
CONCEPTUAL SIMILARITY IN TRADEMARKS: THE CLASH OF IDEAS AND IDENTITIES

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ABSTRACT

Conceptual similarity has emerged as an increasingly significant criterion in trademark infringement disputes, expanding the traditional framework of visual and phonetic comparison. Indian courts have, in certain cases, gone beyond conventional assessments to recognize that marks conveying a similar underlying idea may lead to consumer confusion even in the absence of strong visual or phonetic resemblance. At the same time, judicial opinion remains divided, with other decisions emphasizing that conceptual similarity cannot be examined in isolation and must be assessed alongside overall visual and phonetic impressions. This divergence has resulted in uncertainty in the application of conceptual similarity, largely due to its inherently subjective nature and the absence of standardized tests for determining whether marks convey the same conceptual idea. The paper critically examines Indian and international jurisprudence on conceptual similarity, highlighting the evolving judicial approaches and the challenges posed by subjective consumer perception. It further proposes the development of structured assessment criteria and guiding standards to enhance consistency, predictability, and clarity in trademark protection, thereby strengthening the balance between brand protection and fair competition.

Key Words: - Trademark Infringement, Conceptual Similarity, Consumer Confusion, Judicial Interpretation, Brand Protection

I. Introduction

What happens in a case where a consumer buys a product, mistaking it to be of a well-known brand? Does it not infringe on the rights of the consumer? Does it not confuse the consumers of that brand and fails to protect the proprietary rights of that entity? This concept has been put forth under Section 2(1)(h) of the Trade Marks Act, 1999, as “deceptive similarity.” Deceptive similarity can be construed as the similarity between the trademarks, which is likely to create confusion or deceive the common consumer from the mark in question with the registered or renowned trademark. Section 11 of the Trademark Act, 1999, states that if a trademark is not registered because of it being deceptive or identical, there is a likelihood that it will create confusion in the mind of the consumer. This principle has been reiterated on several occasions that confusion in the minds of the consumers regarding similar trademarks is enough to declare that a mark is deceptively similar.¹ But the factors that are likely to create confusion are very subjective and its determination is still unequivocal and open-ended.

There are numerous factors that are taken into account for determining whether a mark is deceptively similar or not. The most prominent being the visual and phonetic similarity which includes different colour, shapes, sizes, phonetics, font style, etc. Another important determinant to whether a trademark is deceptively similar or not is the conceptual similarity. Conceptual similarity refers to the likeness or similarity of the ideas or concepts conveyed by two distinct trademarks. But there is no such specific mechanism where it can be decided whether marks are semantically similar or not; however the courts have laid emerging guidelines as more players are entering this market.

II. The Indian take on conceptual similarity

The idea of conceptual similarity has been evolving gradually since *Corn Products Refining v. Shangrila Food Products, 1960*², where for the first time the Apex Court, while deciding deceptive similarity addressed that deceptive similarity could arise not only from visual and phonetic similarity but also from the ideas they convey. The court in this case went beyond the conventional assessments and introduced conceptual similarity as an important criterion for deciding deceptive similarity. But contrastingly in the case of *Metis Learning Solutions Private*

¹Montblanc Simplo-GMBH V. New Delhi Stationery Mart, 2008(38) PTC 59.

²Corn Products Refining v. Shangrila Food Products, AIR 1960 SC 142.

*Limited v. Flipkart India Private Limited and Ors.*³the court held that the conceptual similarity cannot be taken into account in isolation and that the overall phonetic and visual similarity should be taken altogether.

Although the idea of conceptual similarity has increased the scope of trademark protection, its application is largely uncertain due to the lack of tests for determination of marks whether they purport the same idea or not and hence is highly subjective. Unlike the phonetic and visual similarity the conceptual similarity depends on the subjective consumer perception. For this purpose the courts have developed deciding factors to assess conceptual similarity in trademark disputes. In *Shree Nath Heritage Liquor Case*⁴,the court outlined the key considerations such as:

- i) There are cases wherein the trademarks differ visually or phonetically but still a shared conceptual meaning can cause confusion.*
- ii) Likelihood of confusion in the perception of the consumer because of linking it with similar ideas.*
- iii) Conceptual similarity can still cause confusion even if there is a packaging difference.*
- iv) False memory can also lead to confusion as the consumer often remembers the concept but tends to forget the exact details of the product.*
- v) Intentionally adopting a mark especially when the marks share similar ideas and the prior mark is in the market is explicitly a case of intentional infringement.*

The court recognizes the issue of conceptual similarity as an intricate and highly subjective one as it makes it challenging for both brand owners and the judiciary. However, the courts are making concerted efforts to incorporate foundational factors on which marks can be construed as conceptually similar.

