

## *IP Laws Declared by the Supreme Court*

# Trademark Law Declared by the Supreme Court of India in Twenty-First Century (2000–2009) — I

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The Parliament of India makes, amends, and unmakes law. The Supreme Court of India (*hereinafter*, the Supreme Court), under Article 141 of the Constitution of India, declares the law and makes and unmakes the law. These constitutional powers of two branches are related but separate. The Supreme Court in the first decade of 21<sup>st</sup> century has delivered 23 decisions on the trademark law. On an average, the Supreme Court has decided 2.3 (point three) trademark cases in a year; or one trademark case in 158.82 (point eight two) days or in .43 (point four three) years. A review of reported 21<sup>st</sup> century decisions reveals that the Court has: (i) declared trademark law in 17 decisions; (ii) not only interpreted the provisions of the statutes but has also constructed them; (iii) not declared anything on the constitutionality of the trademark statutes as no such question of constitutionality was brought before it; (iv) delivered all the decisions unanimously as no dissenting or concurring judgment is reported; and (v) decided maximum number of cases by Division Bench (21) and remaining 2 cases by Full Bench. It is also observed that no sitting or acting Chief Justices of India was on the Bench in any of the cases. Paper proceeds with the same argument and method as developed in the first four papers on patent law, copyright law, design law and trademark law in twentieth-century published under the theme '*IP Laws Declared by the Supreme Court*'. This Paper seeks to cull out the principles of trademark law as declared by the Supreme Court in the first decade of the twenty-first century.

**Keywords:** Trademark, Supreme Court of India, Law Declared, Article 141, The Constitution of India, The Trade Marks Act, 1940, The Trade and Merchandise Marks Act, 1958, The Trade Marks Act, 1999, Decisions, Constructed Meaning, Principles, Bench, Unanimous, Concurring, Dissenting, Interpretation-Construction, Unwary Purchaser, Trademark Trafficking, Trademark Infringement, Passing Off Action, Remedy, Twenty-first Century

By virtue of Article 141 of the Constitution of India, the Supreme Court of India (*hereinafter*, the Supreme Court) declares the law and makes and unmakes the law while deciding cases through the process of judicial review and interpretation-construction. This Paper is in continuation to the papers '*Patent Law Declared by the Supreme Court of India*',<sup>1</sup> '*Copyright Law Declared by the Supreme Court of India*',<sup>2</sup> '*Design Law Declared by the Supreme Court of India*'<sup>3</sup> and '*Trademark Law Declared by the Supreme Court of India in Twentieth-Century*'<sup>4</sup> published in the *Journal of Intellectual Property Rights (JIPR)* under the theme '*IP Laws Declared by the Supreme Court*'. Since most number of reported intellectual property (*hereinafter*, IP) decisions are on trademark law, so the decisions will be covered decadewise. This Paper seeks to cull out the principle of trademark law as declared by the Supreme Court of India (*hereinafter*, the Supreme Court) in its decisions<sup>5</sup> from 2000 to 2009 (first decade of twenty-

first century). In this decade, the Trade Marks Act, 1999<sup>6</sup> (*hereinafter*, the Act of 1999) came into effect from 15 September 2003,<sup>7</sup> repealing the Trade and Merchandise Marks Act, 1958.<sup>8</sup> In this decade, the Supreme Court has delivered a total of 23 reported decisions on the Trademarks Law. Of these 23 decisions, 2 are Full Bench and remainings are by Divisions Bench. No Single or Constitution Bench decision is reported. Two reported Full Bench decisions are from each half of the decade. A total of 27 judges were on the bench in these 23 decisions to decide the cases dealing with trademark law. Justice S B Sinha authored the maximum number of decisions. He was on the bench in 7 cases (all Division Bench) and authored all the 7 judgments. Justices M Jagannadha Rao, Ruma Pal, and S N Variava were on the bench in two cases and authored the judgment in both the cases. Justice Dr Arijit Pasayat was on the bench in 3 cases and authored all the judgments. S N Variava who being on the bench in 2 cases, authored 2 judgments which include 1 Full Bench decision. Justices B N Kirpal (Full

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Bench), R C Lahoti, P K Balasubramanian, and Tarun Chatterjee were on the bench in 1 case each and authored the judgment. Justice H S Bedi was on the bench in 2 cases and authored 1 judgment. Justice S H Kapadia was on the bench in 3 cases and authored only 1 judgment. Out of 3 cases in which he was on the bench, 1 was Full Bench and he authored the judgment on behalf of the Division Bench. Justice P N Naolekar was on the bench in 2 cases and authored only 1 judgment. Justices A P Misra, Y K Sabharwal, Doraiswamy Raju (Full Bench), Brijesh Kumar (Full Bench), G B Pattanaik, K G Balakrishnan, B N Srikrishna, H K Sema, Dr AR Lakshmanan (Full Bench), B Sudershan Reddy, V S Sirpurkar and Cyriac Joseph were on the bench in 1 case each but did not author any judgment. Justices B P Singh and L S Pantawere on the bench in 3 cases but did not author any judgment. Justice P Venkatarama Reddy did not author any judgment and was on the bench in 2 cases. No sitting Chief Justice of India was on the bench in any of these 23 decisions. (Table 1) The first reported decision of the Supreme Court on trademark law from this century is *Haldiram Bhujawala v Anand Kumar Deepak Kumar*<sup>9</sup> and the latest decision from the first decade of this

century is *Thukral Mechanical Works v P M Diesels Private Limited*.<sup>10</sup>

Trademark Law Declared in the First Half of the First Decade of Twenty-First Century

A total of 8 decisions on the trademark law were delivered between 2000 to 2004. Of these 8 decisions, 1 is a Full Bench decision and the remaining decisions are by Division Bench. A total of 15 judges were on the bench in these 8 decisions. The first reported decision from this period is *Haldiram Bhujawala v Anand Kumar Deepak Kumar*<sup>9</sup> and the last is *Satyam Infoway Ltd v Siffynet Solutions (p) Ltd*.<sup>11</sup>

*Haldiram Bhujawala v Anand Kumar Deepak Kumar*<sup>9</sup> is a Division Bench decision of the Supreme Court. The lead judgment was authored by Justice M Jagannadha Rao. Two questions were for consideration before the Court: (1) whether Section 69(2) of the Partnership Act, 1932<sup>12</sup> (*hereinafter*, the Partnership Act) bars a suit by a firm not registered on the date of suit where permanent injunction and damages are claimed in respect of a trade mark as a statutory right or by invoking Common Law principles applicable to a passing-off action?;

Table 1 — Trademark decisions delivered by the Supreme Court of India in the first decade of twenty-first century

Sr. No.	Name of Judgment	Date of Judgment	Bench	Judges*	Concurring Judgment, if reported	Dissenting Judgment, if reported	Whether the Court Declared the Principles of Trademark Law?	Whether Interpreted- Constructed Decision?	Whether Unanimous Decision?
1	<i>Haldiram Bhujawala v Anand Kumar Deepak Kumar</i> , (2000) 3 SCC 250	28 February 2000	Division	<b>M Jagannadha Rao</b> and A P Misra, <i>JJ</i> .	No	No	Yes	Yes	Yes
2	<i>S M Dyechem Ltd v Cadbury (India) Ltd</i> , (2000) 5 SCC 573	9 May 2000	Division	<b>M Jagannadha Rao</b> and Y K Sabharwal, <i>JJ</i> .	No	No	Yes	Yes	Yes
3	<i>Cadila Healthcare Ltd v Cadila Pharmaceuticals Ltd</i> , (2001) 5 SCC 73	26 March 2001	Full	<b>B N Kirpal</b> , Doraiswamy Raju and Brijesh Kumar, <i>JJ</i> .	No	No	Yes	No	Yes
4	<i>Laxmikanth V Patel v Chetanbhai Shah</i> , (2002) 3 SCC 65	4 October 2001	Division	<b>R C Lahoti</b> and K G Balakrishnan, <i>JJ</i> .	No	No	Yes	No	Yes
5	<i>Colgate Palmolive (India) Ltd v MRTIP Commission</i> , (2003) 1 SCC 129	20 November 2002	Division	G B Pattanaik and <b>S B Sinha</b> , <i>JJ</i> .	No	No	No	No	Yes

(Contd.)

