



INTERNATIONAL LAW  
JOURNAL

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**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.

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With this thought, we hereby present to you

# **"COMPARATIVE LEGAL ANALYSIS OF THE INDIAN TRADE MARKS ACT, 1999 AND THE U.S. LANHAM ACT, 1946: A STUDY OF TRADEMARK PROTECTION REGIMES"**

AUTHORED BY - PRAGYA KUMAR

## **INTRODUCTION**

The present research compares the differences between provisions of The Trademark Act, 1999 of India and The Lanham Act, 1946 of U.S.A. with respect to the terminologies and concepts like 'Mark', 'Trademark', 'Use in Commerce', 'Colourable Imitation', 'Counterfeit', 'Domain Name', 'Principal Register' & 'Supplementary Register', 'Well-Known Trademarks', 'Registration', 'Infringement', 'Passing Off' and 'Dilution' of trademarks mentioned below as:

**MEANING OF 'MARK':** The definition under the Indian Act describes the term mark based on its nature i.e., it being an indication or tool or a sign or a symbol for identification. The definition being inclusive, the term mark can include any kind of indication and thus not limited by the words used in the definition. Thus the definition is restrictive in nature and can include non-conventional trademarks like smell, touch and feel, sound and other sensory perceptions in the ambit of the definition.<sup>1</sup> The definition under the US Act describes the term mark to mean different kinds of trademarks capable of being registered under the US Act. As such the definition under the US Act does not specify the components of a mark like the definition under Indian Act. However under the US Act the definition of the term trademark is comprehensive to include the varieties mark as found in the definition of mark in the Indian Act.

**MEANING OF 'TRADEMARK':** The definition under the Indian Act is more exhaustive as it describes as to how a mark will become a trademark. Since the term 'Mark' is defined to refer the nature of the mark or the sign, the definition of trademark provides certain qualifications which if a mark satisfies will make such a mark a trademark. The requirements under the said definition is twofold that a mark that can distinguish the goods or services of one person from those of another and that can be displayed graphically. Thus the principle under the Indian Act is that 'Every trademark is a mark, but every mark need not be a

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<sup>1</sup> The Trademark Act, 1999, S.2(1)(m).

trademark'. Apart from the above, the definition also includes certain kinds of trademarks like shape of goods, combination of colours, packaging etc.<sup>2</sup>

The definition of trademark under US Act includes the kind or nature of a mark as found in the definition of mark under the Indian Act. Hence it can be stated that the definition of trademark includes the definition of mark (as it is in Indian Act). Further the definition also requires use by a person or a bonafide intention to use the same in the course of commerce and applies for registration in the principal register under the said Act. Further the trademark has to distinguish the goods manufactured or sold by one person from others. Further the trademark is required to indicate the source of goods, even if the source is not known. Thus the US Act provides for a wider definition for the term trademark which differs from the definition under the Indian Act on the aspect of requirement of use or a bonafide intention to use and to act as a source indicator. While the Indian Act does not make 'use' as a requirement of the definition whereas the indication as to the source of goods or services is subsumed in the definition.

**MEANING OF 'USE IN COMMERCE':** There is no equivalent definition under the Indian Act for the term 'use in trade or commerce'. However the definition of trademark under Section 2(1)(zb) of the Indian Act subsumes the use of such Trademark in connection with the trade so as to suggest a relationship in the course of trade between the products or services and someone who has the right to use the mark either as the owner or a permitted user, whether or not the person's identity is disclosed. While use of a trademark in the course of commerce or trade is essential for its protection, though the same is not a sine qua non for registration of a trademark. On the other hand, U.S. Act defines 'use in commerce' means using a mark legitimately in the course of business and not only reserving the right to use it. The definition of trademark under the U.S. Act also does not require 'use' as a prior condition for registration.<sup>3</sup>

**MEANING OF 'COLOURABLE IMITATION':** There is no definition under the Indian Act for the term Colourable Imitation. However the Indian Act defines a similar term 'Deceptively similar'<sup>4</sup> 'Deceptively similar' as an 'A mark is said to be deceptively similar to another mark if it resembles it so closely that it could lead to confusion or deception. According to the U.S. Act, "colourable imitation" refers to "any mark that is so similar to a registered mark

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<sup>2</sup> The Trademark Act, 1999, S.2 (zb).

