



INTERNATIONAL LAW  
JOURNAL

---

**WHITE BLACK  
LEGAL LAW  
JOURNAL  
ISSN: 2581-  
8503**

*Peer - Reviewed & Refereed Journal*

The Law Journal strives to provide a platform for discussion of International as well as National Developments in the Field of Law.

[WWW.WHITEBLACKLEGAL.CO.IN](http://WWW.WHITEBLACKLEGAL.CO.IN)

### **DISCLAIMER**

No part of this publication may be reproduced or copied in any form by any means without prior written permission of Editor-in-chief of White Black Legal – The Law Journal. The Editorial Team of White Black Legal holds the copyright to all articles contributed to this publication. The views expressed in this publication are purely personal opinions of the authors and do not reflect the views of the Editorial Team of White Black Legal. Though all efforts are made to ensure the accuracy and correctness of the information published, White Black Legal shall not be responsible for any errors caused due to oversight or otherwise.

WHITE BLACK  
LEGAL

## **EDITORIAL TEAM**

### **Raju Narayana Swamy (IAS) Indian Administrative Service officer**



Dr. Raju Narayana Swamy popularly known as Kerala's Anti-Corruption Crusader is the All India Topper of the 1991 batch of the IAS and is currently posted as Principal Secretary to the Government of Kerala. He has earned many accolades as he hit against the political-bureaucrat corruption nexus in India. Dr Swamy holds a B.Tech in Computer Science and Engineering from the IIT Madras and a Ph. D. in Cyber Law from Gujarat National Law University. He also has an LLM (Pro) (with specialization in IPR) as well as three PG Diplomas from the National Law University, Delhi- one in Urban Environmental Management and Law, another in Environmental Law and Policy and a third one in Tourism and Environmental Law. He also holds a post-graduate diploma in IPR from the National Law School, Bengaluru and

a professional diploma in Public Procurement from the World Bank.

### **Dr. R. K. Upadhyay**

Dr. R. K. Upadhyay is Registrar, University of Kota (Raj.), Dr Upadhyay obtained LLB, LLM degrees from Banaras Hindu University & PHD from university of Kota. He has successfully completed UGC sponsored M.R.P for the work in the Ares of the various prisoners reforms in the state of the Rajasthan.



## **Senior Editor**

### **Dr. Neha Mishra**



Dr. Neha Mishra is Associate Professor & Associate Dean (Scholarships) in Jindal Global Law School, OP Jindal Global University. She was awarded both her PhD degree and Associate Professor & Associate Dean M.A.; LL.B. (University of Delhi); LL.M.; PH.D. (NLSIU, Bangalore) LLM from National Law School of India University, Bengaluru; she did her LL.B. from Faculty of Law, Delhi University as well as M.A. and B.A. from Hindu College and DCAC from DU respectively. Neha has been a Visiting Fellow, School of Social Work, Michigan State University, 2016 and invited speaker Panelist at Global Conference, Whitney R. Harris World Law Institute, Washington University in St. Louis, 2015.

### **Ms. Sumiti Ahuja**

Ms. Sumiti Ahuja, Assistant Professor, Faculty of Law, University of Delhi,

Ms. Sumiti Ahuja completed her LL.M. from the Indian Law Institute with specialization in Criminal Law and Corporate Law, and has over nine years of teaching experience. She has done her LL.B. from the Faculty of Law, University of Delhi. She is currently pursuing PH.D. in the area of Forensics and Law. Prior to joining the teaching profession, she has worked as Research Assistant for projects funded by different agencies of Govt. of India. She has developed various audio-video teaching modules under UGC e-PG Pathshala programme in the area of Criminology, under the aegis of an MHRD Project. Her areas of interest are Criminal Law, Law of Evidence, Interpretation of Statutes, and Clinical Legal Education.



### **Dr. Navtika Singh Nautiyal**

Dr. Navtika Singh Nautiyal presently working as an Assistant Professor in School of Law, Forensic Justice and Policy Studies at National Forensic Sciences University, Gandhinagar, Gujarat. She has 9 years of Teaching and Research Experience. She has completed her Philosophy of Doctorate in 'Inter-country adoption laws from Uttarakhand University, Dehradun' and LLM from Indian Law Institute, New Delhi.

