

Brands in the Boardroom 2009

Protection of translations and transliterations in India

Remfry & Sagar

Part of The IP Media Group



A supplement to *Intellectual Asset Management* magazine
www.iam-magazine.com

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India is a polyglot nation, which can create tricky brand management issues. The variety of languages and scripts, and the fact that one word can have several synonyms in another language, can heighten the risk of infringement and passing off

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“What’s in a name? That which we call a rose/By any other name would smell as sweet.” While William Shakespeare’s immortal words have been cited in many contexts, intellectual property would appear to be one of the more unusual ones. However, this quote serves as an interesting starting point for a discussion of trademark law and practice in India.

India is a linguistically rich nation. Thirty-three different languages and 2,000 dialects have been identified; some of these are accepted nationally while others are typical of a particular region. Further, most languages have corresponding distinct scripts. If the words “languages” and “dialects” are used interchangeably, then according to the census statistics of 2001, 29 languages have more than 1 million native speakers, 60 more than 100,000 and 122 more than 10,000. The government has accorded 22 of these the status of “official language”. This situation adds an extra dimension to the development of new brands in India, as well as to the identification of potential passing off and infringement by third parties.

Insofar as statutory provisions are concerned, where a mark contains a word or words in scripts other than Hindi or English, the application form must contain an endorsement stating the language to

which the word belongs, as well as a “sufficient transliteration and translation to the satisfaction of the Registrar” of each such word in English or Hindi. However, no separate database of translations/transliterations is maintained to facilitate easy identification of similar marks when conducting a search to ascertain prior statutory rights. Conflicting rights are usually detected only when two brands clash in the market.

Descriptiveness

At the examination stage, the basic principle when evaluating a mark is to determine the idea which it intends to convey – if the English/Hindi equivalent would be deemed descriptive, the chances are that the mark in question will face a similar objection. However, the descriptive character of a mark may be mitigated somewhat if the language/dialect is known only to a small minority.

Deceptive similarity

On the issue of deceptive similarity between marks in different languages which convey the same idea, a number of cases clearly outline the Indian position.

One of the first decisions on this subject was issued in the *Falaxar* case (*JC Eno v Vishnu Chemical Co*, AIR 1941 Bom 3). Plaintiff JC Eno Ltd’s effervescent saline was well known in India and was commonly asked for as “fruit salt”. The defendant began selling a similar preparation under the Marathi name *Falaxar*. As the words “fruit salt” had become distinctive of the plaintiff’s product, and in the Marathi language the words *fala* and *kshar* are commonly used as meaning “fruit” and “salt” respectively and in combination would mean “fruit salt”, the court decided the passing off action in favour of the

plaintiff. It held that the plaintiff had, through use, acquired an exclusive right to use the word “fruit salt” for its product; that those words constituted a distinctive mark; and that no one had a right to use those words in any language in India in connection with similar goods. In its ruling, the court remarked that many people in India speak both English and a different vernacular language. But even for those people who do not speak English, if a trader were permitted to use in that language words which had, through long use, become associated with the goods of another trader in another language, this would allow unscrupulous dealers to mislead and deceive individuals who speak only one language.

In a subsequent case (*TG Balaji Chettiar v Hindustan Lever Ltd*, AIR 1967 Mad 148), TG Balaji Chettiar, a manufacturer and seller of soaps, filed three applications for registration of a trademark containing the Tamil word “*Surian*” together with a sun device, and alleged a long period of use. Hindustan Lever Limited (HLL), which held registrations for the words “Sun” and “Sunlight”, as well as a sun device, had been manufacturing and selling soaps bearing these marks for more than six decades. Its products had come to occupy a pre-eminent position on the market and were advertised all over the country in various media, in approximately 12 languages. HLL argued that the Tamil word “*Surian*” was a translation of the word “sun” and was therefore deceptively similar to its mark. It contended that if a purchaser were conversant only in Tamil, he would refer to and ask for HLL’s soap by the name “sun” and in all likelihood would be given Chettiar’s soap and not the Sunlight soap he intended to buy. A supplementary factor was that HLL’s soaps were low priced, and its market was thus largely comprised of people who might not speak English and might also be unfamiliar with the Tamil script. In this instance, evidence of actual confusion between the two marks was also furnished. Further, Chettiar was unable to supplement his claim of concurrent use and the facts suggested that his use was anything but honest. Unsurprisingly, the court ruled that the use of the word “*Surian*” was deceptively similar to HLL’s marks and was sure to cause confusion.

In the above decision the court referred to the *Golden Fan* case (*In re: Trademark of John Dewhurst & Sons Ltd* (1896) 13 RPC 288), in which the applicants had applied for registration of a label containing the device of three shells on a shield and the Burmese expression “*Shway Latoung Fasai*”, the

equivalent of the English words “Golden fan brand”. The comptroller found that trademarks had already been registered in respect of similar classes of goods containing a fan device, and that one in particular comprised a golden fan device. Accordingly, the applicants’ mark was refused. The comptroller held that it did not matter what the language was or what the hieroglyphics said – if the meaning of the foreign language mark was a mere verbal description of a mark already on the register, it could not be permitted to co-exist. Significantly, the owners of the prior marks had consented to the registration of the Burmese trademark, but such consent was held to be immaterial as the public had no notice thereof. Although the general principle laid down by the court in this case remains valid, the same cannot be said of the issue of consent, as the Trade Marks Act 1999 explicitly states that nothing shall prevent the registration of a trademark where the proprietor of an earlier trademark consents to the registration of the later mark.

