

**MUTATION OF THE TRADEMARK DOCTRINE: ANALYSING ACTIONABLE USE TO RECONCILE
BRAND IDENTITIES WITH CONSTITUTIONAL SAFEGUARDS**

M.P. Ram Mohan and Aditya Gupta[‡]*

Abstract: *With continuous and consistent use, trademarks can come to signify opulence, luxury, and dependability; and become cultural icons. The modern trademark doctrine must accommodate these realities of the marketplace while, at the same time, accommodating the flourishing exchange of expressive uses through unauthorised use of trademarks. This push-and-pull has resulted in the complete obliteration of what were already obscure boundaries between the expressive and marketing spheres of trademark law. The present study examines the normative foundations of the modern trademark doctrine, drawing from American, English, and European trademark jurisprudence. These foundations are then extrapolated to Indian trademark law to create a workable limitation of the mutating trademark doctrine through recalibrating the actionable use requirement. The authors attempt to discern the normative foundations of the individual cause of actions in the infringement liability and argue that such foundations should serve to delimit the scope of protection offered therein. Given the relevance of expressive uses in trademark law, the present study also examines the relevance of constitutional and policy-based arguments in determining trademark infringement liability. We find that within Indian judicial discourse, there is an alarming disconnect between the normative foundations of infringement liability and their interpretation. This affects the interpretation of the limitations offered by the trademark statute and can potentially push trademark law in troubling directions.*

* Associate Professor and Member of Centre for Financial Markets and Economy at the Indian Institute of Management Ahmedabad and Research Affiliate, Hiroshima University.

[‡] Research Associate, Indian Institute of Management, Ahmedabad.

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I. INTRODUCTION

*“In an acquisitive society, the drive for monopoly advantage is a very powerful pressure. Unchecked, it would no doubt patent the wheel, copyright the alphabet, and register the sun and moon as exclusive trademarks.”*¹

What is the first thing that comes to your mind when you hear the word ‘Barbie’? Initially adopted as a totem to indicate the origin and confirm the source of a toy, with continuous and consistent use, ‘Barbie’ has descended as a part of the popular language,² and has since assumed the status of a cultural icon.³ Since its initial launch in 1959,⁴ Barbie has accrued an extraordinary level of attention and criticism.⁵ A subject of continuous appropriation and reinterpretation, ‘Barbie’ begs the question: how has Mattel embraced this development?

With gross sales over USD 1 billion⁶ and an overall brand value of USD 571 million,⁷ Mattel claims that they sell over 100 Barbie dolls every minute and over 58 million dolls are sold per annum.⁸ With such astronomical sales and revenue figures, it is safe to say that Mattel has reaped considerable financial gains from the use of its ‘Barbie’ mark. Owing to its significance as a cultural icon and the associations of femininity associated with ‘Barbie’, it has been the subject of an *antibranding movement*. Artists and authors have continually ridiculed and parodied the colloquial conceptualisations associated with the mark.⁹ These

¹ Ralph S Jr Brown, 'Advertising and the public interest: Legal protection of trade symbols' (1948) 57 Yale Law Journal 1619, 1659.

² See, Rachna Sharma, 'Barbie: American Icon to World Idol' (2008) 5 ICFAI Journal of Brand Management 39–51; for example, see, Udo Wagner et al, 'Possession Attachment toward Global Brands: How the “World of Barbie” is Shaping the Mindsets of Millennial Girls' (2021) 33 Journal of International Consumer Marketing 434–451. This study examines the possession attachment of Indian women with Barbie dolls.

³ *Mattel Inc v MCA Records Inc* (2002) 296 Federal Reporter Third Series 894 (United States Court of Appeals for the Ninth Circuit); Ann duCille, 'Dyes and Dolls: Multicultural Barbie and the Merchandising of Difference' in Jacqueline Bobo, Cynthia Hudley, and Claudine Michel (eds), *The Black Studies Reader* (Routledge 2004) 265, 268.

⁴ Mary F Rogers, *Barbie Culture* (SAGE Publications Ltd 1998) 86–112.

⁵ Kristin Noelle Weissman, *Barbie: The icon, the image, the ideal: An analytical interpretation of the Barbie doll in popular culture* (Universal Publishers 1999) 9–11.

⁶ Annabelle Timsit, 'Barbie is back to being a billion-dollar brand' *Quartz* (New York City, 9 February 2019) <<https://qz.com/1546252/barbie-is-back-to-being-a-billion-dollar-brand/>> accessed 10 February 2022.

⁷ 'I'm a Barbie Girl, in a changing world' (*Brand Finance*, 4 August 2016) <<https://brandfinance.com/press-releases/im-a-barbie-girl-in-a-changing-world>> accessed 10 February 2022.

⁸ Emily Dixon, 'As Barbie turns 60, how has the world's most famous doll grown up?' *CNN Style* (Atlanta, 9 March 2019) <www.cnn.com/style/article/us-barbie-60th-birthday-scli-intl/index.html> accessed 16 April 2022).

⁹ M P Ram Mohan and Aditya Gupta, 'Litigating Barbie: Trademark Infringement, Parody and Free Speech' (2022) IIMA Working Papers <<https://web.iima.ac.in/assets/snippets/workingpaperpdf/2013012119-2022-07-01.pdf>> accessed 3 November 2022; see, Rebecca Tushnet, 'Make me walk, make me talk, do whatever you please: Barbie and exceptions' in Jane C Ginsburg and Rochelle Cooper Dreyfuss (eds), *Intellectual Property at the Edge: The Contested Contours of IP* (Cambridge University Press 2014) 405.

parodies and satires run directly hostile to Mattel’s motivations.¹⁰ This situation raises a serious concern for trademark law: which concerns should trademark law protect? Should the antibranding movements be protected, or should Mattel be allowed absolute control over their mark?

‘Barbie’ is one of the possibly hundreds of brands and trademarks which have been appropriated and reappropriated by the linguistics of modern culture.¹¹ For example, when Senator Wendy Davis voiced her pro-choice stance in the abortion debate, the blonde-haired woman was dubbed ‘Abortion Barbie.’¹² Coca-Cola has been heralded to have dawned a new age of capitalism ‘Coca-Cola Capitalism’.¹³ How should the law regulate such brands which have transcended their source-identifying functions?

As soon as trademarks transcend their source identifying function and become the basis of important and evocative metaphors, the trademark doctrine starts to struggle.¹⁴ As Justice Kozinski observes, “*where trademarks come to carry so much communicative freight, allowing the trademark holder to restrict their use implicates our collective interest in free and open communication.*”¹⁵ The modern marketing and advertising values counteract with the expressive and public use of trademarks to thrust trademark doctrine in opposing directions.¹⁶ Analysing this tug-of-war, Prof. Dreyfuss points out, “*the dichotomy between marketing and expressive spheres, which was always somewhat indistinct, has collapsed entirely.*”¹⁷

¹⁰ Mattel has continuously tried to contain the social discourse surrounding Barbie. *See*, for example, body positive Barbie dolls: Afua Hirsch, 'Yes, Barbie has got bigger. But her old body-image message endures' *The Guardian* (London, 16 May 2017) <www.theguardian.com/commentisfree/2017/may/16/barbie-bigger-body-image-fashionista-thin> accessed 10 February 2022; 'Barbie dolls made from ocean plastics: Barbie makers launch first doll collection made from recycled ocean-bound plastic' *The Indian Express* (New Delhi, 11 June 2021) <<https://indianexpress.com/article/lifestyle/life-style/barbie-makers-launch-first-doll-collection-made-from-recycled-ocean-bound-plastic-7352758/>> accessed 10 February 2022.

¹¹ For more examples, *see*, Steven M Cordero, 'Cocaine-Cola, the Velvet Elvis, and Anti-Barbie: Defending the Trademark and Publicity Rights to Cultural Icons' (1997) 8 *Fordham Intellectual Property, Media, and Entertainment Law Journal* 599.

¹² Lisa M Corrigan and Skye de Saint Felix, 'A New Doll in Texas: A Feminist Media Analysis of Senator Wendy Davis’s Rhetorical Framing as “Abortion Barbie,”' (2021) *Feminist Media Studies* 1.

¹³ Bartow J Elmore, 'Citizen Coke: an environmental and political history of the Coca-Cola Company' (2013) 14 *Enterprise and Society* 717.

¹⁴ Rochelle Dreyfuss Cooper, 'Reconciling Trademark Rights and Expressive Values: How to Stop Worrying and Learn to Love Ambiguity' in Graeme B Dinwoodie and Mark D Janis (eds), *Trademark Law And Theory: A Handbook of Contemporary Research* (Edward Elgar Publishing 2008) 262; Mark A Lemley, 'Fame, Parody, and Policing in Trademark Law' (2019) *Michigan State Law Review* 2. Famous marks become a part of social conversation in a way ordinary marks do not.

¹⁵ Alex Kozinski, 'Trademarks Unplugged' (1993) 68 *NYU Law Review* 960, 973.

¹⁶ *See*, Teresa Scassa, 'Trademarks Worth a Thousand Words: Freedom of Expression and the Use of the Trademarks of Others' (2012) 53 *Les Cahiers de droit* 877, 877–907.

¹⁷ Dreyfuss Cooper (n 14).

The present study attempts to study this alleged collapse. Placing the discussion within the debate about trademark expansionism, the authors attempt to trace a discernible boundary of protection offered by trademarks within the Indian jurisprudence. The conception of actionable use, which inherently excludes some forms of secondary use from the definition of trademark infringement, is employed to determine the boundary of protection. In order to study the legislative protection offered, the study is limited to infringement actions. Common law trademark actions do not form a part of the present study.

The conceptualisation of actionable use is fertilised by a discussion of trademark law's normative justifications. From *source designators* to *property simpliciter*, the rationales for trademark protection remain varied and contested. The present study extends this debate to educate the actionable use requirement within trademark litigation in India.

Before studying the Indian trademark jurisprudence, the authors highlight some pragmatic realities of trademark litigation in India. Firstly, trademark litigation in India remains slow and complex, which leads to most intellectual property disputes being determined at the stage of interlocutory applications.¹⁸ Even the Supreme Court of India has lamented their disapproval over the state of intellectual property litigation.¹⁹ Secondly, the Indian trademark law provides a proprietor with two sets of remedies: the statutory remedy of infringement²⁰ and the common law remedy of passing off.²¹ While there are considerable differences between the protection offered within the two remedies,²² the “*two strands have been rather messily merged together, which leads to incoherence within individual decisions and inconsistency across the body of case law.*”²³

To counteract the realities of Indian trademark litigation, the authors supplement the Indian trademark jurisprudence with judicial opinions from the United Kingdom (‘U.K.’) and the European Union (‘E.U.’). Given the common law heritage of Indian trademark law, historically, the Indian trademark doctrine has developed in close correlation with its English

¹⁸ Dev Gangjee, 'India' in Daniel R Bereskin (ed), *International Trademark Dilution* (Thomson Reuters Westlaw 2021) 304.

¹⁹ *Shree Vardhman Rice and General Mills v Amar Singh Chawalwala* (2009) 10 SCC 257 [3]; *Bajaj Auto Ltd. v TVS Motor Copmany Ltd* (2009) 9 SCC 797.

²⁰ Trademarks Act 1999, s 29.

²¹ Trademarks Act 1999, s 27(2).

²² *See, Renaissance Hotel Holdings v B Vijaya Sai andand others* (2022) Civil Appeal No 404 of 2022 (Supreme Court of India).

²³ Gangjee (n 18) 305.

counterpart.²⁴ However, with the UK's adoption of the EU's harmonising legislation,²⁵ English law explicitly adopted the European civil law approach. This adoption divorced English trademark jurisprudence from its common law origins.²⁶ Therefore, while decisions from the UK, and by extension the EU, can serve as important aids of interpretation, they should not lead to *Europeanisation* of the Indian trademark law.²⁷ The present study relies on foreign judicial opinions only to supplement the interpretation offered within Indian trademark jurisprudence. The study fosters deviations from foreign jurisprudence when it can create a discord between the normative thesis and statutory interpretation of trademark infringement liability.

Part II of the present study attempts to trace the normative justifications of protecting trademarks. This understanding educates the examination of the ideal interpretation and the scope of expansion for trademark rights in India. Part III explains the legislative framework which provides the infringement remedy to registered trademark owners. Part IV attempts to discern the ideal scope of actionable use that should be protected by the infringement remedy in line with the doctrinal and normative justifications of trademark protection. Finally, Part V studies how far concerns based in free expression and fair competition have cross-fertilised the concerns of trademark protection and expansionism.

II. WHAT DOES A TRADEMARK REGISTRATION PROTECT?

Decades of research has been devoted to the investigation of the functions of trademark protection within the commercial marketplace. Fluctuating market forces and legislative policies have continually worked to alter the nature of trademark law.²⁸ With brands such as

²⁴ Dev Gangjee, 'Non-conventional trademarks in India' (2010) 22 *National Law School of India Review* 67, 69, 70. However, it is important to note that, before Brexit, the UK trademark jurisprudence was bound to follow the European Civil Law constructions. This can potentially divorce the common law connection between the UK and India. This very fact has been identified in judicial opinions from South Africa and Singapore. .

²⁵ Council Directive 89/104/EEC later replaced by codified version 2008/95/EC of 22 October 2008, implemented by way of the UK Trademarks Act 1994; Alison Firth, 'Reception of EU Trademark Law in New Zealand' in Annika Björkdahl et al (eds), *Importing EU Norms: Conceptual Framework and Empirical Findings* (Springer 2015) 171.

²⁶ Gangjee, 'Non-conventional trademarks in India' (n 24) 70. Ironically, the common law approach to registered trademarks is no longer an option for UK courts – the home of the common law – since they are now bound by ECJ precedents.

²⁷ *ibid*; Rasmus Dalgaard Laustsen, 'Likelihood of Confusion: Legislative Harmonisation?' in Rasmus Dalgaard Laustsen (ed), *The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions* (Springer Cham 2020) 253, 277–279.

²⁸ Connie David Powell, 'We all Know it's a Knock Off-Re-Evaluating the Need for the Post-Sale Confusion Doctrine in Trademark Law' (2012) 14 *North Carolina Journal of Law and Technology* 1, 4–13.

Coca-Cola assuming more monetary might than the combined value of the company's entire asset portfolio,²⁹ it is difficult to limit trademark protection to its informative identities.

In the middle of the 20th century, eminent scholars traced the central premise of trademark protection to its informative function.³⁰ These scholars argued that the *intrinsic symbolic value* of marks does not deserve protection.³¹ Towards the end of the 20th century, this position witnessed significant disapproval. Prof. Lemley argued in 1999 that *as commercial transactions become more complex and less tangible, reputation becomes more central*.³² However, despite an explicit admission that trademark law needs to adapt to the changing realities of trademark's economic function,³³ Prof. Lemley cautioned, "*Unless we are careful, we may end up in a world in which every thing, every idea, and every word is owned. And we will all be poorer for it.*"³⁴

To reconcile Prof. Lemley's concerns with the realities of the contemporary marketplace, it is important to identify the normative justifications underlying trademark monopoly. Legal scholars have long debated the theoretical justifications for trademark protection:³⁵ Did it originate to protect the seller's goodwill from free riding and misappropriation, where protecting the trademark owner's investment assumed importance?³⁶ Or were the primary objectives of trademark law primarily consumer-oriented, where protection from confusion in the marketplace occupied the core of the trademark doctrine?³⁷

This section investigates the debate about the doctrinal foundations of trademark law. In doing so, Part A analyses the varying models of trademark protection and their potential

²⁹ Bruce Proctor, 'Unauthorised Use of Trademarks: A Trademark Proprietor's Perspective' in Jeremy Philips (ed), *Trademarks at the Limit* (ElgarOnline 2016) 212, 216, 217.

³⁰ Brown (n 1) 1167–1170.

³¹ *ibid* 1205–1206.

³² Mark A Lemley, 'The Modern Lanham Act and the Death of Common Sense' (1999) 108 *The Yale Law Journal* 1687, 1693.

³³ *ibid* 1715. For an example of the expansion of the core of the trademark doctrine, *see*, Ilanah Simon Fhima, 'The Court of Justice's protection of the advertising function of trademarks: an (almost) sceptical analysis' (2011) 6 *Journal of Intellectual Property Law and Practice* 325.

³⁴ Lemley (n 32) 1715.