### **Dr. Rinu Saraswat**



Associate Professor at School of Law, Apex University, Jaipur, M.A, LL.M, PH.D,

Dr. Rinu have 5 yrs of teaching experience in renowned institutions like Jagannath University and Apex University. Participated in more than 20 national and international seminars and conferences and 5 workshops and training programmes.

### **Dr. Nitesh Saraswat**

E.MBA, LL.M, PH.D, PGDSAPM

Currently working as Assistant Professor at Law Centre II, Faculty of Law, University of Delhi. Dr. Nitesh have 14 years of Teaching, Administrative and research experience in Renowned Institutions like Amity University, Tata Institute of Social Sciences, Jai Narain Vyas University Jodhpur, Jagannath University and Nirma University. More than 25 Publications in renowned National and International Journals and has authored a Text book on CR.P.C and Juvenile Delinquency law.



### **Subhrajit Chanda**



BBA. LL.B. (Hons.) (Amity University, Rajasthan); LL. M. (UPES, Dehradun) (Nottingham Trent University, UK); PH.D. Candidate (G.D. Goenka University)

Subhrajit did his LL.M. in Sports Law, from Nottingham Trent University of United Kingdoms, with international scholarship provided by university; he has also completed another LL.M. in Energy Law from University of Petroleum and Energy Studies, India. He did his B.B.A.LL.B. (Hons.) focussing on International Trade Law.

## ***ABOUT US***

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provide dedicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

# **TRADEMARK REGISTRATION IN INDIA: AN OVERVIEW OF PROCEDURE AND PRACTICE**

AUTHORED BY - DR.N.DEVANATHAN & DR.V.REKHA,

## **Abstract:**

Trademark law protects a trademark owner's exclusive rights to use the mark, thereby preventing any unlawful use of the mark by an infringer. A trademark protects the mark from any unauthorized use of the mark that shall cause confusion in the minds of the general public. Whenever the plaintiff proves that the defendant has caused confusion in the minds of the public by using the same or a similar mark, a trademark infringement claim shall prevail. The purpose of a trademark is to give exclusive recognition as well as protection to a trademark owner. A claim for infringement will take place in case of a registered trademark. The first and foremost task of the trademark owner is to prove that the prior mark has a very high degree of reputation and the infringed mark is similar to his mark and which would cause confusion or deception regarding the product in the market. A trademark is generally protected to get maximum protection, although unregistered trademarks also get protection under other circumstances. This academic paper endeavors to probe into the role that trademark law plays in the protection and building of brands. The research is carried out by employing a doctrinal research methodology, with the study founded upon an in-depth analysis of the legal instruments that govern trademark law, along with case law and relevant academic literature.

Keywords: Trademark law, Intellectual property, Infringement, Legal protection, Registration.

## **Introduction**

The ability to transmit impulses allows logos to have several meanings. The name "Chiemsee" is also the name of Germany's biggest lake.<sup>1</sup> It may be used to tell windsurfing gear from other brands. As a protected brand, "Barbie" refers to the most famous doll in the world. It also refers to a blonde girl who is shy and maybe a little stupid. Lots of these connections have grown over time; that's why they're okay when enough people see these symbols as "indicating" a certain meaning.

---

<sup>1</sup> Trademarks and related rights, *available at* [https://www.elgaronline.com/monochap/9781781003459/15\\_chapter5.xhtml](https://www.elgaronline.com/monochap/9781781003459/15_chapter5.xhtml) (last visited on September 11 2025)

People who own trademarks can also use ads to make their signs more important or more appealing to people. The idea of idiosyncrasy explains why trademarks can have more than one meaning at the same time, such as meanings in business, culture, society, and politics. If third parties are not allowed to have exclusive rights, it could put too much of a load on people and make other opinions useless or limit their freedom of speech. It might be too hard to keep other people out, but it might make sense to give the owner of brand exclusive rights over some of these meanings, especially the unique one.<sup>2</sup>

### **History and Development of the Trade Mark Laws India**

Common law and equitable principles were the primary means by which intellectual property rights associated with a trademark were protected in India prior to the development of legislative statutes relevant to trademark law and practice. The majority of Indian laws are derived from English laws, which were substantially incorporated into the creation of Indian sub continental laws before to the country's independence.

