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Juxtaposing Trademark Rights and Personal Identity: Exploring the Indian Legal Framework of Personal Name Usage in Commerce

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This research paper seeks to study the legal complexities surrounding the use of personal names or surnames under the Trademark Act 1999, particularly in light of recent findings such as the Delhi High Court's determination that persons cannot be barred from using their names owing to trademark breaches. The paper looks into the history of trademark law, the growth of personal identification rights, and how these ideas overlap in contemporary legal systems. The article will evaluate the balance between preserving intellectual property rights and defending individual autonomy and identity using a detailed study of relevant case law, and laws. Furthermore, the paper will analyze the potential consequences of such verdicts on trademark acts and analyse the trend of these verdicts, including issues encountered by corporations, legal concerns for people, and the larger societal consequences of personal name usage in the field of commerce.

Keywords: *intellectual property, trademark, name, personal identity.*

INTRODUCTION

Trademarks are often used by businesses and consumers to differentiate goods and services in the realm of intellectual property rights. It also increases customer trust and brand loyalty. Traditionally, trademarks included pictures, symbols, slogans, colours, etc. However, as commerce expanded and developed, the complexities rose, as did the scope of trademarks, which also encompassed names. This breakthrough raised legal problems about the convergence of trademark and personal identification rights

While businesses want to protect their identity, build consumer trust, and avoid trademark confusion, and individuals assert their fundamental right to use their name for professional purposes, the main issue is balancing intellectual property rights and individual rights. These conflicts of interest produce legal disputes, indicating a need for balance.

The recent Delhi High Court decision in the case of *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr.*¹, in which the court upheld individual rights by allowing individuals to use their Names. This significant decision highlights the evolving law governing personal name usage in commerce, underlining the need for a comprehensive legal framework that balances competing interests that do not have adverse effects on each other.

Trademark Act 1999

Until 1940, there was no statute law controlling trademarks in India, hence the appropriate law was common law. With globalization came the need to protect and create an identity. Marks, slogans, symbols, brand names, trademarks, and so on became the tool for identification, which eventually called for new and revised rules to protect the unique identity of the businesses. The Indian Trade and Merchandise Marks Act, 1958² was reviewed and amended because it did not comply with the Trade-Related Aspects of Intellectual Property Rights, 1994³; the revised act was

¹ *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr* Case No 679/2023

² Indian Trade and Merchandise Marks Act 1958

³ Trade-Related Aspects of Intellectual Property Rights 1994

amended in 1999 as the Trademark Act⁴ which replaced the former in 2003. Section 2(1)(m)⁵ of the Act defines a mark as a device, mark, heading, label, ticket, name, signature, word, letter, numeral, product shape, packaging, colour combination, or any combination therein. According to Section 2(1)(zb)⁶ of the Act, trademarks must be:

- Marks as defined in Section 2(1)(m)⁷. It can be registered as a trademark if certain extra conditions are met which are mentioned below:
 1. The mark should have the capability to be presented graphically, those marks failing to be presented graphically are not provided trademark registration
 2. Marks should have distinguishing qualities either structural, aesthetic, or linguistic features.

A trademark is an intangible asset that has to be protected. This legislation provides for the registration of marks; however, registration is not compulsory by law, although it is recommended that registered trademarks be provided with more protection. Trademarks once registered are valid for 10 years and can be renewed indefinitely with periodic payments on their expiry.

According to Section 2(1)(zb) of the Trademark Act 1999⁸, the purpose of the trademark was to provide a business with a personal and distinctive identity while also protecting the firm from other businesses that imitate and benefit from their identity. The fundamental difficulty arises when these trademarks conflict with personal identity rights, which are against the monopoly of names and surnames.

Section 35 of Trademark Act, 1999: Section 35 of the trademark act states that ‘Nothing in this Act shall entitle the proprietor or a registered user of a registered trademark to interfere with any bona fide use by a person of his name or that of his place of business, or the name, or the

⁴ Trademark Act 1999

⁵ Trademark Act 1999, s 2(1)(m)

⁶ Trademark Act 1999, s 2(1)(zb)

⁷ Trademark Act 1999, s 2(1)(m)

⁸ Trademark Act 1999, s2(1)(zb)

name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services'⁹. This section initially and even in recent times contributed to a lot of vagueness leading to differences in the interpretation of the section and verdict.

