarity based on overall impression, phonetic resemblance, and consumer perception. The study concludes that Indian courts have progressively evolved a balanced approach, emphasising the perspective of an average consumer with imperfect recollection while safeguarding both business interests and public interest. The paper also highlights defences such as fair use and parody, and contrasts the Indian position with U.S. standards of "likelihood of confusion."**

***Index Terms*—Trademark Law; Deceptive Similarity; Phonetic Similarity; Visual Similarity; Trade Marks Act 1999; Judicial Trends; Infringement; Passing Off; Likelihood of Confusion; Intellectual Property Rights; Consumer Perception.**

I. INTRODUCTION

To develop the identity in the market and in the minds of the consumers, it is of paramount importance for every business venture to develop its own brand value in today's world of globalization and high pace of commerce. Thus trademark plays a pivotal role in the formation of such identity and helps in revenue generation because if a product is good and has a trademark, then nothing can stop it from ruling the market.

But it is to be noted that where a trademark furthers a successful trade, it also becomes highly vulnerable to being misused or infringed. One such mode of infringement is by way of creating a trademark which is "deceptively similar" to the pre-existing trademark in order to confuse the consumers and in case the goodwill of the already established trademark. This not only puts a question to the reputation of the original trademark holder but also results in economic loss.

Deceptive similarity has been defined as "two marks, when placed side by side, may exhibit many and differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same marks s that with which he was acquainted.

II. AIM OF THE STUDY

This study aims to discuss the concept of visual and phonetic similarity of trademarks. We shall also discuss the origin, history and development of trademark in India.

III. MEANING AND SCOPE OF DECEPTIVE SIMILARITY

When a person gets his trademark registered, he acquires valuable rights to the use of the trademark in connection with the goods in respect of which it is registered. And, in the event of any invasion of his rights by any other person using a mark which is identical or deceptively similar to his trademark, he could protect his mark by an action for infringement and obtain an injunction. Thus, the basis for[1] protecting the trademark is that no mark shall be registered which is likely to deceive the public or which creates confusion in the minds of the public concerning the 'origin' or source of goods or services. The expression 'deceptive similarity' as enshrined under section 2(1)(h) of the Trademarks Act, 1999 says that the similarity or resemblance must be such as it would be likely to deceive or cause confusion.[2] To conclude whether one mark is deceptively similar to another, the broad and essential features of the two marks are to be considered. They are not required to be placed side by side to determine whether there are any differences in their design.[3] The test of comparison of the marks side by side is not a sound one[4] because the question is not whether

IV. DECEPTIVE SIMILARITY IN INDIA

Traditionally, it was held that there can be an infringement of a trademark only when there is a likelihood of confusion as to the origin of the trademark.[5] The object of affording protection to a mark, which has acquired a degree of distinctiveness, is to protect the goodwill of the trader, and at the same time, assure the public and customers about the consistency of the nature of services or products they seek.[6] If there is no similarity of goods and services, then the question of likelihood of confusion does not arise. It is not sufficient if one mark merely leads to a likelihood of recall of the other mark.[7]

Whenever two marks are identical, there is a prima facie case of infringement due to confusion. But there are situations where the marks are not identical but are nearly similar. In those cases, the plaintiff has to establish that the mark is identical enough to cause confusion in the minds of the buyer and hence would be misleading. There needs to be an element of resemblance, so strong that causes a deception in the minds of the buyers. The ultimate judge of similarity

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[1] Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories, AIR 1965 SC 980; See also, American Home Products v. Mac Laboratories, AIR 1986 SC 137; National Bell Co. v. Metal Goods Mfg. Co., AIR 1971 SC 898; M/s Avis International Ltd. v. M/s Avi Footwear Industries and another, AIR 1991 Delhi 22 and Ruston and Hornby Ltd. v. Zamindara Engineering Co., AIR 1970 SC 1649.

[2] A.V. Rajadurai Nadar v. P. Ayya Nadar, AIR 1977 Mad 237, any conclusion reasonable and proper can be arrived at by a meticulous examination of each detail and then making a comparison. At the same time, what readily strikes the eye must also be conclusive. But, when one looks at it, especially from the standpoint of a person who is most likely to use a particular brand of matches, if it appears that the difference is prominent and it cannot lead
to any similarity or a deceptive similarity or confusion, then there could be no objection to the two different trademarks.

