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TRADEMARK PROSECUTION & OPPOSITION

DECEPTIVE SIMILARITY AND THE CONSUMER CONFUSION TEST

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Editorial Note

Trademark law in India operates at the intersection of commercial identity and consumer protection. A trademark is the sign by which a trader tells the world who they are and the sign by which a consumer tells the market who they trust. When that sign is registered, it becomes a statutory right - enforceable against the world, renewable indefinitely and capable of accumulating value that may eventually exceed every other asset a business possesses. When it is threatened by a confusingly similar mark, the question of whether the public is likely to be deceived becomes both a legal issue and a commercial one of the first order.

This issue of **PATENEVO IP Law Insights** is devoted to two questions that every trademark practitioner encounters and that no practitioner can afford to misunderstand. The first is procedural: *how does a trademark application move from filing to registration and what happens when a third party seeks to stop it*? The second is substantive: *on what legal basis does a court or the Trade Marks Registry determine that two competing marks are too similar to coexist?* These two questions are inseparable in practice. The opposition procedure exists precisely to answer the second question and the entire machinery of prosecution - examination, objections, hearings, evidence stages is organised around the likelihood that a proposed mark will cause consumer confusion.

The first article in this issue examines trademark prosecution and opposition from filing through registration under the **Trade Marks Act, 1999 and the Trade Marks Rules, 2017.** It covers the filing requirements, the examination process, the four-month opposition window under Section 21, the evidence stages and the strategic considerations that determine whether an application survives or falls. The second article examines the doctrine of deceptive similarity: the statutory definition in **Section 2(1)(h),** the foundational principles developed by the Supreme Court across six decades of adjudication and the multi-factor framework from *Cadila Healthcare v. Cadila Pharmaceuticals* that now governs every deceptive similarity assessment in India.

Together, these articles provide the legal foundation for anyone advising a client on trademark registration strategy, conducting a clearance search, preparing an opposition or defending against one. PATENEVO remains an independent educational platform. It is not a law firm and does not provide legal advice or filing services.

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TRADEMARK PROSECUTION AND OPPOSITION IN INDIA

From Application to Registration under the Trade Marks Act, 1999

A trademark is, in commercial terms, the face of a business. It is the sign by which consumers navigate a crowded market - the word, symbol, logo, shape or combination that tells them who made the goods or provided the service they are about to buy. The legal protection of that commercial identity in India is governed by the Trade Marks Act, 1999, which replaced **the Trade and Merchandise Marks Act, 1958**[1] and brought Indian trademark law into broad alignment with the Agreement on **Trade-Related Aspects of Intellectual Property Rights (TRIPS)**[2]. The 1999 Act introduced a more comprehensive registration framework, a wider definition of what can constitute a mark, enhanced protections for well-known marks and a more structured opposition procedure.

What makes Indian trademark prosecution both distinctive and demanding is that it combines a procedurally detailed administrative process with a substantive examination system that scrutinises applications on grounds of distinctiveness, deceptive similarity and absolute and relative bars to registration. The opposition stage then opens the application to challenge by any person who believes that the proposed registration is legally vulnerable. Between examination and opposition, a trademark applicant in India must satisfy both the Registry and the public marketplace that its mark is registrable.

Core Statutory Framework

Trade Marks Act, 1999 (Act No. 47 of 1999) - primary statute

Trade Marks Rules, 2017 - procedural rules (replaced 2002 Rules)

Manual of Trade Marks Practice and Procedure - CGPDTM

Nice Agreement (45 classes) - India is a member; classification system applied

TRIPS Agreement, Articles 15–17 - minimum standards for trademark protection

What Can Be Registered: The Definition of a Trade Mark

Section 2(1)(zb) of **the Trade Marks Act, 1999** defines a trade mark as a mark capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others. **Section 2(1)(m)** defines “mark” to include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, combination of colours or any combination thereof. The definition is deliberately broad.

The graphical representation requirement has meant that smells, sounds and other non-visual marks have faced practical difficulties in India, though the **Trade Marks Rules, 2017** have introduced provisions for representing non-traditional marks and the Registry has been

[1] The Trade Marks Act, 1999, No. 47 of 1999, Acts of Parliament, 1999 (India).

[2] Agreement on Trade-Related Aspects of Intellectual Property Rights arts. 15–17, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299.

gradually developing its approach to sound marks and colour marks in line with international developments.

The fundamental requirement for registrability is distinctiveness - the capacity of the mark to identify the goods or services of one trader and distinguish them from those of other traders.

Absolute and Relative Grounds for Refusal

Absolute Grounds - Section 9

Section 9 sets out absolute grounds for refusal. These concern the inherent character of the mark itself, independently of any earlier conflicting right. A mark shall be refused registration if it is devoid of distinctive character, consists exclusively of signs that designate the kind, quality, quantity, purpose, value or geographical origin of goods or services or has become customary in the trade. Section 9(2), however, provides an important saving: a mark shall not be refused registration if, before the date of application, it has acquired a distinctive character through use - what the law calls acquired distinctiveness or secondary meaning. A mark that was originally descriptive can therefore become registrable if the applicant demonstrates through evidence that it has come to be understood by the relevant public as identifying that trader's goods exclusively.