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Sr. No.	Name of Judgment	Date of Judgment	Bench	Judges*	Concurring Judgment, if reported	Dissenting Judgment, if reported	Whether the Court Declared the Principles of Trademark Law?	Whether Interpreted- Constructed Decision?	Whether Unanimous Decision?
6	<i>Hardie Trading Ltd v Addisons Paint &amp; Chemicals Ltd</i> , (2003) 11 SCC 92	22 September 2003	Division	<b>Ruma Pal</b> and B N Srikrishna, <i>JJ.</i>	No	No	Yes	Yes	Yes
7	<i>Satyam Infoway Ltd v Siffynet Solutions (P) Ltd</i> , (2004) 6 SCC 145	6 May 2004	Division	<b>Ruma Pal</b> and P Venkatarama Reddy, <i>JJ.</i>	No	No	Yes	No	Yes
8	<i>MilmetOftho Industries v Allergan Inc</i> , (2004) 12 SCC 624	7 May 2004	Division	<b>S N Variava</b> and H K Sema, <i>JJ.</i>	No	No	Yes	No	Yes
9	<i>Dhariwal Industries Ltd v M S S Food Products</i> , (2005) 3 SCC 63	25 February 2005	Division	B P Singh and <b>P K Balasubramanyan</b> , <i>JJ.</i>	No	No	Yes	No	Yes
10	<i>Commissioner of Central Excise, Trichy v Grasim Industries Ltd</i> , (2005) 4 SCC 194	12 April 2005	Full	<b>S N Variava</b> , Dr. A R Lakshmanan and S H Kapadia, <i>JJ.</i>	No	No	No	No	Yes
11	<i>ICICI Bank v Municipal Corporation of Greater Bombay</i> , (2005) 6 SCC 404	4 August 2005	Division	P Venkatarama Reddy and <b>P PNaolekar</b> , <i>JJ.</i>	No	No	Yes	No	Yes
12	<i>Bhavnesht Mohanlal Amin vNirma Chemicals Worlts Ltd</i> , (2006) 1 SCC 185	7 November 2005	Division	<b>Arijit Pasayat</b> and C K Thakker, <i>JJ.</i>	No	No	Reiterated its earlier judicial decision and decided the lis		
13	<i>Dhodha House v S K Maingi</i> , (2006) 9 SCC 41	15 December 2005	Division	B P Singh and <b>S B Sinha</b> , <i>JJ.</i>	No	No	Yes	Yes	Yes
14	<i>Reiz Electrocontrols (P) Ltd v Commissioner of Central Excise, Delhi-I</i> , (2006) 6 SCC 213	31 July 2006	Division	<b>Arijit Pasayat</b> and Lokeshwar Singh Panta, <i>JJ.</i>	No	No	No	No	Yes
15	<i>Ramdev Food Products (P) Ltd vArvindbhai Rambhai Patel</i> , (2006) 8SCC 726	29 August 2006	Division	<b>S B Sinha</b> and P P Naolekar, <i>JJ.</i>	No	No	Yes	No	Yes

(Contd.)

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16	<i>Gomzi Active v Reebok India Co</i> , (2007) 10 SCC 632	2 February 2007	Division	<b>Dr. Arijit Pasayat</b> and S H Kapadia, <i>JJ.</i>	No	No	No	No	Yes
17	<i>Meghraj Biscuits Industries v Commissioner of Central Excise</i> , UP, (2007) 3 SCC 780	14 March 2007	Division	<b>S H Kapadia</b> and B Sudershan Reddy, <i>JJ.</i>	No	No	Yes	No	Yes
18	<i>Heinz Italia v Dabur India Ltd</i> , (2007) 6 SCC 1	18 May 2007	Division	B P Singh and <b>Harjit Singh Bedi</b> , <i>JJ.</i>	No	No	Yes	No	Yes
19	<i>P D Lakhaniv State of Punjab</i> , (2008) 5 SCC 150	22 April 2008	Division	<b>S B Sinha</b> and V S Sirpurkar, <i>JJ.</i>	No	No	No	No	Yes
20	<i>Dabur India Ltd v K R Industries</i> , (2008) 10 SCC 595	16 May 2008	Division	<b>S B Sinha</b> and L S Panta, <i>JJ.</i>	No	No	No	No	Yes
21	<i>Kabushiki Kaisha Toshiba v Toshiba Appliances Company</i> , (2008) 10 SCC 766	16 May 2008	Division	<b>S B Sinha</b> and L S Panta, <i>JJ.</i>	No	No	Yes	Yes	Yes
22	<i>K Narayanan v S Murali</i> , (2008) 10 SCC 479	5 August 2008	Division	<b>Tarun Chatterjee</b> and H S Bedi, <i>JJ.</i>	No	No	Yes	No	Yes
23	<i>Thukral Mechanical Works v P M Diesels Private Limited</i> , (2009) 2 SCC 768	18 December 2008	Division	<b>S B Sinha</b> and Cyriac Joseph, <i>JJ.</i>	No	No	Yes	Yes	Yes

\*Name of the judge in **bold** refers to the judge who delivered the judgment on behalf of the Court.

and (2) whether the words ‘arising from a contract’ in Section 69 (2) of the Partnership Act refer only to a situation where an unregistered firm is enforcing a right arising from a contract entered into by the firm with the defendant during the course of its business or whether the bar under Section 69 (2) can be extended to any contract referred to in the plaint unconnected with the defendant, as the source of title to the suit property?

As to the question (1), the Court declared that:

‘[A] suit is not barred by Section 69 (2) if a statutory right or a common law right is being enforced.’<sup>13</sup>

‘[A] suit for perpetual injunction to restrain the defendant not to pass-off the defendant’s goods as

those of plaintiffs by using the plaintiffs’ trade mark and for damages is an action at common law and is not barred by Section 69 (2).’<sup>13</sup>

‘[I]f the reliefs of permanent injunction or damages are being claimed on the basis of a registered trade mark and its infringement, the suit is to be treated as one based on a statutory right under the Trade Marks Act and is, in our view, not barred by Section 69 (2).’<sup>13</sup>

As to the question (2), the Court declared:

‘[T]he contract by the unregistered firm referred to in Section 69 (2) must not only be one entered into by the firm with the third-party defendant but must also be one entered into by the plaintiff firm in the course

*of the business dealing of the plaintiffs firm with such third-party defendant.*<sup>14</sup>

*‘[L]egislature when it used the word ‘arising out of a contract’ in Section 69 (2), it is referring to a contract entered into in course of business transaction by the unregistered plaintiff firm with its customers defendants and the idea is to protect those in commerce who deal with such a partnership firm in business...[T]hird parties who deal with the partners ought to be enabled to know what the names of the firm are before they deal with them in business.*<sup>15</sup>

*‘Section 69 (2) is not attracted to any and every contract referred to in the plaint as the source of title to an asset owned by the firm.*<sup>16</sup>

*S M Dyechem Ltd v Cadbury (India) Ltd*<sup>17</sup> is a Division Bench decision of the Supreme Court. The unanimous judgment of the Court was delivered by Justice M Jagannadha Rao. A total of seven questions were for consideration before the Court.<sup>18</sup> The principle of Trademark Law declared by the Court in this case are as follows:

*‘[U]nder Section 107 of the Patents Act, it is permissible in any suit for infringement of a patent, for the defendant to raise all pleas in defence which he could have raised under Section 64 of the Act for revocation and there is no similar provision in the Trade Marks Act, 1958.*<sup>19</sup>

*‘If a trade mark does not satisfy Section 9, it is well settled that it is to be treated as “invalid”.*<sup>20</sup>

*‘[I]n trade mark matters, it is now necessary to go into the question of “comparable strength” of the cases of either party, apart from balance of convenience.*<sup>21</sup>

*‘Under Section 29 of the Act, a plaintiff in a suit on basis of infringement has to prove not only that his trade mark is infringed by a person who is not a registered proprietor of the mark or a registered user thereof but that the said person is using a mark in the course of his trade, “which is identical with or deceptively similar to the trade mark of the plaintiff, in such manner as to render the use of the mark likely to be mistaken as the registered trade mark”.*<sup>21</sup>

*‘[P]laintiff must prove that essential features of his registered mark have been copied. The onus to prove “deception” is on the part of the plaintiff who alleges infringement.*<sup>21</sup>...