[3] Man Mohan Sharma v. Manjit Singh, FAO No.4739 of 2016(O&M); See also, Parle Products (P) Ltd. v. J.P. and Co., AIR 1972 SC 1359; Lily ICOS LLC v. Maiden Pharmaceuticals Lim, 2009 (39) PTC 666; Kirorimal Kashiram Marketing & Agencies Private Limtied v. Shree Sita Chawal Udyog Mill Tolly Vill., 2010(44) PTC 293 (Delhi) and DB Ruston and Hornby Ltd. v. Zamindara Engineering Co., AIR 1970 SC 1649.

[4] The Singer Manufacturing Co. v. The Registrar of Trade Marks, AIR 1965 Cal 417; See also, Eno v. Dunn, (1890) 15 AC 252, deception is not proved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, tor orders are not placed, or are often not placed, under such conditions; Firm Koonerji Becharilal v. Firm Adam Hazi Pirmohomed Esabh , AIR 1944 Sind 21.

[5] Kearly's Law on Trademarks and Trade Names, Sweet and Maxwell, 2001, p. 360.

[6] Evergreen Sweet House v. Ever Green and Others (2008) 38 PTC 325 (Del), p. 330.

[7] Baywatch Production Co Inc v The Home Video Channel (1997) FSR 22.

is the consumers who would be misled into distinguishing between two marks and hence failing to compare the two.

A deceptive mark can be said to be such a mark that is likely to cause confusion in the minds of the buyer. The most important deciding factor while taking ―Deceptive Marks‖ into account is that the general public with average intelligence is confused so as to the source of the product. The most important test is to look for an overall similarity. The expression ―likely to deceive‟ is a question largely one of first impression. It is not necessary to prove intention. It is sufficient if the Court comes to the conclusion it is likely to deceive and that conclusion must be based partly on evidence and partly upon the appeal to the eye of the judge.[8] Deception can arise with regard to[9] :

a) Deception as to goods
b) Deception as to trade origin
c) Deception as to trade connection

Thus, it can be said that a trademark serves to identify the source of goods and as an indicator of the origin of goods. A trademark also guarantees a consumer of the consistent quality of the products upon which it is used. These principles have been enshrined in the modern definition of a trademark. The Indian Act defines a trade mark in section 2(1)(zb) and states that a trademark means a mark:

(a) Capable of being represented graphically;
(b) Capable of distinguishing the goods or services of one person from those of others; and
(c) Used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services and some person having the right, whether as a proprietor or a permitted user, to use the mark.

Deceptive similarity has been defined as "Two marks, when placed side by side, may exhibit many differences, yet the main idea left on the mind by both may be the same. A person acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with the second mark, into a belief that he was dealing with goods which bore the same marks as that with which he was acquainted.[10] Section 2(h) of the Trade Mark Act, 1999 defines Deceptively Similar as "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 or cause confusion." The wording of the above section is also similar to Section 2(d) of the repealed Act of 1958. In the present Act, the Deceptively Similar‖ and its variants have been used in several sections and form different grounds and criteria to be applied in the trade mark law, e.g. S.11, S.16 (1), S.29, S.30, S.34, S.75, S.102; though they construe the same meaning and effect. The act does mention that what will be the - Deceptively Similar, but does not lay down any particulars to decide it.[11]

Over the years, through case law, the courts have developed principles and factors to be applied to determine the question of deceptive similarity between marks. The criteria for a court of law or tribunal are concerned with the following factors at the time of determining deceptive similarity and likelihood of confusion between marks in question that have evolved over the years through precedents are as follows:

(i) The nature of the marks, whether the marks are words, labels or composite marks;
(ii) The degree of resemblance between the marks, phonetic or visual or similarity in idea;
(iii) The nature of goods or services in respect of which they are used as trademarks;
(iv) The similarity in the nature, character and performance of the goods/services of the rival traders/service providers;
(v) The class of purchasers/customers who are likely to buy the goods or avail the services, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods;
(vi) The mode of purchasing in the trading channels that the goods/services traverse in the course of business or placing an order for the goods; The above

[8] H.C Dixon & Sons Ltd. v. Geo Rihardson & Co. Ltd 50 RPC 36, p 374.