Section 9 also prohibits registration of marks that are likely to deceive or cause confusion, that are contrary to law or morality, that contain scandalous matter or that are protected under **the Emblems and Names (Prevention of Improper Use) Act, 1950.**

Relative Grounds - Section 11

Section 11 sets out relative grounds for refusal, which concern conflicts with earlier existing rights. **Section 11(1)** provides that a mark shall not be registered if it is identical with or similar to an earlier trade mark and the goods or services are identical or similar and if there exists a likelihood of confusion on the part of the public, including a likelihood of association with the earlier mark. **Section 11(2)** extends this protection to well-known trademarks: where an earlier trade mark is well-known in India, registration of a later similar mark may be refused even if the goods or services are entirely different, if the use of the later mark would take unfair advantage of or be detrimental to, the distinctive character or repute of the well-known mark.

Key Prohibitions Under Section 9 and Section 11

Section 9(1)(a) - marks devoid of distinctive character

Section 9(1)(b) - marks exclusively designating kind, quality, geographical origin

Section 9(1)(c) - marks that have become customary in the trade

Section 9(2) - saving for acquired distinctiveness through use

Section 11(1) - relative grounds: identity/similarity + likelihood of confusion

Section 11(2) - well-known marks: protection across different goods/services

Section 11(10) - application made in bad faith shall not be registered

Filing the Application

A trademark application is filed before the Trade Marks Registry, which operates through its headquarters in Mumbai and branch offices in Delhi, Kolkata, Chennai and Ahmedabad. Applications are filed in **Form TM-A** under the **Trade Marks Rules, 2017**, accompanied by the prescribed fee[3]. India follows the Nice Classification system under the Nice Agreement Concerning the International Classification of Goods and Services[4], which divides goods and services into 45 classes - **Classes 1 to 34** for goods and **Classes 35 to 45** for services. A single application covers one class; multi-class applications are not permitted under Indian practice. An applicant seeking protection across multiple classes must file separate applications, each with a separate fee.

The application must identify the mark, the class, the goods or services within that class, the applicant's name and address, a claim of prior use (with the date of first use in India) or proposed use, and, where priority is claimed under **Section 154** read with the Paris Convention, the details of the priority application. The distinction between use-based and proposed-to-be-used applications matters substantially in opposition proceedings, where a party with demonstrable prior use may defeat a registered proprietor's priority claim even without registration.

Examination and the Trade Marks Journal

Once filed, the application is examined by an examiner at the Registry in accordance with the **Trade Marks Rules, 2017 and the Manual of Trade Marks Practice and Procedure** published by the CGPDTM[5]. The examiner issues an Examination Report identifying objections under the absolute grounds in Section 9 or the relative grounds in Section 11. Common objections include lack of distinctiveness, descriptiveness, phonetic or visual similarity to a prior registered mark and conflict with a well-known mark.

The applicant must file a response to the Examination Report within thirty days (extendable on sufficient cause). If the examiner is not satisfied with the written response, the applicant may be called for a hearing before the Registrar. If the objections are overcome, the application is accepted. If not, it is refused. A refusal may be appealed to the Intellectual Property Division of the High Court having jurisdiction - since the abolition of the Intellectual Property Appellate Board (IPAB) in 2021, appeals from Registry decisions lie directly before the jurisdictional High Court.

Upon acceptance, the mark is advertised in the weekly Trade Marks Journal published online by the Registry through the CGPDTM's official website. The date of advertisement starts the four-month opposition window. Once that window closes without opposition, the mark proceeds to registration.

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[3] The Trade Marks Rules, 2017, G.S.R. 724(E) (India). The Rules replaced the Trade Marks Rules, 2002.

[4] Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, June 15, 1957, as revised, 890 U.N.T.S. 191.

[5] Controller General of Patents, Designs & Trade Marks, Manual of Trade Marks Practice and Procedure (2015) (India)

The Opposition Procedure Under Section 21

Standing and Timing

Section 21(1) of the Trade Marks Act, 1999 provides that any person may, within four months from the date of advertisement or re-advertisement, give notice in writing in the prescribed manner to the Registrar of opposition to the registration. The four-month period is absolute and cannot be extended under any circumstances - the Trade Marks Rules, 2017 removed the earlier discretionary one-month extension. A competitor or prior user who misses the four-month window has no recourse within the opposition procedure and must instead seek rectification of the register after registration under **Section 57.**

The use of the words "any person" reflects a deliberate legislative choice. Indian law allows any person - a competitor, a consumer, a trade association or a member of the public - to file an opposition. The Calcutta High Court confirmed this position in **P.N. Mayor v. Registrar of Trademarks, AIR 1969 Cal 80**[6], holding that the phrase is to be read in its full ordinary meaning and does not require the opponent to establish a proprietary interest in the outcome.

