
TRADEMARK JURISPRUDENCE ACROSS BORDERS: INSIGHTS FROM INDIA, UNITED STATES AND UNITED KINGDOM COMPARATIVE ANALYSIS

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ABSTRACT

The paper examines the subtleties of trademark jurisprudence in the three important jurisdictions that are India, the United States and the United Kingdom. Trademarks are significant tools in the protection of brand identity and ensuring fair competition within a globalized economy. The study provides a comprehensive overview of the statutory provisions, judicial pronouncements and enshrined rights of the trademark holders. Through a comparative analysis the study examines the frameworks governing trademark registration, enforcement and infringement, shedding light on both commonality and critical differences. The paper also covers the pivotal role of World Intellectual Property Rights (WIPO) in regulating Trademark practices throughout the world. With the changing dynamics of trademark understanding the global perspective of trademark is essential.

Keywords: Intellectual Property Rights, Trademark, WIPO, Infringement, IPR, United states laws, United Kingdom laws.

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1. INTRODUCTION

Intellectual property rights consist of multiple aspects like copyright, patent, design etc. One of the key aspects of Intellectual property rights is “**Trademark**”. Trademark provides security and individuality in the market to any product name, company’s name or other matters related. The trademark throughout the world is governed by the World Intellectual Property Rights (WIPO) under which every signatory country is required to make provisions and acts in accordance with the WIPO guidelines. Trademarks in India are governed by ‘**The Trademark Act 1999**’. Whereas in the United States it is governed by ‘**The Lanham Act 1946**’ and in the United Kingdom it is being covered by ‘**The Trademark Act 1994**’. In the case of *London rubber co. ltd. Durex products*² it was stated that a Trade mark is a kind of property and is entitled to protection under the law, irrespective of its value in money so long as it has some business or commercial value. Not merely the interest of the public but also the interest of the owner are the subject and concern of trade mark legislation. Trademark has always been a crucial part of Intellectual property rights and it holds similar rights like a property and ‘the law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or are associated therewith³’. By examining the legal definitions, registration process and its enforcement, this paper aims to identify the key similarities and differences between the Acts of the United States, United Kingdom and India.

1.2 DEFINITIONS & INTERPRETATION OF TRADEMARK

According to *Trademarks Act 1999(India)*, section 2(zb) says that “trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors. Essentials of trademark’s definition states that (1). There should be a mark. (2) It should be a valid mark and should not fall in any of the exceptions of not being a registered trademark. (3) It can be either any goods, shape of goods, color combination, packaging and also services. Trademarks in India are being classified between 45 classes which are influenced by the **Nice Classification system** of the *World Intellectual property organization*. It specifies different types of classes which help’s in distinguishing the

² London rubber co. ltd. vs. Durex products 1964 2 SCR 227

³ Laxikant v. patel vs. Chetanbhai shah 2001 5 Suppl. SCR 435

trademarks according to their work class and also helps proprietors and registry to create a difference in firms having similar marks. In the case of *Laxikant v. patel vs. chetanbhai shah (supra)* it was held that “The definition of trade mark is very wide and means, inter alia, a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. Mark includes amongst other things name or word also. Name includes any abbreviation of a name⁴”. According to *Lanham Act (United States)*, Section 45: - a trademark is any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods⁵. Essentials of Trademark’s definition in Lanham Act: -(1) There should be a mark which can be any word, name, symbol, or design or combination. (2) Mark should differentiate the goods from other manufacturer and sellers. (3) Must indicate source of goods. All goods and services are classified or organized into broad categories of goods and services as specified in ‘**Nice classification**’. There are 1-45 classes which deal with different subject matters. Classes 1-34 cover’s **goods** and 35-45 cover **services**. In the case of *United states v. Wittemann*, it was held that a trade-mark is neither an invention, a discovery, nor a writing, within the meaning of the eighth clause of the eighth section of the first article of the Constitution, which confers on Congress power to secure for limited times to authors and inventors the exclusive right to their respective writings and discoveries⁶. According to *Trademark Act 1994(United Kingdom)*, section 1 states that “Trademark” means any sign capable of being represented graphically which is capable of distinguishing goods and services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging. Essentials of definition are: -(1) Any sign means – words, designs, letters, numerals, shape and packaging of goods, symbols, colour shades, or combination of any these (2) Mark should be capable of being graphically represented (3) Capable of distinguishing goods and services of one undertaking from those of other undertakings. Likewise, India and United states, United Kingdom is also a signing country to world intellectual property organization and follows “Nice classification” therefore there are 45 classes dealing matters related to goods and services.