³⁵ Deven R Desai, 'The Chicago School Trap in Trademark: The Co-evolution of Corporate, Antitrust, and Trademark Law' (2015) 37 *Cardozo Law Review* 551, 553.

"Dissatisfaction with trademark has only grown...with critics arguing that trademark rights have expanded too far in protecting right holders' interests, have become property rights and that trademark law does not regulate competition well. Other reproaches focus on the way trademark law allows mark holders to chill expression."

³⁶ Lemley (n 32) 1707.

³⁷ For a better understanding of this debate *see*, Rober G Bone, 'Hunting Goodwill: A History of the concept of Goodwill in Trademark Law' (2006) 86 *Boston University Law Review* 547; Glynn Lunney, 'Trademark Monopolies' (1999) 48 *Emory Law Journal* 367.

effects on the future expansion and interpretation of the law. Part B turns to the ECJ's *functions theory* to examine how the protection afforded to the expanded roles of trademark law recalibrates the canonical discussions about the scope of the trademark formula. In doing so, the authors propose a *three-step* model, which is explained towards the end of this section, where the protections afforded to trademarks are carefully catered to accommodate the doctrinal discussions on the subject.

A. Information Transmission *vis-à-vis* Misappropriation

Prof. Bone divided the debate over the trademark protection paradigm between the *information transmission* and the *misappropriation* models in 2007.³⁸ The information transmission model intends to protect consumer confusion and argues that *the essence of the wrong lies in making consumers believe that a product comes from, is affiliated with, or is sponsored by the trademark owner when it is not.*³⁹ It serves three policy objectives:⁴⁰ First, it reduces consumer search costs by allowing trademarks to serve as abbreviated indicators of important product information. This information may have been obtained by a consumer through advertising, personal experience, or word of mouth.⁴¹ Second, protecting an exclusive association between a mark and a proprietor incentivises the seller to maintain and improve product quality.⁴² Third, and most importantly, it reduces the risk of consumer confusion and prevents consumer from being misled into purchase unwanted products.

In its most uncomplicated distillation, the misappropriation argument asserts that a person *should not be able to appropriate the benefits of another's investment without a similar investment of their own.*⁴³ The American Supreme Court explained the misappropriation argument in *International News Service* as "*he who reaps where he has not sown is said to be unjustly enriched.*"⁴⁴ The misappropriation argument focuses on a trademark's goodwill and reputation, rather than preventing consumer confusion in the marketplace.⁴⁵

³⁸ There are other authors who classify this debate with different nomenclatures. *See*, David Nichols and Charley Carroll, 'Trouble in Trademark Law: How Applying Different Theories Leaves the Door Open for Abuse' (2014) 17 SMU Science and Technology Law Review 1, 5. Search costs theory is also an interesting theory which seeks to retrace the justification for trademark protection. *See*, Ariel Katz, 'Beyond Search Costs: The Linguistic And Trust Functions Of Trademarks' Brigham Young University Law Review 1555.

³⁹ Bone (n 37) 556.

⁴⁰ *ibid* 555–556.

⁴¹ Robert G Bone, 'Enforcement costs and trademark puzzles' (2004) Virginia Law Review 2099, 2105.

⁴² Barton Beebe, *Trademark Law: An Open-Source Casebook* (8th edn, New York University Press 2021) 24-25.

⁴³ David W Barnes, 'Misappropriation of Trademark' (2008) 9 North Carolina Journal of Law and Technology 171, 174–176.

⁴⁴ *International News Service v The Associated Press* (1918) 248 US 215 (Supreme Court of the United States); Brown (n 1) 1199–1205.

⁴⁵ Powell (n 28) 6-13.

Some scholars maintain that the information transmission model should dominate trademark theory.⁴⁶ Others, however, argue that *trademark laws were never specifically designed to protect consumers or encourage information availability in the markets, but were to protect producers from illegitimate copies of their products.*⁴⁷ While the scholarly debate about the provenance of trademark policy has witnessed many disagreements, there appears to be some consensus that the present version of trademark law incorporates both models of protection.⁴⁸ As Prof. Desai explains, “*As the economy shifted to mass production and distribution on a national scale, this doctrine (the information transmission model or strict source doctrine) became suspect. Once companies moved beyond direct competition, trademark theory and law struggled to find a way to explain what trademarks protect.*”⁴⁹

With the proliferation of trademark functions in the commercial marketplace, the motivation to protect every possible iteration of a trademark’s secondary use should not be permitted in the name of protecting a trademark’s reputation and goodwill. The influence and authority of the two protection paradigms in modern trademark law must be classified. As Prof. Lemley and McKenna point out:

“It (trademark law) is designed to facilitate a competitive marketplace by allowing consumers to know what they are buying, or at least from whom. But a trademark law that is distorted into a right to own markets— one that seeks out and

⁴⁶ See, for example, Mark A Lemley and Mark P McKenna, 'Owning mark (et) st' (2010) 109 Michigan Law Review 137.

“The market pre-emption and free-riding arguments have served to distract attention from the question of whether consumers are in fact confused to their detriment? or, in the case of dilution, whether they are otherwise harmed by such uses. In so doing, those arguments have contributed to the expansion of trademark law beyond its traditional conceptual moorings.”

⁴⁷ Patricio Sáiz and Rafael Castro, 'Trademarks in branding: Legal issues and commercial practices' (2018) 60 Business History 1105, 1107; Powell (n 28) 7–110; William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 The Journal of Law and Economics 265, 265–275; Mark P McKenna, 'The Normative Foundations of Trademark Law' (2007) 82 Notre Dame Law Review 1839, 1873–1880. First, 'traditional' American trademark law was primarily concerned with protecting producers' interests. In many cases, protecting those interests yielded an additional benefit to consumers, but that side benefit did not motivate decisions.

⁴⁸ Nichols and Carroll (n 38) 7. As such, the functions of trademarks now extend beyond source identification; Stacey L Dogan and Mark A Lemley, 'Parody as Brand' 47 UCD Law Review 473 “*Trademark law, even as it has expanded to prevent dilution, has purported to focus on preventing harm, either to the trademark holder or to the public (and sometimes even both).*”

⁴⁹ Deven R Desai, 'From Trademarks to Brands' (2012) 64 Florida Law Review 981, 1010–1011; Also see: McKenna (n 47).

tries to forbid all free riding on a mark ends up interfering with rather than enabling competition."⁵⁰

Therefore, the *misappropriation argument* should be applied with caution and should not colour the entire spectrum of trademark protection. While goodwill, reputation, and free riding can be considered as important aspects of trademark protection, they need to be reconciled with the conflicting concerns of competition and speech.⁵¹ Alternatively, even if the *information transmission* model occupies the core of trademark protection, it has to be counteracted with the modern realities of branding and advertising.⁵² This coherent understanding of the law is necessary lest it handicaps efforts to identify the ideal direction for its development and push *trademark law in troubling directions*.⁵³

Regardless of the importance of this distinction and delimitation, even judicial opinions have used the information transmission and misappropriation arguments concurrently.⁵⁴ In light of the provenance of the information transmission model and the reservations cited against the misappropriation argument, the authors suggest a three-step model for analysis of trademark infringement cases. This model can be applied to administer all the archetypes of trademark law, including the trademark use requirement and the likelihood of confusion.⁵⁵ When evaluating the validity of an action based on trademark law, the primary concern of the legal doctrine should be preventing consumer confusion. Resultantly, restricting the scope of trademark protection to the information transmission model. Reputation, goodwill, and free riding should only be considered if consumer confusion is insufficient to prevent secondary use harm. The second step should be a conjoint reading of the two models, where goodwill and reputation is considered in conjunction with the confusion paradigm. Lastly, there will be instances, such as dilution, where consumer confusion cannot prevent the resulting harm from the secondary use. These situations should be exceptions warranting a total abandonment of

⁵⁰ Lemley and McKenna (n 46) 187.

⁵¹ Lunney (n 37) 486. "*In this light, property-based trademark goes too far toward prohibiting imitation as imitation, rather than limiting itself to imitation as material deception.*"

⁵² Prof. Resai identifies a brand theoretical approach to trademark law which attempts to reconcile the information transmission model with the two-way transmission model created by use of brands in marketing and advertising. Desai (n 49).

⁵³ Bone (n 37) 549.

⁵⁴ See for example: *Ramdev Food Products Pvt Ltd v Arvindbhai Rambhai Patel and others* (2006) 8 SCC 726. The Court opined that a loss to the goodwill and reputation of the mark would be sufficient to prove irreparable harm. Irreparable harm is a necessary ingredient for a temporary injunction in a trademark litigation. Thus, the court indirectly conflated goodwill protection with consumer protection. See, *Australian Gold Inc. v Hatfield* (2006) 436 Federal Reporter Third Series 1228 (United States Court of Appeals for the Tenth Circuit).

⁵⁵ Stacey L Dogan and Mark A Lemley, 'Grounding Trademark Law Through Trademark Use' (2007) 92 Iowa Law Review 1669, 1682–1683. The inquiry of 'trademark use' turns on many of the same factors as the likelihood-of-confusion analysis.

the consumer confusion requirement. As the court progresses from the first to the third step, it should increase its scrutiny of the harm caused by a secondary use and its reluctance to provide protection. The analysis of these suggestions run across the expanse of this paper. The authors will further examine the statutory language considering the three-step model in Part III and IV of the paper.

However, the model suggested by the authors does not explain the meaning of harm within trademark law. Without a conception of harm and without an understanding when each of the three steps assume significance, the viability of the suggested model would be questioned. To understand the meaning of harm within the remit of the trademark doctrine, the authors turn to the jurisprudence of the European Union and discuss the functions doctrine.

B. The Functions theory of trademark protection

The diversion from the core of the trademark doctrine and its foray into misappropriation protection has been a subject of concern for judges, scholars, and practitioners alike. Stakeholders have proposed a plethora of measures to rebalance the *trademark formula* and reconcile the expanding trademark uses with the principles of free competition and expression.⁵⁶ Unlike the American judiciary, where misappropriation-based concerns are not readily accepted,⁵⁷ the *European doctrine has traditionally been congenial to the anti-misappropriation impulse*.⁵⁸ In a long line of arguably overbroad protection to trademarks,⁵⁹ the European Court of Justice (‘E.C.J.’) in the latter part of the twentieth century started developing a *functions theory*.

The primary argument of the functions doctrine suggests that, given the configurations of the modern marketplace, the role performed by trademarks cannot be circumscribed by their core function of signalling origin and source.⁶⁰ Unlike other intellectual property rights,

⁵⁶ For example, *see*, Barnes (n 43); Desai (n 49).

⁵⁷ Jeremy N Sheff, 'Misappropriation-Based Trademark Liability in Comparative Perspective' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020) 452, 456.

⁵⁸ *ibid* 453, 454; Dev S Gangjee, 'Property in brands: The commodification of conversation' in Helena Howe (ed) *Concepts of Property in Intellectual Property Law* (Cambridge University Press 2013) 29, noting that the EU is the “most generous trademark regime.”; *L’Oréal v Bellure* [2010] EWCA Civ 535: “the EU has a more ‘protective’ approach to trademark law than other major trading areas and blocs.”

⁵⁹ *See*, generally, Rasmus Dalgaard Laustsen, *The Average Consumer in Confusion-based Disputes in European Trademark Law and Similar Fictions* (Springer Cham 2019) 9–20.

⁶⁰ Annette Kur, 'Trademark Functions in European Union Law' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020) 162–177.

trademark *protection is not related to what trademarks are, but what they do.*⁶¹ For trademarks, the protection is limited to the functions they perform in the marketplace.⁶² Trademarks develop brand characteristics through advertising, marketing, and prolonged use.⁶³ These characteristics then *form the basis of consumer communities, inspire tribal loyalties and are framed in the language of relationships rather than transactions.*⁶⁴ Therefore, it is safe to suggest that *although essential, indication of commercial origin is by no means the sole function that trademarks perform in modern-day economies.*⁶⁵

The observation by the ECJ, stands to reason as these acquired brand characteristics associated with a trademark also deserve protection. After a long line of decisions, where the ECJ implicitly recognised the expanded functions served by a trademark,⁶⁶ it was only in 2009 that the ECJ identified four additional trademark functions: *quality, advertising, investment, and communication.*⁶⁷ However, the court did not provide adequate guidance on the interpretation, scope, and difference between these functions. Even at the time of writing this paper, the delimitation of functions remains substantially obscure.⁶⁸

The functions theory was developed to suppress the protection offered to trademark owners by Article 5(1)(a) and 10(1)(a) of the European Trademark Directive.⁶⁹ Also referred to as *double identity provisions*, these provisions protect against a secondary use⁷⁰ of identical marks on identical goods and services. In cases of double identity, the statute assumes a likelihood of confusion,⁷¹ providing *absolute* protection to trademark owners.⁷² To reign in the *absolute protection*, the ECJ held that unless a secondary user can demonstrate an adverse

⁶¹ *ibid* 162; Séverine Dusollier, 'Building Coherence in Technological Transitions: Putting Exploitation at the Core of IP' in Ansgar Ohly et al (eds), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press 2021) 284–293, 290–291.

⁶² Kur (n 60) 162, 163.

⁶³ Jurgita Randakevičiūtė-Alpman, 'The Role of Trademarks on Online Retail Platforms: An EU Trademark Law Perspective' (2021) 70 GRUR International 633–643.

⁶⁴ Gangjee (n 58) 38–39.

⁶⁵ Alvaro Fernandez-Mora, 'Trademark Functions in Business Practice: Mapping the Law Through the Search for Economic Content' (2021) 52 International Review of Intellectual Property and Competition Law 1370, 1374.

⁶⁶ *See*, Case C-206/01 *Arsenal Football Club Plc v Reed* [2002] 120(5) RPC 144 (European Court of Justice); Case C-48/05 *Adam Opel AG v Autec AG* [2007] ETMR 33 (European Court of Justice).

⁶⁷ *L'Oréal v Bellure* (n 58); *See*, Mats Björkenfeldt, 'The genie is out of the bottle: the ECJ's decision in L'Oréal v Bellure' (2010) 5 Journal of Intellectual Property Law and Practice 105–110.

⁶⁸ *See*, Fernandez-Mora (n 65) 1381–1401.

⁶⁹ EU Directive 2015/2436 of 23rd December 2015; *ibid* 1374–1380; Charles Gielen, 'Trademark Dilution in the European Union' in Daniel R Bereskin (ed), *International Trademark Dilution* (Thomson Reuters Westlaw 2013) 229–231.

⁷⁰ The term 'secondary use' for the present study denotes the possible use by the alleged infringer or any use that the plaintiff can potentially indict as being infringement.

⁷¹ Kur (n 60) 164–167.

⁷² Annette Kur, 'Trademarks function, don't they? CJEU jurisprudence and unfair competition principles' (2014) 45 International Review of Intellectual Property and Competition Law 434, 442.

effect on the four additional functions of the mark, the secondary user cannot be held liable.⁷³ However, without providing any guidance on the import of the four additional functions, the ECJ subjected the double identity provision to a showing of an adverse effect upon the expanded functions.⁷⁴

Within the remit of its expanded functions doctrine, the ECJ confirmed that the *prestige* associated with *luxury brands* cannot be appropriated by *downmarket imitations*.⁷⁵ With the ‘functions formulation’, EU’s trademark jurisprudence increased its reliance on protecting against unfair competition, while reducing the relevance of consumer confusion in the infringement analysis.⁷⁶

The merit of the functions doctrine as pointed out by Prof. Dusollier, resides in the caveat that any liability within trademark law should show an adverse effect on the functions of the trademark. The requirement of an adverse effect for establishing any liability, therefore, creates a direct correlation between the scope of protection and the very objective of trademark protection.⁷⁷ If applied reasonably, it can insulate trademark law from mere property-based misappropriation protection to a *purpose bound property right that only confers its owner a right to control the exploitation of the right, defined as what the grant of the right aims at*.⁷⁸ Further, the functions doctrine also provides for a contextual inquiry of trademark liability.⁷⁹ The mandatory requirement of finding an *adverse effect* or *market harm* requires a court to consider the compounding market realities.⁸⁰

In the next part, the authors examine infringement liability within the Indian Trademarks Act, 1999, in an attempt recalibrate and identify the misappropriation-based protection impulse, and identify the trademark functions sought to be protected by each individual cause of action.

⁷³ D Ribbons, 'What's the difference between Article 5(1)(a) and 5(1)(b)? Not a lot...' (2011) 6 Journal of Intellectual Property Law and Practice 435, 436.