> **P.N. Mayor v. Registrar of Trademarks**
> *AIR 1969 Cal 80 - Calcutta High Court*
> The phrase "any person" in Section 21(1) is to be read in its full ordinary meaning. An opponent need not establish a proprietary interest; it is sufficient to have a legitimate reason to believe that the proposed registration would harm the public or existing commercial rights.

Filing the Opposition Notice

The opposition notice is filed in **Form TM-O** along with the prescribed fee (currently ₹2,700 for e-filing). The notice must set out the grounds of opposition in sufficient particularity. The grounds available broadly mirror the grounds for refusal at examination: lack of distinctiveness, deceptive similarity to an earlier mark, contrariety to law, deceptive use, conflict with a well-known mark, bad faith under Section 11(10), and, for a prior user, the claim that the applicant is not the true owner of the mark.

Counter-Statement and the Consequences of Default

Section 21(2) requires the Registrar to serve a copy of the notice on the applicant. The applicant then has two months from the date of receipt of the notice to file a counter-statement. If the applicant fails to file within this period, the application is deemed abandoned - a hard consequence with no provision for condonation of delay. The starting point of the two-month period was addressed by the Madras High Court in **Ramya S. Moorthy v. Registrar of Trade Marks (2023),** which held that the period runs from the date the applicant actually receives the notice, not from the date the Registry dispatches it - a ruling that aligns with principles of natural justice and protects applicants from systemic postal delays.

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[6] *Prem N. Mayor v. Registrar of Trade Marks*, AIR 1969 Cal 80 : (1969) 1 CLJ 385 (India). Decided April 24, 1968, Calcutta High Court (P.B. Mukharji J.).

Ramya S. Moorthy v. Registrar of Trade Marks

(2023) - Madras High Court

The two-month period for filing a counter-statement under Section 21(2) runs from the date on which the applicant actually receives the notice from the Registry, not from the date of dispatch. This interpretation protects applicants from being timed out by postal or administrative delays.

The Evidence Stages

After the counter-statement, the opposition proceeds to the evidence stage under **Rules 45 to 47** of the **Trade Marks Rules, 2017**[7]. The timeline is as follows:

1. Opponent files evidence in support of opposition by affidavit - within two months of receiving the counter-statement (extendable by one month on application).
2. Applicant files evidence in support of the application - within two months of receiving the opponent's evidence.
3. Opponent may file evidence in reply - within one month of receiving the applicant's evidence.

The evidence stage is the decisive battlefield of trademark opposition. A well-mounted opposition with strong evidence of prior use, acquired distinctiveness of the opponent's mark and documentary proof of similarity in goods and marks can succeed decisively. An opposition filed on thin grounds with inadequate evidentiary support will fail, regardless of the legal argument in the abstract.

The Hearing and Decision

After the evidence stages are complete, **Section 21(5)** requires the Registrar to afford both parties an opportunity of hearing. Hearings are conducted before the Registrar or a hearing officer. The Registrar then decides the opposition: either allowing it (application refused) or dismissing it (mark proceeds to registration). The decision may be appealed to the High Court under Section 91.

Grounds of Opposition and Leading Cases

Deceptive Similarity Under Section 11(1)

The most frequently invoked ground is deceptive similarity under Section 11(1), read with Section 2(1)(h), which provides that a mark shall be deemed deceptively similar to another if it so nearly resembles that other mark as to be likely to deceive or cause confusion. The leading cases on the deceptive similarity standard are examined in detail in Article 2 of this issue. In the context of opposition, three Supreme Court decisions are essential[8].

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[7] The Trade Marks Rules, 2017, rr. 45–47, G.S.R. 724(E) (India).

[8] Corn Products Ref. Co. v. Shangrila Food Prods. Ltd., AIR 1960 SC 142 : (1960) 1 SCR 968 (India); Cadila Healthcare Ltd. v. Cadila Pharms. Ltd., (2001) 5 SCC 73 : AIR 2001 SC 1952 (India); M/S. Nandhini Deluxe v. Karnataka Coop. Milk Producers Fed'n Ltd., (2018) 9 SCC 183 : AIR 2018 SC 3516 (India).

Corn Products Refining Co. v. Shangrila Food Products Ltd.[9]

AIR 1960 SC 142, (1960) 1 SCR 968 - Supreme Court of India

The test of deceptive similarity must be approached from the standpoint of a person of average intelligence and imperfect recollection. Marks must be compared as a whole, not dissected element by element. A trade connection between different goods is a relevant consideration. “GLUCOVITA” and “GLUVITA” found deceptively similar.

Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd.