⁴ *Laxikant v. patel vs. chetanbhai shah* 2001 5 Suppl. SCR 435 pg. no. 441

⁵ *Lanham Act 1946*, 15 U.S.C. § 1127

⁶ U.S. Reports: Trade-mark cases, 1879, 100 U.S. 82 (1879)

2. REGISTRATION OF A TRADEMARK

In countries that have traditionally based trademark protection on use, the registration of a trademark merely confirms the trademark right that has been acquired by use. Consequently, the first user has priority in a trademark dispute, not the one who first registered the trademark.⁷ In India registration of a trademark is regulated by **Trademark Registry** it is being governed under **Trademark rules, 2017** which especially deals with the procedure of how a trademark should be registered what is the appropriate authority to go before for the registration of trademark and other aspects also. But only those marks can get registered which fulfills the essentials elements –**(a)** Distinctive in character that is the mark is required to be distinctive and unique in character. **(b)** Does not indicate any quality or describes the goods for which mark is being used. **(c)** Does not contain any word that is commonly used and is part of normal day to day language. **(d)** Is not similar to well-known trade mark. **(e)** Is not similar to a registered trade mark. **(f)** not causing confusion and deception in the minds of ordinary consumers regarding source of origin. **(g)** To contain any symbol or word that is prohibited under the emblem and names (prevention of improper use Act 1950). **(h)** The mark should not contain shape of goods or shape that is by virtue of the nature of goods or a shape that is necessary to obtain a technical result or adds substantial value to goods. **Steps of Registration of trademark – Trademark search-** Trademark search is a first step taken up by any entrepreneurs. TM search helps proprietors to know, whether there is any similar trademark available and also gives fair picture of similarity of existing marks. **Filing of Trademark application** After finalizing the trademark an application is lodge either in **Proposed to be used** (applied prior to using) or by **User** (mark already in use) after filling TM-1 form the application is filed in the appropriate office according to section 4 of Trademark rules 2017. According to **section 4** of Trademark Rule 2017, an **Appropriate office of trademark registry** is decided by the territorial limits of registry where – (a) Principal place of business in India of registered proprietor in the register is situated. (b). If there is no entry in register of principal place then address of service in India as entered in the register. (c) In case of Joint registered proprietors, principal place of proprietor whose name is entered first in the register. (d) In case where none joint registered proprietors are mentioned in register, then in the address for service will be taken up. (e) In case where both principal place and service address is not mentioned then place from where the application for registration is made will have the

⁷ Introduction to trademark law & practice: The basic concept, 1993, 2nd edition WIPO training manual Geneva, WIPO Pg.11

jurisdiction. **Examination** - After filing of trademark application the registry examines the mark whether it is barred by section 9 and section 11 of Trademark act 1999. If there is an objection raised by the registry then the party has to give reply of that objection clarifying how their mark does not come under any of the following objection: - **Section 9- Absolute grounds of refusal of registration of trademark:** The trademarks shall not register which are – **(a)** The trademarks are incapable to differentiate the applicants' products/services from those of others. **(b)** A trademark identifies the kind, quality, intended purpose, values, geographical origin, time of production, or qualities of goods or services. **(c)** or which consist exclusively of marks or indications which has become customary in the current language or the bona-fide and established practices of the trade. **(d)** A mark misleads consumers or creates confusion. Section 9(2) (a) primarily concerns the deceptive nature of the mark. A mark may be deceptive if something about it or how it is used, such as the quality, character, or place of origin of the goods or services, is inherent in the mark itself. **(e)** A mark must contain marks that are likely to offend the religious sensitivities of any part or class of Indian nationals. For example, a mark cannot be allowed in the name of religious heads or deities on meat products, footwear, etc. **(f)** A trademark that comprises or contains scandalous or obscene matter. **(g)** Their use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950. For example, names such as Mahatma Gandhi, Pandit Nehru, or a logo which is similar to Indian Flag etc are unregistrable **(h)** The nature of the commodities determines their shape. For instance, round or lever-style door knobs would be exempt from registration under section 9(3)(a). **(i)** The shape of goods that are essential to obtain a technical result. **(J)** The shape that significantly increases the worth of the products—The shape should be appealing to the sight to add value. **Section 11 – Relative grounds of refusal:** The trademark cannot be registered if –**(a)** The mark's identity is similar to earlier registered mark or of similar goods and services. **(b)** If there is any mark which can create confusion in the public is restricted from registration. **Publication of trade mark** – after all the procedure from the registry if the mark got approval, then the mark should be published for 4 months where people who have any kind of issue with the mark, they can raise their objection within the prescribed time. **Notice of opposition** – If any of the person have any kind of objection, they can raise their objection by filing the notice of opposition in the competent court where all the hearing procedure is done under code of civil procedure 1908. **Registration** – In case where there is no opposition or dispute. If any got resolved then a certificate of Registration is issued by registry, which permits the mark to be used in public as registered mark. **Renewal** – The trademark is supposed to be get renewed in

every 10 years, if the proprietor fails to renew the mark, he will lose all the rights provided to him along with the trademark registration.