Following the passage of the English Act of 1875, which created trademark protection in England, a similar Bill was introduced in India. This was a catalyst for the adoption of the bill. After that, the Bombay Chamber of Commerce and the Mill Owner's Association sent a petition to the Bombay Government, requesting that the Bombay Legislative Council be given the responsibility of introducing a bill that was fashioned after the English Act. For the purpose of soliciting comments from the general public, the Central Government addressed the matter in 1879 and distributed the Trade Mark Bill. In spite of this, the Bill was met with significant opposition from well-established interests and the corporate sector, which ultimately led to its abandonment.<sup>3</sup>

The necessity for a legislation specifically governing trademark practice and process in India was reiterated in the 19th century, culminating in the enactment of the Trade Mark Act, 1940. The Trade Mark Act of 1940 primarily mirrored the stipulations included in the UK Trade Mark Act of 1938. Consequently, with the advancement of trade and commerce, the Trade Mark Act of 1958 was enacted to rectify the deficiencies observed in the Trade Mark Act of 1940. The Trade Mark Act of 1958 combined the provisions related to trade markings under

---

<sup>2</sup> The Institutional Repository of the University of Amsterdam *available at* <http://dare.uva.nl/> documents, (last visited on August 28,2025)

<sup>3</sup> TR Srinivas Iyengar, —*Commentary on Trade Marks Act*l, (Universal Law Publication, New Delhi, 2011).

the Indian Penal Code<sup>4</sup>, the Criminal Procedure Code<sup>5</sup>, and the Sea Customs Act<sup>6</sup>. In the case of *Gujarat Bottling Co. Ltd. v. Coca-Cola Co*<sup>7</sup>, the Supreme Court of the United States ruled that the Trade Marks Act of 1940 was the first piece of legislation to establish the framework for the registration and statutory protection of trademarks in this country. Prior to the year 1940, the legal framework that governed trademarks in India was established on common law ideas that were comparable to those that were used in England prior to the introduction of the Trade Marks Registration Act of 1875. The Trade Marks Act of 1999 provides for the modification and consolidation of the existing legislation pertaining to trade marks, as well as the facilitation of registration, the enhancement of protection for trade marks for products and services, and the prevention of the use of artificial marks.<sup>8</sup>

### **Meaning and definition of Trademarks:**

#### **Definition:**

A logo is a unique word, phrase, picture, sign, design, symbol, or mix of these things that a business, group, or manufacturer uses to help people find and recognize it.

The following is a shortened form of the description that can be found in Wikipedia as well as in other sources available from the literature world:-

*“Trademarks are well-known signs or images that stand for companies, businesses, or groups. The unique thing about a product could be a name, sign, style, symbol, brand, motto, picture, or anything else that makes it stand out from the company's other products.”*

It is possible for anyone, even businesses and other legal groups, to own the brand. While the brand doesn't have to be on the product itself, it can be on the box, label, or coupon that holds the product. To keep their brand consistent, many businesses put their name on buildings. In the United States, a brand that is used for services instead of things is called a "service mark."<sup>9</sup>

#### **Role of Trademarks:**

Since a brand's primary function is to identify the source of products and services, one way to

---

<sup>4</sup> The Indian Penal Code, 1860 (45 of 1860).

<sup>5</sup> The Code of Criminal Procedure, 1973 (2 of 1974).

<sup>6</sup> The Sea Customs Act, 1878 (18 of 1878).

<sup>7</sup> (1995) 5 SCC 545, p 556.

<sup>8</sup> *Meghraj Biscuits Industries Ltd v. CCE* (2007) 3 SCC 780, p. 788.

<sup>9</sup> What is a trademark? available at <https://www.uspto.gov/trademarks/basics/what-trademark>, (last visited on September 11 2025)

conceive of it as a symbol of the product's origin. Having a registered mark gives you several additional benefits. That is exactly what the title says.

1. An entity needs a name to indicate the origin of a commodity or service.
2. Because this particular product differs from others of its kind.
3. Customers benefit from it as it makes it simple for them to locate items that belong to particular individuals.
4. Distinguish them from other items in the same category; identifying them is crucial.
5. It may assist maintain or even improve the items' quality and standard.
6. Helps individuals make the best decision by offering guidance and recommendations.
7. Maintaining high standards helps the company's reputation by enhancing its brand.
8. When you sell a product, you may utilize it to help develop a brand.