(2001) 5 SCC 73 - Supreme Court of India

Laid down the multi-factor test for deceptive similarity: nature of the marks; degree of phonetic, visual and conceptual resemblance; nature of the goods; class of consumers; mode of purchase. In pharmaceutical cases, a stricter standard applies because confusion can harm public health. Reversed the High Court’s finding of insufficient confusion.

M/S. Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd.

(2018) 9 SCC 183, AIR 2018 SC 3516 - Supreme Court of India

Phonetic similarity alone does not compel a finding of deceptive similarity. Where marks are visually and contextually distinct when encountered in their respective commercial contexts and where goods and consumer bases differ, coexistence may be permissible even with phonetic overlap. Allowed registration of “NANDHINI DELUXE” limited to exclude milk and milk products.

Bad Faith as a Ground of Opposition

Section 11(10)(ii) of the Trade Marks Act, 1999 provides that the Registrar shall not register a mark if the application was made in bad faith[10]. A trademark applicant who applies knowing that the mark belongs to another party or who seeks registration with the deliberate intention of blocking a competitor or extracting a commercial settlement, acts in bad faith and the application should be refused. Indian courts have engaged with bad faith in trademark proceedings, though the doctrine remains less developed than in European law. Evidence of prior knowledge of the opponent’s mark, combined with suspicious similarity in the applied-for mark, can form the basis of a credible bad faith allegation.

Concurrent Use and Section 12

Section 12 of the Act provides that in cases of honest concurrent use or other special circumstances, the Registrar may permit registration of identical or similar marks for the same goods by more than one proprietor, subject to such conditions and limitations as the Registrar thinks fit. Concurrent registration requires a demonstration of honest adoption and bona fide use of the mark, typically over a prolonged period, predating the applicant’s knowledge of the opponent’s mark. The Nandhini Deluxe decision, read alongside Section 12[11], has reinforced that long and honest concurrent use in different markets or product categories can co-exist within the same trademark class, provided the registration is appropriately limited.

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9 *Corn Products Ref. Co. v. Shangrila Food Prods. Ltd.*, AIR 1960 SC 142 : (1960) 1 SCR 968 (India). Decided October 8, 1959.

10 The Trade Marks Act, 1999, § 11(10)(ii), No. 47 of 1999, Acts of Parliament, 1999 (India).

11 *M/S. Nandhini Deluxe v. Karnataka Coop. Milk Producers Fed'n Ltd.*, (2018) 9 SCC 183 : AIR 2018 SC 3516 (India) (A.K. Sikri and Ashok Bhushan, JJ.).

Evidence Strategy in Opposition

Opposition proceedings in India are decided primarily on evidence, not legal argument alone. The evidence that proves most consequential includes:

- Documents showing the date and nature of first use of the mark in India.
- Documentary evidence of the volume and value of sales under the mark - invoices, sales figures, market share data.
- Advertising and promotional expenditure - establishing the commercial reputation of the mark.
- Awards, recognitions or third-party references to the mark.
- Evidence of the mark's recognition among the relevant consumer class.

Consumer survey evidence, while technically admissible, is not routinely produced in opposition proceedings before the Registry, partly because of cost and partly because the Registry has not developed a rigorous methodology for evaluating such evidence. Survey evidence is more commonly encountered in High Court infringement proceedings where expert witnesses can be cross-examined.

Prosecution Strategy and Examination Objections

A well-designed trademark prosecution strategy anticipates examination objections and addresses them efficiently. When the Registry raises a deceptive similarity objection citing a prior mark, the applicant's response must go beyond simply asserting that the marks are different. It should address the Cadila v. Cadila multi-factor framework systematically: demonstrating phonetic and visual differences, identifying differences in goods or services and channels of trade, characterising the relevant consumer and the degree of care that consumer exercises, and, where available, producing evidence of co-existence in the marketplace without confusion.

Where the objection is on absolute grounds - distinctiveness or descriptiveness - the applicant must demonstrate either inherent distinctiveness (where the mark is coined, fanciful or arbitrary) or acquired distinctiveness through evidence of use. The Trade Marks Rules, 2017 also permit the filing of amended applications to limit the specification of goods or services, which can be a strategic tool for overcoming relative grounds objections by narrowing the class specification to avoid direct conflict with the cited prior mark.

Post-Opposition: Registration, Renewal and Rectification

Registration and Its Consequences

Once opposition proceedings are resolved in the applicant's favour - whether because no opposition was filed, the opposition was dismissed or it was not pursued to conclusion - the mark is registered. The proprietor then acquires the rights conferred by Section 28 of the Act: the exclusive right to use the mark[12] in relation to the goods or services for which it is registered.

[12] The Trade Marks Act, 1999, § 28, No. 47 of 1999, Acts of Parliament, 1999 (India).

Registration is for ten years from the date of application, renewable indefinitely in further periods of ten years under Section 25.