[9] Vikram Stores v. S.N. Perfumery Works, 2008 AIHC 494 (Guj)

[10] David Kitchin, David Llewelyn, James Mellor, Richard Meade, Thomas Moody-Stuart & David Keelinf, "Kerly's Law of Trade Marks and Trade Names", 14th ed., Sweet and Maxwell, London,p.456.

[11] https://poseidon01.ssrn.com/delivery.php, last accessed on 10th March 2017

factors are not exhaustive but only illustrative. It is not necessary that all the factors are considered while determining the similarity of marks. Where a totality of circumstances indicates deceptive similarity of the trademarks, it may be sufficient. Registration of a mark, which is merely a reproduction or imitation of a well-known trademark, should not be allowed. Section 11(2)(b)[12] seeks to provide that where the goods or services are not similar and the use of a trademark identical with or similar to an earlier trademark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trademark, shall not be registered.[13] With respect to section 11 of the Act, the most important criterion is that there should be similarity with likelihood of confusion on the part of the public. This sub-section is directed specifically to cases where the proposed mark is identical with or similar to the earlier trademark, but where the goods and services are not similar.

Further, the reputation of an earlier mark is an essential requisite in the context of subsection (2), which is not called for in respect of subsection (1).[14]

The provision of section 11(2) has to be construed in the broader context of the law of unfair competition. The unauthorised use of a trademark for a competing product not only constitutes undue exploitation of the trademark owner‘s goodwill, but also deceives the public as to the commercial origin of the product (and hence its characteristics).[15] Section 11 lays down that the existence of a likelihood of confusion on the part of the public, which, in other words, means perception of the marks in the minds of the average consumer of the type of goods or services in question, plays a decisive role in the matter.[16]

In the case of Montblanc Simplo-GMBH v New Delhi Stationery Mart[17] , Delhi High Court held that since both the marks are used in respect to identical goods, this court then needs to determine whether the defendant's adoption is likely to cause confusion in the minds of the public. It is not necessary to prove actual confusion or damage; it is sufficient if the likelihood of confusion is established.

In the case of SBL Ltd. v. Himalaya Drug Co.[18] , the Delhi High Court quoted Halsbury‘s Laws of England[19]on establishing - likelihood of confusion of deception‟.

In this case, two factual elements were laid down:

a) That a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons.

b) That members of that class will mistakenly infer from the defendant‘s use of a name, mark or other feature which is the same or sufficiently similar that the defendant‘s goods or business are from the same source or are connected.

In Delhi, Lakme Ltd vs. Subhash Trading[20], the plaintiff was selling cosmetic products under the registered Trade Mark ―Lakme. Defendant was using the Trade Mark- LikeMe for the same class of products. It was held that there was a striking resemblance between the two wards. The two words are also phonetically similar. There is every possibility of deception and confusion being caused in the mind of the prospective buyer of the plaintiff‘s products. The injunction was made permanent. In M/S Mahashian Di Hatti Ltd. Vs. MR. Raj Niwas, Proprietor of MHS Masalay[21], judgment pronounced by Delhi HC in 2011 – The plaintiff company engaged in the business of manufacturing and selling spices and condiments, which are being sold under its registered logo(comprising ―MDH‖ within three hexagon device on red colour background)and is registered since 31st may 1991 and the plaintiff company use its logo throughout in India and also claim for throughout the world. The plaintiff company have tremendous goodwill and reputation not only in India but worldwide in respect of the goods sold under its registered trademark. The defendant has been using the logo- MHS within a hexagon device with a red colour background on the

[12] The Trademark Act, 1999 S. 11(2)(b)

[13] K.C Kailasam, RamuVedaraman Law of Trademarks and Geographical Indications, 1st Edition, p.170

[14] Ibid. at p. 196.

[15] Ibid at p. 199

[16] SABEL v. Puma, Rudolph Dassler Sport, [1998] R.P.C 199, para. 16 & 17

[17] (2008) 38 PTC 59 (Del), p. 68-69

[18] AIR 1998 Del 126.