⁷⁴ Andrew Bailey, 'Trademark Functions and Protection for Marks With A Reputation' (2013) 8 Journal of Intellectual Property Law and Practice 868, 871.

⁷⁵ *L'Oréal v Bellure* (n 58).

⁷⁶ See, Sheff (n 57) 453–456: “EU authorities have responded by minimizing the relevance of confusion in such cases.”

⁷⁷ Dusollier (n 61) 290.

⁷⁸ *ibid*.

⁷⁹ Porangaba Luis H, 'A contextual account of trademark functions theory' (2018) 3 Intellectual Property Quarterly 230.

⁸⁰ For example, in the case of *Adam Opel AG v Autec AG* (n 66), the court accommodated the realities of the German scale toys manufacturing industry in order to protect the defendants from infringement liability. Luis H (n 79) 231-234.

III. UNDERSTANDING THE INDIAN TRADEMARK LANDSCAPE

Having analysed the doctrinal debates surrounding trademark protection and its growth in line with commercial expectations, the authors now examine the Indian Trademarks Act, 1999 (**'Act of 1999'**). The Indian trademark jurisprudence also accepts that the primary purpose of a trademark is to indicate the source of the goods or services which bear the subject mark.⁸¹ The capacity to distinguish one person's goods and services from others is a necessary element in the very definition of a trademark within the Act of 1999.⁸²

The Act of 1999 replaced The Trade and Merchandise Marks Act, 1958. In doing so, the new enactment marked a radical shift from its predecessor. The statute introduced protections against dissimilar goods, unfair advantage and free-riding. It also introduced a species of infringement actions independent of any likelihood of confusion.⁸³ With the new protection paradigms offered, the Act of 1999 was arguably a movement towards the *modern trademark doctrine*, where misappropriation is protected alongside the concerns based in information transmission. This section illustrates the different infringement actions fostered by the Act of 1999.

Section 29 of the Act of 1999 deals with the different situations where secondary use would amount to infringement of a registered trademark.⁸⁴ Section 29(1) is a general proposition of the law, while subsections (2) through (9) deal with specialised situations in which a trademark is infringed.⁸⁵

Section 29(1) allows a plaintiff to proceed against the use of a mark that is (1) identical to or is deceptively similar to a mark used by a registered proprietor;⁸⁶ (2) the secondary use is in the course of trade,⁸⁷ and, (3) in reference to goods and services of the plaintiff's registered

⁸¹ *Gaurav Polymers v Delight Chemicals Private Limited* (2020) SCC OnLine AP 1484 22–24 (Andhra Pradesh High Court). (**'Gaurav Polymers'**)

⁸² Trademarks Act 1999, s 2(1)(zb).

⁸³ *Roshan Lal Oil Mills Ltd v Assam Company Ltd* (1996) 16 PTC 699 (Delhi High Court). In reference to the Trade and Merchandise Marks Act 1958, the Delhi High Court held that there cannot be a monopoly in the use of trademark in respect of goods falling in different classes. Preeti Mehta, 'The Trademarks Act, 1999-India Conforms to TRIPS' (2004) 2 International Journal of Franchising Law 15, 18; Akhileshwar Pathak, *Changing Context of Trademark Protection In India: A Review Of The Trademarks Act 1999* (2004) 18–21.

⁸⁴ *Cadila Pharmaceuticals Ltd v Sami Khatib of Mumbai* (2011) 3 Bom CR 587 (Bombay High Court).

⁸⁵ K. C Kailasam, *Venkateswaran on Trademarks and Passing-Off* (6th edn, LexisNexis 2015), vol 1 1504.

⁸⁶ Section 2(1)(h) of the Trademarks Act 1999 defines the term 'deceptively similar'; For principles deciding the question of deceptive similarity see: *Macleods Pharmaceuticals v Swissem Healthcare and others* (2019) Commercial IP Suit No 32 of 2011 (Bombay High Court); *SM Dyechem Ltd v Cadbury India Ltd* (2000) 5 SCC 573.

⁸⁷ *Pepsi Co Inc and another v Hindustan Coca Cola and others* (2001) 94 DLT 30 (Delhi High Court): "The right conferred by registration is a right to use the mark in the course of trade and obviously this right is increased only when the infringer also uses the mark in course of trade."

trademark. (4) Further, the secondary use should be likely to be taken as being used as a trademark.⁸⁸ While other provisions in Section 29 require the use of an *identical* or *similar* mark, Section 29(1) clubs the *identical* requirement with the higher qualification of *deceptive similarity*. This requirement falls closer to identical use than similar use as is applied in different subsections.⁸⁹

In comparison to Section 29(1), Section 29(2) is broader in its approach.⁹⁰ Along with an explicit likelihood of confusion requirement, Section 29(2)(a)-(c) provide three situations where a secondary use would be actionable:

1. Use of an identical mark in reference to similar goods and services.
2. Use of a similar mark in reference to identical or similar goods and services.
3. Use of an identical mark in reference to identical goods and services. When both the mark, and the goods/services in reference to which the mark is applied are identical, the statute, through Section 29(3), assumes likelihood of confusion.⁹¹

The above three uses should be in the course of trade and should be either likely to confuse the relevant part of the public, or likely to have an association with the registered trademark.⁹² In the case of *Canon Kabushiki Kaisha*, the European Court of Justice explained that a likelihood of confusion may arise in one of three circumstances:

“1) where the public confuses the sign and the mark in question (likelihood of direct confusion); (2) where the public makes a connection between the proprietors of the sign and those of the mark and confuses them (likelihood of indirect confusion or association); (3) where the public considers the sign to be similar to the mark and perception of the sign calls to the mind

⁸⁸ *Mother Care v Penguin Books* [1998] RPC 113 (EWCA); *Wockhardt Ltd v Aristo Pharmaceuticals* (1999) 19 PTC 540 (Madras High Court): “*It stands to reason that a Trademark Act would only be concerned to restrict the use of a mark as a trademark or in a trademark sense, and should be construed accordingly.*”

⁸⁹ *Balkrishna Hatcheries v Nandos International* (2007) 35 PTC 295 (Bombay High Court); *Marico Limited v Pratik Goyal* (2014) 60 PTC 185 (Delhi High Court).

⁹⁰ While the point of comparison in Section 29(1) is limited, (i.e., the two marks should be identical or deceptively similar in respect of the goods or services for which the trademark is registered) this point of comparison is comparatively broader within Section 29(2), where any of the three conditions can be fulfilled to assume liability. Similarly, the effect that the latter protects is also comparatively broader (such a manner as to render the use of the mark likely to be taken as being used as a trademark likely to cause confusion in the minds of the public or likely to have an association with the registered trademark.)

⁹¹ Trademarks Act 1999, s 29(3).

⁹² Dev Gangjee, 'Lots in a Name: Would “Diluted” marks still sell as sweetly?' (2003) 15 Student Bar Review 5, 11, 12.

the memory of the mark, although the two are not confused (likelihood of confusion in the strict sense).”

This conceptualisation of the confusion requirement has also been confirmed in India by the Delhi High Court⁹³ and the Supreme Court.⁹⁴

Section 29(4) is not cut from the same cloth as the remainder of Section 29,⁹⁵ in the sense that the provision applies in reference to application of the mark in reference to dissimilar goods.⁹⁶ It embodies the Indian trademark law’s protection against *dilution of a registered mark*.⁹⁷ The provision imposes liability where an identical or a similar trademark is *used in the course of trade* in reference to dissimilar goods and services. Such secondary use of the registered mark should take unfair advantage of or be detrimental to the distinctive character or reputation of the mark.⁹⁸ The provision incorporates two statutory limitations to its general rule: 1) it only protects *marks with reputation*,⁹⁹ 2) secondary use should be *without due cause*.

Section 29(5) provides that a third party cannot adopt a registered trademark as a trade name while dealing with goods or services in reference to which the registered trademark is applied. A *no-fault* provision,¹⁰⁰ Section 29(5) does not require a showing of likelihood of confusion, unfair advantage, or detriment to the distinctive character of the registered mark.¹⁰¹ As long as the secondary use of the registered trademark is used as a part of the trade name and is used in reference to identical goods and services as the registered trademark, liability is

⁹³ *ITC Limited v Philip Morris Products SA and others* (2010) Indlaw DEL 643 (Delhi High Court).

⁹⁴ *Ramdev Food Products Pvt Ltd v Arvindbhai Rambhai Patel and others* (n 54).

⁹⁵ *RPG Enterprises Ltd v Riju Ghoshal and others* (2022) SCC OnLine Bom 626 39–43 (Bombay High Court); *Ford Motor Company v CR Borman* (2009) 38 PTC 76 (Delhi High Court): “*This also indicates that the Parliament intended Section 29(4) as a pandect or fasciculus operating on its own; that it is an important exception to the other provisions of the Act.*”

⁹⁶ *Bloomberg Finance LP v Prafull Saklecha and others* (2014) 207 DLT 35, 37 (Delhi High Court): “*Section 29(4) is also distinct from Section 29(1) to (3) of the TM Act is another important aspect. The element of having to demonstrate the likelihood of confusion is absent.*”

⁹⁷ Gaurav Mukherjee and Srishti Kalro, 'What Is the Confusion over Dilution: Towards a Meaningful Understanding of Section 29(4) of the Trademarks Act, 1999' (2011) 4 Indian Journal of Intellectual Property Law 139, 141–142.

⁹⁸ Renuka Medury, 'Trademark dilution before and after Section 29(4) of the Indian Trademarks Act' in Kung-Chung Liu (ed), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019) 242; *Bennett Coleman and Company Ltd and another. v Sol Lifestyle Pvt Ltd* (2016) SCC OnLine Bom 6946 (Bombay High Court). The import of these provisions is further discussed in part IV, C of the present study.

⁹⁹ *Ford Motor Company v CR Borman* (n 95): “*What should not be lost sight of is the fact that section 29(4) is palpably an exception to the scheme of the Act and applies only to those trademarks which have earned a reputation in India.*” For the difference between 'well-known marks' and 'marks with reputation', see: *Ashok Leyland v Blue Hill Logistic Pvt. Ltd* (2011) 46 PTC 35 (Madras High Court); Gangjee (n 92) 12–14.

¹⁰⁰ *Bloomberg Finance LP v Prafull Saklecha and others* (n 96).

¹⁰¹ *Cisco Technology Inc v Santosh Tantia* (2014) 59 PTC 356 (Delhi High Court).

established.¹⁰² Section 29(6) is illustrative in nature and identifies certain actionable uses of a registered trademark.¹⁰³ The provision is fairly broad in character¹⁰⁴ and injuncts the use of the registered mark on packaging of goods, in marketing or stocking, importing or exporting, and even secondary use on business papers and advertising.¹⁰⁵

Section 29(7) provides that if a person applies a registered trademark knowing that the application of such a mark was not authorised by the mark holder, it will amount to infringement.¹⁰⁶ Section 29(8) protects the use of a registered trademark during advertising. If an advertisement takes unfair advantage and is a dishonest commercial or industrial practice or is detrimental to the distinctive character or reputation of the mark, infringement is established.¹⁰⁷ As far as the requirements set out in Section 29(8) are fulfilled *it would make no difference at all whether the goods are similar or dissimilar*.¹⁰⁸ The statutory language employed by Section 29(8) is identical to the language employed in Section 29(4). Both sections protect against unfair advantage and detriment to distinctive character and repute. However, the statutory limitations which form a part of Section 29(4) i.e., reputation and due cause requirement, are absent from Section 29(8).¹⁰⁹ Given the lack of the statutory limitations, the protection offered by Section 29(8) is arguably broader than Section 29(4).

Finally, Section 29(9) provides that where the distinctive element of a registered trademark consists of or includes words, infringement can be established by the spoken use or visual representation of the trademark.¹¹⁰ For accrual of any liability under Section 29(9), the

¹⁰² *Cipla Ltd v Cipla Industries Pvt Ltd* (2017) AIR 2017 Bom 75 [25]–[28]; *Bloomberg Finance LP v Prafull Saklecha and others* (n 96) [39]; *Mankind Pharma Ltd v Chandra Mani Tiwari* (2018) 75 PTC 8 (Delhi High Court) (the Court held that the use of a trade name deceptively similar to a registered trademark does not constitute trademark infringement, as Section 29(5) only applies to the use of a trade name identical to a registered trademark); Karan Trehan, 'Delhi High Court rules that the use of a trade name similar or deceptively similar to a registered trademark does not amount to infringement under the Indian Law' (2018) 13 Journal of Intellectual Property Law and Practice 771.

¹⁰³ *Crompton Greaves Ltd v Salzer Electronics Ltd* (2011) 46 PTC 450 (Madras High Court): “*Interestingly, the whole of Section 29 deals with infringement and sub-s. (6) of Section 29 gives an indication of what constitutes use of a registered trademark, for the purposes of Section 29 viz. infringement*”; see, *Tilaknagar Industries Ltd v Deejay Distilleries Pvt Ltd* (2009) SCC OnLine Bom 1449 (Bombay High Court).

¹⁰⁴ Kailasam (n 85).

¹⁰⁵ Trademarks Act 1999, s 29(6).

¹⁰⁶ The provision should be read in conjunction with section 101 of the Trademarks Act, 1999, which defines what would it mean to apply trademarks and trade descriptions.

¹⁰⁷ *Cipla Ltd v Cipla Industries Pvt Ltd* (2016) 67 PTC 509 (Bombay High Court).

¹⁰⁸ *ibid*.

¹⁰⁹ *Raymond Limited v Raymond Pharmaceutical Pvt Ltd* (2016) SCC OnLine Bom 5159: “*Section 29(4) of the Act requires all three sub-clauses to be satisfied unlike Section 29(8).*”

¹¹⁰ *Renaissance Hotel Holdings v B Vijaya Sai and others* (2022) Civil Appeal No. 404 of 2022 (Supreme Court of India); *Vardhman Buildtech v Vardhman Properties* (2016) 233 DLT (DB) 25 (Delhi High Court) [10]. The Court opined that Section 29(9), Trademarks Act 1999 applies only to the distinctive characters of the registered trademark. Individual and non-distinctive elements of a trademark are not protected within Section 29(9).

secondary use should “*either cause infringement by making a mis-statement or causing confusion and deception, or in the alternative, the said spoken words should cause infringement by diluting the distinctive character and repute which may either be intentional or unintentional.*”¹¹¹

The findings of the above discussion have been summarised in the following table:

Section	Activity	Point of comparison (mark)	Point of comparison (goods and services)	Effect
29(1)	Use in the course of trade	Identical/ deceptively similar mark	Identical goods or services	Use in a manner as to render the mark likely to be taken as being used as a trademark
29(2)	Use in the course of trade	Identical/similar mark	Identical/similar goods or services	Use in a manner likely to cause confusion on the part of public or likely to have an association with the registered trademark ¹¹²
29(4)	Use in the course of trade	Identical/similar mark	Dissimilar goods or services	Takes unfair advantage OR detrimental to reputation OR accrues unfair advantage

¹¹¹ *Hamdard National Foundation v Hussain Dalal* (2013) DLT 291, 13–17 (Delhi High Court).

¹¹² To the exception of Section 29(2)(c), where likelihood of confusion/association is assumed by reference to Trademarks Act 1999, s 29(3).

29(5)	Use as part of trade name	Identical mark	Identical goods or services	NA ¹¹³
29(8)	Use in the course of advertising	NA	NA	Takes unfair advantage OR detrimental to reputation OR accrues unfair advantage
29(9)	Use of those words or their visual representation	Secondary use should incorporate distinctive elements of a trademark	NA	Any of the effects elaborated in Section 29 ¹¹⁴

In summary, Section 29 can be abstracted into four sets of protections based on the actionable use requirement.¹¹⁵

1. Subsections 1 through 4 protect *use in the course of trade*,
2. Subsections 5 through 7 enlist the specific use cases where a secondary use would amount to infringement.
3. Subsection 8 is concerned with the advertising of a mark, while;
4. Subsection 9 restricts the visual and spoken use of a trademark.

Authors in the present study are concerned with studying the first of these four protection paradigms, i.e., the *use in the course of trade*.

The next part examines Section 29(1), (2) & (4) of the Act of 1999, the only three subsections which include an explicit actionable use requirement. The authors now analyse

¹¹³ As explained, this is a no-fault provision where an effect is not required by the statutory language.

