

**SKYBAGS V. SKOBAGS: A CRITICAL AND COMPARATIVE ANALYSIS OF THE
REGISTRAR'S APPROVAL OF 'SKOBAGS'**

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ABSTRACT

The primary aim of trademark law is to act as source identification, prevent consumer confusion caused by deceptive similar marks and safeguard the rights of the proprietor. However, a departure from this principle was observed when the mark “Skobags” was recently accepted by the Indian Trade Marks Registry. Skobags, with a strikingly similar trademark to “Skybags” was accepted under the identical class for identical goods and services. The acceptance of Skobags raises multiple questions as both marks have the same class of goods, similar logo fonts, and similar name structures. This paper aims to critique the decision of the Registrar while comparing it with other jurisdictions and a need for amendment in Section 11. In Part I, the paper delves into the concept of deceptive similarity and the initial interest confusion test. Further, in Part II, the paper critically analyses the Registrar’s approval of the “Skobags” mark despite the long-standing existence of “Skybags” for over 3 years. It does so on grounds of phonetic and visual similarity, comparison of goods and consumer bases, and procedural lapses. Part III compares the concept of deceptive similarity in South Asian Countries like Taiwan, Japan and Singapore with India and examines the importance of protecting brand identity in trademark law. These jurisdictions have been selected due to the higher prevalence of counterfeit luxury goods in these regions. It further suggests an amendment to Section 11 to include phonetic similarity, whereby marks that are phonetically similar despite lacking visual similarity or overlap in goods or services would be subjected to stricter scrutiny in trademark registration processes, while reinforcing the need for comprehensive evaluations.

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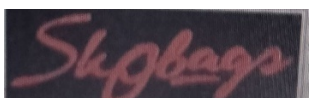
I. INTRODUCTION

In recent years, there has been debate regarding the inconsistent application of Section 11 of the Trade Marks Act, 1999 [**“the Act”**] by the Registry.¹ Marks that meet the requirements of deceptive similarity are still being accepted by the Registry, which may be attributed either to the Registry’s leniency or oversight. The acceptance of such a mark challenges the fundamental principles of trademark law which are to ensure source identification and protect the consumer from potential confusion. Recently, the mark “Skobags” was accepted and advertised in the Indian Trade Marks Journal.² In the examination report, objections were raised under Section 11(1) of the Act by the Registry for the mark to be similar to the registered trademark “Skybags.”³ The objection was countered by stating that the Skobags mark is phonetically and visually different from the cited mark and that the goods used are entirely different from those associated with Skybags and have different trade channels.

However, the acceptance of Skobags raises multiple concerns as both marks share a similar name structure, fall under the same class of goods (travelling bags, backpacks, etc), and feature similar logo fonts. Notably, in the device representation of the mark, the letter ‘o’ in Skobags appears deliberately stylised to resemble ‘y’ in Skybags. Both marks appear to be phonetically and visually similar or to be precise, “virtually identical.” The decision is not an isolated oversight but rather another chapter in a series of Registry actions that weaken trademark protection.

This paper analyses the Registrar’s decision to allow the registration of a deceptively similar trademark, examines the relevant jurisprudence, explores the position in foreign jurisdictions and proposes a legislative amendment to Section 11 of the Act.

Table A: Details of the Rival Trademarks

Trademark	Registration No.	Class	Date of filing
	425700	18	13/08/1984
	5481437	18	09/06/2022

¹ The Trade Marks Act, 1999, § 11, No. 47, Acts of Parliament, 1999.

² Trademark Application No. 5481437 (Trade Marks Registry, India).

³ Trademark Application No. 425700 (Trade Marks Registry, India).