K.G. Khosla Compressors Ltd v Khosla Extraktions Ltd: The term 'Khosla' refers to the plaintiffs. The defendant's name was intentionally chosen to capitalize on the plaintiffs' notoriety by using the 'famous Khosla family of New Delhi' to confuse the consumer. In light of established legislation, it is apparent that a surname that is rarely used is protectable.¹⁰

Dr. Reddy's Laboratories Ltd. v Reddy Pharmaceuticals Limited: Section 34 of the Trade and Merchandise Marks Act, 1958¹¹ was referred to in this case, although the Trademark Act was abolished by the Trade Marks Act of 1999 but Trademark Amendment Act of 1999 came into effect in 2003 and this case was in the trial before the Trademark amendment act 1999 came into effect, which held that the use of surname was not saved by Section 34¹² for an artificial person like incorporated Company. Till August 2003, there was no clash of ideas. The threat arose in August 2003, when the defendant launched its pharmaceutical preparations to the market, threatening the plaintiff company's financial interests. This move of the defendant was mala fide. The defendant's use of the trademark/name 'Reddy' on medicinal preparations is neither concurrent nor honest. The defendant adopted this trademark with the intent to deceive customers.¹³

Anjani Kumar Goenka & Anr v Goenka Institute of Education: The defendant contended that Goenka was a common surname and therefore no monopoly could be claimed on it and also that GOENKA being a part of a trust, college, and pharmacy is to be considered a bona fide use of the common name. The defendant also claimed that other parties were using the Goenka as a part of their name in the same service before the Plaintiff. The plaintiff's submission emphasized

⁹ Trademark Act 1999, s35

¹⁰ *K.G. Khosla Compressors Ltd v Khosla Extraktions Ltd* Case No 416/1895

¹¹ Trade and Merchandise Marks Act 1958, s34

¹² *ibid*

¹³ *Dr. Reddy's Laboratories Ltd. v Reddy Pharmaceuticals Limited* Case No 128/2005

the term 'his name' and suggested that has to mean the full name of the person. The court observed that the defense under section 35 will only apply to full name and also by a natural person not by a legal entity due to which the defendant was given four months to discontinue the use of Goenka.¹⁴

Precious Jewels & Anr v Varun Gems: This was a case relating to Section 35 of the Trademark Act 1999¹⁵. The Plaintiff has a trademark of Rakyan and pleaded with the Delhi High Court to put a restraining order on the defendant to stop using it, The High Court restrained them from using the phrase. Defendants availed the defence of section 35, stating Rakyan was a common surname in the Supreme Court and later the Delhi High Court order was quashed.¹⁶

Both Anjani Kumar Goenka & Anr v Goenka Institute of Education on 24 February 2009 and Precious Jewels & Anr v Varun Gems on 4 August 2014 have similar cases about surnames and the same section that is section 35 was directed yet the interpretation of section different in these judgments.

Mr. Gautam Gambhir v D.A.P & Co. & Anr: The case consisted of Plaintiff Gautam Gambhir, the famous cricketer and defendant whose name too was Gautam Gambhir. The defendant owned several restaurants and pubs where his name appeared as part of a slogan. This generated confusion among individuals, leading them to think of some type of connection with the cricketer Gautam Gambhir. The court found that the defendant did not claim that his business was associated with the player, nor did he post photos of the cricketer anywhere, but rather displayed his pictures. Furthermore, the court noted that no one objected to the registration of the restraint's logos. As a result, the court determined that an interim injunction was not to be issued since the defendant had made use of the cricketer's fame and had legitimate.¹⁷

¹⁴ *Anjani Kumar Goenka & Anr v Goenka Institute of Education* Case No 118/2009

¹⁵ Trademark Act 1999, s 35

¹⁶ *Precious Jewels & Anr v Varun Gems* SLP (C) 9942/2013

¹⁷ *Mr. Gautam Gambhir v D.A.P & Co. & Anr* Case No 395/2017

Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr: In this case, Justice C. Hari Shankar stated that this judgment maintains the legal protection that allows individuals to use their names in business, emphasizing the balance between trademark rights and personal liberty. The court highlighted that any interpretation of Section 35 of the Trade Marks Act that restricts the use of a person's name for their goods would amount to 'reading a non-existent proviso into Section 35 and, in effect, rewriting the provision.'