3. RIGHTS GUARANTEED TO TRADEMARK HOLDER

According to Section 28 of Trademark Act 1999. Few Rights are being conferred after registration. **Right to Exclusive use** – one of the essential and key right of the proprietor is to use its mark exclusively, means no person other than he authorize can use the mark. This right empowers the proprietor to secure its mark from any kind of infringement and also ensure safety in the market. **Right to seek statutory remedies** – under this right a proprietor can take legal action against the person infringing the mark. The proprietor has option to either go for civil or criminal remedies. This right not only ensures a safety to the mark but it also punishes the infringer for commit such act. **Right to Assign/ license** – under section 38 of Trademark Act 1999, license some rights are being transferred to the licensee whereas the ownership remains with the trademark holder. On the other hand, Assign means the owner of the trademark gives his ownership to other person with all the rights, by this right a proprietor can earn money by transferring either rights or ownership. **Right of Correction** – if there is any error in the name, address or description of the proprietor, goods and services etc. The proprietor can get it changed under section 58 of the Trademark Act 1999.

4. REMEDIES AGAINST TRADEMARK INFRINGEMENT

4.1 (India)

Chapter 12 of Trademark Act 1999, talks about remedies and penalties such as, **Civil Remedies: Injunction**, temporary Injunction – Court may order the infringer from the process until the law suit concludes. Permanent Injunction – Court may grant permanent injunction for a longer period of time, where the infringer is restricted from doing any further activity with the mark. **Damages, Compensation** for all the financial losses or reputational damage caused by the infringement. Which means that the infringer has to pay the decided amount as compensation. **Accounts of profits**, the infringer has to disclose and pay all the profits he has gained by using the infringing mark. **Criminal Remedies: Imprisonment** (1) Imprisonment of 6 months to 3 years can be given for infringement for the 1st time. (2) In case of subsequent offence person can be sentenced for 1year to 3year imprisonment. **Fine** (a). A fine of 50,000 to

2lakhs can be imposed on infringer. (b)In case of subsequent offence fine can be imposed from 1lakh which may extend to 2lakh.

4.2 (United States)

Chapter 6 of Lanham Act, 1946 specifies remedies for Trademark infringement.

Injunctive Relief –Injunctive relief means Injunctions which includes both temporary and permanent relief given by courts for infringement. **Destruction or forfeiture** – This means seizure and destruction of either good, products, services or advertisements which are causing infringement of a particular registered mark. **Monetary damages** – Marshal can order for monetary compensation for the damage caused to the proprietor by the act of infringement, Marshalls have awarded more than \$5 billion monetary compensation in the infringement cases. **Reasonable royalties** – courts calculate the damages considering both the parties with a reasonable amount to be paid. **Statutory damages** – courts can also grant statutory damages from \$1000 to \$20,000 for every type of goods and services. **Defendants' profits** – similar to accounts of profit, infringer held liable to pay all the profits he has gained by using the mark. **Attorney's fees and courts costs** – in special cases where infringement has been done the courts may impose penalty on defendant or infringer to pay the attorney cost and court cost of the plaintiff which he has done during the suit. **Treble Damages** – Rather than compensation courts have the power to increase the award to three times of the actual amount, this is used in cases where willful infringement has been done and it is also proved.

4.3 (United Kingdom)

Part 1 of Trademark Act 1994 (Section 14 – 20) specifically deals with remedies of infringement.

Injunction – Court may order the infringer for stopping his good and services which is being running under someone else registered trademark. Court directs this remedy in cases where there is any urgency or likelihood that the infringer can destroy the evidence or property in such cases permanent and temporary injunctions are issued. **Damages** – Damages are the amount which the infringer has to pay in return to the damage he has caused to the registered trademark holder by infringing his mark, this also covers damages caused to the reputation and goodwill for the mark holder. **Accounts of profits** – It is the discretion of the plaintiff whether

he wants accounts of profit, the defendant has to show all the profits and have to pay all the profits he has gained by using the trademark. **Other remedies** – (a) Erasure, removal or obliteration of the infringing good, product, sign or material containing infringing mark. (b) Delivery or destruction of good, material containing infringing mark. (c) Payment of suit costs is also a remedy under UK law.