<sup>3</sup> The Lanham Act, S.45.

<sup>4</sup> The Trademark Act, 1999, S.2 (1)(h).

as to be likely to confuse, mislead, or deceive.’<sup>5</sup>

Thus it can be seen that both the Indian and US Act addresses the same subject of a deceiving mark or a trademark capable of causing confusion in the same meaning and context, however with different terminologies.

**MEANING OF ‘COUNTERFEIT’:** There is no definition under the Indian Act for the term ‘counterfeit’. However the Indian Act under Chapter XII dealing with procedure relating to offences and penalties provides for dealing with goods with false description. However it is worthwhile to note that Section 28 of the Indian Penal Code (IPC) provides for a definition for the term counterfeit. As per the said definition ‘Counterfeit’ is one who causes a thing to resemble the another so as to result in deception or knowing that making such resembling thing or its practice is likely to deceive. Section 45 of the US Act defines ‘counterfeit’ as a fake mark which is identical with, or substantially indistinguishable from, a registered mark.

**MEANING OF ‘DOMAIN NAME’:** There is no definition w.r.t. to domain name in Indian Act. The Supreme Court in Rediff Communication Limited v. Cyberbooth held for the first time that domain name is a trademark. However the U.S. Act defined domain name as ‘any alphanumeric designation that is a component of an Internet electronic address that is registered or assigned by a domain name registrar, registry, or other domain name registration authority.’

**MEANING OF ‘PRINCIPAL REGISTER’ & ‘SUPPLEMENTARY REGISTER’:**

The Indian Act recognises one single Register which will contain the names of the trademarks registered, matters relating to licensing, assignment and other notifications relating to a trademark.<sup>6</sup> The U.S. Act recognises two different registers Principal and Supplementary. While the Principal Register will contain trademarks which are registered and are per se distinctive in nature, the Supplementary Register contains trademarks which are not distinctive or which are descriptive. A registration in the Principal Register also means that the mark has proven continuous extensive use. The marks registered under Supplementary Register are not per se capable of being registered under the Principal Register. A mark which has foreign origin and not in use prior in US jurisdiction will be registered in the Supplementary Register. However a mark registered in Supplementary Register can pre-empt a prospective similar or identical mark to be registered in the Principal or Supplementary Register.

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<sup>5</sup> The Lanham Act, S.45.

<sup>6</sup> The Trademark Act, 1999, S.6.

A mark which is registered under the Principal Register cannot be contested after 5 years while a mark registered under Supplementary Register does not achieve that status. Thus it can be said that US follows federal structure of governance when it comes to registration of trademarks, while India follows a unitary register process.

**MEANING OF ‘WELL-KNOWN TRADEMARKS’:** The Indian Act defines ‘Well-known trademark’ under the Act of 1999 which means a mark that has become so well-known to a sizable portion of the public who uses such goods or receives such services that the use of such mark in relation to other goods or services would likely be interpreted as indicating a connection between those goods or services and the person using the mark in relation to the first mentioned goods or services in the course of trade or rendering of services.<sup>7</sup> There is no equivalent term defined under the U.S. Act. However the U.S. Act recognises the term ‘Famous Mark’ which is defined to mean A mark that is well-known and extensively recognised by the general U.S. consumer public as designating the source of the owner's goods or services.<sup>8</sup>

**PRINCIPLES OF ‘REGISTRATION’:** The Indian Act identifies certain characteristic features which are per se deemed not distinctive or devoid of distinctive character.<sup>9</sup> One of the basic qualifications for a trademark is its distinctive or distinguishing feature or its ability to distinguish goods or services of one person from that of another. Hence a mark which is not distinctive or which is descriptive or suggestive of quality, kind, quantity, intended purpose, geographical origin or which consists of marks which become generic or customary in the current language are deemed not capable of registration.