### **Essential features of Trademark:**

Thanks to progress in technology, things can now be made that have more perceptive powers than humans could have imagined using their five senses alone. But it's hard to register these brand names because the law is complicated and there isn't a uniform way to do things.

Based on what we can see, the rules about brand names in some countries don't actually say that non-traditional brand names can't be used as brand names. In other words, they are a real security issue. These gadgets can do a lot more than just show what they are. They can also tell you what they are by touching them. These identities are made up of surface, shape, sound, smell, and taste.

### **How the law sees trademarks? :**

Trademarks are usually made through business, but once they are registered with the right people in a certain area, only that person can use the name and protect it from strong competition. Since trademarks are officially a type of property, the owner has the right to the intellectual property rights that come with the registered brand. If someone steals someone else's property, they could be punished by the law. In most countries, you need to register a trademark before you can do this kind of business officially.

- a. In the vast majority of countries, you need to follow these three main steps in order to register a trademark:
- b. If it can tell the difference between the two companies' goods and services.

- c. With this method, consumers are not tricked about the link between the two parties, and there is no room for doubt about where the things came from.
- d. The traits of the goods are not laid to the customer in any way.

### **Trademarks: Objectives, Scope, Types, and Varieties:**

Companies around the world are using more and more creative logos along with standard word marks or devices. This is because there are more ways to sell brands now, and our digital world has grown recently. These recently registered logos can be used for business deals and to show where the goods came from. On the other hand, some brands don't do what most people think is right and instead appeal to all five senses. It's possible that they could work together.

Any signs that can be seen, like shapes, colors, movements, holograms, and so on; or something you can't see, like sounds, tastes, smells, or feelings. According to the 2015 Draft Manual of Trademarks Practice and Procedure of the Indian Trademark Registry, trademarks can include things that make a product stand out, such as color, sound, shape, packing, and smell.<sup>10</sup> Different countries protect these marks in different ways, depending on where they are used. It's not impossible that a mark could be protected in some countries but not in others. Here is a list of the most popular types of non-traditional trademarks that can be registered around the world:

#### **Scent or perfume or aroma is an olfactory mark:**

Taking everything into account, it can captivate and amaze both large and small groups. In order to attract other people, it might be smart to use smells that make people feel good. This is because people can smell things that make them feel good. Using perfumes and colognes that reflect a business's goods and services can improve the connection between the customer and the institution. This is especially important in business, where getting new customers is important for many reasons and through many channels.

However, trademark law says that the chosen sign or term cannot explain or express the nature, makeup, or unique qualities of the goods or services it stands for. This condition needs to be

---

<sup>10</sup> Sr. No. 3.2.4 of Draft Manual, 2015 at 143, available at: [http://www.ipindia.nic.in/tmr\\_new/TMR\\_Manual/TMR\\_DraftManual\\_11March2015.pdf](http://www.ipindia.nic.in/tmr_new/TMR_Manual/TMR_DraftManual_11March2015.pdf) (last visited on August 20, 2025).

met.<sup>11</sup> The legality of descriptive titles is harmed because they don't have the authority and respect they need. When it comes to logos, detailed marks are those that tell you something about the goods or services they represent. These marks all tell us something about the mark, like what it is or how it was made. So, if the smell is mostly made from the product's ingredients, it could be a good sign of its quality.

### **Sound Marks:**

i) *Sound trademarks are also called aural marks or audio signatures*

The sound of the famous Tarzan yell;<sup>12</sup> merrie melodies theme song;<sup>211</sup> the spoken letters \_AT & T<sup>13</sup>; the sound \_ooh it's so good<sup>14</sup>; the melody \_sweet Georgia Brown<sup>15</sup> sound patterns in the US are well known for things like and so on. In India, sound marks that can be shown clearly are not prevented from being registered. There were two sound marks registered by the Indian Trade Marks Registry in 2011.

The first was "dhin chik dhin chik" by ICICI. Google recognized the sound mark "yodel" as the first one in 2008. US, AU, DK, F, G, IE, IT, OHIM, SP, UK, Norway, and SWISS are some of the countries that can read sound fingerprints. There needs to be an answer to the following question: are other traders likely to want to use the sound in the normal course of their business, without any bad intentions?