*‘A mark is said to be infringed by another trader if, even without using the whole of it, the latter uses one or more of its “essential features”. The identification of an essential feature depends partly on the courts’ own judgment and partly on the burden of the*

*evidence that is placed before it. Ascertainment of an essential feature is not to be by ocular test alone; it is impossible to exclude consideration of the sound of words forming part or the whole of the mark.*<sup>22</sup>

*‘When the question arises whether a mark applied for bears, such resemblance to another mark as to be likely to deceive, it should be determined by considering what is the leading character of each. The one might contain many, even most, of the same elements as the other, and yet the leading, or it may be the only, impression left on the mind might be very different. On the other hand, a critical comparison of the two marks might disclose numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same.*<sup>23</sup> ...

*‘[I]t is clear that a mark is infringed if the essential features, or essential particulars of it, are copied. In cases of device marks, especially, it is helpful before comparing the marks, to consider what are the essentials of the plaintiff’s device. The trade mark is the whole thing—the whole picture on each has to be considered. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the part or parts is enough to make the whole dissimilar...[I]f the only resemblances between two marks are in parts which are common, so that the owner of the one has taken nothing which is peculiar to the other, then there is at all events no infringement, at any rate unless the plaintiff had a distinctive arrangement of the common elements. But this approach is hardly suited to a comparison of word marks; and even in relation to label marks or other features of get-up, it would be more appropriate to consider the case as a whole, with due regard to the background provided by any other marks shown to be in use.*<sup>23</sup> ...

*‘The marks, names or get-up concerned must always be considered as the whole thing, as the true test is whether the totality of the impression given both orally and visually is such that it is likely to cause mistake, deception or confusion.*<sup>24</sup>

*‘Where common marks are included in the rival trade marks, more regard is to be paid to the parts not common and the proper course is to look at the marks as whole, but at the same time not to disregard the parts which are common.’<sup>24</sup>*

The Court laid down three tests:

*‘[F]irst...: Is there any special aspect of the common feature which has been copied?...[S]econd test will be with reference to the*

“mode in which the parts are put together differently? That is to say whether the dissimilarity of the part or parts is enough to mark the whole thing dissimilar...[T]hird test is whether when there are common elements, should one not pay more regard to the parts which are not common, while at the same time not disregarding the common parts? What is the first impression?”<sup>25</sup>

The Court relied on the judgment of Lord Denning in *Parke-Knoll v Knoll International*<sup>26</sup> to clear that Section 29 uses the words “deceptively similar” and Section 2 (1) (d) defines “deceptively similar” as situations where one is “deceiving” others or “confusing” others, and to keep in view the distinction between the words “deceive” and “confuse” used in Section 2(1)(d):

‘Looking to the *natural meaning* of the words,... two observations: first, the offending mark must “so nearly resemble” the registered mark as to be “likely” to deceive or cause confusion. It is not necessary that it should be intended to deceive or intended to cause confusion. You do not have to look into the mind of the user to see what he intended. *It is its probable effect on ordinary people which you have to consider.* No doubt, if you find that he did not intend to deceive or cause confusion, you will give him credit for success in his intentions. You will not hesitate to hold that his use of it is likely to deceive or cause confusion. But if he had no such intention, and was completely honest, then you will look carefully to see whether it is likely to deceive or cause confusion before you find him guilty of infringement...*(Emphasis added)* Secondly, “to deceive” is one thing. To cause “confusion” is another. The difference is this: when you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.”<sup>27</sup>

‘[I]f, in a given case, the essential features have been copied, the intention to deceive or to cause confusion is not relevant in an infringement action. Even if, without an intention to deceive, a false representation is made, it can be sufficient. Similarly,

confusion may be created unintentionally but yet the purchaser of goods may get confused for he does not have the knowledge of facts which can enable him not to get confused.’<sup>28</sup>

‘As to scope of a buyer being deceived, in a passing off action, the...principles (as laid down in *Payton & Co v Snelling Lampard & Co*<sup>29</sup> by Lord Romer) have to be borne in mind:...*that it is a misconception to refer to the confusion that can be created upon an ignorant customer. The kind of customer that the Courts ought to think of...is the customer who knows the distinguishing characteristics of the plaintiff’s goods, those characteristics which distinguish his goods from other goods in the market so far as relates to general characteristics. If he does not know that, he is not a customer whose views can properly be regarded by the Court.*’<sup>30</sup>

‘If wrong principles were applied by the trial Court under Order 39, Rule 1 (of the Code of Civil Procedure, 1908)<sup>31</sup>..., the appellate Court could certainly interfere in interlocutory proceedings under Order 39, Rule 1...’<sup>32</sup>

*Cadila Healthcare Ltd v Cadila Pharmaceuticals Ltd*,<sup>33</sup> is a Full Bench decision of the Court. Justice B N Kirpal delivered the unanimous judgment of the Court. Following principles of trademark law were declared by the Court:

‘A critical comparison of the two names may disclose some points of difference but *an unwary purchaser of average intelligence and imperfect recollection* would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking for with a somewhat vague recollection that he had purchased a similar medicine on a previous occasion with a similar name. The trade mark is the whole thing—the whole word has to be considered.’<sup>34</sup>

‘The passing off action depends upon the principle that nobody has a right to represent his goods as the goods of some body. In other words, a man is not to sell his goods or services under the pretence that they are those of another person.’<sup>35</sup>

‘Trade mark is essentially adopted to advertise one’s product and to make it known to the purchaser. It attempts to portray the nature and, if possible, the quality of the product and over a period of time the mark may become popular. It is usually at that stage that other people are tempted to pass off their products as that of the original owner of the mark.’<sup>36</sup>

‘A stricter approach should be adopted while applying the test to judge the possibility of confusion of

one medicinal product for another by the consumer. While confusion in the case of non-medicinal products may only cause economic loss to the plaintiff, confusion between the two medicinal products may have disastrous effects on health and in some cases life itself. *Stringent measures should be adopted specially where medicines are the medicines of last resort as any confusion in such medicines may be fatal or could have disastrous effects.* The confusion as to the identity of the product itself could have dire effects on the public health.<sup>37</sup>

‘Keeping in view the provisions of Section 17B of the Drugs and Cosmetics Act, 1940<sup>38</sup> which *inter alia* indicates an imitation or resemblance of another drug in a manner likely to deceive being regarded as a spurious drug it is but proper that before granting permission to manufacture a drug under a brand name the authority under that Act is satisfied that there will be no confusion or deception in the market. The authorities should consider requiring such an applicant to submit an official search report from the Trade Mark Office pertaining to the trade mark in question which will enable the drug authority to arrive at a correct conclusion.’<sup>39</sup>