Further, a mark of such a character that it can deceive or confuse the public, or that it is likely to harm the religious sensibilities of any class of public, or that is scandalous or prohibited by the Emblems and Names (Prevention of Improper Use) Act, 1950. Furthermore, a trademark consisting solely of the shape of goods can be registered, unless the shape derives from the nature of the goods, or to produce a technical result, or the shape adds significant value to the goods. Since the above factors goes against the grain of the important function of trademark being the distinguishing feature, the above grounds are called absolute grounds for refusal. Hence when a mark fall under any other categories mentioned above the application for

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<sup>7</sup> The Trademark Act, 1999, S.2(1)(zg).

<sup>8</sup> The Lanham Act, S.43.

<sup>9</sup> The Trademark Act, 1999, S.9.

registration of such mark will be summarily rejected by the Registrar.

The Indian Act deals with much more complex aspects as regards identical or similarity in trademark vis-a-vis the trademarks already registered or in the process of registration.<sup>10</sup> The grounds of objection under Section 11 already discussed in the study. Section 11 provides for a detailed process to classify a trademark as Well-known Trademark and provides power to the Registrar of Trademarks to register the same. The US Act comprises all of the absolute grounds under Section 9 of the Indian Act and relative grounds under Section 11 of Indian Act. It provides specific objection relating to geographical indications in respect of wines and spirits, whereas Indian Act provides a general objection to all geographical indications. Further the US Act provides for objections on the grounds of a mark resembling flag, coat of arms or other insignias, name, signature, portrait of a person living or dead. However widow of a dead person can provide consent for registration to use the name, portrait or signature of that dead person. The Indian Act takes care of all these things under the Emblems and Names (Prevention of Improper Use) Act, 1950 however, there is no concept of a mark getting prohibited from registration just because it is similar or identical to the name of a dead person unless such a person is recognised as a national icon as specified in the above Act.

Further, the provisions are in place to refuse registration on account of confusion, deception, mis-description, mistake or descriptive nature of the marks. Further a mark which has become distinctive by continuous use of five years or more can be registered subject to the application of the objections stated above. There is no concept of a trademark getting to a not-challengeable position after 5 years in Indian Act. Further a mark may be refused registration if it were likely to cause dilution by blurring or dilution by tarnishment mentioned under U.S. Act.<sup>11</sup> While these concepts are not expressly stated in the Indian Act, they are well covered in its general language. Thus it can be seen that the provisions in relation to objections or refusal to register trademarks on an application is similar in many aspects with exception of certain additional grounds provided in the U.S. Act especially with regard to aspects relating to dilution of trademark.

**PRINCIPLES OF 'INFRINGEMENT':** The Trademark Act, 1999 provides that a registered trade mark is said to be infringed, if a person other than the registered proprietor or a permitted

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<sup>10</sup> The Trademark Act, 1999, S.11.

<sup>11</sup> The Lanham Act, S.43(c).

user, uses the trademark with respect to goods or services so as to render the use of the mark as being used as a trademark.<sup>12</sup> The use by an unregistered proprietor should be such that the unregistered trade mark is deceptively similar to a registered trade mark.

Hence under Section 29(1) the mere similarity or identical nature of an unregistered trade mark with a registered trade mark will render such use by the unregistered trade mark liable to be sued for infringement. The word 'deceptively similar' refers to a mark that is so similar to another mark that it is likely to deceive or cause confusion. However the provisions of Section 29(1) can be stated to be mark centric meaning that a registered proprietor can claim action for infringement, if, the defendant's mark identical or is deceptively similar to the registered mark. No loss of profits or damage need to be proved. The provides a combination of instances of identical nature or similarity of the infringing mark vis-a-vis the registered trade mark and the goods or services which it represents so as to ascertain whether the use of such unregistered trade mark will cause confusion in the eyes and minds of the public.<sup>13</sup> When someone who is not the registered proprietor or an allowed user uses a mark in the course of their business violates a registered trade mark, it is because of following mentioned reasons:

- a) Its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark;
- b) Its resemblance to the registered trademark and the nature of the goods or services covered by the registered trademark, as well as their similarity; and
- c) Its similarity to the registered trade mark and the nature of the goods or services covered by the registration both provide a risk of public confusion or suggest a connection to the registered trade mark.