¹¹⁴ As has been declared by the court in *Hamdard National Foundation v Hussain Dalal* (n 111).

¹¹⁵ *Consim Info Pvt Ltd v Google India Pvt Ltd* (2011) 45 PTC 575 (Madras High Court).

how a secondary use becomes actionable within the three provisions in line with their statutory language and doctrinal expectations.

IV. TRADEMARK PROTECTION SPECTRUM

The last part identified the various kinds of infringement actions protected within the remit of the Indian trademark law. From general infringement, to dilution, to infringement in advertising and through spoken words, Section 29 prohibits a broad range of secondary uses. However, despite its overarching swathe, Section 29 does not allow a mark holder to exercise absolute control over the secondary use of her trademark.¹¹⁶ Multiple statutory safeguards and limitations have been baked into the trademark statute which control the expanse of a trademark holder's monopoly.¹¹⁷

One limiting factor that determines the expanse of the infringement liability is the *actionable use* requirement. Infringement liability within trademark law is triggered only when the defendant uses a registered mark “*to brand or advertise the defendant's services or to suggest an affiliation with the plaintiff— so called “trademark use”... Individuals or companies may make reference to, or use of, a trademark without fear of liability unless they are making trademark use.*”¹¹⁸ The actionable use or the trademark use requirement is a form of legal formalism which suggests that some categories of secondary use should be immunised from liability.¹¹⁹

Every individual infringement action in Section 29 includes some requirement of actionable use.¹²⁰ The Delhi High Court in *Consim Info* held that Section 29 “*brings within its fold (i) the use of the mark, (ii) the application of the mark and (iii) the advertisement of the mark.*”¹²¹ The requirement of actionable use is a ubiquitous element of trademark law and

¹¹⁶ *Rxworks Ltd v Hunter* [2007] EWHC 3061 (Ch). A registered mark was a marketing instrument, not a platform for an absolute monopoly in its use; *R v Johnstone* [2003] UKHL 28; Dima Basma, 'Trademark protection versus freedom of expression: towards an expressive use defence in European Trademark Law' (2021) *Intellectual Property Quarterly* 206, 213.

¹¹⁷ For example, see: Trademarks Act 1999, s 30.

¹¹⁸ Stacey L Dogan and Mark A Lemley 'Trademarks and Consumer Search Costs on the Internet' (2004) 41 *Houston Law Review* 777–838, 804–806.

¹¹⁹ Luis H (n 79) 234. The association with formalism is also one of the major critiques associated with the trademark use requirement. For further criticism see, Mark Janis and Graeme Dinwoodie, 'Confusion Over Use: Contextualism in Trademark Law' (2007) 92 *Iowa Law Review* 1597, 1632–1638.

¹²⁰ Every secondary use is not actionable. Only when the secondary use complies with the requirements of the statute does it become actionable. For example, if the secondary user uses a registered trademark in a nominative non-commercial sense, it would, in all probability, not be actionable as it fails to fulfil the *use in the course of trade* requirement.

¹²¹ *Consim Info Pvt Ltd v Google India Pvt Ltd* (n 115) 164.

appears in different iterations in every trademark statute:¹²² “*using in the course of trade*,”¹²³ “*used in association with wares*,”¹²⁴ “*use in commerce*,”¹²⁵ “*commercial use in commerce*”.¹²⁶ The ability of the actionable use requirement to limit the trademark liability and expansionism has witnessed considerable debate and disagreements; with some scholars classifying this debate as a ‘hot button issue’.¹²⁷ As Prof. Simon and Philips note, “*there is no significant aspect of trademark law that does not require the concept of use. There is however no single cogent and authoritative definition of use.*”¹²⁸

A. An Argument for Limitation: Section 29(1)

The statutory mandate of Section 29(1) is unique. To establish liability under this provision, the plaintiff does not need to establish consumer confusion.¹²⁹ The lack of a consumer confusion requirement brings Section 29(1) in close correlation with EU’s double identity provisions, where similar to Section 29(1), a showing of likelihood of confusion is not *sine qua non* for a finding of infringement.¹³⁰

As long as the secondary use is *in the course of trade* and *is likely to be taken as a trademark*, it would be actionable within Section 29(1). This part attempts to sensitise the actionable use analysis within Section 29(1) with the doctrinal expectations that the provision seeks to fulfil. In other words, the authors attempt to identify the paradigm case for the application of Section 29(1) by educating the actionable use analysis with the normative justifications and doctrinal expectations of the provision. In doing so, either of two approaches can be taken:¹³¹ First, the European approach, where the double identity provision protects

¹²² Dreyfuss Cooper (n 14) 268, 269.

¹²³ India: Trademarks Act 1999, s 29(1), (2), (4); Australia: Trademarks Act 1995, s 120, *see, Angela Christou v Tonch Pty Ltd* [2008] ATMO 24 (The Registrar of Trademarks, Australia); United Kingdom: Trademarks Act 1994, s 10, *see, Po Yap Jen, 'Making Sense of Trademark Use'* (2007) 29 *European Intellectual Property Review* 420.; New Zealand: Trademarks Act 2002; Singapore: Trademarks Act 1998, s 27; European Union: Directive EU 2015/2436, art 10.

¹²⁴ Canada Trade-marks Act, R.S.C., c. T-13 § 4.

¹²⁵ 15 U.S.C. § 1114(1).

¹²⁶ 15 U.S.C. § 1125(c)(1).

¹²⁷ Dogan and Lemley (n 55) 1670; Also *see, Vicki T Huang, 'Empirical Analysis of Australian Trademark Infringement Decisions: Implications for the US Trademark Use Debate'* (2018) 35 *Santa Clara High Technology Law Journal* 1, 4–7; McKenna (n 47) 1887–1893.

¹²⁸ Jeremy Phillips and Ilanah Simon (eds), *Trademark Use, 1.05* (Oxford University Press 2005); Huang (n 127) 13–16.

¹²⁹ *Elofic Industries Ltd and others v Mobis India Ltd and others* (2019) 77 PTC (Del) 128 (Delhi High Court) [34]; Kailasam (n 31) 1503–1504.

¹³⁰ Directive (EU) 2015/2436, art 10(2)(a); While a closer comparison to the double identity provision would be Section 29(2)(c) r/w Section 29(3), even Section 29(1) provides a similar protection in the sense that neither the European provision and nor Section 29(1) require a showing of likelihood of confusion for ensuring liability.

¹³¹ Loy Wee Loon Ng, 'The Conundrum of “Trademark Use”': *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2010] 1 SLR 382' (2011) 23 *Singapore Academy of Law Journal* 640–652.

trademarks beyond their source or origin identifying capabilities.¹³² Second, the Singaporean approach,¹³³ where the concomitant provision of Section 29(1),¹³⁴ limits the scope of actionable use to the origin/source identifying function of a trademark.¹³⁵

The European trademark jurisprudence has *traditionally been more congenial to the anti-misappropriation impulse*.¹³⁶ This congeniality is also reflected in EU's flagship formulation for limiting trademark monopoly—the functions doctrine.¹³⁷ Initially developed to suppress the *absolute* protection offered within the double identity provisions,¹³⁸ the functions doctrine has ended up expanding the protection available within the double identity provision to the brand characteristics of a mark.¹³⁹ The foundations of this extension can be traced back to 2003, where the ECJ in *Arsenal v. Reed* ('*Arsenal*') indicated that the protection offered within the double identity provisions extends beyond the origin identifying function of trademarks.¹⁴⁰ Critics cautioned that such an extension could cede to the trademark owner the entire range of functions, potentially allowing her to bulldoze every secondary use of a trademark.¹⁴¹ In the wake of this criticism, the attempts at expansion were substantially thwarted in *R v. Johnstone*¹⁴² and *Opel v. Autec*.¹⁴³ In both the decisions, the House of Lords and the European Court of Justice respectively highlighted the overarching relevance of finding *confusion as to the source* for establishing liability within the double identity provision.¹⁴⁴

¹³² For this section the analysis is limited to Directive (EU) 2015/2436, arts 5(1)(a) and 10(1)(a).

¹³³ The authors refer to the second approach as Singaporean for ease of reference. Other countries and judicial institutions have also sided with similar justifications. The case of Australia, for example is discussed in this part.

¹³⁴ Similar to Section 29(1), Section 27(1) of Singapore's Trademarks Act 1998 impugns liability upon secondary use without a requirement of likelihood of confusion. However, unlike the Singaporean law, where both the mark and the goods it has been applied to should be identical, the Indian Law also allows for an infringement by use of similar marks over similar goods. However, this should not affect the trademark functions that the two sections seek to protect.

¹³⁵ Ng (n 131).

¹³⁶ Sheff (n 57) 453, 454.

¹³⁷ Norma Dawson, 'Non-Trademark Use' (2012) Intellectual Property Quarterly 204, 223.

¹³⁸ Directive (EU) 2015/2436; Fernandez-Mora (n 65) 1374–1380; Gielen (n 69) 229–231.

¹³⁹ Dawson (n 137) 223.

¹⁴⁰ *Arsenal Football Club Plc v Reed* (n 66); Also see: *Flynn Pharam v Drugrus Ltd and Anr* [2017] Bus LR 1874; Alice Blythe, 'A useful test for trademark use: an analysis of current CJEU guidance and the difference between defining use online and offline' (2016) 38 European Intellectual Property Review 563, 564, 656.

¹⁴¹ Jennifer Davis, 'To Protect or Serve? European Trademark Law and the Decline of the Public Interest' (2003) European Intellectual Property Review 180, 187; Dawson (n 137) 214–218.

¹⁴² *R v Johnstone* (n 116); *Arsenal Football Club Plc v Reed* [2003] EWCA Civ 696. Even after the ECJ's judgement in *Arsenal v Reed*, the Court of Appeal relied on a finding of consumer confusion for the grant of an injunction.

¹⁴³ *Adam Opel AG v Autec AG* (n 66); Kur (n 72) 435; Luis H (n 79) 232: "Adam Opel is known for shaping the functions theory as a limiting doctrine."

¹⁴⁴ Dawson (n 137) 222; Noam Shemtov, 'Trademark use' in Europe: revisiting Arsenal in the light of Opel and Picasso' (2007) 2 Journal of Intellectual Property Law and Practice 557–563, 563. Reviewing the Opel decision, the authors argued that the interpretation of the House of Lords in *R v Johnstone* was the correct position of the law. See, Blythe (n 140).

However, the critics' arguments did not persuade the courts for a very long time. In 2009, with *L'Oréal v. Bellure* ('*L'Oréal*'), the ECJ explicitly noted that the expanded functions of a trademark can be protected within the double identity provisions.¹⁴⁵ What the ECJ suggested in *Arsenal*, it explicitly admitted in *L'Oréal*: apart from *origin*, any adverse effect on a trademark's *communication, investment, and advertising* function¹⁴⁶ would confirm liability within double identity provisions.¹⁴⁷ The proponents of stronger trademark protection welcomed *L'Oréal*.¹⁴⁸ However, the decision received overwhelming criticism.¹⁴⁹ The critics argument was based on a simple premise: *How can every individual trademark develop brand characteristics?*¹⁵⁰

Brand characteristics are a unique entitlement of a limited number of trademarks. They are acquired through continuous use, marketing, and advertising.¹⁵¹ Therefore, the general forms of infringement should be limited to protecting the origin function.¹⁵² The double identity provision extends protection to every registered trademark. It should not be cited to protect the expanded brand characteristics, where no such characteristics have been developed.¹⁵³ The argument stands to reason, how can the law be curated to protect what does not exist?

The Singaporean judiciary has explicitly aligned with arguments of the critics of the EU approach. Section 27(1) of the Singaporean Trademarks Act, 1998, which is identical to the EU's double identity provision,¹⁵⁴ limits the protection offered therein to the origin function of trademarks.¹⁵⁵ Interpreting the ECJ jurisprudence, the Singaporean judiciary developed this

¹⁴⁵ See, Irina Pak, 'The expansion of trademark rights in Europe' (2013) 3 IP Theory 7.

¹⁴⁶ *L'Oréal v Bellure* (n 58). This position was reiterated and confirmed in Case C-323/09 *Interflora Inc v Marks and Spencer plc* [2011] ECR I-0000.

¹⁴⁷ *L'Oréal v Bellure* (n 58); Dawson (n 137) 223.

¹⁴⁸ See, James Nurton, 'L'Oréal opinion welcomed as positive for brand owners' (2009) 48 *Managing Intellectual Property* 480; Mark Heritage, "'Smells-alike" defeat for truthful comparative advertising' (2010) 15 *Communications Law* 105.

¹⁴⁹ See, Katy Dowell, 'L'Oreal victory deemed anti-competitive' (2010) 24 *Lawyer* 6; MRF Senftleben, 'Function Theory and International Exhaustion: Why it is Wise to Confine the Double Identity Rule in EU Trademark Law to Cases Affecting the Origin Function' (2014) 36 *European Intellectual Property Review* 518; Ilanah Simon Fhima, *Trademark Dilution in Europe and the United States* (Oxford University Press 2011) 247; Max Planck Institute for Intellectual Property and Competition Law, *Study on the Overall Functioning of the European Trademark System* (Publications Office of the European Union 2011) 103; Dev Gangjee and Robert Burrell, 'Because You're Worth It: L'Oréal and the Prohibition on Free Riding' (2010) 73 *The Modern Law Review* 282–295, 291–295.

¹⁵⁰ See, David Tan, 'Differentiating between Brand and Trademark: City Chain v. Louis Vuitton Malletier' (2010) *Singapore Journal of Legal Studies* 202–210.

¹⁵¹ *ibid.*

¹⁵² See, Kur (n 72) 438–441; Senftleben (n 149).

¹⁵³ Tan (n 150) 203.

¹⁵⁴ Directive (EU) 2015/2436, art 10(1)(a).

¹⁵⁵ Ng (131).

view in *Nation Fittings*¹⁵⁶ and affirmed it in *City Chain Stores*.¹⁵⁷ In both these decisions, the court consciously rejected providing any protection to the expanded functions of a trademark within Section 27(1) of the Trademarks Act, 1998.¹⁵⁸ Similarly, the courts in Australia¹⁵⁹ and New Zealand¹⁶⁰ have opined that unless a secondary use is designed to distinguish the products in reference to which it is applied *in the sense of indicating origin*, liability cannot be established within the concomitant provisions of Australian¹⁶¹ and New Zealand Trademark Law.¹⁶²

In the present study, the authors also align with the critics of the EU approach and suggest that the Indian trademark law should side with other common law jurisdictions. Three individual arguments can be relied on to substantiate this position. First, within Section 29(1) no liability can be established unless the secondary use qualifies *as use as a trademark*. To satisfy this condition, the secondary use must distinguish the goods and services of the defendant from other similar options in the marketplace.¹⁶³ Therefore, unless the secondary use designates the origin/ source of the defendants' goods, it should not qualify as a trademark and therefore not be actionable within Section 29(1). Second, to gain protection within Section 29(1), the mark holder does not have to show that his trademark has acquired any brand characteristics. Extending expanded protection without a showing of goodwill or reputation begs the question: *Have non-reputed marks sufficiently developed brand-dimensions susceptible to protection?*¹⁶⁴ Therefore, the protection offered within Section 29(1) should be limited to the core function of a trademark, i.e., designating origin. Lastly, affording extended protection to marks within Section 29(1) neglects the doctrinal thesis of underlying the protection against trademark dilution.¹⁶⁵ Dilution explicitly protects *marks with reputation* and therefore, the protection against dilution is better suited to protect the brand characteristics of a trademark.

B. Statutory Requirement of Likelihood of Confusion: Section 29(2)

¹⁵⁶ *Nation Fittings Sdn Bhd v Oystertec plc* [2005] SGHC 225, [2006] 1 SLR(R) 712.

¹⁵⁷ *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* [2009] SGCA 53.

¹⁵⁸ Tan (n 150) 203–205; Ng (n 131) 643.

¹⁵⁹ Michael Handler, 'Disentangling Functionality, Distinctiveness and use in Australian Trademark Law' (2018) 42 Melbourne University Law Review 55.

¹⁶⁰ Firth (n 25) 183–184.

¹⁶¹ Australian Trademarks Act 1995, s 120.

¹⁶² New Zealand Trademarks Act 2002, s 89.

¹⁶³ *Elofic Industries Ltd. and others v Mobis India Ltd and others* (n 129); *Mahle Filter Systems India Private Limited v Mobis India Limited and another* [2018] Indlaw DEL 4746 (Delhi High Court).

