

‘Notable IP Division Decisions Pertaining to Section 11 of the Trade Marks Act, 1999’

Relevant Legal Provisions

❖ Section 11, The Trade Marks Act, 1999

“11. *Relative grounds for refusal of registration.*—

(1) Save as provided in section 12, a trade mark shall not be registered if, because of—

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”

Relevant Legal Provisions (Contd.)

❖ Section 11, The Trade Marks Act, 1999

(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented—

(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or

(b) by virtue of law of copyright.

(5) A trade mark shall not be refused registration on the grounds specified in sub-sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

(8) Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

Relevant Legal Provisions (Contd.)

❖ Section 11, The Trade Marks Act, 1999

(10) While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall—

(i) protect a well-known trade mark against the identical or similar trade marks;

(ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.

Relevant Judicial Decisions

❖ ***Manu Garg and Ratan Behari Agarwal v. Registrar of Trade Marks [C.A. (COMM.IPD-TM) 143/2021]***

“15. ...there must, additionally, exist a likelihood of confusion on the part of the public, for registration to be refused under Section 11(1). The provision also clarifies that “confusion” would include likelihood of association with the earlier trademark”

“19. ...Likelihood of confusion is not to be easily presumed. The nature of the goods and the class of their purchasers has to be borne in mind.”

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“22. ...Similarity, for the purposes of Section 11(1), has to be of the goods and services, not of the occasion of their user.”

Relevant Judicial Decisions (Contd.)

❖ *Lite Bite Travel Foods Private Limited v. The Registrar of Trademarks [C.A. (COMM.IPD-TM) 4/2021]*

“10. The impugned order reflects the view that mere similarity of the marks, of which registration is sought, is, by itself, sufficient as a ground to reject the application seeking registration. That, however, is not the position as it obtains in law.”

*“13. The existence, or otherwise, of likelihood of confusion is an issue of fact. **Until and unless, on facts, it is established that, owing to identity/similarity of the mark of which registration is sought, and of the goods/services covered thereby, with an earlier mark, there is likelihood of confusion/association in the mind of the public, registration cannot be refused on that ground.**” (Emphasis Supplied)*

Relevant Judicial Decisions (Contd.)

❖ *Twentieth Century Fox Film Corporation v. Registrar [C.A. (COMM.IPD-TM) 162/2022]*

“12 (i) ...No doubt, the two marks are phonetically similar and, perhaps, even identical. However, mere phonetic similarity is insufficient to render the marks identical or similar within the meaning of Section 11(1). The identity or similarity has to be such as would result in likelihood of confusion on the part of the public.” (Emphasis Supplied)

“12 (ii)When comparing marks for the purpose of assessing infringement, Section 17 of the Trade Marks Act specifically proscribes vivisection of marks into its individual components and holds that where a mark is registered as a whole, exclusivity is conferred on the whole mark, and not on individual parts thereof.”

Relevant Judicial Decisions

❖ *Jainsons Lights Private Limited v. Registrar of Trade Marks [C.A. (COMM.IPD-TM) 113/2021]*

“11. The unwary customer of average intelligence and imperfect recollection cannot be attributed the perspicacity to be able to recollect that, in one case, “lights” was spelt “Lites” and, in the other, “Lights”. Nor can the mere inclusion, in the subject mark, of the words “since 1978” be regarded as factors which would mitigate the possibility of such confusion arising in the minds of the customer of average intelligence and imperfect recollection as these are elements of a mark which may change from time to time.”

“18Though Mr. Grover emphasizes that the mark “JAINSONS” was being used since 1978, that is irrelevant. The court, while applying Section 34, has to take into account the claim of user in respect of the subject mark.....” (Emphasis Supplied)

Relevant Judicial Decisions (Contd.)

❖ *Armasuisse v. The Trade Mark Registry & Anr. [C.A. (COMM.IPD-TM) 158/2022]*

“125. Even read in the context of Sections 11(1) and 11(2) and the other clauses of Section 11(3), or vis-à-vis Section 9, therefore, the words “by virtue of any law”, as used in Section 11(3)(a), would appear to apply only to law which relates to protection of existing intellectual property of others”

“132.if the word “any law”, finding place in Section 11(3)(a) is to embrace all laws in force in India, the proscription would cease to be “relative” and would become “absolute”. It would, then, appropriately have to find place in Section 9, not in Section 11.” (Emphasis Supplied)

Relevant Judicial Decisions (Contd.)