[19] Halsbury‘s Laws of England, 4 th edition, Vol. 48, p. 163.

[20] 1996 PTC (16)567

[21] 2011 (46) PTC 343 (Del)

carton is alleged to be similar to those being used by the plaintiff company. The plaintiff company has accordingly sought an injunction restraining the defendant from using the infringing logo, MHS, or any other trademark identical with or deceptively similar to the plaintiff‘s registered trademark-MDH logo. The plaintiff was also awarded punitive damages amounting to Rs. 1 Lakh against the defendant.

V. SUPREME COURT CASES

1. CORN PRODUCTS REFINING CO.V. SHANGRILA FOOD PRODUCTS LTD.[22]

Facts of the Case:

The Respondent is a manufacturer of Biscuits. It made an application for the registration of Mark-Gluvita. Registrar ordered for publication before acceptance. Appellant opposed it; it‘s a USA-based corporation already registered trademark - Glucovita in India.

High Court Single Bench: J. Desai

1. He agreed that the Appellant has acquired a reputation among the general public.
2. He found the mark to be deceptively similar and hence set aside the order of the

Deputy Registrar.

Division Bench:

1. Division bench differed from the point of view that the Appellant has acquired a reputation among the general public. High Court‘s interpretation of the word in the trade led to the conclusion that the Appellant did not require a reputation among the public but among traders only. So there is no chance of confusion.
2. Gluco and Vita are commonly used prefixes and suffixes, not only associated with the appellant.
3. Accordingly, set aside the order of the Single Bench.

Supreme Court:

1. The High Court took a narrower view regarding the in the trade. It committed an error while deciding that the word only means among the trade. But the actual position in the instant case is that it also means the public who purchase these products. Hence, the Appellant has acquired a considerable reputation among the general public.
2. Hon‘ble Court took the view of the Kely and a different authority and concluded that both the markers are deceptively similar.
3. To decide upon the similarity between both the marks Apex Court also considered the test:

(a) Mark should be looked at as a whole.
(b) Average Intelligence.
(c) Imperfect recollection.

2. AMRITDHARA PHARMACY V. SATYADEO GUPTA[23]

In Amritdhara v. Satya Deo[24] The Supreme Court observed that the ordinary purchaser would go more by the overall structure and phonetic similarity and the nature of medicine he has previously purchased or has been told about, or about which he has otherwise learnt and which he wants to purchase. The words- Amritdhara‟ were held deceptively similar through registration of – Lakshmandhara” and were allowed based on an honest concurrent user.

Court on the following grounds Came to this Conclusion

I. The average consumer would perceive the plaintiff's mark in its overall effect as representing the badge of origin.
II. The average consumer normally perceived a mark as a whole and did not proceed to analyse its various details. Where the proprietor used his mark in combination with another mark in order to create a composite badge of origin, the average consumer would normally perceive the whole and not proceed to analyse its various details.
III. There was a likelihood of confusion.
IV. The claim for passing off was upheld, and the use of the Mark Lakshmandhara was limited to Uttar Pradesh only based on honest concurrent use. In this again, the test of Average Intelligence and Imperfect Recollection was taken into consideration and was established as a test to judge Deceptive Similarity.

3. SM DYECHEM LTD. V. CADBURY (INDIA) LTD.[25]

In the instant case Honourable Supreme Court emphasised the dissimilar aspect as a test, then the

[22] AIR 1960 SC 142.

[23] AIR1963 SC 449.

[24] Ibid.

[25] (2000) 5 SCC573

similar aspect as which was taken as a test in the earlier case.