The *Peacock* case (*Bhatia Plastics v Peacock Industries Ltd*, AIR 1995 Delhi 144) is another case in point. The plaintiff was the registered proprietor of the word mark MAYUR and had used it in connection with plastic goods for close to two decades. On account of extensive sales and advertising activity during this period, the plaintiff’s goods were widely recognised by the word MAYUR as well as its Punjabi and English equivalents – “*Mayuri*”, “*Mor*” and “*Peacock*”. Accordingly, it sought to restrain the defendants from using “*Peacock*” in respect of plastic goods. The defendants contended that “*Peacock*” was a commonly used trade name; their financial turnover was far greater than the plaintiff’s; the goods did not have common trading channels, as their products were of a superior quality; and their company focused on exports. They also alleged that “*Mayur*” is a Sanskrit word not used in ordinary parlance. The court held that use of the “*Mayur*” mark had occurred prior to use of the “*Peacock*” mark, and that a person cannot use a trademark comprising a word in a different language that nonetheless conveys the same idea as an earlier mark in another language. Thus, “*Peacock*” was held to be deceptively similar to MAYUR.

In *Surya Roshni Limited v Electronic Sound Components Co* AIR 1995 Delhi 92, the plaintiff was a prior user of the well-known SURYA mark in respect of electronic chokes and filed an application to enjoin the respondent from using the mark “*Bhaskar*”

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together with a sun device for the same goods. In its defence, the respondent alleged that although the word “*bhaskar*” was a translation of “*Surya*”, meaning “sun”, the word also had many other meanings. However, the court enjoined the defendant and held that since one of the meanings of the word “*bhaskar*” is “sun”, the word mark, coupled with a sun device, was likely to cause confusion and deception with the plaintiff’s trademark.

However, all these decisions concerned competing trademarks used for similar goods. When it comes to dissimilar goods, the courts are likely to take a more lenient view – unless of course, the mark in question is well known.

Trademarks in foreign languages

Insofar as descriptiveness is concerned, the position is largely the same for foreign-language trademarks. If the mark is the name of the goods or describes the services in another language (eg, GELATO for ice-cream or RISTORANTE for a café), and is thus likely to be required for use by other traders, it will be rejected. However, if the language is not well known in India and the reference is more covert (eg, ATTRAYANT (“attractive” in French) for a clothing chain), the mark is more likely to go through. In making any such assessment, the relevant class of consumers is also important – that is, whether the goods or services are for the mass market or a niche group. For instance, if the words “EXCELLENT BAKES” are translated into German and used for mass-marketed cookies, they are unlikely to be understood by the Indian public, who will make a selection based on the visual and phonetic rendering of the words and not based on their meaning. However, if “BEST STAY” is translated into Japanese and used in connection with hotels specifically

catering to Japanese tourists, the mark will be rejected. Another factor which must be kept in mind is that the trademark for which registration is sought should have no negative connotations in India.

The same considerations will apply in respect of third-party rights and decisions will follow established precedents.

On this point, it is pertinent to contrast the situation in India with the Chinese and Japanese position. As the Chinese language has thousands of characters, each of which has its own meaning and pronunciation, it is impossible to transcribe exactly the sound of a foreign word. Similar issues exist in Japan, as the Japanese language uses three scripts (one which it shares with Chinese and Korean, with the result that a word has a different Chinese and Japanese reading), allowing for a word to be written in three different ways. However, in the Indian context, since English is an official language, the transcription of foreign trademarks is not an issue in most cases.

Internationalised domain names

English is the predominant language used online – so much so that the coding standard used in order to interchange information on the Internet, ASCII, works only when the information is expressed in English. As a result, until recently most URLs were in English. However, as the number of non-English speaking internet users has increased, the need to access web pages in other languages has also grown. As a consequence, internationalised domain names (IDNs) have been introduced which allow for registration of domain names in non-English languages.

In most jurisdictions, including India, domain names are treated on a par with trademarks, as they can indicate to internet users the source or origin of the web page.

Hence, domain names in India are governed by the legal norms applicable to trademarks, and by extension, the court decisions on translation and transliteration of trademarks will apply equally to domain names. In this regard it is pertinent to mention the decision in *Satyam Infoway Ltd v Siffynet Solutions (P) Ltd* (2004) 28 PTC 566, where Satyam registered several domain names that were variations of the term “sify” (eg, sify.net, sifymall.com) and contended that confusion was unlikely to occur with respect to the domain names as the parties operated in different fields. Dismissing this argument and taking a strict approach, the court observed that “a domain name is accessible by all internet users and the need to maintain an exclusive symbol for such access is crucial”. In light of the above, a much stricter approach in cases of domain name infringement can be expected, which would automatically extend to translations and transliterations of domain names.

However, the introduction of IDNs is likely to complicate matters somewhat with respect to the translation and transliteration of trademarks, on account of the sheer variety of languages and scripts, and the

fact that one word has several synonyms in another language. Further, many scripts resemble each other - such as Tamil and Malayalam - making for close variants of the same word in different languages, which can be easily exploited by miscreants. Thus, a protection model must be developed to ensure that the various permutations of a trademark as an IDN are either registered by the same party or barred from registration by unrelated third parties. It must be borne in mind, however, that in addition to being a polyglot country, India has a population divided into many different educational and income strata. Thus, the need for accessibility may mitigate against the considerations of stringent domain name protection, especially when catering to the semi-literate and illiterate population, where the need for accessibility may be profound.

Against this backdrop, the impact of the introduction of IDNs on trademark infringement and passing off proceedings remains to be seen.

To conclude, what may appear on the face of it a case of “much ado about nothing” is, upon closer inspection, anything but. **iam**



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