Hence this provision can be stated to be effect centric, meaning that the impact of the infringing mark vis-a-vis the registered mark and the goods or services for which its registration operates needs to be seen. The concept of likelihood of confusion is the key factor which needs to be seen. However in respect of an infringing mark which is identical both in respect of the registered trademark and also the goods or services in respect of which it is registered, the Court dealing with the issue shall presume likely hood of confusion on the part of the public.<sup>14</sup> The Supreme Court in *Amritdhara Pharmacy v. Satya Deo*<sup>15</sup> while deciding whether the

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<sup>12</sup> The Trademark Act, 1999, S.29(1).

<sup>13</sup> The Trademark Act, 1999, S.29(2).

<sup>14</sup> The Trademark Act, 1999, S.29(2).

<sup>15</sup> AIR 1963 SC 449

trademarks 'Amritdhara' and 'Lakshmandhara' are deceptively similar or likely to cause confusion Gupta in the minds of the public held that the question has to be seen from the point of view of a consumer 'who is a man of average intelligence and imperfect recollection hence the marks deceptively similar. However a deeper reading of Section 29(1) will reveal that the provision is not just mark centric.

A comparison of the infringing trade mark's usage with respect to the goods or services for which a registered trade mark is registered is allowed under the provision, but only if it is done in the course of business. Thus, to prove trademark infringement, it is necessary to combine the comparison of the marks, their use in commerce, and the resemblance or identity of the goods or services to which the infringing marks are applied. Additionally, Section 29(2) states that once the infringing and registered trademarks are identical and there is identity of type of products or services represented by the respective trade marks, the idea of probability of public confusion is proven.

On an analysis of above mentioned provisions of Section 29(1) and (2), the following summation can be stated as:

Section 29(1) specifies two permutations, one of which is the use of an identically infringing trademark in connection with identical products or services, which could lead to the infringing mark being regarded as a registered trademark. The second is the potential for the infringing mark to be mistaken for an officially registered trademark when it is used in the course of business in relation to identical or similar goods or services. The use of the infringing trademark in the course of commerce is crucial in both configurations. Section 29(1) specifies two permutations, one of which is the use of an identically infringing trademark in connection with identical products or services, which could lead to the infringing mark being regarded as a registered trademark. The second is the potential for the infringing mark to be mistaken for an officially registered trademark when it is used in the course of business in relation to identical or similar goods or services. The use of the infringing trademark in the course of commerce is crucial in both configurations.

A wider variation of the conditions of identical trade mark in relation to same goods or services, similar trade mark in relation to similar goods or services, and similar trade mark in relation to similar goods or services.<sup>16</sup> In such a manner that usage of the infringing trademark in the

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<sup>16</sup> Trademark Act 1999, S. 29(2).

course of trade is likely to cause public confusion or likely to have an association with the registered trade mark.

Hence it is clear that the combination of permutations relating to the identical or similar character of the infringing trade mark in relation to the identical or similar nature of goods in reference to the registered trade mark broadens the scope of coverage of circumstances which can cause public confusion. The plaintiff has the burden of demonstrating whether a competing mark is likely to lead to consumer confusion. Therefore, the Act's position is with regard to a mark's potential to cause public confusion rather than actual confusion being proven.<sup>17</sup>

Use of a registered trademark is considered to have taken place if it is applied to goods or packaging, if the goods bearing the trademark are offered for sale or placed on the market, or if the goods are imported or exported and the trademark is used in advertising.<sup>18</sup> Furthermore, protection against dilution of a registered trademark is covered by Sections 29(4), (5), and (8). The U.S. Act provides for a cause of action on the ground of likelihood of confusion under Section 32 against a person who uses in commerce any reproduction, counterfeit, copy or colourable imitation of a registered trade mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake or, to deceive; or reproduce, counterfeit, copy or colourably imitate a registered mark and apply such reproduction, counterfeit, copy or colourable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive. As a result, under Section 32 of the US Act, a claimant must demonstrate the following to prove infringement of a mark:

- That the defendant is using the mark, or a mark that is confusingly similar to it, in commerce without authorization;
- That it is the owner of a valid mark, that is, a mark that is registered, and is entitled to protection;
- That the defendant's use of the mark in commerce is likely to cause confusion, mistake or deception as to who Actually is the source of either the plaintiff's or the defendant's products;

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<sup>17</sup> Trademark Act 1999, S.11(1) and S.29(1) and S.29(2).