‘[I]n an action for passing off on the basis of unregistered trade mark generally for deciding the question of deceptive similarity the following factors to be considered:

- (a) The nature of the marks *i.e.*, whether the marks are word marks or label marks or composite marks, *i.e.*, both words and label works.
- (b) The degree of resemblance between the marks, phonetically similar and hence similar in idea.
- (c) The nature of the goods in respect of which they are used as trade marks.
- (d) The similarity in the nature, character and performance of the goods of the rival traders.
- (e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and/or using the goods.
- (f) The mode of purchasing the goods or placing orders for the goods.
- (g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same

weightage cannot be given to each factor in every case.’<sup>40</sup>

*Laxmikanth V Patel v Chetanbhai Shah*,<sup>41</sup> is a Division Bench decision of the Court. Justice R C Lahoti delivered the unanimous decision on behalf of the Court. Following principles of trademark law were declared by the Court:

- (i) ‘Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently.’<sup>42</sup>
- (ii) ‘The definition of trade mark is very wide and means, *inter alia*, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. Mark includes amongst other things name or word also. Name includes any abbreviation of a name.’<sup>42</sup>
- (iii) ‘The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury.’<sup>43</sup>
- (iv) ‘In an action for passing off it is usual, rather essential, to seek an injunction temporary or *ad-interim*. The principles for the grant of such injunction are the same as in the case of any other action against injury complained of. The plaintiff must prove a *prima facie* case, availability of balance of convenience in his favour and his suffering an irreparable injury in the absence of grant of injunction.’<sup>44</sup>

*Colgate Palmolive (India) Ltd v MRTP Commission*,<sup>45</sup> is a Division Bench decision of the Court. Justice S B Sinha penned down the judgment of the Court. No principle of trademark law was declared by the Court in this case.

*Hardie Trading Ltd v Addisons Paint & Chemicals Ltd*,<sup>46</sup> is a Division Bench decision of the Court.

Justice Ruma Pal authored the judgment of the Court. Following principles of trademark law were declared by the Court:

‘[B]efore the High Court or the Registrar direct the removal of the registered trademarks they must be satisfied in respect of the following (wrt Section 46):

(i) That the application is by a “person aggrieved”;

(ii) That the trade mark has not been used by the proprietor for continuous period of at least five years and one month prior to the date of the application;

(iii) There were no special circumstances which affected the use of the trade mark during this period by the proprietor.’<sup>47</sup>

‘The onus to establish the first two conditions obviously lies with the applicant, whereas the burden of proving the existence of special circumstances is on the proprietor of the trade marks. These conditions are not to be cumulatively proved but established seriatim. There is no question of the third condition being established unless the second one has already been proved and there is no question of the second one even being considered unless the High Court or the Registrar is satisfied as to the locus standi of the applicant.’<sup>48</sup>

‘[T]he phrase “*person aggrieved*” for the purposes of removal on the ground of non-use under Section 46 has a different connotation from the phrase used in Section 56 for cancelling or expunging or varying an entry wrongly made or remaining in the Register’.<sup>49</sup>

‘[T]he word “*use*” in Section 46(1) (is not limited)...[T]he use may be other than physical. It may be in any other relation to the goods...[N]o reason to limit the user to use on the goods or to sale of goods bearing the trademark.’<sup>50</sup>

‘In Section 2(2)(b) of the Act,...the additional words “*any*” and “*whatsoever*” qualifying the words “*other relation*” giving the words a much wider meaning. Reading this definition into Section 46(1), it is clear that the word “*use*” in Section 46(1) may encompass actions other than actual sale.’<sup>50</sup>

*Satyam Infoway Ltd v Siffynet Solutions (P) Ltd*,<sup>51</sup> is a Division Bench decision of the Court. Justice Ruma Pal penned down the judgment of the Court. The Court decided the question ‘whether a domain name can be said to be a word or name which is capable of distinguishing the subject of trade or service made available to potential users of the internet?’:

The original role of a domain name was no doubt to provide an address for computers on the internet...

With the increase of commercial activity on the internet, a domain name is also used as a business identifier...[D]omain name not only serves as an address for internet communication but also identifies the specific internet site...[A] domain name may pertain to provision of services within the meaning of Section 2(1)(z). A domain name is easy to remember and use, and is chosen as an instrument of commercial enterprise not only because it facilitates the ability of consumers to navigate the Internet to find websites they are looking for, but also at the same time, serves to identify and distinguish the business itself, or its goods or services, and to specify its corresponding online Internet location. Consequently, a domain name as an address must, of necessity, be peculiar and unique and where a domain name is used in connection with a business, the value of maintaining an exclusive identity becomes critical.<sup>52</sup>

To the question ‘would would the principles of trade mark law and in particular those relating to passing off apply’, the Court answered that:

‘An action for passing off, as the phrase “*passing off*” itself suggests, is to restrain the defendant from passing off its goods or services to the public as that of the plaintiff’s. It is an action not only to preserve the reputation of the plaintiff but also to safeguard the public. The defendant must have sold its goods or offered its services in a manner which has deceived or would be likely to deceive the public into thinking that the defendant’s goods or services are the plaintiff’s. The action is normally available to the owner of a distinctive trademark and the person who, if the word or name is an invented one, invents and uses it. If two trade rivals claim to have individually invented the same mark, then the trader who is able to establish prior user will succeed. The question is, as has been aptly put, who gets these first? It is not essential for the plaintiff to prove long user to establish reputation in a passing off action. It would depend upon the volume of sales and extent of advertisement.’<sup>52</sup>....

‘The second element that must be established by a plaintiff in a passing off action is misrepresentation by the defendant to the public. The word misrepresentation does not mean that the plaintiff has to prove any malafide intention on the part of the defendant. Of course, if the misrepresentation is intentional, it might lead to an inference that the reputation of the plaintiff is such that it is worth the defendant’s while to cash in on it. An innocent misrepresentation would be relevant only on the

question of the ultimate relief which would be granted to plaintiff.<sup>53</sup>...The third element of a passing off action is loss or the likelihood of it.<sup>53</sup>

‘The use of the same or similar domain name may lead to a diversion of users which could result from such users mistakenly accessing one domain name instead of another. This may occur in e-commerce with its rapid progress and instant (and theoretically limitless) accessibility to users and potential customers and particularly so in areas of specific overlap. Ordinary consumers/users seeking to locate the functions available under one domain name may be confused if they accidentally arrived at a different but similar web site which offers no such services. Such users could well conclude that the first domain name owner had mis-represented its goods or services through its promotional activities and the first domain owner would thereby lose their custom. It is apparent therefore that a domain name may have all the characteristics of a trademark and could found an action for passing off.’<sup>53</sup>

As to the distinction between a trademark and a domain name, the Court held that:

‘However, there is a distinction between a trademark and a domain name which is not relevant to the nature of the right of an owner in connection with the domain name, but is material to the scope of the protection available to the right. The distinction lies in the manner in which the two operate. A trademark is protected by the laws of a country where such trademark may be registered. Consequently, a trade mark may have multiple registration in many countries throughout the world. On the other hand, since the internet allows for access without any geographical limitation, a domain name is potentially accessible irrespective of the geographical location of the consumers. The outcome of this potential for universal connectivity is not only that a domain name would require world wide exclusivity but also that national laws might be inadequate to effectively protect a domain name....’<sup>54</sup>

‘Another facet of passing off is the likelihood of confusion with possible injury to the public and consequential loss to the appellant. The similarity in the name may lead an unwary user of the internet of average intelligence and imperfect recollection to assume a business connection between the two.’<sup>55</sup>

*MilmetOftho Industries v Allergan Inc*<sup>56</sup> is a Division Bench decision of the Court. Justice S N Variava authored the unanimous judgment on behalf of the Court. The Court observed as to the test to

decide the possibility of likelihood of deception or confusion:

‘Whilst considering the possibility of likelihood of deception or confusion, in present times and particularly in the field of medicines, the Courts must also keep in mind the fact that nowadays the field of medicine is of an international character. The Court has to keep in mind the possibility that with the passage of time, some conflict may occur between the use of the mark by the Applicant in India and the user by the overseas company. The Court must ensure that public interest is in no way imperiled...[I]f a mark in respect of a drug is associated with the Respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India. However, one note of caution must be expressed. Multinational corporations, who 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*.’<sup>57</sup>

### **Trademark Law Declared in the Second Half of the First Decade of Twenty-First Century**

A total of 15 decisions on the trademark law were delivered between 2005 to 2009. Of these 15 decisions, 1 is a Full Bench decision and the remainings are by Division Bench. A total of 16 judges were on the bench in these 15 decisions. The first reported decision from this period is *Dhariwal Industries Ltd v M S S Food Products*<sup>58</sup> and the last is *Thukral Mechanical Works v P M Diesels Private Limited*.<sup>59</sup>

*Dhariwal Industries Ltd v M S S Food Products*<sup>58</sup> is a Division Bench decision of the Court. Justice P K Balasubramanian authored the unanimous judgment on behalf of the Court. On Section 27 of The Trade Marks Act, 1999, the Court held that: ‘[F]act that neither party has a registered trade mark as on the date of the suit cannot stand in the way of entertaining the claim of the plaintiff and granting the plaintiff an injunction in case the plaintiff is in a position to show prima facie that it was the prior user of its mark, that it had a prima facie case and that the balance of convenience was in favour of the grant of an interim injunction...Section 39...It is, therefore, possible for

a plaintiff or a defendant to show that an unregistered trade mark that was being used by another person earlier had been assigned to it and that it can tack on the prior user of its predecessor.<sup>60</sup>

*Commissioner of Central Excise, Trichy v Grasim Industries Ltd*<sup>61</sup> is a Full Bench decision of the Court. Justice S N Variava delivered the judgment on behalf of the Court. No principle of trademark law was declared by the Court in this case.

*ICICI Bank v Municipal Corporation of Greater Bombay*<sup>62</sup> is a Division Bench judgment of the Court. Justice P P Naolekar authored the unanimous judgment of the Court. The Court in this case held that: 'An advertisement tries to get consumers to buy a product or a service. An advertisement is generally of goods and services and is an information intended for the potential customers and not a mere display of the name of the company unless the same happens to be a trade mark or trade name.'<sup>63</sup>

*Bhavnesb Mohanlal Amin v Nirma Chemicals Works Ltd*<sup>64</sup> is a Division Bench decision of the Court. Justice Arijit Pasayat authored the judgment. The Court in this case reiterating to its earlier decisions decided the case.

*Dhodha House v S K Maingi*<sup>65</sup> is a Division Bench decision of the Supreme Court. Justice S B Sinha delivered the unanimous decision on behalf of the Court. The Court declared that 'A judgment or order passed by a court lacking territorial jurisdiction, thus, would be *coram non jure*. Thus, if a district court, where the plaintiff resides but where no cause of action arose otherwise, adjudicates a matter relating to infringement of trade mark under the 1958 Act, its judgment would be a nullity.'<sup>66</sup> The Court also declared that '*A cause of action will arise only when a registered trade mark is used and not when an application is filed for registration of the trade mark*. In a given case, an application for grant of registration certificate may or may not be allowed. The person in whose favour, a registration certificate has already been granted indisputably will have an opportunity to oppose the same by filing an application before the Registrar, who has the requisite jurisdiction to determine the said question. In other words, a suit may lie where an infringement of trade mark or copyright takes place but a cause of action for filing the suit would not arise within the jurisdiction of the court only because an advertisement has been issued in the Trade Marks Journal or any other journal, notifying the factum of filing of such an application.'<sup>67</sup> To the question 'whether causes of action in terms of both the 1957 Act and the 1958 Act although may be

different, would a suit be maintainable in a court only because it has the jurisdiction to entertain the same in terms of Section 62 (2) of the 1957 Act', the Court answered that:

'A cause of action in a given case both under the 1957 Act as also under the 1958 Act may be overlapping to some extent. The territorial jurisdiction conferred upon the court in terms of the provisions of the Code of Civil Procedure indisputably shall apply to a suit or proceeding under the 1957 Act as also the 1958 Act. Sub-section (2) of Section 62 of the 1957 Act provides for an additional forum. Such additional forum was provided so as to enable the author to file a suit who may not otherwise be in a position to file a suit at different places where his copyright was violated. The Parliament while enacting the Trade and Merchandise Marks Act in the year 1958 was aware of the provisions of the 1957 Act. It still did not choose to make a similar provision therein. Such an omission may be held to be a conscious action on the part of the Parliament. The intention of the Parliament in not providing for an additional forum in relation to the violation of the 1958 Act is, therefore, clear and explicit. The Parliament while enacting the Trade Marks Act, 1999 provided for such an additional forum by enacting sub-section (2) of Section 134 of the Trade Marks Act. The court shall not, it is well well-settled, readily presume the existence of jurisdiction of a court which was not conferred by the statute. For the purpose of attracting the jurisdiction of a court in terms of sub-section (2) of Section 62 of the 1957 Act, the conditions precedent specified therein must be fulfilled, the requisites whereof are that the plaintiff must actually and voluntarily reside to carry on business or personally work for gain.'<sup>68</sup>

'The expression "carries on business" and the expression "personally works for gain" connote two different meanings. For the purpose of carrying on business only presence of a man at a place is not necessary. Such business may be carried at a place through an agent or a manager or through a servant. The owner may not even visit that place. The phrase "carries on business" at a certain place would, therefore, mean having an interest in a business at that place, a voice in what is done, a share in the gain or loss and some control thereover. The expression is much wider than what the expression in normal parlance connotes, because of the ambit of a civil action within the meaning of Section 9 of the Code. But it is necessary that the following three conditions should be satisfied, namely: (1) The agent must be a

special agent who attends exclusively to the business of the principal and carries it on in the name of the principal and not a general agent who does business for any one that pays him...(2) The person acting as agent must be an agent in the strict sense of the term. The manager of a joint Hindu family is not an “agent” within the meaning of this condition.(3) To constitute “carrying on business” at a certain place, the essential part of the business must take place in that place.<sup>69</sup>

‘A corporation in view of Explanation appended to Section 20 of the Code would be deemed to be carrying on business inter alia at a place where it has a subordinate office. Only because, its goods are being sold at a place would thus evidently not mean that it carries a business at that place.’<sup>70</sup>

‘Section 45 of the Trade Marks Act; sub-section 2 (m) where of shows that the marks includes a device, brand, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. It may be so that in a given case if such label is registered, a violation thereof may give rise to cause of action under the said Act; but only because in a given case, the activities on the part of the defendant may give rise to a cause of action both under the 1958 Act as also under the 1957 Act, the same would not mean, irrespective of the nature of violation, the plaintiff would be entitled to invoke the jurisdiction of the court in terms of sub-section (2) of Section 62 of the 1957 Act.’<sup>71</sup>

‘For the purpose of invoking the jurisdiction of a court only because two causes of action joined in terms of the provisions of the Code of Civil Procedure, the same would not mean that thereby the jurisdiction can be conferred upon a court which had jurisdiction to try only the suit in respect of one cause of action and not the other. Recourse to the additional forum, however, in a given case, may be taken if both the causes of action arise within the jurisdiction of the court which otherwise had the necessary jurisdiction to decide all the issues.’<sup>71</sup>

*Reiz Electrocontrols (P) Ltd v Commissioner of Central Excise, Delhi-I*<sup>72</sup> is a Division Bench decision. The judgment of the Court was delivered by Justice Arijit Pasayat. No principle of trademark law was declared by the Court in this case.