### **Marks on the touchable Sometimes:**

By feeling the material of the mark, you can figure out what things or items are being made. In the business world, touch is one of several senses that can show if something exists and how appealing it is.<sup>218</sup> This is likely because of trade signs. These marks, which are sometimes called touch marks or texture marks, tell people about the products or services they represent by showing what they mean and how they feel. Customers need to be able to tell the touch mark from other marks; it can't just be a style choice. A trademark must be able to identify the goods or services it stands for and also have the traits of a normal brand.

---

<sup>11</sup> David Vaver, —*Recent Trends in European Trademark Law: of Shape, Senses and Sensation*”, 95, Trademark Reporter. Pg. No: 85

<sup>12</sup> Registration no: 2210506, a yell consisting of a series of approximately ten sounds <sup>211</sup> Registration no: 2473248, the mark consists of thirty musical notes.

<sup>13</sup> Registration no: 1761724, the mark consists of the spoken letters \_AT &T

<sup>14</sup> Registration no: 200096

<sup>15</sup> Registration no: 1700895.

### **Marks of Color:**

The words "mark" and "trademark" are clearly explained in terms of a color scheme. At first look, this might seem to mean that a certain color design can be registered. According to the law, you can register a group of colors, or even just one color, with a word or symbol.

It's easier to prove true uniqueness when both the things or services in question and the people who want them are very specific. The Supreme Court of the United States made its ruling in the case of *Qualitex Company v. Jacobson Products Company*., When it first showed up on dry cleaning press pads, the greenish-gold color had already made a name for itself, which meant it could be registered as a brand. It doesn't matter what kind of thing a sign is a color, shape, smell, word, or symbol it can still be used as a brand. On the other hand, the court says that the sign can be used for this because it has "source distinguishing ability." In this case, green is a "secondary" color, but the use of it and gold became associated with the name. No affects were seen in terms of how they worked in real life.

Based on the world color coding system, there are 1,800 different shades of color. To find out if extra meaning has been gained, a number of factors connected to the subject must be taken into account. When marketing and selling a product, the color should be the most important thing, taking into account how the buyer sees it and how other people will use it.

### **Marks of Shape:**

In the UK Trade Marks Act of 1994<sup>16</sup> and the Indian Trade Marks Act of 1999, forms were added to the list of things that could be trademarked. Forms with important practical features can't be registered. The Trade Marks Act of 1999 in India says that a single-element stamp can't be kept as a brand.

- i) The shape of things comes from the way they are made.
- ii) The kinds of things that are needed to reach a certain tech goal`
- iii) Because that strongly encourages or greatly increases the value of the things.

This is something that the ECJ, the OHIM, and the Indian legal system all agreed on many years ago: brand names that are three-dimensional and include geometric elements are naturally unique. Because this is about the *Coca-Cola Company v. AG. Barr and Co.* case,<sup>236</sup>

---

<sup>16</sup> <https://www.legislation.gov.uk/ukpga/1994/26/contents>

some people thought that the container's unique form showed that it was connected to the company.

## **Analysis of Trade Mark Law in India**

The basic purpose of a trademark is to serve as a representative of the origin and source of the goods and services that are made available to customers. According to the Trade Mark Act of 1999, the term "mark"<sup>17</sup> can refer to a device, a trademark, a heading, a label, a ticket, a name, a signature, a word, a letter, a numerical value, a form of products, packaging, or any combination of colors or any combination thereof. Not only must the 'mark' be physically represented, but it must also be acceptable for reproduction in a printed format.<sup>18</sup>

The term "mark" refers to a broad idea that may include other components that are consistent with its broader and literal understanding. One of the most important requirements is that the trademark must be able to distinguish the products or services of one business from those of another company.<sup>19</sup> It is necessary for it to have inherent characteristics that distinguish it from other marks and make it possible to differentiate the mark of one person from that of another. Under the Trade Mark Act of 1999, registration in India is governed by regulations.

### **Functions of Trade Mark:**

One goal of rights is to make their purpose clear. The other goal is to help. The messenger function and the identity function are each made up of these steps. We talk about the "identifier function of a trademark" when we talk about the part of the trademark that tells people what the product is and how it works so they can buy it. People who own trademarks can also tell their products and services apart from those of competitors better. In the advertising business, the messenger role is used. Trademarks let marketers get their messages to people by acting as carriers. The trademark's trustworthiness is increased because it conveys trust, even if this message has nothing to do with the protected goods and services. In the modern sense, imprints were not trademarks because they had to be given when asked for. In the last few decades, trademarks have become useful in many more areas than those listed above. Without a question, their purpose has changed from boosting individual pride to building a base, and

---

<sup>17</sup> The Trade Mark Act, 1999 (Act 47 of 1999), s. 2(1)(m).