II. DECEPTIVE SIMILARITY AND TRADEMARK CONFUSION

Section 2(h) of the Act defines a deceptively similar mark as one that is likely to mislead or confuse an average consumer with imperfect recollection, causing them to associate it with an already registered or well-known trademark.⁴ At the examination stage, under Section 11 of the Act, the registrar may refuse registration if the application falls within the scope of Section 11(1).⁵

Table B: Trademark Tussle Matrix under Section 11

Scenario	Trademark Status	Law	Case Law
Twin Trouble	Identical trade mark + similar goods/ services	Refused under Section 11(1)(a)	Yahoo.com v. Yahooindia.com: identical marks and similar internet services; the latter was set aside. ⁶
Look-alike confusion	Similar trade mark+ Identical or similar goods and services	Refused under Section 11(1)(b)	Lakme v. Like me: similar marks and services led to refusal of registration. ⁷
Absolute Clash	Identical mark + Identical goods/ services	Refused under Section 11(1)	Chotiwalla (Rishikesh) v. Chotiwalla (Delhi); identical marks and services led to refusal of registration. ⁸
Well known trademark	Identical or similar mark+ Dissimilar goods/services	Refused under Section 11(2)	Maaza (bisleri) v. Maaza(Coca-Cola): the well-known Coca-Cola mark was <u>protected</u> , despite dissimilar goods. ⁹

In the present case, conditions under Section 11(1)(b) of the Act are satisfied, as Skybags and Skobags have similar trademarks registered under the same class for identical goods.¹⁰ This

⁴ Subway Ip Llc v. Infinity Food, (2023) 1 HCC (Del) 84.

⁵ *Supra* note 3.

⁶ Yahoo! Inc. v. Akash Arora & Anr., 78 (1999) DLT 285.

⁷ M/s Lakme Ltd. v. M/s Subhash Trading and Ors., 1996 PTC (16) 567.

⁸ Chotiwalla Food and Hotels Private Ltd. v. Chotiwalla and Others, 2025 SCC OnLine Del 1354.

⁹ The Coca-Cola Company v. Bisleri International Pvt. Ltd., 2009 SCC OnLine Del 3275.

¹⁰ The Trade Marks Act, 1999, § 11(1)(b), No. 47, Acts of Parliament, 1999.

creates a high likelihood of consumer confusion.¹¹ The acceptance of Skobags appears to have been made in bad faith, likely intended to capitalise on the reputation and goodwill of the well-established brand Skybags.¹² Consequently, the case squarely falls within the definition of deceptive similarity as per Section 2(h) of the Trademarks Act, 1999.¹³

This interpretation is further reinforced by a recent decision, *Chotiwalla Food and Hotels v. Chotiwalla and Others* where the Plaintiff had been using the mark for over 65 years, making it a well-known trademark.¹⁴ Several Restaurants in Delhi were unauthorisedly using the name “Chotiwalla” as “Chotiwalla Pandit”, “Chotiwalla Parantha”, etc and creating confusion among consumers who were complaining about the substandard food. The Court granted a permanent injunction to the plaintiff, stating that the Defendants adopted the trademark to mislead the consumers and benefit from the reputation of the plaintiff. The rationale strongly parallels the present case involving Skybags, where the only notable difference lies in the substitution of ‘y’ with a stylised ‘o’ in Skobags. This again reinforces the concept of deceptive similarity and bad-faith imitation. Both these cases illustrate attempts to exploit the established reputation of renowned brands through minor alterations that retain the overall impression of the original mark.

Further analysis of the Skobags case reveals that it may fall under the doctrine of initial interest confusion. This doctrine holds that even temporary confusion caused by a look-alike product constitutes infringement, regardless of whether the confusion is resolved at the point of purchase.¹⁵ In the present case, even if consumers ultimately realise that the product is Skobags and not Skybags, the initial attraction can cause confusion and harm the reputation of Skybags. This rationale is resonated by the case of *Under Armour v. Anish Agarwal* whereby the court granted an injunction to “Under Armour” against an Indian Company using the mark “Aero Armour” holding that even momentary confusion amounts to trademark infringement.¹⁶ The Court applied the initial interest confusion test stating that pre-purchase, regardless of duration confusion is sufficient to infringe a global brand.¹⁷

¹¹ Thomas R. Lee, Glenn L. Christensen, Trademarks, Consumer Psychology and the Sophisticated Consumer, 57 EMORY L.J. 575, 580 (2008).

¹² NR Dongre v. Whirlpool Corporation, (1996) 5 SCC 714 (India).

¹³ The Trade Marks Act 1999, § 2(h), No. 47, Acts of Parliament, 1999.