¹⁶⁴ Gangjee and Burrell (n 149) 286.

¹⁶⁵ Senftleben (n 149) 520.

Given that Section 29(1) does not protect the expanded functions and the brand characteristics of a trademark, an obvious question arises: *which subsection of Section 29 can be cited as a repository of the expanded functions doctrine?* In this part, the authors examine if Section 29(2) can be cited to protect the brand characteristics of a trademark.

As explained in Part 2, for establishing liability within Section 29(2) the plaintiff needs to show either a likelihood of confusion on the part of the relevant public, or a likelihood of association with the registered mark.¹⁶⁶ An association is said to occur when the secondary use of a mark acts as a reminder of a registered trademark.¹⁶⁷

Many judicial decisions have dealt with the meaning of confusion,¹⁶⁸ but the concept of association has not received substantial judicial attention. While some Indian decisions have dealt with the meaning of association,¹⁶⁹ the primary judicial opinion which determines the meaning of association is the ECJ's opinion in the case of *Sabel v. Puma*.¹⁷⁰ The ECJ opined that “*the concept of likelihood of association is not an alternative to that of likelihood of confusion but serves to define its scope. The terms of the provision itself exclude its application where there is no likelihood of confusion on the part of the public.*” The ECJ's position in *Sabel v. Puma* has since been ratified by later judicial decisions.¹⁷¹

In line with the ECJ's instruction, it can be argued that the likelihood of association does not operate independently of confusion.¹⁷² Mere reminder of a registered trademark by a secondary use, denoting association, would not be independently actionable.¹⁷³ The inclusion of the association requirement in statutory language serves as a mere reminder that association can be one of the ingredients of confusion.¹⁷⁴ Therefore, the confusion requirement subsumes

¹⁶⁶ An association occurs when the secondary use serves as a reminder of the registered trademark; *See*, Laustsen (n 27) 264–267.

¹⁶⁷ Fields Désirée, 'British Amateur Gymnastics Association vaults to triple victory in trademark infringement and passing off claim against “UK Gymnastics”' (2021) 32 Entertainment Law Review 9; *British Amateur Gymnastics Association v UK Gymnastics Ltd* [2020] EWHC 1678 (Intellectual Property Enterprise Court).

¹⁶⁸ *See*, for example, *Surya Agro Oils Ltd. v Surya Coconut Oil Industries* (1994) AIR 1995 Del 72 (Delhi High Court); *Gaurav Polymers v Delight Chemicals Private Limited* (n 81).

¹⁶⁹ *See*, for example, *Consitex SA v Kamini Jain* [2011] SCC OnLine Del 2947 (Delhi High Court).

¹⁷⁰ Case C-251/95 *Sabel BV v Puma AG, Rudolf Dassler Sport* [1995] ECR I-06191; Many decisions continue to rely on the ECJ opinion. For example, *see*, *AMPM Fashions (P) Ltd v Akash Anil Mehta* 2021 SCC OnLine Del 4945 (Delhi High Court).

¹⁷¹ *Tripadvisor LLC v Handsam Ltd* [2016] EWHC 1659 (Ch); *British Amateur Gymnastics Association v UK Gymnastics Ltd* (n 167).

¹⁷² *AMPM Fashions (P) Ltd v Akash Anil Mehta* (n 170); Paul LC Torremans, 'The likelihood of association of trademarks: an assessment in the light of the recent case law of the Court of Justice' (1998) 3 Intellectual Property Quarterly 295, 304–306.

¹⁷³ *AMPM Fashions (P) Ltd v Akash Anil Mehta* (n 170); *British Amateur Gymnastics Association v UK Gymnastics Ltd* (n 167).

¹⁷⁴ Ilanah Fhima and Dev S Gangjee, *The Confusion Test in European Trademark Law* (1 ed, OUP 2019) 6,7.

the association requirement. However, which functions does the confusion requirement seek to protect?

In order to elaborate on the meaning of confusion in terms of the ‘functions’ doctrine, the authors examine two approaches: the European approach and the American approach. Once the temporal limits of confusion can be understood with reference to the ‘functions’ doctrine, the paper analyses the Indian jurisprudence to evaluate its conformity with the appropriate framework.

Within the European jurisprudence, likelihood of confusion occurs *where the public can be mistaken as to the origin of the goods or services in question*.¹⁷⁵ Prof. Fhima and Gangjee suggest that the confusion requirement seeks to protect against the classic *diversion of trade scenario*, where consumers mistake the junior goods for the goods of the senior user.¹⁷⁶ This position has been ratified by the ECJ in *Daimler v. Egyud Garage*, where the court explicitly admitted that *despite functions other than the origin function, it is only possible to find confusion-based infringement, if use of the junior mark affects or is liable to affect the origin function*.¹⁷⁷ Therefore, unless the origin function is affected, the requirement of confusion cannot be satisfied. A similar position can be traced in Singaporean trademark jurisprudence. Prof. Wee Loon notes that, “*When the defendant’s use is non-origin-related in nature, it would be extremely difficult — if not impossible — to prove existence of confusion*.”¹⁷⁸

Unlike EU and Singapore, American trademark law defines confusion in much broader terms. The Lanham Act defines confusion as “*affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person*.”¹⁷⁹ This definition of confusion fosters infringement liability even in situations where the secondary use does not impact consumer behaviour/ purchasing patterns.¹⁸⁰ Such a protection can create a self-perpetuating crisis: If the law teaches consumers that every sponsorship has to be authorised, they will start to believe that every secondary use, irrespective of its expressive values, has been authorised by the trademark owner.¹⁸¹ This construction can have deleterious effects on trademarks in parodic and satirical settings.

¹⁷⁵ Case C-39/97 *Canon Kabushiki Kaisha v Metro Goldwyn-Mayer Inc* [1999] ECR I-5517.

¹⁷⁶ Fhima and Gangjee (n 174) 5.

¹⁷⁷ Case C-179/15 *Daimler v Együd Garage* [2016]; Laustsen (n 59) 11.

¹⁷⁸ Ng (n 131) 645.

¹⁷⁹ Lanham Act, s 43(a).

¹⁸⁰ Mark A Lemley and Mark McKenna, 'Irrelevant confusion' (2009) 62 *Stanford Law Review* 413, 430.

¹⁸¹ *ibid* 439–445.

Given the criticism accrued by the US approach and the wide acceptance of the ‘confusion as to origin’ approach fostered by the EU and adopted by other common law countries, the authors suggest that a similar interpretation should be retained in Indian trademark law.

The ‘confusion as to origin’ approach has already seen approval within Indian trademark jurisprudence. Many Courts have interpreted the confusion requirement to protect the origin function of trademarks. The opinion in the case of *Gaurav Polymers* is a prime example, where the Court opined that the primary question that needs to be answered in case of trademark infringement is *whether a buyer would get confused between the goods of the defendant and the plaintiff because of the usage of the offending trademark by the defendant*.¹⁸² While many factors including mode of purchasing the goods, the class of consumers are considered while assessing confusion,¹⁸³ the underlying examination always attempts to determine if the average consumer would be confused as to the commercial origin of the goods bearing the competing marks.¹⁸⁴

C. A Storehouse of the Expanded Functions: Section 29(4)

Since confusion only protects the adverse effect to the origin function, Section 29(2) cannot be cited as the repository of the protection afforded to extended functions. The requirement of confusion in the marketplace limits the scope of Section 29(2) to the origin function. Continuing the exploration into the repository of expanded functions, this section explores the doctrinal thesis underlying the protection against dilution and examines if Section 29(4) can be cited to protect the expanded functions of a trademark.

The Trademarks Act, 1999 introduced dilution as a form of infringement.¹⁸⁵ Before 1999, dilution was protected within common law through the protections against passing off.¹⁸⁶ With dilution, any harm to the reputation or the *selling power* of a trademark was also included

¹⁸² *Gaurav Polymers v Delight Chemicals Private Limited* (n 81) [28].

¹⁸³ *Hamdard National Foundation v Sadar Laboratories (P) Ltd* (2022) 1 HCC (Del) 36 (Delhi High Court); *FDC Ltd v Tas Med (India) (P) Ltd* (2021) 4 HCC (Del) 299 (Delhi High Court).

¹⁸⁴ *Surya Agro Oils Ltd v Surya Coconut Oil Industries* (n 168); *RPG Enterprises Ltd v Riju Ghoshal and others* [2022] SCC OnLine Bom 626 (Bombay High Court) [31]; *Rajeshwar Prasad v Prem Mehendi Centre* [2016] SCC OnLine Bom 8984 (Bombay High Court); *MESO (P) Ltd v Liberty Shoes Ltd* [2019] SCC OnLine Bom 1506 (Bombay High Court); *HTC Corporation v LV Degao* (2022) 3 HCC (Del) 80 (Delhi High Court); *Hamdard National Foundation v Sadar Laboratories (P) Ltd* (2022) 1 HCC (Del) 36 (Delhi High Court).

¹⁸⁵ *Medury* (n 98) 240, 241; *ITC Limited v Philip Morris Products SA and others* (n 93) 44; *Kamdhenu Ispat Ltd v Kamdhenu Pickles and Spices Ind Pvt Ltd and Anr* [2010] Indlaw Del 2694 (Delhi High Court).

¹⁸⁶ *Medury* (n 98) 241; Dev Gangjee, 'The Polymorphism of Trademark Dilution in India' (2008) 17 *Transnational Law and Contemporary Problems* 611, 106, 107.

within actionable use.¹⁸⁷ A claimant who sought protection within the dilution framework did not have to prove any consumer confusion.¹⁸⁸

The core of the dilution doctrine can be traced back to a seminal 1927 article by Prof. Schechter, where it was suggested that the primary concern of the trademark doctrine should be protecting the *selling power* of trademarks.¹⁸⁹ Marking a *fundamental shift in the nature of trademark protection*,¹⁹⁰ dilution treats trademarks as property that deserve protection in their own right¹⁹¹ without showing consumer confusion.¹⁹² The protection is geared towards the *substantial investment an owner has made in the mark and the commercial value and aura of the mark itself, protecting both from those who would appropriate the mark for their own gain*.¹⁹³ Prof. Carty notes that the protection offered by dilution is “*completely at odds with the identification and guarantee function of trademarks, from which the common law never swerved.*”¹⁹⁴

Within the function-based formulation of trademark protection offered by the European Union, the law on dilution was (arguably) *intended to protect the functions of mark beyond its source or origin functions*.¹⁹⁵ According to ECJ decisions, the protection offered to trademark dilution secures the investment and advertising functions.¹⁹⁶ These functions are closely correlated.¹⁹⁷ After conducting a detailed enquiry into the extent and scope of the expanded functions Dr Mora notes that there remains some uncertainty regarding how they would map in a dilution case.¹⁹⁸ The investment function is adversely affected when the secondary use “*substantially interferes with the proprietor’s use of the mark to acquire and preserve a*

¹⁸⁷ See, Frank I. Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 Harvard Law Review 813.

¹⁸⁸ *ITC v Philip Morris* (n 93); *Cipla Ltd v Cipla Industries Pvt Ltd* (n 102) [24], “*Thus, for attracting sub-section (4), it is not necessary for the plaintiff to show possibility of confusion.*”; Gangjee (n 184); Pathak (n 83).

¹⁸⁹ Schechter (n 187). Prof. Schechter’s conceptualisation heavily relied on German case law jurisprudence. For details see, Barton Beebe, 'The suppressed misappropriation origins of trademark antidilution law: The Landgericht Elberfeld’s Odol Opinion and Frank Schechter’s “The Rational Basis of Trademark Protection”' in Jane C Ginsburg and Rochelle Cooper Dreyfuss (eds), *Intellectual Property at the Edge: The Contested Contours of IP* (Cambridge University Press 2014) 59.

¹⁹⁰ Lemley (n 32) 1698.

¹⁹¹ Alice Blythe, 'Attempting to define unfair advantage: an evaluation of the current law in light of the recent European decisions' (2012) 34 European Intellectual Property Review 754, 755, 756.

¹⁹² Robert G Bone, 'Schechter’s ideas in historical context and dilution’s rocky road' (2007) 24 Santa Clara Computer and High Technology Law Journal 469, 472–473.

¹⁹³ Clarisa Long, 'Dilution' (2006) 106 Columbia Law Review 1029, 1034, 1035.

¹⁹⁴ Hazel Carty, 'Dilution and passing off: cause for concern' (1996) 112 The Law Quarterly Review 632–666 .

¹⁹⁵ Graeme B Dinwoodie, 'The Function of Trademarks in the United States' in Irene Calboli and Jane C Ginsburg (eds), *The Cambridge Handbook of International and Comparative Trademark Law* (Cambridge University Press 2020) 178–191.

¹⁹⁶ *Interflora v Mark and Spencer’s Plc* (n 146).

¹⁹⁷ Robert Burrell and Michael Handler, 'Reputation in European trademark law: a re-examination' (2016) 17 ERA Forum 85–99, 88.

¹⁹⁸ Fernandez-Mora (n 65) 1379.

reputation capable of attracting customers and retaining their royalty.”¹⁹⁹ Closely related to investment, an adverse effect on the advertising function occurs when the secondary use denies the proprietor the opportunity *of using its mark effectively to inform and win over customers.*²⁰⁰ In *Interflora*, the ECJ opined that while the two functions might overlap, the investment function is broader since it protects various other *commercial techniques* to create and sustain reputation.²⁰¹

While the Indian trademark jurisprudence does not rely on the functions-based formulation, the relationship that dilution shares with the advertising and investment function can be abstracted through judicial discourse. While commenting on the nature of secondary uses protected by each subsection within Section 29, the Bombay High Court in *Raymond v. Raymond* noted that *investments made for developing the reputation of the mark and protecting against its unfair misappropriation of goods* is a primary concern for trademark dilution.²⁰² In 2010, the Delhi High Court held that dilution is geared towards preserving the *uniqueness of the mark itself.*²⁰³ Further in 2020, injunctioning the unauthorised secondary use of the mark ‘BMW’ on electric commercial vehicles, the Delhi High Court held that the dilution doctrine protects against an *unauthorised appropriation of the goodwill and reputation.*²⁰⁴

Therefore, while Indian judicial discourse does not incorporate the terminology of the functions doctrine, judicial decisions admit that the protection within Section 29(4) extends beyond the source identifying function. Having understood that the protection offered within Section 29(4) extends beyond the origin function, this part explores the relationship between Section 29(4) and the misappropriation argument. In line with the three-step model proposed by the authors in Part 1, the further the dilution paradigm moves away from the information transmission argument, the more relevance the statutory limitations, such as due cause, would assume.

Within dilution, three independent causes of action extend protection beyond the origin function: blurring, tarnishment, and unfair advantage. While the recognition of these

¹⁹⁹ Heather Taylor, 'The David-And-Goliath-esque Problematic of "Unfair Advantage" in Trademark Law: Is the EU Moving Towards a Categorical Protection of Famous Brands?' (2021) 52 *International Review of Intellectual Property and Competition Law* 1069, 1076–1079.

²⁰⁰ Fernandez-Mora (n 65) 1388; *Interflora v Mark and Spencer's Plc* (n 146).

²⁰¹ *Interflora v Mark and Spencer's Plc* (n 146) [60]; Gangjee (n 58) 42, 43; Fernandez-Mora (n 65) 1389, 1390.

²⁰² *Raymond Limited v Raymond Pharmaceutical (P) Ltd* (2016) 2017 69 PTC 79 (Bombay High Court).

²⁰³ *ITC v Philip Morris* (n 93).