*Ramdev Food Products (P) Ltd v Arvindbhai Rambhai Patel*<sup>73</sup> is a Division Bench decision. The judgment of the Court was delivered by Justice S B Sinha. The Court declared:

- (1) ‘A trade mark is the property of the manufacturer. The purpose of a trade mark is to establish a connection between the goods and the source thereof which would suggest the quality of goods. If the trade mark is registered, indisputably the user thereof by a person who is not otherwise authorised to do so would constitute infringement.’<sup>74</sup>
- (2) ‘A proprietor of a registered trade mark indisputably has a statutory right thereto. In the event of such use by any person other than the person in whose name the trade mark is registered, he will have a statutory remedy in terms of Section 21 of the 1958 Act. Ordinarily, therefore, two people are not entitled to the same trade mark, unless there exists an express licence in that behalf.’<sup>74</sup>
- (3) ‘Traditionally, a trade mark has always been considered a vital and inseparable part of the goodwill of the business. In fact, the sale of a trade mark without the sale of the goodwill to the same buyer is considered null and void. However, the trade mark can be assigned with or without the goodwill of business though subject to certain conditions.’<sup>75</sup>
- (4) ‘The non-obstante nature of a provision although may be of wide amplitude, the interpretative process thereof must be kept confined to the legislative policy. A non-obstante clause must be given effect to, to the extent the Parliament intended and not beyond the same.’<sup>76</sup>
- (5) ‘If an infringement of trade mark is established, the onus would be on the defendants to show that he is entitled thereto either by reason of acquiescence on the part of the owner of the registered trade mark or he himself has acquired a right thereto.’<sup>76</sup>
- (6) ‘What is needed by way of cause of action for filing a suit of infringement of trade mark is use of a deceptively similar mark which may not be identical. What would be deceptively similar, as defined in Section 2 (d) of the 1958 Act, would be a mark if it nearly resembles that other mark as to be likely to deceive or cause confusion.’<sup>77</sup>
- (7) ‘The right conferred in terms of Section 28 of the 1958 Act although is required to be read with Sections 15 and 17 thereof but it is difficult to accept that each part of the logo was required to be separately registered. Section 28 of the 1958 Act confers an exclusive right of using trade mark to a person who has got the trade mark

registered in his name. Such right is, thus, absolute. Sub-section (3) of Section 28 raises a legal fiction for the purposes specified therein but we are not concerned therewith in the instant case. Sub-section (2) of Section 29 inter alia provides for the defences.<sup>78</sup>

- (8) 'The doctrine of passing off is a common law remedy whereby a person is prevented from trying to wrongfully utilise the reputation and goodwill of another by trying to deceive the public through "passing off" his goods.'<sup>79</sup>
- (9) '[I]n an infringement action, an injunction would be issued if it is proved that the defendant is improperly using the plaintiff's mark. In an action for infringement where the defendant's trade mark is identical with the plaintiff's mark, the Court will not enquire whether the infringement is such as is likely to deceive or cause confusion. The test, therefore, is as to likelihood of confusion or deception arising from similarity of marks is the same both in infringement and passing off actions.'<sup>80</sup>
- (10) 'Acquiescence is a facet of delay. The principle of acquiescence would apply where: (i) sitting by or allow another to invade the rights and spending money on it; (ii) it is a course of conduct inconsistent with the claim for exclusive rights for trade mark, trade name, etc.'<sup>81</sup>
- (11) 'The defence of acquiescence, thus, would be satisfied when the plaintiff assents to or lay by in relation to the acts of another person and in view of that assent or laying by and consequent acts it would be unjust in all the circumstances to grant the specific relief.'<sup>82</sup>
- (12) 'Registration of a trade mark and user thereof per se may lead to the conclusion that the plaintiff has a prima facie case, however, existence thereof would also depend upon the determination of the defences raised on behalf of the respondents.'<sup>83</sup>
- (13) '[W]hen a prima facie case is made out and balance of convenience is in favour of the appellant, it may not be necessary to show more than loss of goodwill and reputation to fulfil the condition of irreparable injury. In fact, if the first two pre-requisites are fulfilled, in trade mark actions irreparable loss can be presumed to have taken place.'<sup>84</sup>
- (14) '[G]rant of an interlocutory injunction is in exercise of discretionary power and hence, the appellate courts will usually not interfere with it. However, appellate courts will substitute their

discretion if they find that discretion has been exercised arbitrarily, capriciously, perversely, or where the court has ignored settled principles of law regulating the grant or refusal of interlocutory injunctions.'<sup>85</sup>

*Gomzi Active v Reebok India Co*<sup>86</sup> is a Division Bench decision of the Court. Justice Dr. Arijit Pasayat delivered the unanimous decision of the Court. The Court did not declare any principle of trademark law in this case.

*Meghraj Biscuits Industries v Commissioner of Central Excise, UP*<sup>87</sup> is a Division Bench decision of the Court. Justice S H Kapadia delivered the judgment. The Court declared that '[T]he effect of making the registration certificate applicable from retrospective date is based on the principle of deemed equivalence to public user of such mark. This deeming fiction cannot be extended to the Excise Law. It is confined to the provisions of the Trade Marks Act.'<sup>88</sup> The Court further held that '[A] trader acquires a right of property in a distinctive mark merely by using it upon or in connection with his goods irrespective of the length of such user and the extent of his trade. The trader who adopts such a mark is entitled to protection directly the article having assumed a vendible character is launched upon the market. As between two competitors who are each desirous of adopting such a mark, it is, to use familiar language, entirely a question of who gets there first.'<sup>89</sup> Registration under the statute does not confer any new right to the mark claimed or any greater right than what already existed at common law and at equity without registration. It does, however, facilitate a remedy which may be enforced and obtained throughout the State and it established the record of facts affecting the right to the mark. Registration itself does not create a trade mark. The trade mark exists independently of the registration which merely affords further protection under the statute. Common law rights are left wholly unaffected. Priority in adoption and use of a trade mark is superior to priority in registration.'<sup>90</sup>

*Heinz Italia v Dabur India Ltd*<sup>91</sup> is a Division Bench decision of the Court. Justice Harjit Singh Bedi delivered the unanimous decision of the Court. The Court declared that '[B]efore the use of a particular mark can be appropriated it is for the plaintiff to prove that the product that he is representing had earned a reputation in the market and that this reputation had been sought to be violated by the opposite party.'<sup>92</sup>

*P D Lakhani v State of Punjab*<sup>93</sup> is a Division Bench decision of the Court. Justice S B Sinha delivered the unanimous decision of the Court. The Court did not declare any principle of trademark law in this case.