¹⁴ Chotiwalla Food and Hotels Private Ltd. v. Chotiwalla and Others, 2025 SCC OnLine Del 1354.

¹⁵ Warner Bros. Entertainment Inc. v. Harinder Kohli & Ors., 2008 SCC OnLine Del 1081.

¹⁶ Under Armour v. Anish Agarwal, 2025 SCC OnLine Del 3784.

¹⁷ *Id.*

III. ANALYSIS OF THE DECISION

The Skybags and Skobags share significant visual and phonetic similarities. According to Section 11 of the Act,¹⁸ registration must be refused if the applied mark is identical with or similar to an already existing trademark and the goods or services are also identical or similar which can cause a likelihood of confusion to the public or association with an already existing trademark.¹⁹ In the instant case, it appears that there are visual and phonetic similarities between the two rival marks and considering that an average consumer forms an impression based on overall look and sound,²⁰ this kind of similarity is likely to cause confusion and association between the marks.²¹ This confusion is further aggravated by the fact that Skobags has applied for registration in a similar class of goods and services. The similarity between the two marks could suggest the intention to benefit from the goodwill of Skybags.²² However, the Trade Marks examiner appears to have overlooked such a possibility in the examination process.

Furthermore, the acceptance of Skobags by the Registry, despite Skybags being registered under class 18 since 1984 overlooks various judicial precedents with respect to comparison of trademarks from the lens of the likelihood of confusion such as the Parle Products case²³ and the Cadila case.²⁴ These decisions emphasise that a comprehensive assessment must be undertaken when comparing two marks. In *Parle Products*, the Supreme Court emphasised that trademarks must be compared as a whole, and even slight similarities can mislead an average consumer with imperfect recollection. Similarly, in *Cadila Health Care*, the Court laid down detailed factors to determine deceptive similarity, including the nature of the marks, the degree of resemblance, the nature of goods, and the class of purchasers. These principles clearly reinforce that acceptance of *Skobags* disregards established judicial standards in assessing the likelihood of confusion.²⁵ It raises questions as to why the mark was not rejected at the initial stage.

It is the Registry's responsibility to ensure that such marks are not accepted and advertised. Allowing deceptively similar trademarks defeats the very purpose of a legitimate trademark proprietor investing in registration, building brand goodwill and reputation, and paying renewal fees to maintain the registration, only for the Registry to permit a similar mark.

¹⁸ The Trade Marks Act, 1999, § 11(1), No. 47, Acts of Parliament, 1999.

¹⁹ *Rolex SA v. Alex Jewellery*, 2009 SCC OnLine Del 753 (India).

²⁰ *FMI Limited v. Midas Touch Metalloys Pvt. Ltd.*, 2025 SCC OnLine Del 4.

²¹ *Unish Health Checkup and Diagnostics LLP v. Unison Pharmaceuticals Pvt. Ltd.*, C/AO/98/2024.

²² *United Biotech Pvt. Ltd v. Orchid Chemicals & Pharmaceuticals Ltd.*, 2012 SCC OnLine 2942.

²³ *Parle Products Ltd. v. J.P. & Co., Mysore*, (1972) 1 SCC 618 (India).

²⁴ *Cadilla Health Care v. Cadilla Pharmaceuticals Ltd.*, (2001) 5 SCC 73.

²⁵ *S.M. Dychem Ltd. v. Cadbury (India) Ltd.*, (2000) 5 SCC 573.

In this context, trademark protection plays a pivotal role. Section 2(zb) of the Act defines a trademark and only addresses graphical representation and visual similarity but does not consider phonetic similarity.²⁶ There exist brands with different logos but phonetically similar names. In such cases, registration is permitted since the current definition of a trademark encompasses only visual similarity. For instance, Zara and Azra.²⁷ The issue becomes even more nuanced when we deal with highly reputed trademark and word marks that function as source identifiers. For instance, Skybags, although registered as a word mark, also serves as a source identifier by evoking specific associations in the minds of consumers.

