

## Legal Issues - Seminar Series

### Legal Issues in 'IP in Fonts & Characters'

**Issue: Is there a threshold for the stylization of font in determining the likelihood of confusion?**

## Related Provisions

### ❖ Section 29(2) of the Trademarks Act, 1999

*2) A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of—*

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

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

*(c) its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark,*

*is likely to cause confusion on the part of the public, or which is likely to have an association with the registered trade mark.* (emphasis supplied)

## Relevant Judicial Decisions

- ❖ *Cadila Healthcare Ltd. v. Diat Foods (India) [FAO (OS) No. 385 of 2008], Judgement dated Septemeber 20, 2010, Delhi High Court*

“21. We are, thus, of the view that the three expressions—‘SUGAR FREE’, ‘SUGARLESS Bliss’ and ‘Splenda’ should be used in equal prominence and no extra prominence should be given to ‘SUGAR FREE’. **The font size of ‘SUGAR FREE’ can hardly be expected to be larger than of ‘SUGARLESS Bliss’ or the expression ‘Sweetened with Splenda’.** We are not insisting that all the three must be used in identical font size as in designing a packaging an artistic balance has to be maintained, but suffice to say that in whatever prominence and font size ‘SUGARLESS Bliss’ and ‘Sweetened with Splenda’ are used (they can be of different prominence or sizes), ‘SUGAR FREE’ should not be used in a more prominent manner/font size as is sought to be done even in the proposed modified carton.” (emphasis supplied)

## Relevant Judicial Decisions

- ❖ *Advance Magazine Publishers, Inc. and Ors. vs. Just Lifestyle Pvt. Ltd. [Notice Of Motion (L) NO.2125 OF 2015 In Suit No.32 Of 2016], Judgement dated September 19, 2016, Bombay High Court*

“23. .... It is important to note that whilst the Plaintiffs' registered trade mark is the word "VOGUE", the Defendant in its impugned mark is not using the word simplicitor but in conjunction with two other words, namely, "JUST" and "IN VOGUE". **Besides, the Defendant's mark is a device mark, which is rendered in a distinctive style of writing with the word "JUST", which is part of the corporate name of the Defendant, being prominently displayed above the words "IN" and "VOGUE" and in a font size which is significantly larger (said to be four times that of the word 'VOGUE' used in the mark). The word 'JUST' is further emphasized by an underline below it and is written in Italics. The font and writing style used by the Defendant for the word 'VOGUE' are also not similar to the font/writing style used by the Plaintiffs for its trade mark 'VOGUE'. All this indicates that there is no per se visual, phonetic and structural similarity between the two marks, when they are compared as a whole, that is to say, without breaking them into parts for comparison.**”

(emphasis supplied)

## Relevant Judicial Decisions (contd.)

❖ *Yahoo Inc vs Mr Rinshad Rinu & Ors. [CS(COMM) 668/2016], Judgement dated July 03, 2017, Delhi High Court*

8. *This Court is of the opinion that the adoption of the YAHOO mark by the defendants is dishonest as is evident from the fact that **the font used by the defendants to represent YAHOO in their trading name is identical to the unique stylized font which the plaintiff used to represents its YAHOO trade mark till 2014.** There is also no plausible explanation for the adoption of the identical mark as part of trading name and domain name of the defendants. Further, the defendants cannot have any justification for the adoption of the mark YAHOO. The potentiality of harm is enormous on the internet as the plaintiff has a very wide internet presence and operates various YAHOO formative websites.*

## Relevant Judicial Decisions (contd.)

- ❖ *Shri Shakti Schools Private Limited vs M/S. Chirec Public School [Civil Miscellaneous Appeal No.160 OF 2020], Judgement dated July 03, 2020, Telangana High Court*

28. *It agreed with the contention of the respondent that a comparative study of the trade mark used by both parties showed that the respondent is using the word 'CHIREC' with a logo on both sides of the name and their name is written only in blue colour with same font, while the trade mark used by the appellant is in different colours, i.e., red, green and blue and the description of the name 'CHIREC' is in different font in different style and the term is used without any logo.*

47. *The Court below as well as this Bench had perused the trade mark being used by both the parties. Prima facie it appears that the respondent is using the word 'CHIREC' with a logo and its name is written only in blue colour with same font, but the appellant is using the said trade name with different style and with different font without any logo.*

## Relevant Judicial Decisions (contd.)

- ❖ *Sujata Chaudhri Vs. Swarupa Ghosh [C.S. (Comm) 732/2022 and I.A. 17155/2022-17157/2022], Judgement dated October 19, 2022, Delhi High Court*

*“23. The Plaintiff's logo is a part of the registered mark bearing No. 2823275 in class 45 wherein the stylized SC device mark is clearly visible. The said SC device mark forms an inalienable part of the said registration. Under such circumstances, the use of an almost identical logo in respect of identical services would be violative of the Plaintiff's statutory and common law rights. **The mere fact that the font may be an openly available font does not mean that the same very font has to be used by the Defendant, from amongst the thousands of font options that are available.** The Plaintiff has, bonafidely attempted amicable resolution prior to the filing of the present suit which has also not borne any result. Clearly, therefore, the intervention of the Court would be needed in these facts. (emphasis supplied)*

## Conclusion

- ❖ While the size and design of the font may seem to offer some level of distinction, it is not the sole determinant of whether a mark is likely to cause confusion. Courts, in various case laws such as Advance Magazine Publishers and Cadila Healthcare Ltd., have emphasized that it is the overall impression of the mark — considering its visual, phonetic, and conceptual similarity — that matters in assessing the likelihood of confusion.
- ❖ A certain threshold of stylization in the font may indeed reduce the risk of confusion, but only if such stylization is sufficiently unique and distinct and does not lead to a similar overall impression of a registered trademark.
- ❖ Therefore, while font stylization can be an important factor, it is just one aspect among many that must be considered in determining whether trademark infringement exists. Ultimately, each case will depend on the specific facts, including the degree of similarity between the marks and the likelihood of public confusion, as mandated by Section 29(2).

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# THANK YOU!

## Questions?

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