5. LANDMARK CASE LAWS

5.1 (United Kingdom)

1. ***Thom Browne Inc & ors vs. Adidas***⁸ - Thom Browne is a luxury fashion brand having '4 strips' as their logo, the Adidas claimed that the 4 strips are violation of their '3-strip mark', good will and reputation also it may cause confusion among consumers. Court held that mark of Adidas, particularly three strips possess a degree of goodwill and reputation, but it did not conclude this goodwill was significantly harmed by the Thom Browne mark. The court also stated that the adidas has failed to prove the distinctiveness of its mark and the use of four bar design did not infringe upon adidas's trademark rights.
2. ***Lidl vs. Tesco***⁹ - Lidl the German supermarket giant sued Tesco for infringement of using 'yellow circle on a blue square background' to indicate Clubcard prices promotion. The Judge held that the average consumer would make a link between the mark with text and sign. Court also found 'unfair advantage' due to resemblance between the marks. The court of appeals however changed the judgement on copyright infringement.
3. ***Spacesavers vs. Asda***¹⁰ - Spacesavers is a prominent optical retailer, brought a claim against Asda a supermarket chain for trademark infringement and passing off. The Asda was using similar logo featuring overlapping circles in its own optician services, which Spacesavers argued was likely to cause confusion among consumers. Court held that the Asda's logo was likely to cause confusion among consumers due to its similarities. Hence it is clear infringement of the trademark.

⁸ *Thom Browne Inc & ors vs. Adidas* [2024] EWHC 2990 (Ch)

⁹ *Lidl vs. Tesco* [2024] EWCA Civ 262

¹⁰ *Spacesavers vs Asda* [2012] EWCA Civ 24

4. *Lifestyle equities cv vs. Royal County of berkshire polo club ltd and ors*¹¹ - Suit for trademark infringement and passing off was made by Beverly hills polo club brand against Royal County of Berkshire polo club for the use of mark comprising name of club with a figure representation of a mounted polo player. The logo of claimant comprises of fictional polo club with representation figure of polo player. The judge held that, the market of polo themed clothing is very crowded and the only distinctiveness is the use of name of brand. Hence the claimant failed to provide sufficient evidence of infringement therefore the suit was dismissed.

5.2 (United States)

1. *U.S Patent and Trademark Office vs. Booking.com*¹² - The USPTO denied the registration of 'Booking.com' as it has a generic word booking which is a commonly used term for booking and reservation. 'Booking.com' challenged the decision before the Supreme court of U.S. The Hon'ble court held that 'Booking.com' can be registered as it contains generic term with a distinctive domain name, thereby makes its non-generic and distinctive trademark.¹³
2. *Jack Daniel properties Inc vs. VIP products LLP*¹⁴ - VIP made chewable dog toy similar to Jack Daniel whiskey bottles with a changed name Bad spaniel. Jack Daniel demanded to stop selling such toys. VIP sought declaratory judgement for the protection of being called infringed mark. Jack Daniel counterclaimed and the question arose weather *Rogers* test will be applicable to determine infringement. The Supreme court held that the *Rogers* test cannot be used because *Rogers* apply when the challenged use of mark is as a mark and Supreme court vacated the case.
3. *Dewberry Group Inc vs. Dewberry Engineers Inc*¹⁵- Dewberry engineers sued Dewberry group for the infringement of 'Dewberry' trademark. The district court awarded nearly \$43 million in profits. The court treated dewberry group and its affiliates as a corporate entity totaling the affiliates real estate profit to calculate the award. The Supreme court of United States held that, the district court has erred in

¹¹ Lifestyle equities cv vs Royal County of berkshire polo club ltd and ors [2023] EWHC 1839 Ch

¹² U.S Patent and Trademark Office vs. Booking.com [2020] 591 U. S.

¹³ Trademark Law: An Open- Access casebook by Barton Beebe 2023, V.10.0 TMCASEBOOK.ORG, Pg.51

¹⁴ Jack Daniel properties Inc vs. VIP products LLP [2023] 599 U.S.

¹⁵ Dewberry Group Inc vs. Dewberry Engineers Inc [2025] 604 U.S.

calculating profit of Dewberry group as considering its affiliates as single corporate entity. The court ordered for new award.