Facts of the Case:
Plaintiff started business in 1988 with four products, like potato chips, potato wafers, and corn-pops. In January 1989, it started using the trade mark PIKNIK. It applied for registration on 17.2.198. Respondent was found using the mark 'PICNIC' for chocolates. The appellant filed the suit based on alleged infringement of trade mark and passing off, and for a temporary injunction. The Trial Court held in favour of the appellant and held that the two are Deceptively Similar Marks. On appeal, the High Court reversed the trial court and held that the two marks are different in their appearance and word composition. The Supreme Court held the view of the High Court and chose to take the following grounds to decide the case.
Principles laid down:
1. Whether there was any special aspect of the common feature that had been copied.
2. Mode in which the parts were put together differently, i.e. whether dissimilarity of the part or parts was enough to make the product dissimilar.
3. Whether, when there were common elements, one should not pay more regard to parts which were not common, while at the same time not disregarding the common parts.
4. CADILA HEALTH CARE LTD V. CADILA PHARMACEUTICAL LTD.[26]
This case is the landmark decision that holds the ground regarding the test to decide upon what constitutes Deceptively Similar. The Supreme Court has overruled the Cadbury case in this judgment.
Facts of the Case:
Appellant and Respondent in the instant case took over the assets of the Cadila group with the condition that both can use the name Cadila for their corporate transaction. The whole dispute arises when the Respondent apply for the Registration of the trademark "Falcitab" as a brand name for the medicine. The objection was raised by the appellant, who had already applied for the brand name "Falcigo", and permission was granted. The medicine was to be used for the treatment of cerebral malaria, commonly known as 'Falcipharum'. The appellant contended that the names used by the respondent are similar to those used by the appellant. Hence appellant applied for the interim injunction. Extra Assistant Judge, Vadodara, dismissed the interim injunction application. The same was also rejected by the High Court. Against this order, the Appellant moved to the Supreme Court.
Decision of the Supreme Court:
The Hon‘ble Court analysed the whole situation and, without going into the merits of the case, laid down certain principles which should be taken into consideration while deciding the Deceptive Similarity. The Apex Court referred the matter to the district court to be decided on the given principle.
Principles led to decide upon the “Deceptively Similar”.
1. The Nature of the Mark, i.e. whether the marks are word marks or label marks or composite marks that include both word and label works.
2. Degree of resemblance between marks phonetically similar and hence in idea.
3. The nature of goods in respect of which they are used as trade mark.
4. The similarity in the nature, character and performance of the goods of the rival traders.
5. The class of purchaser who are likely to buy the goods bearing the marks they require, based on their education, intelligence and a degree of care they are likely to exercise in purchasing and /or using the goods.
6. The mood of purchasing the goods or placing orders for the goods.
7. Any other surrounding circumstances which may be relevant to the extent of the dissimilarity between competing marks.
5. MAHENDRA AND MAHENDRA PAPER MILLS LTD. V. MAHINDRA AND MAHINDRA LTD.[27]
The issue which came before the Supreme Court decided upon was whether the Mahendra and Mahendra and, Mahindra and Mahindra are deceptively similar or not.
Mahindra and Mahindra, the respondent, is a company under the Companies Act, 1956. The Mahindra and Mahindra is not a single company but represents different companies under its head. It has

[26] 30 4 (2001) 5 SCC 73

[27] AIR 2002 SC 117

acquired considerable goodwill, reputation and has a large amount of turnover. The appellant contended that it‘s not violating any of the law as it is using it honestly. They also contended that they are better known as Mahendrabhai in the corporate sector; also, they paid the income tax in their name and have a reputation in a separate sector of business. They only came to be known as Mahendra and Mahendra after they started the firm with their brother.

The respondent has also drawn notice regarding it to the SEBI and other authorities. The plaint and appeal were both rejected by the District Court and Bombay High Court, respectively. Supreme Court, relying upon the criteria given in Cadila Case, came to the conclusion that both the marks are Deceptively Similar and refused to interfere with the decision of the Bombay High Court.

6. SCHERING CORPORATION AND ORS. V. GETWELL LIFE SCIENCES INDIA PVT. LTD.[28]

In the instant case, Plaintiff filed an application restraining defendant from using the mark Temoget in respect of pharmaceutical products Temozolomide on the ground that the mark Temoget is deceptively similar to Plaintiff's registered trademarks – Temodal ―Temodar to the plaintiff in respect of the same pharmaceutical product used to cure the Brain Cancer.