<sup>18</sup> The Trade Marks Rules, 2002, r. 2(k).

<sup>19</sup> The Trade Mark Act, 1999 (Act 47 of 1999), s. 2(1)(zb).

from showing what someone is worth to being used as advertising tools.<sup>20</sup> This brings up the question of what the real point of trademarks is.

### **Features of the Trade Mark Act, 1999**

The qualities of a trademark that is eligible for protection are outlined in the Act of 1999. The following items or services are specified, along with their origin:

- (i) Identifies goods/or services and origin: The mark must be able to distinguish one product from another in order to be effective. The purpose of the mark is to serve as a means of identifying the origin of the products or services, making it easier for the general public to trace the product back to its origin. Because of this, the impression of the products or services is improved, and it also helps to reduce ambiguity.
- (ii) Guarantees unchanged quality: The mark acts as a guarantee of the product's quality, with the second benefit being that it ensures constant quality. A certain mark is connected to a particular level of goodwill, makes it easier to sell the object in question. As a result of the public's association of the product with the brand, an assurance of the product's quality is established. The brand, over the course of time, certifies the quality and appeals to a demographic that is convinced of the excellence and standards of the product and its specifications. As a consequence of this, a mark may be taken to be an indication of the quality of your goods.
- (iii) Advertises the goods/services: The Act of 1999 has provided incentives to merchants and service providers, encouraging them to improve their commercial activities. (iii) Promotes the products and services. The mark has the effect of enhancing globalization and elevating the reputation of the items across international borders. Through advertising, the logo is able to become well-known and recognized across a wide range of demographics all around the world. The mark makes the production of products easier and contributes to the expansion of businesses. As advertising efforts get more intense, the brand's popularity increases.
- (iv) Creates an impression of the available products or services: The marks, which have been used for a considerable amount of time and acquired a level of distinctiveness and public awareness, help to the construction of an impression around the product. It is possible to construct a representation of the mark, which establishes a connection

---

<sup>20</sup> T D Drescher, —*The Transformation and Evolution of Trademarks: from Signals to Symbols to Myth* pp. 301, 325, Trademark Reporter, (1992)

between the product and the mark. Products, their packaging, and color combinations are all included into the design of the product.

- (v) Inclusion of shape of goods, packaging, and combination of colours: After taking into account the ever-changing trends on a worldwide scale, this has been incorporated. This is a somewhat broad description that allows for additional modifications to be made. The definition of a trademark has been expanded to include any mark that may separate the goods and services of one entity from those of another entity. Additionally, a trademark can be any mark that can be graphically represented. Consequently, even well-known designs are now able to seek protection under the legislation governing trademarks.

### **Inclusion of “Service Mark” by Enactment of 1999 Act**

The introduction of service marks into the law that was passed in 1999 is one of the most significant and most important changes that were made to the legislation. Attempting to include services inside the meaning of a trademark is the direct attempt that is being undertaken. Consequently, this would make it possible for any firm or individual that provides services to register their trademarks.

Companies who provide services relating to corporate, industrial, or commercial issues are able to register their service marks thanks to the new Act's extensive scope of services, which allows them to do so.

Section 2(1)(z),<sup>21</sup> ‘service’ means ‘services of any nature offered to prospective users, including those related to industrial or commercial activities such as banking, communication, education, financing, insurance, chit funds, real estate, transportation, material storage and treatment, processing, energy supply, news dissemination, and advertising’.

### **Registration of Trade Marks**

An individual who is listed in the Register of Trade Marks as the current owner of the trademark is referred to as the registered proprietor.<sup>22</sup> Registration gives the registered proprietor the ability to commence legal action for infringement of the registered trademark,

---

<sup>21</sup> The Trade Mark Act, 1999 (Act 47 of 1999), s. 2(1)(z).

<sup>22</sup> Id., s. 2(1)(v).

regardless of whether or not the brand is being used. A trademark that is not registered does not provide any legal redress in the event of infringement.