A similar concern arises in the Skybags-Skobags dispute. The material problem is not just in the context of product differentiation but also in consumer perception and associative memory. The similar-looking marks may not deceive an expert, but they will most likely impact an average consumer with imperfect recollection.²⁸ No similar name or logo must be adopted to safeguard brand identity, especially when the original mark is well reputed and recognisable.²⁹

IV. COMPARATIVE ANALYSIS

This comparative analysis is between South Asian countries which have well-established trademark jurisprudence and have been consistently dealing with cases of deceptive similarity. By examining these jurisdictions, the intention is to get a broader understanding of how similar cases are dealt in other legal systems, thereby highlighting the need of amendments in the Indian Trade Mark Act. These jurisdictions have been selected due to the higher prevalence of counterfeit luxury goods in these regions.

A. Japan

The deceptive similarity has been defined in Article 4(1)(xi) of the Japanese Trademark law.³⁰ According to the provision trademark registration will be barred if the trademark is identical or similar to a prior registered trademark and used for identical or similar goods or services.³¹ Additionally it is provided that the word “similar” should be interpreted to imply similarity to the degree that it is likely to lead confusion regarding the origin of goods or services.³² Following this,

²⁶ The Trade Marks Act 1999, § 2(zb), No. 47, Acts of Parliament, 1999.

²⁷ *Supra*, note 42.

²⁸ Hamdard National Foundation (India) v. Sadar Laboratories Pvt. Ltd., 2022 SCC OnLine Del 4523.

²⁹ Macleods Pharmaceuticals Ltd., v. Swisskem Healthcare, 2019 SCC OnLine Bom 1186.

³⁰ Trademark Act, Act No. 127 of 1959, art. 4(1)(xi) (Japan).

³¹ Seiwa Patent & Law, *Revision of Japanese Trademark Law (Introduction of Trademark Consent System, etc.)*, Seiwa IP News (Apr. 18, 2024).

https://www.seiwapat.jp/en_ip/.assets/Seiwa_IP_News_EN.240418_Revision_of_Japanese_Trademark_Law.pdf.

³² *Supra*, note 29.

the Japan Patent Office [**JPO**] examines the similarity or dissimilarity between trademarks using detailed guidelines which include degree of similarity, recognition, possibility of business diversification etc.³³ India could benefit from adopting similar manuals. Although a patent manual exists in India, having one for the trademark examination process would help the registry to follow a consistent approach.

The Intellectual Property High Court of Japan [**IPHC**] in one case held that a trademark registration of “GUZZILLA” owned by a Japanese construction machinery component manufacturer, Taguchi Industrial Co. Ltd, could cause confusion with “GODZILLA”, the English name of a renowned Japanese monster movie distributed by Toho Co. Ltd. Accordingly, the IPHC held that “GUZZILLA” was very similar to “Godzilla” and is likely to cause confusion.³⁴

In another instance, JPO examined the similarity between the “COCOCHI” and “COCO”.³⁵ Chanel, the proprietor of the trademark “COCO” opposed the registration of “COCOCHI” on the ground that “COCO” enjoys a high degree of reputation in the cosmetics and related industries and that the impugned mark closely resembles it, indicating an intention to free-ride on the goodwill of Chanel. However, JPO took a holistic view and held that there was no similarity, reasoning that the opposed mark should be assessed as a whole. Given the tight combination of its literal elements, it was found to be dissimilar to “COCO” from a visual, phonetic and conceptual point of view.³⁶ The decisions of both IPHC and JPO resonate with the jurisprudence that is being followed in India and India could benefit from adopting a trademark manual similar to that being used in Japan.

B. Taiwan

Article 30.1.11 of the Trademark Act 2022 provides that the mark shall not be registered where it is identical or similar to an earlier trademark and is likely to cause confusion or dilute the distinctiveness of a well-known trademark.³⁷ Such a provision is analogous to Section 11(2) of the Indian Trademark Act, which states that even if a mark is not registered for similar goods or

³³ *Supra*, note 30.

³⁴ Yukari Ueda, IP HIGH COURT FINDS A TRADEMARK REGISTRATION VERY SIMILAR TO “GODZILLA” INVALID, SHIGA PATENT, (Oct. 2023).

³⁵ Masaki Mikami, *Chanel Defeated in Trademark Opposition Against “COCOCHI,”* JAPAN TRADEMARK REV. (Dec. 23, 2023).