The Supreme Court held that

1. The mark- Temodal /Temodar and Temoget are not phonetically and ideologically similar.
2. These marks are Portmanteaus and can be used for the trademark.
3. The price range of both products is different; also, the product is only given to the practitioners who are highly qualified and well-known about the product in the present era. Hence, there is no chance of confusion. The Supreme Court, in light of the open market and globalization took the view that the Public

Interest is paramount and stated:

If a mark in respect of a drug is associated with a worldwide reputation, it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, one note of caution must be expressed. Multinational corporations, which have no intention of coming to India or introducing their product in India, should not be allowed to throttle an Indian Company by not permitting it to sell a product in India, if the Indian Company has genuinely adopted the mark and developed the product and is first in the market. Thus, the ultimate test should be who is first in the market."

DECEPTIVE SIMILARITY IN THE USA

If a party owns the rights to a particular trademark, that party can sue subsequent parties for trademark infringement. As per the US Trademark Act of 1946, Title VI- Remedies § 32 (15 U.S.C. § 1114). Remedies; infringement; innocent infringers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colourable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on origin connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.

Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive. As used in this paragraph, the term ―any person‖ includes the United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, or other persons acting for the United States and with the authorization and consent of the United States, and any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity.

The United States, all agencies and instrumentalities thereof, and all individuals, firms, corporations, other persons acting for the United States and with the

[28] 2008(37) PTC487(Del)

authorization and consent of the United States, and any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any non-governmental entity. In the case of Polaroid Corp. v. Polarad Elect. Corp.[29]It was held to judge the deceptive similarity, the standard is "likelihood of confusion." To be more specific, the use of a trademark in connection with the sale of a good constitutes infringement if it is likely to cause consumer confusion as to the source of those goods or as to the sponsorship or approval of such goods. In deciding whether consumers are likely to be confused, the courts will typically look to many factors, including:

(1) the strength of the mark;
(2) the proximity of the goods;
(3) the similarity of the marks;
(4) evidence of actual confusion;
(5) the similarity of marketing channels used;
(6) the degree of caution exercised by the typical purchaser;
(7) the defendant's intent.

So, for example, the use of an identical mark on the same product would clearly constitute infringement. If I manufacture and sell computers using the mark "Apple," my use of that mark will likely cause confusion among consumers, since they may be misled into thinking that the computers are made by Apple Computer, Inc. Using a very similar mark on the same product may also give rise to a claim of infringement, if the marks are close enough in sound, appearance, or meaning to confuse. So, for example, "Applet" computers may be off-limits; perhaps also "Apricot." On the other end of the spectrum, using the same term on a completely unrelated product will not likely give rise to an infringement claim. Thus, Apple Computer and Apple Records can peacefully co-exist, since consumers are not likely to think that the computers are being made by the record company, or vice versa. Between the two ends of the spectrum lie many close cases, in which the courts will apply the factors listed above. So, for example, where the marks are similar and they are also similar, it will be difficult to determine whether consumer confusion is likely.

[29] 287 F.2d 492 (2d Cir. 1961)

In the case of AMF Inc. v. Sleekcraft Boats[30]The owners of the mark "Slickcraft" used the mark in connection with the sale of boats used for general family recreation. They brought an infringement action against a company that used the mark "Sleekcraft" in connection with the sale of high-speed performance boats. Because the two types of boats served substantially different markets, the court concluded that the products were related but not identical. However, after examining many of the factors listed above, the court concluded that the use of Sleekcraft was likely to cause confusion among consumers.

VI. DEFENCES AGAINST DECEPTION AND DILUTION

Defendants in a trademark infringement or dilution claim can assert basically two types of affirmative defense: fair use or parody. Fair use occurs when a descriptive mark is used in good faith for its primary, rather than secondary, meaning, and no consumer confusion is likely to result. So, for example, a cereal manufacturer may be able to describe its cereal as consisting of "all bran," without infringing upon Kellogg's rights in the mark "All Bran." Such a use is purely descriptive and does not invoke the secondary meaning of the mark. Similarly, in one case, a court held that the defendant's use of "fish fry" to describe a batter coating for fish was fair use and did not infringe upon the plaintiff's mark "Fish-Fri." (Zatarain's, Inc. v. Oak Grove Smokehouse, Inc[31]). Such uses are privileged because they use the terms only in their purely descriptive sense. Some courts have recognised a somewhat different, but closely related, fair-use defence, called nominative use. Nominative use occurs when the use of a term is necessary for purposes of identifying another producer's product, not the user's own product.