*Dabur India Ltd v K R Industries*<sup>94</sup> is a Division Bench decision of the Court. Justice S B Sinha delivered the unanimous decision on behalf of the Court. The Court did not declare any principle of trademark law but held that ‘Under the Code (of Civil Procedure) claims arising under a statute governing substantive or procedural law, a number of remedies may be combined. The Court may grant an order of injunction even in a passing off action. It is trite that where the court has the jurisdiction/power to adjudicate, it will necessarily have the incidental power therefor. It may, however, be different if the Court may have exercised a power which is not provided for as a supplemental proceeding e.g., Section 94 of the Code.’<sup>95</sup>

*Kabushiki Kaisha Toshiba v Toshiba Appliances Company*<sup>96</sup> is a Division Bench decision of the Court. Justice S B Sinha delivered the unanimous decision on behalf of the Court. The Court declared that:

- (i) ‘Section 46 (1) (a) and (b) of the Act...It is beyond any doubt or dispute that sub-section (1) of Section 46 confers a discretionary jurisdiction on the Registrar. The jurisdiction may be exercised if any application is filed by a person aggrieved. The said application has to be filed in the manner prescribed therefor. Whence it is found that the application is filed by a person aggrieved in the prescribed manner, the grounds which would be available to the Registrar for exercise of its discretionary jurisdiction are stated in clauses (a) and (b) of sub-section (1) of Section 46 ...[C]lauses (a) and (b) are disjunctive and not cumulative. Recourse may be taken to either of them or both of them. A combined application even under Sections 46 and 56 of the Act is permissible in law.’<sup>97</sup>
- (ii) ‘Whereas clause (a) refers to bona fide use of the trade mark; clause (b) stipulates the period upto a date of one month before the date of application, a continuous period of five years or longer elapsed during which the trade mark was registered and during which there was no bona fide use there of in relation to those goods by any proprietor thereof for the time being. Sub-section (3)

postulates an exclusion clause as regards application of clause (b) of sub-section (1) of Section 46 if any non-use of a trade mark which is shown to have been due to special circumstances in the trade or not to any intention to abandon or not to use the trade mark in relation to the goods to which the application relates.’<sup>98</sup>

- (iii) ‘The concept of the term “person aggrieved” is different in the context of Sections 46 and 56. Section 46 speaks of a private interest while Section 56 speaks of a public interest.’<sup>98</sup>

*K Narayanan v S Murali*<sup>99</sup> is a Division Bench decision of the Court. Justice Tarun Chatterjee delivered the unanimous decision on behalf of the Court. The Court declared that ‘[M]ere filing of a trade mark application cannot be regarded as a cause of action for filing a suit for passing off since filing of an application for registration of trade mark does not indicate any deception on the part of the respondent to injure business or goodwill of the appellants.’<sup>100</sup>

*Thukral Mechanical Works v P M Diesels Private Limited*<sup>101</sup> is a Division Bench decision of the Court. Justice S B Sinha delivered the unanimous decision on behalf of the Court. The Court declared that:

‘[S]cope of the provisions for removal from Register in terms of Section 46 and 56 of the Act stand on different footings. Whereas Section 46 had a limited application, Section 56 of the Act is wider in nature.’<sup>102</sup>

....

‘A registered proprietor of a trade mark should not be permitted to circumvent the law of user of the trade mark for a long time by assigning the same from time to time...Allegation of trafficking is a serious one. It must be proved in presence of the person against whom such allegations are made. At the time of grant of original registration, advertisements are issued and objections are called for. Renewal of registration, in a sense, also is not automatic. A person who had been using the said trade mark as a proprietor thereof by user is supposed to keep itself abreast with such applications filed by another either for registration of the trade mark or renewal thereof. The non-user for a long time would disentitle a registered proprietor from renewal of the registration.’<sup>103</sup>

...

‘Section 46 (1) (b) provides for a special remedy. As a person obtains a right on and from the date of registration and/or renewal thereof, he can

ordinarily be deprived of his right unless it is shown that the assignment thereof by his holder was not a bona fide one or had been made by way of camouflage. If the assignee has obtained assignment for bona fide use, he may not be fastened with any liability owing to non-user on the part of his predecessor. In other words, the mistake of the predecessor should not be visited with non-use of the present registered owner.<sup>103</sup>

...

‘[W]hether a use is for bonafide purpose would essentially be a question of fact. Whether Section 46 (1) (b) read with Section 48 of the Act would bring within its purview, not only a registered proprietor but also the proprietor who had otherwise acquired a right would depend upon the facts and circumstances of each case.’<sup>103</sup>

...

‘Two interpretations of the said provision Section 46 (1) (b) are possible. While interpreting the same, however, certain basic principles of construction of statute must be kept in mind. As it takes away somebody’s right, it deserves strict construction. Jurisdiction of the Board being dependent on determination of the foundational facts, the same was required to be established on the basis of the averments made in the application and not otherwise.’<sup>104</sup>

....

‘The right of a registered trade mark is not lost automatically on the expiry of five years and one month. It does not provide for a “sun set” law. It has to be adjudicated upon. Whether the registered proprietor of the trade mark had taken recourse to trafficking or not must be determined in an appropriate proceeding. The principle of ‘*purchaser of a property has a duty to make enquiries*’, therefore, cannot apply in a case of this nature. So long as the right to assign a registered trade mark remains valid, once the same is validly assigned, the assignee derives the same right as that of the assignor in terms of the statute. A title to a trade mark derived on assignment as provided for under the Act cannot be equated with a defective title acquired in any other property as admittedly on the date of assignment, the right of the registered trade mark was not extinguished.’<sup>105</sup>

## Conclusion

Out of 23 reported decisions, the Court declared the principles of patent law only in 17 decisions. The

Court has also in 7 decisions interpreted-constructed the text of the trademark (and other related) statutes to declare the principles of trademark law. In 1 decision, the Court reiterating to its earlier position decided the case. In 6 decisions the Court declared the principle of trademark law and also interpreted-constructed the statutory provisions to provide a clear meaning and picture by ironing out the creases of law. Whereas, in 9 decisions, the Court only declared the principles but did not interpret-construct. No such case has been found where the court interpreted-constructed but did not declare the principles of trademark law. The judgments delivered in the first decade of 21<sup>st</sup> century are higher than the number of decisions delivered in the 20<sup>th</sup> century (which includes five decades after coming into being of the Supreme Court of India *i.e.*, 28 January 1950). Interesting thing to note is that no sitting Chief Justice of India was on the bench in any of the trademark cases decided in this decade. Also, no Single or Constitution Bench decision is reported. All the judgments are unanimous and without any separate concurring or dissenting judgments. The issue of constitutionality of trademark law was not brought before the Court in any of the cases. Hence, no such decision on the constitutionality of the Trade Marks Act is reported. In this decade, it has been observed that the Court in most of the cases relied upon its earlier decisions and applied and reiterated the principles declared in those cases while deciding the trademark cases. The focus of the Court in trademark cases has been the protection of interest of *unwary purchaser* from confusion or deception and protection of the rights of the trademark owner.<sup>106</sup> A review of decisions reveals that the writ jurisdiction of the Supreme Court was not invoked in any of the reported trademark matters in this decade. All the reported cases are Civil Appeal matters except one Criminal Appeal matter (*P D Lakhani v State of Punjab*).<sup>93</sup> From the review of reported decisions, it may be also be said that with more number of reported decisions on the trademark law in this decade, more clarity on the law has been provided by the Court through its law declaring<sup>1</sup> and interpretation-construction<sup>107</sup> powers.