<sup>18</sup> Trademark Act 1999, S.29(6) and S.29(7).

- One interesting differentiating feature of U.S. Act is that use of a mark as stated above by a non-registrant is liable for civil action only if it can be proved that such use is with a purpose to cause confusion, or to confuse or to cause a mistake or to deceive. Hence there a situation, whereby, an innocent user without any intention to deceive or to cause confusion may use the registered mark and in such an instance he can be let off with a cease and desist order without any damages. Hence intention to deceive or bad faith is the corner stone of any civil proceedings under U.S.A. Act.<sup>19</sup>

The U.S. Act provides limitations against civil action<sup>20</sup> under Section 32(1) and also under Section 43(a) of the U.S. Act where, the infringer or violator is only a printer or publisher or advertiser in a newspaper or a magazine or similar periodical if such infringer or violator proves that he is an innocent infringer or innocent violator. However injunctive relief is available on the owner of the registered trademark. Further such injunctive relief is not available even in such cases if it can be shown that, such relief if awarded will delay the issue or transmission of publication of newspaper or magazine as a sound business practice and not to avoid or evade the action under Section 32(1) of the US Act. This is a major difference from the provisions of Indian Act point of view, since, as per the Indian Act, mere use of a registered identical trademark is considered to be an infringement. There is no express provision under the Indian Act under Section 29 or elsewhere for an 'Innocent Infringer'.

However reference can be made to Section 29(7) which provides an action for infringement against an advertiser or a person who labels or packs goods with infringing marks is possible if it can be proved that such person has reason to believe that the application of the mark is not duly authorised by the proprietor of the registered mark or by the licensee.

However when it comes to awarding damages, the Court may take a call on its quantum based on the loss suffered by the plaintiff. Further the U.S. Act vide the amendment caused by the Anti-Cybersquatting Consumer Protection Act, 1999 introduced provisions relating to domain name protection enabling the domain name registrar, the domain name registry, the domain name registration authority to claim injunctive relief against domain name infringement or dilution. Therefore, any domain name registration that could lead to public confusion or misinformation about a registered brand constitutes infringement or dilution, as the case may be.

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<sup>19</sup> The Lanham Act 1946, S.32 (1).

<sup>20</sup> The Lanham Act 1946, S.32 (2).

Hence both under the Indian Act and the U.S. Act the law effectively deals with infringing marks which are likely to confuse or cause deception in the minds of the public. However the scope and applicability of the provisions of U.S. Act is expansive whereas the provisions of Indian Act is inclusive and needs excellent interpretational skill to expand its coverage to acts of infringement which is not otherwise so worded in the provisions explicitly.

**PRINCIPLES OF ‘PASSING OFF’:** Under Trademark Act, 1999 the term ‘Passing off’ is explicitly mentioned under the Act which recognises the common law rights of the trademark owner to take action against any person for passing off their goods/services as the goods of another person or as services rendered by the other person but provides that no infringement action will lie in respect of an unregistered trademark.<sup>21</sup> Although the Lanham Act does not specifically mention passing off, this action falls within Section 43(a), which prohibits false designations of origins. Section 43(a) prohibits unfair competition such as ‘Passing off’ (15 U.S.C. S. 1125). Unfair competition under the federal Lanham Act is commonly known as passing off one’s goods or services for another’s which means when a party tries to pass his goods or services off as affiliated with or sponsored by another. Unfair competition usually involves an element of consumer deception. One of the benefits of a claim for unfair competition is that you need not have a registered trademark in order to bring the claim. Another benefit of a claim for unfair competition it is often broader than a claim for trademark infringement. There are two types of theories for unfair competition, one for ‘Likelihood of Confusion’ and one for ‘False Advertising.’<sup>22</sup>

**PRINCIPLES OF ‘DILUTION’:** The Indian Act has not provided or dedicated any separate provision unlike the U.S. Act to protect a registered trademark from dilution. While Section 29(1), (2) and (3) provides for protection against infringement of registered trademark arising from confusion. However, Sub-sections (4), (5) and (7) deal with dilution of registered trademark. Further Section 11 (2) of the Indian Act also aids in protecting a registered trademark against dilution, however at the time of registration of an identical or similar trademark. The Act which recognises the common law rights of the trademark owner to take action against any person for passing off their goods/services as the goods of another person or

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<sup>21</sup> Trademark Act 1999, S.27.

