

**TRADEMARK INFRINGEMENT IN INDIA: ANALYSIS OF CASES AND  
LEGAL IMPLICATIONS**- Aravamudhan G & Nithin K<sup>1</sup>**ABSTRACT**

India is well known for its highly competitive business environment, moreover after the pandemic [covid] India became an attractive manufacturing hub, as a result of many MNCs entering the market as well as the Indian startup economy crossed the major milestone as it added the hundredth unicorn club in 2022. In such a crucial situation infringement of intellectual property rights becomes the biggest threat. The pharmaceuticals, information technology, consumer goods, and e-commerce industry has built a simple and clear path for trademark infringement not only in India, all across the world. This research paper focuses on several trademark infringement cases in India.

**KEYWORDS**

Intellectual Property Rights, Trademark, Infringement

**INTRODUCTION**

As is well known, In India the trademarks are protected under Trademark Acts, 1999. This Act establishes the Law governing trademark registration, protection, and penalties for infringement. The term infringement of registered trademark has been defined exclusively under section 29 of the Trademark Acts, 1999.

Trademark infringement is defined as the unauthorized use of a trademark or service mark. This may be related to a product or service and may cause confusion, deception, or misunderstanding

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about the actual entity from which the product or service is based. Trademark owners may take legal action if they believe that their registered trademark is infringed. If the trademark infringement is proved before the court, the concerned court may pass an injunction order against the defendant to use the trademark which is related to the plaintiff, and may award monetary compensation in certain circumstances.

### **BURDEN OF PROOF**

In the case of the trademark, it's the plaintiff's responsibility to prove any trademark violation. The honorable Supreme Court addressed the issue of burden of proof in an action for trademark infringement in the *DUTTA SHARMA V. NAVARATNA PHARMACEUTICALS LABORATORIES* case

In these cases, the court held that the "course of trade" the question of whether there has been an infringement is to be decided by the comparison of the two marks. Where the two marks are identical no question arises, but when the two marks are not identical the only proof lies with the party bringing the lawsuit in a case involving trademark infringement.

### **OVERALL SIMILARITY IS SUFFICIENT**

The trademark must be analyzed as a whole for misleading resemblance." Deceive or cause of confusion" are the two important factors that are taken into consideration by the court for deciding the similarity of two competing trademarks. In 1972, The Honorable Supreme Court gave a clear expression on overall similarity in the case name called *PARLE PRODUCTS V. JP & CO LTD*

In this case, the court held that the broad and basic elements of two marks are taken into consideration to determine if one mark is deceptively similar to another mark. The keeping of infringement marks and infringing mark side by side to find out the necessary differences in design is not necessary. The Supreme Court believes that it is not necessary to specify how many points are similar and how many are different. Instead, it might suffice if the contested mark is sufficiently similar to the registered mark generally to make someone who normally deals with one mistakenly believe the other if it were presented to them.

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## **BRAND NAME AND BRAND POSITIONING**

During the infringement trial, the consent court not only observes [consider] the prefix and suffix of a both brand name and products name, but it also considers the brand logo and its color, the reputation of the brand among the public, and how much amount the brand spent on advertisement and publicity things. From the earlier stage, the cases related to the infringement of brand name and positioning become the biggest threat to intellectual property rights, as a result, the court gives more focus and attention to it and laid down principles in its judgment, which are as follows,

### *4.1 FEVICOL V. TREVICOL*

(Pidilite Industries Pvt.Ltd V. Mittes Corporation And Anr.)

Fevicol has been on the market since 1960, and the trademark was filed in the same year. It sold a lot of units, and Pidilite spent a lot of money on advertising and promotion for the brand. Pidilite sues the makers of Trevicol, a competing product. In 1985 the trademark Trevicol was first used. In 1987, a lawsuit was filed. In both marks, the suffix “VICOL” was used. Prefixes “FE” and “TRE” was the only one that differed. However, when both were said together, they sounded very similar. The names of the companies, Pidilite and Mitees, were typed in the same way. Both marks had a blue lettering style that was nearly identical. The Fevicol mark has elephants pulling aside a sphere, in Trevicol there had been ships in the location of the elephants. The customers of each of those merchandise blanketed a massive section of the illiterate populace like carpenters or civil contractors.

In the view of above, The Judgement was concluded as:

Both phonetically and aesthetically, the two markings were deceptively similar. The packet's color scheme and appearance were nearly identical, and the general public was likely to be misled. Trevicol was found illegal and was phased out after Fevicol won the case.

### *4.2 STARBUCKS COFFEE V. SARDARBUKSH COFFEE*

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This a humorous yet intriguing instance in which the well-known Starbucks was victimized by the clever brains of Indian trademark infringers, who used Sardar instead of Star in such a deceptive and large-scale manner that people were led to believe they were owned by the same person. The court, on the other hand, granted the defendant the right to use a modified version of the trademark Sardar Baksh to Sardarji Baksh, as well as the right to sue anyone who uses Baksh in the future.