5.3 (India)

1. ***Metro Brands Ltd vs. Nice shoes LLP¹⁶***- The applicant sought injunction for restraining defendants from using the word mark ‘DESIMOCHI’ which is similar to the registered wordmark ‘MOCHI’ which is being used by the applicant since 1977. Hon’ble court held that the applicant has valid and enforceable rights to the mark ‘MOCHI’ and defendant used the deceptively similar mark ‘DESIMOCHI’ which may likely to cause confusion and thus the court ordered for injunction and passing off in favour of applicant.
2. ***Lenovo (Singapore) Pvt. Ltd vs R.P.D Workstations Private Limited¹⁷*** - The appellant challenged the mark ‘THINBOOK’ which was deceptively and phonetically similar to the registered and well-known trademark ‘THINKBOOK’ under section 2(1) (zg) of trademark act 1999. The court observed that Lenovo has obtained several trademarks under various classes with the word ‘THINK’. Thus, using the word ‘THINBOOK’ will not only confuse the consumers but likely to cause irreparable harm to the registered trademark owner. Hence court ordered Trademark registry to cancel the mark ‘THINBOOK’ in accordance with section 57 of the Trademark act 1999.
3. ***Inter IKEA systems BV vs. I Key Home Studio LLP¹⁸*** - Suit was filed by the Inter IKEA systems against the mark ‘IKEY’ which is deceptively similar to registered mark ‘IKEA’. The Delhi High Court held that the use of mark ‘IKEY’ indicates clear malafide intention of the defendant. The intention of the defendant is to gain profit from the brand having goodwill in the market. Hence defendant is liable to stop using the impugned mark ‘IKEY’, and using any domain name, mark or logo will be considered as infringement.

¹⁶ Metro Brands Ltd vs. Nice shoes LLP 2024 SCC Online Bom 3647

¹⁷ Lenovo (Singapore) Pvt. Ltd vs R.P.D workstations private limited 2024 SCC Online Mad 7336

¹⁸ IKEA systems BV vs. I Key Home Studio LLP 2024 SCC Online Del 9160

6. COMPARATIVE ANALYSIS OF TRADEMARK LAWS OF UNITED STATES, UNITED KINGDOM AND INDIA

S.NO	ASPECT	UNITED STATES	UNITED KINGDOM	INDIA
1.	Primary legislation	Lanham Act, 1946	Trademarks Act, 1994	Trademarks Act, 1999
2.	Administered by	United States Patent and Trademark Office (USPTO)	United Kingdom Property Office (UKIPO)	Controller general of Patents, Designs and Trademark (CGDTM)
3.	Examination criteria	Section 2: Refusal on grounds like deceptiveness and descriptiveness, etc.	Section 3&5: Absolute and relative grounds of refusal.	Section 9 (absolute) and section 11 (relative) grounds of refusal.
4.	Opposition process	Section 13: Opposition within 30 days from publication.	Section 38: 2 months from publication.	Section 21: Opposition within 4 months from publication.
5.	Valid Upto	10 years	10 years	10 years
6.	Criminal Penalty	No Direct penalty under federal law	Limited scope in counterfeiting	Section 103-105: Imprisonment upto 3 years or fine.

7. CONCLUSION

In the era of globalization where businesses are being operated across borders and identity of a brand, company or even a product is an asset, the role of trademark has increased and became pivotal. Through this detailed comparative study of trademark jurisprudence in India, United States and United Kingdom this paper highlights not only the basic similarities between the legal systems but it also covers the essentials such as registration, enforcement and protection of the trademark. All three jurisdictions recognize trademark as essential tool to distinguish goods and services and each country follows a codified legislative framework such as Trademarks Act 1999 in India, Lanham Act, 1946 in United States and Trademarks Act, 1994 in United Kingdom. All these frameworks are backed by the provision of WIPO world intellectual property organization where countries are required to fulfil Nice-Classification where 45 classes are defined and every mark is required to fall under these classes. Similarly, all these trademarks are backed by a formulized legal structure from application to opposition

and then registration of trademark. The law provides a well-structured way of protecting the rights of the owner who holds a registered trademark. Some remedies are provided to the owner such as Injunction which can be temporary or permanent, monetary compensation, passing off, or damages. The law of all three countries specifies a well-structured punishment mechanism which ensures that in case of infringement the wrong doer will be punished. This paper aims to provide a detailed yet simple explanation of legal definitions, what aspects are being covered under the provisions and what is the scope of the definitions. Despite these common foundations some notable differences exist, the Indian legal system outlines both civil and criminal remedies, whereas other two countries law emphasizes more on monetary remedies and compensatory relief. Through the landmarks judgements of these three countries, we can understand the practical implementation of these laws. In conclusion, the trademark not only protects the company, brand, product, etc. in domestic market but it also focuses on the international market place.

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