<sup>22</sup> False advertisement means any advertisement which is false, misleading or deceptive in a material respect. In determining whether any advertisement is misleading, there shall be taken into account not only representations made or suggested by statement, word, design, device, sound or any combination thereof, but also the extent to which the advertisement fails to reveal facts material in the light of such representations made.

as services rendered by the other person but provides that no infringement action will lie in respect of an unregistered trademark.<sup>23</sup> Further, the Act provides that a registered trademark is infringed by a person if he uses such registered trademark, as his trade name or part of his trade name, or name of his business.<sup>24</sup>

Additionally, The Act also offers protection against unfair advantage taken against honest business and industrial practises, against the distinctive character of the registered trademark, or against the reputation of the registered trademark, as well as against disparaging use of registered trademarks.<sup>25</sup> It is interesting note that while the Indian Act under Section 29 or under Section 11 does not use the word 'dilution' per se which is purely a U.S. term, however providing the import of the meaning of the term dilution and providing for remedies against such dilution of a registered trademark, its reputation and distinctive character.

A mark which is identical or similar to a registered trademark shall not be registered even in respect of goods or services which may not be similar to the goods or services represented by the registered trademark, if such registration could result in unfair advantage or harm the registered trademark's reputation or distinctive character.<sup>26</sup>

For determining a mark as a well-known mark the registrar shall take into account any fact which he considers relevant such as<sup>27</sup>:

- The recognition or knowledge of the brand in the relevant segment of the public, including information acquired in India as a result of the trademark's promotion;
- The duration, extent and geographical area of any use of that trademark;
- The duration, scope, and geographic region of any trademark promotion, including any advertising, publicity, and display at trade shows or exhibitions, as well as the goods or services the trademark is used to identify;
- The duration and geographic scope of any trademark registration or publication under the Trademark Act, to the degree that these factors reflect the trademark's usage or recognition;
- The record of effective trademark rights enforcement, particularly the degree to which

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<sup>23</sup> Trademark Act 1999, S.29(4).

<sup>24</sup> Trademark Act 1999, S.29(5).

<sup>25</sup> Trademark Act 1999, S.29(8).

<sup>26</sup> Trademark Act 1999, S.11(2).

<sup>27</sup> Trademark Act 1999, S.11(6).

the brand has been acknowledged as a well-known trademark by any court on the Registrar's record;

- The number of Actual or potential consumers of the goods or services;
- The number of persons involved in the channels of distribution of the goods or services; and
- The business circles dealing with the goods or services.

The U.S.A. Act provides for detailed provisions against dilution.<sup>28</sup> This doctrine prevents the weakening or reduction of the ability of a mark to clearly and unmistakably distinguish one origin of goods or services for the other and protects thus affords protection for the distinctiveness of a mark.

The doctrine of dilution as a separate basis for protection of trademarks originated in Britain and Germany and was introduced into the United States through the writings and Congressional testimony of Frank Schechter in his seminal article. The U.S.A. Act addresses the concept of dilution under the following two dimensions i.e., Dilution by 'Blurring' and Dilution by 'Tarnishment.'

Thus it can be learnt that while the concept of dilution is recognised under the Indian Act by creating a separate class of trademark called a Well Known Trademark, the same concept is advanced under the U.S.A. Act through recognition of a Famous Mark.

## CONCLUSION

It can be stated that while the Indian Trademarks Act, 1999 though not very exhaustive in its language, its content is wider in ambit requiring excellent interpretational skills to bring out the spirit and import of the law. Whereas the Trademarks Act, 1946 of the U.S.A. is quite exhaustive and long winding but however provides legal measure to take on trademark based violations in advanced economy. The U.S.A. has always been a front runner in establishing concepts and principles in registration and protection of trademarks, which India has already taken advantage of and can take advantage of further in the near future too.

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<sup>28</sup> The Lanham Act, 1946, S.43.