Rectification Under Section 57

Registration is not immutable. The register can be challenged after registration through a rectification petition under Section 57[13]. Any aggrieved person may apply to the Registrar or the High Court for rectification on any ground that would have justified refusal of registration, including deceptive similarity, descriptiveness and bad faith.

Non-Use Removal Under Section 47

Section 47 provides for the removal of a registered mark[14] from the register on the ground of non-use, if the mark has not been used in India for a continuous period of five years and three months preceding the date of the application for removal. The non-use action is the post-registration equivalent of the opposition - it allows competitors to clean up the register by removing marks that have been registered but are not being used, thereby freeing up trademark space for new entrants.

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[13] The Trade Marks Act, 1999, § 57, No. 47 of 1999, Acts of Parliament, 1999 (India).

[14] The Trade Marks Act, 1999, § 47, No. 47 of 1999, Acts of Parliament, 1999 (India).

DECEPTIVE SIMILARITY AND THE CONSUMER CONFUSION TEST IN INDIAN TRADEMARK LAW

The Central Doctrinal Question in Trademark Registration, Opposition and Infringement

Few questions in Indian trademark law arise more frequently or are decided with greater consequence, than whether two competing marks are deceptively similar to each other. The resolution of this question governs whether a trademark application will be accepted or rejected by the Registrar, whether an opposition proceeding will succeed or fail and whether an infringement suit will result in an injunction or be dismissed. The test applied by courts and the Trade Marks Registry to answer this question - the consumer confusion test - is the central organising principle of deceptive similarity analysis in India.

The concept is deceptively simple in its statutory formulation but demands sophisticated application in practice. The Trade Marks Act, 1999 defines the term tersely, leaving courts to develop the substantive content of the doctrine through decades of adjudication. The result is a body of jurisprudence that is rich, nuanced and calibrated to the social and demographic realities of the Indian market in ways that distinguish it from the trademark law of other jurisdictions.

The Statutory Foundation

Section 2(1)(h): The Definition

Section 2(1)(h) of the Trade Marks Act, 1999 defines the concept as follows[15]: a mark shall be deemed to be deceptively similar to another mark if it so nearly resembles that other mark as to be likely to deceive or cause confusion.

The definition is intentionally open-textured. Parliament did not specify any criteria for determining when resemblance rises to the level of deception or confusion. The Act provides no exhaustive list of factors, no prescribed methodology and no hierarchy of considerations. Each case is to be decided on its own facts, with the weight given to individual factors varying with the nature of the marks, the character of the goods or services and the identity of the consumers likely to encounter them.

This deliberate flexibility serves an important purpose. The universe of trademark disputes is enormously varied - a dispute over pharmaceutical product names involves different considerations from a dispute over luxury fashion logos; a dispute between marks used for industrial machinery involves a different consumer base than one involving mass-market consumer goods. A rigidly codified test would not serve the diversity of these contexts. The courts have accordingly developed a set of principles and sub-tests through judicial decision that together constitute the Indian consumer confusion test.

Where Deceptive Similarity Operates in the Act

The concept of deceptive similarity is operative across three distinct provisions of the Act:

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[15] The Trade Marks Act, 1999, § 2(1)(h), No. 47 of 1999, Acts of Parliament, 1999 (India).

- Section 11(1) - relative ground for refusal of registration: a trademark shall not be registered if[16], because of its identity or similarity to an earlier trademark and the identity or similarity of the goods or services covered, there exists a likelihood of confusion on the part of the public, including a likelihood of association with the earlier trademark.
- Section 11(2) - well-known trademark protection: a trademark shall not be registered if it is identical or similar to a well-known mark and its use would take unfair advantage of or be detrimental to, the distinctive character or repute of that well-known mark. For well-known marks, protection operates across class boundaries.
- Section 29(1) and (2) - infringement: a registered trademark is infringed where the defendant's mark, because of its identity or similarity to the registered mark and the identity or similarity of the goods or services covered, gives rise to a likelihood of confusion. The standard for infringement is substantially the same as for refusal of registration.

The Deceptive Similarity Standard: Key Statutory Provisions

Section 2(1)(h) - defines "deceptively similar": so nearly resembles as to be likely to deceive or cause confusion

Section 11(1) - relative ground for refusal: identity/similarity + likelihood of confusion

Section 11(2) - well-known marks: protection across dissimilar goods/services

Section 29(2) - infringement: deceptive similarity gives rise to likelihood of confusion

Section 2(1)(h) applies identically to refusal, opposition and infringement proceedings

The Consumer Confusion Test: Foundational Principles

Indian courts have developed a set of foundational principles that constitute the consumer confusion test across more than six decades of Supreme Court adjudication. Each principle has been developed through a specific decision that remains authoritative today.

Principle 1: The Average Consumer with Imperfect Recollection

The most fundamental principle is that the assessment must be made from the perspective of a person of average intelligence with imperfect recollection - not an expert, not a trademark lawyer, not a person of exceptional observation and not a person who has both marks placed before them simultaneously for careful comparison.