²⁰⁴ *Bayerische Motoren Werke AG v Om Balajee Automobile (India) Private Limited* [2020] 82 PTC (Del) 194 (Delhi High Court).

independent causes of action remains limited in Indian jurisprudence,²⁰⁵ this tri-partite structure of Section 29(4) has been confirmed by the Delhi High Court in *Bloomberg Finance*:²⁰⁶

*“The words ‘detriment’ in the context of the ‘distinctive character’ of the mark brings in the concept of ‘dilution’ and ‘blurring’. In the context of ‘repute’ they are also relatable to the concept of ‘tarnishment’ and ‘degradation’. The words ‘takes ‘unfair advantage’” refers to ‘free riding’ on the goodwill attached to mark which enjoys a reputation. The disjunctive ‘or’ between the words ‘distinctive character’ and ‘repute’ is designedly inserted to cater to a situation where a mark may not have a distinctive character and yet may have a reputation.”*²⁰⁷

1. What Use Constitutes ‘Blurring’?

The first arm of protection offered within the dilution doctrine, i.e. Section 29(4), is a prohibition against detriment to the distinctive character, also referred to as ‘Dilution by Blurring’.²⁰⁸ This concept is best explained based on the associative network theory.²⁰⁹ Human memory is comprised of nodes, where each node links specific product categories with certain trademarks.²¹⁰ If multiple products bearing the same trademark were presented to a consumer, it would inevitably diminish the immediate association that is evoked by the use of the original trademark.²¹¹ A similar situation can occur when a famous trademark is subjected to expressive uses. Such uses can diminish the *recallability* of a trademark and dilute its association with its parent products.²¹² In simpler terms, a famous mark cannot be applied in reference to other goods, lest it loses its associative power and, by extension, its *selling power*.

²⁰⁵ Gangjee (n 18).

²⁰⁶ *Bloomberg Finance LP v Prafull Saklecha and others* (n 96).

²⁰⁷ Subsequently cited with approval in: *Nokia Corporation v Manas Chandra and Anr* [2017] Indlaw DEL 2936 (Delhi High Court); *Advance Magazine Publishers v Just Lifestyle Pvt Ltd* [2016] SCC OnLine Bom 8417 (Bombay Hgh Court).

²⁰⁸ *Bloomberg Finance LP v Prafull Saklecha and others* (2013) (2014) 207 DLT 35 (Delhi High Court); *Hypnos Limited v Hosur Coir Foam Pvt Ltd* [2015] SCC OnLine IPAB 213 [52] (Intellectual Property Appellate Board).

²⁰⁹ Washington Macías and Julio Cerviño, 'Trademark dilution: comparing the effects of blurring and tarnishment cases over brand equity' (2017) 12 *Management and Marketing* 346, 349–352.

²¹⁰ See: Chris Pullig, Carolyn J Simmons and Richard G Netemeyer, 'Brand dilution: when do new brands hurt existing brands?' (2006) 70 *Journal of Marketing* 52, 54.

²¹¹ Dima Basma, 'Dilution Versus Unfair Advantage: Myths and Realities' (2021) 52 *International Review of Intellectual Property and Competition Law* 1217–1257, 1222; Also see, Case C-253/ 07 *Intel Corporation Inc v CPM United Kingdom Limited* [2008] ECR I-08823; Case C-375/97 *General Motors Corporation v Yplon SA* [1999] ECR I-5421.

²¹² See, *Mattel Inc v MCA Records Inc* (n 3); Wallack (n 11).

Many decisions from the Indian judiciary have sought to protect these associative nodes by ensuring exclusive associations of a mark with a source. Examples are many. For instance, in the case of *Ford Motor Company*, the trademark 'Ford' was used by the defendants in respect to footwear. The Delhi High Court cited Section 29(4) and the loss of distinctiveness of the mark to injunct the use by the defendants.²¹³ In *Krizm Hotels*, the plaintiffs used the mark 'Lemon Tree' in reference to well-known hotel chains. The Delhi High Court injuncted the defendant's use of an identical mark in reference to housing projects.²¹⁴ In another case, the mark 'Ultra Tech' was used in reference to cement. When the defendant started using the mark in reference to solar heaters, the Court injuncted the secondary use.²¹⁵

Therefore, blurring would occur when a viewer of the famous mark is led to either believe that the mark is now associated with a new product or service, or if the association between the famous mark and its owner is diminished/reduced.²¹⁶ The protection against blurring can be reconceptualised as reducing the *search costs* of a consumer by protecting a consumer's associative nodes. Therefore, it can be argued that the protection against blurring considers the concerns of a consumer in the commercial marketplace and arguably confirms with the *information transmission* paradigm.²¹⁷

2. What Use Constitutes 'Tarnishment'?

The second cause of action after 'blurring' is 'tarnishment'. The protection against detriment to reputation is referred to as 'Dilution by Tarnishment'. While the contours of tarnishment are not particularly clear, any association of a registered trademark with unsavoury goods would result in negative associations with the mark and thus damage its reputation.²¹⁸ The principle of tarnishment has been explained in some detail by the Delhi High Court in *Rolex v. Alex Jewellery*. The defendant therein was selling artificial jewellery by applying the 'Rolex' mark. The court held that if the defendant is allowed to continue his operations,

²¹³ *Ford Motor Company v CR Borman* (n 95).

²¹⁴ *Krizm Hotels (P) Ltd v Vaishnavi Estates Pvt Ltd* (2011) SCC OnLine Del 3157 (Delhi High Court).

²¹⁵ *UltraTech Cement Limited v Ultratech Solar Technologies Pvt Ltd* [2018] SCC OnLine Bom 8644 (Bombay High Court); Also see, *Ozone Spa Pvt Ltd v M/S Ozone Club* (2010) CS (OS) No. 1528/2009 (Delhi High Court).

²¹⁶ Ilanah Simon, 'Dilutive trademark applications: trading on reputations or just playing games?' (2004) 26 *European Intellectual Property Review* 67, 71–74.

²¹⁷ See, *Ty Inc v Perryman* (2002) 306 Federal Reporter Third Series 509 (United States Court of Appeals for the Seventh Circuit). The concern motivating blurring "is that consumer search costs will rise if a trademark becomes associated with a variety of unrelated products."

²¹⁸ Patrick Emerson, "'I'm Litigatin' It": Infringement, Dilution, and Parody Under the Lanham Act' (2011) 9 *Northwestern Journal of Technology and Intellectual Property* 477, 482.

*“The goods of the plaintiff may lose their sheen to the strata of the society for which they are intended if such strata find the goods in the same brand name even though not from the house of the plaintiff being available for a much lower price. The goods of the plaintiff would then cease to be a status symbol or a fashion statement. Undoubtedly, the same would be to the detriment of the plaintiff.”*²¹⁹

Therefore, this protection of reputation associated with trademarks is activated to paralyse accrual of any negative associations with a registered trademark.²²⁰

In *Piruz Khambatta*, the plaintiffs were using the mark ‘Rasna’ in reference to soft-drink mixtures, which were primarily targeted towards children. The defendant adopted the mark ‘Pan Rasna’ in reference to tobacco products. Injuncting the secondary use, the Delhi High Court noted that if *“The mark which has already acquired residual goodwill and reputation if used by another party other than real owner, there would be fair chances of danger of tarnishment and dilution.”*²²¹ Similarly, in *Skol Breweries*, the plaintiff was using the mark ‘Knock Out’ in reference to beer. The defendant adopted an identical trademark in reference to pepper sprays. The Delhi High Court agreed that the secondary use can be detrimental to the senior user’s reputation.²²²

Be that as it may, the Indian courts have remained wary of an overbroad application of this protection. The Delhi High Court in *Caterpillar Inc. v. Mehtab Ahmed* noted that protection against tarnishment is only available to *well recognised, strong, and famous marks*. The Court further observed that *“the act of dilution of mark by way of tarnishment is always with regard to well recognised, strong and famous marks, it should have effect to diminish or weaken the strength and identification value of the mark.”*²²³ Further, it has been declared that an identical secondary use would not automatically result in a damaging association(s). A plaintiff would

²¹⁹ *Rolex SA v Alex Jewellery Pvt Ltd* [2009] SCC OnLine Del 753 [24] (Delhi High Court).

²²⁰ *Basma* (n 211) 1232, 1233.

²²¹ *Piruz Khambatta v Soex India Ltd* [2012] (49) PTC 330 (Del) (Delhi High Court).

²²² *Skol Breweries v Unisafe Technologies* [2010] Indlaw DEL 2197 (Delhi High Court). However, the plaintiff could not fulfil the threshold of reputation and therefore the secondary use was not injuncted. .

²²³ *Caterpillar Inc v Mehtab Ahmed and others* [2002] Indlaw DEL 558; *Raymond Limited v Raymond Pharmaceutical (P) Ltd* (n 202). On the other hand, an act of tarnishment would, as the term indicates, result in detrimental reference to the mark when used by the defendant.

have to demonstrate the damaging association(s) for the secondary use to be rendered actionable.²²⁴

Since the protection against tarnishment is aimed at protecting the unsavoury associations, the idea of consumer confusion does not assume prominence. The protection is especially concerned with protecting goodwill and reputation, rather than consumer confusion. Therefore, the protection against tarnishment becomes difficult to reconcile with the information transmission model.

3. What Use Constitutes 'Unfair Advantage'?

Apart from tarnishing and blurring, the protection against unfair advantage can be cited as the statutory injection of the *misappropriation argument* within the Indian trademark law. Marking a complete and absolute departure from the information transmission model, protecting against *unfair advantage* is concerned with a secondary user's unauthorised gains as opposed to any loss of the prior user.²²⁵ Therefore, the protection is *more of a question of dilution of the proprietor's investments into building his brand than the mark per se*.²²⁶

Characterised as a *particular form of unfair competition*,²²⁷ the protection against unfair advantage provides a court with substantial latitude to determine its scope. Any enquiry within this protection should be divided into two parts. First, whether the similarity between the marks triggers a mental association. Second, using multifactor analysis, the court should assess whether the creation of such link is unfair and causes a transfer of reputation and goodwill situated in the earlier mark.²²⁸ This two-part analysis ensures that unless an advantage is demonstrably unfair, it will not be injuncted within the infringement analysis.²²⁹

²²⁴ *Raymond Ltd v Raymond Pharms Ltd* [2007] PTC (Bom) 334 (Bombay High Court).

²²⁵ Case C-253/ 07 *Intel Corporation Inc v CPM United Kingdom Limited* (n 211); Gangjee (n 18) 321.

²²⁶ Taylor (n 197) 1073; Audrey Horton, 'The implications of L'Oreal v. Bellure- A retrospective and a looking forward: the essential functions of a trademark and when is an advantage unfair' (2011) 33 *European Intellectual Property Review* 550, 551, 552.

²²⁷ *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 [80]; *W3 Ltd v Easygroup Ltd and Anr* [2018] EWHC 7 (Ch) [300]; *Sky Plc v Skykick UK Ltd* [2018] EWHC 155 (Ch) [315].

²²⁸ Gangjee (n 58) 46; Taylor (n 199) 1074–1079; Basma (n 211) 1249. However, it is apposite to mention that the ECJ in *L'oreal v. Bellure*, seems to have conflated these two conditions. The protection provided by the ECJ's judgement can be cited to injunct every possible secondary use where some advantage is derived from the prior user's good will and reputation. See, Blythe (n 191).

²²⁹ David Llewelyn, 'Comparative Advertising: Does Trademark Law Over- or Under-Protect the Average Consumer? A Couple of Recent Examples of Asian Jurisdictions Going their Own Way' in Ansgar Ohly et al (eds), *Transition and Coherence in Intellectual Property Law: Essays in Honour of Annette Kur* (Cambridge University Press 2021) 478–486; *Whirlpool v Kenwood* [2009] EWCA Civ 753; *Argos Ltd v Argos Systems Inc* [2018] EWCA Civ 2211.

The first step i.e. accrual of an advantage is said to occur when a secondary use *brings to the mind* a prior mark, potentially altering the economic and behavioural patterns of the relevant consumers.²³⁰ A failure to show such a possibility would mean that no advantage is being taken by the secondary user, *unfair or otherwise*.²³¹ The requirement of economic change is said to be implicit in the concept of unfair advantage, as free riding seeks to protect against the *cross-pollination* of the reputed mark's value.²³² Explaining how an economic change can occur, the England and Wales High Court in *PlanetArt* opined that if by reason of the subsequent use, the prior user feels *obliged to make (his) mark more different from that of a new comer in order to maintain the same level of recognition*, then the secondary user can be said to have taken an advantage of the goodwill and reputation of the mark.²³³

Once it has been established that the secondary use *brings to the mind* the prior use and takes an advantage upon it, the analysis should address whether such an advantage is unfair and, thus, actionable.²³⁴ Such test of unfairness requires a global appreciation that accommodates multiple factors, including the possibility of a bad faith adoption, the intrinsic strength of the mark, its reputation and other market realities.²³⁵ However, it should be noted that not every element of this test can be given similar weightage. For example, the presumption in a paradigm case for unfair advantage is that *a very strong mark is easier to harm and more tempting to take advantage of*.²³⁶ The Delhi High Court in *Tata Sons v. Manoj Dodia* explicitly admitted that a significant reputation and a close similarity between the two marks would create a rebuttable presumption of misappropriation.²³⁷ Therefore, the *heavier the advertising expenditure or investment in promotion, the more likely any advantage that may be obtained by the applicant will be deemed disproportionate and illegitimate, and thus to constitute free-riding*.²³⁸

²³⁰ *Argos Ltd v Argos Systems Inc* (n 229) 83.

²³¹ *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* [2020] EWHC 2424 (Ch); Taylor (n 199) 1074, 1075; For a summary of the case, see, Julius Stobbs, Yana Zhou and Adeline Weber Bain, 'Overview of United Kingdom Trademark and Designs Cases 2020' (2021) 52 *International Review of Intellectual Property and Competition Law* 329–344, 333–335.

²³² Taylor (n 199) 1075.

²³³ *PlanetArt LLC v Photobox Ltd. and another* [2020] EWHC 713 (Ch); For a summary of the case, see, Stobbs, Zhou, and Weber Bain (n 231) 332–333.

²³⁴ Taylor (n 199).

²³⁵ Taylor (n 199) 1077; *Deere and Company and another v Malkit Singh and others* [2018] Indlaw DEL 2101. In this case, the Delhi High Court took into account the reputation, distinctiveness, the identical nature of the subject marks and the reply of the defendants to the plaintiff's legal notice.

²³⁶ Taylor (n 199) 1074.

²³⁷ *Tata Sons Ltd v Manoj Dodia and others* (2011) 46 PTC 244 (Del) (Delhi High Court) [20]; *FDC Limited v Docsuggest Healthcare Services Private Limited and Anr* (2017) 69 PTC 218 [74]; *Bayerische Motoren Werke AG v Om Balajee Automobile (India) Pvt Ltd* (n 202) 23.

²³⁸ Taylor (n 199) 1076; *Sazerac Brands LLC v Liverpool Gin Distillery Ltd* (n 231) 108.

4. Statutory Safeguards against Dilution

Given that the protection against dilution substantially moves beyond the core function of trademark law, the protection is available only in *limited and extraordinary circumstances*.²³⁹ The legislature has counterbalanced this protection with multiple statutory safeguards.²⁴⁰ Such a legislative treatment is in tune with the three-step model suggested by the authors in Part I.A: Protection afforded to additional functions and an absolute dissociation from the *information transmission model* should be counterbalanced with explicit limitations.²⁴¹

The primary legislative safeguard included in Section 29(4) is that the protection is limited to marks which “*have a reputation in India.*”²⁴² When protection extends beyond the source-identifying function, it is only obvious that the concerned mark should also have some *brand dimensions* extending beyond the mere indication of origin.²⁴³ When the Trademarks Act, 1999, introduced the dilution provision, the courts equated the requirement of reputation with well-known marks.²⁴⁴ This position has since been amended. The Delhi High Court in *Bloomberg Finance*²⁴⁵ and *Dharampal Satyapal*²⁴⁶ noted that the reputation requirement is a lower threshold than the well-known threshold. This position has also seen approval from the Bombay High Court as late as March 2022.²⁴⁷ It can be satisfied relatively easily than the well-known mark requirement.²⁴⁸ How this lower threshold will be achieved and what kind of evidence is required to comply with the requirement has not been clarified.²⁴⁹ However, judicial

²³⁹ Mukherjee and Kalro (n 97) 144.

²⁴⁰ *Renaissance Hotel Holdings v B Vijaya Sai and others* (n 22) [52]. Unless all the three conditions are satisfied, it will not be open to the proprietor of the registered trademark to sue for infringement when though the impugned trademark is identical with the registered trademark, but is used in relation to goods or services which are not similar to those for which the trademark is registered; *Oliver Bernd Freier v Rasul Exports* (2014) 58 PTC (Del) 630 (Delhi High Court).

²⁴¹ These counterbalancing interests can include concerns based in fair competition and free expression. Amanda Michaels and Andrew Norris, *A Practical Guide to Trademark Law* (5th edn, Oxford University Press 2014) 7–11.