³⁶ *Id.*

³⁷ Trademark Act, 2022, § 30.1.11 (Taiwan).

services similar to the present, it can still be refused if it is identical or similar to a prior well-known trademark and can cause damage its reputation.³⁸

Recently, the Taiwan's Intellectual Property Office [**"TIPO"**] cancelled the registration of the contested mark "Diora" due to its likelihood of confusion with "Dior" under Article 30.1.11 of the Trademark Act of Taiwan.³⁹ TIPO observed that the only difference between the two marks was the addition of the letter 'a' in "Diora". Such similarity was held to be damaging to its reputation.⁴⁰ The rationale strongly parallels the present case involving Skybags, where the only notable difference lies in the substitution of 'y' with a stylised 'o' in Skobags. This again reinforces the concept of deceptive similarity, with both cases illustrating attempts to exploit the established reputation of renowned brands through minor alterations that retain the overall impression of the original mark.⁴¹

In a similar instance, Prada filed opposition against "NIUNIU", contending that it would be confused with its "MIUMIU" trademark.⁴² The Petitions and Appeals Committee of Taiwan's Ministry of Economic Affairs [**"committee"**] upheld TIPO's decision, holding that the "NIU NIU" mark is confusingly similar and could mislead the consumers as there is visual and phonetic similarity, overlapping goods and services and strong evidence that Prada's "MIU MIU" is already a well-known trademark.⁴³ The registrant "NIU NIU" had argued that its goods were sold online, unlike "MIU MIU's", which primarily used physical store channels.⁴⁴ However, the committee rejected this defence, noting that such variance is not enough to show the difference between the two products and there was evidence of Prada's MIU MIU products being available online as well. This defence resembles the defence taken by Skobags stating that their *"channels of trade are entirely different from the channels of Skybags"*. Nevertheless, such defence is unlikely to succeed as it can still mislead consumers and create an association with the goods of Skybags. Taiwan's legislative intent and the jurisprudence look similar to what is being followed in India, specifically in protecting the trademarks against deceptive similarity.

³⁸ Trademarks Act, 1999, § 11(2), No. 47, Acts of Parliament, 1999.

³⁹ TIP, Fashion Brand "DIOR" Prevailed in Trademark Opposition Against "Diora" (Apr. 20, 2025).

⁴⁰ Cloud TIPO, Trademark Search System of the Intellectual Property Bureau (Apr. 20, 2025).

⁴¹ *Selle Royal Group v. ACE Footmark Ltd*, C.O.(COMM.IPD-TM) 196/2022.

⁴² *Supra*, note 40.

⁴³ *Id.*

⁴⁴ TIP, *Taiwan's IP Office Rejects Prada's Opposition Against "Jiu Jiu" Trademark* (Apr. 20, 2025).

C. Singapore

In Singapore, the concept of deceptive similarity is governed by Section 7(4)(b) of the Trade Marks Act 1998 which states that a trademark application will be refused if the mark contains any connotation or sign such that its use, in relation to the goods or services claimed in the application would be likely to deceive the public.⁴⁵ The deception could relate to characteristics of the goods or services, quality or quantity, etc.⁴⁶

In a recent case, *Google LLC v. Green Radar*, Google, which owns the trademark registration for “Gmail” in several countries and has a cross-border reputation, opposed the registration of “grMail” by Green Radar before the Intellectual Property Office of Singapore [“IPOS”].⁴⁷ IPOS rejected Google’s claims holding that the two marks were not similar and that any link between them would not result in any damage to the distinctive character of Gmail.⁴⁸ In *Bytedance Ltd. v. Dol Technology Pte Ltd*, Bytedance, the owner of “TikTok”, alleged that Dol Technology’s “Tiki” mark was deceptively similar to its mark and likely to cause confusion among consumers.⁴⁹ IPOS dismissed Bytedance’s allegations stating that the marks were visually, conceptually dissimilar and phonetically similar only to a low extent. Thereby rejecting the ByteDance trademark challenge. Compared to the jurisprudence in India, Singapore adopts a narrower approach focusing solely on phonetic, visual and conceptual distinctions, whereas Indian courts emphasise on overall impression. Indian courts also give tremendous weightage to reputation and goodwill of well-known trademarks.