## References

- 1 Raza A and Alam G, Patent Law Declared by the Supreme Court of India, *Journal of Intellectual Property Rights*, 28 (1) (2023) 46–67.
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- 3 Raza A and Alam G, Design Law Declared by the Supreme Court of India, *Journal of Intellectual Property Rights*, 28 (3) (2023) 236–241.
- 4 Raza A and Alam G, Trademark Law Declared by the Supreme Court of India in Twentieth-Century, *Journal of Intellectual Property Rights*, 28 (4) (2023) 334–346.
- 5 The decisions on trademark law have been taken from the Judgment Information System of the Supreme Court (JUDIS), <https://main.sci.gov.in/judgments> (accessed on 12 June 2023). For the purposes of citations: Supreme Court Reports (SCR), TruePrint copies from Supreme Court Cases (SCC), SCC OnLine, Supreme Court Almanac (SCALE) and All India Reporter (AIR) have been referred and relied upon. Where, the judgment is not reported in the above-mentioned judgment reporters, reliance has been placed on the judgment copy as available on JUDIS.
- 6 Act 47 of 1999.
- 7 *Vide* notification No. S.O. 1048(E), dated 15 September 2003, Gazette of India, *Extraordinary*, Part II, Section 3(ii).
- 8 Act 43 of 1958.
- 9 (2000) 3 SCC 250.
- 10 (2009) 2 SCC 768.
- 11 (2004) 6 SCC 145.
- 12 Act 9 of 1932.
- 13 (2000) 3 SCC 250, 257.
- 14 (2000) 3 SCC 250, 260.
- 15 (2000) 3 SCC 250, 261.
- 16 The Court explained it with an example: ‘If the plaintiff referred to such a contract it could only be as a historical fact. For example, if the plaintiff filed by the unregistered firm refers to the source of the firm’s title to a motor car and states that the plaintiff has purchased and received a Motor Car from a foreign buyer under a contract and that the defendant has unauthorisedly removed it from the plaintiff firm’s possession, it is clear that the relief for possession against defendant in the suit does not arise from any contract with defendant entered into in the course of plaintiff firm’s business with defendants but is based on the alleged unauthorised removal of the vehicle from the plaintiff firm’s custody by the defendant. In such a situation, the fact that the unregistered firm has purchased the vehicle from somebody else under a contract has absolutely no bearing on the right of the firm to sue the defendant for possession of the vehicle. Such a suit would be maintainable and Section 69(2) would not be a bar, even if the firm is unregistered on the date of suit. The position in the present case is not different.’ (2000) 3 SCC 250, 261.
- 17 (2000) 5 SCC 573.
- 18 The questions for consideration before the Court were: (i) Whether the defendant could, in the interlocutory proceedings, based on infringement and passing off, raise any defence that the registration of plaintiff’s mark was itself ‘invalid’ because the plaintiff’s mark did not satisfy the ingredients of clauses (a) to (e) of Section 9 (1) and was, in particular, not ‘distinctive’ as required by section 9(1)(e)?; (ii) Whether plaintiff could rely on the presumption in Section 31 and also contend that under Section 32 the ‘validity’ of the registration of the plaintiff’s mark had become conclusive on the expiry of 7 years long before defence was raised in the suit (such time reckoned from date of application for rectification under Section 23(1)) and whether there were any exceptions to the said bar? (iii) Whether, assuming that Sections 31 and 32 did not come in the way of the defendant, on merits the word ‘PIKNIK’ was not distinctive and did not satisfy section 9(1)(e)?; (iv) For grant of temporary injunction, should the Court go by principle of prima facie case (apart from balance of convenience) or comparative strength of the case of either parties or by finding out if the plaintiff has raised a ‘triable issue’?; (v) Whether, assuming that plaintiff’s registration was valid, the comparative strength of the case on the question of infringement is in favour of plaintiff?; (vi) Whether, alternatively, the plaintiff had made out that for grant of temporary injunction treating the suit as a ‘passing off’ action, the relative strength of the case, was in plaintiff’s favour?; and (7) Whether there was unreasonable delay on the part of the plaintiff in filing suit and whether the High Court was justified in interfering in appeal in interlocutory proceedings? (2000) 5 SCC 573, 586–587.
- 19 (2000) 5 SCC 573, 588.
- 20 (2000) 5 SCC 573, 589.
- 21 (2000) 5 SCC 573, 591.
- 22 (2000) 5 SCC 573, 591–592.
- 23 (2000) 5 SCC 573, 593.
- 24 (2000) 5 SCC 573, 594.
- 25 (2000) 5 SCC 573, 596.
- 26 1962 RPC 265 (HL).
- 27 (2000) 5 SCC 573, 597–598.
- 28 (2000) 5 SCC 573, 598.
- 29 (1900) 17 RPC 48.
- 30 (2000) 5 SCC 573, 600.
- 31 Act 5 of 1908.
- 32 (2000) 5 SCC 573, 601.
- 33 (2001) 5 SCC 73.
- 34 (2001) 5 SCC 73, 84.
- 35 (2001) 5 SCC 73, 80.
- 36 (2001) 5 SCC 73, 93.
- 37 (2001) 5 SCC 73, 94.
- 38 Act 23 of 1940.
- 39 (2001) 5 SCC 73, 94.
- 40 (2001) 5 SCC 73, 95.
- 41 (2002) 3 SCC 65.
- 42 (2002) 3 SCC 65, 71.
- 43 (2002) 3 SCC 65, 72.
- 44 (2002) 3 SCC 65, 73.
- 45 (2003) 1 SCC 129.
- 46 (2003) 11 SCC 92.
- 47 (2003) 11 SCC 92, 104.
- 48 (2003) 11 SCC 92, 105.
- 49 (2003) 11 SCC 92, 108.
- 50 (2003) 11 SCC 92, 108–109.
- 51 (2004) 6 SCC 145.
- 52 (2004) 6 SCC 145, 150.
- 53 (2004) 6 SCC 145, 151.
- 54 (2004) 6 SCC 145, 152.
- 55 (2004) 6 SCC 145, 156.
- 56 (2004) 12 SCC 624.
- 57 (2004) 12 SCC 624, 627–628.
- 58 (2005) 3 SCC 63.
- 59 (2009) 2 SCC 768.
- 60 (2005) 3 SCC 63, 68.

- 61 (2005) 4 SCC 194.  
62 (2005) 6 SCC 404.  
63 (2005) 6 SCC 404, 414.  
64 (2006) 1 SCC 185.  
65 (2006) 9 SCC 41.  
66 (2006) 9 SCC 41, 49.  
67 (2006) 9 SCC 41, 51.  
68 (2006) 9 SCC 41, 53–54.  
69 (2006) 9 SCC 41, 54–55.  
70 (2006) 9 SCC 41, 55.  
71 (2006) 9 SCC 41, 56.  
72 (2006) 6 SCC 213.  
73 (2006) 8 SCC 726.  
74 (2006) 8 SCC 726, 755.  
75 (2006) 8 SCC 726, 758.  
76 (2006) 8 SCC 726, 760.  
77 (2006) 8 SCC 726, 763.  
78 (2006) 8 SCC 726, 763–764.  
79 (2006) 8 SCC 726, 765.  
80 (2006) 8 SCC 726, 766.  
81 (2006) 8 SCC 726, 769.  
82 (2006) 8 SCC 726, 770.  
83 (2006) 8 SCC 726, 771.  
84 (2006) 8 SCC 726, 773.  
85 (2006) 8 SCC 726, 775.  
86 (2007) 10 SCC 632.  
87 (2007) 3 SCC 780.  
88 (2007) 3 SCC 780, 789.  
89 (2007) 3 SCC 780, 791.  
90 (2007) 3 SCC 780, 791–792.  
91 (2007) 6 SCC 1.  
92 (2007) 6 SCC 1, 7.  
93 (2008) 5 SCC 150.  
94 (2008) 10 SCC 595.  
95 (2008) 10 SCC 595, 606.  
96 (2008) 10 SCC 766.  
97 (2008) 10 SCC 766, 782.  
98 (2008) 10 SCC 766, 785.  
99 (2008) 10 SCC 479.  
100 (2008) 10 SCC 479, 493.  
101 (2009) 2 SCC 768.  
102 (2009) 2 SCC 768, 777.  
103 (2009) 2 SCC 768, 779.  
104 (2009) 2 SCC 768, 782.  
105 (2009) 2 SCC 768, 782–783.  
106 For a detailed discussion on the theoretical underpinnings of trademark law in the light of the reported decisions of the Supreme Court in last 72 years, *see*: Raza A and Alam G, Theoretical Underpinnings of Trademark Law: Decisions of the Supreme Court of India, *Journal of Intellectual Property Rights*, 27 (5) (2022) 351–366.  
107 In the paper, the expression ‘interpretation-construction’ has been used in the same sense as explicated by Lawrence B Solum. *See*: Solum L B, The Interpretation-Construction Distinction, *Constitutional Commentary*, 27 (2010) 95–218.