



Law Relating to Trademarks

Part-5

Understanding Trademark Protection

Infringement of Registered Trade Marks

A person shall be deemed to have infringed a registered trade mark, if he uses a mark which is identical with or similar to the registered trade mark, and is used in relation to goods or services which are not similar to those for which trademark is registered; and the registered trade mark has a reputation in India and the use of the mark without due cause would take unfair advantage of or is detrimental to the distinctive character or repute of the registered trade mark.

Section 29 dealing with infringement of trademarks, explicitly enumerates the grounds which constitute infringement of a trademark. Section 29(1) provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which is identical with, or deceptively similar to, the trade mark in relation to goods or services in respect of which the trade mark is registered and in such manner as to render the use of the mark likely to be taken as being used as a trade mark.

Section 29(2) & 29(3)

Grounds for Trademark Infringement

As per section 29(2) of the Act, a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which because of —

(a) Identity with Registered Mark

its identity with the registered trade mark and the similarity of the goods or services covered by such registered trade mark; or

(b) Similarity to Registered Mark

its similarity to the registered trade mark and the identity or similarity of the goods or services covered by such registered trade mark; or

(c) Identity of Mark & Goods

its identity with the registered trade mark and the identity of the goods or services covered by such registered trade mark, is likely to cause confusion on the part of the public, or is likely to have an association with the registered trade mark.

❏ **Section 29(3) states that in any case falling under section 29(2)(c), the court shall presume that it is likely to cause confusion on the part of the public.**

Section 29(4) – Dissimilar Goods or Services

Section 29(4) provides that a registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which —

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

Sections 29(5), 29(6) & 29(7)

Additional Forms of Trademark Infringement

Use as Trade Name

According to Section 29(5) of the Act, a registered trade mark is infringed by a person if he uses such registered trade mark, as his trade name or part of his trade name, or name of his business concern or part of the name, of his business concern dealing in goods or services in respect of which the trade mark is registered.

What Constitutes 'Use'

Section 29(6) provides that a person uses a registered mark, if, in particular, he:-

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market, or stocks them for those purposes under the registered trade mark, or offers or supplies services under the registered trade mark;
- (c) imports or exports goods under the mark; or
- (d) uses the registered trade mark on business papers or in advertising.

Unauthorised Application

Section 29(7) states that a registered trade mark is infringed by a person who applies such registered trade mark to a material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, provided such person, when he applied the mark, knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

Sections 29(8) & 29(9)

Infringement Through Advertising and Spoken Use

Section 29(8) – Advertising Infringement

As per Section 29(8) a registered trade mark is infringed by any advertising of that trade mark if such advertising:-

- (a) takes unfair advantage of and is contrary to honest practices in industrial or commercial matters; or
- (b) is detrimental to its distinctive character; or
- (c) is against the reputation of the trade mark.

Section 29(9) – Spoken Use

Section 29(9) provides that where the distinctive elements of a registered trade mark consist of or include words, the trade mark may be infringed by the spoken use of those words as well as by their visual representation and reference in this section to the use of a mark shall be construed accordingly.

Renaissance Hotel Holdings Inc. vs. B. Vijaya Sai & Ors.

Civil Appeal No. 404 of 2022 (Judgment dated 19.01.2022)

Facts of the Case

Renaissance Hotel Holdings Inc., the appellant, is the registered proprietor of the well-known trademark "**RENAISSANCE**" in respect of hotel and hospitality services. The appellant forms part of the globally reputed Marriott group and has registrations for the mark "RENAISSANCE" in India.

The respondents/defendants were using the mark "**SAI RENAISSANCE**" as part of their hotel/business name for providing identical hospitality services. The appellant filed a suit for **trademark infringement and passing off**, contending that the use of the word "RENAISSANCE" by the respondents was unauthorised and amounted to infringement under Section 29 of the Trade Marks Act, 1999.

The **Trial Court** ruled in favour of the appellant and restrained the respondents from using the mark "SAI RENAISSANCE".

However, the **High Court reversed the Trial Court's order**, holding that:

- There was no likelihood of confusion between "RENAISSANCE" and "SAI RENAISSANCE"
- The appellant failed to prove **trans-border reputation** and **actual damage**
- The case would fall under **Section 29(4)** and not Section 29(2), and the requirements of Section 29(4) were not satisfied

Aggrieved by the High Court's judgment, the appellant filed an appeal before the **Supreme Court of India**.



Legal Questions

Issues Before the Supreme Court

01

Infringement Question

Whether the use of "SAI RENAISSANCE" infringed the registered trademark "RENAISSANCE".

02

Proof of Confusion

Whether proof of confusion or damage was required when the marks and services were identical.

03

Application of Law

Whether the High Court correctly applied Section 29 of the Trade Marks Act, 1999.

Observations of the Supreme Court

The Hon'ble Supreme Court made the following important observations:

Section 29(2)(c) Applicability

Section 29(2)(c) applies when:

- The defendant's mark is **identical** to the registered trademark, and
- The goods or services are **identical**

Presumption of Confusion

Section 29(3) mandates that in cases falling under Section 29(2)(c), the Court **shall presume likelihood of confusion**. No separate proof of confusion or damage is required.

High Court's Error

The High Court **erroneously applied Section 29(4)** in isolation, ignoring that:

- Section 29(4) applies only when goods/services are **dissimilar**
- In the present case, services were **identical (hotel services)**

Trade Name Protection

Use of a registered trademark as part of a **trade name or business name** squarely attracts **Section 29(5)**.

Spoken and Visual Use

Spoken and visual use of a word mark is also protected under **Section 29(9)**.

Section 30 Defence

To claim protection under **Section 30**, the defendant must prove:

- Honest commercial practices, and
- No unfair advantage or detriment to the mark's reputation

The respondents failed to satisfy these conditions.

Contextual Interpretation

The Court emphasised that statutory provisions must be interpreted **contextually and harmoniously**, and no provision should be read in isolation.

Judgment

Final Decision

The Supreme Court held that the High Court committed a grave error in interfering with the Trial Court's well-reasoned order.

- The case was **squarely covered under Section 29(2)(c) read with Section 29(3)**, and also under **Sections 29(5) and 29(9)** of the Trade Marks Act, 1999.
- The use of "SAI RENAISSANCE" amounted to **trademark infringement**.
- The appeal was **allowed**, and the **Trial Court's injunction was restored**, restraining the respondents from using the mark "RENAISSANCE".

Key Legal Principle

When an identical trademark is used for identical goods or services, the law presumes likelihood of confusion, and no proof of actual confusion or damage is required.



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