This declaration by the court emphasizes the absolute character of the proscription under Section 35, which applies to both infringing and passing off activities, confirming an individual's right to use their name in business, regardless of trademark claims.

The issue in dispute addressed the trademark registration of the common name or surname 'JINDAL'. The court noticed. This declaration by the court emphasizes the absolute character of the proscription under Section 35, which applies to both infringing and passing off activities, confirming an individual's right to use their name in business, regardless of trademark claim. 'It is open to anyone, and everyone, to use his name on his goods, and, therefore, the possibility of there being several 'JINDAL's looms large.'¹⁸

Importance of this Judgment: *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr.*¹⁹ Provided certain clarity and pattern that was missing in earlier judgments which led to different verdicts on similar issues. This judgment empowered section 35. The plaintiff presented Section 29(1)²⁰, which defines infringement as the use of an identical trademark by the defendant 'as a trademark'. Surnames are not an exception. A surname is also a 'mark'. Regardless of Section 29(1)²¹, Section 35 is a non-observant clause, indicating that its provision rules over other incongruous provisions of other sections of any act. This means that it advocates the right to use an individual's name is explicitly protected under section 35, irrespective of other provisions in an act.

¹⁸ *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr* Case No 679/2023

¹⁹ *Ibid*

²⁰ Trademark Act 1999, s 29(1)

²¹ *Ibid*

The judgment also highlighted the protection rendered under section 35 is not dependent on the existence of family ties. The protection of section 35 is lost only when the disputed mark causes actual confusion rather than speculation of confusion among consumers. Due to this the unique identity of the business is also protected and individual identity rights are granted. This Judgment places a higher burden of proof on Plaintiff who is alleging infringement.

ANALYSIS OF SECTION 35 OF THE TRADEMARK ACT 1999

The key argument of the section is Bona fide as almost all the above-mentioned cases have dwelled around and given importance to this point, but at times the judgment does not have a standard interpretation leading to different verdicts.

In *K.G. Khosla Compressors Ltd v Khosla Extractions Ltd*²² rare surnames such as Khosla were protected, while popular surnames were not. So, the trademark was dependent on the popularity of the name/surname which could be witnessed by the phrase ‘famous Khosla family of New Delhi’.

In *Dr Reddy's Laboratories Ltd. v Reddy Pharmaceuticals Limited*²³ wherein the major contention was the male fide intention of Reddy Pharmaceuticals Limited to benefit out of the goodwill of Dr Reddy’s Laboratories Ltd. by confusing the customers.

In *Anjani Kumar Goenka & Anr v Goenka Institute of Education*²⁴, the court observed that section 35²⁵ would only apply to full names and that too only by a natural person, not by a legal entity; Bona fide intentions were not taken into consideration as it didn’t fulfil the first clause itself.

In *Precious Jewels & Anr v Varun Gems*²⁶, the Delhi High Court order was quashed when the defendant appealed for Section 35²⁷, by giving the reason that they shared a common surname.

²² *K.G.Khosla Compressors Ltd v Khosla Extraktions Ltd* Case No 416/1895

²³ *Reddy' S Laboratories Ltd. v Reddy Pharmaceuticals Limited* Case No 128/2005

²⁴ *Anjani Kumar Goenka & Anr v Goenka Institute of Education* Case No 118/2009

²⁵ Trademark Act 1999, s 35

²⁶ *Precious Jewels & Anr v Varun Gems* SLP (C) 9942/2013

²⁷ Trademark Act 1999, s 35

Here the Supreme Court did not interpret the section like the previous one, which means the court thought that section 35²⁸ applied to surnames as well.

In *Mr. Gautam Gambhir v D.A.P & Co. & Anr.*²⁹ The main contention was bona fide, where in court recognized that an individual can use their name for their business provided that they did not confuse the consumer and pretend to be someone they are not.

In *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr*³⁰ court addressed that a common surname cannot be a violation of the Trademark Act,1999 due to mere speculation of potential confusion in customers.