Corn Products Refining Co. v. Shangrila Food Products Ltd.

AIR 1960 SC 142, (1960) 1 SCR 968 - Supreme Court of India

The test of deceptive similarity must be approached from the point of view of a person of average intelligence and imperfect recollection. The overall structural and phonetic similarity and the similarity of the idea conveyed is the determinative question. "GLUCOVITA" and "GLUVITA" found deceptively similar; a trade connection between glucose and biscuits was treated as a relevant consideration.

The rationale for the imperfect recollection standard is grounded in consumer behaviour. A person purchasing goods does not typically have both competing marks before them at the same

[16] The Trade Marks Act, 1999, §§ 11(1), 11(2), 29(1)–(2), No. 47 of 1999, Acts of Parliament, 1999 (India).

time. They encounter one mark, form an impression of it and then - perhaps days or weeks later - encounter the other. Their response is mediated not by precise visual comparison but by a general impression retained in memory. As the Supreme Court observed in Parle Products (P) Ltd. v. J.P. & Co., Mysore[17], (1972) 1 SCC 618, an ordinary purchaser is not gifted with the powers of observation of a Sherlock Holmes[18].

Principle 2: The Anti-Dissection Rule

Marks must be considered in their entirety. Courts must not dissect a mark into its component parts and compare individual elements in isolation. The question is whether the mark as a whole - in its totality, including its visual impression, phonetic character and conceptual meaning - is likely to cause confusion.

> **Parle Products (P) Ltd. v. J.P. & Co., Mysore**
>
> *(1972) 1 SCC 618, AIR 1972 SC 1359 - Supreme Court of India*
>
> The biscuit packaging case. The correct approach requires comparison of the broad and essential features of marks, not a meticulous inventory of similarities and differences. If the essential features have been copied, the fact that there are differences in minor details does not save the defendant. Both the District Court and the High Court had applied the wrong standard; the Supreme Court reversed concurrent findings.

The anti-dissection rule reflects a basic truth about consumer psychology: a buyer remembers a general impression of a mark - its overall look, its dominant element, the feeling it evokes - rather than a detailed catalogue of its components. A mark can therefore be deceptively similar to another even if there are points of difference, provided the overall impression it creates in the mind of a consumer of average intelligence is likely to cause confusion with the earlier mark.

Principle 3: No Side-by-Side Comparison

Courts should not place the two marks side by side and compare them with close attention. The proper inquiry is whether the marks create a similar overall impression when encountered separately, as they would be in commerce. A meticulous side-by-side comparison that catalogues the differences between marks defeats the purpose of the test - it transforms the inquiry from one about consumer perception into one about forensic dissection.

Principle 4: Likelihood of Confusion, Not Actual Confusion

The test is one of likelihood of confusion or deception, not of actual confusion. It is not necessary to prove that any particular consumer was in fact confused. It is sufficient to establish that an average consumer of the relevant goods or services, exercising the degree of care ordinarily exercised in that kind of purchase, would be likely to be confused. This is a matter for the court

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[17] *Parle Prods. (P) Ltd. v. J.P. & Co.*, (1972) 1 SCC 618 : AIR 1972 SC 1359 (India).

[18] *Parle Prods. (P) Ltd. v. J.P. & Co.*, (1972) 1 SCC 618 : AIR 1972 SC 1359 (India). Decided January 28, 1972 (Mitter, Vaidyialingam and Dua JJ.).

to assess as a question of first impression; a claimant need not produce evidence of instances of actual confusion.

Amritdhara Pharmacy v. Satya Deo Gupta[19]

AIR 1963 SC 449, (1963) 2 SCR 484 - Supreme Court of India

The two fundamental questions in any deceptive resemblance analysis: (1) who are the persons likely to be deceived or confused; and (2) what rules of comparison are to be adopted to judge whether such resemblance exists. "AMRITDHARA" and "LAKSHMANDHARA" found deceptively similar for medicinal preparations. No evidence of actual confusion was required. The Allahabad High Court's contrary finding reversed.

The Multi-Factor Framework: Cadila Healthcare v. Cadila Pharmaceuticals

The most comprehensive elaboration of the factors relevant to the deceptive similarity analysis was provided by the Supreme Court in Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd., (2001) 5 SCC 73 - the most frequently cited trademark decision in Indian jurisprudence and the starting point for every pharmaceutical trademark dispute.

The dispute arose from a corporate restructuring of the Cadila group, which resulted in two separate pharmaceutical companies - Cadila Healthcare and Cadila Pharmaceuticals - each entitled to use the "Cadila" name. Cadila Healthcare launched an anti-malarial drug named "FALCIGO"; Cadila Pharmaceuticals launched a similar drug named "FALCITAB," both derived from the word "falciparum malaria." The District Court and the High Court had both held that there was insufficient likelihood of confusion because the drugs were sold only to hospitals and clinics, not to the general public. The Supreme Court reversed this approach.