For example, in the case of the newspaper USA Today, it ran a telephone poll, asking its readers to vote for their favourite member of the music group New Kids on the Block. The New Kids on the Block sued USA Today for trademark infringement. The court held that the use of the trademark "New Kids

[30] 599 F.2d 341 (9th Cir. 1979)
[31] 698 F.2d 786 (5th Cir. 1983)

on the Block" was a privileged nominative use because:

(1) the group was not readily identifiable without using the mark;

(2) USA Today used only so much of the mark as reasonably necessary to identify it; and

(3) There was no suggestion of endorsement or sponsorship by the group. The basic idea is that the use of a trademark is sometimes necessary to identify and talk about another party's products and services. When the above conditions are met, such a use will be privileged. (New Kids on the Block v. News America Publishing, Inc.,[32]

Finally, certain parodies of trademarks may be permissible if they are not too directly tied to commercial use. The basic idea here is that artistic and editorial parodies of trademarks serve a valuable critical function, and that this critical function is entitled to some degree of First Amendment protection. The courts have adopted different ways of incorporating such First Amendment interests into the analysis. For example, some courts have applied the general "likelihood of confusion" analysis, using the First Amendment as a factor in the analysis. Other courts have expressly balanced First Amendment considerations against the degree of likely confusion. Still other courts have held that the First Amendment effectively trumps trademark law, under certain circumstances. In general, however, the courts appear to be more sympathetic to the extent that parodies are less commercial, and less sympathetic to the extent that parodies involve commercial use of the mark. Successful plaintiffs are entitled to a wide range of remedies under federal law. Such plaintiffs are routinely awarded injunctions against further infringing or diluting use of the trademark. In trademark infringement suits, monetary relief may also be available, including:

(1) defendant's profits,

(2) damages sustained by the plaintiff, and

(3) the costs of the action.

Damages may be trebled upon showing of bad faith. In trademark dilution suits, however, damages are available only if the defendant willfully traded on the plaintiff's goodwill in using the mark. Otherwise, plaintiffs in a dilution action are limited to injunctive relief.

[32] 971 F.2d 302 (9th Cir. 1992)

VII. CONCLUSION

It is clear that the primary function of the trademark is to indicate the source or origin of goods or services. But this function is guided by two principles. Firstly, the mark should meet all the necessary conditions as laid down under the Trademarks Act, 1999 i.e., it should be distinctive. Secondly, it should not be of such nature as to deceive or confuse the public regarding the source or origin of goods or services. These two conditions must be fulfilled before deciding whether a mark fulfils the criteria of granting protection or not. Deceptive Similarity as a ground for refusal of trademark registration is the most important feature of the Act, along with other supplementary provisions covered under the purview of Deceptive Similarity. As already discussed, proof of intention to show Deceptive Similarity is irrelevant. What amounts to Deceptive Similarity is a question of fact and depends upon facts and circumstances of each case. Indian Judiciary as played a very important role in determining whether a particular mark will deceive the public or not. In this paper, the Judicial Endeavour (India as well Foreign) has been discussed very thoroughly to determine the features of Deceptive Similarity and the relevant criteria to determine what amounts to Deceptive Similarity in a particular case.

To establish infringement about a registered trademark, it is necessary to establish that the infringing mark is identical or deceptively similar to the registered mark and no further proof is required. In the case of a passing off action, proving that the marks are identical or deceptively similar alone is not sufficient. The use of the mark should be likely to deceive or cause confusion. Further, in a passing off action, it is necessary to prove that the use of the trademark by the defendant is likely to cause injury or damage to the plaintiff's goodwill, whereas, in an infringement suit, the use of the mark by the defendant need not cause any injury to the plaintiff. Thus, it can be concluded that a proprietor cannot use the trademark which is of another proprietor, he cannot adopt/use a mark which causes or is likely to cause confusion or deception in the minds of public, he cannot use a trademark of a Company which is a well-known trademark, and also, he cannot through the use of mark indicate that particular goods

originated from him which is actually originating from another person having well established reputation and goodwill.

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