²⁴² *Arudra Engineers Private Limited v Pathanjali Ayurved Limited* (2020) SCC OnLine Mad 1670 (Madras High Court) [104].

²⁴³ See generally: Fernandez-Mora (n 65) 1375–1379; Gangjee and Burrell (n 149)286.

²⁴⁴ *Tata Sons Ltd v Amit Mahna* (2013) CS(OS) No. 1228/2004 (Delhi High Court).

²⁴⁵ *Bloomberg Finance LP v Prafull Saklecha and others* (n 208).

²⁴⁶ *Dharampal Satyapal Ltd v Suneel Kumar Rajput and Anr* (2013) 56 PTC 116 (Delhi High Court).

²⁴⁷ *RPG Enterprises Ltd v Riju Ghoshal and others* (n 95) 44.

²⁴⁸ *Arudra Engineers Private Limited v Pathanjali Ayurved Limited* (n 242) [106]. In the instant case, the words specifically used are “*reputation in India*”. It means only “*reputation in India*” and does not mean “*well known mark*”.

²⁴⁹ The Court noted that if the mark enjoys reputation in one geographical location it would be sufficient to sustain a dilution claim *TV Venugopal v Ushodaya Enterprises Ltd* (2011) 4 SCC 85; The Court in this case noted that the “*cut-off date for determining whether by reason of the reputation of the plaintiff’s mark, the defendant ought to be enjoined from using its rival mark is the date on which the defendant starts using the mark*” *Advance Magazine Publishers v Just Lifestyle Pvt Ltd* (n 207).

opinions make it abundantly clear that the protection within dilution is not available to every registered trademark.

The second statutory safeguard significantly reducing the applicability of the dilution provision is that the use of the mark should be “*without due cause*.” If the defendant can successfully establish a *necessity of some kind* for using the plaintiff’s mark, the secondary use would amount to due cause.²⁵⁰ A *justifiable reason*²⁵¹ or a *tenable explanation*²⁵² for the secondary use has been indicated to qualify as *due cause*. Repeatedly interpreted to protect free speech interests,²⁵³ this limitation significantly counterbalances the expanse of the dilution doctrine.²⁵⁴ The ‘due cause’ requirement can also be cited to protect secondary use when the doctrine of actionable use fails to protect free speech interests. The German Federal Court in *Lila Postkarte* was presented with a situation where the defendant was selling postcards, which ironically alluded to the plaintiff’s registered trademarks. Since the secondary use was commercial, the actionable use requirement could not insulate the defendants from liability. The court eventually relied on the ‘due cause’ requirement to argue that an ironic reinterpretation of the underlying meanings of the plaintiff’s mark cannot be infringing.²⁵⁵

Judicial instructions dictate that a finding of bad faith²⁵⁶ and consumer confusion²⁵⁷ can be destructive to fair use, whereas denominative use would be conclusive to a finding of fair use.²⁵⁸ Further, the Delhi High Court in *Nestle India v. Mood Hospitality* suggested that if a secondary use qualifies as *non-trademark use*, it will constitute *due cause*.²⁵⁹ Hence, it is not difficult to argue that *due cause* is very expansive in its approach and allows a court to take into account a variety of concerns that are not limited to free speech interests and fair

²⁵⁰ Michaels and Norris (n 241) 3.73-3.75; Taylor (n 199) 1081.

²⁵¹ *Blue Hill Logistics Private Ltd v Ashok Leyland Limited* (2011) 48 PTC (DB) 564 (Madras High Court); Gangjee (n 18) 322.

²⁵² *Nestle India Ltd v Mood Hospitality India Pvt Ltd* (2010) 42 PTC (Del.) 514 (Delhi High Court); Gangjee (n 18) 322, 323.

²⁵³ Łukasz Żelechowski, 'Invoking freedom of expression and freedom of competition in trademark infringement disputes: legal mechanisms for striking a balance' (2018) 19 ERA Forum 115, 128–131.

²⁵⁴ Ilanah Fhima, 'Due cause' (2017) 12 Journal of Intellectual Property Law and Practice 897–905, 897.

²⁵⁵ *Lila-Postkarte* (2005) I ZR 159/02 German Federal Court of Justice (FCJ); Martin Senftleben, 'Free signs and free use: How to offer room for freedom of expression within the trademark system' in Christophe Geiger (ed), *Research Handbook on Human Rights and Intellectual Property* (ElgarOnline 2015).

²⁵⁶ *Merck KGaA v Merck Sharp and Dohme Corp* [2016] EWHC 49 (Pat); Fhima (n 254) 903.

²⁵⁷ *Comic Enterprises Ltd v Twentieth Century Fox Film Corp* [2016] EWCA Civ 4; *ibid* 904.

²⁵⁸ Renuka Medury, “‘Denominative’ use of another’s trademark can constitute prima facie “due cause” under Section 29(4) of the Indian Trademarks Act' in Kung-Chung Liu (ed), *Annotated Leading Trademark Cases in Major Asian Jurisdictions* (Routledge 2019).

²⁵⁹ *Nestle India Ltd v Mood Hospitality India Pvt Ltd* (n 252); Also *see*, Michaels and Norris (n 241) 87,88.

competition concerns. However, given the lack of any statutory or judicial guidance on the scope of its application, the provision remains *somewhat of an enigma*.²⁶⁰

Given the wide range of secondary uses that the expanded trademark doctrine can injunct, one could argue that the due cause requirement should also be malleable to counter overbroad protection within the trademark doctrine.²⁶¹ In *PlanetArt LLC v. Photobox Ltd.*, the England and Wales High Court explicitly admitted that the due cause requirement does not require a showing that “*there is no practical alternative at all to the use of the sign in question.*”²⁶² The requirement should be interpreted liberally, giving due credence to the attenuating circumstances, such as free speech and fair competition.

The analysis in Part IV indicates that the protections offered by the different subsections of Section 29 are unique and can be independently and distinctly applied. While there can be an overlap between the scope of actionable use prohibited by the subsections, the paradigm cases for each section are sufficiently delineated. Where Section 29(1) and (2) rely on the information transmission model and protect the source-identifying function and its closely related quality function, Section 29(4) is the storehouse of the misappropriation argument. It caters the expanded functions of the modern trademark doctrine. However, these individual subsections are often applied concurrently in Indian judicial discourse and practice. Therefore, the watertight compartmentalisations that the authors offer in this present study assume limited judicial recognition.

In the next section, the authors study the concurrent applications of the various causes of action within Section 29 to examine how judicial discourse affects the factual simulations that result in a conflict between the trademark doctrine and concerns based in fair competition and free speech. This is done through two case studies: comparative advertising and trademark parodies.

V. CONSTITUTIONAL SAFEGUARDS AND TRADEMARK DOCTRINE

A. Use of trademarks in Comparative Advertising

²⁶⁰ Fhima (n 254) 509.

²⁶¹ See, Basma (n 211).

²⁶² *PlanetArt LLC v Photobox Ltd and another* (n 231) [43]; Taylor (n 199) 1080, 1081.

Comparative Advertising is defined as *an explicit or implicit comparison of two or more brands in an advertisement*.²⁶³ The transaction involves a ‘sponsoring brand’ that compares and contrasts its goods with a ‘competing brand’.²⁶⁴ By its very nature, comparative advertising seeks to distinguish between the attributes of the sponsoring brand with those of the competing brand. Since the very definition of comparative advertisements requires differentiation between the sponsor and the competitor, the relationship between comparative advertising and trademark infringement can be difficult to conceptualise. The Delhi High Court in *Skol Breweries* admitted that *comparative advertisements by their very nature are antithetical to infringement*.²⁶⁵

Dubbed as a *vehicle of expression that assists consumers in making informed purchasing decisions*,²⁶⁶ empirical evidence suggests that *customer’s cognitive responses, such as attention, awareness, informative sensitiveness, and recall, are expected to be more positive toward comparative advertising than non-comparative advertising*.²⁶⁷ The Madras High Court has explained the effect of such advertising on consumer literacy: “*Consumer education, in a country with limited resources and a low literacy level, is possible only by allowing a free play for the trade rivals in the advertising arena, so that each exposes the other and the consumer thereby derives a fringe benefit*.”²⁶⁸ Given the market efficiency created by comparisons in advertising, they are protected as a function of free speech²⁶⁹ and promoting effective competition in the marketplace.²⁷⁰

The best possible exposition of the trademark doctrine’s stranglehold on advertising interests has been provided by Justice Jacob in *L’Oreal v. Bellure*.²⁷¹ After the ECJ submitted that the use of trademarks in comparative lists amounts to free-riding and infringement, Justice

²⁶³ See: Kishore Gopalakrishna Pillai and Ronald E Goldsmith, 'How brand attribute typicality and consumer commitment moderate the influence of comparative advertising' (2008) 61 Journal of Business Research 933–941.

²⁶⁴ *ibid*.

²⁶⁵ *Skol Breweries Ltd v Fortune Alcobrew Pvt Ltd* (2012) 50 PTC (Bom) 413 (Bombay High Court).

²⁶⁶ Filippo M Cinotti, 'Fair Use of Comparative Advertising Under the 1995 Federal Dilution Act' (1996) 37 *Idea* 133.

²⁶⁷ Byun and Jang (n 263) 144.

²⁶⁸ *Colgate-Palmolive v Anchor Health and Beauty Care* (2008) Original Application No 493 and 494 of 2008 (Madras High Court); and *Reckitt Benckiser v HUL* (2008) 38 PTC 138 (Delhi High Court).

²⁶⁹ *Tata Press Ltd v Mahanagar Telephone Nigam Limited and others* [1995] SCC (5) 139; *Horlicks Limited v Heinz India Private Limited* (2019) 256 DLT 468 (Delhi High Court).

²⁷⁰ *Havells India Ltd v Amritanshu Khaitan* (2015) 62 PTC 64 (Delhi High Court) [38]; See, Kaylene C Williams and Robert A Page Jr, 'Comparative advertising as a competitive tool' (2013) 7 *Journal of Marketing Development and Competitiveness* 47–62.

²⁷¹ *L’Oreal v Bellure* (n 58); The dispute in *L’Oreal v Jacob* was referred to the ECJ by Justice Jacob. When the ECJ delivered its findings and the case came back for disposal before Justice Jacob, he was not convinced by the reasoning employed by the ECJ.

Jacob was not convinced.²⁷² He argued that the defendant's advertisement of smell-alikes did not cause any consumer confusion or economic harm to the plaintiff.²⁷³ With a judgment high in moral content and policy expositions, Justice Jacob opined that the plaintiffs had effectively convinced the court to injunct the defendant from *telling the truth*.²⁷⁴ He was not incorrect in stating that the trademark doctrine should not be allowed to injunct a trader from saying that "*my goods are the same as Brand X (a famous registered mark) but half the price.*"²⁷⁵ Expressing his disappointment, Justice Jacob argued that if a similar construction of the law is afforded to medicines, a manufacturer of cheap and generic medicines would be restrained from advertising the equivalence of his medicines with those of the more expensive market standard medicines.²⁷⁶ Fostering such an interpretation of the law would create market inefficiency at the peril of consumers.

Jacob LJ's considerations have reverberated in both legal scholarship²⁷⁷ and judicial discourse. Courts from different jurisdictions have repeatedly declined to side with the broad construction of trademark protection offered by the European courts. For example, as discussed in Part IV.A, Singaporean trademark court in *City Chain*²⁷⁸ and *National Fittings*²⁷⁹ have explicitly dissociated from the European Approach.²⁸⁰ A similar approach can be witnessed in Australia,²⁸¹ New Zealand,²⁸² and Hong Kong. In 2018, the Hong Kong Court of First Instance in *PCCW-HKT Datacom Services Limited*²⁸³ concluded a three-year long dispute concerning the use of a competitor's trademark in comparative advertising. Dealing extensively with English judicial judgements, the Hong Kong Court noted that the English Law has taken a drastically different approach post 2003. The congeniality of the EU towards the misappropriation argument has substantially coloured the judicial trends in UK as well.²⁸⁴ While European and English cases have been consistently applied in Hong Kong's trademark

²⁷² Heritage (n 150) 106; Horton (n 226).

²⁷³ Christopher Morcom, 'L'oreal v. Bellure- The Court of Appeal reluctantly applies the ECJ ruling' (2010) 32 European Intellectual Property Review 530, 533; Horton (n 226).

²⁷⁴ *L'Oréal v Bellure* (n 60); Ilanah Simon Fhima, 'Trademarks and Free Speech' (2013) 44 International Review of Intellectual Property and Competition Law 293, 303, 304.

²⁷⁵ *L'Oréal v Bellure* (n 58) [5].

²⁷⁶ Morcom (n 273).

²⁷⁷ See, for example: *ibid.* Fhima (n 33); Kur (n 72); Ng (n 131); Dowell (n 149); Senftleben (n 149).

²⁷⁸ *City Chain Stores (S) Pte Ltd v Louis Vuitton Malletier* (n 157).

²⁷⁹ *Nation Fittings Sdn. Bd v Oystertec plc* (n 156).

²⁸⁰ Ng (n 131).

²⁸¹ Handler (n 159).

²⁸² Firth (n 25) 183–184.

²⁸³ *PCCW-HKT Datacom Services Limited and others v Hong Kong Broadband Network Limited* [2018] HKCFI 2037.

²⁸⁴ Santos T S Cheung, 'European Jurisprudence on Comparative Advertising Not Followed in Hong Kong' (2019) 13 Hong Kong Journal of Legal Studies 1, 5,6.

jurisprudence,²⁸⁵ the court in *PCCW-HKT Datacom Services Limited* explicitly dissociated itself from the EU and the English approach.²⁸⁶

Letting trademark law regulate advertising standards too strictly is always questionable wisdom.²⁸⁷ However, since comparative advertising requires identifying and referring to competing brands, it often intersects with trademark doctypes. Further, as the previous sections of this study illustrate, modern trademark doctrine is not solely concerned with protecting the *source identifying* function of trademarks. Concerns based in misappropriation of goodwill or denigration and defamation of reputation brings trademark law at cross-roads with comparative advertising.²⁸⁸ Therefore, a comparative advertising setting exemplifies a situation where trademark doctrine comes into conflict with concerns based in freedom of expression and fair competition.

As explained in Part 2, Section 29(8) of the Trademarks Act, 1999 covers the use of trademarks in advertising. The provision provides that blurring, tarnishment, and accrual of unfair advantage not in compliance with honest industrial and commercial practices would attract liability under Section 29(8).²⁸⁹ The language employed in Section 29(8) is very similar to the language of Section 29(4), which, as elaborated in Part IV.C, also protects against blurring tarnishment and accrual of unfair advantage. Given such close correlation in the language employed, it is safe to argue that the protection afforded to trademarks in advertising extends beyond the *origin function*.

Judicial decisions have considered the scope of comparative advertising and have provided guiding principles for addressing its legality. Two general principles are apparent from this judicial discourse: Firstly, an advertisement cannot contain a false statement which influences consumer decisions. Secondly, the advertisement cannot be misleading or defamatory. The standard of review for any court would be the effect of any depiction on an end user or common man of average intelligence.²⁹⁰

²⁸⁵ *ibid* 9, 10.

²⁸⁶ *PCCW-HKT Datacom Services Limited and others v Hong Kong Broadband Network Limited* (n 283).

²⁸⁷ Gangjee (n 92) 43, 44.

²⁸⁸ *Dabur India Ltd v M/S Colortek Meghalaya Pvt Ltd* (2010) FAO (OS) No 625 of 2009 (Delhi High Court); *Pepsi Co Inc and another v Hindustan Coca Cola and others* (n 87); *see*, Semila Fernandes, 'A Case Study Approach – An Analysis of the Infringement of Trademark by Comparative Advertising' (2014) 133 *Procedia - Social and Behavioral Sciences* 346, 346-357.

²⁸⁹ Saha Pratyayee and Rudrani Sengupta, 'Comparative Advertising and Generic Disparagement: A Probe into its Status in the Indian Legal System in the Light of Recent Cases' (2018) 4 *Indian Journal of Law and Public Policy* 21.

²⁹⁰ Fernandes (n 288) 348.