### **COMPARATIVE ADVERTISING IN CERTAIN CASES LEADS TO INFRINGEMENT**

In certain cases, comparative advertising that discredits a competitor's trademark or trade name is not permitted. In the PEPSI V. COCA-COLA PVT LMT case, the Delhi High Court exclusively stated that

- Intent of commercial
- Manner of commercial
- Storyline of commercial

Out of the above the manner of the commercial is very important, a tradesman or company can claim that his products are the best or better in the market however, the tradesman cannot disparage or degrade the competition goods nor can he term them bad or inferior based on comparison.

### **INTENTION TO DECEIVE IS NOT NECESSARY**

It is something drastically vary from the penal laws, In penal laws intention is a very important aspect but in trademark infringement cases the intention is not necessary even though the defendant knowingly infringed the registered trademarks that don't take into consideration by the honorable court. As a KIRLOSKAR DIESEL RECON LTD V. KIRLOSKAR PROPERTIES LTD., the supreme court made the following observations on 'passing off action, the plaintiff is not necessary to prove the fraudulent intention on the part of the defendant.' Therefore, the established legal principle is that fraud is not a need for passing off a claim. As stated quite explicitly by the supreme court IN LAXMIKANT PATEL V. CHETANBHAI SHAH casewhere there is a likelihood of confusion in a business an injunction is to be granted even if the

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defendants adapted the name innocently. As well as the Honorable Supreme Court described the three elements of passing off action

- Reputation of goods
- Probability of deception; and
- Likelihood of deception’’

## RELIEFS

According to section 135 of the Trademark Acts 1999, in a suit for ‘infringement’ or ‘passing off of the trademark, ‘the aggrieved party may obtain the following reliefs;

### *a. Injunctions*

Injunction relief is an effective remedy to prevent infringement of a registered trademark or disclosure of a registered or unregistered trademark, as a court-issued injunction prevents a person from proceeding further. The trademark owners prevent unauthorized use of trademarks by appealing for prohibition injunction by court order. Injunctive remedies allow trademark owners to prohibit others from using similar trade mark and prevent others from monetizing the reputation and goodwill gained by their trademarks.

Similarly in MAHENDRA & MAHENDRA PAPER MILLS LTD V. MAHINDRA & MAHINDRA LTD The plaintiff’s name, Mahindra & Mahindra, and the defendant’s trade name Mahendra & Mahendra is practically an exact match in terms of phonetics, appearance, and structural similarity. Mahendra & Mahendra’s trade name is misleadingly similar to Mahindra & Mahindra’s trade name, hence the supreme court maintained the High Court’s injunction order prohibiting the defendant from using the trade name ‘‘Mahendra & Mahendra’’ in the plaintiff’s favor.

### HONDA MOTORS CO. LTD V. CHARANJIT SINGH & ORS.

Charanjith Singh & Ors used the Honda trademark for vehicles and power equipment. The plaintiff has built a worldwide utilizing the trademark Honda for its cars and power equipment over the five decades. While the defendant only began using the mark for its pressure cookers.

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The court ruled that the defendant's use of the trademark for its pressure cooker has the effect of tarnishing the plaintiff's reputation around the world because consumers may purchase the defendant's product believing to be from the same sources as Honda of Japan. Defendants were prohibited from using Honda's trademark.

*b. Damage*

Damages are the compensations awarded to the plaintiff by the defendant for the legal injury caused by him to the plaintiff. Damages are the notional compensation paid to the plaintiff irrespective of the actual amount of loss suffered by the plaintiff. The honorable Delhi High Court, the case named Prestige Housewares LTD V. Dinesh Gupta stated that The respondent was not only prohibited from using the trade name PRESTIGE to sell pressure cooker spare parts because it was confusingly similar to the trade name PRESTIGE belonged to the plaintiff. In this instance, the plaintiff was not only successful in stopping the defendant from using the trademark PRESTIGE but also received a settlement of Rs 25,000/- in damages and Rs 35,000/- in court costs.

## CONCLUSION

In conclusion, trademark infringement poses a significant threat to intellectual property rights in India, particularly in industries such as pharmaceuticals, information technology, consumer goods, and e-commerce. The burden of proof lies with the plaintiff to establish trademark violation, and overall similarity between trademarks is a crucial factor in determining infringement. The court considers various aspects, including brand name, brand positioning, and comparative advertising, in infringement cases. Intent to deceive is not a requirement for trademark infringement, and the court can grant reliefs such as injunctions to protect the rights of trademark owners. It is essential for businesses to understand the legal framework and take necessary measures to safeguard their trademarks in India.

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