- ❖ *Bennet, Coleman and Company Limited v. Vnow Technologies Private Limited and Anr. [C.O. (COMM.IPD-TM) 117/2021]*

“22.9 ...If, therefore, no opposition predicated on Section 11(2) or 11(3) was raised by the petition when the defendant’s mark was being considered for registration, the mark could not have been refused registration under Section 11(2) or 11(3). The corollary would, therefore, be that the grant of registration to the mark cannot be said to be improper, illegal or vitiated as being violative of Section 11(2) or 11(3)”

“22. 10 As, admittedly, no opposition, predicated on Section 11(2) or 11(3) was raised by the petitioner at the time when the defendant’s mark was proceeding to registration, the petitioner cannot urge Section 11(2) or 11(3) as a ground to seek its cancellation or variation.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *BPI Sports LLC v. Saurabh Gulati & Anr. [C.O. (COMM.IPD-TM) 16/2021]*

“38.11 ...Having imported the petitioner’s goods under the BPI SPORTS word and device mark, and having noticed the existence of a market for the goods and, perhaps, influenced by the global goodwill that the mark commanded, Respondent 1 has, for reasons recondite, obtained registration of the petitioner’s mark in his name for the very goods in respect of which, albeit abroad, the mark stood registered in favour of the petitioner. The motivation, for doing so, is apparently unwholesome.” (Emphasis Supplied)

“39. ... Though, therefore, I am not of the view that the petitioner is entitled to relief for the grounds of Section 11(2) and (3) urged in the petition, nonetheless, as the facts urged in the petition make out a case of bad faith adoption of the impugned mark by the respondent, ergo, invoking Section 11(10)(ii) of the Trade Marks Act.” (Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ *Tata SIA Airlines Limited v. Union of India [W.P.(C)-IPD 64/2021]*

*“14. ... A conjoint reading of Section 11(8) of the Act and Rule 124(1) shows that the Scheme of the Act provides two different and distinct mechanisms for determination of a trademark to be a well-known mark viz. (a) by a Court or Registrar, which is covered by Section 11(8); and (b) by the Registrar on an application in accordance with the procedure prescribed under Rule 124 read with the relevant Schedules. **This unambiguously connotes that either the Court or the Registrar can determine a trademark to be a well-known mark and it goes without saying that if either one of them has determined the trademark to be a well-known trademark, the other cannot and therefore no proprietor can be relegated to a second route.**”*

(Emphasis supplied)

Relevant Judicial Decisions (Contd.)

❖ **Fybros Electric Private Limited v. Vasu Dev Gupta Trading as Vasu Electronics [C.O. (COMM.IPD-TM) 13/2021]**

“27. ...The expression “covered by the trademark” cannot be equated, in my view, with the words “in respect of which the mark is used”. Coverage of a trademark has to be decided on the basis of the certificate of registration which sets out the goods in respect of which the trademark is registered. All such goods would be “covered by the trademark”.

“41. ... Bona fide adoption is not a ground on which the rigour of Section 11(1)(b) can be avoided. No doubt, Section 11 is subject to Section 12. Section 12, however, does not deal with bona fide adoption but deals with honest and concurrent user. Honest and concurrent user, as a principle of trademark law, has its own ingredients” (Emphasis Supplied)

Relevant Judicial Decisions (Contd.)

❖ *Raj Kumar Sharma v. Sandeep Kumar & Anr. [C.O.(COMM.IPD-TM) 39/2021]*

“18. ...Though the petitioner’s application, dated 31st August 2020, for registration of the device mark, and the respondent’s application dated 1st February 2021 for registration of the “PIZZA GALLERIA” word mark were for different classes, that cannot make any difference, as the applicability of Section 11(1) is not dependent on the class in respect of which the marks are registered, or registration of the marks is sought.”

(Emphasis supplied)

Conclusion

- ❖ From the cases mentioned in this seminar, and also from other decisions of the High Court of Delhi questioning the Trade Marks Registry for lack of reasoned decisions/orders vis-à-vis provisions of Trade Marks Act, 1999, there is an evolving practice-oriented approach that is being adopted by the IP Division of High Court.
- ❖ In the cases discussed in this seminar, while there were several questions answered by the High Court of Delhi, there continue to be issues which would require further consideration of the Courts. Issues such as reconciliation of the “dominant part” principle vis-à-vis anti-dissection principle, and similarity of goods across different class in light of “likelihood of confusion” as enumerated in Section 11(1) continue to derive different decisions from different benches without any harmonious way to interpret the provisions.

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THANK YOU!
Questions?

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