III. THE GLOBAL OUTLOOK ON CONCEPTUAL SIMILARITY

The issue of conceptual similarity in trademark conflict is a complex one and it has been recognised in international legal forums. Although there is no universally accepted framework in determining conceptual similarity in trademark infringement cases, courts employ various

³Metis Learning Solutions Private Limited v. Flipkart India Private Limited and Ors., CS (COMM) 393/2022.

⁴Shree Nath Heritage Liquor Pvt. Ltd. v. Allied Blender & Distillers Pvt. Ltd, (2015) 63 PTC 551.

approaches to determine the likelihood of confusion including similarity between goods and services. When determining whether two marks are similar, the courts assess three key factors: phonetic, visual and conceptual similarity. The European General Court further clarified this issue in the case of *Ice Mountain Ibiza, SL v/s Office of EUIPO*⁵ the court emphasised that conceptual similarity should not be restricted solely to *figurative elements* of a mark; instead all aspects of a trademark must be considered holistically to determine whether it is likely to cause confusion among consumers.

In a ruling by the Court of Justice of the European Union (CJEU) pertaining to the dispute between PASH and BASS, an important precedent was laid down. It was held that conceptual difference can counteract the visual and phonetic similarities of the signs that are being compared. Such a counteraction would take place when at least one of the marks have a “*clear and specific*” meaning attached to it so that the consumers and the public are capable of recognizing it immediately.

Again in *Inditex v. EUIPO*⁶ a similar debate arose between the globally recognized fashion brand ZARA and the Italian pasta manufacturer Ffauf Italia, which registered their mark as LE DELIZIE ZARA for different classes of goods and services, some of them having conceptual resemblance with ZARA. The food brand argued that Zara was solely associated with clothing retail and that there was a substantial difference between the two brands. The EU General Court ruled aligning it with the previous landmark judgments that conceptual resemblance combined with similar goods and consumer perception can still justify the refusal of trademark registration.

Foreign courts are increasingly recognizing the significance of conceptual similarity in trademark disputes. While phonetic and visual similarities are important factors, courts have also emphasized that strong conceptual similarity or dissimilarity can also become an important factor. In *Chefaro Ireland Case*⁷, the general court emphasized the importance of conceptual similarity in trademark disputes. It was held that the signs in question were not conceptually similar, and this factor alone significantly reduced the likelihood of confusion. The evolving jurisprudence highlights the growing importance of the conceptual distinction in trademark law,

⁵Ice Mountain Ibiza, SL v. Office of EUIPO, C-412/16 P, 2017.

⁶Inditex v. EUIPO, T-467/20, 2021.

⁷Chefaro IrelandDAC v/s European Union Intellectual Property Office (EUIPO), T-788/16, 2018.

reinforcing the need for a comprehensive assessment of trademarks beyond their visual and phonetic similarities.

IV. THE ROADMAP FOR CLARITY IN TRADEMARK PROTECTION STANDARDS

Given the challenges, it becomes essential to explore ways to enhance clarity and consistency while enforcing conceptual similarity in trademark laws. The absence of the foundation and the metrics for determination of these marks often leads to ambiguity both during the registration of marks and adjudication of such infringements. While courts have established some guiding principles, however, a structured legal mechanism must be introduced for proper assessment of the marks.

The initial step towards solving this problem under intellectual property law is to create a standard test to measure conceptual similarity between marks. What can be created then is a flexible system of suggestive standards to provide focus and organization to this problem. Such a framework would act as a decision-making guideline in such cases while permitting flexibility in various situations. However, making this approach more concrete, legislation and formal codification must be reinforced to ensure consistency in trademark disputes. By the employment of duly stated statutory criteria, not only unnecessary litigations will be avoided but legal predictability and certainty will also increase. Additionally, by the operation of an index-based approach, the assessment of the marks will become better. It will rank words and signs in terms of semantic similarities with a predisposed tendency to the possibility of uncertain behaviour by the consumers. Lastly, the database created as a result will help make the registration process easy and hassle free for the business owners.

V. CONCLUSION

A trademark is a symbolic identity of an idea, goods, or services that reflects its distinctiveness from other ideas, goods, or services. It is just like a secret recipe of the chef who chooses the best and unique ingredients to make it taste better and memorable. However, if this recipe is stolen by another competitor in the market by deceiving the consumers, the idea and creator's identity are thinned out. Therefore, to preserve the distinctiveness of the creator's idea and to allow free and fair competition, the trademark law shall incorporate a well-defined mechanism for deducing semantic similarity, which not only helps business proprietors to register their trademarks easily

and with more clarity but also avoids unnecessary litigations. Additionally, it also helps the courts to assess whether the marks have the probability to create the likelihood of confusion in the minds of the consumers, thus making the adjudication more effective.