However, it acknowledges the common law rights of the trademark owner to pursue action against any party for passing off goods or services as those of another, along with the associated remedies. Section 27 of the Act stipulates that no individual is permitted to initiate proceedings to prevent or recover damages for the infringement of an unregistered trademark. This provision prevents individuals from initiating proceedings to prevent or recover damages on behalf of an unregistered trademark.<sup>23</sup>

### **Registration of Trade Mark for Services<sup>263</sup>**

The Act<sup>24</sup> of 1999 makes it possible to register trademarks for services in addition to those for goods. As a result of the growth of the service business across the country, the requirement became quite evident. The Act of 1958 allowed for the registration of trademarks only for products, while the Act that is currently in effect provides for the registration of marks for both goods and services. According to a broad definition, the term "service" refers to any kind of service that is made available to those who could utilize it. Moreover, India is obligated to develop rules for the preservation of trademarks for 'services' in line with the Paris Convention [Article 1(2) in combination with Article 6] and [Article 15(4)] for registration under the TRIPS Agreement, of which India is a signatory.

#### **Infringement of Trademark:**

If someone or some group that isn't the registered owner uses names that are the same as or look like the registered ones, they are trying to trick customers. This is called an infringement.<sup>25</sup> When someone breaks the law by using a sign that looks eerily like another sign for the same goods or services that the authorized mark is meant for, that was trademark infringement. In the event of a trademark case, on the other hand, proof will need to be shown that shows the possibility of a link and the chance of mistake.

---

<sup>23</sup> B. L. Wadhwa, —*Law Relating to Intellectual Property*l, pg.162 (Universal Law Publication, New Delhi, 2017). 263

K.C. Kailasam and Ramu Vedaraman, —*Law of Trademarks and Geographical Indications*l, 8 (LexisNexis, New Delhi, 2017).

<sup>24</sup> The Trade Mark Act, 1999 (Act 47 of 1999).

<sup>25</sup> —What to do if someone uses your trademarkl, *available at* <https://www.indiafilings.com/>(last visited on October 1, 2025)

A key part of proving theft is showing that the two marks are somewhat identical. For this reason alone, there must be a likeness and a trait of similarity in order for there to be a chance of misunderstanding. People who own businesses can show that they have exclusive rights by filing a case for trademark abuse after they have registered their name. Intentional use of a registered brand is not necessary for infringement to happen, but when someone intentionally lies to the client in an infringement case, they are usually given more money in damages.

### **Infringement of Registered Trade Mark**

Bringing a lawsuit for infringement requires establishing that statutory rights have been violated.<sup>26</sup> When a person who is not the registered owner of a mark uses that mark with the intention of misleading customers in the course of business, this is considered an instance of infringement taking place.

There is a possibility that the infringing mark is not only identical to the registered mark but also misleadingly similar to the items or services for which the registered mark is registered.<sup>27</sup> Consequently, if the mark is employed in a manner that is not likely to signal its commercial origin, it may not give rise to a cause of action for infringement, as was determined in the case of Ox-cart.<sup>28</sup>

In accordance with the provisions of section 28 of the Trade Mark Act, 1999, the proprietor of a registered trade mark is the exclusive owner of the mark and has the legal right to seek remedy in the event that the mark is taken without permission.

Trade Mark infringement generally contains the issues of:

- (i) Likelihood of Confusion
- (ii) Deceptive Marks
- (iii) Identical Marks
- (iv) Dilution of Marks

---

<sup>26</sup> VK Ahuja, *Intellectual Property Rights in India*, 25 (Bharat Law House, New Delhi, 2002).

<sup>27</sup> K.C Kailasam, Ramu Vedaraman, *Law of Trademarks and Geographical Indications*, p.392. (LexisNexis, New Delhi, 2017)

<sup>28</sup> *Edward Young & Co. Ltd v. Grierson Oldham & Co. Ltd.*, (1924) 41 RPC 548.

## **Likelihood of Causing Confusion**

In the past, it was often assumed that trademark infringement only takes place in situations where there is a possibility of doubt regarding the origin of the trademark.<sup>29</sup> The protection of a mark that has achieved uniqueness serves two purposes: first, it protects the goodwill of the merchant, and second, it assures the general public and consumers that the services or goods they want will be consistent<sup>30</sup>. If the items and services in question are completely unlike to one another, then the problem of the likelihood of confusion does not develop. However, it is not sufficient for one mark to just stimulate the prospect of recalling the other mark<sup>31</sup>.