Through these cases, which are taken from different periods it can be analyzed that even though there was a difference in interpretation of section 35³¹ eventually with advancement and increasing awareness about personal identity rights the interpretation of the same has become rather standardized and homogenous.

Should Surnames/Names be Marks? According to Section 2(1)(m) of the Trademark Act³², the name is considered a mark and Section 29(1)³³, defines infringement as the use of an identical trademark by the defendant 'as a trademark'. Surnames/names are not an exception therefore surname/name is also a 'mark'. So, to protect individual identity rights section 35³⁴ consists of a non-obstante clause that is evident from the use of absolute words which is, 'Nothing in this Act' indicating that its provision overrules other provisions of this act, as long as the proprietor has bona fide intention.

This act is ideal if interpreted in a balanced way for the following reasons:

²⁸ *Ibid*

²⁹ *Mr. Gautam Gambhir v D.A.P & Co. & Anr* Case No 395/2017

³⁰ *Jindal Industries Private Limited v Suncity Sheets Private Limited and Anr* Case No 679/2023

³¹ Trademark Act 1999, s 35

³² Trademark Act 1999, s 2(1)(m)

³³ Trademark Act 1999, s 29(1)(20)

³⁴ Trademark Act 1999, s 35

- due to the presence of Section 29(1)³⁵ names/surnames are considered trademarks that is, it provides a scope for a business to build consumer trust and brand loyalty but
- due to the presence of Section 35³⁶, the act also doesn't give the monopoly of a name/surname to a particular business which safeguards individual identity rights but if a business under the shade of Article 35 tries to confuse the consumers and benefit out of other business's goodwill, the protection of section 35 is lost due to absence of bona fide intentions.

This provides the required equilibrium in Trademark and Personal identity Rights.

SUGGESTION

The analysis provides useful insights into the interpretation and use of Section 35 of the Trademark Act of 1999, notably in the context of surnames and names as marks. However, to increase the depth and breadth of the conversation, various proposals might be made:

First, it would be good to delve more into the legal subtleties and complexity underlying the idea of bona fide intents concerning trademark protection. A more thorough approach would involve delving into case law and legal precedents that have affected our understanding of bona fide intentions in trademark disputes.

Additionally, given the changing nature of business operations and the growing relevance of personal identification rights, it is appropriate to analyze current trends and advances in trademark law. This might entail looking at previous decisions or legislative developments that have altered the interpretation and execution of Section 35.

Furthermore, the recommendation may entail broadening the conversation to include comparative evaluations of trademark laws and practices in other countries. Exploring how other nations approach the protection of surnames and names as marks may provide useful insights and contribute to a more sophisticated view of the subject.

³⁵ Trademark Act 1999, s 29(1)(20)

³⁶ Trademark Act 1999, s 35

Moreover, it would be useful to analyze the practical consequences of various interpretations of Section 35 for enterprises, customers, and society as a whole. This might include discussions on the influence on market competition, consumer choice, and the balance between trademark protection and individual identity rights.

Finally, offering guidance to politicians, corporations, and legal practitioners on how to manage the complexity of Section 35 and ensure a balanced approach to trademark protection and personal identification rights would be valuable. This might involve putting up standards for detecting genuine intents, lobbying for clearer legal frameworks, or promoting alternative conflict resolution.

CONCLUSION

In a day and age where the world is developing and progressing at a fast pace, complexity and intricacy in every field increase and therefore a multifaceted approach is required. When it comes to the expansion of commerce the complexities of the legal domain of commerce have increased as well. When it comes to Trademark Act 1999 or rather Juxtaposing Trademark Rights and Personal Identity, Section 35 and Section 29(1)20 provide the equilibrium that is required, absence of this section could lead to the monopoly of Names and Surnames which would lead to violation of personal identity rights or fooling of consumers by pretending to be other business and profiting out of their business, which would eventually lead to loss of the other business both in terms of money and consumer trust. Every business wants to have a unique identity to stand out from the rest but this should not compromise personal identification right. To find a balance that protects and provides opportunities to a business for their further growth and unique identification while providing personal identity rights is what is required in the present-day scenario.