The courts have upheld an advertiser's right to claim that his products are superior to those of his competitors,²⁹¹ and he may even claim that his products are the best in the world.²⁹² An advertiser is also entitled to select the characteristics of the sponsoring products that are superior to those of the competing products.²⁹³ However, the comparison should always be limited to similar products,²⁹⁴ for instance an antiseptic solution cannot be compared with a bathing soap in a commercial.²⁹⁵ Similarly, while an advertiser is allowed to puff up and glorify her goods,²⁹⁶ she is not allowed to denigrate or disparage competing goods.²⁹⁷ While the courts acknowledge that comparative advertising is a *clear candidate for being considered 'fair competition'*,²⁹⁸ a breach of any of these limitations would render the advertisement an *unfair trade practice*, making it actionable under Section 29(8).

Considering these judicial expositions, it can be argued that the constitutional safeguards have successfully cross-fertilised the limitations on trademark monopoly. Numerous trademark courts rely on the constitutional doctrines to limit the scope of actionable use protected by Section 29. The cross-fertilisation of jurisprudence is best captured by Justice Muralidhar: "*In a democratic country, free flow of commercial knowledge is indispensable, and the public has a right to receive commercial expression.*"²⁹⁹

B. Trademark Parodying

Similar to comparative advertising, trademark parodies and anti-brand movements provide an interesting context for examining the development of trademark expansionism in conjunction with constitutional and free market-based considerations. Trademarks are a unique form of intellectual property rights. Unlike copyrights, trademarks do not disseminate knowledge or elevate the public discourse, and unlike patents, they do not lead to life enhancing innovations.³⁰⁰ Instead of flourishing the public domain, a trademark may *tantamount to the*

²⁹¹ *Reckitt and Colman Of India Ltd v Kiwi TTK Ltd* (1996) 63 (1996) DLT 29 (Delhi High Court).

²⁹² *Dabur India Limited v Colgate Palmolive India Ltd* (2004) 29 PTC Del 401 (2004) (Delhi High Court).

²⁹³ *Havells India Ltd v Amritanshu Khaitan* (n 270).

²⁹⁴ *Hindustan Unilever Limited v Reckitt Benckiser India Limited*, 2014 (57) PTC 495 (Delhi High Court).

²⁹⁵ *ibid.*

²⁹⁶ *Dabur India Ltd v M/S Colortek Meghalaya Pvt Ltd* (n 288).

²⁹⁷ *Karamchand Appliances Pvt Ltd v Sh Adhikari Brothers and others* (2005) 31 PTC 1 Del (Delhi High Court); *Dabur India Ltd v Wipro Ltd* (2006) 32 PTC Del 677 (Delhi High Court); *Dabur India Ltd v Colgate Palmolive India Ltd* (n 292); *Godrej Sara Lee Ltd v Reckitt Benckiser Australia Pty Ltd and others* (2010) 2 SCC 535..

²⁹⁸ *Fhima* (n 254) 509.

²⁹⁹ *Horlicks Limited v Heinz India Pvt Ltd* (n 269).

³⁰⁰ *See*, David W Barnes, 'A new economics of trademarks' (2006) 5 *Northwestern Journal of Technology and Intellectual Property* 22.

*gift of exclusive ownership of the use of an English word.*³⁰¹ However, given the nature of protection and the explicit limitations placed on the scope of trademark law, it is *more accurate to say that trademark law removes only certain uses of a symbol from the public domain, leaving other uses available for the public.*³⁰²

Since words in their intrinsic capacities can invoke powerful memories and associations,³⁰³ it is imperative that trademark protection leave scope for the protection of expressive and communicative uses of trademarked language. Artists, parodists, and other social commentators frequently incorporate brand names to create a negative identity of the targeted brand. These identities may be influenced by dubious business practises, socially irresponsible behaviour, or a critique of the brand's associated representations.³⁰⁴ Prof. Katyal studies these *antibranding movements* and argues that *national disparities regarding whether parody as a constitutionally protected freedom carry dramatic implications for the movement's (trademark antibranding) future.*³⁰⁵

When protected elements of the trademark law are used as elements of satire or parody, they invoke complicated legal issues, which question the very premise of trademark protection.³⁰⁶ An overbroad reliance on the extended functions doctrine³⁰⁷ and overzealous protection of a trademark's goodwill and reputation³⁰⁸ can muzzle the expressive, critical, satirical, and parodical uses of trademarks. For ease of reference and for the purposes of the present study, parody is used to refer to *juxtaposing the irreverent representation of the trademark with the idealised image created by a mark owner.*³⁰⁹

³⁰¹ *Majestic Manufacturing Co v Majestic Electrical Appliance Co* (1948) 79 Federal Supplement 649, 651 (United States District Court for the Northern District of Ohio); Sigmund Timberg, 'Trade-marks, Monopoly, and the Restraint of Competition' (1949) 14 Law and Contemporary Problems 323, 330–333.

³⁰² Tyler T Ochoa, 'Origins and meanings of the public domain' (2002) 28 University of Dayton Law Review 215, 266.

³⁰³ David A Simon, 'The Confusion Trap: Rethinking Parody in Trademark Law' (2013) 88 Washington Law Review 1021.

³⁰⁴ Sandeep Krishnamurthy and S Umit Kucuk, 'Anti-branding on the Internet' (2009) 62 Journal of Business Research 1119, 1119–1126. For examples, *see*, Cordero (n 11).

³⁰⁵ Sonia K Katyal, 'Trademark Cosmopolitanism', (2013) 47 University of California Davis Law Review 875, 912.

³⁰⁶ Robert J Shaughnessy, 'Trademark Parody: A Fair Use and First Amendment Analysis' (1986) Virginia Law Review 1079, 1079–1117, 1095–1099.

³⁰⁷ Simon (n 303).

³⁰⁸ Shaughnessy (n 306).

³⁰⁹ *LL Bean Inc v Drake Publishers Inc* (1987) 811 Federal Reporter Second Series 26, [34] (United States Court of Appeals for the First Circuit); Kathleen E McCarthy, 'Free Ride or Free Speech: Predicting Results and Providing Advice for Trademark Disputes Involving Parody' (2019) 109 Trademark Reporter 691, 694.

For decades, courts have been perplexed by the definition of parody and the effect that such a finding should have in cases of trademark infringement.³¹⁰ While a finding of parody educates a court's infringement analysis, it cannot lead to an outright omission from the subject matter of trademark protection.³¹¹ A primary example of such parodies are *weapon parodies*, where a parodist uses a trademark "to get attention or to avoid the drudgery of working up something new."³¹² In *UK Schweppes*, the defendant copied a distinctive label that was being used in reference to tonic water and applied it in reference to bath products. The defendant argued that they reconceptualised the famous and distinctive mark of the plaintiff and applied it to their product in a parodic sense. The court was not convinced by the defendant's argument and held that this was a primary example of a defendant attempting to *free-ride* the reputation accrued by the senior user.³¹³

Some literature suggests a non-commercial use of a trademark may fall outside the scope of *use in the course of trade*.³¹⁴ Building on this premise, some literature suggests that a finding of commercial use would be destructive of a defence under parody.³¹⁵ However, in order to protect expressive use of trademarks, some courts have relied on a very nuanced interpretation of what constitutes commercial use. For instance, in the case of *Mattel v. MCA*, the court argued that commercial use occurs when the secondary use *does nothing more than merely proposing a commercial transaction*.³¹⁶ Therefore, the definition of commercial use can be purposively interpreted to cover a *broad range of mixed communication—those that contain both commercial and non-commercial element—be deemed entirely non-commercial*.³¹⁷

The Delhi High Court incorporated this line of reasoning into Indian law in 2017.³¹⁸ Similar to the American dispute, Mattel attempted to restrain the use of the mark 'Barbie' in a cinematograph film in India. Heavily relying on the American judicial opinions, the Court in

³¹⁰ Simon (303) 1024.

³¹¹ McCarthy (n 309) 709–715; Justin J Gunnell, 'Evaluation of the dilution-parody paradox in the wake of the trademark dilution revision Act of 2006' (2008) 26 *Cardozo Arts and Entertainment Law Journal* 441, 466.

³¹² Catherine Seville, 'The Space Needed for Parody within Copyright Law: Reflections following Deckmyn' (2015) 27 *National Law School of India Review* 1, 3–6.

³¹³ *Schweppes Ltd v Wellingtons Ltd* 1984 FSR 210.

³¹⁴ See, Sabine Jacques, 'Parody Exception: Why trademark owners should get the joke' (2016) 38 *European Intellectual Property Review* 471.

³¹⁵ 'Does it matter if the judge laughs?' (2010) *Managing Intellectual Property* 32.

³¹⁶ *Mattel Inc v MCA Records Inc* (n 3). Also see, *Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and another* [2005] ZACC 7 (Constitutional Court of South Africa); Dreyfuss Cooper (n 12) 272.

³¹⁷ Patrick D Curran, 'Diluting the Commercial Speech Doctrine: "Noncommercial Use" and the Federal Trademark Dilution Act' (2004) 71 *The University of Chicago Law Review* 1077, 1089. This interpretation has been approved by the court in *American Family Life Insurance Co v Hagan* (2002) 266 *Federal Supplement Second Series* 682 (United States District Court for the Northern District of Ohio).

³¹⁸ *Mattel Inc and another v Ms Aman Bijal Mehta and others* [2017] SCC OnLine Del 11857 (Delhi High Court).

India held that, “*Barbie is seeking in India what has been denied it in the Court of its origin.*”³¹⁹ The court’s decision in the Barbie case can be interpreted to mean that commercial use of a trademark would not necessarily invalidate a parody defence under trademark law.

Apart from free-riding, another concern for parodic reinterpretations of trademarks, similar to comparative advertising, is the disparagement and defamation of the concerned mark.³²⁰ A parodic reinterpretation of any trademark can potentially hamper the *selling power* of the mark by creating unfavourable associations and defaming and denigrating trademarks. This was the primary concern before the Delhi High Court in *Tata v. Greenpeace*.³²¹ To express their discontentment over the creation of a port, which could potentially threaten the breeding ground of Olive Ridley Turtles, the defendants created a Pacman style game, where the ‘Tata’ mark was used critically.³²² Tata initiated infringement proceedings against the defendants and argued that the use of their mark amounted to defamation and disparagement of their mark. Heavily relying on the non-commercial nature and interests of free speech and expression, the court denied the grant of an injunction.³²³

The position which emerges from the study of these judgements is that a finding of non-commercial use significantly helps in establishing a defence of parody. However, a troubling trend seems to be emerging. The underlying reason for parodying is colouring the interpretation of trademark law. As Prof. Gangjee remarks, if the underlying reason for parodying is *legitimate and reasonable*, and the secondary use retains its non-commercial nature, the secondary use should not be actionable.³²⁴ This position can be very problematic. An intellectual property court should not be allowed to assess the legitimacy or reasonableness of secondary use. This position has been reiterated by Justice Bhat in *Tata v. Greenpeace*, “*The Court cannot anoint itself as a literary critic, to judge the efficacy of use of such medium, not can it don the robes of a censor.*”³²⁵ However, as alarming as this trend can potentially be, Prof. Gangjee’s conclusions seem to resonate within judicial decisions.

In another example, in July 2020, the Delhi High Court enjoined the defendants from publishing a YouTube video. The bizarre facts of the case are best explained by the court:

³¹⁹ *ibid* 32.

³²¹ *Tata Sons Ltd v Greenpeace International and another* (2011) 45 PTC 275 (Delhi High Court).

³²² Katyal (n 305) 923–927; Medury (n 258).

³²³ Gangjee (n 18) 323, 324; Katyal (n 305).

³²⁴ Gangjee (n 18) 324.

³²⁵ *Tata Sons Ltd v Greenpeace International and another* (n 321).

“The video, which is dramatised in the manner of a news report, shows defendant number 2 reporting that the reporter of the channel “The Fauxy” has been investigating if the claims that the employees of the plaintiff had been urinating in the beer sold to its customers are true or not. The video then cuts to defendant number 1, Mr. Rishav Sharma, presenting the viewers a bottle of plaintiff’s Budweiser Beer and a sample of urine. The defendant number 1 thereafter proceeds to taste the urine sample and the plaintiff’s Budweiser Beer. On tasting the two, the defendant number 1 concludes and reports that the news that the employees of the plaintiff have been urinating in the beer sold to its customers, has to be fake since the plaintiff’s beer tastes worse than the urine.”

Without providing any reasons for its order and without constructing a workable interpretation of Section 29, the court opined that the acts of the defendant amount to infringement of the plaintiff’s mark.³²⁶ When the court in *Tata v. Greenpeace* had explicitly noted that nominative use of a trademark would not attract any liability,³²⁷ how did the court conclude the defendant’s use as infringing?

The only logical difference seems to be the underlying reason for the secondary use. The court seems to have effectively coloured the actionable use requirement with issues that are beyond the concern of the trademark doctrine.

VI. CONCLUSION

Initially, the authors designed this study as a trademark protection spectrum.³²⁸ The initial research undertook an examination of trademark cause of actions *vis-à-vis* the expansion of actionable secondary use in line with the expanding normative justifications of trademark law.

³²⁶ *Anhueser Busch Llc v Rishav Sharma* (2020) 83 PTC (Del) 217 (Delhi High Court). The order came from the hearing of an interlocutory injunction application and not all of the defendants recorded their submissions. There were two independent causes of action. Even if the action for trademark infringement failed, the plaintiff could have made a case under the common law remedy of product disparagement. .

³²⁷ *Tata Sons Ltd v Greenpeace International and Another* (n 321); *Medury* (n 258).

³²⁸ The spectrum was not expected to consider an exhaustive list of infringement actions. It was only supposed to be indicative of the various forms of infringement.

Figure 1: Trademark Protection Spectrum

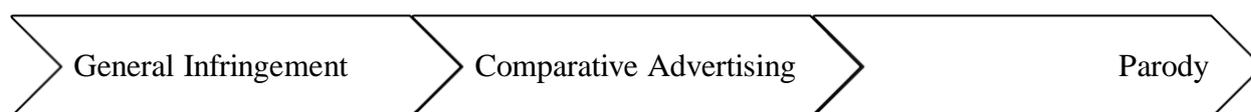
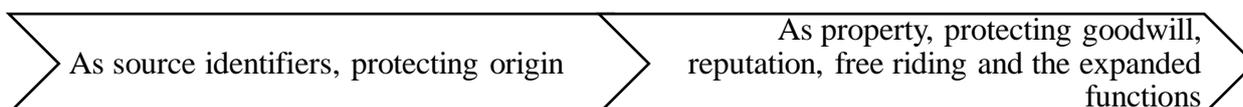


Figure 2: Expansion of actionable secondary use in line with normative justifications



The identified nodes were not intended to serve as water-tight compartments. Since the various subsections of Section 29 can be applied concurrently, it was expected that there would be significant cross-fertilisation of case law and jurisprudence. However, while undertaking this study, the authors came to a very unfortunate conclusion: *the engagement of Indian trademark courts with the normative foundations and justifications of trademark law remains very limited and constrained*. Apart from a few eloquent discussions,³²⁹ most judicial discourse has failed to appreciate the differences in the underlying thesis of protections offered within infringement, particularly Section 29(1), (2), and (4). This precluded the authors from analysing their model in line with judicial comments and perspectives.

The lack of a judicial engagement with the normative foundations of trademark law also affects the protection afforded to expressive uses of trademarks. As the discussion in Part V demonstrates, policy and constitutional concerns have successfully cross-pollinated trademark jurisprudence. However, these developments have been forestalled by the lack of a discourse around the expanding and mutating premise of trademark protection. Value judgements about the viability of secondary use to adjudge limitations and protections is a very dangerous development and should be analysed in more detail.

Despite the criticism amassed by the EU's functions-based interpretation of the trademark law, it is a step in the right direction. It allows courts to engage with the normative dimension of the trademark law while engaging with the facts of a trademark dispute. Such a thesis, if interpreted reasonably, can help in a sharper delineation between socially desirable and undesirable behaviour.³³⁰ If the functions formulation can be consciously merged with a

³²⁹ A primary example of such a decision would be *Tata Sons Ltd v Greenpeace International and another* (n 321).

³³⁰ Damjan Kukovec, 'The Realist Trend of the Court of Justice of the European Union' (2021) European University Institute Working Paper 2021/11, 15 <<https://cadmus.eui.eu/handle/1814/72658>> accessed 14 February 2023.

discussion about the limits of the misappropriation argument, it can save trademark law from venturing into problematic directions. Since the present study attempts to integrate this analysis based on the actionable use requirement, it is limited to only three subsections of Section 29. The arguments and thesis of this examination must be expanded to other subsections of Section 29, which omit the actionable use requirement, but explicitly limit the scope of their application.