## **Principles of Section 11 of the Trade Marks Act, 1999**

If a mark is essentially a duplicate or imitation of a well-known trademark, then the registration of such mark ought to be barred. Section 11(2)(b)<sup>32</sup> stipulates that if the goods or services are dissimilar, the use of a trademark that is identical or similar to an earlier trademark, without a justifiable reason, would unfairly exploit or harm the distinctive character or reputation of the earlier trademark, and as a result, the trademark in question shall not be registered.<sup>33</sup> In accordance with the provisions of Section 11 of the Act, one of the most important criteria is the existence of similarities that might result in a public misunderstanding.

## **Deceptive Marks**

A mark is considered to be deceptive if it has the potential to mislead customers. One of the most important criteria for determining whether or not a product is "Deceptive Marks" is whether or not the average buyer is confused about where the goods came from.

First, it is necessary to determine whether or not there is a general similarity. When it comes to first impressions, the expression "likely to deceive" is most commonly seen. The demonstration of purpose is not required. The only thing that the court needs to do is decide whether or not deceit is likely to occur, which is a determination that must be based on both

---

<sup>29</sup> James Mellor, David Llewelyn, *Kearly's Law on Trade Marks and Trade Names*, 360 (Sweet and Maxwell, 2001).

<sup>30</sup> *Evergreen Sweet House v. Ever Green and Others*, (2008) 38 PTC 325 (Del), p. 330.

<sup>31</sup> *Baywatch Production Co Inc v. The Home Video Channel*, (1997) FSR 22.

<sup>32</sup> The Trade Mark Act, 1999 (Act 47 of 1999), s.11 (2)(b).

<sup>33</sup> K.C Kailasam, Ramu Vedaraman, —*Law of Trade Marks and Geographical Indications*||, p. 170 (LexisNexis, New Delhi, 2017)

the facts and the judge's visual evaluation.<sup>34</sup>

Deception can arise about:<sup>287</sup>

- (i) Deception as to goods
- (ii) Deception as to trade origin
- (iii) Deception as to trade connection

### **Dilution of Trade Mark**

The term "dilution" refers to the process by which the value of a trademark is diminished, hence weakening its power. When a different user uses a mark that is similar to the trademark for the same products, it will ultimately result in a decrease in the trademark's inherent value.

In *Caterpillar Inc. v. Mehtab Ahmed and Others*<sup>35</sup>, the Delhi High Court determined that, under the law of dilution, there exists a presumption that the pertinent consumer begins to associate the mark or trademark with a new and distinct source. This impacts the connection between the former user's mark and its products. The connection between the brand and the product is ambiguous. This constitutes an unjust practice anticipated in trade and commerce.

It is not the same as traditional examples of infringement. Those who are customers are protected by infringement laws, whereas proprietors are safeguarded by dilution legislation. The allegations of infringement or fraud are not necessary for a dilution lawsuit.

The commercial magnetism of the mark is the basis for this conclusion, which is based on the value of the trademark to the owner of the mark<sup>36</sup>. Dilution is the category that encompasses the concept of tarnishing. When a trademark gets tarnished, its originality is diminished, and the positive value of the mark is diminished as well.

### **Conclusion**

Within the group of BRIC countries, India's GDP is expanding at the fastest rate available. The fact that this is the case shows that businesses in India are expanding at a rapid rate, which further suggests that trademarks are also expanding at the same time. Together, the Trade Mark

---

<sup>34</sup> *H.C Dixon & Sons Ltd. v. Geo Richardson & Co. Ltd.*, 50 RPC 36, p 374. <sup>287</sup> *Vikram Stores v. S.N. Perfumery Works*, 2008 AIHC 494 (Guj).

<sup>35</sup> (2002) 25 PTC 438 (Del).

<sup>36</sup> VK Ahuja, *Intellectual Property Rights in India*, 432. (Bharat Law House, New Delhi, 2002).

Act of 1999 and the Trade Mark Rules of 2002 have provided India with a trademark system that is both more efficient and more transparent.

Among the many rules and regulations that exist, the concept of passing-off is an essential safeguard for the rights of trademark holders who have not yet registered their trademarks. This idea has been used on several occasions, and it provides relief to those who do not register their trademarks, while simultaneously criticizing others who wish to portray items as belonging to them since they are not registered.