Cadila v. Cadila: The Multi-Factor Test for Deceptive Similarity

1. Nature of the marks - word marks, label marks or composite marks
2. Degree of resemblance - phonetic, visual and conceptual
3. Nature of the goods or services - class, use and commercial proximity
4. Similarity of character and performance of the goods
5. Class of consumers - education, intelligence and degree of care exercised
6. Mode of purchasing - over the counter, prescription, online, catalogue
7. Any other relevant surrounding circumstances

Note: In pharmaceutical cases, a stricter standard applies - confusion can affect public health

The Court's holding on pharmaceutical marks carries enduring significance: even trained medical professionals are not infallible and drugs prescribed verbally by doctors and requested verbally at pharmacies are particularly vulnerable to phonetic confusion. The risk of harm from administering the wrong drug is a public health concern that justifies a heightened standard of care in the pharmaceutical sector.

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[19] *Amritdhara Pharmacy v. Satya Deo Gupta*, AIR 1963 SC 449 : [1963] 2 SCR 484 (India). Decided April 27, 1962 (S.K. Das, Hidayatullah and J.C. Shah JJ.).

Cadila Healthcare Ltd. v. Cadila Pharmaceuticals Ltd.

(2001) 5 SCC 73 - Supreme Court of India

The multi-factor test for deceptive similarity in pharmaceutical marks. A stricter standard applies in the pharmaceutical sector because confusion affects public health directly. Drugs sold to hospitals and clinics can be confused even by trained professionals. The High Court's finding of insufficient confusion reversed. "FALCIGO" and "FALCITAB" found deceptively similar.

The Three Dimensions of Similarity

Phonetic Similarity

Phonetic similarity focuses on the sound of the marks when spoken aloud. This is of particular importance in India for two reasons. First, a substantial proportion of the population purchases goods by oral request - asking a shopkeeper for a product by name rather than reading the packaging. Second, in a country with over twenty-two officially recognised languages and numerous regional dialects, the same word may be pronounced differently across regions and transliterations from one script to another may produce marks that are phonetically identical even if visually distinct.

Ruston & Hornsby Ltd. v. Zamindara Engineering Co.[20]

(1969) 2 SCC 727, AIR 1970 SC 1649 - Supreme Court of India

"RUSTAM-E-HIND" found phonetically and deceptively similar to the registered mark "RUSTON" for diesel engines. The addition of words ("E-HIND") that distinguish the mark does not save it where the phonetic identity of the dominant element is established. The test is likelihood of deception; where the dominant element is phonetically identical, subsidiary additions are insufficient.

Visual Similarity

Visual similarity examines the appearance of the marks - their spelling, design elements, colour scheme, layout and overall get-up. Trade dress - the totality of visual elements associated with a product, including packaging, colour combinations and design - is assessed for visual similarity in the same manner as word marks. Parle Products v. J.P. & Co. is the pre-eminent authority on visual similarity in trade dress disputes, establishing that comparison of the broad and essential features of the packaging, not a line-by-line inventory of differences, is the correct approach.

Conceptual or Ideational Similarity

Conceptual similarity applies where two marks convey the same underlying idea, even if they do so through different words, languages or symbols. Marks that are translations of each other into different languages or that use different words to denote the same concept, may be found deceptively similar on this basis.

[20] *Ruston & Hornsby Ltd. v. Zamindara Eng'g Co.*, (1969) 2 SCC 725 : AIR 1970 SC 1649 (India). Decided September 8, 1969 (Ramaswami and J.C. Shah JJ.).

Indian courts have found deceptive similarity based on conceptual equivalence in several notable instances. The marks "SURYA" and "BHASKAR" were found deceptively similar because both are Hindi words meaning "sun" - the same conceptual idea expressed through synonymous terms. Similarly, "PEACOCK" and "MAYUR" - the English and Hindi words for the same bird - have been held deceptively similar on conceptual grounds. The Supreme Court in Corn Products Refining Co. v. Shangrila Food Products Ltd. held that the idea conveyed by both "GLUCOVITA" and "GLUVITA" - the combination of glucose and vitality - was the same and that this conceptual identity contributed to the likelihood of confusion.

The Nandhini Qualification: Context, Goods and Consumer Base

The Supreme Court's 2018 decision in M/S. Nandhini Deluxe v. M/S. Karnataka Co-Operative Milk Producers Federation Ltd.,[21] (2018) 9 SCC 183, introduced an important qualification: phonetic similarity alone, without more, does not compel a finding of deceptive similarity if the nature of the goods, the consumer base and the overall impression of the marks in their respective commercial contexts differ sufficiently to make confusion unlikely.