V. RECOMMENDATIONS: PROPOSING AMENDMENT TO SECTION 11

In light of such cases, it is not wrong to consider an amendment to Section 11. A proviso may be introduced to clarify that where phonetic similarity exists but there is no visual resemblance or similarity in the class of goods or services, registration may still be allowed. However, such case must undergo a comprehensive evaluation, such as likelihood of consumer confusion, trade channel, conceptual similarity etc. For instance, in a case of Taiwan involving Prada and the mark “Jiu Jiu”, the claim of infringement was rejected.⁵⁰ Although there was phonetic similarity with “Miu Miu,” the marks were visually different and the goods were dissimilar. Another example is the Japanese case of Zara and Azra where the JPO dismissed the allegations of similarity stating

⁴⁵ Trade Marks Act 1998, § 7(4)(b) (2020 Rev. Ed.) (Singapore).

⁴⁶ *Id.*

⁴⁷ *Google LLC v. Green Radar* (Singapore) Pte Ltd, (2024) SGIPOS 1 (Singapore).

⁴⁸ Denise Mirandah, *R We Similar*, ASIA IP (March 31, 2024).

⁴⁹ *Bytedance Ltd. v. Dol Technology Pte Ltd*, (2024) SGIPOS 5 (Singapore).

⁵⁰ *Supra*, note 44.

that despite the phonetic similarities, the visual appearance differed and no confusion could arise, as the goods or services were not similar.⁵¹ Therefore, incorporating such a carve-out under Section 11 would ensure that legitimate registrations are not denied merely based on sound, where actual confusion is unlikely.

While Section 29(9) of the Act states that infringement is caused by “spoken use of those words” acknowledging the importance of phonetic similarity, this provision operates at the enforcement stage, after registration.⁵² If an amendment to Section 11 is allowed then at a very initial stage of registration, the Registry can address potential conflicts. Specifically, where trademarks are phonetic similar but lack visual similarity and are used for dissimilar goods or services, a more introspective approach could prevent unnecessary refusals and promote consistency in examination.

Sub- clause 11(c) can be framed as follows “*Subject to Section 12, a trade mark shall be registerable where there exists only phonetic similarity without any visual similarity to an earlier trade mark and where the goods or services covered are neither identical nor similar, such that no likelihood of confusion arises on the part of the public, which includes the likelihood of association with the earlier trade mark.*”

Visual dissimilarity should be one of the additions to the criteria of relative refusal, despite phonetic similarities. Amending this provision will ensure that marks exhibiting only phonetic similarity and no visual resemblance to earlier registered trademarks operating in different goods and services can still be allowed registration.

VI. CONCLUSION

The registration of Skobags, despite its similarities with the brand Skybags, poses a threat to proprietors of prior registered Trademarks that their marks may be misappropriated by others despite their registration. This case is an instance of deceptive similarity not only under Indian law but also when assessed against international standards of South Asian Countries such as in the Taiwan, Japan, Singapore.⁵³ When analysed under the initial interest confusion test, the registration of Skobags compromises brand loyalty, even if consumer confusion is resolved later.

However, a plausible reason for allowing such a trademark could be the co-existence of an agreement between Skobag and Skybag. Such contracts are legally permissible and often used when

⁵¹ Masaki Mikami, ZAEA v. AZRA, Japan Trademark Review, (Sept. 09, 2023).

⁵² Trademarks Act 1999, § 29(9), No. 47, Acts of Parliament, 1999.

⁵³ *Supra* Note 13.

two trademarks are similar, but the parties agree not to oppose each other's marks under certain conditions. In this case, there is a possibility that VIP Industries, proprietor of Skybags might have entered into a private agreement with Skobags to use and register the mark with defined limitations to avoid consumer confusion. Such an agreement could have been submitted to the Trade Mark Registry, who, based on it, might have accepted the registration; however, such agreements are rarely made public, leaving the rationale behind the approval speculative unless officially disclosed. If such an agreement does not exist, it calls for re-evaluating registration protocols and a serious push to protect such reputed marks in India.