Karnataka Co-Operative Milk Producers Federation Ltd. had been using the mark "NANDINI" since 1985 for milk and milk products, with registrations in Classes 29 and 30. Nandhini Deluxe, a restaurant chain operating primarily in Bengaluru, had been using the mark "NANDHINI" since 1989 for restaurant services. The IPAB and the Karnataka High Court had upheld the opposition. The Supreme Court reversed, allowing the registration of "NANDHINI DELUXE" with a condition excluding milk and milk products.

M/S. Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd.

(2018) 9 SCC 183, AIR 2018 SC 3516 - Supreme Court of India (A.K. Sikri and Ashok Bhushan, JJ.)

Phonetic similarity alone does not compel a finding of deceptive similarity. Where marks are visually and contextually distinct in their respective commercial settings and where the goods and consumer bases differ, coexistence may be permissible. Neither "NANDINI" nor "NANDHINI" is a coined or invented mark - both are generic words from Hindu mythology. Registration of "NANDHINI DELUXE" allowed, limited to exclude milk and milk products.

The Nandhini decision confirms that the consumer confusion test is not a mechanical exercise in phonetic or visual comparison. It requires a holistic assessment that accounts for the actual conditions under which consumers encounter the competing marks, the nature of the goods or services and the realistic possibility that a consumer would associate one mark with the other. It has significantly strengthened the position of applicants who face opposition from established brand holders in adjacent markets.

Honest Concurrent Use Under Section 12

The Trade Marks Act, 1999 acknowledges that two marks that are similar or even identical may have been in honest concurrent use in the Indian market, such that their coexistence does not

[21] *M/S. Nandhini Deluxe v. Karnataka Coop. Milk Producers Fed'n Ltd.*, (2018) 9 SCC 183 : AIR 2018 SC 3516 (India). Decided July 26, 2018 (A.K. Sikri and Ashok Bhushan JJ.).

cause undue confusion. Section 12 of the Act empowers the Registrar, in the case of honest concurrent use or other special circumstances, to permit registration of a mark that would otherwise be refused on grounds of deceptive similarity, subject to conditions and limitations as the Registrar thinks fit.

The principle was discussed by the Supreme Court in Amritdhara Pharmacy v. Satya Deo Gupta, where the Registrar had initially permitted registration of “LAKSHMANDHARA” in Uttar Pradesh on the basis that Amritdhara Pharmacy’s acquiescence in the respondent’s long-running use in that state constituted a special circumstance. The Supreme Court upheld the finding on acquiescence. The doctrine establishes that where concurrent use has been genuinely established over a significant period without evidence of actual confusion and where the proprietor of the earlier mark has not protested the use, coexistence may be permitted subject to appropriate territorial or goods-based limitations.

Deceptive Similarity in Infringement Proceedings Under Section 29

In infringement proceedings under Section 29, the deceptive similarity standard applies with the same foundational principles as in registration proceedings. There is, however, a critical distinction: in an infringement action, the registered proprietor’s rights flow from the registration itself. Once the plaintiff establishes that their mark is registered and that the defendant is using a mark that is identical or deceptively similar to it in relation to the same or similar goods or services, infringement is made out without the need to prove actual confusion or damage.

As the Supreme Court confirmed in Parle Products v. J.P. & Co., an infringement action differs from a passing off action in this crucial respect: it is not necessary for the plaintiff in an infringement action to establish goodwill, actual confusion or damage. The exclusive right conferred by registration under Section 28 is infringed as soon as a deceptively similar mark is used in the course of trade in respect of the registered goods or services, whether or not any consumer was in fact misled.

Practical Implications for Practitioners

The body of doctrine examined in this article carries clear practical implications.

For Applicants and Brand Owners

- A clearance search before adoption of a new mark must go beyond checking for identical marks. It must assess phonetic equivalents, visual lookalikes and conceptual synonyms in multiple languages, including regional language equivalents of the proposed mark.
- Where a mark is proposed for pharmaceuticals or other health-related goods, a higher standard of differentiation is required. The Cadila v. Cadila framework applies with heightened vigilance and marks that differ in only one or two phonetic components may still face deceptive similarity objections.
- Evidence of honest concurrent use without confusion is a valuable commercial asset. Brand owners who operate alongside similar marks without incident should document that coexistence systematically, as it may support a Section 12 application if registration is later sought.

For Opponents

- An opposition based solely on phonetic similarity, without attention to the nature of the goods, the consumer base and the visual and conceptual differences between marks, may fail under the Nandhini qualification. Opposition notices must be supported with evidence that addresses all relevant Cadila factors, not merely phonetic resemblance.
- Documentary evidence of the opponent's prior use, acquired distinctiveness and commercial reputation is essential. The strength of a deceptive similarity claim is directly proportional to the strength of the reputation evidence that accompanies it.

For Litigants in Infringement Proceedings

- The distinction between infringement and passing off is of practical significance: a registered proprietor does not need to prove goodwill or actual confusion to establish infringement, only deceptive similarity. The availability of the infringement action, rather than passing off, is therefore a significant procedural advantage for a proprietor with a registered mark.